

ESTTA Tracking number: **ESTTA1111572**

Filing date: **02/01/2021**

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

Proceeding	91256500
Party	Defendant Tapa Reef Pty Ltd
Correspondence Address	CHRISTINE DEVENEY TAPAREEF LLC 3830 S HWY A1A SUITE 4-103 MELBOURNE BEACH, FL 32951 UNITED STATES Primary Email: christine.deveney@tapareef.com 321-505-5775
Submission	Answer
Filer's Name	Christine deveney
Filer's email	christine.deveney@tapareef.com
Signature	/Christine Deveney/
Date	02/01/2021
Attachments	TapaReef_Answer to TTAB 13 and Amended Notice of Opposition_91256500_20210201.pdf(224923 bytes)

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

TapaReef Pty Ltd v. Roberto Giordani

Opposition No. 91256500

ANSWER AND AFFIRMATIVE DEFENSES

Proceeding	91256500
Party	Defendant TapaReef Pty Ltd
Correspondence Address	TapaReef LLC 3830 S Hwy A1A Suite 4-103 Melbourne Beach FL 32951 UNITED STATES christine.deveney@tapareef.com
Submission	Answer to 13 TTABVUE Answer to Amended Notice of Opposition
Filer's Name	Christine Deveney, Managing Director, TapaReef Pty Ltd Domestic Representative for the Defendant
Filer's e-mail	christine.deveney@tapareef.com
Signature	
Date	
Attachments	TapaReef Pty Ltd Answer as ESTTA FILED February 1, 2021

Registration Subject to the Filing

Application No	88421700	Publication date	12/24/2019
Opposition Filing Date	06/21/2020		
Applicant	TapaReef Pty Ltd		

Goods/Services Subject to the Filing

Class 018. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Tote bags

Class 025. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Clothing, namely, shirts, pants, tops, bottoms, jackets, footwear, hats, skirts, dresses, and beach cover ups

Class 035. First Use: 2015/06/23 First Use In Commerce: 2015/06/23

All goods and services in the class are opposed, namely: Discount retail and wholesale retail store services featuring skin care, sporting equipment, printed publications and online publications on sports, leisure, travel, education or entertainment; promotional services, namely, the promotion of the goods of others, via online gift cards, gift certificates, coupons, online advertising, social media advertising; promoting the goods of others on public communication media, for retail purposes; retail store services featuring skin care products, sporting equipment, printed publications and online publications on sports, leisure, travel, education or entertainment; retail store services featuring cosmetics, skin care, hair care, sporting goods, travel accessories, travel guides, books, workbooks, educational material; Distributorship services in the field of skin care, sporting equipment, printed publications and online publications on sports, leisure, travel, education or entertainment; Wholesale store services featuring skin care products, sporting equipment, printed publications and online publications on sports, leisure, travel, education or entertainment; sales promotion services; demonstration of goods for promotional purposes; online advertising and promotional services on a computer network; Promoting the sale of goods and services of others by awarding purchase points for credit card use; promotion of business opportunities; promoting the travel services of others via print and electronic media; advertising and promotional services; promotional sponsorship of sporting events and surfing events; promoting tourism in Southern California, Northern California, and Hawaii; arranging and conducting exhibitions for

business and advertising purposes in the fields of skin care, sporting, leisure, travel, education and entertainment; promoting and conducting trade shows in the fields of skin care, sporting ,leisure, travel, education and entertainment; compilation of advertisements for use as web pages on the internet; Providing business information via a website ;online advertising on a computer network; distribution of advertising material; distribution of samples for publicity purposes; advertising services provided over the internet for others; rental of advertising space on websites

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

In the Matter of Trademark Application Serial No. 88421700 Published in the Official Gazette December 24, 2019

Roberto Giordani.,
Opposer,

v.

TapaReef Pty Ltd.,
Applicant.

Opposition No.
91256500

In re application no. 88421700 Mark:



Published in Official Gazette of Dec. 24, 2019

APPLICANT’S RESPONSE TO 13 TTABVUE

Opposer claims Applicant’s representation that it is not required to appoint U.S. counsel should be disregarded. In discussing the term “principal place of business”, Opposer provides an explanation of the role of the Australian Securities & Investments Commission (ASIC) and references the website, <https://asic.gov.au/about-asic/what-we-do/our-role/>. As further explained therein, ASIC is set up and administered under the Australian Securities and Investments Commission Act 2001 (ASIC Act) and carries out its work under the Corporations Act. The terms “principal place of business” and “domicile” are not defined in the ASIC Act or the Australian Corporations Act 2001. However, Applicant submits that for purposes of this proceeding, the definition provided by Trademark Rule 2.2(p) is the relevant definition, not the

definition according to Australian authority. That section states:

“The term principal place of business as used in this part means the location of a juristic entity's headquarters where the entity's senior executives or officers ordinarily direct and control the entity's activities and is usually the center from where other locations are controlled.”

As stated in Applicants Response dated December 17, 2020, the sole shareholder and sole executive officer of the Applicant, Christine Deveney, is a U.S. citizen residing in and domiciled in the United States where all corporate affairs are directed and managed and therefore, Applicant submits that it does not have a foreign domicile.

