

ESTTA Tracking number: **ESTTA801275**

Filing date: **02/14/2017**

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

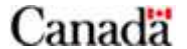
Proceeding	92065095
Party	Defendant Wiston International Trade Co., Ltd. dba Wiston International Hardwood Co.
Correspondence Address	WISTON INTERNATIONAL TRADE CO LTD #120 4611 VIKING WAY RICHMOND, V6V2K9 CANADA admin@witffloor.ca
Submission	Answer
Filer's Name	Gina M. Lupino
Filer's e-mail	gina@ascendionlaw.com, kelly@ascendionlaw.com
Signature	/Gina M. Lupino/
Date	02/14/2017
Attachments	Exhibit_A.pdf(533036 bytes) 003. Answer - WOODPECKER cancellation.pdf(348953 bytes)

EXHIBIT A



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Canadian Intellectual Property Office

Canadian trade-mark data

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The database was last updated on:2017-02-07

APPLICATION NUMBER:

1546467

REGISTRATION NUMBER:

TMA840290

STATUS:

REGISTERED

FILED:

2011-10-04

FORMALIZED:

2011-10-06

ADVERTISED:

2012-09-19

REGISTERED:

2013-01-15

REGISTRANT:

Wiston International Trade Co., Ltd. DBA Wiston Building Materials Co.
120-4611 Viking Way
Richmond
V6V 2K9
BRITISH COLUMBIA

REPRESENTATIVE FOR SERVICE:

COASTAL TRADEMARK SERVICES LIMITED
1081 Cambie Street
Vancouver
BRITISH COLUMBIA V6B 5L7

TRADE-MARK (Design):



WOODPECKER

MARK DESCRIPTIVE REFERENCE:

woodpecker & design

INDEX HEADINGS:

WOODPECKER

VIENNA INFORMATION:

VIENNA INFORMATION

Code Description

- 3.7.13 Sparrows or other passerine birds
- 3.7.19 Heads of birds, parts of birds, feathers, footprints, skeletons of birds
- 3.7.21 Other birds
- 3.7.24 Birds stylized

GOODS:

(1) Wood flooring, namely, solid hardwood stripes, planks, engineered hardwood flooring, laminated flooring, parquet hardwood flooring, engineered bamboo flooring. Wooden doors, window frames and wood cabinets.

SERVICES:

(1) Wholesale and retail store services dealing with the sale of flooring materials, doors, window frames, furniture, and the installation and maintenance of flooring materials, doors, window frames, furniture.

CLASSIFICATION DATA:

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- 19 - Non-metallic building materials
- 20 - Furniture, mirrors, articles not included in other classes
- 35 - Advertising, marketing, promotional and business
- 37 - Building construction and repair

CLAIMS:

Declaration of Use filed January 15, 2013.

ASSOCIATED MARKS:

TMA779,544 TMA836,079 TMA836,081 TMA840,289

Action Information

<u>ACTION</u>	DATE	BF	COMMENTS
Filed	2011-10-04		
Created	2011-10-05		
Formalized	2011-10-06		
Note to File	2012-01-25		To amend the name of the applicant as per correspondence dated January 9, 2012.
Search Recorded	2012-04-03		
Examiner's First Report	2012-04-03	2012-10-03	
Correspondence Created	2012-04-17	2012-10-17	
Rep for Service Changed	2012-07-11		From: To: 7206
Agent Changed	2012-07-11		From: To: 7206
Approval Notice Sent	2012-07-11	2012-08-08	
Approved	2012-08-30		APPROVED BY PROGRAM EX200M1
Extracted for Advertisement	2012-09-14		Vol.59 Issue 3021 2012/09/19
Advertised	2012-09-19		Vol.59 Issue 3021
Allowed	2013-01-04		
Allowance Notice Sent	2013-01-04	2014-10-04	
Registered	2013-01-15		
Agent Name Change	2013-01-15		
Rep for Service	2013-01-15		

Name Change		
Amendment to Registration	2013-03-07	Name / Voir Preuve au dossier/See evidence on File No. 1546648
Amendment to Registration	2013-06-07	Section 41.1(a) - Owner Information / Voir Preuve au dossier/See evidence on File No. 1435119
Amendment to Registration	2014-05-28	Owner Address Change / Voir Preuve au dossier/See evidence on File No. 1435119

