

ESTTA Tracking number: **ESTTA1275758**

Filing date: **04/01/2023**

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

Proceeding no.	91281645
Party	Defendant Pray Not Prey Apparel, LLC
Correspondence address	MORRIS E. TUREK YOURTRADEMARKATTORNEY.COM 167 LAMP AND LANTERN VILLAGE, #220 CHESTERFIELD, MO 63017-8208 UNITED STATES Primary email: morris@yourtrademarkattorney.com 314-749-4059
Submission	Answer and Counterclaim
Filer's name	Morris E. Turek
Filer's email	morris@yourtrademarkattorney.com
Signature	/met20/
Date	04/01/2023
Attachments	Pray Not Prey Answer and Counterclaim FINAL with Exhibits.pdf(1575766 bytes)

Registration subject to the submission

Registration no.	5886020	Registration date	10/15/2019
Register	Principal		
Registrant	Lee Dickinson 2388 KINGS POINT DRIVE DUNWOODY, GA 30338 UNITED STATES Email: iamanempress@hotmail.com		

Goods/services subject to the submission

Class 025. First Use: Jan 10, 2019 First Use In Commerce: Jan 10, 2019 All goods and services in the class are requested, namely: Hoodies; Baseball caps; Baseball caps and hats; Blouses; Boxer shorts; Fleece pullovers; Fleece tops; Graphic T-shirts; Halter tops; Headwear; Knitted caps; Ladies' underwear; Motorcycle jackets; Polo shirts; Scarves; Shirt fronts; Sleeping garments; Sleeveless jerseys; Stocking caps; Sweat shirts; Sweatshirts; T-shirts; Tank-tops; Undershirts; Women's athletic tops with built-in bras
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Grounds for cancellation

Mark never used in commerce	Trademark Act Section 14(6)
No use of mark in commerce before application, amendment to allege use, or statement of use was due	Trademark Act Sections 14(1) and 1(a), (c), and (d)
Failure to function as a mark	Trademark Act Sections 14(1) and 1,2 and 45

Registration subject to the submission

Registration no.	5886035	Registration date	10/15/2019
Register	Principal		
Registrant	Lee Dickinson 2388 KINGS POINT DR DUNWOODY, GA 30338 UNITED STATES Email: leesdickinson@gmail.com		

Goods/services subject to the submission

Class 025. First Use: Dec 30, 2017 First Use In Commerce: Dec 30, 2017 All goods and services in the class are requested, namely: Hats; Hoodies; T-shirts; Tank-tops; Tank tops; Graphic T-shirts; Short-sleeved or long-sleeved t-shirts; Small hats; Stocking hats

Grounds for cancellation

Mark never used in commerce	Trademark Act Section 14(6)
No use of mark in commerce before application, amendment to allege use, or statement of use was due	Trademark Act Sections 14(1) and 1(a), (c), and (d)
Failure to function as a mark	Trademark Act Sections 14(1) and 1,2 and 45

Registration subject to the submission

Registration no.	6069563	Registration date	06/02/2020
Register	Principal		
Registrant	Lee Smith Dickinson 2388 KINGS POINT DR DUNWOODY, GA 30338 UNITED STATES Email: leesdickinson@gmail.com		

Goods/services subject to the submission

Class 025. First Use: Dec 26, 2019 First Use In Commerce: Dec 26, 2019 All goods and services in the class are requested, namely: Tank-tops; Tank tops; Dresses for women and children; Hoodies; Jackets; Mantles; Pajamas for men, women, and children; Shirts for men, women, and children; Shoes for men, women, and children; Shorts for men, women, and children; Sweatshirts for men, women, and children; T-shirts for men, women, and children; Trousers for men, women, and children
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Grounds for cancellation

No use of mark in commerce before application, amendment to allege use, or statement of use was due	Trademark Act Sections 14(1) and 1(a), (c), and (d)
Failure to function as a mark	Trademark Act Sections 14(1) and 1,2 and 45

