

ESTTA Tracking number: **ESTTA604525**

Filing date: **05/15/2014**

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

Proceeding	92058683
Party	Defendant William Lowell Elliott
Correspondence Address	DAVID LUDWIG DUNLAPWEAVER LLP 211 CHURCH STREET SE LEESBURG, VA 20175 UNITED STATES dludwig@dunlapweaver.com
Submission	Answer
Filer's Name	David Ludwig
Filer's e-mail	dludwig@dunlapweaver.com
Signature	/David Ludwig/
Date	05/15/2014
Attachments	Answer and Affirmative Defenses.pdf(102630 bytes)

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

**IN THE MATTER OF Trademark Registration No. 3,944,981
For the mark PLEASE ME and design;
Registered on April 12, 2011**

WIZARDS OF THE COAST LLC,)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92058683
)	
WILLIAM LOWELL ELLIOT,)	
)	
Registrant.)	
<hr style="width: 40%; margin-left: 0;"/>)	

ANSWER AND AFFIRMATIVE DEFENSES

Registrant William Lowell Elliot, by counsel and pursuant to 37 C.F.R. § 2.114, submits this Answer and Affirmative Defenses to the Petition to Cancel that was filed by Petitioner Wizards of the Coast LLC.

1. Registrant admits the allegations in Paragraph 1 of the Petition to Cancel.
2. Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 2 of the Petition to Cancel and therefore denies those allegations.
3. Registrant admits the allegations in Paragraph 3 of the Petition to Cancel.
4. Registrant admits the allegations in Paragraph 4 of the Petition to Cancel.
5. Registrant admits the allegations in Paragraph 5 of the Petition to Cancel.
6. Registrant denies the allegations in the first sentence of Paragraph 6 of the Petition to Cancel. Registrant is without knowledge or information sufficient to form a belief as

to the truth of the allegations in the remainder of Paragraph 6 of the Petition to Cancel and therefore denies those allegations.

7. Registrant denies the allegations in Paragraph 7 of the Petition to Cancel.

8. Registrant denies the allegations in Paragraph 8 of the Petition to Cancel.

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

10. Registrant denies the allegations in Paragraph 10 of the Petition to Cancel.

11. Registrant denies the allegations in the first sentence of Paragraph 11 of the Petition to Cancel. Registrant admits the allegations in the remainder of Paragraph 11 of the Petition to Cancel.

12. First Affirmative Defense: Laches. Registrant's Trademark application was Published for Opposition on Sep. 22, 2009, and Registrant's Principal Register registration issued on April 21, 2011. Petitioner was put on constructive notice of Registrant's registration at that time. The Petition to Cancel was filed on February 14, 2014. Petitioner made no effort to communicate with Registrant until its Petition to Cancel was filed. Between his first use in commerce in May 2010 and the filing of the Petition to Cancel in February 2014, Registrant invested his time and financial resources into marketing his products and developing significant public goodwill in them. Accordingly, cancellation of his Mark in light of this undue and unreasonable delay would result in economic prejudice to Registrant. *See Teledyne Technologies, Inc. v. Western Skyways, Inc.*, 78 U.S.P.Q.2d (BNA) 1203 (TTAB 2006). Given the differences in the parties' respective Marks, as well as their respective uses of those Marks and channels of trade, confusion is not inevitable in this case.

13. Second Affirmative Defense: Acquiescence. As set forth in Paragraph 12, above, Petitioner was on constructive notice of Registrant's Mark since at least as early as April 2011.

However, Petitioner never objected to Registrant's use of the Mark until the Petition to Cancel was filed nearly three years later. Petitioner's silence in this regard constitutes acquiescence. *See Christian Broadcasting Network, Inc. v. ABS-CBN Int'l*, 84 U.S.P.Q.2d (BNA) 1560 (TTAB 2007). Given the differences in the parties' respective Marks, as well as their respective uses of those Marks and channels of trade, confusion is not inevitable in this case.

14. Third Affirmative Defense: No Trademark Use by Petitioner. Based on the specimen filed with its application, Petitioner's only use of the claimed Mark appears to be as a part of the artwork that appears on some of its playing cards. In information and belief, the claimed design does not appear on Petitioner's product packaging, in proximity to Petitioner's product name, or in Petitioner's advertising materials. As such, Petitioner's claimed prior use upon which its claim of priority is based is not a source identifying use or a Trademark Use in commerce sufficient to create a consumer association between the claimed design and Petitioner.

15. Fourth Affirmative Defense: No Likelihood of Confusion. The parties' Marks, when considered in their entirety, do not convey a similar commercial impression. The parties' channels of trade are sufficiently distinct so as to obviate any likelihood of confusion.

16. Fifth Affirmative Defense: In the alternative to the foregoing Affirmative Defenses, Registrant is at least entitled to a registration with a particular restriction. Such restriction would highlight the differences in the parties' goods as well as their respective channels of trade. Specifically, by restricting Registrant's description of goods to "*adult themed board games for adult couples and individuals that are primarily erotic, sensual or sexual in nature,*" any potential likelihood of confusion with Petitioner's youth oriented fantasy trading card game would be obviated.

DATED this 15th day of May 2014.

Respectfully submitted,

WILLIAM LOWELL ELLIOT,
Registrant,
By counsel,

/David Ludwig/

David Ludwig
DUNLAPWEAVER PLLC
211 Church Street, SE
Leesburg, VA 20175
Tel.: (703) 777-7319
Fax.: (703) 777-3656
dludwig@dunlapweaver.com

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this Petition for Cancellation is being electronically filed using the Electronic System for Trademark Trials and Appeals (ESTTA) on this 15th day of May 2014.

/David Ludwig/
David Ludwig

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Petition for Cancellation has been served upon Petitioner by ESTTA and also by depositing one copy thereof in the U.S. Mail, First Class, postage prepaid, on this 15th day of May 2014, addressed as follows:

Kim J. Landsman
Carin G. Reynolds
Golenbock Eiseman Assor Bell & Peskoe LLP
437 Madison Avenue
New York, NY 10022

/David Ludwig/
David Ludwig