

thereunder. By reason of Opposer's extensive advertising, promotion and other use thereof, the SWOOSH DESIGN mark has acquired secondary meaning.

Response

Applicant denies that Opposer's design is distinctive, as that term is defined under 15 U.S.C. §1125(c). Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations of this paragraph, and thus denies the remaining allegations of paragraph 2.

3. Opposer is the owner of various United States Trademark Registrations on the Principal Register for the SWOOSH DESIGN mark, including, but not limited to, the following registrations (hereinafter the "Opposer's Registrations"):

Reg. No. 1,145,473, registered January 6, 1981, filed on January 15, 1979, for all-purpose sport bags, travel bags, hand bags and shoulder bags, claiming first use since March 1972;

Reg. No. 977,190, registered January 22, 1974, filed on January 31, 1972, for athletic shoes with spikes and athletic uniforms for use with such shoes and athletic shoes without spikes and athletic uniforms for such shoes, claiming first use since June 18, 1971;

Reg. No. 1,284,385, registered on July 3, 1984, filed on April 22, 1982, for athletic and casual clothing for men, women and children, namely, shirts, pants, shorts, jackets, warm-up suits, swimwear, tenniswear, skirts, sweaters, underwear, headwear, socks and wristbands, claiming first use since June 18, 1971;

Reg. No. 1,264,529, registered on January 17, 1984, filed on April 3, 1981, for retail footwear and apparel store services, claiming first use since February 1972;

Reg. No. 1,926,168, registered on October 10, 1995, filed on May 5, 1993, for binders, student planners, notebooks, portfolio covers, and pouches for carrying school materials, claiming first use since April 10, 1995;

Reg. No. 2,024, 437, registered December 17, 1996, filed on December 2, 1994, for sports balls, claiming first use since July 26, 1995;

Reg. No. 2,239,078, registered April 13, 1999, filed on December 19, 1994, for ear plugs for swimming purposes, nose clips for swimming purposes, swim goggles, kickboards, and buoys for recreational and training use, claiming first use since January 9, 1998;

Reg. No. 2,107,521, registered October 21, 1997, filed on December 15, 1995, for eyewear (glasses); namely, sunglasses and parts and accessories for eyewear; namely, cases for eyewear, claiming first use since August 28, 1996;

Reg. No. 2,490,994, registered on September 18, 2001, filed on October 2, 1995, for jewelry and entertainment services in the nature of sporting events of all types, namely, contests, clinics, camps, tournaments and exhibitions, claiming first use on for jewelry since 1996 and first use for entertainment services since July 1997;

Reg. No. 2,522,877, registered December 25, 2001, filed August 30, 1996, for helmets of all types for the practice of sports, sports balls of all types; weights for exercise and for lifting; weight lifting belts; protective padding, guards and body protectors of all types for the practice of sports; golf bags; head covers for golf clubs; golf tees and ball markers; baseball and softball bats; mitts and gloves for the practice of all types of sports; ice hockey sticks; ice skates and goggles for swimming claiming first use since July 26, 1995;

Reg. No. 2,237,852, registered April 6, 1999, filed October 2, 1995, for sunglasses (glasses, eyewear) and sunglass frames, watches, claiming use since August 26, 1997;

Reg. No. 1,323,343, registered on March 5, 1985, filed on April 3, 1981, for footwear, claiming first use since June 18, 1971; and

Reg. No. 1,990,180, registered on July 30, 1996, filed on December 1, 1995, for a full line of sports clothing, claiming first use since June 18, 1971.

Response

Applicant is without knowledge or information sufficient to form a belief as to the truth of this paragraph, and thus denies the allegations of paragraph 3.

4. Opposer's Registrations are valid and subsisting and record title therein is in the name of Opposer. Reg. Nos. 977,190; 1,145,473; 1,284,385; 1,323,343 and 1,990,180 are incontestable.