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

Lee S. Dickinson)
Opposer,)
v.) Opposition No. 91281645
Pray Not Prey Apparel, LLC)
Applicant.)
_____)

**APPLICANT’S ANSWER TO OPPOSER’S AMENDED NOTICE OF OPPOSITION
AND COUNTERCLAIM PETITION FOR CANCELLATION**

In answer to the Amended Notice of Opposition filed by Lee S. Dickinson, Applicant Pray Not Prey Apparel, LLC states the following:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 1 of the Notice of Opposition and, accordingly, denies each and every allegation set forth therein.
2. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 2 of the Notice of Opposition and, accordingly, denies each and every allegation set forth therein.
3. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 3 of the Notice of Opposition and, accordingly, denies each and every allegation set forth therein.
4. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 4 of the Notice of Opposition and, accordingly, denies each and every allegation set forth therein.

5. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 5 of the Notice of Opposition and, accordingly, denies each and every allegation set forth therein.

6. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 6 of the Notice of Opposition and, accordingly, denies each and every allegation set forth therein.

7. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 7 of the Notice of Opposition and, accordingly, denies each and every allegation set forth therein.

8. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 8 of the Notice of Opposition and, accordingly, denies each and every allegation set forth therein.

9. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 9 of the Notice of Opposition and, accordingly, denies each and every allegation set forth therein.

10. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 10 of the Notice of Opposition and, accordingly, denies each and every allegation set forth therein.

11. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 11 of the Notice of Opposition and, accordingly, denies each and every allegation set forth therein.

12. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 12 of the Notice of Opposition and, accordingly, denies each and every allegation set forth therein.

13. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 13 of the Notice of Opposition and, accordingly, denies each and every allegation set forth therein.

14. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 14 of the Notice of Opposition and, accordingly, denies each and every allegation set forth therein.

15. Applicant admits only that it filed an application for registration of the mark PRAY NOT PREY for “clothing, namely, shirts, tops, pants, bottoms, and socks; headwear; footwear.” Applicant denies each and every remaining allegation set forth in Paragraph 15 of the Notice of Opposition.

16. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 16 of the Notice of Opposition and, accordingly, denies each and every allegation set forth therein.

17. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 17 of the Notice of Opposition and, accordingly, denies each and every allegation set forth therein.

18. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 18 of the Notice of Opposition and, accordingly, denies each and every allegation set forth therein.

19. Applicant admits only that its application was filed on an intent to use basis under §1(b). Applicant denies each and every remaining allegation in Paragraph 19 of the Notice of Opposition.

20. Applicant admits the allegations set forth in Paragraph 20 of the Notice of Opposition.

21. Applicant denies each and every allegation set forth in Paragraph 21 of the Notice of Opposition.

22. Applicant denies each and every allegation set forth in Paragraph 22 of the Notice of Opposition.

23. Applicant admits the allegations set forth in Paragraph 23 of the Notice of Opposition.

24. Applicant admits the allegations set forth in Paragraph 24 of the Notice of Opposition.

25. Applicant admits the allegations set forth in Paragraph 25 of the Notice of Opposition.

26. Applicant admits the allegations set forth in Paragraph 26 of the Notice of Opposition.

27. Applicant admits the allegations set forth in Paragraph 27 of the Notice of Opposition.

28. Applicant denies each and every allegation set forth in Paragraph 28 of the Notice of Opposition.

29. Applicant admits the allegations set forth in Paragraph 29 of the Notice of Opposition.

30. Applicant admits the allegations set forth in Paragraph 30 of the Notice of Opposition.

31. Applicant denies each and every allegation set forth in Paragraph 31 of the Notice of Opposition.

32. Applicant denies each and every allegation set forth in Paragraph 32 of the Notice of Opposition.

DENIAL OF PRAYER FOR RELIEF

Applicant denies that Opposer is entitled to any of the relief sought in her prayer for relief against Applicant.

