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

Proceeding	91183309
Party	Defendant Pacific Sunwear of California, Inc.
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Submission	Motion to Amend/Amended Answer or Counterclaim
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Signature	/Matthew D. Murphey/
Date	06/20/2008
Attachments	Applicant's Amended Answer to Opposer's Notice of Opposition.pdf ( 8 pages ) (27624 bytes )

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

WILLY BOGNER GMBH & CO., )  
KOMMANDITGESELLSCHAFT )  
AUF AKTIEN )  
Opposer, )  
v. ) Opposition No. 91183309  
PACIFIC SUNWEAR )  
OF CALIFORNIA INC., )  
Applicant. )  
PACIFIC SUNWEAR )  
OF CALIFORNIA INC., )  
Counterclaim-Petitioner, )  
v. )  
WILLY BOGNER GMBH & CO., )  
KOMMANDITGESELLSCHAFT )  
AUF AKTIEN )  
Counterclaim-Respondent. )

APPLICANT PACIFIC SUNWEAR OF CALIFORNIA INC.’S AMENDED ANSWER  
TO OPPOSER’S AMENDED NOTICE OF OPPOSITION AND COUNTERCLAIM  
FOR PARTIAL CANCELLATION

Pacific Sunwear of California, Inc. (“Applicant”), a corporation organized and existing under the laws of the State of California, by and through its attorneys, hereby answers the allegations set forth in the Notice of Opposition filed by Willy Bogner GmbH & Co. Kommanditgesellschaft auf Aktien (“Opposer”) and asserts its Counterclaim for Partial Cancellation.

Applicant states that it is the owner of the mark “B” in International Class 025 for the goods set forth in Applicant’s application (No. 77/279917). Applicant denies that Opposer is entitled to the relief sought and denies that Opposer will be damaged as alleged.

The numbered Answers herein correspond to the numbered paragraphs set forth in Opposer’s Notice of Opposition.

1. Applicant is without knowledge and information sufficient to form a belief as to the truth of the allegations set forth in paragraph 1 and therefore denies same.
2. Applicant is without knowledge and information sufficient to form a belief as to the truth of the allegations set forth in paragraph 2 and therefore denies same.
3. Applicant is without knowledge and information sufficient to form a belief as to the truth of the allegations set forth in paragraph 3 and therefore denies same.
4. Applicant is without knowledge and information sufficient to form a belief as to the truth of the allegations set forth in paragraph 4 and therefore denies same.
5. Applicant admits only that the records of the U.S. Patent and Trademark Office reveal U.S. Trademark Registration No. 2,264,266, for the mark B BOGNER (stylized) for “wearing apparel, namely, pants, trousers, riding pants, golf pants, sports jackets, jackets, dresses, coats, suits, skirts, blouses, shirts, parkas, ski pants, ski suits, pullovers, caps, hats, stockings and gloves, shawls, scarves, headbands, suspenders, shoes, belts made from leather and imitation leather, footwear and headwear” in International Class 025, and that it purports to have been registered in the United States on July 27, 1999. Applicant is without knowledge and information sufficient to form a belief as to the truth of the remaining allegations set forth in paragraph 5 and therefore denies same.

6. Applicant admits only that the records of the U.S. Patent and Trademark Office reveal U.S. Trademark Registration No. 3,076,868 for the mark B (stylized) for “winter clothes, namely, ski suits, and anoraks; sports suits” in International Class 025, and that it purports to have been registered in the United States on April 4, 2006. Applicant is without knowledge and information sufficient to form a belief as to the truth of the remaining allegations set forth in paragraph 6 and therefore denies same.
7. Applicant admits only that the records of the U.S. Patent and Trademark Office reveal U.S. Trademark Registration No. 3,233,645 for the mark B (in circle) for “clothing, namely, cycling shorts, cycling shirts, and cycling jackets, pants, trousers, riding pants, golf pants, ski pants, ski suits, sports shirts, sports jackets, anoraks, gymnastics clothing, namely leotards, bodysuits, tank shirts, exercise shorts, sweat socks, and sports bras; raincoats, shorts, blousons, jackets, dresses, coats, suits, skirts, shirts, parkas, pullovers, stockings, evening dresses, ponchos, chasubles, blue jeans, capes, girdles, blouses, swimming caps, swimsuits, chemisettes, chemises, sweaters, sweatshirts, sweat pants, cardigans, underwear, polo shirts, pullovers, t-shirts, bandanas, ear muffs, gloves, mittens, shawls, shoulder wraps, scarves, socks, water proof clothing, namely, raincoats, and trousers; overalls, overcoats; footwear and headwear” in International Class 025, and that it purports to have been registered in the United States on April 24, 2007. Applicant is without knowledge and information sufficient to form a belief as to the truth of the remaining allegations set forth in paragraph 7 and therefore denies same.
8. Applicant admits only that the records of the U.S. Patent and Trademark Office reveal U.S. Trademark Registration No. 3,275,447 for the mark B (stylized) for “clothing, namely, pants, trousers, riding pants, golf pants, denim pants, sports jackets, jackets, dresses, coats, suits, skirts, blouses, shirts, parkas, ski pants, ski suits,

overalls, pullovers, t-shirts, stockings, and gloves, shawls, scarves, headbands, suspenders, belts, headwear, shoes, boots, footwear, ski boots, and snow board boots; parts of footwear, namely, heels; soles of shoes; ski gloves and snowboard gloves” in International Class 025, and that it purports to have been registered in the United States on April 24, 2007. Applicant is without knowledge and information sufficient to form a belief as to the truth of the remaining allegations set forth in paragraph 8 and therefore denies same.

