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

Proceeding	91269827
Party	Defendant Jefferson, Oneil
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Date	07/21/2021
Attachments	Answer to Notice of Opposition - Neilo.pdf(195245 bytes )

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

Sisco Textiles N.V. )  
Opposer, ) Opposition No. 91269827  
v. ) In the Matter of  
Oneil Jefferson ) Application Serial No. 90072693  
Applicant. ) Mark: NEILO  
)

**ANSWER TO NOTICE OF OPPOSITION**

Applicant, Oneil Jefferson (hereinafter “Applicant”), owner of Federal Trademark Application Serial No. 90072693 for the mark “NEILO,” a design mark, by and through Counsel, Trademark Lawyer Law Firm, PLLC, for its Answer and Affirmative Defenses to the Notice of Opposition filed June 11, 2021 and assigned Cancellation No. 91269827, hereby responds, solely for the purpose of this proceeding, to each of the grounds set forth in the Notice of Opposition, as follows:

1. Opposer, directly and through licensees, has long used and uses the mark O’NEILL® and formatives of that mark, the trade name O’Neill, and the domain name oneill.com in connection with a variety of goods and services, including clothing, active wear, such as swimwear, footwear, hats, gloves, bags, and accessories, and related goods and services including retail store services, catalog services and online retail store services featuring such goods. Specifically, for decades, the goods and services offered under Opposer’s O’NEILL® mark have been and are distributed, sold and promoted in the United States, including in O’NEILL® branded retail stores and online at [www.oneill.com](http://www.oneill.com), and in catalogs, and through independent retail stores and e-commerce sites, including, among other e-commerce sites, [amazon.com](http://amazon.com).

**ANSWER: Applicant neither admits nor denies the allegations set forth in Paragraph 1 but leaves Opposer to its proofs.**

2. Opposer owns valid, subsisting, and unrevoked federal trademark registrations consisting of the word mark O’NEILL®, including U.S. Registration Nos. 1,183,040, 1,339,268,

1,069,298, 2,425,804, and 3,939,936. Opposer also owns valid, subsisting, and unrevoked federal trademark registrations for marks that contain formatives of O'NEILL® mark, including U.S. Registration Nos. 1,367,364, 4,085,740, and 4,251,127. These registrations also cover apparel, footwear and accessories in Class 25 and other classes, and other related goods and services, including retail store services featuring apparel. Certain of the referenced registrations have become and are incontestable. True and correct copies of the TSDR and Assignment Status printouts for these marks from the USPTO website are attached hereto as **Exhibit A**

**ANSWER: Applicant neither admits nor denies the allegations set forth in Paragraph 2 but leaves Opposer to its proofs.**

3. Opposer has used the O'NEILL® mark in interstate and foreign commerce in connection with clothing, sunglasses, bags, wetsuits, hats, gloves, footwear, active wear, such as swimwear, and accessories, and related goods and services, since at least as early as February 1976, decades prior to the filing date and first use date of the opposed designation at issue in this proceeding. As such, the O'NEILL® mark has long been associated exclusively with Opposer. Opposer, directly and through licensees, owns and uses the domain name oneill.com and the trade name O'Neill.

**ANSWER: Applicant neither admits nor denies the allegations set forth in Paragraph 3 but leaves Opposer to its proofs.**

4. Opposer has expended substantial time and effort in promoting the O'NEILL® mark and name in connection with clothing, footwear, sunglasses, wetsuits, bags, hats, gloves, active wear and accessories, and other related goods and services. Opposer promotes the O'NEILL® mark and name through its website (<https://oneill.com/>), its social media accounts on platforms such as Twitter, Instagram and Facebook (<https://twitter.com/teamoneill?lang=en>, <https://www.facebook.com/ONeill/>, and <https://www.instagram.com/oneillusa/?hl=en>), and through videos on its YouTube page ([https://www.youtube.com/channel/UCJpYAIXW5M\\_sDR8jvXbrxog](https://www.youtube.com/channel/UCJpYAIXW5M_sDR8jvXbrxog)).

**ANSWER: Applicant neither admits nor denies the allegations set forth in Paragraph 4 but leaves Opposer to its proofs.**

5. Through continuous and exclusive use, Opposer's O'NEILL® mark has become exclusively identified with Opposer's goods and related services, and Opposer has developed substantial goodwill in its federally registered O'NEILL® mark. Opposer's federally registered O'NEILL® mark is well-regarded, well-known and has become famous in the United States).

