Trademark Trial and Appeal Board Electronic Filing System. https://estta.uspto.gov

ESTTA Tracking number: **ESTTA1185919**

Filing date: **01/21/2022**

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

Proceeding no.	91273395
Party	Defendant Belfor Franchise Group LLC
Correspondence address	JEREMY D. BISDORF JAFFE RAITT HEUER & WEISS, P.C. 27777 FRANKLIN RD., SUITE 2500 SOUTHFIELD, MI 48034 UNITED STATES Primary email: trademark@jaffelaw.com Secondary email(s): jbisdorf@jaffelaw.com, dcooke@jaffelaw.com No phone number provided
Submission	Answer
Filer's name	David S. McDaniel
Filer's email	dmcdaniel@jaffelaw.com
Signature	/David S. McDaniel/
Date	01/21/2022
Attachments	Answer to Notice of Opposition BKP - 4864-3655-9882.v1.pdf(169895 bytes)

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

PACKOUT HOLDINGS, LLC,	)	Opposition No. 91273395
Opposer,	)	Serial No. 90307108
v.	)	
BELFOR FINANCE GROUP LLC,	)	
Applicant.	)	

ANSWER AND AFFIRMATIVE DEFENSES TO NOTICE OF OPPOSITION

Applicant Belfor Franchise Group, LLC ("Belfor"), by its undersigned counsel, states the following for its Answer and Affirmative Defenses to Opposer Packout Holdings, LLC's ("Opposer") Notice of Opposition regarding U.S. Application Serial No. 90,307,108:

PRELIMINARY STATEMENT

In its Notice of Opposition, Opposer identifies the Applicant of U.S. Application Serial No. 90,307,108 as "Belfor Finance Group, LLC." As indicated in the application materials on file with the USPTO, and as set forth in the Notice of Institution issued by the TTAB, the actual applicant is Belfor Franchise Group, LLC. The allegations of the Notice of Opposition will be treated as made against Belfor Franchise Group, LLC for the purposes of this pleading.

ANSWER

1. Packout Holdings, LLC and its affiliates (collectively, "Opposer", unless otherwise indicated) operate in an industry called the "restoration industry," and more generally, the "contents industry." Companies in this industry assist homeowners and business owners during

renovation and in responding to fire, smoke, flood, mold or other like circumstances, i.e. situations typically requiring taking inventory and, if not a total loss, removal of personal property from the premises, restoration, storage and return of the property.

ANSWER: Belfor lacks knowledge or information sufficient to form a belief about the truth of the allegations of this paragraph.

2. In 2013, Opposer's co-founders, Kevin Loner and Bart Parker perceived a need for a "contents" business that could offer "one stop shopping" for insurance companies covering personal property claims. Insurers could obtain a bundle of services from Opposer that included packing services, inventory, cleaning, storage and return. At the time, insurance companies typically dealt with a variety of different restoration professionals, e.g. one company would take care of smoke damage on clothing and other textiles, while another company would install dehumidifiers for flooded structures, yet another company would pack/clean/store. Opposer offered a more efficient, consolidated solution for handling personal property.

ANSWER: Belfor lacks knowledge or information sufficient to form a belief about the truth of the allegations of this paragraph.

3. In 2013, Opposer coined the term ''PACKOUTS" for its consolidated solution and launched this business under the mark "1-800-PACKOUTS". The "1-800-PACKOUTS" mark is registered for ''removal and storage of residential, commercial and industrial contents, namely, junk, trash and debris removal, moving and storage of furniture and personal property, pick-up and delivery of furniture and personal property, and providing storage facilities for others." on the Principal Register in the U.S. Patent and Trademark Office as Registration No. 4,908,139. Such Registration issued on March 1, 2016, and is valid and subsisting.

ANSWER: Belfor admits the allegations of the second sentence of this paragraph and the allegation that the registration referenced in the third sentence issued on March 1, 2016.

Belfor lacks knowledge or information sufficient to form a belief about the truth of the remaining allegations of this paragraph.

4. On information and belief, at the time Opposer launched its business in 2013, the singular term ‘‘pack-out” was at times used informally to describe one aspect (i.e. packing/storing/returning) among many in the mitigation and restoration process that had usually been implemented by engaging more than one vendor, but which Opposer offered to its customers as a single solution with Opposer as the single point of contact. On information and belief, ‘‘pack-out” was not and is not used to describe the multi-faceted services provided by Opposer.

ANSWER: Belfor lacks knowledge or information sufficient to form a belief about the truth of the allegations of this paragraph.

5. Opposer’s business model was extremely successful. In 2015, Opposer launched a franchise operation under the 1-800-PACKOUTS mark, and began licensing such mark for the operation of franchises providing the consolidated content handling and restoration solution that Opposer pioneered. Opposer has expanded to 89 franchise locations across the U.S. since mid-2015, and maintains its original company-owned locations. *Entrepreneur* magazine ranked Opposer’s franchise as #275 in its “Franchise 500 2021” rankings, and Opposer’s franchise has been noted on *Entrepreneur’s* list of fastest growing franchises for three years. See Exhibit A.