FOOTNOTES:

CHANGE IN TITLE/CHANGEMENT EN TITRE:

TYPE OF CHANGE/GENRE DE CHANGEMENT: Name/Nom
DATE REGISTERED/DATE DE L'ENREGISTREMENT: 07 mars/Mar 2013
DATE OF CHANGE/DATE DE CHANGEMENT: 29 janv/Jan 2013
COMMENTS/COMMENTAIRES: FROM: Wiston International Trade Co., Ltd
DBA Wiston International Hardwood Co.
TO: Wiston Building Materials Co.
Voir Preuve au dossier/See evidence on File No. 1546648

AMENDMENT TO REGISTRATION/MODIFICATION A L'ENREGISTREMENT:

TYPE OF AMENDMENT/GENRE DE MODIFICATION: Section 41.1(a) - Owner Information/Alinéa 41.1a) - information sur le propriétaire
DATE REGISTERED/DATE DE L'ENREGISTREMENT: 07 juin/Jun 2013
DATE OF CHANGE/DATE DE CHANGEMENT: 07 juin/Jun 2013
COMMENTS/COMMENTAIRES: Voir Preuve au dossier/See evidence on File No. 1435119

OWNER ADDRESS CHANGE/CHANGEMENT D'ADRESSE DU PROPRIÉTAIRE:

DATE REGISTERED/DATE DE L'ENREGISTREMENT: 28 mai/May 2014
COMMENTS/COMMENTAIRES: Voir Preuve au dossier/See evidence on File No. 1435119

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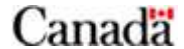
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The database was last updated on:2017-02-07

APPLICATION NUMBER:

1546474

REGISTRATION NUMBER:

TMA840289

STATUS:

REGISTERED

FILED:

2011-10-04

FORMALIZED:

2011-10-07

ADVERTISED:

2012-09-19

REGISTERED:

2013-01-15

REGISTRANT:

Wiston International Trade Co., Ltd. DBA Wiston Building Materials Co.
120-4611 Viking Way
Richmond
V6V 2K9
BRITISH COLUMBIA

REPRESENTATIVE FOR SERVICE:

COASTAL TRADEMARK SERVICES LIMITED
1081 Cambie Street
Vancouver
BRITISH COLUMBIA V6B 5L7

TRADE-MARK (Word):

WOODPECKER

INDEX HEADINGS:

WOODPECKER

GOODS:

(1) Wood flooring, namely, solid hardwood stripes, planks, engineered hardwood flooring, laminated flooring, parquet hardwood flooring, engineered bamboo flooring. Wooden doors, window frames and wood cabinets.

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- 20 - Furniture, mirrors, articles not included in other classes
- 35 - Advertising, marketing, promotional and business
- 37 - Building construction and repair

CLAIMS:

Declaration of Use filed January 15, 2013.

ASSOCIATED MARKS:

TMA840,290

Action Information

<u>ACTION</u>	DATE	BF	COMMENTS
Filed	2011-10-04		
Created	2011-10-05		
Formalized	2011-10-07		
Note to File	2012-01-25		To amend the name of the applicant as per correspondence dated January 9, 2012.
Search Recorded	2012-04-03		
Examiner's First Report	2012-04-03	2012-10-03	
Correspondence Created	2012-04-17	2012-10-17	
Approval Notice Sent	2012-07-11	2012-08-08	Approval notice declared void on 2012/07/11
Rep for Service Changed	2012-07-11		From: To: 7206
Agent Changed	2012-07-11		From: To: 7206
Approval Notice Sent	2012-07-11	2012-08-08	
Approved	2012-08-30		APPROVED BY PROGRAM EX200M1
Extracted for Advertisement	2012-09-14		Vol.59 Issue 3021 2012/09/19
Advertised	2012-09-19		Vol.59 Issue 3021
Allowed	2013-01-04		
Allowance Notice Sent	2013-01-04	2014-10-04	
Registered	2013-01-15		
Agent Name Change	2013-01-15		
Rep for Service Name Change	2013-01-15		
Amendment to Registration	2013-03-07		Name / Voir Preuve au dossier/See evidence on File No. 1546648
Amendment to Registration	2013-06-07		Section 41.1(a) - Owner Information / Voir Preuve au dossier/See evidence on File No. 1435119
Amendment to Registration	2014-05-28		Owner Address Change / Voir Preuve au dossier/See evidence on File No. 1435119

