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Filing date: **08/12/2013**

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

Proceeding	92057474
Party	Defendant The May Department Stores Company
Correspondence Address	THE MAY DEPARTMENT STORES COMPANY 611 OLIVE STREET ST LOUIS, MO 63101 UNITED STATES
Submission	Answer
Filer's Name	Chester Rothstein
Filer's e-mail	ptodocket@arelaw.com
Signature	/Chester Rothstein/
Date	08/12/2013
Attachments	TTAB Cancellation No. 92057474-FOLEY'S-Answer and Aff Defs.pdf(380647 bytes )

In the Matter of:

33765/1222

Registration No.: 1,850,100  
Registered: August 16, 1994  
Trademark: FOLEY'S  
International Class: 42

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

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Strategic Marks, LLC, :  
: Petitioner, : **Cancellation No. 92057474**  
: v. : **ANSWER AND**  
: **AFFIRMATIVE DEFENSES**  
Macy's Retail Holdings, Inc., :  
: Registrant. :  
-----X

Macy's Retail Holdings, Inc. ("Registrant"), registrant through *mesne* assignments and changes of name from the original applicant,<sup>1</sup> through its attorneys Amster, Rothstein & Ebenstein LLP, answers the Petition to Cancel filed by Strategic Marks, LLC ("Petitioner") as follows:

1. Registrant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 1 of the Petition to Cancel, and, accordingly, denies the same.
2. Registrant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 2 of the Petition to Cancel, and, accordingly, denies the same, except Registrant admits that U.S. Service Mark Application Serial No. 85/933,452 for FOLEY'S in plain block type for "Mobile retail store services featuring clothing,

<sup>1</sup> Including, most recently, a Change of Name from The May Department Stores Company to Federated Retail Holdings, Inc. and a Change of Name from Federated Retail Holdings, Inc. to Macy's Retail Holdings, Inc. that have been filed with the U.S. Patent & Trademark Office.

shoes and general merchandise; On-line retail department store services; On-line retail store services featuring a wide variety of consumer goods of others; On-line retail store services featuring physical and virtual merchandise for use by members of an online community in connection with a designated website featuring fictional characters; On-line retail store services featuring clothing, shoes and general merchandise; Retail apparel stores; Retail department store services; Retail store services featuring a wide variety of consumer goods of others” in International Class 35 (“Application”) is pending.

3. Registrant denies the truth of the allegations contained in Paragraph 3 of the Petition to Cancel, except Registrant admits that at one time The May Department Stores Company was a corporation with a business address of 611 Olive Street, Suite 1750, St. Louis, Missouri 63101. Registrant affirmatively states that Macy’s Retail Holdings, Inc., registrant through *mesne* assignments and changes of name from the original applicant, is a corporation organized under the laws of the state of New York with a business address of 7 West Seventh Street, Cincinnati, Ohio 45202.

4. Registrant denies the truth of the allegations contained in Paragraph 4 of the Petition to Cancel. Registrant affirmatively states that a Change of Name from The May Department Stores Company to Federated Retail Holdings, Inc. and a Change of Name from Federated Retail Holdings, Inc. to Macy’s Retail Holdings, Inc. have been filed with the U.S. Patent & Trademark Office.

5. Registrant denies the truth of the allegation contained in Paragraph 5 of the Petition to Cancel that “Petitioner will be damaged by the continued registration of the Mark.” Registrant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 5 of the Petition to Cancel regarding Petitioner’s beliefs and, accordingly, denies the same. Registrant admits the truth of the allegations contained in

Paragraph 5 of the Petition to Cancel that the Registration and Application cover service and trademarks “that are identical or nearly identical” and that “the respective goods or services associated with the Registration and the Application are identical, nearly identical, or highly similar.”

6. Registrant repeats and incorporates by reference as though fully set forth herein the responses contained in Paragraphs 1 through 5 of this Answer.

