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

| | |
|------------------------|---|
| Proceeding | 91231418 |
| Party | Defendant Wayne Small |
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| Date | 12/09/2016 |
| Attachments | Answer 120916.pdf(160601 bytes) |

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

DIESEL S.P.A.,

Opposer,

v.

**Opposition No. 91231418
Application No. 86926512**

WAYNE SMALL,

Applicant.

_____/

**ANSWER AND AFFIRMATIVE DEFENSES TO
NOTICE OF OPPOSITION**

COMES NOW, Applicant, Wayne Small, (hereinafter “Applicant” or “Small”), by and through his undersigned attorneys and pursuant to 37 CFR §2.106(b)(1) serves the instant Answer and Affirmative Defenses to Opposer, Diesel S.p.A.’s, (hereinafter “Opposer” or “Diesel”) Opposition to the registration of U.S. Serial No. 886926512 for and states:

1. Admitted.
2. Without knowledge, and therefore denied.
3. Admitted that Exhibit A speaks for itself and that the USPTO database indicates that Diesel owns the Marks identified in Exhibit A. Without knowledge, however, as to the authenticity of Exhibit A, and therefore denied. All other allegations contained in paragraph three (3) are without knowledge and therefore denied.
4. Without knowledge, and therefore denied.
5. Admitted.
6. Admitted.

COUNT 1- LIKELIHOOD OF CONFUSION

7. Denied.
8. Denied.
9. Denied.
10. Without knowledge as to Opposer's beliefs, and therefore Denied.

COUNT 2 - DILUTION

11. Applicant, Small, hereby restates and realleges his responses to the allegations of paragraphs 1 through 10, and hereby incorporates same as if fully set forth herein.

12. Without knowledge, and therefore Denied.
13. Denied.
14. Denied.
15. Denied.

AFFIRMATIVE DEFENSES

1. Opposer has failed to state a claim upon which relief can be granted, and in particular, fails to state legally sufficient grounds for sustaining the opposition.
2. Opposer's Notice of Opposition is barred because there can be no likelihood of confusion in the marketplace when Applicant's DON'T BE A GASHOLE DRIVE A DIESEL mark is clearly referencing diesel engines and not Diesel-branded jeans such that no consumer would be confused into thinking that Applicant or its products are in any way approved, endorsed or associated with Opposer.
3. Opposer's claim is precluded because Opposer has suffered no injury nor is there a likelihood of injury.

4. Opposer's claim is precluded by the Doctrine of Unclean Hands and Misuse of Trademark. Specifically, Opposer is the epitome of a "trademark bully" in that Opposer has filed over 100 trademark Opposition and/or Cancellation Proceedings against any person/entity that attempts to file any mark with the word DIESEL in it despite the fact that: (1) diesel is a common term found in the dictionary identifying "a machine or vehicle powered by a diesel engine"¹ such that Opposer does not have exclusive rights to the term "diesel"; and, (2) the large majority of the trademark applications Opposer has opposed are not likely to cause confusion with Opposer's marks.

5. Opposer's claim is precluded under the anti-dissection rule because the DON'T BE A GASHOLE DRIVE A DIESEL mark as a whole is unlikely to cause confusion, mistake, or to deceive as to origin, sponsorship, or association with that of Opposer. Accordingly, the use and registration of the mark will not damage Opposer and will not cause dilution of Opposer's marks.

6. Opposer's claim is precluded due to waiver and acquiescence in that Opposer has allowed other diesel marks clearly related to diesel engines based on the Registrant's logo to proceed to registration in Class 025, namely:

- a. - Registration No. 4,222,627:



- b. Registration No. 4,513,915 :

¹ See Dictionary.Com definition of "diesel", 2016.



c. Registration No. 4,746,238:



7. Opposer's claim is precluded because no dilution by blurring has occurred, or is likely to occur, by the registration or commercial use of Applicant's mark for at least the following reasons: 1) Applicant's mark and Opposer's marks are dissimilar; 2) Applicant did not intend to create an association with Opposer's marks; 3) Opposer is not engaging in substantially exclusive use of the mark (see, for example, ¶6 herein); and, 4) no actual confusion between Applicant's mark and Opposer's marks has occurred or is likely to occur.

8. Opposer's claim is precluded because no dilution by tarnishing has occurred, or is likely to occur, by the registration or commercial use of Applicant's mark because: 1) Applicant's mark is dissimilar from Opposer's marks, and therefore no association between the marks has occurred or is likely to occur; and, 2) the reputation of Opposer's mark would not be harmed by Applicant's mark.

DATED this 9th day of December, 2016.

Respectfully Submitted,

BEUSSE WOLTER SANKS & MAIRE, PLLC

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