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

Proceeding	92047998
Party	Defendant Cigar Oasis, Inc.
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Cancellation No. 92047998

Reg. No. 2639175

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

In the Matter of:

MARK: CIGAR OASIS Stylized
Reg. No.: 2639175

Lamsia Corporation, Petitioner)
) Cancellation No. 92047998
v.)
)
Cigar Oasis, Inc., Respondent.)

**ANSWER TO PETITION FOR CANCELLATION
AND AFFIRMATIVE DEFENSES**

Respondent, Executive Enterprise, Inc., a California corporation (formerly the California corporation known as Cigar Oasis, Inc.), having a business address of 4506 E. La Palma Avenue, Anaheim, CA 92807 (hereinafter "Respondent"), by its attorneys, answers the Petition of Cancellation of LAMSIA CORPORATION, a New York corporation, of 2586 Hempstead Turnpike, East Meadow, NY 11554 (hereinafter "Petitioner") as follows:

PFC 1 On information and belief, Respondent admits the status and location of the Petitioner.

PFC 2 Respondent denies the statements in Paragraph 2 and states that the Respondent is Executive Enterprise, Inc., having a mailing address of 4506 E. La Palma Avenue, Anaheim, CA 92807, and further states that pursuant to assignment recorded September 27, 2007, Respondent is the registrant of record for U.S. Trademark Registration 2,639,175 ("Respondent's Registration"), registered October 22,

2002 for the mark “CIGAR OASIS THE AFICONADO’S CHOICE” and design in connection with retail shops featuring tobacco products, claiming usage since July 18, 2001; and further states that Respondent purchased the business and all assets, including good will and trademarks, of the former California corporation known as Cigar Oasis, Inc., now dissolved, pursuant to a written purchase agreement dated February 13, 2006; and finally states that Respondent has acquired all rights of its predecessor-in-interest and has continued business operations using said Registration at the business locations in Rancho Santa Margarita and Aliso Viejo, California, and in website advertising.

PFC 3 Respondent lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 3, and therefore denies each and every allegation in paragraph 3.

PFC 4 Respondent lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 3, and therefore denies each and every allegation in paragraph 3.

PFC 5 Respondent admits that Petitioner has two pending trademark applications, one for the mark “CIGAR OASIS” and design in International Class 34 for humidifiers (Serial No. 77/018,802), and one for the mark “CIGAR OASIS” in International Class 35 for website sales of humidifiers (Serial No. 77/018,841).

PFC 6 Respondents admits that the U.S. Patent and Trademark Office has issued Section 2(d) non-final rejections of said pending trademark applications based on likelihood of confusion with Respondent’s Registration.

- PFC 7 Respondent denies all allegations in Paragraph 7.
- PFC 8 Respondent lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 8, and therefore denies each and every allegation in paragraph 8.
- PFC 9 Respondent denies all allegations in Paragraph 9.
- PFC 10 Respondent denies all allegations in Paragraph 10.
- PFC 11 Respondent admits that the corporation Cigar Oasis, Inc., has been dissolved, said dissolution occurring after the purchase of the business and all assets by the Respondent. Respondent denies the allegation related to non-use.
- PFC12 Respondent lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 12, and therefore denies each and every allegation in paragraph 12.
- PFC13 Respondent lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 12, and therefore denies each and every allegation in paragraph 13.
- PFC14 Respondent admits that is not a member of the voluntary association known as the Retail Tobacco Dealers of America.
- PFC15 Respondent admits that it maintains a website at the domain <www.cigaroasislounge.com> and that it operates retail tobacco outlets in Aliso Viejo and Rancho Santa Margarita, California. Respondent denies all other allegations in Paragraph 15.
- PFC16 Respondent denies all allegations in Paragraph 16.

PFC17 Respondent denies all allegations in Paragraph 16.

PFC18 Respondent admits that, at certain times, it may make application to secure the incontestable right to the use of its mark in commerce in connection with retail shops featuring tobacco products, but Respondent otherwise denies the allegations in Paragraph 18 that indicate Respondent's mark will be "deemed incontestable" merely when sufficient time has elapsed or that said incontestability will bar Petitioner from securing trademark rights.

FIRST AFFIRMATIVE DEFENSE

Respondent's Registration is for "CIGAR OASIS THE AFICONADO'S CHOICE" and design, and said mark is visually, aurally, and in commercial impression sufficiently distinctive from the mark that Petitioner is allegedly using. The dissimilarity of the marks dispels any likelihood of confusion. Moreover, the two marks at issue in this case have been in simultaneous use for more than six years, but Petitioner alleges no actual confusion in all this time. It is Respondent's assertion that the difference in the marks on their face obviates likelihood of confusion.