Response

Applicant admits that, according to the United States Patent and Trademark Office website on August 20, 2002, that Opposer's Registrations are subsisting and that record title of such registrations are in the name of Opposer. Applicant further admits that the registrations listed in paragraph 4 have been registered on the Principal Register for at least five years. Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations of this paragraph, and thus denies the remaining allegations of paragraph 4.

5. Opposer has used and is using the SWOOSH DESIGN mark in interstate commerce in connection with all of the goods and services described in the Opposer's Registrations.

Response

Applicant is without knowledge or information sufficient to form a belief as to the truth of this paragraph, and thus denies the allegations of paragraph 5.

COUNT I

THERE IS A LIKELIHOOD OF CONFUSION WITH OPPOSER'S MARK

6. Opposer realleges paragraphs 1 through 5 as paragraph 6 of this Count I.

Response

Applicant incorporates its responses to paragraphs 1 through 5 as its response to paragraph 6.

7. On March 19, 1998, Applicant filed the '121 Application for the mark "Miscellaneous Design" for the following goods:

Chemicals for use in the manufacture and finishing of textile, leather, metal, pharmaceutical compounds and paper; unprocessed concentrates for use in the manufacture of thermoplastics containing additives and/or pigments in Intl. Class 1; and

Dyestuffs for use in the manufacture and finishing of textiles, leather, metal and paper; color pigments; mordants for use in the textile, leather, metal and paper industries; lacquers in the nature of a coating in Intl. Class 2.

Response

Applicant admits that on March 19, 1998, Applicant filed United States Application Serial No. 75/453,121 in the United States Patent and Trademark Office for a mark entitled "Miscellaneous Design." Applicant denies that the application, as filed, contained the above description of goods.

8. Opposer's use and registration of its SWOOSH DESIGN mark long pre-dates the filing date of the '121 Application and Applicant's first use of Applicant's mark.

Response

Applicant is without knowledge or information sufficient to form a belief as to the truth of this paragraph, and thus denies the allegations of paragraph 8.

9. The grant of a registration to Applicant for its "Miscellaneous Design" mark as sought in the '121 Application, should be denied on the grounds of Opposer's prior use of its SWOOSH DESIGN mark. The mark sought to be registered by Applicant is confusingly similar to Opposer's SWOOSH DESIGN mark, and the use of the mark "Miscellaneous Design" by Applicant is likely to cause confusion or mistake in the minds of the public and to lead the public and prospective purchasers to believe that Applicant's goods are those of Opposer or are endorsed, sponsored or otherwise affiliated or connected with Opposer, or that Opposer's goods and services are associated with Applicant, all to the damage and injury of the purchasing public and to the damage and injury of Opposer.

Response

Applicant denies each and every allegation in paragraph 9.

COUNT II

THE '121 APPLICATION [SIC, APPLICANT'S MARK] DILUTES OPPOSER'S MARKS

10. Opposer realleges paragraphs 1 through 9 as paragraph 10 of this Count II.

Response

Applicant incorporates its responses to paragraphs 1 through 9 as its response to paragraph 10.

11. Through extensive advertising and promotion, Opposer's SWOOSH DESIGN mark has become and is a famous mark in the United States.

Response

Applicant denies each and every allegation in paragraph 11.

12. Applicant claims it has used the mark sought to be registered in the '121 Application since July 1995. Such alleged use began after Opposer's SWOOSH DESIGN mark became famous.

Response

Applicant admits that it has used the mark sought to be registered in the '121 Application since at least as early as July 1995. Applicant denies the remaining allegations of paragraph 12.

13. Applicant's use of its "Miscellaneous Design" mark causes and is likely to cause dilution of Opposer's SWOOSH DESIGN mark to the injury of Opposer by lessening the capacity of the SWOOSH DESIGN mark to identify and distinguish Opposer's goods and services and by diluting the distinctive quality of Opposer's famous mark.

Response

Applicant denies each and every allegation in paragraph 13.

