

TTAB

OPPOSITION NO.: 91,123,141

RECEIVED
COMM. DIV.
MAR 5 9 31

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

PUMA AG RUDOLF DASSLER SPORT

Opposer,

v.

MOURAD, SAMIR

Applicant.

)
)
) **OPPOSITION NO.: 91,123,141**
) **SERIAL NO.: 75/936,519**
) **MARK: V WITH LEAPING TIGER**
) **DESIGN**

) **APPLICANT'S ANSWER TO THE**
) **SECOND AMENDED NOTICE OF**
) **OPPOSITION**

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



04-14-2003

U.S. Patent & TMO/c/TM Mail Rpt Dt. #11

APPLICANT'S ANSWER TO THE SECOND AMENDED NOTICE OF OPPOSITION

Applicant, SAMIR MOURAD. answers the Second Amended Notice of Opposition identified above as follows:

1. In respect to the allegations of paragraph 1 of the Notice, the averments are admitted.

2. In respect to the allegations of paragraph 2 of the Notice, Applicant is without knowledge or information sufficient to form a belief as to the truth or relevancy of the averments that Opposer makes in Paragraph 2 and based thereon denies each and all of the averments.

3. In respect to the allegations of paragraph 3 of the Notice, Applicant admits that Opposer has used the various designs with words for clothing in the United States, but Applicant

✓

is without knowledge or information sufficient to form a belief as to the truth or relevancy of the averments that Opposer makes in Paragraph 3 and based thereon denies each and all of the averments.

4. In respect to the allegations of paragraph 4 of the Notice, Applicant is without knowledge or information sufficient to form a belief as to the truth or relevancy of the averments that Opposer makes in Paragraph 4 and based thereon denies each and all of the averments.

5. In respect to the allegations of paragraph 5 of the Notice, Applicant is without knowledge or information sufficient to form a belief as to the truth or relevancy of the averments that Opposer makes in Paragraph 5 and based thereon denies each and all of the averments.

6. In respect to the allegations of paragraph 6 of the Notice, Applicant is without knowledge or information sufficient to form a belief as to the truth or relevancy of the averments that Opposer makes in Paragraph 6 and based thereon denies each and all of the averments.

7. In respect to the allegations of paragraph 7 of the Notice, applicant is without knowledge or information sufficient to form a belief as to the truth of the averments that Opposer makes in Paragraph 7 and based thereon denies each and all of the averments.

8. In respect to the allegations of paragraph 8 of the Notice, Applicant generally denies all averments that Opposer makes in paragraph 8. Applicant specifically denies the averments that Applicant's mark is the silhouette of a leaping cat, the animal in the Applicant's mark is a leaping tiger. Applicant denies that the silhouette of the leaping tiger resembles a puma. While a puma and a tiger are both within the cat family, they are not specifically cats and do not resemble each other. Applicant specifically denies that Applicant's mark creates the same or similar commercial impression in the minds of prospective purchasers. Applicant denies that

Applicant's mark will cause confusion or mistake or deceive consumers as to the origin of the marks. Applicant denies that Applicant's registration of this mark will cause Opposer damage.

9. In respect to the allegations of paragraph 9 of the Notice, the averments are denied.

10. In respect to the allegations of paragraph 10 of the Notice, Applicant is without knowledge or information sufficient to form a belief as to the truth or relevancy of the averments that Opposer makes in Paragraph 10 and based thereon denies each and all of the averments.

11. In respect to the allegations of paragraph 9 of the Notice, applicant is without knowledge or information sufficient to form a belief as to the truth of the averments that Opposer makes in Paragraph 9 and based thereon denies each and all of the averments.

AFFIRMATIVE DEFENSES

APPLICANT'S FIRST AFFIRMATIVE DEFENSE

NO PROPRIETARY RIGHTS TO ANIMALS IN THE CAT FAMILY

12. Upon information and belief, Opposer has no proprietary right as to the use of images of animals in the cat family. The use of images in the cat family for trademarks is common, alone and in combination, as a trademark and/or service mark for a wide variety of goods and services, such that Opposer's alleged mark is weak.

APPLICANT'S SECOND AFFIRMATIVE DEFENSE

NO UNIFIED REPRESENTATION

13. Opposer owns several marks and has attached them as examples with this Notice of Opposition instituted against Applicant. These numerous examples show different kinds and

styles of pumas and other cats in association with the word mark PUMA, and otherwise. The font in which the word mark PUMA is written varies from mark to mark as does the appearance of the puma representation. The diversity of marks owned by Opposer and the obvious differences within Opposer's own catalog of marks lends to confusion as to the origin of Opposer's own products and vitiates the unified single purpose of a unique trademark to clearly represent a company to the consuming public.

APPLICANT'S THIRD AFFIRMATIVE DEFENSE

UNCLEAN HANDS

14. The Notice of Opposition instituted by the Opposer is filed with unclean hands, and is an unfair attempt to monopolize and prevent use of images of animals in the cat family by denying all legitimate uses of images of animals in the cat family by third parties.