FOOTNOTES:

CHANGE IN TITLE/CHANGEMENT EN TITRE:

TYPE OF CHANGE/GENRE DE CHANGEMENT: Name/Nom
 DATE REGISTERED/DATE DE L'ENREGISTREMENT: 07 mars/Mar 2013
 DATE OF CHANGE/DATE DE CHANGEMENT: 29 janv/Jan 2013
 COMMENTS/COMMENTAIRES: FROM: Wiston International Trade Co., Ltd
 DBA Wiston International Hardwood Co.
 TO: Wiston Building Materials Co.
 Voir Preuve au dossier/See evidence on File No. 1546648

AMENDMENT TO REGISTRATION/MODIFICATION A L'ENREGISTREMENT:

TYPE OF AMENDMENT/GENRE DE MODIFICATION: Section 41.1(a) - Owner

Information/Alinéa 41.1a) - information sur le propriétaire

DATE REGISTERED/DATE DE L'ENREGISTREMENT: 07 juin/Jun 2013

DATE OF CHANGE/DATE DE CHANGEMENT: 07 juin/Jun 2013

COMMENTS/COMMENTAIRES: Voir Preuve au dossier/See evidence on
File No. 1435119

OWNER ADDRESS CHANGE/CHANGEMENT D'ADRESSE DU PROPRIÉTAIRE:

DATE REGISTERED/DATE DE L'ENREGISTREMENT: 28 mai/May 2014

COMMENTS/COMMENTAIRES: Voir Preuve au dossier/See evidence on
File No. 1435119

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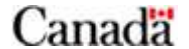
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The database was last updated on:2017-02-07

APPLICATION NUMBER:

1546648

REGISTRATION NUMBER:

TMA836079

STATUS:

REGISTERED

FILED:

2011-10-05

FORMALIZED:

2011-10-11

ADVERTISED:

2012-07-18

REGISTERED:

2012-11-08

REGISTRANT:

Wiston International Trade Co., Ltd. DBA Wiston Building Materials Co.
120-4611 Viking Way
Richmond
V6V 2K9
BRITISH COLUMBIA

TRADE-MARK (Design):



MARK DESCRIPTIVE REFERENCE:

woodpecker bird no eye design

VIENNA INFORMATION:

VIENNA INFORMATION

Code Description

3.7.13 Sparrows or other passerine birds

3.7.19 Heads of birds, parts of birds, feathers, footprints, skeletons of birds

3.7.21 Other birds

3.7.24 Birds stylized

GOODS:

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19 - Non-metallic building materials

20 - Furniture, mirrors, articles not included in other classes

CLAIMS:

Declaration of Use filed November 08, 2012.

ASSOCIATED MARKS:

TMA779,544 TMA836,081 TMA840,290

Action Information

<u>ACTION</u>	DATE	BF	COMMENTS
Filed	2011-10-05		
Created	2011-10-06		
Formalized	2011-10-11		
Note to File	2012-01-25		To amend the name of the applicant as per correspondence dated January 9, 2012.
Search Recorded	2012-04-03		
Examiner's First Report	2012-04-03	2012-10-03	
Correspondence Created	2012-04-18	2012-10-18	
Approval Notice Sent	2012-05-09	2012-06-06	
Approved	2012-06-28		APPROVED BY PROGRAM EX200M1
Extracted for Advertisement	2012-07-13		Vol.59 Issue 3012 2012/07/18
Advertised	2012-07-18		Vol.59 Issue 3012
Allowed	2012-11-02		
Allowance Notice Sent	2012-11-02	2014-10-05	
Registered	2012-11-08		
Correspondence Created	2013-02-22		
Amendment to Registration	2013-03-07		Name / Voir Preuve au dossier/See evidence on File No. 1546648
Amendment to Registration	2013-06-07		Section 41.1(a) - Owner Information / Voir Preuve au dossier/See evidence on File No. 1435119
Amendment to Registration	2014-05-28		Owner Address Change / Voir Preuve au dossier/See evidence on File No. 1435119

