

ESTTA Tracking number: **ESTTA1076872**

Filing date: **08/21/2020**

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

Proceeding	92074713
Party	Defendant Asmodee North America, Inc.
Correspondence Address	ASMODEE NORTH AMERICA, INC. LEGAL DEPARTMENT 1995 WEST COUNTY ROAD B2 ROSEVILLE, MN 55113 UNITED STATES Primary Email: legal@asmodeena.com 651-639-1905
Submission	Answer
Filer's Name	Eugene Bely
Filer's email	officeactions@azoralaw.com
Signature	/EB/
Date	08/21/2020
Attachments	Answer to Cancellation 08.21.20.pdf(91589 bytes)

1
2 **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
3 **BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

4 _____)
Orda USA, Inc.,) Proceeding No. 92074713
5 Petitioner,)
6 v.)
Asmodee North America, Inc.,) Mark: **SMALL WORLD**
7 Registrant.) Serial No. 87697401
8 _____)
9

10 **ANSWER AND AFFIRMATIVE DEFENSES OF ASMODEE NORTH AMERICA, INC.**

11
12 Registrant Asmodee North America, Inc. (“**Asmodee**”), by and through its attorneys,
13 hereby answers the Cancellation Petition (the “**Cancellation**”) filed by Orda USA, Inc.
14 (“**Petitioner**”) as follows. To the extent not explicitly admitted, all allegations in the
Cancellation are denied.

15
16 **ANSWER**

- 17 1. Asmodee lacks knowledge or information sufficient to form a belief as to the truth of the
18 matters alleged in Paragraph 1 and, on that basis, denies them.
- 19 2. Asmodee lacks knowledge or information sufficient to form a belief as to the truth of the
20 inadvertence of the abandonment alleged in Paragraph 2 and, on that basis, denies it.
21 Asmodee admits that the owner of the SMALL WORLD TOYS marks U.S. Reg. Nos.
22 1268062 and 1383504 abandoned those marks. Asmodee denies all remaining allegations
23 and legal conclusions in Paragraph 2.
- 24 3. Asmodee admits only that the owner of the SMALL WORLD TOYS marks U.S. Reg.
25 Nos. 1268062 and 1383504 used those marks in connection with toys. Asmodee denies
all remaining allegations and legal conclusions in Paragraph 3.

- 1
- 2 4. Asmodee admits the allegations in Paragraph 4.
- 3 5. Asmodee admits that it alleges August 01, 2012 as the date of first use of the subject
4 registration, U.S. Reg. No. 5464697 SMALL WORLD.
- 5 6. Paragraph 6 sets forth legal conclusions and questions of law to which no response is
6 necessary. To the extent a response is necessary, Asmodee denies the allegations, legal
7 conclusions, and assumptions in Paragraph 6.
- 8 7. Paragraph 7 sets forth legal conclusions and questions of law to which no response is
9 necessary. To the extent a response is necessary, Asmodee denies the allegations, legal
10 conclusions, and assumptions in Paragraph 7.
- 11 8. Paragraph 8 sets forth legal conclusions and questions of law to which no response is
12 necessary. To the extent a response is necessary, Asmodee denies the allegations and
13 legal conclusions in Paragraph 8.
- 14 9. Paragraph 9 sets forth legal conclusions and questions of law to which no response is
15 necessary. To the extent a response is necessary, Asmodee denies the allegations and
16 legal conclusions in Paragraph 9.

17 **AFFIRMATIVE DEFENSES**

18 Asmodee undertakes the burden of proof only as to those defenses deemed affirmative
19 defenses by law, regardless of how such defenses are denominated below. Asmodee expressly
20 reserves the right to plead additional affirmative and other defenses should any such defenses be
21 revealed by discovery in this case. As and for its affirmative and other defenses, Asmodee states
22 as follows:

23 **First Affirmative Defense**

24 Petitioner has no standing to properly assert a claim or maintain the proceeding.
25

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25

Second Affirmative Defense

Petitioner has alleged insufficient grounds to properly assert a claim or maintain the proceeding.

Third Affirmative Defense

The Cancellation fails to state a claim upon which relief can be granted.

Fourth Affirmative Defense

Asmodee alleges on information and belief that as a result of Petitioner’s own acts or omissions, the Cancellation is barred by the doctrine of laches.

Fifth Affirmative Defense

Asmodee alleges on information and belief that the Cancellation is barred by the doctrine of estoppel.

Sixth Affirmative Defense

Asmodee alleges on information and belief that as a result of Petitioner’s own acts or omissions, Petitioner has waived any right to pursue the Cancellation.

Seventh Affirmative Defense

Asmodee alleges on information and belief that the Cancellation is barred by the doctrine of acquiescence.

Eighth Affirmative Defense

Asmodee alleges on information and belief that the Cancellation is barred by the doctrine of unclean hands.

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25

Ninth Affirmative Defense

Asmodee alleges on information and belief that there exists no likelihood of confusion between Asmodee’s SMALL WORLD mark and Petitioner’s SMALL WORLD TOYS mark. In the alternative, Asmodee has senior rights in its mark and Petitioner is therefore infringing Asmodee’s mark.

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25

PRAYER FOR RELIEF

WHEREFORE, Asmodee requests that the Cancellation Petition be dismissed with prejudice, together with whatever other relief the Board may deem appropriate.

CERTIFICATE OF SERVICE

WHEREFORE, a copy of the forgoing Answer and Affirmative defenses was duly served on Petitioner on August 21, 2020 by email to Petitioner’s counsel at the following email addresses:

bnatter@haugpartners.com
jsblendorio@haugpartners.com
docket@haugpartners.com

Dated: August 21, 2020

Respectfully submitted,



Eugene V. Bely
Azora Law
15600 NE 8th St., Ste B1-178
Bellevue, WA 98008
Tel.: 206-291-4336
ebely@azoralaw.com
Attorneys for Petitioner