14. The grant of a registration to Applicant for its “Miscellaneous Design” mark as sought in the ‘121 Application, should be denied based on likelihood of confusion with Opposer’s prior SWOOSH DESIGN mark and dilution of Opposer’s famous SWOOSH DESIGN mark.

Response

Applicant denies each and every allegation in paragraph 14.

APPLICANT’S FIRST AFFIRMATIVE DEFENSE

1. There is no likelihood of confusion under 15 U.S.C. § 1052(d) because the use of Applicant's mark in connection with the identified goods is not likely to cause confusion, or mistake, or to deceive.

APPLICANT’S SECOND AFFIRMATIVE DEFENSE

1. The rights of Opposer are limited due to third party use of similar “checkmark-like” logos in a wide variety of industries, and specifically, the sports marketplace. Such third party usage includes, for example, ESPN, the premier sports network in the United States, and Renegade Golf, which sells golf equipment and apparel:



APPLICANT'S THIRD AFFIRMATIVE DEFENSE

1. The Federal Trademark Dilution Act, 15 U.S.C. §1125(c) cannot be applied retroactively. Thus, registration of Applicant's mark, which was used in commerce prior to the January 16, 1996 effective date of the statute, cannot be refused under 15 U.S.C. § 1125(c).

APPLICANT'S FOURTH AFFIRMATIVE DEFENSE

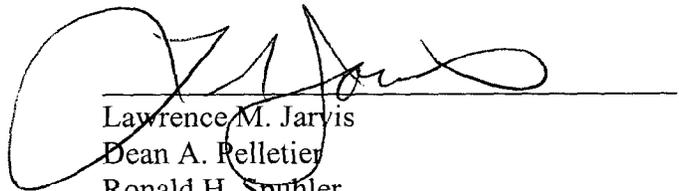
1. There is no dilution, or likelihood of dilution, of Opposer's mark under 15 U.S.C. § 1125(c) sufficient to deny registration of Applicant's mark. Applicant's mark is not similar to Opposer's mark and consequently does not evoke an instinctive mental association of the two designs by a relevant universe of consumers. Furthermore, given the numerous third-party uses of "checkmark-like" designs, Opposer's mark is not distinctive and, as a result, Opposer's mark does not warrant protection under the Federal Trademark Dilution Act.

APPLICANT'S FIFTH AFFIRMATIVE DEFENSE

1. Opposer was aware of Applicant's use of its mark at least as early as February 1999.
2. Opposer's delay in protesting Applicant's use of its mark in commerce, after Opposer had been made aware of Applicant's use of the mark in connection with Applicant's chemical products, constitutes laches, acquiescence, and estoppel.

Respectfully submitted,

Date: 8-21-02



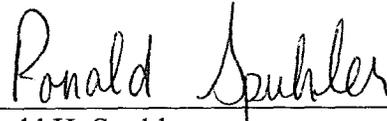
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**ATTORNEYS FOR APPLICANT
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CERTIFICATE OR MAILING

I hereby certify that the foregoing **ANSWER TO NOTICE OF OPPOSITION** is being deposited with the United States Postal Service, Express Mail No. EL 849008868 US in an envelope addressed to Box TTAB, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513. A true copy of the foregoing is also being sent to the following counsel of record for Opposer by facsimile and hand-delivery on this 21st day of August, 2002:

Keith W. Medansky
Piper Rudnick
P.O. Box 64807
Chicago, Illinois 60664-0807



Ronald H. Spuhler
Attorney for Applicant

TTAB

Express Mail No. EL 849008868

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

NIKE, INC.,)
)
)
Opposer,)
)
v.)
)
CLARIANT AG,)
)
Applicant.)

Opposition No. 91152065

TRADEMARK TRIAL AND
APPEAL BOARD
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TRANSMITTAL LETTER

08-21-2002
U.S. Patent & TMO/TM Mail Rcpt Dt. #99

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

Sir:

Please find enclosed Applicant's **ANSWER TO NOTICE OF OPPOSITION**. Please charge any additional fees to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

Ronald Spuhler

Dated: August 21, 2002

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