9. Applicant is without knowledge and information sufficient to form a belief as to the truth of the allegations set forth in paragraph 9 and therefore denies same.
10. Applicant is without knowledge and information sufficient to form a belief as to the truth of the allegations set forth in paragraph 10 and therefore denies same.
11. Applicant admits the allegations in paragraph 11 of the Notice of Opposition.
12. Applicant denies the allegations in paragraph 12 of the Notice of Opposition.
13. Applicant denies the allegations in paragraph 13 of the Notice of Opposition.
14. Applicant denies the allegations in paragraph 14 of the Notice of Opposition.

#### AFFIRMATIVE DEFENSES

15. Applicant hereby incorporates by reference all of the preceding paragraphs.
16. Opposer fails to state a claim upon which relief can be granted.
17. On information and belief, Opposer has waived its alleged right to seek relief as set forth in the Opposition.
18. On information and belief, Opposer is barred by estoppel from maintaining said Opposition.

19. On information and belief, Opposer is barred by laches from maintaining said Opposition.
20. On information and belief, Opposer is barred by acquiescence from maintaining such Opposition.
21. On information and belief, Opposer's purported trademarks do not distinguish Opposer's goods from the goods of others.
22. On information and belief, Opposer has failed to continuously use its purported trademarks in commerce.
23. On information and belief, Opposer's purported trademarks have been abandoned by Opposer in that they have ceased to indicate (if they ever did indicate) Opposer as the source of any goods or services.
24. Many similar trademarks have been applied for, registered, and used by others including Applicant, for the same goods and services in the United States, without objection from Opposer, such that Opposer has no exclusive right to use its marks (or preclude others from using similar marks) in connection with such goods and services. Registration of Applicant's mark is consistent with prior registrations.
25. Due to such prior third party use and Applicant's use of such marks, and due to Opposer's failure to monitor and object to such use and registration, Opposer has abandoned any rights it had in its marks in connection with such goods and services.
26. Applicant's mark will not, does not, and is not likely to cause confusion, mistake, or deception as to the source of any goods or services, including those of Opposer, as is evidenced by the significant overall differences in the appearance, meaning, connotation and suggestion of the parties' respective marks.

27. Opposer has not suffered nor is it likely to suffer any injury or harm to its business or property by reason of Applicant's application and subsequent registration, and it therefore lacks standing to oppose Applicant's application.
28. Opposer's marks have acquired no secondary meaning or distinctiveness as used with the goods and services alleged by Opposer, and they cannot function as an indicator of source in connection with such goods and services.
29. Applicant reserves the right to develop further defenses during the Discovery Phase of the Opposition.

COUNTERCLAIM FOR PARTIAL CANCELLATION

30. Applicant hereby incorporates by reference all of the preceding paragraphs.
31. Applicant seeks a partial cancellation of all of Opposer's asserted trademark registrations, Registration Nos. 2,264,266, 3,076,868, 3,233,645, and 3,275,447, in this matter pursuant to Section 18 of the Trademark Act (15 U.S.C. § 1068). As grounds for such partial cancellation, Applicant states that Opposer has abandoned its marks for, among other things, pants, jeans, shorts, denims, and many other items in International Class 025.
32. Opposer has abandoned its marks for such goods and services by allowing the use and registration of similar and nearly-identical marks by third parties and Applicant for the same goods and services in International Class 025 in the United States.
33. Opposer's abandonment is evidenced by its failure to monitor and attempt to block such third party use and registrations such that it has no exclusive right to use its marks or preclude others from using similar and nearly-identical marks in connection with such goods and services.

34. Applicant seeks such partial cancellations in order to limit or restrict the goods and services covered by Opposer's marks to those goods and services it has not previously abandoned.
35. Applicant has standing to bring this counterclaim because Registration Nos. 2,264,266, 3,076,868, 3,233,645, and 3,275,447, are being asserted against Applicant in Opposer's Notice of Opposition, such that the existence of these registrations are causing damage to Applicant.
36. The statutory fee of \$1,200.00 (\$300.00 per class) as prescribed in Trademark Rule 2.6(a)(16) is to be charged to Deposit Account No. 50-1990.

WHEREFORE, Applicant prays the Notice of Opposition be dismissed in its entirety with prejudice, that the Board grant Applicant the relief requested in its counterclaim, that the Board agree that a registration should be issued to Applicant for its trademark application Serial No. 77/279917 for the mark B in International Class 025, and that the Trademark Trial and Appeal Board grant such other relief as it deems just and proper.

Respectfully submitted by:

/s/

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CERTIFICATE OF ELECTRONIC FILING

I hereby certify that the above document was filed electronically with the Trademark Trial and Appeal Board on this the 20<sup>th</sup> day of June, 2008.

/s/ \_\_\_\_\_  
Matthew D. Murphey

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the above and foregoing has been served on counsel for the Opposer Willy Bogner GmbH & Co. Kommanditgesellschaft auf Aktien via E-mail on this the 20<sup>th</sup> day of June, 2008:

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/s/ \_\_\_\_\_  
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