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

Proceeding	92063649
Party	Defendant Lincoln Global, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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The ESAB Group, Inc.,)	
)	
Petitioner,)	Cancellation No. 92/063,649
)	
v.)	
)	Mark: FLASHBACK FRIDAY
)	
Lincoln Global, Inc.)	
)	
Respondent.)	Registration No. 4,562,560

ANSWER TO PETITIONER’S PETITION FOR CANCELLATION

Respondent Lincoln Global, Inc. (“Respondent” or “Lincoln”), by and through its undersigned counsel, hereby answers Petitioner The ESAB Group, Inc.’s (“Petitioner” or “ESAB”) Petition for Cancellation as follows.

1. Petitioner manufactures and sells welding and cutting equipment, as well as various related goods.

ANSWER: Respondent admits the allegations of Paragraph 1.

2. Petitioner is a prominent company in the welding and cutting field whose related entities trace their roots back to 1904.

ANSWER: Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 2, and therefore denies those allegations.

3. On April 22, 2014, Petitioner publicly announced the acquisition (by their now-common parent company) of Victor Technologies Holdings, Inc. (“Victor”), which is another well-known company in the welding and cutting field.

ANSWER: Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 3, and therefore denies those allegations.

4. On Friday, April 22, 2016 – two years to the day after announcing the Victor acquisition – Petitioner commemorated the Victor announcement by publishing the posts shown below to its accounts on Facebook®, Twitter®, and Google®: [IMAGES OMITTED].

ANSWER: Respondent admits that Petitioner posted content on various online social media platforms on or about April 22, 2016 that infringed Respondent’s rights in its federally-registered FLASHBACK FRIDAY mark. Respondent is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations of Paragraph 4, and therefore denies those allegations.

5. Petitioner’s three social media posts, shown in paragraph 4 above, each used the hashtag #FLASHBACKFRIDAY.

ANSWER: Respondent admits the allegations of Paragraph 5.

6. #FLASHBACKFRIDAY is a commonly-used hashtag on social media platforms, including but not limited to Facebook®, Twitter®, Google®, Instagram®, and Reddit®.

ANSWER: Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 6, and therefore denies those allegations.

7. The website Slang Definition states:

FBF, or Flashback Friday, is a popularly used hashtag on Instagram. When users use the hashtag #FBF, they usually tag in on a photo of something that’s happened in their past, such as a vacation, party, or graduation ceremony. FBF posts usually only occur on Friday, but they can occur on other days for various reasons. . . . Flashback Friday posts can occur on other social media websites as well, like Facebook, Twitter, or Tumblr.

ANSWER: Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 7, and therefore denies those allegations.

8. The website About.com, in an article titled What’s the Difference Between Throwback Thursday and Flashback Friday?, states:

If you spend any amount of time on social media or online in general, you've probably heard of two very popular social sharing trends – Throwback Thursday and Flashback Friday.

Social media users, bloggers and even brands will post some type of content (like a photo, a video or a song) from the past and they'll tag it with #ThrowbackThursday or #TBT if they're posting it on a Thursday. If it's Friday, they'll tag it with #FlashbackFriday or #FBF.

ANSWER: Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 8, and therefore denies those allegations.

9. The International Business Times, in an article titled What Do MCM, WCW, TBT, LB, IRL, TIL And Other Instagram and Reddit Hashtags and Terms Mean?, explained the significance of #FLASHBACKFRIDAY (bolding added):

[T]he following glossary explains some of the more frequently used [abbreviations on social media].

(...)

TBT, TT, FBF: These terms are for types of flashbacks, to show friends and family a glimpse of the past. TBT stands for “throwback Thursday” and is one of the most popular hashtags. TT stands for “transformation Tuesday” and is usually used to show a change in appearance (weight loss, haircut, etc.). FBF stands for “flashback Friday” and is pretty much the same as TBT, except it's used on Fridays.

ANSWER: Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 9, and therefore denies those allegations.

