

ESTTA Tracking number: **ESTTA615027**

Filing date: **07/10/2014**

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

Proceeding	92058094
Party	Defendant Lightwave Publishing Inc.
Correspondence Address	DAVID P COOPER KOLISCH HARTWELL PC 520 S W YAMHILL STREET, SUITE 200 PORTLAND, OR 97204 UNITED STATES
Submission	Motion to Amend/Amended Answer or Counterclaim
Filer's Name	David P. Cooper
Filer's e-mail	cooper@khpatent.com,mandi@khpatent.com
Signature	/ David P. Cooper /
Date	07/10/2014
Attachments	20140710 Second Amended Answer to Petition for Cancellation SMTT429CAN.pdf(97984 bytes )

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

THE ZONDERVAN CORPORATION L.L.C.	)	
	)	
Petitioner,	)	
	)	
v.	)	Opposition No.: 92058094
	)	
LIGHTWAVE PUBLISHING INC.	)	
	)	
Registrant.	)	
<hr style="border: 0.5px solid black;"/>		

ATTN: Trademark Trial and Appeal Board  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Sir:

**SECOND AMENDED ANSWER TO PETITION FOR CANCELLATION**

Registrant, Lightwave Publishing Inc., through its attorneys, for its amended answer to the Petition for Cancellation filed by Petitioner, The Zondervan Corporation L.L.C. answers as follows:

**Petitioner and Its Business**

1. Petitioner is a corporation of the State of Delaware, having a place of business at 5300 Patterson Avenue SE, Grand Rapids, Michigan 49530.

**ANSWER**

Registrant lacks sufficient knowledge or information to form a belief as to the truth of the allegation.

2. Petitioner is a Christian publishing and media company.

**ANSWER**

Registrant lacks sufficient knowledge or information to form a belief as to the truth of the allegation.

3. Petitioner publishes a wide variety of products, including Bibles, books, audio, video, curriculum, software, and digital products.

**ANSWER**

Registrant lacks sufficient knowledge or information to form a belief as to the truth of the allegation.

4. Petitioner has used BOYS BIBLE in the titles of its Bibles and related products, including the titles 252 BOYS BIBLE and NIV BOYS BIBLE.

**ANSWER**

Registrant lacks sufficient knowledge or information to form a belief as to the truth of the allegation.

5. Petitioner has owned the 252 BOYS BIBLE and NIV BOYS BIBLE titles for Bibles and related products at all times.

**ANSWER**

Registrant lacks sufficient knowledge or information to form a belief as to the truth of the allegation.

**Respondent and Its Alleged Mark**

6. Respondent is a corporation of Canada with an address at 349 W. Georgia Street, P.O. Box 2446, Vancouver, British Columbia V6B3W7.

**ANSWER**

Admitted.

7. On June 26, 2012, Respondent filed Application Serial No. 85661860 for BOYS BIBLE under Section 1(a), 15 U.S.C. Section 1051(a) (the "Application"). Respondent claimed a first-use date of August 27, 2002.

**ANSWER**

Admitted.

8. In fact, Respondent was not using BOYS BIBLE as of Respondent's claimed first-use date or filing date, and has never used BOYS BIBLE in commerce for any of the goods identified in the Application.

**ANSWER**

Denied.

9. Respondent submitted a specimen of use with the Application purportedly showing Respondent's use in commerce of BOYS BIBLE for the goods identified in the Application.

**ANSWER**

Admitted.

10. In fact, the specimen of use submitted by Respondent actually showed Petitioner's use in commerce of its 252 BOYS BIBLE and NIV BOYS BIBLE titles for Bibles.

**ANSWER**

Denied.

11. In response to a 2(e)(1) refusal, Respondent submitted a Section 2(f) declaration in support of the Application stating that BOYS BIBLE had become distinctive "through [Respondent's] substantially exclusive and continuous use in commerce . . . for at least the five years immediately before the date of this statement."

**ANSWER**

Admitted.