COUNTERCLAIM PETITION FOR CANCELLATION

1. Pray Not Prey Apparel, LLC (“Counterclaim Petitioner”) is a Maryland limited liability company with a mailing address of 10731 Wickwood Ct., Ellicott City, Maryland 21042.

2. Upon information and belief, the name and address of the current owner of U.S. Registration Nos. 5,886,020, 5,886,035, and 6,069,563 is Lee S. Dickinson, 2388 Kings Point Drive, Dunwoody, Georgia 30338 (“Counterclaim Registrant”).

3. Pursuant to 15 U.S.C. §1064, Counterclaim Petitioner believes it is damaged by Registration Nos. 5,886,020, 5,886,035, and 6,069,563 and hereby petitions to cancel the same.

COUNT I – NON-USE OF TRADEMARK

4. Counterclaim Petitioner realleges and incorporates by reference the allegations set forth in the preceding paragraphs as if fully set forth herein.

5. Counterclaim Registrant is the owner of U.S. Registration No. 5,886,020 for the trademark NOT PREY for “hoodies; baseball caps; baseball caps and hats; blouses; boxer shorts;

fleece pullovers; fleece tops; graphic t-shirts; halter tops; headwear; knitted caps; ladies' underwear; motorcycle jackets; polo shirts; scarves; shirt fronts; sleeping garments; sleeveless jerseys; stocking caps; sweat shirts; sweatshirts; t-shirts; tank-tops; undershirts; women's athletic tops with built-in bras,” in International Class 25.

6. On January 8, 2019, the USPTO issued the Notice of Allowance for the underlying application of Registration No. 5,886,020. On July 3, 2019, Counterclaim Registrant filed a request for an extension of time to file a statement of use. Therefore, the deadline for filing the Statement of Use was January 8, 2020.

7. On August 10, 2019, Counterclaim Registrant filed the Statement of Use for the underlying application of Registration No. 5,886,020. Counterclaim Petitioner has attached a copy of the specimen submitted with the Statement of Use as **Exhibit A**.

8. Upon information and belief, Counterclaim Registrant was not using the NOT PREY mark in commerce in connection with some or all of the products listed in Registration No. 5,886,020 on or before January 8, 2020, which was the expiration of the time period in which to file the Statement of Use.

9. Upon information and belief, Counterclaim Registrant has never used the NOT PREY mark in commerce in connection with some or all of the products listed in Registration No. 5,886,020.

10. Counterclaim Registrant is the owner of U.S. Registration No. 5,886,035 for the trademark #NOTPREY for “hats; hoodies; t-shirts; tank-tops; tank tops; graphic t-shirts; short-sleeved or long-sleeved t-shirts; small hats; stocking hats,” in International Class 25.

11. On January 8, 2019, the USPTO issued the Notice of Allowance for the underlying application of Registration No. 5,886,035. On July 3, 2019, Counterclaim Registrant

filed a request for an extension of time to file a statement of use. Therefore, the deadline for filing the Statement of Use was January 8, 2020.

12. On August 10, 2019, Applicant filed the Statement of Use for the underlying application of Registration No. 5,886,035. Counterclaim Petitioner has attached a copy of the specimen submitted with the Statement of Use as **Exhibit B**.

13. Upon information and belief, Counterclaim Registrant was not using the #NOTPREY mark in commerce in connection with some or all of the products listed in Registration No. 5,886,020 on or before January 8, 2020, which was the expiration of the time period in which to file the Statement of Use.

14. Upon information and belief, Counterclaim Registrant has never used the #NOTPREY mark in commerce in connection with some or all of the products listed in Registration No. 5,886,035.