FOOTNOTES:**CHANGE IN TITLE/CHANGEMENT EN TITRE:**

TYPE OF CHANGE/GENRE DE CHANGEMENT: Name/Nom

DATE REGISTERED/DATE DE L'ENREGISTREMENT: 07 mars/Mar 2013

DATE OF CHANGE/DATE DE CHANGEMENT: 29 janv/Jan 2013

COMMENTS/COMMENTAIRES: FROM: Wiston International Trade Co., Ltd

DBA Wiston International Hardwood Co.
TO: Wiston Building Materials Co.
Voir Preuve au dossier/See evidence on File No. 1546648

AMENDMENT TO REGISTRATION/MODIFICATION A L'ENREGISTREMENT:

TYPE OF AMENDMENT/GENRE DE MODIFICATION: Section 41.1(a) - Owner
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DATE REGISTERED/DATE DE L'ENREGISTREMENT: 07 juin/Jun 2013
DATE OF CHANGE/DATE DE CHANGEMENT: 07 juin/Jun 2013
COMMENTS/COMMENTAIRES: Voir Preuve au dossier/See evidence on
File No. 1435119

OWNER ADDRESS CHANGE/CHANGEMENT D'ADRESSE DU PROPRIÉTAIRE:

DATE REGISTERED/DATE DE L'ENREGISTREMENT: 28 mai/May 2014
COMMENTS/COMMENTAIRES: Voir Preuve au dossier/See evidence on
File No. 1435119

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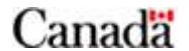
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The database was last updated on:2017-02-07

APPLICATION NUMBER:

1546471

REGISTRATION NUMBER:

TMA836081

STATUS:

REGISTERED

FILED:

2011-10-04

FORMALIZED:

2011-10-07

ADVERTISED:

2012-07-18

REGISTERED:

2012-11-08

REGISTRANT:

Wiston International Trade Co., Ltd. DBA Wiston Building Materials Co.
120-4611 Viking Way
Richmond
V6V 2K9
BRITISH COLUMBIA

TRADE-MARK (Design):



MARK DESCRIPTIVE REFERENCE:

woodpecker bird design

VIENNA INFORMATION:

VIENNA INFORMATION

Code Description

3.7.13 Sparrows or other passerine birds

3.7.19 Heads of birds, parts of birds, feathers, footprints, skeletons of birds

3.7.21 Other birds

3.7.24 Birds stylized

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CLAIMS:

Declaration of Use filed November 08, 2012.

ASSOCIATED MARKS:

TMA779,544 TMA836,079 TMA840,290

Action Information

<u>ACTION</u>	DATE	BF	COMMENTS
Filed	2011-10-04		
Created	2011-10-05		
Formalized	2011-10-07		
Note to File	2012-01-25		To amend the name of the applicant as per correspondence dated January 9, 2012.
Search Recorded	2012-04-03		
Examiner's First Report	2012-04-03	2012-10-03	
Correspondence Created	2012-04-18	2012-10-18	
Approval Notice Sent	2012-05-09	2012-06-06	
Approved	2012-06-28		APPROVED BY PROGRAM EX200M1
Extracted for Advertisement	2012-07-13		Vol.59 Issue 3012 2012/07/18
Advertised	2012-07-18		Vol.59 Issue 3012
Allowed	2012-11-02		
Allowance Notice Sent	2012-11-02	2014-10-04	
Registered	2012-11-08		
Amendment to Registration	2013-03-07		Name / Voir Preuve au dossier/See evidence on File No. 1546648
Amendment to Registration	2013-06-07		Section 41.1(a) - Owner Information / Voir Preuve au dossier/See evidence on File No. 1435119
Amendment to Registration	2014-05-28		Owner Address Change / Voir Preuve au dossier/See evidence on File No. 1435119

FOOTNOTES:**CHANGE IN TITLE/CHANGEMENT EN TITRE:**

TYPE OF CHANGE/GENRE DE CHANGEMENT: Name/Nom

DATE REGISTERED/DATE DE L'ENREGISTREMENT: 07 mars/Mar 2013

DATE OF CHANGE/DATE DE CHANGEMENT: 29 janv/Jan 2013

COMMENTS/COMMENTAIRES: FROM: Wiston International Trade Co., Ltd
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TO: Wiston Building Materials Co.

