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

Proceeding	92075957
Party	Defendant emoji company GmbH
Correspondence Address	EMOJI COMPANY GMBH NECKLENBROICHER STRASSE 52-54 MEERBUSCH, 40667 GERMANY No email provided. No phone number provided.
Submission	Answer
Filer's Name	Marijan Stephan Hucke
Filer's email	e.sal@huckelaw.com, m.hucke@huckelaw.com
Signature	/MARIJAN HUCKE/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Mattel, Inc.,

Petitioner,

v.

Cancellation No.: 92075957

emoji company GmbH,

Registrant.

Trademark Trial and Appeal Board

U.S. Patent and Trademark Office

P.O. Box 1451

Alexandria, VA 22313-1451

REGISTRANT’S ANSWER TO PETITION FOR CANCELLATION

Registrant, emoji company GmbH, by and through counsel, hereby responds to the “Petition to Cancellation” (the “Petition”) filed by Petitioner, Mattel Inc. For convenience, the language of each specific numbered paragraph in the Petition is followed by Registrant’s response. Unless specifically admitted, Registrant denies each of the allegations in Petitioner’s Petition. Registrant admits, denies and alleges as follows:

In response to the introductory unnumbered paragraph, emoji company (“Registrant”) is without information sufficient to form a belief to the truth of the Petitioner’s principal place of business and therefore denies the same, and leaves Petitioner to its proofs.

Registrant denies that Petitioner is damaged by the trademark shown in Reg. No. 4,868,832 of EMOJI in Classes 3, 16, 17, 18, 21, 22, 25, 26, 27, 29, 30 and 32 (the “Registration”).

1. In response to the contentions of Paragraph 1 of the Petition, Registrant states that it does not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly denies the allegations.

2. In response to the contentions of Paragraph 2 of the Petition, Serial No. 87/005,050 for “UNO EMOJI” in Classes 28 purports to have been filed by Petitioner (“Petitioner’s Application”), and Petitioner’s Application, including its history of prosecution in the

USPTO is a document that speaks for itself and for which no responsive pleading is required. All other averments of Paragraph 2 of the Petition are denied.

3. In response to the contentions of Paragraph 3 of the Petition, Registrant states that the file history of Petitioner's Application is a document that speaks for itself and for which no responsive pleading is required. All other averments of Paragraph 3 of the Petition are denied.

4. In response to the contentions of Paragraph 4 of the Petition, Registrant states that the file history of Petitioner's Application is a document that speaks for itself and for which no responsive pleading is required. All other averments of Paragraph 4 of the Petition are denied.

5. Admitted.

6. In response to the contentions of Paragraph 6 of the Petition, Registrant states that Exhibit "A" of the Petition is a copy of the letter Registrant sent to Mattel on or around May 29, 2020. The document speaks for itself, for which no responsive pleading is required. To the extent that Paragraph 6 of the Petition states facts that are relevant to this proceeding and are deemed to require a response, Registrant denies that the letter cites the trademark shown in Reg. No. 4,766,492 of EMOJI in Classes 27 and 41 (the "Registration") and therefore denies the same, and leaves Petitioner to its proofs.

7. Registrant's admits having filed opposition against Petitioner's application to register UNO EMOJI, the opposition number being 91264338.

8. The responses to Paragraphs 1-7 to the Petition are hereby incorporated and realleged as though fully set forth and repeated herein.

9. Denied.

10. Denied.

11. Denied.

12. The responses to Paragraphs 1-11 to the Petition are hereby incorporated and realleged as though fully set forth and repeated herein.

13. Denied.

14. Paragraph 14 of the Petition states a legal conclusion for which no responsive pleading is required. To the extent that any responsive pleading is deemed to be required, Registrant

denies the averments of Paragraph 14 of the Petition and leaves the Petitioner to its proofs. In response to the contentions of Paragraph 14 of the Petition that relate to twenty-five trademarks containing the word EMOJI that are not owned by Registrant, Registrant states that it does not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly denies the allegations.

15. Paragraph 15 of the Petition states a legal conclusion for which no responsive pleading is required. To the extent that any responsive pleading is deemed to be required, Registrant denies the averments of Paragraph 15 of the Petition and leaves the Petitioner to its proofs.

16. The responses to Paragraphs 1-15 to the Petition are hereby incorporated and realleged as though fully set forth and repeated herein.

