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Filing date: **01/17/2012**

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

Proceeding	91201495
Party	Defendant VIKING RIVER CRUISES (BERMUDA) LTD.
Correspondence Address	Beth M. Goldman ORRICK, HERRINGTON & SUTCLIFFE LLP 2050 MAIN STREET, SUITE 1100 IRVINE, CA 92614-8255 ipprosecutionsf@orrick.com
Submission	Answer and Counterclaim
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Signature	/Betsy Wang/
Date	01/17/2012
Attachments	VIKING.pdf (7 pages)(184392 bytes)

Registration Subject to the filing

Registration No	3326880	Registration date	10/30/2007
Registrant	Viking Range Corporation 111 Front Street Greenwood, MS 38930 UNITED STATES		

Goods/Services Subject to the filing

Class 041. First Use: 2004/01/31 First Use In Commerce: 2004/01/31

All goods and services in the class are requested, namely: Educational and entertainment services, namely, conducting a cooking school and providing cooking classes and demonstrations

and to associate and identify said marks with Opposer or with a single source, and Opposer derives substantial goodwill and value from the aforesaid identification by the consuming public and trade.” Except as expressly denied, Applicant lacks sufficient information on which to form a belief as to the truth of the remaining allegations in Paragraph 4 and on that basis denies each and every one of them.

5. Applicant admits that Opposer is listed as the “last owner of record” for Registration Nos. 1,437,211; 1,565,774; 1,598,452; 1,798,615; 1,885,831; 1,805,114; 2,196,291; 2,196,439; 2,724,541; 2,493,555; 3,655,276; 3,163,333; 3,326,880; and 3,836,066 on the TARR system at the United States Patent and Trademark Office (“USPTO”). Applicant lacks sufficient information on which to form a belief as to the truth of the remaining allegations in Paragraph 5 and on that basis denies each and every one of them.

6. Applicant admits that it is a company organized under the laws of Bermuda with an address at Clarendon House, 2 Church Street, Hamilton, Bermuda HM 11, and that it filed intent-to-use Application Serial No. 85/133,747 (the “Application”) on September 20, 2010 to register the mark VIKING in Class 41. Applicant further admits that, as of January 17, 2012, the TARR system at the USPTO lists the description of services in the Application as follows: “Arranging, organizing and hosting social entertainment events; entertainment and education services in the nature of live dance and musical performances; entertainment information; entertainment services, namely, organizing and conducting parties, wine and food tastings, contests, live stage performances, namely, plays, concerts, piano recitals, vocal recitals, comedy shows, monologue performances, poetry and narrative readings, nightclub shows, namely, plays, concerts, piano recitals, vocal recitals, comedy shows, monologue performances, poetry and narrative readings, variety and comedy shows, and theatrical and musical floor shows provided at performance venues; entertainment services, namely, casino gaming; educational services, namely, conducting lectures and seminars in the fields of music, theatre, and film; video arcade services; libraries; provision of in-cabin interactive television programming; health club services, namely providing instruction, classes, and equipment in the field of physical exercise; organizing

and hosting cultural and arts events; organization of exhibitions for cultural or educational purposes.”

7. Applicant admits that it has filed six other U.S. applications for VIKING LONGSHIPS (Application Serial No. 85/276,774), VIKING RIVER CRUISES EXPLORING THE WORLD IN COMFORT and Design (Application Serial No. 85/136,757), VIKING TOURS (Application Serial No. 85/136,552), VIKING RIVER CRUISES (Application Serial No. 85/133,778), VIKING RIVER CRUISES and Design (Application Serial No. 85/136,505), and VIKING LEGEND (Application Serial No. 85/136,726) for a variety of services in Class 41, including “cooking classes” and/or “wine and food tastings.” Applicant further admits that the USPTO issued Office Actions for Application Serial Nos. 85/136,552, 85/133,778, 85/136,505, and 85/133,747 with respect to the educational cooking services, citing a provisional likelihood of confusion with Opposer’s Registration No. 3,326,880 for VIKING, which covers “educational and entertainment services, namely, conducting a cooking school and providing cooking classes and demonstrations.” Applicant admits that it deleted “cooking classes” from the aforementioned applications that received Office Actions. Except as expressly admitted, Applicant denies the allegations of Paragraph 7.