APPLICANT'S FOURTH AFFIRMATIVE DEFENSE

ESTOPPEL, LACHES AND ACQUIESCENCE

15. The Notice of Opposition instituted by the Opposer is barred by the doctrines of estoppel, laches and acquiescence.

APPLICANT'S FIFTH AFFIRMATIVE DEFENSE

NO LIKELIHOOD OF CONFUSION

16. There is no likelihood of confusion between Opposer's marks and Applicant's Mark. Applicant is the owner of Serial Number 75/936,519, for the mark V with Leaping Tiger Design. This mark has a prominent letter "V" with a tiger leaping from the left to the right through the legs of the letter "V." This mark is unique and does not look similar to any of Opposer's marks, nor does it cause confusion to the consuming public as to the origin of goods.

APPLICANT'S SIXTH AFFIRMATIVE DEFENSE

FAMILY OF MARKS

17. Applicant is the owner of Serial No. 75/861,343, word mark for "VARESSI." The letter "V" in Serial Number 75/936,519, V with leaping tiger, stands for the letter "V" in VARESSI. This mark was registered by the USPTO on October 23, 2001 and was assigned Reg. Number 2,500,926.

18. Applicant is the owner of Serial Number 75/936,520 of a silhouette of the same leaping tiger from Serial Number 75,936,519, V with leaping tiger, only this silhouette of a leaping tiger appears behind the word VARESSI. The V from the word VARESSI is in the same script and font style as the letter "V" in Serial Number 75/936,519.

19. Applicant is the owner of Serial Number 75/936,066 of a tiger head, encircled in a Greek Key design and the words VARESSI JEANS. The script and font style used for the mark VARESSI JEANS is identical to the font style used in the letter "V" in Serial Number 75/936,519, and in the mark VARESSI in front of a silhouette of a leaping tiger, Serial Number 75/936,520.

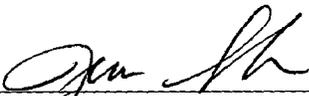
20. Applicant is the owner of Serial Number 75/936,519, for the mark V with leaping tiger design. These four marks are part of a family of marks. Taken individually none of these marks would cause a likelihood of confusion among consumers with Opposer's products. Taken in concert, all four of these marks reemphasize the fact that the letter V is emblematic of the word VARESSI, of which Applicant has adopted with the logo of a tiger as its trademarks.

WHEREFORE, Applicant respectfully prays that this Opposition be dismissed and that Applicant's Application serial number 75/936,519 for the mark V with leaping tiger design proceed on to registration.

SAMIR MOURAD

Respectfully Submitted,
TROJAN LAW OFFICES
by

Dated: 4/8/03



Jessica J. Slusser
Attorneys for Applicant

TROJAN LAW OFFICES
9250 Wilshire Blvd., Ste. 325
Beverly Hills, CA 90212
Tel: (310) 777-8399
Fax: (310) 777-8348

CERTIFICATE OF MAILING (37 C.F.R. 1.8(a))

I hereby certify that the following documents:

1. APPLICANT'S ANSWER TO THE SECOND AMENDED NOTICE OF OPPOSITION (6 pages);
2. Certificate of Mailing/Proof of Service (2 pages); and
3. Return Post Card (1 page).

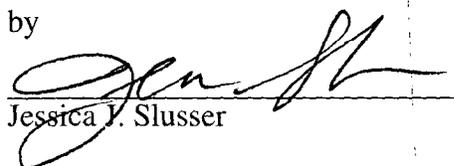
are being deposited with the U.S. Postal Service, postage prepaid, pursuant to 37 C.F.R. 1.8(a) and is addressed to:

Assistant Commissioner for Trademarks
Box TTAB - NO FEE
2900 Crystal Drive
Arlington, VA 22202-3513

on April 8, 2003,

TROJAN LAW OFFICES

by



Jessica J. Slusser

PROOF OF SERVICE

I am over the age of 18 years, employed in the County of Los Angeles, and not a party to the above entitled action. My business address is 9250 Wilshire Blvd., Suite 325 Beverly Hills, California 90212.

On April 8, 2003, I served:

1. APPLICANT'S ANSWER TO THE SECOND AMENDED NOTICE OF OPPOSITION (6 pages); and
2. Certificate of Mailing/Proof of Service (2 pages)

to:

Mr. Stuart J. Friedman, Esq.
NIXON PEABODY LLP
8180 Greensboro Drive, Suite 800
McLean, VA 22102

BY PERSONAL SERVICE: (Federal Court): I caused such envelope to be delivered by hand to the offices of the addressee(s); (State Court): By personally delivering by hand to the offices of the addressee(s).

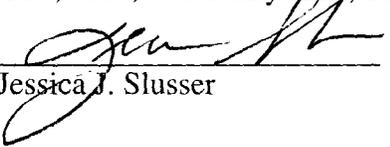
BY MAIL: I am readily familiar with the firm's practice of collection and processing correspondence for mailing. Under that practice it would be deposited with the U.S. Postal Service

on the same day with postage thereon fully prepaid at Beverly Hills, California, in the ordinary course of business. I am aware that on the motion of the party served, service is presumed invalid if the postal cancellation date or postage meter date is more than one day after the date of deposit for mailing shown on this proof of service.

BY FACSIMILE: I caused a copy of such document to be sent via facsimile machine to the office of the addressee(s) at the phone number shown above.

FEDERAL: I declare, under penalty of perjury under the laws of the United States that the foregoing is true and that I am employed in the office of a member of the bar of this Court at whose direction the service was made.

Executed on April 8, 2003, at Beverly Hills, California.



Jessica J. Slusser