15. Counterclaim Registrant is the owner of U.S. Registration No. 6,069,563 for the trademark WOMEN ARE NOT PREY for “tank-tops; tank tops; dresses for women and children; hoodies; jackets; mantles; pajamas for men, women, and children; shirts for men, women, and children; shoes for men, women, and children; shorts for men, women, and children; sweatshirts for men, women, and children; t-shirts for men, women, and children; trousers for men, women, and children,” in International Class 25.

16. The underlying application of Registration No. 6,069,563 was filed on January 2, 2020 under §1(a) of the Trademark Act. Counterclaim Petitioner has attached a copy of the specimen filed with the underlying application as **Exhibit C**.

17. Upon information and belief, Counterclaim Registrant was not using the WOMEN ARE NOT PREY mark in commerce in connection with some or all of the products listed in Registration No. 6,069,563 on or before January 2, 2020.

18. Upon information and belief, Counterclaim Registrant has never used the WOMEN ARE NOT PREY mark in commerce in connection with some or all of the products listed in Registration No. 6,069,563.

19. On November 2, 2021, Counterclaim Petitioner filed an application with the USPTO under §1(b) seeking to register the trademark PRAY NOT PREY for “clothing, namely, shirts, tops, pants, bottoms, and socks; headwear; footwear” in International Class 25. Counterclaim Petitioner’s application was assigned Serial No. 97105218 by the USPTO.

20. On November 8, 2022, Counterclaim Registrant filed a Notice of Opposition against Application Serial No. 97105218 on the basis of priority and likelihood of confusion. On January 10, 2023, Counterclaim Registrant filed an Amended Notice of Opposition against Application Serial No. 97105218 on the basis of priority and likelihood of confusion.

21. Counterclaim Petitioner is harmed and damaged by Registration Nos. 5,886,020, 5,886,035, and 6,069,563 because Counterclaim Registrant is using the registrations as a basis for opposing Counterclaim Petitioner’s application to register its PRAY NOT PREY mark.

22. Counterclaim Petitioner is harmed and damaged by the registration of the marks in Registration Nos. 5,886,020, 5,886,035, and 6,069,563 because such registration gives color of exclusive statutory rights to Counterclaim Registrant in violation of the Lanham Act.

COUNT II – FAILURE TO FUNCTION AS A TRADEMARK

23. Petitioner realleges and incorporates by reference the allegations set forth in the preceding paragraphs as if fully set forth herein.

24. The specimen for Registration No. 5,886,020 (**Exhibit A**) shows “Not Prey” used either ornamentally or in a way that merely informs consumers that Counterclaim Registrant’s clothing products feature the ornamental phrase “Not Prey.” None of the uses of “Not Prey” on the specimen demonstrate NOT PREY used as a trademark for clothing.

25. Counterclaim Registrant’s use of “Not Prey” on or in connection with her clothing does not function as a trademark to indicate the source of Counterclaim Registrant’s clothing.

26. Counterclaim Registrant’s use of “Not Prey” on or in connection with her clothing does not function as a trademark to identify and distinguish Registrant’s clothing from the clothing advertised and sold by others.

27. The relevant segment of the purchasing public would not perceive Counterclaim Registrant’s use of “Not Prey” as functioning as a trademark for Counterclaim Registrant’s clothing.

28. The specimen for Registration No. 5,886,035 (**Exhibit B**) shows “#NotPrey” used either ornamentally or in a way that merely informs consumers that her clothing products feature the ornamental phrase “#NotPrey.” None of the uses of “#NotPrey” on the specimen demonstrate #NOTPREY used as a trademark for clothing.

29. Counterclaim Registrant’s use of “#NotPrey” on or in connection with her clothing does not function as a trademark to indicate the source of Counterclaim Registrant’s clothing.

30. Counterclaim Registrant’s use of “#NotPrey” on or in connection with her clothing does not function as a trademark to identify and distinguish Registrant’s clothing from the clothing advertised and sold by others.

31. The relevant segment of the purchasing public would not perceive Counterclaim Registrant's use of "#NotPrey" as functioning as a trademark for Counterclaim Registrant's clothing.

