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

Proceeding	91265225
Party	Defendant NEWYORKSOCIALDIARY.COM, L.L.C.
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Date	11/03/2020
Attachments	Palm Beach Answer 10.20 final for filing.pdf(82879 bytes)

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

In re United States Appl. Ser. [88878050](#)
Mark: PALM BEACH SOCIAL DIARY

PALM BEACH SOCIAL DIARY, LLC,)
)
Opposer,)
)
v.)
)
NEWYORKSOCIALDIARY.COM, L.L.C.,)
)
Applicant.)

Opposition No. 91265225

ANSWER TO NOTICE OF OPPOSITION

Applicant, NEWYORKSOCIALDIARY.COM, L.L.C., (“Applicant”), by and through its attorneys Baker and Rannells, PA, for its d Answer to the Notice of Opposition filed by Opposer, PALM BEACH SOCIAL DIARY, LLC (“Opposer”) alleges on knowledge as to its own acts and otherwise upon information and belief as follows:

ANSWER

1. Applicant has insufficient knowledge or information upon which to form a belief concerning the allegations contained in Paragraph 1 of the Notice of Opposition and leaves Opposer to its proofs.
2. Applicant has insufficient knowledge or information upon which to form a belief concerning the allegations contained in Paragraph 2 of the Notice of Opposition and leaves Opposer to its proofs.

3. Applicant has insufficient knowledge or information upon which to form a belief concerning the allegations contained in Paragraph 3 of the Notice of Opposition and leaves Opposer to its proofs.
4. Applicant admits that it is a limited liability company organized under the laws of the state of New York and denies the remainder of the allegations of Paragraph 3 of the Notice of Opposition.
5. Applicant admits that there was a meeting in 2019 and denies the remainder of the allegations of Paragraph 5 of the Notice of Opposition.
6. Applicant denies the allegations of Paragraph 6 of the Notice of Opposition and affirmatively asserts that the “coming soon” referred to an about to be launch Instagram account and not to use PALM BEACH SOCIAL DIARY as demonstrated by the specimens filed with the application being opposed which demonstrate continuous use since at least as early as 2008..
7. Applicant admits that it is not registered to conduct business in the state of Florida with the Florida Secretary of State / Division of Corporations, and denies the and denies the remainder of the allegations of Paragraph 7 of the Notice of Opposition as irrelevant to the issues in the proceeding.
8. Applicant denies the allegations of Paragraph 8 of the Notice of Opposition.
9. Applicant admits that there was a meeting in 2019 requested by Jessica Swift, Opposer’s Editor-in-Chief and denies the remainder of the allegations of Paragraph 9 of the Notice of Opposition.
10. Applicant realleges its responses to paragraphs 1 – 9 of the Notice of Opposition as if set forth fully herein.

11. Applicant denies the allegations of Paragraph 11 of the Notice of Opposition.
12. Applicant admits seeking a registration of the mark being opposed and denies the remainder of the allegations of Paragraph 12 of the Notice of Opposition.
13. Applicant denies the allegations of Paragraph 13 of the Notice of Opposition.
14. Applicant denies the allegations of Paragraph 14 of the Notice of Opposition.
15. Applicant denies the allegations of Paragraph 15 of the Notice of Opposition.
16. Applicant realleges its responses to paragraphs 1 – 15 of the Notice of Opposition as if set forth fully herein.
17. Applicant has insufficient knowledge or information upon which to form a belief concerning the allegations contained in Paragraph 17 of the Notice of Opposition and leaves Opposer to its proofs.
18. Applicant admits that the marks are identical and denies the remainder of the allegations of Paragraph 18 of the Notice of Opposition.
19. Applicant admits that it is not connected to Opposer and denies the remainder of the allegations of Paragraph 19 of the Notice of Opposition.
20. Applicant admits that Applicant's mark Palm Beach Social Diary has acquired fame and reputation and denies the remainder of the allegations of Paragraph 20 of the Notice of Opposition.
21. Applicant denies the allegations of Paragraph 21 of the Notice of Opposition.
22. Applicant realleges its responses to paragraphs 1 – 21 of the Notice of Opposition as if set forth fully herein.
23. Applicant admits the recitation of the law as set forth in Paragraph 23 of the Notice of Opposition

24. Applicant has insufficient knowledge or information upon which to form a belief concerning the allegations of Opposer's alleged use as set forth in Paragraph 24 of the Notice of Opposition and leaves Opposer to its proofs and denies the remainder of the allegations of Paragraph 24 of the Notice of Opposition.

25. Applicant denies the allegations of Paragraph 25 of the Notice of Opposition.

26. Applicant denies the allegations of Paragraph 26 of the Notice of Opposition.

27. Applicant denies the allegations of Paragraph 27 of the Notice of Opposition.

AFFIRMATIVE DEFENSES

28. On July 15, 2017, Opposer filed an application to register PALM BEACH SOCIAL DIARY for "Advertising and directory services on the website of the applicant that promotes and advertises services of others through digital informational campaigns such as experiential first person marketing. Goods and services of paid advertisers are placed throughout the website in banner ads and articles. The website of the applicant is accessed through connecting to the Internet and navigating to the applicant's web domain, and the website is available without restriction to viewers and on a free basis. The website provides two main references pages, the first is a social calendar of charitable events occurring in and around the Palm Beach Florida area, the second is a dining guide including contact information and links to the websites of restaurants in the Palm Beach Florida area. The mark is used in a suggestive manner in that readers of the digital publication will be given suggestions from the digital publication as to how to host events, events to attend, and other social occurrences to attend. In limited circumstances, recaps of past events are also presented in the digital publication."

29. The application referred to in paragraph 28 encountered a 2(d) rejection based on Applicant's U.S. Reg. No. 4241044 for NEW YORK SOCIAL DIARY and a 2(e)(2) rejection based on Opposer's alleged mark because the applied-for mark is primarily geographically descriptive of the origin of applicant's services.

30. After a series of responses and rejections, the application referred to in paragraph 28 encountered a final rejection.

31. On October 17, 2019, Opposer filed a Request for Reconsideration after Final Action.

32. On October 24, 2019, the Request for Reconsideration after Final Action was denied and the 2(d) and 2(e)(2) were reiterated.

33. Opposer failed to appeal the denial of the Request for Reconsideration after Final Action.

34. Opposer's use of PALM BEACH SOCIAL DIARY is likely to cause confusion with Applicant's NEW YORK SOCIAL DIARY and its PALM BEACH SOCIAL DIARY marks.

35. Opposer has no legitimate interest in the mark PALM BEACH SOCIAL DIARY and thus lacks standing to bring this opposition.

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Wherefore, Applicant requests that the Notice of Opposition be denied.

November 3, 2020

BAKER AND RANNELLS, PA

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing ANSWER TO NOTICE OF OPPOSITION AND AFFIRMATIVE DEFENSES has been served on Opposer via email on November 03, 2020, to the attorneys for Opposer at: tswift@foryourrights.com, lnetherland@foryourrights.com

 /Stephen L. Baker/
Stephen L. Baker