

ESTTA Tracking number: **ESTTA391956**

Filing date: **02/07/2011**

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

Proceeding	92053383
Party	Defendant Heather Daniels
Correspondence Address	HEATHER DANIELS 22682 BRIDLE TRAIL KILDEER, IL 60047 UNITED STATES
Submission	Motion to Amend/Amended Answer or Counterclaim
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Date	02/07/2011
Attachments	Amended Answer.pdf (9 pages)(341689 bytes)

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

SPENCER GIFTS, LLC

Petitioner,

v.

Cancellation No. 92053383

Registration No. 3,888,346

HEATHER DANIELS,

Respondent.

AMENDED ANSWER

Honorable Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

HEATHER DANIELS (“Daniels”), by and through her attorneys, Foley & Lardner LLP, respond to Petition for Cancellation by Spencer Gifts, LLC (“Spencer”) as follows:

1. Heather Daniels (“Daniels”) has secured Supplemental Register Registration No. 3,888, 346 for SORRY BOYS MY DADDY SAYS I CAN’T DATE ‘TILL I’M 30 as a trademark for shirts for infants, babies, toddlers and children as set forth in said certificate of registration (“the Registration”).

ANSWER: Daniels admits that it owns Supplemental Register Registration No. 3,888,346 for a trademark (“Registered Trademark”). Daniels further admits that her Registered Trademark is registered for shirts for infants, babies, toddlers and children. Daniels denies the remaining allegations of paragraph 1.

2. Spencer is and has for many years been engaged in the distribution and sale of novelty items and gifts, including t-shirts and hats and sweatshirts with humorous slogans and parodies and common catch phrases having then-current popularity.

ANSWER: Daniels is without knowledge sufficient to admit or deny the allegations of paragraph 2.

3. Spencer has offered for sale and sold the item depicted in Attachment A.

ANSWER: Daniels is without sufficient knowledge as to which item in Attachment A is referred to in paragraph 3; therefore Daniels denies allegations of paragraph 3.

4. Daniels has objected to Spencer's sale of the t-shirts with the ornamental slogan on the item, namely: "Sorry Boys My Daddy Says I Can't Date 'Till I'm 30" alleging such use is an infringement of its rights.

ANSWER: Denied.

5. This slogan, and other similar slogans, are commonly used by Spencer's vendor and Daniels and others to convey a non-trademark message in connection with the same and closely related products.

ANSWER: Denied.

6. As such, Daniels knowingly made material false statements concerning the nature of her rights in the alleged mark and the use by others of identical and similar slogans in prosecution of the Registration and, upon information and belief, such statements were made with the intent to deceive the Trademark Office in order to secure the Registration.

ANSWER: Denied.

7. Specifically, Daniels averred in her application that "no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive."

ANSWER: Daniels admits that in the application which led to its Registered Trademark,

Daniels submitted a declaration which included the following statement:

"he/she believes Application to be the owner of the mark sought to be registered, or if the application is being filed under 15 U.S.C. § 1051(b) or 15 U.S.C. § 1126, he/she believe Applicant to be entitled to use such mark in commerce, to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true."

Daniels denies the remaining averments of paragraph 7.

8. Daniels' declaration is false and was false when made. The slogan that is the subject of the Registration did not originate with Daniels. T-shirts bearing identical or nearly identical slogans appear to have been available prior to the date of Daniels' application and her claimed date of first use. See the items depicted in Attachment B which are exemplary.

ANSWER: Denied.

9. Similar slogans employing the "Sorry Boys..." formula or other similar formulas are and have been commonly used in a gag sense to decorate t-shirts and other novelty items. See the items depicted in Attachment C which are exemplary.

ANSWER: Daniels is without knowledge sufficient to admit or deny the allegations of paragraph 9.

10. Daniels also knowingly made material false misrepresentations in support of her petition to make the application special when she argued the petition to make special was imperative because her company Urban Bratz LLC was "in litigation with Spencer gifts LLC for copyright and trademark infringement."

ANSWER: Denied.

11. This statement is also false. The proceeding Daniels referenced is *Heather Daniels, et al. v. Spencer Gifts, LLC, et al.*, Case No. 10-cv-5345 (RGW) currently pending in the United States District Court for the Northern District of Illinois. Daniels' complaint contained a count for copyright infringement and one single count for False Designation of Origin under Section 43(a) of the Lanham Act. Daniels' complaint centers on an alleged copyright infringement of a slogan design, referring only to Daniel's "copyrighted work" or "copyrighted materials." The slogan design is the same as is shown on the specimen attached to the Registration. The complaint contained no claim of trademark rights in Daniels' alleged mark. It contained no claim against Spencer for trademark infringement of the alleged mark. See attached as Attachment D, the complaint filed by Daniels in the above referenced proceeding ("the Federal Complaint").

ANSWER: Denied.

12. Upon information and belief, Daniels submitted her trademark application in a belated effort to claim trademark rights where no such rights exist, and only after Spencer moved to dismiss the count of False Designation for failure to state a claim pursuant to *Dastar Corp. v. Twentieth Century Fox Corp.*, 523 U.S. 23 (2003). All of her efforts were conducted with the intent to deceive the Trademark Office.

ANSWER: Denied.

13. Based on the aforementioned acts, Daniels has committed fraud in the procurement of the Registration, and the Registration should accordingly be cancelled.

ANSWER: Denied.

14. Even if Daniels' actions in obtaining the Registration were not fraudulent, the alleged mark which is the subject of the Registration is incapable of distinguishing Daniels' goods from the like goods of others, including Spencer, so that the Registration should be cancelled.

ANSWER: Denied.

15. The slogan claimed as a mark by Daniels is one of a number of common slogans employed by numerous entities before and since Daniels' use of the slogan as ornamental designs in a gag sense to decorate t-shirts and other novelty goods. See the items in Attachments Band C which are exemplary.

ANSWER: Denied.

16. The slogan claimed as a mark by Daniels is one which has been in general use in diverse variations and is not and cannot be associated exclusively with any one entity.

ANSWER: Denied.

17. If Daniels is able to maintain her registration for the mark which is the subject of this Petition, Spencer and others would be damaged insofar as there would be a cloud on their ability to sell products which use such slogans as humorous, fun ornamental designs.

ANSWER: Denied.

18. The registration which is the subject of this Petition is a source of damage and injury to Spencer and others who sell products which use such common variations on popular catch phrases to amuse buyers and recipients, having nothing to do with source identification, by placing a cloud on their ability to sell products which use such phrases and by providing Daniels a basis to advance claims against them under the Lanham Act.

ANSWER: Denied.

AFFIRMATIVE DEFENSE – Unclean Hands

For its affirmative defense, Daniels pleads and states as follows:

1. On or about March 23, 2009, Daniels contacted by email Spencer through Cori Totoro who was then Associate Buyer of Spencer and informed Cori Totoro of Daniels products.

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