10. An article titled Everything You Need to Know About Your Favorite Day: Throwback Thursday (Er, #TBT), which appeared on the website Digital Trends, stated:

If you use Instagram or Twitter, you've probably seen or used the hashtag #throwbackthursday, or #tbt, once or twice (or a million times). It rose to such infamy that along came #flashbackfriday so people would have an excuse to post old pictures two days a week instead of one.

ANSWER: Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 10, and therefore denies those allegations.

11. Intuit QuickBooks, in a post titled Tips for Boosting Sales With Twitter, made clear why businesses use hashtags and weekly themes, including Flashback Friday:

Hashtags – words and phrases preceded by the # character – help Twitter users find posts that interest them, so don't be afraid to use them in your tweets. Popular hashtags relate to current events, celebrity personalities, as well as weekly themes, such as Throwback Thursday (#TBT) and Flashback Friday (#FBF). You can engage and expand your audience by using relevant hashtags. Just be sure to tie the tweets back to your brand.

ANSWER: Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 11, and therefore denies those allegations.

12. The website creativejuice, in a post titled #What #Does #This #Even #Mean? Hashtags That Are Trending, explained:

Hashtags have many uses. Companies use them for marketing, to easily gain user feedback, or to track the conversation around a product...

(...)

Throwback Thursday and Flashback Friday are themes to generate involvement from users across social media. The aim is that, on these days, people will feel encouraged to share old pictures of themselves, usually with a description of why the photo was shared. Creating an event such as this is a great way to get people engaged. People like to share, and creating engaging events such as these can be effective means for free online publicity.

ANSWER: Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 12, and therefore denies those allegations.

13. The term “Flashback Friday” – with or without the hashtag, with or without a space between “Flashback” and “Friday”, and with or without capitalization – is commonly used online, on Fridays, to refer to a past event or time period.

ANSWER: Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 13, and therefore denies those allegations.

14. On April 29, 2016 – a Friday – USA Gymnastics published a Flashback Friday to its YouTube channel about gymnast Shannon Miller's performance at the 1992 Olympics: [IMAGES OMITTED].

ANSWER: Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 14, and therefore denies those allegations.

15. On April 1, 2016 – a Friday – Fox Sports published a Flashback Friday observing the 23rd anniversary of the death of NASCAR driver Alan Kulwicki: [IMAGES OMITTED].

ANSWER: Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 15, and therefore denies those allegations.

16. On August 1, 2014 – a Friday – The Huffington Post published a post titled You Won't See Another Flashback Friday Video Quite Like This '80s Tribute Gem: [IMAGES OMITTED].

ANSWER: Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 16, and therefore denies those allegations.

17. On April 29, 2016 – a Friday – the Silicon Valley Business Journal posted a #FlashbackFriday comparing Apple Inc.'s poor recent quarterly earnings with that of twenty years ago: [IMAGES OMITTED].

ANSWER: Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 17, and therefore denies those allegations.

18. Also on April 29, 2016, People magazine published an article about actress Allison Janney winning #FlashbackFriday: [IMAGES OMITTED].

ANSWER: Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 18, and therefore denies those allegations.

19. On February 17, 2016, the NBA professional basketball team Sacramento Kings announced the team would play on a retro-themed basketball court for its “five remaining #FlashbackFriday games”: [IMAGES OMITTED].

ANSWER: Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 19, and therefore denies those allegations.

20. Lincoln Global, Inc. (“Respondent”) is one of Petitioner’s competitors in the welding field.

ANSWER: Respondent admits the allegations of Paragraph 20.

21. Petitioner and Respondent are currently engaged in patent litigation.

ANSWER: Respondent admits the allegations of Paragraph 21.

22. Respondent is the owner of U.S. Registration No. 4,562,560 for FLASHBACK FRIDAY (“FRIDAY” disclaimed), which covers “online journal, namely, text and graphic works featuring information in the field of welding” in Class 41 (“Respondent’s Registration”).

ANSWER: Respondent admits the allegations of Paragraph 22.