32. The specimen for Registration No. 6,069,563 (**Exhibit C**) shows "Women are Not Prey" used either ornamentally or in a way that merely informs consumers that her clothing products feature the ornamental phrase "Women are Not Prey." None of the uses of "Women are Not Prey" on the specimen demonstrate WOMEN ARE NOT PREY used as a trademark for clothing.

33. Counterclaim Registrant's use of "Women are Not Prey" on or in connection with her clothing does not function as a trademark to indicate the source of Counterclaim Registrant's clothing.

34. Counterclaim Registrant's use of "Women are Not Prey" on or in connection with her clothing does not function as a trademark to identify and distinguish Registrant's clothing from the clothing advertised and sold by others.

35. The relevant segment of the purchasing public would not perceive Counterclaim Registrant's use of "Women are Not Prey" as functioning as a trademark for Counterclaim Registrant's clothing.

36. Counterclaim Petitioner is harmed and damaged by Registration Nos. 5,886,020, 5,886,035, and 6,069,563 because Counterclaim Registrant is using the registrations as a basis for opposing Counterclaim Petitioner's application to register its PRAY NOT PREY mark.

37. Petitioner is harmed and damaged by the registration of U.S. Registration Nos. 5,886,020, 5,886,035, and 6,069,563 because such registration gives color of exclusive statutory rights to Registrant in violation of the Lanham Act.

WHEREFORE, Counterclaim Petitioner is damaged by U.S. Registration Nos. 5,886,020, 5,886,035, and 6,069,563 and prays that the same be canceled pursuant to 15 U.S.C. §1064.

Respectfully submitted,

PRAY NOT PREY APPAREL, LLC

By: _____ /met20/
Morris E. Turek
YourTrademarkAttorney.com
167 Lamp and Lantern Village, #220
Chesterfield, MO 63017-8208
Tel: (314) 749-4059
Fax: (800) 961-0363
morris@yourtrademarkattorney.com

Dated: _____ 4/1/2023 _____

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing has been served by emailing said copy on _____ 4/1/2023 _____ to:

