

ESTTA Tracking number: **ESTTA1231797**

Filing date: **08/26/2022**

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

Proceeding no.	91274819
Party	Defendant Darker Still Spirits Company Limited
Correspondence address	MICHAEL L. LEETZOW MICHAEL L. LEETZOW, P.A. 170 BELLA VISTA TER UNIT D NOKOMIS, FL 34275 UNITED STATES Primary email: michael@leetzow.com Secondary email(s): kiran@iusjuris.com, renns@ennsandarcher.com 407-302-9970
Submission	Answer
Filer's name	Rodrick J. Enns
Filer's email	renns@ennsandarcher.com
Signature	/Rodrick J. Enns/
Date	08/26/2022
Attachments	Answer of Darker Still Spirits Company Ltd.pdf(27234 bytes)

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

Lotion, LLC,)	
)	Opposition No. 91274819
)	
Opposer,)	Serial No. 90/078,428
)	Mark: DARK IRISH
v.)	
)	
DARKER STILL SPIRITS COMPANY)	
LIMITED)	
)	Filing Date: July 28, 2020
Applicant.)	Publication Date: November 2, 2021

ANSWER OF APPLICANT DARKER STILL SPIRITS COMPANY LIMITED

Applicant Darker Still Spirits Company Limited, by its undersigned counsel, for its Answer to the Notice of Opposition filed by Opposer Lotion, LLC on March 2, 2022 (“the Opposition”), and the time in which to respond having been extended until August 29, 2022, admits, denies, and alleges as follows, with the paragraph numbers below corresponding to the paragraph numbers of the Notice of Opposition:

1. With respect to the allegations of Paragraph 1 of the Opposition, Applicant is without information sufficient to form a belief as to the truth of the allegations and on that basis all such allegations are denied.
2. With respect to the allegations of Paragraph 2 of the Opposition, Applicant is without information sufficient to form a belief as to the truth of the allegations and on that basis all such allegations are denied.
3. With respect to the allegations of Paragraph 3 of the Opposition, Applicant is without information sufficient to form a belief as to the truth of the allegations and on that basis all such allegations are denied.
4. With respect to the allegations of Paragraph 4 of the Opposition, Applicant admits that a trademark application for BLACK IRISH was filed on July 30, 2019 by Lotion, LLC.
With respect to the list of goods, Applicant submits that the application presents the best

evidence of the enumerated goods. To the extent that there are other allegations in the paragraph, Applicant denies the same.

5. The allegations of Paragraph 5 are admitted.
6. The allegations of Paragraph 6 are admitted.
7. The allegations of Paragraph 7 are admitted.
8. The allegations of Paragraph 8 are admitted.
9. With respect to the allegations of Paragraph 9 of the Opposition, Applicant is without information sufficient to form a belief as to the truth of the allegations and on that basis all such allegations are denied.
10. With respect to the allegations of Paragraph 10 of the Opposition, Applicant is without information sufficient to form a belief as to the truth of the allegations and on that basis all such allegations are denied.
11. The allegations of Paragraph 11 are admitted.
12. The allegations of Paragraph 12 are admitted.
13. With respect to the allegations of Paragraph 13 of the Opposition, Applicant admits that at the time the BLACK IRISH registration in the EU was assigned to DesignAR, DesignAR was aware of Lotion LLC's trademark application for BLACK IRISH in the United States. It is also admitted that DesignAR sought to exploit the EU trademark for BLACK IRISH and had then been engaged in product and brand development efforts in good faith for some time. Except as so admitted, the remaining allegations of Paragraph 13 are denied.
14. With respect to the allegations in Paragraph 14, Applicant admits a cancellation proceeding was filed by an entity called Splashes Beverages LLC in the EU against the BLACK IRISH registration alleging as grounds lack of use. Except as so admitted, Applicant is without information sufficient to form a belief as to the truth of the remaining allegations in Paragraph 14, and on that basis all such allegations are denied.
15. The allegations of Paragraph 15 are admitted.
16. The allegations of Paragraph 16 are admitted.
17. With respect to the allegations of Paragraph 17, it is admitted that Applicant and DesignAR have a common director, namely David Phelan. Except as so admitted, the allegations of Paragraph 17 are denied.