23. Respondent’s Registration issued on July 8, 2014.

ANSWER: Respondent admits the allegations of Paragraph 23.

24. The services identified in Respondent’s registration – i.e., “online journal, namely, text and graphic works featuring information in the field of welding” (“Respondent’s Services”) – consist of Flashback Friday posts.

ANSWER: Respondent denies the allegations of Paragraph 24.

25. Respondent used “Flashback Friday®” and “#flashbackfriday” in the same Facebook post on Friday, April 29, 2016: [IMAGES OMITTED].

ANSWER: Respondent admits the allegations of Paragraph 25.

26. Respondent used “Flashback Friday®” and “#flashbackfriday” in the same Twitter post on Friday, April 29, 2016: [IMAGES OMITTED].

ANSWER: Respondent admits the allegations of Paragraph 26.

27. On April 22, 2016 – a Friday – Respondent used “#FlashbackFriday” on Facebook in connection with Respondent’s Services: [IMAGES OMITTED].

ANSWER: Respondent admits the allegations of Paragraph 27.

28. On April 22, 2016 – a Friday – Respondent used “#FlashbackFriday” on Twitter in connection with Respondent’s Services: [IMAGES OMITTED].

ANSWER: Respondent admits the allegations of Paragraph 28.

29. On May 18, 2014, Respondent used “Flashback Friday™” in connection with what Respondent called its “#FlashbackFriday series” and referenced Respondent’s “inaugural installment of #FlashbackFriday” (highlighting added): [IMAGES OMITTED].

ANSWER: Respondent admits the allegations of Paragraph 29.

30. Respondent is aware that Respondent’s Services consist of a Flashback Friday, or #FlashbackFriday, as those terms are understood on social media and in the online world.

ANSWER: Respondent denies the allegations of Paragraph 30.

31. In a letter dated April 27, 2016, Lincoln asserted that Petitioner’s use of “#FLASHBACKFRIDAY”, as shown above in paragraph 4, “infringes Lincoln Electric’s rights in its federally-registered service mark ‘FLASHBACK FRIDAY.’” Petitioner’s use of “#FLASHBACKFRIDAY” on social media, Respondent further asserted, “constitutes trademark infringement and unfair competition in violation of federal trademark law.”

ANSWER: Respondent admits that its April 27, 2016 letter referenced Petitioner’s infringement of Respondent’s federally-registered FLASHBACK FRIDAY mark, among other issues. Respondent denies that the claims asserted in its April 27, 2016 letter were limited to this infringing act by Petitioner.

32. Petitioner has standing to bring this proceeding by virtue of the facts that (i) Petitioner and Respondent are competitors and Petitioner is in a position to use “Flashback Friday” or “FlashbackFriday” or “#FlashbackFriday” on social media, (ii) Petitioner is in fact using the social media term “#FLASHBACKFRIDAY” as noted above in paragraph 4, and (iii) Respondent has taken the position that Petitioner’s use constitutes infringement of the registered mark Petitioner now seeks to cancel.

ANSWER: Respondent admits that Petitioner and Respondent are competitors and that Petitioner has infringed Respondent's federally-registered FLASHBACK FRIDAY mark. The remaining allegations of Paragraph 32 call for a legal conclusion as to whether Petitioner has standing to bring its claims and do not require Respondent to admit or deny those allegations.

33. The mark FLASHBACK FRIDAY shown in Respondent's Registration was merely descriptive of Respondent's Services, within the meaning of Section 2(e)(1) of the Trademark Act, as of the date of registration, i.e., July 8, 2014. Indeed, as shown at paragraph 29 above, Respondent itself refers to its posts as its "#FlashbackFriday series" and references "the inaugural installment of #FlashbackFriday."

ANSWER: Respondent denies the allegations of Paragraph 33.

34. The mark FLASHBACK FRIDAY shown in Respondent's Registration had not acquired distinctiveness with respect to Respondent's Services as of the date of registration, i.e., July 8, 2014.