ANSWER: Belfor lacks knowledge or information sufficient to form a belief about the truth of the allegations of this paragraph.

6. Opposer has used 1-800-PACKOUTS as a mark and as the distinctive portion of the tradename 1-800-Packouts Franchise continuously in U.S. commerce since at least as early as October 2013 for its services, and it continues to do so.

ANSWER: Belfor lacks knowledge or information sufficient to form a belief about the truth of the allegations of this paragraph.

7. After Opposer launched its business in 2013, Opposer's customers, insurance adjusters, general contractors and other relevant members of the industry began to refer to Opposer and its services as simply "PACKOUTS," shorthand for "1-800-PACKOUTS." As a result, the relevant public has come to associate PACKOUTS with Opposer, exclusively. See Exhibit B, declarations from members of the relevant public. Such exclusive association of PACKOUTS as source identifier of Opposer has continued to the present day.

ANSWER: Belfor lacks knowledge or information sufficient to form a belief about the truth of the allegations of the first sentence of this paragraph. The remaining allegations of this paragraph are denied as untrue.

8. The PACKOUTS mark and name are inherently distinctive as applied to Opposer's services. PACKOUTS, as applied to Opposer's services, is, at most, suggestive of "packing and moving things out."

ANSWER: Denied as untrue.

9. As a result of use in commerce of PACKOUTS for over eight years, and the quality of the services provided thereunder, such mark has come to be known among the relevant public as an indicator of services originating with, sponsored by or otherwise associated with Opposer, exclusively. Opposer enjoys substantial goodwill in the PACKOUTS mark.

ANSWER: Denied as untrue.

10. Opposer owns published U.S. Application Serial No. 88/424,896 for the mark PACKOUTS on the Principal Register in the U.S. Patent and Trademark Office for "removal and storage of residential, commercial and industrial contents, namely, junk, trash and debris removal, moving and storage of furniture and personal property, pick-up and delivery of furniture and personal property, and providing storage facilities for others."

ANSWER: Admitted that opposer owns the referenced application, but denied as untrue that the mark in the application is registrable.

11. On information and belief, applicant, Belfor Finance Group LLC ("Applicant") operates Belfor Property Restoration, a property restoration company that competes directly with Opposer. See Exhibit C, the website at www.belfor.com, accessed 12/12/2021. On information and belief, approximately two years ago, Belfor was actively seeking to acquire its own restoration business that would make subcontracting with various vendors for such work unnecessary.

ANSWER: Belfor lacks knowledge or information sufficient to form a belief about the truth of the allegations of this paragraph.

12. With full knowledge of Opposer and Opposer's PACKOUTS mark and its rights therein, Applicant applied to register a composite mark comprising a spelling variation of PACKOUTS with the addition of a house mark, i.e. BLUE KANGAROO PACKOUTZ, for "restoration services in the field of water, smoke, fire, explosion, wind, roof collapse damage; Air duct cleaning services; Restoration services, namely, restorative drying services in the field of water damage remediation and fire remediation services in commercial, industrial and residential buildings; Cleaning of commercial, industrial and residential buildings; Cleaning and restoration of books, documents, electronics, fine artworks, furniture, furnishings, inventories consisting of paper, plastic, metal, and organic materials, machinery, office equipment, raw materials consisting of paper, wood and metal, and vital records consisting of paper and plastic microfilm; Packing, crating, and warehousing services in the nature of packing and storage of goods; Delivery, transport, and storage of goods; Packout services in the nature of packing and storage of goods ("PACKOUTZ Mark").

ANSWER: Admitted that Belfor filed U.S. Application Serial No. 90,307,108 for a composite BLUE KANGAROO PACKOUTZ mark, as depicted in the Application, for use with "Restoration services in the field of water, smoke, fire, explosion, wind, roof collapse damage; Air duct cleaning services; Restoration services, namely, restorative drying services in the field of water damage remediation and fire remediation services in commercial, industrial and residential buildings; Cleaning of commercial, industrial and residential

buildings; Cleaning and restoration of books, documents, electronics, fine artworks, furniture, furnishings, inventories consisting of paper, plastic, metal, and organic materials, machinery, office equipment, raw materials consisting of paper, wood and metal, and vital records consisting of paper and plastic microfilm." The remaining allegations of this paragraph are denied as untrue.

13. Opposer's use and registration of the 1-800-PACKOUTS mark long predates the filing date of the application opposed herein. Priority is not in issue.

ANSWER: The allegations of the first sentence of this paragraph are admitted. Belfor lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations of this paragraph.

14. The filing date of the application opposed herein long postdates the relevant public's association of the PACKOUTS mark as an exclusive indicator of source in Opposer.