Voir Preuve au dossier/See evidence on File No. 1546648

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Information/Alinéa 41.1a) - information sur le propriétaire

DATE REGISTERED/DATE DE L'ENREGISTREMENT: 07 juin/Jun 2013

DATE OF CHANGE/DATE DE CHANGEMENT: 07 juin/Jun 2013

COMMENTS/COMMENTAIRES: Voir Preuve au dossier/See evidence on
File No. 1435119

OWNER ADDRESS CHANGE/CHANGEMENT D'ADRESSE DU PROPRIÉTAIRE:

DATE REGISTERED/DATE DE L'ENREGISTREMENT: 28 mai/May 2014

COMMENTS/COMMENTAIRES: Voir Preuve au dossier/See evidence on
File No. 1435119

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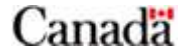
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The database was last updated on:2017-02-07

APPLICATION NUMBER:

1435119

REGISTRATION NUMBER:

TMA779544

STATUS:

REGISTERED

FILED:

2009-04-20

FORMALIZED:

2009-04-23

ADVERTISED:

2010-03-17

REGISTERED:

2010-10-12

REGISTRANT:

Wiston International Trade Co., Ltd. DBA Wiston Building Materials Co.
120-4611 Viking Way
Richmond
V6V 2K9
BRITISH COLUMBIA

TRADE-MARK (Design):



WISTON

MARK DESCRIPTIVE REFERENCE:

WISTON & design

INDEX HEADINGS:

WISTON

VIENNA INFORMATION:

VIENNA INFORMATION

Code Description

3.7.19 Heads of birds, parts of birds, feathers, footprints, skeletons of birds

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CLAIMS:

Declaration of Use filed September 08, 2010.

ASSOCIATED MARKS:

TMA836,079 TMA836,081 TMA840,290

Action Information

<u>ACTION</u>	DATE	BF	COMMENTS
Filed	2009-04-20		
Created	2009-04-21		
Formalized	2009-04-23		
Search Recorded	2009-10-14		
Examiner's First Report	2009-10-22	2010-04-22	
Correspondence Created	2009-11-30	2010-05-30	
Approval Notice Sent	2010-01-21	2010-02-18	
Approved	2010-03-11		APPROVED BY PROGRAM EX200M1
Extracted for Advertisement	2010-03-12		Vol.57 Issue 2890 2010/03/17
Advertised	2010-03-17		Vol.57 Issue 2890
Allowed	2010-07-02		
Allowance Notice Sent	2010-07-02	2012-04-20	
Registered	2010-10-12		
Amendment to Registration	2011-03-01		Owner Address Change / Voir Preuve au dossier/See evidence on File No. 1435119
Amendment to Registration	2013-03-07		Name / Voir Preuve au dossier/See evidence on File No. 1546648
Amendment to Registration	2013-06-07		Section 41.1(a) - Owner Information / Voir Preuve au dossier/See evidence on File No. 1435119
Amendment to Registration	2014-05-28		Owner Address Change / Voir Preuve au dossier/See evidence on File No. 1435119

FOOTNOTES:***OWNER ADDRESS CHANGE/CHANGEMENT D'ADRESSE DU PROPRIÉTAIRE:***

DATE REGISTERED/DATE DE L'ENREGISTREMENT: 01 mars/Mar 2011

COMMENTS/COMMENTAIRES: Voir Preuve au dossier/See evidence on

File No. 1435119

CHANGE IN TITLE/CHANGEMENT EN TITRE:

TYPE OF CHANGE/GENRE DE CHANGEMENT: Name/Nom

DATE REGISTERED/DATE DE L'ENREGISTREMENT: 07 mars/Mar 2013

DATE OF CHANGE/DATE DE CHANGEMENT: 29 janv/Jan 2013

COMMENTS/COMMENTAIRES: FROM: WISTON INTERNATIONAL TRADE CO., LTD.

TO: Wiston Building Materials Co.