ANSWER: Respondent denies the allegations of Paragraph 34.

35. The mark FLASHBACK FRIDAY shown in Respondent's Registration is merely descriptive of Respondent's Services.

ANSWER: Respondent denies the allegations of Paragraph 35.

36. The mark FLASHBACK FRIDAY shown in Respondent's Registration has not acquired distinctiveness with respect to Respondent's Services.

ANSWER: Respondent denies the allegations of Paragraph 36.

37. The mark FLASHBACK FRIDAY shown in Respondent's Registration is, and was as of its date of registration, merely descriptive and without acquired distinctiveness as applied to Respondent's Services.

ANSWER: Respondent denies the allegations of Paragraph 37.

38. The mark FLASHBACK FRIDAY shown in Respondent's Registration is primarily used by the relevant public to refer to the genus of Respondent's Services, or the central focus and/or key aspect of said genus of services.

ANSWER: Respondent denies the allegations of Paragraph 38.

39. The mark FLASHBACK FRIDAY shown in Respondent's Registration is primarily understood by the relevant public to refer to the genus of Respondent's Services, or the central focus and/or key aspect of said genus of services.

ANSWER: Respondent denies the allegations of Paragraph 39.

40. The mark FLASHBACK FRIDAY shown in Respondent's Registration is a generic term as applied to Respondent's Services.

ANSWER: Respondent denies the allegations of Paragraph 40.

41. Petitioner is entitled to be free from meritless, harassing threats by Respondent based on rights Respondent does not in fact possess.

ANSWER: Respondent denies the allegations of Paragraph 41.

AFFIRMATIVE DEFENSES

FIRST AFFIRMATIVE DEFENSE

ACQUIRED DISTINCTIVENESS

42. Respondent's mark, FLASHBACK FRIDAY, is inherently distinctive as applied to the services identified in Reg. No. 4,562,560, namely, "online journal, namely, text and graphic works featuring information in the field of welding." However, in the alternative, Respondent's mark has acquired distinctiveness through Respondent's extensive use and promotion of the mark in commerce.

SECOND AFFIRMATIVE DEFENSE

LACHES

43. Petitioner's claims are barred by the doctrine of laches. Petitioner unduly and unreasonably delayed in asserting its claims, and Respondent has been prejudiced by this delay.

THIRD AFFIRMATIVE DEFENSE

UNCLEAN HANDS

44. Petitioner's claims are barred by the doctrine of unclean hands. Petitioner's claims are barred by the doctrine of unclean hands because Petitioner, a direct competitor in the welding and cutting industry, has engaged in a pattern of infringing Respondent's federally-registered trademarks, including the FLASHBACK FRIDAY mark at issue in this proceeding. Petitioner has conducted its infringing activity through social media postings on Facebook, Twitter, and Google under FLASHBACK FRIDAY or confusingly similar marks intended to deceive and confuse consumers, and to divert consumers into visiting Petitioner's social media pages and websites. Respondent learned of Petitioner's unlawful actions and in a letter dated April 27, 2016 demanded that Petitioner cease and desist. In response, and in retaliation,

Petitioner seeks, in bad faith, to cancel one of Respondent's asserted marks, FLASHBACK FRIDAY.

WHEREFORE, Respondent respectfully requests the Board to dismiss Petitioner's Petition for Cancellation with prejudice.

Date: May 18, 2016

Respectfully submitted,

/s/ Thomas M. Williams/
*One of the Attorneys for Respondent
Lincoln Global, Inc.*

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CERTIFICATE OF SERVICE

On May 18, 2016 I served the foregoing **ANSWER TO PETITIONER'S PETITION FOR CANCELLATION** on the parties in said action by depositing a true copy thereof with the United States Postal Service as first class mail, postage prepaid, at Chicago, Illinois, enclosed in a sealed envelope addressed to counsel of record for Petitioner as follows:

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By: /s/ Thomas M. Williams
Thomas M. Williams