**ANSWER: Applicant neither admits nor denies the allegations set forth in Paragraph 5 but leaves Opposer to its proofs.**

6. On July 24, 2020, decades after Opposer commenced use of and had first registered the O'NEILL® mark in the United States, and after the O'NEILL® mark had become well-known and famous, Applicant filed an use-based application for the designation NEILO, (stylized), Serial No. 90/072,693. The opposed application covers the following goods in International Class 25: “Boots; Coats; Hats; Headwear; Jeans; Knit tops; Pants; Pullovers; Shirts; Shoes; Shorts; Sneakers; Socks; Suits; Sweatshirts; T-shirts; Vests; Windbreakers; Belts; Bottoms as clothing; Gloves as clothing; Hoodies; Jackets; Jerseys; Polo shirts; Short sets; Tops as clothing.” The date of first use set forth in the opposed application is May 29, 2020, also decades after Opposer commenced use of and first registered its O'NEILL® mark in the United States

**ANSWER: Applicant neither admits that he filed his application on July 24, 2020 based on use in commerce at least as early as May 29, 2020 and was assigned Serial No. 90072693. Applicant further admits that his description of good on the application included “Boots; Coats; Hats; Headwear; Jeans; Knit tops; Pants; Pullovers; Shirts; Shoes; Shorts; Sneakers; Socks; Suits; Sweatshirts; T-shirts; Vests; Windbreakers; Belts; Bottoms as clothing; Gloves as clothing; Hoodies; Jackets; Jerseys; Polo shirts; Short sets; Tops as clothing” in International Class 25. Applicant denies the remainder of the allegations set forth in Paragraph 6.**

7. Based on the goods for which Applicant seeks to register the applied-for designation, Applicant's goods will be competitive with, directly related or overlapping with the goods and services Opposer has long offered and sold under its O'NEILL® mark.

**ANSWER: Applicant denies the allegations set forth in Paragraph 7.**

8. On information and belief, the goods that Applicant offers or will offer under the applied-for designation will or are sold and offered for sale through the same or overlapping channels of trade and in the same geographic locations, will or are used by the same or overlapping end users, and will or are used by the same or overlapping type of customers to whom Opposer markets, promotes and sells its products and services under its O'NEILL® mark. Opposer's registrations for the O'NEILL® mark on their face are not limited to any type of consumer or channels of trade. Similarly, Opposer's goods identified in its registrations are not limited to any type of consumer or channels of trade.

**ANSWER: Applicant denies the allegations set forth in Paragraph 8.**

9. Applicant's applied-for designation, NEILO (stylized), is effectively identical in sight, sound, and overall commercial impression to Opposer's O'NEILL® mark, which thereby conveys an affiliation, association or sponsorship between Applicant and Opposer when there is none, and creates a likelihood of consumer confusion, and threatens to harm the O'NEILL® mark

**ANSWER: Applicant denies the allegations set forth in Paragraph 9.**

10. Indeed, Applicant was well aware of Opposer's long established trademark rights when Applicant began to use and filed the designation covered in the opposed application at issue in this proceeding. On March 14, 2019, over a year earlier, Applicant had filed an intent-to-use application in the United States Patent and Trademark Office for the designation NEILO for the same goods as opposed application in this proceeding: "Boots; Coats; Hats; Headwear; Jeans; Knit tops; Pants; Pullovers; Shirts; Shoes; Shorts; Sneakers; Socks; Suits; Sweatshirts; T-shirts; Vests; Windbreakers; Belts; Bottoms as clothing; Gloves as clothing; Hoodies; Jackets; Jerseys; Polo shirts; Short sets; Tops as clothing," bearing Serial No. 88/323,634. Opposer timely opposed that application based on its established trademark rights in the brand O'NEILL® and its trade name rights. In that opposition proceeding, on December 11, 2019, before the opposed application in this proceeding was filed, a default judgment was issued against Applicant's first application for NEILO. A true and correct copy of that TTAB order is attached hereto as Exhibit B. Thus, there can be no doubt that Applicant knew of Opposer's established trademark rights when the opposed application was filed and the designation was adopted for use.

**ANSWER: Applicant neither admits nor denies the allegations set forth in Paragraph 10 but leaves Opposer to its proofs.**

11. Opposer incorporates by reference and re-alleges as though fully set forth herein the allegations of paragraphs 1 through 10 of this Notice of Opposition.