17. Paragraph 17 of the Petition states a legal conclusion for which no responsive pleading is required. To the extent that any responsive pleading is deemed to be required, Registrant denies the averments of Paragraph 17 of the Petition and leaves the Petitioner to its proofs.

18. Paragraph 18 of the Petition states a legal conclusion for which no responsive pleading is required. To the extent that any responsive pleading is deemed to be required, Registrant denies the averments of Paragraph 18 of the Petition and leaves the Petitioner to its proofs.

19. The responses to Paragraphs 1-18 to the Petition are hereby incorporated and realleged as though fully set forth and repeated herein.

20. Denied

21. Denied.

22. In response to paragraph 22 of the Petition, Registrant denies that Petitioner is damaged by the continued registration of the mark shown in the Registration, Registrant denies that the Registration has been abandoned, fails to function as a trademark, and/or is descriptive and Registrant denies that it did not have the requisite bona fide intent to use the mark in the United States at the time of filing or any relevant time thereafter. Registrant moves to strike the contentions of the second sentence of Paragraph 22 of the Petition as being irrelevant to any issue that is properly before the U.S. Trademark Trial and Appeal Board. To the extent that Paragraph 22 of the Petition states facts that are relevant to this proceeding and are deemed to require a response, Registrant denies the same and leaves Petitioner to its proofs.

23. In response to paragraph 23 of the Petition, Registrant denies that the Petition should be sustained, and denies that the Registrations should be cancelled.

DEFENSES

In further answer to the Petition for Cancellation, Registrant asserts as separate and affirmative defenses that:

1. The Petition for Cancellation and each paragraph thereof, taken either individually or collectively, fails to support a basis for the relief sought.
2. The Petition for Cancellation fails to state a cause of action upon which relief may be granted in law or equity.
3. Petitioner lacks standing to seek cancellation of the Registrations, or any of them, in that Petitioner is not likely to be damaged or injured by Registrant's use or registration of the marks in the Registrations.
4. Petitioner cannot merit cancellation of the Registration because Petitioner has not sufficiently used any mark that is the subject of the Registration, in United States commerce in connection with Petitioner's goods so as to establish exclusive rights therein.
5. Petitioner's unclean hands prevent it from being held to be the prior user of the marks of the Registration, because Petitioner has not engaged in the *bona fide* use of those marks or confusingly similar marks in the ordinary course of business so as to fairly assert recognizable prior rights to those marks in connection with the same or similar goods as are specified in the Registrations.
6. Petitioner is estopped from asserting that the mark of the Registration, when used in connection with Registrant's goods creates a likelihood of confusion with respect to Petitioner's use of the mark in the Registration either alone or in combination with other terms.
7. Petitioner's contentions in the Petition are or may be barred by waiver and/or acquiescence.
8. Registrant reserves the right to plead any appropriate counterclaims and additional affirmative defenses and to supplement those claims and defenses asserted herein upon discovery of further information and investigation into the Petitioner's claims.

WHEREFORE, Registrant respectfully requests that this Honorable Board:

- (i) dismiss the Petition with prejudice; and
- (ii) afford such other relief as the Board deems appropriate.

This Answer to Petition for Cancellation is being filed electronically.

Dated: January 25, 2021

Respectfully submitted,

HUCKE & SCHUBERT

BY: /MARIJAN HUCKE/
ATTORNEY FOR REGISTRANT

Marijan Stephan Hucke,
1732 1st Ave Ste 27500,
10128 New York, NY,
Tel.: 646-396-0410
Fax.: 646-396-0411
Email: m.hucke@huckelaw.com

Certificate of E-filing

I hereby certify that a true and complete copy of the foregoing **ANSWER TO PETITION FOR CANCELLATION** is being transmitted electronically to Commissioner of Trademarks, Attn: Trademark Trial and Appeal Board through ESTTA pursuant to 37 C.F.R. §2.195(a), on this January 25, 2021.

/Marijan Hucke/
Marijan Hucke

Certificate of Service

I hereby certify that a true and complete copy of the foregoing **ANSWER TO PETITION FOR CANCELLATION** has been served on Paul A. Bost by forwarding said copy on January 25, 2021, via email to pbost@sheppardmullin.com:

PAUL BOST
SHEPPARD MULLIN RICHTER & HAMPTON LLP
1901 AVENUE OF THE STARS, SUITE 1600
LOS ANGELES, CA 90067
UNITED STATES
Email: pbost@sheppardmullin.com

Signature:

Date: January 25, 2021

/Marijan Hucke/

Marijan Hucke

Attorney for Registrant