12. In fact, as noted above, Respondent never used BOYS BIBLE in commerce for any of the goods identified in the Application, and the use relied on in Respondent's Section 2(f) Declaration was actually Petitioner's use of Petitioner's titles containing BOYS BIBLE. Further, any alleged use could not have been "substantially exclusive" because of Petitioner's concurrent use of titles containing BOYS BIBLE for Bibles.

**ANSWER**

Denied.

13. The Application matured into U.S. Registration No. 4323349 for BOYS BIBLE for “Bibles, Bibles annotated with religious commentary and activities in the field of Bible studies; printed activity guides in the field of Bible and religious studies; printed publications in the nature of books, workbooks, and printed educational materials, all in the field of bible and religious studies,” in Class 16 (the “Registration”).

**ANSWER**

Admitted.

14. Although the Registration was issued to Respondent, Respondent has never owned the alleged mark BOYS BIBLE for any of the goods identified in the Registration.

**ANSWER**

Denied.

**VOID AB INITIO, 15 U.S.C. § 1051(a)**

15. Petitioner repeats and realleges each and every allegation set forth in Paragraphs 1 to 14 above.

**ANSWER**

Registrant responds as it did to each allegation above.

16. Trademark Act Section 1(a), 15 U.S.C. § 1051(a), allows registration of trademarks “used in commerce” and requires that an applicant make a verified statement that the mark is in use in commerce before filing the application.

**ANSWER**

Admitted.

17. Respondent had not used the alleged mark BOYS BIBLE in commerce for any of the goods identified in the Application as of the filing date (or at any other relevant time), as required under Trademark Act Sections 1(a) and 45, 15 U.S.C. § 1127.

**ANSWER**

Denied.

18. The Application is void ab initio and the Registration must therefore be cancelled.

**ANSWER**

Denied.

**OWNERSHIP, 15 U.S.C. § 1051(a)**

19. Petitioner repeats and realleges each and every allegation set forth in Paragraphs 1 to 18 above.

**ANSWER**

Registrant responds as it did to each allegation above.

20. Trademark Act Section 1(a), 15 U.S.C. § 1051(a), allows the “owner of a trademark used in commerce” to request registration of its trademark on the Principal Register.

**ANSWER**

Admitted.

21. Respondent has never used in commerce the alleged mark BOYS BIBLE for any of the goods in the Registration.

**ANSWER**

Denied.

22. Respondent is not and has never been the owner of the alleged BOYS BIBLE mark in violation of 15 U.S.C. § 1051(a) and the Registration must be cancelled.

**ANSWER**

Denied.

**DESCRIPTIVENESS, 15 U.S.C. § 1052(e)**

23. Petitioner repeats and realleges each and every allegation set forth in Paragraphs 1 to 22 above.

**ANSWER**

Registrant responds as it did to each allegation above.

24. The alleged mark BOYS BIBLE is merely descriptive of the goods identified in the Registration, in violation of Section 2(e)(1), 15 U.S.C. § 1052(e)(1).

**ANSWER**

Denied.

25. Respondent has not and cannot establish acquired distinctiveness in the term BOYS BIBLE under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).

**ANSWER**

Denied.

26. Petitioner and others have a competitive and equal right to use the term BOYS BIBLE to describe their products.

**ANSWER**

Denied.

27. If Respondent is allowed to maintain the Registration for the descriptive term BOYS BIBLE, it will effectively misappropriate a descriptive term for its exclusive use, and cause injury and damage to Petitioner and others.

**ANSWER**

Denied.

28. Accordingly, the Registration should be cancelled under Sections 2(f) and 2(e)(1) of the Trademark Act, 15 U.S.C. §§ 1052(e)(1) and 1052(f) on the ground that the alleged mark BOYS BIBLE is merely descriptive without acquired distinctiveness.

**ANSWER**

Denied.