Voir Preuve au dossier/See evidence on File No. 1546648

AMENDMENT TO REGISTRATION/MODIFICATION A L'ENREGISTREMENT:

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DATE OF CHANGE/DATE DE CHANGEMENT: 07 juin/Jun 2013

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File No. 1435119

OWNER ADDRESS CHANGE/CHANGEMENT D'ADRESSE DU PROPRIÉTAIRE:

DATE REGISTERED/DATE DE L'ENREGISTREMENT: 28 mai/May 2014

COMMENTS/COMMENTAIRES: Voir Preuve au dossier/See evidence on

File No. 1435119

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Last updated: 2017-02-07

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

Woodpecker Flooring Inc.)
)
 Petitioner,)
)
 v.)
)
 Wiston International Trade Co., Ltd.)
)
 Registrant.)
_____)

Cancellation No. 92,065,095
Registration No.: 4,876,546
Mark:



Trademark Trial and Appeal Board
Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451
U.S.A.

ANSWER

Registrant Wiston International Trade Co., Ltd. (“Registrant”), through counsel, hereby answers the Petitioner Woodpecker Flooring Inc.’s (“Petitioner”) Petition to Cancel U.S. Trademark Registration No. 4,876,546 as follows.

Registrant denies that Petitioner is and/or will be damaged by the registration of the mark shown in U.S. Trademark Registration No. 4,876,546, which consists of the stylized word “WOODPECKER” with a stylized woodpecker design appearing above these words, (the “WOODPECKER & DESIGN Registration”) as follows:

1. Regarding Paragraph 1, Registrant admits that U.S. Trademark Application Serial No. 87/178971 was filed on September 21, 2016 for the word “Woodpecker” in connection with the goods “engineered hardwood flooring; hard wood flooring; wooden flooring” (the “Petitioner’s WOODPECKER Application”) and denies all other allegations of Paragraph 1.
2. Regarding Paragraph 2, Registrant admits that the United States Patent and Trademark Office (the “USPTO”) refused registration of the applied-for mark in the Petitioner’s

WOODPECKER Application on October 26, 2016 because of a likelihood of confusion with the WOODPECKER & Design Registration and denies all other allegations of Paragraph 2.

3. Regarding Paragraph 3, Registrant admits that the USPTO registered the WOODPECKER & Design Registration on December 29, 2015 and denies all other allegations of Paragraph 3.
4. Regarding Paragraph 4, Registrant admits that it has not assigned the WOODPECKER & Design Registration to any third parties and denies all other allegations of Paragraph 4.
5. Registrant incorporates each of the foregoing numbered and unnumbered paragraphs responses of this Answer as if fully restated here and denies each and every allegation of Paragraph 5.
6. Registrant denies each and every allegation of Paragraph 6.
7. Registrant denies each and every allegation of Paragraph 7.
8. Registrant denies each and every allegation of Paragraph 8.
9. Registrant denies each and every allegation of Paragraph 9.
10. Registrant denies each and every allegation of Paragraph 10.
11. Registrant denies each and every allegation of Paragraph 11.
12. Paragraph 12 calls for a legal conclusion to which no response is required. To the extent any response is required, Registrant denies each and every allegation of Paragraph 12.
13. Registrant incorporates each of the foregoing numbered and unnumbered paragraphs responses of this Answer as if fully restated here and denies each and every allegation of Paragraph 13.
14. Registrant denies each and every allegation of Paragraph 14.
15. Paragraph 15 calls for a legal conclusion to which no response is required. To the extent any response is required, Registrant denies each and every allegation of Paragraph 15.