ANSWER: Denied as untrue.

15. Applicant's PACKOUTZ Mark as applied to its services so resembles Opposer's PACKOUTS mark as applied to its services that Applicant's mark is likely to cause confusion, mistake, or deception among the relevant public, resulting in damage and injury to Opposer.

ANSWER: Denied as untrue.

16. Applicant's PACKOUTZ Mark as applied to its services so resembles Opposer's 1-800-PACKOUTS mark and name as applied to its services that Applicant's mark is likely to cause confusion, mistake, or deception among the relevant public, resulting in damage and injury to Opposer.

ANSWER: Denied as untrue.

17. The PACKOUTZ Mark is confusingly similar to Opposer's PACKOUTS mark. Applicant has incorporated in its entirety in its mark a legal equivalent of Opposer's PACKOUTS mark. The addition of a house mark, BLUE KANGAROO, is insufficient to distinguish the mark. At a minimum, the relevant public is likely to conclude, in error, that the Applicant and Opposer

are affiliated, or that Applicant is operating an extension of Opposer's franchise under the PACKOUTS and 1-800-PACKOUTS marks.

ANSWER: Denied as untrue.

18. The services under the parties' respective marks are the same - both parties provide the same or related property restoration services under the marks at issue.

ANSWER: Belfor lacks knowledge or information sufficient to form a belief as to the truth of the allegations of this paragraph.

19. On information and belief, the parties market and sell their respective services under their respective marks to the same classes of purchasers and end users through the same channels of trade. The same classes of persons, i.e. insurance adjusters, agents and contractors, will encounter the parties' marks in the ordinary course of business.

ANSWER: Belfor lacks knowledge or information sufficient to form a belief as to the truth of the allegations of this paragraph.

20. On information and belief, Applicant adopted the mark opposed herein with the intent to cause confusion among Opposer's customers and potential customers and other members of the relevant public for the purpose of diverting business from Opposer to Applicant's nascent in-house property restoration unit.

ANSWER: Denied as untrue.

21. Therefore, if Applicant is permitted to register its PACKOUTZ Mark for the services set forth in the application, confusion of the relevant public is likely to result, such confusion resulting in damage and injury to Opposer.

ANSWER: Denied as untrue.

22. Furthermore, any defect, objection to, or fault found with Applicant's services provided under the PACKOUTZ Mark would necessarily reflect on and seriously injure the reputation that Opposer has established and fostered under its PACKOUTZ mark and 1-800-PACKOUTS mark and name since 2013.

ANSWER: Denied as untrue.

23. If Applicant were granted a registration for the mark herein opposed, it would obtain thereby at least a *prima facie* exclusive right to use the mark. Such registration would be a source of damage and injury to Opposer, its reputation and goodwill.

ANSWER: Belfor admits the allegations of the first sentence of this paragraph and denies the remainder.

AFFIRMATIVE DEFENSES

1. Opposer has failed to state a claim on which relief can be granted.

2. Opposer has no protectable or enforceable rights or interests in the term PACKOUTS because it is generic with respect to the subject goods or services.

3. Opposer has no protectable or enforceable rights or interests in the term PACKOUTS because it is descriptive with respect to the subject goods or services.

4. Opposer has no protectable or enforceable rights or interests in the term PACKOUTS with respect to the subject goods or services because its lacks acquired distinctiveness.

5. Opposer has no protectable or enforceable rights or interests in the term PACKOUTS because it has not used the term as a trademark or service mark.

6. Use of PACKOUTZ within the applied-for composite mark, when viewed as a whole, is not likely to cause consumer confusion.

7. Opposer's claim is barred, in whole or in part, under the doctrines of latches or acquiescence.

8. Opposer's claim is barred, in whole or in part, under the doctrine of unclean hands.

9. Belfor hereby reserves the right to assert additional defenses that may appear or become known during the course of these proceedings.

JAFFE, RAITT, HEUER, & WEISS, P.C.

/s/ David McDaniel

Dated: January 21, 2022

David S. McDaniel (MI Bar No. P56994)
Counsel for Applicant
27777 Franklin Road, Suite 2500
Southfield, MI 48034
(248) 351- 3000
dmcdaniel@jaffelaw.com

CERTIFICATE OF SERVICE

On January 21, 2022, the undersigned served Belfor's *Answer and Affirmative Defenses to Notice of Opposition* on opposing counsel via email to the following addresses of record: kkepchar@akingump.com, dc_ipdocketing@akingump.com, and dlee@akingump.com

JAFFE, RAITT, HEUER, & WEISS, P.C.

/s/ David McDaniel

Dated: January 21, 2022

David S. McDaniel (MI Bar No. P56994)
Counsel for Applicant
27777 Franklin Road, Suite 2500
Southfield, MI 48034
(248) 351- 3000
dmcdaniel@jaffelaw.com