18. The allegations of Paragraph 18 are admitted.
19. The allegations of Paragraph 19 are admitted.
20. Applicant admits that the USPTO issued the first of three suspension letters with respect to the DesignAR Application on February 10, 2020, saying that Opposer's Application "has an earlier filing date or effective filing date than applicant's application," and if the mark in Opposer's Application registers, "the USPTO may refuse registration of applicant's mark." Except as so admitted, the allegations of Paragraph 20 are denied.
21. With respect to the allegations in Paragraph 21, Applicant admits that on March 24, 2021, the USPTO issued a Non-Final Office Action with respect to the DesignAR Application which, among other things, continued and maintained the suspension previously entered based on Opposer's earlier-filed application. Except as so admitted, the allegations of Paragraph 21 are denied.
22. The allegations of Paragraph 22 are admitted.
23. The allegations of Paragraph 23 are admitted.
24. The allegations of Paragraph 24 are admitted.
25. The allegations of Paragraph 25 are admitted.
26. The allegations of Paragraph 26 are admitted.
27. The allegations of Paragraph 27 are admitted.
28. Applicant admits it was aware of Opposer's Application to register the BLACK IRISH mark at the time Applicant filed the pending application to register the DARK IRISH mark. Except as so admitted, the allegations of Paragraph 28 are denied.
29. Paragraph 29 makes no allegations of fact and therefore requires no response by Applicant. To the extent Paragraph 29 of the Opposition may be deemed to make any allegation of fact, such allegation is denied.
30. With respect to the allegations of Paragraph 30, Applicant is without knowledge sufficient to form a belief as to whether Opposer will ever file a Statement of Use with respect to Opposer's Application, or as to the validity or effect of any such hypothetical filing, and on that basis the allegations of Paragraph 30 are denied.
31. The allegations of Paragraph 31 are denied.
32. The allegations of Paragraph 32 are denied.
33. The allegations of Paragraph 33 are denied.

34. Applicant admits that it selected the DARK IRISH mark in an attempt to avoid conflict after it became apparent that Opposer was committed to opposing Applicant's registration and use of the BLACK IRISH mark in multiple jurisdictions, including in the EU and the UK where Applicant has clear priority. It is also admitted that Applicant released, to the Irish, British, and European media but not the US media, a photograph of its director with a bottle of its BLACK IRISH product in the same pose as a photo posted the week before by Ms. Carey to her Instagram account. This was a tongue-in-cheek means of attempting to respond in the Irish, British, and European media to the significant confusion created by Ms. Carey's posting about her new BLACK IRISH product, which was made despite the fact that Applicant's BLACK IRISH product had already launched in Ireland the previous year. Except as so admitted, the remaining allegations of Paragraph 34 are denied.
35. Paragraph 35 makes no allegations of fact, but consists only of two images, and therefore requires no response by Applicant. To the extent Paragraph 35 is deemed to require any response, Applicant incorporates by reference its response to Paragraph 34, above.
36. With respect to the allegations of Paragraph 36, Applicant admits that it does not have, nor does it need, the consent or permission of Opposer. Except as so admitted, the remaining allegations of Paragraph 36 are denied.
37. The allegations of Paragraph 37 are denied.
38. The allegations of Paragraph 38 are denied.
39. With respect to the allegations of Paragraph 39, Applicant lacks information as to what Opposer may or may not believe, and on that basis the allegations of Paragraph 39 are denied.
40. With respect to the allegations of Paragraph 40, Applicant denies that the filing basis of the pending application was under Section 2(d) or Section 44(e) of the Lanham Act, the truth of the matter being that the application was filed under Section 1(b) and Section 44(d) of the Lanham Act. The remaining allegations of Paragraph 40 are admitted.
41. The allegations of Paragraph 41 are admitted.
42. The allegations of Paragraph 42 are admitted.
43. The allegations of Paragraph 43 are denied.
44. The allegations of Paragraph 44 are denied.

- 45. The allegations of Paragraph 45 are admitted.
- 46. The allegations of Paragraph 46 are admitted.
- 47. The allegations of Paragraph 47 are admitted.
- 48. The allegations of Paragraph 48 are denied.
- 49. The allegations of Paragraph 49 are denied.
- 50. The allegations of Paragraph 50 are denied.
- 51. The allegations of Paragraph 51 are denied.
- 52. The allegations of Paragraph 52 are denied.
- 53. The allegations of Paragraph 53 are denied.
- 54. The allegations of Paragraph 54 are denied.
- 55. The allegations of Paragraph 55 are denied.

Wherefore, Applicant respectfully requests that this Opposition be dismissed with prejudice and that Application Serial No. 90078428 be allowed to proceed to registration.

Dated: August 26, 2022

By: /Michael L. Leetzow/
Michael L. Leetzow, Esq.

Michael L. Leetzow, P.A.
170 Bella Vista Terr Unit D
Nokomis, FL 34275
Telephone: 407/302-9970
michael@leetzow.com

/Rodrick J. Enns/
Rodrick J. Enns
Enns & Archer LLP
939 Burke Street
Winston-Salem, NC 27101
Telephone: 336-723-5180
renns@ennsandarcher.com

Attorneys for Applicant Darker Still Spirits
Company Ltd.

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing document has been served on counsel of record for Opposer by email transmission to:

Thomas A. Telesca
ttelesca@rmfpc.com

This the 26th day of August, 2022.

/Rodrick J. Enns/

Rodrick J. Enns

ENNS & ARCHER LLP
939 Burke Street
Winston-Salem, NC 27101
336-723-5180
renns@ennsandarcher.com