

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

Boom Club, Inc., )  
)  
                  Opposer, )  
)  
                  v. )  
)  
Boom-X Enterprise, Ltd., )  
)  
                  Applicant. )

Opposition No. 123, 447  
Serial No. 75/652, 305

**TTAB**

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

Now comes Applicant, Boom-X Enterprise, by and through its attorneys, and hereby files the following answer in response to Opposer's Notice of Opposition:

1. Denied.
2. Applicant admits that various trademark applications and registrations are attached to the Notice of Opposition as Exhibits A through E. Applicant denies the remaining allegations and statements of paragraph 2.
3. Applicant does not have sufficient knowledge or information to admit or deny the allegations of paragraph 3 and therefore denies the same.
4. Denied.
5. Denied.
6. Denied.
7. Denied.

As an affirmative defense to this Notice of Opposition, Applicant states that it is a Licensee of all of Opposer's valid and subsisting trademarks under the License Agreement of March 19, 2003 (attached as Exhibit 1) proposed by Opposer to settle this Opposition proceeding. This License Agreement was proposed as a settlement to the pending Opposition Proceeding by Opposer and agreed to by Applicant on March 19, 2003 as evident in the signed Trademark License Agreement of Exhibit 1. As evidenced, Opposer has no standing to continue this Opposition Proceeding as Applicant is a valid and subsisting Licensee under all of Opposer's valid trademarks. Accordingly, this Opposition Proceeding should be dismissed in its entirety.

In the alternative, if this Opposition Proceeding should continue for any reason, which Applicant believes it should not, Applicant demands the return of its fully paid up royalty payment of \$100.00. This royalty payment was made to Opposer on March 19, 2003 as evidenced in attached money order dated March 5, 2003 provided to Opposer by Applicant and cashed by Opposer on or about March 26, 2003.



11-17-2004

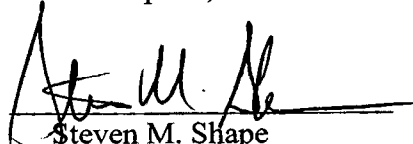
WHEREFORE, Applicant prays that the Notice of Opposition be dismissed in its entirety and that Application Serial No. 73/652,305 pass through to issuance without further delay.

Dated: November 8, 2004

Respectfully submitted,

Boom-X Enterprise, Ltd.

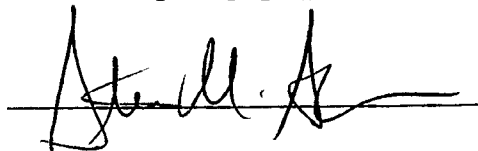
By:

  
Steven M. Shape  
Registration No. 30,802

Steven M. Shape & Associates  
3681 Commercial Avenue  
Northbrook, Illinois 60062  
Attorneys for Applicant, Boom-X Enterprise, Ltd.

PROOF OF SERVICE

The undersigned hereby certifies that a copy of the above ANSWER AND AFFIRMATIVE DEFENSES TO NOTICE OF OPPOSITION has been served on Mitchell P. Brook, Baker and McKenzie, 101 West Broadway, 12<sup>th</sup> Floor, San Diego, CA 92101 and Sidney Turner, Sidney Turner, P.C, Westchester Financial Center, 11 Martine Avenue, White Plains, New York 10606 by United States Mail, postage prepaid, this 8<sup>th</sup> day of November, 2004.

A handwritten signature in black ink, appearing to read "Mitchell P. Brook", written over a horizontal line.

**STEVEN M. SHAPE & ASSOCIATES**

ATTORNEYS AT LAW  
3681 COMMERCIAL AVENUE  
NORTHBROOK, IL 60062

TELEPHONE: 847-412-9909

FACSIMILE: 847-412-9901

Steven M. Shape

**By Facsimile and U. S. Mail**

March 19, 2003

Mr. Sidney Turner  
Sidney Turner, P.C.  
Westchester Financial Center  
11 Martine Avenue  
White Plains, New York 10606

**Re: Boom Club v. Boom-X Opposition No. 123,447-Settlement**

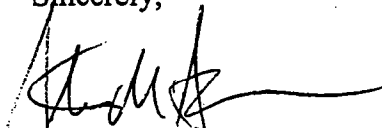
Dear Mr. Turner:

As we discussed and agreed, enclosed is the Trademark License Agreement which has now been executed by my client to settle the referenced Opposition Proceeding. The one time royalty fee of \$100.00 is also enclosed. Please have your client execute the Agreement and return a fully executed copy to me for my files. Please also inform the Trademark Trial and Appeal Board of our settlement so that they do not expect our answer to be filed in the proceeding.

I will then proceed to abandon pending trademark application serial number 75/652,305 as agreed and confirm such to you. At that point, I expect that you will formally terminate the Opposition Proceeding as agreed.

I apologize for the delay in getting this executed Agreement to you and appreciate your understanding and cooperation in resolving this matter.

Sincerely,



Steven M. Shape

SMS/mpc  
Enclosure: Trademark License Agreement

cc: Ms. Shirley Hassan, Trademark Trial and Appeal Board

## TRADEMARK LICENSE AGREEMENT

THE AGREEMENT by and between Boom Club, Inc., a California corporation, having an office at 1407 Broadway, Suite 1410, New York, New York 10018 ("Licensor"), and Boom-X Enterprise, Ltd., an Illinois corporation having an office at 7510 North Caldwell Avenue, Niles, Illinois 60714 ("Licensee"), is effective as of the date of the last signature below.

### WHEREAS:

A. Licensor uses in commerce and owns various federal registrations and applications for federal registration of the trademark "BOOM" clothing and retail and wholesale, and on-line retail store services, as described in Exhibit A hereto; and

B. Licensee has applied to register the mark BOOM-X for "clothing, namely shirts, jackets and coats", Application Serial No. 75/652,305; and

C. Licensor has instituted an Opposition Proceeding before the U.S. Trademark Trial and Appeal Board opposing the registration of Licensee's mark, TTAB Opposition No. 123,447; and

D. The parties are desirous of settling this matter without resort to litigation or other *inter partes* proceedings; and

E. Licensee desires to acquire a license, from Licensor to use the mark "BOOM-X" (the "Licensed Mark") for and in connection with the Licensed Products as hereafter defined; and

F. Licensor desires to grant Licensee an exclusive license to use the Licensed Mark for and in connection with the Licensed Products, subject to the terms and conditions as set forth herein.

NOW THEREFORE, in consideration of the promises and the terms, covenants, and conditions herein contained, the parties hereby agree:

### 1. Grant of License

Upon terms and conditions hereinafter set forth, Licensor grants to Licensee an exclusive right to use the Licensed Mark in connection with clothing, namely shirts, jackets sweaters, pants, hats, jogging suits, sweat shirts fleece sets and coats, as described in Exhibit B attached hereto to be sold only direct and at tradeshow booths, (the "Licensed Products"), and for no other products or services, and no other channels of trade. Notwithstanding any other term or condition this license agreement is for a limited period of one year from the date of execution of this license agreement. This agreement may be renewed on such terms as the parties may mutually agree to.

As a condition for this grant of License, Licensee agrees 1) to state in its product literature that "BOOM" is a trademark of Licensor which is licensed to Licensee 2) that the license to use "BOOM" is not an endorsement of Licensee's products 3) pay one time fully paid royalty fee in the amount \$100.00.

### 2. Territory

The license granted hereunder is for the territory of the United States and Puerto Rico (the "Territory").

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