7. Registrant denies the truth of the allegations contained in the first sentence of Paragraph 7 of the Petition to Cancel. Registrant affirmatively states that the inclusion in the rest of Paragraph 7 of the Petition to Cancel of a three page alleged excerpt from Wikipedia is improper, and that a response to the allegations contained therein is neither required nor appropriate. To the extent that a response is required, Registrant denies the truth of the allegations contained in the remainder of Paragraph 7 of the Petition to Cancel.

8. Because the parameters of the phrase “in connection with” contained in Paragraph 8 of the Petition to Cancel are ambiguous, Registrant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 8 of the Petition to Cancel, and, accordingly, denies the same.

9. Registrant denies the truth of the allegations contained in Paragraph 9 of the Petition to Cancel.

#### AFFIRMATIVE DEFENSES

1. Registrant has not abandoned its FOLEY’S mark under the law.
2. Registrant uses its FOLEY’S mark on related goods and services in interstate U.S. commerce.
3. Petitioner’s claims are barred because Petitioner lacks standing to bring this Cancellation Action because its Application Serial No. 85/933,452 for the mark FOLEY’S

(“Application”) is void *ab initio*. Petitioner’s standing is based solely on the fact that Petitioner “believes that the USPTO will refuse to register the Application” based on Registrant’s Registration No. 1,850,100 for FOLEY’S for “retail department stores services” (“Registration”). Upon information and belief, Petitioner lacks a *bona fide* intention to use the FOLEY’S mark in commerce, without which its Application is void *ab initio*. Petitioner’s lack of a *bona fide* intent to use the FOLEY’S mark in commerce is evidenced by numerous facts, including, by way of example:

a. The fact that Petitioner filed an excessive number of other intent-to-use applications for marks covering identical, nearly identical, or highly similar services, including:

1. BULLOCK’S DEPARTMENT STORE, Serial No. 85/136,164;
2. MAY COMPANY, Serial No. 85/137,181;
3. JORDAN MARSH, Serial No. 85/137,183;
4. ROBINSON’S, Serial No. 85/137,185;
5. JOSEPH MAGNIN, Serial No. 85/137,187;
6. THE BROADWAY, Serial No. 85/137,191;
7. THE BON MARCHE, Serial No. 85/137,193;
8. ABRAHAM AND STRAUS, Serial No. 85/137,194;
9. FILENE’S, Serial No. 85/137,196;
10. GOTTSCHALKS, Serial No. 85/137,197;
11. BAMBERGER’S, Serial No. 85/933,374;
12. BURDINE’S, Serial No. 85/933,423;
13. GOLDSMITH’S, Serial No. 85/933,432;
14. HECHT’S, Serial No. 85/933,433;

15. I. MAGNIN & COMPANY, Serial No. 85/933,434;
16. KAUFMANN'S, Serial No. 85/933,437;
17. LAZARUS, Serial No. 85/933,440;
18. MARSHALL FIELD'S, Serial No. 85/933,442;
19. MEIER & FRANK, Serial No. 85/933,446;
20. STERN'S, Serial No. 85/933,449;
21. STRAWBRIDGE'S, Serial No. 85/933,451; and
22. RICH'S, Serial No. 85/933,454.

All of these applications cover famous department store names and marks, and all but one (JOSEPH MAGNIN) are owned by Registrant.

b. Upon information and belief, Petitioner is not currently providing, and has never provided, the services covered by its Application and its other intent-to-use applications.

c. Upon information and belief, Petitioner has no present ability or reasonable expectation of obtaining the ability in the foreseeable future to provide the services covered by its Application and its other intent-to-use applications.

4. Petitioner's claims are barred because, upon information and belief, Petitioner is trafficking in trademarks—that is, reserving what Petitioner perceives to be desirable names based on the fame of the marks (including, without limitation, FOLEY'S)—with the intent to sell or license them to others, and therefore, does not have a *bona fide* intent to use the FOLEY'S mark in commerce.

