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Filing date: **04/12/2013**

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

Proceeding	92056876
Party	Defendant Bad Elf, LLC
Correspondence Address	BAD ELF LLC 150 BEACON HILL DR WEST HARTFORD, CT 06117 UNITED STATES
Submission	Answer and Counterclaim
Filer's Name	Marina F. Cunningham
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Date	04/12/2013
Attachments	783800101Answer.pdf ( 5 pages )(175728 bytes )

Registration Subject to the filing

Registration No	4058110	Registration date	11/22/2011
International Registration No.	NONE	International Registration Date	NONE
Registrant	DATALOGIC ADC S.R.L. Via San Vitalino, 13 - Frazione Lippol-40012 CALDERARA DI RENO (BO)  ITALY		

Goods/Services Subject to the filing

<p>Class 009. All goods and services in the class are requested, namely: Microprocessor controlled portable hand-held data terminals with voice communication functions and capable of transmitting and receiving data by radio; radio frequency and scanning and imaging devices for the capture, collection, and management of data, comprised of optical code readers, bar code scanners, electronic tags readers and writers, portable data terminals, and accessories therefor, namely, docking stations, handles, stands, holders, holsters, battery chargers, batteries, screen protectors, stylus, power suppliers, cables, adapters, headsets, modules for expanding communication options, and covers sold as components of data reader devices, and replacement parts therefor; computer software for use in decoding the collected data; computer software for use in decoding readers and processors of data from optical codes and electronic tags; computer software for use in training users of data capture systems, namely, optical code readers, bar code scanners, electronic tags readers and writers and portable data terminals; computer software for providing feedback on and analyzing operation and efficiency of data capture systems, namely, optical code readers, bar code scanners, electronic tags readers and writers and portable data terminals; downloadable user manuals for data capture systems, namely, optical code readers, bar code scanners, electronic tags readers and writers and portable data terminals; all the aforementioned goods not for development, dimensioning and arrangement of the facilities of railways</p>
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
TRADEMARK TRIAL AND APPEAL BOARD**

Datalogic ADC S.r.l.,	)	Opposition No.: 91209626
	)	Mark: BAD ELF and Design
Opposer	)	Serial No. 85/488,305
	)	Filed: December 6, 2011
	)	Published: September 25, 2012
v.	)	
	)	Registration No.: 3,973,625
Bad Elf, LLC,	)	Registered: June 7, 2011
	)	Mark: BAD ELF
Applicant	)	

**APPLICANT'S ANSWER TO NOTICE OF OPPOSITION; RESPONSE TO  
PETITION TO CANCEL; AND COUNTERCLAIM FOR CANCELLATION OF THE  
OPPOSER'S MARK**

Applicant, Bad Elf, LLC ("Applicant"), through its counsel, submits this Answer to the Notice of Opposition and Response to Petition to Cancel filed by Datalogic ADC S.r.l. ("Opposer") in the above-identified proceeding.

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 1 and therefore the allegation is denied.
2. Admitted.
3. Denied.
4. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 4 and therefore the allegation is denied.
5. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 5 and therefore the allegation is denied.

6. Admitted.
7. Denied.
8. Denied.
9. Admitted.
10. Denied.

### AFFIRMATIVE DEFENSES

Applicant asserts the following affirmative defenses in response to the Notice of Opposition and Petition to Cancel.

1. Opposer's registered mark is not entitled to a scope of protection sufficient to support the Opposition and Cancellation.

2. Applicant is the owner of a family of ELF marks (U.S. Registration No. 3973625 for the standard characters mark "BAD ELF," Exhibit A, and U.S. Registration No. 3973626 for a stylized elf, Exhibit B), which are widely used and recognized within its industry without any instances of confusion with the Opposer's mark.

3. The Notice of Opposition and Petition to Cancel fail to state a claim upon which relief can be granted.

WHEREFORE, Applicant denies that Opposer is entitled to the relief requested in its Notice of Opposition and Petition to Cancel and requests that the Notice of Opposition and Petition to Cancel be dismissed.

## COUNTERCLAIM

### CANCELLATION OF REGISTRATION NO. 4,058,110

1. Opposer Datalogic ADC S.r.l. has alleged that it is the owner of Registration 4,058,110 for ELF (stylized) for use in connection with the following goods and services in International Class 9:

Microprocessor controlled portable hand-held data terminals with voice communication functions and capable of transmitting and receiving data by radio; radio frequency and scanning and imaging devices for the capture, collection, and management of data, comprised of optical code readers, bar code scanners, electronic tags readers and writers, portable data terminals, and accessories therefor, namely, docking stations, handles, stands, holders, holsters, battery chargers, batteries, screen protectors, stylus, power suppliers, cables, adapters, headsets, modules for expanding communication options, and covers sold as components of data reader devices, and replacement parts therefor; computer software for use in decoding the collected data; computer software for use in decoding readers and processors of data from optical codes and electronic tags; computer software for use in training users of data capture systems, namely, optical code readers, bar code scanners, electronic tags readers and writers and portable data terminals; computer software for providing feedback on and analyzing operation and efficiency of data capture systems, namely, optical code readers, bar code scanners, electronic tags readers and writers and portable data terminals; downloadable user manuals for data capture systems, namely, optical code readers, bar code scanners, electronic tags readers and writers and portable data terminals; all the aforementioned goods not for development, dimensioning and arrangement of the facilities of railways

2. Upon information and belief, Opposer did not have a bona fide intention to use the Opposer's mark in commerce in connection with one or more of the goods listed in application for the Registration No. 4,058,110.

3. Upon information and belief, Opposer does not use the mark, as registered, in commerce in connection with all of the goods listed in the Registration No. 4,058,110.

4. Applicant avers that it is damaged by the continued registration of ELF (stylized), Registration No. 4,058,110, because Opposer filed a Notice of Opposition based upon its assertion that there is a likelihood of confusion.

WHEREFORE, if the Trademark Trial and Appeal Board finds a likelihood of confusion between the respective marks of the parties Applicant/ Counterclaimant Bad Elf, LLC prays that its Counterclaim be granted, that Registration No. 4,058,110 be cancelled and that Opposer's Opposition and Cancellation on grounds of likely confusion be denied.

Respectfully submitted,

Applicant,  
Bad Elf, LLC

Dated: April 12, 2013

By: /Marina F. Cunningham/  
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing APPLICANT'S ANSWER TO NOTICE OF OPPOSITION; RESPONSE TO PETITION TO CANCEL; AND COUNTERCLAIM FOR CANCELLATION OF THE OPPOSER'S MARK has been sent and served by first class mail, postage prepaid this 12th day of April 2013 to the following counsel of record:

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900 SW Fifth Avenue  
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By /Marina F. Cunningham/  
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