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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91256213
Party	Defendant Community Brands Holdco, LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Heartland Payment Systems, LLC,

Opposer,

v.

Opposition No. 91256213

Community Brands Holdco, LLC,

Applicant.

ANSWER AND DEFENSES TO NOTICE OF OPPOSITION

Community Brands Holdco, LLC (“Applicant”) hereby responds to the Notice of Opposition (“Notice”) of Heartland Payment Systems, LLC (“Opposer”) as follows:

1. Applicant admits the allegations of paragraph 1 of the Notice.
2. Applicant admits the allegations of paragraph 2 of the Notice.
3. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 3 of the Notice and therefore denies the same.
4. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 4 of the Notice and therefore denies the same.
5. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 5 of the Notice and therefore denies the same.
6. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 6 of the Notice and therefore denies the same.

7. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 7 of the Notice and therefore denies the same.

8. Applicant admits the allegations of paragraph 8 to the extent they comport with the public record for U.S. Registration Nos. 4,255,165 and 5,955,915. With regard to the validity of the registrations and date of first use alleged in the registrations, Applicant is without knowledge or information sufficient to form a belief and therefore denies that the registrations are valid and that that the marks were used by Opposer as of the alleged dates of first use.

9. Applicant admits the allegations of paragraph 9.

10. Applicant admits the allegations of paragraph 10.

11. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 11 of the Notice and therefore denies the same.

12. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 12 of the Notice and therefore denies the same.

13. Applicant denies the allegations of paragraph 13.

14. Applicant admits that Applicant's mark and Opposer's asserted marks both begin with the "MYSCHOOL" text. Applicant denies that Applicant's mark and Opposer's asserted marks are identical.

15. Applicant denies the allegations of paragraph 15.

16. Applicant denies the allegations of paragraph 16.

17. Applicant denies the allegations of paragraph 17.

18. Applicant denies the allegations of paragraph 18.

19. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 19 of the Notice concerning the goods for which Opposer has used its asserted marks and therefore denies the allegations of paragraph 19.

20. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 20 of the Notice concerning the channels of trade through which Opposer has offered its goods and therefore denies the allegations of paragraph 20.

21. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 21 of the Notice concerning the consumers targeted by Opposer and therefore denies the allegations of paragraph 21.

22. Applicant denies the allegations of paragraph 22 of the Notice.

23. Applicant admits the allegations of paragraph 23 of the Notice.

24. Applicant denies the allegations of paragraph 24 of the Notice.

25. Applicant denies the allegations of paragraph 25 of the Notice.

26. All allegations in the Notice not specifically admitted or denied are hereby denied.

AFFIRMATIVE AND OTHER DEFENSES

1. The Notice fails to state a claim upon which relief can be granted.

2. The Notice fails by reason of the fact that use of the MYSCHOOLWALLET mark of U.S. Application Serial No. 88/296,846 (the “846 Application”) for the goods stated therein

has not caused and is not likely to cause confusion, mistake, or deception with regard to the source of the goods vis-a-vis the source of Opposer's goods and services allegedly provided under its MYSCHOOLBUCKS and MYSCHOOLAPPS marks and that registration of Applicant's MYSCHOOLWALLET mark of its '846 application for the goods listed therein has not caused and is not likely to cause any damage to any cognizable right or interest of Opposer.

3. The Notice fails by reason of the fact that confusion between Applicant's mark and Opposer's asserted marks is unlikely due to, at least in part, the extreme weakness of the "MYSCHOOL" text in Opposer's alleged marks as an indication of source in view of the widespread adoption, use, and registration of marks starting with the "MYSCHOOL" text by third parties for use with academic-related goods and services, and in particular for payment processing for academic institutions. Examples of such third party marks that are registered on the Principal Register include, but are not limited to:

MY SCHOOL – Reg. No. 4921521 – providing on-line educational classes
MY SCHOOL. MY CARD. MY BANK. – Reg. 2338010 – electronic payment processing
MYSCHOOLWORX – Reg. No. 4364480 – software for school management (which includes payment processing)
MYSCHOOLINSURANCE.COM – Reg. No. 3530595 – insurance agency services specializing in the education industry
MY SCHOOL SWAP – Reg. No. 4252880 – charitable school fundraising services

Examples of such third party common law marks include, but are not limited to:

MYSCHOOLACCOUNT for payment processing software -
<https://www.myschoolaccount.com/>
MYSCHOOLFEES for payment processing software -
https://secure3.myschoolfees.com/start_v2.aspx
NYC MYSCHOOLS for online applications to schools -
<https://www.myschools.nyc/en/>

MY SCHOOL DC for online applications to schools -

<https://www.myschooldc.org/>

BOOSTMYSCHOOL for software for school fundraising and payment processing -

<https://www.boostmyschool.com/>

MYSCHOOL MAIL for communication software for schools -

<https://www2.vbschools.com/xtra/myschoolmail.asp>

4. Applicant reserves the right to assert such other and further defenses including, but not limited to, affirmative defenses, as it may become aware of in the course of this proceeding.

WHEREFORE, Applicant prays that the Board deny all relief requested by Opposer herein, that the Board dismiss the Opposition Proceeding with prejudice against Opposer, and that the Board grant Applicant such other and further relief as it deems just.

Respectfully Submitted,

LUEDEKA NEELY GROUP, P.C.

Dated: July 10, 2020

By: s/Michael J. Bradford

Michael J. Bradford, Reg. No. 52,646

LUEDEKA NEELY GROUP, P.C.

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Certificate of Service

This is to certify that a true and correct copy of the foregoing is being served on counsel of record, by email, addressed as follows:

Norm J. Rich – nrich@foley.com
Katherine P. Califa – kcalifa@foley.com

Date: July 10, 2020

s/Michael J. Bradford/
Michael J. Bradford