16. Registrant denies each and every allegation of Paragraph 16.
17. Paragraph 17 calls for a legal conclusion to which no response is required. To the extent any response is required, Registrant denies each and every allegation of Paragraph 17.
18. Paragraph 18 calls for a legal conclusion to which no response is required. To the extent any response is required, Registrant denies each and every allegation of Paragraph 18.
19. Paragraph 19 calls for a legal conclusion to which no response is required. To the extent any response is required, Registrant denies each and every allegation of Paragraph 19.
20. Regarding Paragraph 20, Registrant admits that on or about September 13, 2013, the Supreme Court of British Columbia in Vancouver, British Columbia, Canada, ordered the Registrant to refrain from engaging in the following conduct within British Columbia, Canada:
- (a) passing off or attempting to pass off or causing, enabling, or assisting others to pass off or to attempt to pass off their wares and services as and for the wares and services of the Plaintiff through the use of the name Woodpecker; and
 - (b) directing public attention to their wares and services in such a way as to cause or to be likely to cause confusion between their wares and services and the wares and services of the Plaintiff through the use of the name Woodpecker;
- and that it did not notify the USPTO of this order. Respondent denies all other allegations of Paragraph 20.
21. Regarding Paragraph 21, the second sentence calls for a legal conclusion to which no response is required. To the extent any response is required, Registrant admits that on or about September 26, 2013, it filed a Petition to Revive Abandoned Application and stated, among other things, that it "...has a continued bona fide intention, and is entitled, to use the mark in commerce on or in connection with all of the goods/services listed in the Notice of Allowance or as subsequently modified for..." international classes 019, 020, 035, 037 and denies all other allegations of Paragraph 21.

22. Regarding Paragraph 22, the fourth sentence calls for a legal conclusion to which no response is required. To the extent any response is required, Registrant admits that on or about February 26, 2014, September 2, 2014, and February 25, 2015, it filed Requests for Extensions of Time to File a Statement of Use and in which, it stated among other things that it "...has a continued bona fide intention, and is entitled, to use the mark in commerce on or in connection with all of the goods/services listed in the Notice of Allowance or as subsequently modified for..." international classes 019, 020, 035, 037 and denies all other allegations of Paragraph 22.

23. Regarding Paragraph 23, the fourth sentence calls for a legal conclusion to which no response is required. To the extent any response is required, Registrant admits that on or about August 12, 2015, it filed a Petition to Amend Basis Post-Publication, in which it stated as follows:

The application is currently based on §1(b), intent to use. The Applicant requests that the application be amended to include a §44(e) basis. The Applicant requests that the §1(b) basis be deleted. The Applicant herein submits a PDF copy of a registration in the Applicant's country of origin (i.e., Canada) showing that the mark has been registered in Canada, and that the registration is in full force and effect. The corresponding Canadian registration is Canada trademark registration no. TMA840290 registered on January 15, 2013, with a renewal date of January 15, 2028 and an expiration date of January, 2028.

Respondent denies all other allegations of Paragraph 23.

24. Paragraph 24 calls for a legal conclusion to which no response is required. To the extent any response is required, Registrant denies each and every allegation of Paragraph 24.

25. Paragraph 24 calls for a legal conclusion to which no response is required. To the extent any response is required, Registrant denies each and every allegation of Paragraph 25.

26. Paragraph 24 calls for a legal conclusion to which no response is required. To the extent any response is required, Registrant denies each and every allegation of Paragraph 26.

27. Paragraph 27 calls for a legal conclusion to which no response is required. To the extent any response is required, Registrant denies each and every allegation of Paragraph 27.

28. Paragraph 28 calls for a legal conclusion to which no response is required. To the extent any response is required, Registrant denies each and every allegation of Paragraph 28.

29. Paragraph 29 calls for a legal conclusion to which no response is required. To the extent any response is required, Registrant denies each and every allegation of Paragraph 29.

30. Paragraph 30 calls for a legal conclusion to which no response is required. To the extent any response is required, Registrant denies each and every allegation of Paragraph 30.

All allegations in the Petition to Cancel whether explicit or implicit that require an answer are denied to the extent that those allegations are not expressly and specifically admitted in this Answer.

AFFIRMATIVE DEFENSES

FIRST AFFIRMATIVE DEFENSE

(LACHES)


Petitioner's claims are barred, in whole or in part, by the doctrine of laches. Specifically, upon information and belief, Petitioner has unreasonably delayed in asserting any claimed rights against Registrant causing material prejudice due to that delay, including Petitioner's failure to oppose Registrant's WOODPECKER & Design Registration when it was published for opposition on October 13, 2015.

SECOND AFFIRMATIVE DEFENSE

(ACQUIESCENCE)

Petitioner's claims are barred, in whole or in part, by the doctrine of acquiescence.