5. Petitioner's claims are barred because its Application, which is alleged as a basis for standing for this Proceeding, is void *ab initio* and should be refused registration for falsely suggesting a connection with “persons, living or dead” in violation of Section 2(a) of the Lanham Act. Specifically, the use or registration by Petitioner of FOLEY'S falsely suggests a connection

with Messrs. Pat and James Foley, who founded the firm in 1900. The Foleys possessed a property right to commercially exploit their last name and did so commercially in the United States during their lifetime by, *inter alia*, using the name Foley as part of a composite mark for their well-known retail stores and related clothing. Starting in 1946, the Foleys' successors in interest began using the FOLEY'S mark for those well-known retail stores and related clothing. These property rights and goodwill have been passed to Registrant, but not to Petitioner.

6. Petitioner's claims are barred because its Application, which is alleged as a basis for standing for this Proceeding, is void *ab initio* and should be refused registration for falsely suggesting a connection with an "institution[]" in violation of Section 2(a) of the Lanham Act. Specifically, the use or registration by Petitioner of FOLEY'S falsely suggests a connection with Foley's department store and Registrant. The Foley's department store had common law rights in the mark FOLEY'S from its use of the mark in U.S. commerce for well-known retail stores and related clothing from at least 1946. The department store obtained the instant federal service and trademark registrations on August 16, 1994. The department store's property rights and goodwill have been passed to Registrant, but not to Petitioner.

7. Petitioner's claims are barred because its Application, which is alleged as a basis for standing for this Proceeding, cannot issue as a registration since Petitioner is not entitled to make use of the mark because such use would constitute false advertising and/or false designation of origin under Section 43(a) of the Lanham Act. Specifically, the FOLEY'S mark has had a venerable history and fame for over 100 years, which goodwill is owned by Registrant but not Petitioner. Use of the mark by Petitioner misrepresents the nature, characteristics or qualities of Petitioner's goods, services, or commercial activities, and/or is likely to cause confusion, to cause mistake, or to deceive as to the affiliation, connection, or association of

Petitioner with Registrant as to the origin, sponsorship, or approval of Petitioner's goods, services, or commercial activities.


8. Petitioner's claims are barred by the doctrine of unclean hands.
9. Petitioner has failed to state a claim upon which relief may be granted.
10. Registrant has insufficient information upon which to form a belief as to whether it may have additional unstated Affirmative Defenses. Registrant reserves the right to assert additional Affirmative Defenses in the event discovery indicates that they are appropriate.

WHEREFORE, Registrant requests that this Petition be denied in all respects.

Respectfully submitted,

AMSTER, ROTHSTEIN & EBENSTEIN LLP  
Attorneys for Macy's Retail Holdings, Inc.  
90 Park Avenue  
New York, New York 10016  
(212) 336-8000

Dated: New York, New York  
August 12, 2013

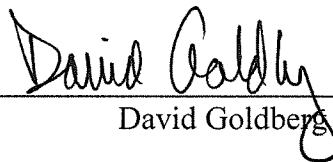
By:   
\_\_\_\_\_  
Anthony F. Lo Cicero  
Chester Rothstein  
David Goldberg



**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that he is one of the attorneys for Registrant Macy's Retail Holdings, Inc. in the above-captioned Cancellation proceeding and that, on the date which appears below, he caused a copy of the foregoing ANSWER AND AFFIRMATIVE DEFENSES to be served on the attorneys for Petitioner Strategic Marks, LLC by first class mail, by causing a copy thereof to be placed in a depository under the care and custody of the United States Postal Service, in the State of New York, postage pre-paid, in a wrapper addressed as follows:

Benjamin Ashurov, Esq.  
KB Ash Law Group PC  
7011 Koll Center parkway, Suite 160  
Pleasanton, CA 94566.

  
\_\_\_\_\_  
David Goldberg

Dated: New York, New York  
August 12, 2013