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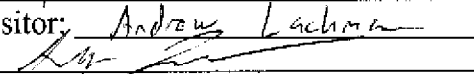
Filing date: **06/29/2004**

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

Proceeding	92041018
Party	Defendant REFAELY AND SONS INC. 7964 ARJONS SUITE F (IN THE REAR) SAN DIEGO, CA 92126
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Date	06/29/2004
Attachments	Andrew.tif (6 pages)

CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited electronically and with the United States Postal Service as First Class Express Mail in an envelope addressed to: Box NO FEE, Patent and Trademark Office Trademark Trial and Appeal Board, 2900 Crystal Drive, Arlington, VA 22202-3513, on:

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Signature of Depositor: 
Date of Signing: 6/28/04

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

In the matter of trademark registration Serial No. 2,352,015

For the mark BENEFEET

LANGER, INC.

Petitioner,

v.

Cancellation Proceeding No. 92041018

REFAELY AND SONS, INC.

Registrant.

Law Offices of Andrew Lachman
9952 Santa Monica Blvd. 1st Floor
Beverly Hills, CA 90212

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Trademark Trial and Appeals Board
2900 Crystal Drive
Arlington, VA 22202-3513

ANSWER TO PETITION FOR CANCELLATION

TO PLAINTIFF AND TO ITS ATTORNEYS OF RECORD:

The Registrant, Refaely & Sons, Inc., a California corporation, with its principal place of business to 4130 LA JOLLA VILLAGE DR PMB#10743 LA JOLLA, CA 92013 respond to this Cancellation Proceeding by denying that Plaintiff, Langer, Inc. would be damaged by the Defendant's mark, "Benefeet" for the following reasons:

1. Registrant does not have enough information to fully and specifically answer every allegation in the Petition of Cancellation. Registrant lacks sufficient information to contest allegations in paragraphs 1 and 2., but otherwise denies the allegations in paragraph 3, 4,5, 6, and 7 of the Petition of Cancellation.
2. Petitioner's mark has hardly become distinctive or famous. There are numerous marks in the health and apparel fields that use Benefit or some similar wording. Furthermore, Petitioner's mark did was not incontestable at the time of Registrant's Notice of Allowance, nor was there any likelihood of confusion by virtue of its use since the medical supply and apparel fields are also crowded with uses of similar words to both Petitioner and Registrant's marks and variations thereof, for example:
 - a. HIDDEN BENEFITS Reg. No. 2,489,317 for IC 025. US 022 039. G & S:
INTIMATE APPAREL AND FIGURE ENHANCING GARMENTS,
NAMELY, BRAS, PANTIES, UNDERWEAR, UNDERPANTS,
UNDERGARMENTS, UNDERCLOTHES, SLIPS, LINGERIE,
FOUNDATION GARMENTS, GIRDLES, BODY SLIPS AND BODY SUITS.
FIRST USE: 20000725. FIRST USE IN COMMERCE: 20000725

- b. FULL BENEFIT Reg. No. 2058204 for IC 025. US 022 039. G & S:
CAMOUFLAGE CLOTHING, NAMELY, PANTS, SHIRTS, JACKETS,
GLOVES, HATS AND VESTS. FIRST USE: 19960105. FIRST USE IN
COMMERCE: 19960105
 - c. BENEFIT – Serial No. 76137036 IC 025. G & S: HEADWEAR; CLOTHING,
NAMELY, T-SHIRTS, UNDERWEAR, HEADBANDS, PAJAMAS,
LINGERIE, TOPS, BOTTOMS, BELTS, SOCKS, HOSIERY, SWEATERS
AND SCARVES. (approved for publication).
 - d. BENEFITSELECT – Serial No. 2478898, IC 035, G&S: PROVIDING
REBATES AT PARTICIPATING ESTABLISHMENTS OF OTHERS
THROUGH THE USE OF A MEMBERSHIP CARD FOR DISCOUNTED
HEALTH CARE SERVICES, AND FOR DISCOUNTED NUTRITIONAL
AND MEDICAL SUPPLIES. FIRST USE: 19980720. FIRST USE IN
COMMERCE: 19980720
3. Petitioner did not own the BENEFOOT trademark at the time of Registrant’s filing date. At the time of registration of Registrant’s mark, Petitioner’s circumstances and combination of goods were, and still are, insufficiently related to Registrant’s mark to merit cancellation.
4. Petitioner’s sale of orthotics is irrelevant to any claim of a likelihood of confusion. Such goods are medical devices and not apparel. In addition, sales of Petitioner’s goods are made to, through or by medical professionals and other sophisticated consumers looking for medical-related supplies.

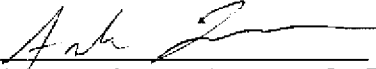
5. Petitioner's sale of custom-made footwear is made under the Birkenstock name, and is made through medical professional channels.
6. Plaintiff's alleged sale of support hose, cited by is also irrelevant. Support hose, or other cloth footwear designed to compliment orthotics/prosthetics are designed for medical benefit and are still a medical-related good subject to the same sophisticated consumer as orthotics.
7. Registrant has also invested a substantial amount of time and money to build goodwill in its mark, resulting in several million in sales through general retail and convenience stores throughout the United States and Mexico.
8. Registrant's channels of distribution are much different that of Petitioner's channels of distribution, which either sells directly to medical professionals or utilizes medical professionals to market its products and catalogs to a group of consumers that specifically seek medical relief for their maladies.
9. Registrant does not assert in its claim that its use of BENEFOOT constitutes a family of marks.

Affirmative Defenses

10. **Laches/Estoppel.** Petitioner did not object to Registrant's use of the mark in Petitioner's initial correspondence with Registrant and waited too long after discovery of the mark to demand cancellation.
11. **Unclean Hands.** Petitioner is engaging in the bullying of another company in an unrelated business and merely seeking to retaliate against Registrant for failing to respond its first letter even though Petitioner has received assurances that no health claims were made in association with Registrant's mark.

12. **Failure to oppose similar marks.** Petitioner failed to object to Registrant's prior application for the mark BENEFIT, Serial No. 76095323, for a "complete line of lingerie," filed July 24, 2000.

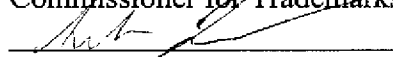
Respectfully submitted,

By 

Andrew Lachman, Attorney for Refaely & Sons, Inc..
9952 Santa Monica Blvd.
Beverly Hills, CA 90212
Phone: 310 282-0507

CERTIFICATE OF MAILING


I hereby certify that on June 28, 2004, this ANSWER TO PETITION FOR CANCELLATION is being filed electronically on the USPTO website and deposited in mail with the United States Postal Service, first class, postage pre-paid, addressed to Commissioner for Trademarks Crystal Drive, Arlington, VA 22202 Box TTAB by


Andrew Lachman, Esq.

CERTIFICATE OF SERVICE

On this 28th Day of June, 2004 a copy of the foregoing ANSWER TO PETITION FOR CANCELLATION via first class mail, postage prepaid on:

Harold James
Epstein Drangel Bazerman & James
60 E. 42nd Street, Suite 820
New York, NY 10165


Andrew Lachman, Esq.