Registrant is also the owner of U.S. Trademark Registration No. 4,996,815 for a WOODPECKER-based mark (the "WOODPECKER-Based Registration), as follows:


Trademark	Class/Description of Goods and Services	Filing Date	Registration Date
	<p>Class 19: Wood flooring, namely, solid hardwood stripes, planks, engineered hardwood flooring, laminated flooring, parquet hardwood flooring, engineered bamboo flooring</p> <p>Class 35: Wholesale and retail store services featuring flooring materials</p> <p>Class 37: Installation and maintenance of wood flooring materials</p>	November 5, 2015	July 12, 2016



Upon information and belief, Petitioner's actions establish its assent to Registrant's WOODPECKER & Design Registration and the WOODPECKER-Based Registration.

Upon information and belief these actions include Petitioner's consent to Registrant's registration of its pre-existing WOODPECKER & Design Registration and WOODPECKER-Based Registration, which furthered Registrant's activities in connection with the Registrant's WOODPECKER & Design Registration and the WOODPECKER-Based Registration.

Registrant is also the owner of the following Canadian Trademark registrations:

Mark	Registration No.	Description of Goods and Services	Filing Date	Registration Date
	TMA840290	<p>Wood flooring, namely, solid hardwood stripes, planks, engineered hardwood flooring, laminated flooring, parquet hardwood flooring, engineered bamboo flooring. Wooden doors, window frames and wood cabinets.</p> <p>Wholesale and retail store services</p>	October 4, 2011	January 15, 2013

		dealing with the sale of flooring materials, doors, window frames, furniture, and the installation and maintenance of flooring materials, doors, window frames, furniture.		
WOODPECKER	TMA840289	Wood flooring, namely, solid hardwood stripes, planks, engineered hardwood flooring, laminated flooring, parquet hardwood flooring, engineered bamboo flooring. Wooden doors, window frames and wood cabinets. Wholesale and retail store services dealing with the sale of flooring materials, doors, window frames, furniture, and the installation and maintenance of flooring materials, doors, window frames, furniture.	October 4, 2011	January 15, 2013
	TMA836079	Wood flooring, namely, solid hardwood stripes, planks, engineered hardwood flooring, laminated flooring, parquet hardwood flooring, engineered bamboo flooring. Wooden doors, window frames and wood cabinet.	October 5, 2011	November 8, 2012

	TMA836081	Wood flooring, namely, solid hardwood stripes, planks, engineered hardwood flooring, laminated flooring, parquet hardwood flooring, engineered bamboo flooring. Wooden doors, window frames and wood cabinet.	October 4, 2011	November 8, 2012
	TMA779544	Wood flooring, namely, solid hardwood stripes, planks, engineered hardwood flooring, laminated flooring, parquet hardwood flooring, engineered bamboo flooring. Wholesale and retail store services dealing with the sale of flooring materials and the installation and maintenance of flooring materials.	April 20, 2009	October 12, 2010

(the “Canadian Registrations”). Copies of the Canadian Registrations are attached as Exhibit A.

Upon information and belief, Petitioner has also failed to object to or challenge registration of Registrant’s Canadian Registrations.

Petitioner has failed to adequately protect the WOODPECKER mark that it is now claiming will be damaged should Registrant’s WOODPECKER & Design Registration remain registered.

These Answers and Affirmative Defenses are based on the knowledge and information currently available to Registrant, and Registrant reserves the right to seek amendment of these

answers or affirmative defenses pursuant to Federal Rule of Civil Procedure 15 and any other applicable rule, statute or case law, based on facts later discovered, plead, or offered.

WHEREFORE, Registrant respectfully requests that the Board:

- (a) dismiss and/or deny this Petition to Cancel in its entirety and with prejudice;
- (b) enter a judgment in favor of Registrant; and
- (c) award any further relief that the Board may deem just and proper.

Respectfully submitted,
ASCENDION LAW

Date: February 14, 2017

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CERTIFICATE OF SERVICE

On February 14, 2017, I filed the Registrant's ANSWER electronically and served a true copy of it on Petitioner's counsel via overnight mail by delivering a true copy of this motion to an overnight courier, pursuant to 37 CFR § 2.119(b)(5) and (c) to:

Erik Dykema
105 Grove Street
Suite 16-3
Montclair, New Jersey 07042
USA

Date: February 14, 2015

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