Notwithstanding, Applicant has requested both a change of correspondence address and motion to join/substitute TapaReef LLC a U.S. company to this proceeding. Opposer has consistently opposed these motions which Applicant believes merely distracts from Opposer's original stated reasons for opposing this trademark and serves to delay this proceeding. Applicant respectfully requests the Board accept Applicant's Motion to Join/Substitute TapaReef LLC so that proceedings can continue to move forward

**APPLICANT'S ANSWER
TO NOTICE OF OPPOSITION, AFFIRMATIVE DEFENSES**

Applicant, TapaReef Pty Ltd (“TapaReef”), for its answer to the Amended Notice of Opposition filed by Roberto Giordani against application for registration of TapaReef's design mark, Serial No. 88421700 filed May 8, 2019, and published in the Official Gazette of December 24, 2019 (the “Mark”), pleads and avers as follows:

1. Applicant denies knowledge and information sufficient to admit or deny the allegations of ¶ 1.

2. Answering ¶ 2, Applicant admits TapaReef Pty Ltd. is a proprietary limited company according to the laws of Australia however, the company no longer maintains its address at 17 Ebor Road Palm Beach NSW Australia 2108.

3. Applicant denies knowledge and information sufficient to admit or deny the allegations of ¶ 3.

4. Applicant denies knowledge and information sufficient to admit or deny the allegations of ¶ 4.

5. Applicant admits to the statement contained in ¶ 5.

6. Applicant denies each and every allegation contained in ¶ 6.

7. Applicant denies each and every allegation contained in ¶ 7.

8. Answering ¶ 8, Applicant admits Applicant filed the Application as being owned by “Tapa Reef Pty Ltd.” a proprietary limited company according to the laws of Australia but otherwise denies each and every allegation contained therein.

9. Applicant denies knowledge and information sufficient to admit or deny the allegations ¶ 9.

10. Applicant denies each and every allegation contained in ¶ 10.

11. Applicant denies knowledge and information sufficient to admit or deny the allegations contained in ¶ 11.

12. Applicant denies each and every allegation contained in ¶ 12.

13. Applicant denies each and every allegation contained in ¶ 13.

14. Applicant denies each and every allegation contained in ¶ 14.

15. Applicant denies each and every allegation contained in ¶ 15.

16. Applicant denies each and every allegation contained in ¶ 16.

17. Applicant denies each and every allegation contained in ¶ 17.

AFFIRMATIVE DEFENSES

First Affirmative Defense

There is no likelihood of confusion, mistake or deception because, inter alia, the Applicant's Mark and the alleged Mark of Opposer are not confusingly similar.

Second Affirmative Defense

Applicant's primary use of the Applicant's Mark is in association with goods marketed toward beach goers, swimmers, surfers and other beach and pool watersports. This is a highly niche market. We don't see evidence that Opposer is using the Opposer's Mark in association with related goods sold to the same classes of purchaser.

Third Affirmative Defense

Applicant has been using the Applicant's Mark and developing consumer recognition and goodwill therein since at least June 23, 2015, such use being continuous, open and notorious.

Fourth Affirmative Defense

Christine Deveney, a U.S. citizen residing and domiciled in the United States, is the sole shareholder and executive officer of both TapaReef Pty Ltd. and TapaReef LLC. All business affairs are directed and controlled by Ms Deveney within the United States which is also where the significant majority of customers are located and revenue is generated. A motion to assign the rights to the trademark that is the subject of this proceeding to TapaReef LLC was filed on July 22, 2019 which reflects the business' commercial domicile and intent to operate the business

through the domestic entity, TapaReef LLC.

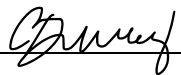
WHEREFORE, Applicant, TapaReef Pty Ltd, prays as follows:

- (a) this opposition be dismissed;
- (b) registration for Serial No. 88421700 be issued to the Applicant.

Dated: February 1, 2021

Respectfully Submitted,

TapaReef Pty Ltd

By:  _____

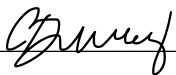
Christine Deveney

Managing Director, TapaReef Pty Ltd

Domestic Representative for Defendant

CERTIFICATE OF SERVICE

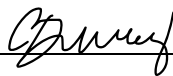
I hereby certify that a true and complete copy of the foregoing (ANSWER AND AFFIRMATIVE DEFENSES) has been served on (on Attorney for the Opposer, Jason DeFrancesco) by forwarding said copy on (February 1, 2021), via email to: (jdefrancesco@hillwallack.com).

Signature  Date February 1, 2021

CERTIFICATE OF ELECTRONIC FILING

The undersigned certifies that this submission (along with any paper referred to as being attached or enclosed) is being filed with the United States Patent and Trademark Office via the Electronic System for Trademark Trials and Appeals (ESTTA) on this 1st day of February 2021.

By:



Christine Deveney

Managing Director, TapaReef Pty Ltd

Domestic Representative for Applicant