Jace Williams
Attorney for Opposer
jace@gatehouse.law

_____/met20/_____
Morris E. Turek, Attorney for Applicant

EXHIBIT A

Not Prey SOU 87734165

Please see the screenshots for the use of Not Prey in commerce

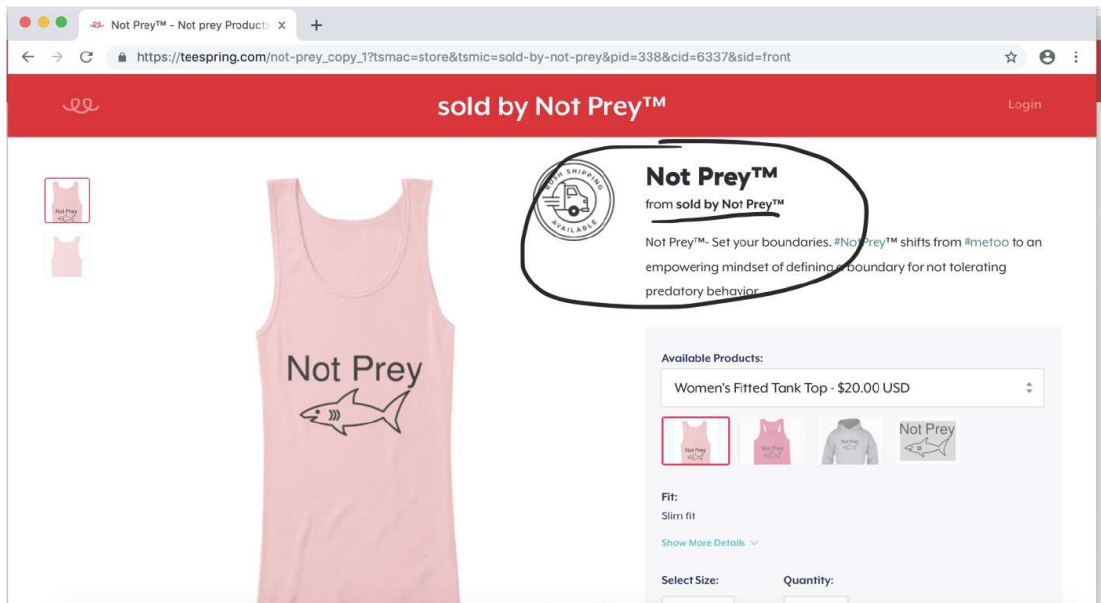
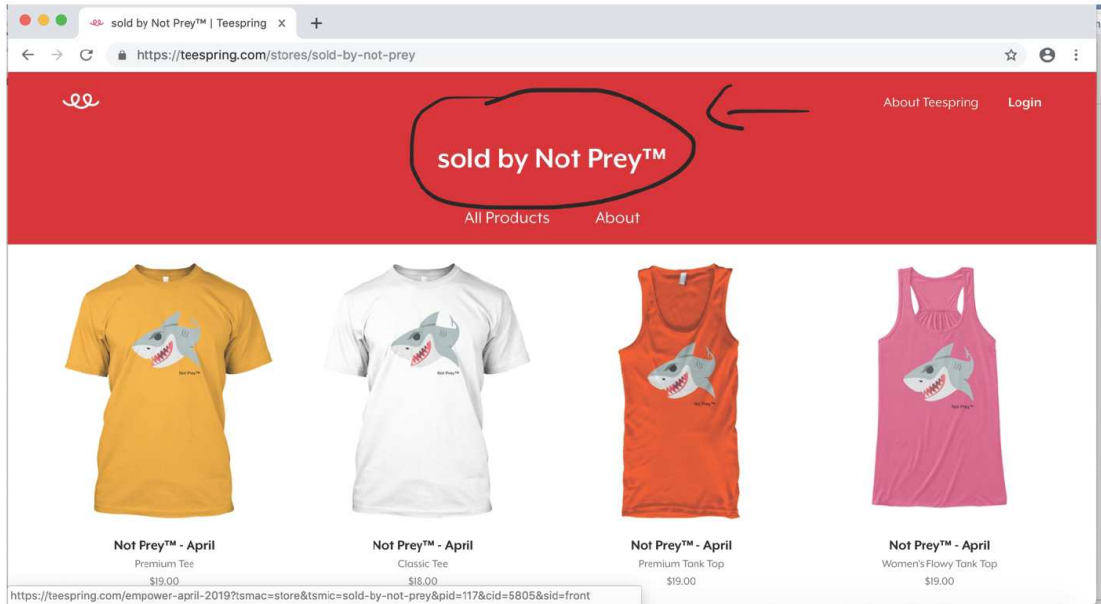


EXHIBIT B

#NotPrey SOU [87744662](https://www.teespring.com/stores/sold-by-notprey-2)