**AFFIRMATIVE DEFENSES**

**FIRST AFFIRMATIVE DEFENSE**

29. On March 27, 2001, Petitioner and Registrant entered into an agreement attached as Exhibit A (“the Agreement”) pertaining to publishing a Work owned by Registrant and called “252 Bible for Boys.” Based upon at least paragraphs 1, 10 and 16 of the Agreement, Registrant thought and Petitioner knew that Registrant owned all intellectual property rights in the Work, including the trademark BOYS BIBLE, and that Registrant was licensing Petitioner to use that trademark in connection with publications of the Work.

30. From March 27, 2001 until October 24, 2013 (“the Delay Period”), the date of Petitioner’s Petition for Cancellation in this case (“the Petition”), Petitioner failed to assert an ownership in the trademark BOYS BIBLE, or otherwise communicate to Registrant that Petitioner thought Petitioner owned the BOYS BIBLE trademark.

31. Petitioner and Registrant were in regular communication during the Delay Period.

32. During the Delay Period, Petitioner did not communicate to third parties that Petitioner owned the BOYS BIBLE trademark.

33. During the Delay Period, Petitioner did not apply for a federal trademark registration for the BOYS BIBLE trademark.

34. During the Delay Period, Registrant relied on its opinion that it owned the BOYS BIBLE trademark, and relied on Petitioner’s lack of an assertion that Petitioner owned that trademark.

35. Petitioner is responsible for the Delay Period.

36. The Delay Period is unreasonable in duration.



37. If Petitioner is successful in this Cancellation proceeding, Registrant will be materially prejudiced as a result of the Delay Period.

38. As to all claims except for the descriptiveness claim, the Petition is barred in whole or in part by the doctrine of laches.

### **SECOND AFFIRMATIVE DEFENSE**

39. Registrant repeats and realleges each and every allegation set forth in Paragraphs 1 to 38 above.

40. Given Petitioner's failure to assert an ownership interest in the BOYS BIBLE trademark for the entire Delay Period, which included regular communications with Petitioner, Registrant reasonably inferred that Petitioner did not think it owned that trademark, and that Registrant did own that trademark.

41. Petitioner's failure to assert an ownership interest to Registrant during the Delay Period ("Petitioner's Failure to Assert") was misleading to Registrant.

42. Registrant relied upon its understanding that it owned the BOYS BIBLE trademark, and also relied upon Petitioner's Failure to Assert.

43. If Petitioner is successful in this Cancellation proceeding, Registrant will be materially prejudiced as a result of the Delay Period and Petitioner's Failure to Assert.

44. Based upon the Delay Period and Petitioner's Failure to Assert, Petitioner expressly consented to, encouraged, or otherwise furthered Registrant's activities with respect to Registrant's ownership of the BOYS BIBLE trademark.

45. Based upon the Delay Period and Petitioner's Failure to Assert, Petitioner gave clear implication to Registrant that Petitioner consented to, encouraged, or otherwise furthered Registrant's activities with respect to Registrant's ownership of the BOYS BIBLE trademark.

46. Based upon the Delay Period and Petitioner's Failure to Assert, Petitioner intentionally relinquished or abandoned any ownership interest that it may have had in the BOYS BIBLE trademark.

47. As to all claims except the descriptiveness claim, the Petition is barred in whole or in part by the doctrine of estoppel, acquiescence and waiver.

WHEREFORE, Registrant Lightwave Publishing requests that this Petition for Cancellation be dismissed, and for any other and further relief that the Trademark Trial Appeal Board may deem just and appropriate.

Respectfully submitted,

Dated: July 10, 2014

\_\_\_\_\_  
/ David P. Cooper /

David P. Cooper  
Registration No. 33,372  
Kolisch Hartwell, P.C.  
520 S.W. Yamhill Street, Suite 200  
Portland, Oregon 97204  
Telephone: (503) 224-6655  
Facsimile: (503) 295-6679  
Of Attorneys for Registrant

CERTIFICATION UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence is being filed electronically with the United States Patent and Trademark Office via the Electronic System for Trademark Trials and Appeals this 10<sup>th</sup> day of July, 2014.

\_\_\_\_\_  
/ Mandi M. Leighty /

Mandi M. Leighty