**ANSWER: Applicant incorporates by reference its responses to Paragraphs 1-10 as if set forth fully here.**

12. The goods set forth in the opposed application on their face overlap with, and/or are directly competing or related to the goods and services Opposer has long offered and sold under the O'NEILL® mark in the United States. Further, on information and belief, the goods listed in the opposed application are or will be sold or offered for sale through the same or overlapping channels of trade and/or in the same geographic locations, are or will be used by the same or overlapping users, and are or will be directed to the same or overlapping type of customers to whom Opposer markets, promotes and sells its goods and services under its O'NEILL® mark.

**ANSWER: Applicant denies the allegations set forth in Paragraph 12 to the extent that there is no likelihood of confusion between the marks based on the distinctive**

**nature of the goods and services, differences in channels of trade, sophistication of the consumers and difference between the appearance and meaning of the marks..**

13. The opposed designation is essentially identical and/or substantially similar in terms of sight, sound, and overall commercial impression to Opposer's O'NEILL® mark and the O'Neill trade name, used for overlapping related and/or directly competing goods, and thereby, is confusingly similar to Opposer's O'NEILL® mark and name.

**ANSWER: Applicant denies the allegations set forth in Paragraph 13 to the extent that there is no likelihood of confusion between the marks based on the distinctive nature of the goods and services, differences in channels of trade, sophistication of the consumers and difference between the appearance and meaning of the marks..**

14. The designation covered by the opposed application is likely to cause confusion, or to cause mistake or disparage or deceive by falsely suggesting a connection with Opposer and the goods and services for which Opposer uses and has long used its O'NEILL® mark and name, when there is no such connection or any relationship between Opposer and Applicant.

**ANSWER: Applicant denies the allegations set forth in Paragraph 14 to the extent that there is no likelihood of confusion between the marks based on the distinctive nature of the goods and services, differences in channels of trade, sophistication of the consumers and difference between the appearance and meaning of the marks..**

15. Opposer believes it will be damaged by registration of the applied-for designation in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d). Unless Applicant's application is denied, Applicant will unjustifiably reap the benefits of the goodwill attached to Opposer, its O'NEILL® mark, and its goods and services offered and sold under the O'NEILL® mark and name, and Opposer will likely suffer damage and injury as a result of the confusion that is likely to arise if the opposed application is allowed to proceed to registration.

**ANSWER: Applicant denies the allegations set forth in Paragraph 14 to the extent that there is no likelihood of confusion between the marks based on the distinctive nature of the goods and services, differences in channels of trade, sophistication of the consumers and difference between the appearance and meaning of the marks.**

16. Opposer incorporates by reference and re-alleges as though fully set forth herein the allegations of paragraphs 1 through 15 of this Notice of Opposition

**ANSWER: Applicant incorporates by reference its responses to Paragraphs 1-15 as if set forth fully here.**

17. Opposer believes it will be damaged by registration of the applied-for designation under Section 13 of the Lanham Act, 15 U.S.C. § 1063, because the use and registration of the applied-for designation is likely to dilute the distinctive quality of Opposers' famous O'NEILL® mark, in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

**ANSWER: Applicant denies the allegations set forth in Paragraph 16 to the extent that there is no likelihood of confusion between the marks based on the distinctive nature of the goods and services, differences in channels of trade, sophistication of the consumers and difference between the appearance and meaning of the marks.**

**Additional and Affirmative Defenses**

1. The Notice fails to state a claim upon which relief can be granted.
2. There is no likelihood of confusion between Opposer's and Applicant's marks.
3. Opposer has not been damaged.
4. Opposer will not be damaged by the registration of Applicant's mark.

There may be additional affirmative defenses, and/or counterclaims to Opposer's Notice of Opposition that are currently unknown to the Applicant. Applicant therefore reserves the right to amend this answer and allege additional defenses, and/or counterclaims in the event discovery or other information indicates they are appropriate.

Wherefore, Applicant respectfully requests that the Trademark Trial and Appeal Board deny and dismiss the Opposition in all respects.

Respectfully Submitted,  
Oneil Jefferson

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**CERTIFICATE OF SERVICE**

I hereby certify that on July 21, 2020, a true and correct copy of the foregoing Answer to the Notice of Opposition was served upon:

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By Electronic Mail.

I further certify that the foregoing paper is being filed electronically via the Electronic System for Trademark Trials and Appeals (ESTTA).

Date: July 21, 2020

/Erin C. Bray/  
Erin C. Bray