SECOND AFFIRMATIVE DEFENSE

Respondent's Registration is made in connection with services that are distinct from the goods of the Petitioner. Both of the Petitioner's pending trademarks are limited in their specifications to use in connection with humidors, and the Petitioner's allegations further state that its marks are used in connection with humidors only. In comparison, the Respondent

operates retail stores for tobacco products. As stated previously, the two marks at issue in this case have been in simultaneous use for more than six years, but Petitioner alleges no actual confusion in all this time. It is Respondent's assertion that the difference in the parties' goods and services obviates likelihood of confusion.

THIRD AFFIRMATIVE DEFENSE

AF1. Respondent further asserts that it secured its rights in its Registration without knowledge of Petitioner's alleged rights and that the Registration has been in force for more than six years, whereas Petitioner failed to seek timely the registration of its own claimed rights in its trademark. In such event, if likelihood of confusion remains an objection, Petitioner's remedy is to seek concurrent use rights.

AF2. Specifically, Respondent's Registration rights, and those of its predecessor-in-interest, were registered October 22, 2002, more than six years ago without objection by the Petitioner, who alleges use since 1999. Respondent innocently purchased its Registration as part of the assets of a company that was openly operating as Cigar Oasis, Inc., a California corporation registered with the California Secretary of State. This purchase was made on February 13, 2006, in good faith from the original owner of the corporation, business, and Registration pursuant to a written agreement and for good and valuable consideration. At that time, Respondent's due diligence search found no other companies or individuals using the same trademark for the same services, nor was any such usage disclosed to Respondent during the sale process. The Registration that Respondent purchased as part of the business had been filed

October 10, 2001, published for opposition July 30, 2002, and registered without opposition October 22, 2002.

AF3. Despite alleging use since 1999, Petitioner did not file any trademark registration for about 7 years, not until October 2006. Moreover, although Respondent and its predecessor-in-interest was openly operating retail outlets, had a registered trademark, and maintained a website, Petitioner did not contact Respondent prior to 2007. Petitioner's claims did not become known to Respondent until Respondent was notified that a Cancellation Petition had been filed in August 2007, which notice was received by Respondent despite Petitioner's claim of not being able to find the Respondent.

AF4. It is noted that, even if Respondent's right to use its mark were to become incontestable pursuant to 15 U.S.C. §1065, Respondent's rights can still be subject to a concurrent use registration. *See* *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630 (C.C.P.A. 1976); *Thrift mart, Inc. v. Scot Lad Foods, Inc.*, 207 USPQ 330 (TTAB 1980). Accordingly, the Petitioner's right to a concurrent use registration would not be barred by Respondent's right to secure incontestable status for its Registration.

AF5 Petitioner alleges use of its trademark since 1999, yet it did not object to the registration published and issued in 2002 for Respondent's predecessor-in-interest, nor did Petitioner object to the open use of said registered trademark by the California corporation Cigar Oasis, Inc., during the five years it was operated by Respondent's predecessor-in-interest. On September 25, 2008, Respondent's Section 8 (6-year) Affidavit was accepted, and the Respondent's Assignment of the Registration was recorded at about the same time (September 27, 2008).

FOURTH AFFIRMATIVE DEFENSE

Finally, it is noted that Respondent received confirmation on February 23, 2009, from counsel for Petitioner that the long-awaited consent agreement between the parties has been approved with minor alterations. It is anticipated that this agreement can be completed and signed within 30 days.

WHEREFORE, Applicant requests that the United States Patent and Trademark Office set aside the default for good cause shown, reset the relevant dates, and grant other relief as deemed appropriate in this matter.

February 24, 2009

Respectfully submitted,



Karla C. Shippey
Attorney for Applicant

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CERTIFICATE OF TRANSMISSION

I hereby certify that the foregoing ANSWER TO PETITION FOR CANCELLATION AND AFFIRMATIVE DEFENSES is being transmitted electronically by ESTTA to the Patent and Trademark Office on February 24, 2009.

Dated: February 24, 2009



Karla C. Shippey

Cancellation No. 92047998

Reg. No. 2639175

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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MARK: CIGAR OASIS Stylized
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Lamsia Corporation, Petitioner)	
)	Cancellation No. 92047998
v.)	
)	
Cigar Oasis, Inc., Respondent.)	

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing ANSWER TO PETITION FOR CANCELLATION AND AFFIRMATIVE DEFENSES has been served on LAMSIACORPORATION, Petitioner, by mailing said copy on February 24, 2009, via First Class Mail, postage prepaid, certified with return receipt to:

Schweitzer Comman Gross & Bondell LLP
292 Madison Avenue 19th Floor
New York, NY 10017
Attn: Meyer A. Gross

Dated: February 24, 2009



Karla C. Shippey