Please see the screenshots highlighting the use of #NotPrey

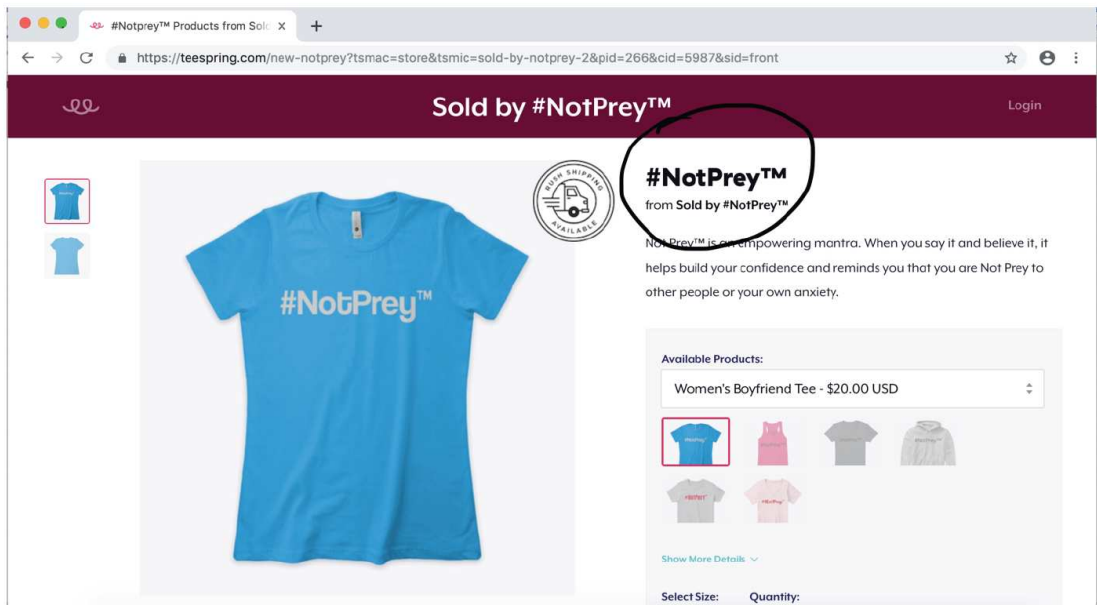
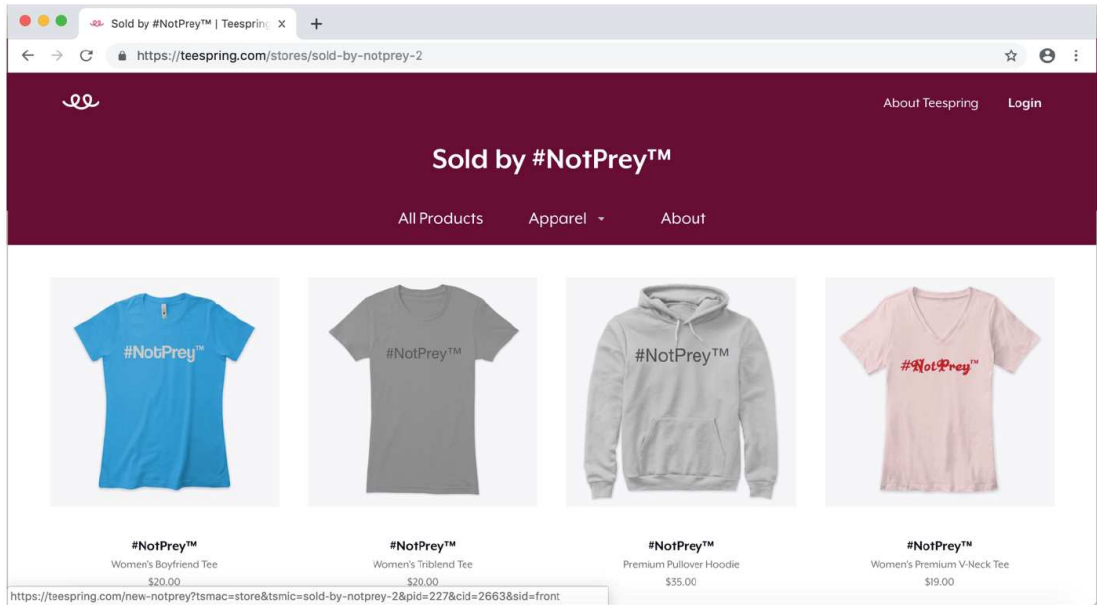


EXHIBIT C

Women are Not Prey- 1/2/2020

Current Link <https://teespring.com/stores/sold-by-women-are-not-prey>

Please note that I am the official owner of the Not Prey (87734165) trademark. This is to add a variation of the Not Prey trademark.