8. Paragraph 8 requires no response. To the extent a response is required, Applicant denies each and every allegation in Paragraph 8.

9. Applicant admits that it seeks to register the VIKING mark for a variety of services in Class 41, including “wine and food tastings.” Except as expressly admitted, Applicant denies the allegations of Paragraph 9.

10. Applicant denies each and every allegation in Paragraph 10.

11. Applicant denies each and every allegation in Paragraph 11.

12. Applicant denies each and every allegation in Paragraph 12.

13. The first sentence of Paragraph 13 requires no response. To the extent a response is required, Applicant denies each and every allegation. Applicant lacks sufficient information

on which to form a belief as to the truth of the remaining allegations in Paragraph 13 and on that basis denies them.

14. Applicant lacks sufficient information on which to form a belief as to the truth of the allegations in Paragraph 14 and on that basis denies each and every one of them.

15. Applicant denies each and every allegation in Paragraph 15.

16. Applicant denies each and every allegation in Paragraph 16.

17. Applicant admits that it is a cruise line company organized under the laws of Bermuda that offers river cruises that tour through Europe, Asia, and Egypt. Except as expressly admitted, Applicant denies the allegations of Paragraph 17.

18. Applicant denies each and every allegation in Paragraph 18.

19. Applicant denies each and every allegation in Paragraph 19.

COUNTERCLAIM FOR CANCELLATION

20. Applicant hereby incorporates and realleges what is set forth in the preceding paragraphs as if fully set forth herein.

21. Applicant hereby brings a counterclaim seeking cancellation of Opposer's Registration No. 3,326,880 for VIKING in Class 41.

22. Upon information and belief, Opposer is a Mississippi corporation having its principal place of business at 111 Front Street, Greenwood, Mississippi 38930.

23. Opposer is the listed registrant for Registration No. 3,326,880 for VIKING for "educational and entertainment services, namely, conducting a cooking school and providing cooking classes and demonstrations" in Class 41.

24. Applicant began using its VIKING mark, whether alone or in combination with any other term, terms, symbols or designs, prior to the date that Opposer filed the application that matured into Registration No. 3,326,880 and prior to Opposer's date of first use alleged in Registration No. 3,326,880. Accordingly, Applicant has priority over Opposer. Should the Board find that a likelihood of confusion or mistake or deception exists as between Applicant's

and Opposer's VIKING marks in Class 41, Applicant requests that Opposer's registration in Class 41 be canceled in light of Applicant's priority.

25. In addition, Applicant's VIKING mark is distinctive and famous throughout the United States, and has become closely associated with the goods and services of Applicant. Applicant's VIKING mark became famous prior to the filing of Opposer's application that matured into Registration No. 3,326,880 for VIKING. If the Board finds that there is dilution in this proceeding, it should find that Opposer's Registration No. 3,326,880 for VIKING in Class 41 is likely to cause dilution by blurring and dilution by tarnishment of Applicant's VIKING mark, and that it reduces the capacity of Applicant's famous VIKING mark to identify the goods and services of Applicant.

26. Registration of Opposer's mark is damaging to Applicant if the Board finds that a likelihood of confusion or mistake or deception exists as between Opposer's and Applicant's VIKING marks or if the Board finds that Applicant's VIKING mark would dilute Opposer's VIKING mark. Applicant is further damaged because Opposer has asserted the subject registration against Applicant's Application Serial Nos. 85/133,747; 85/276,774; 85/136,757; 85/136,552; 85/133,778; 85/136,505 and 85/136,726.

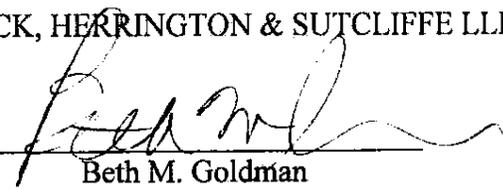
WHEREFORE, Applicant respectfully requests that Application Serial No. 85/133,747 be approved for registration on the Principal Register and this Opposition be dismissed in favor of Applicant. If the Board finds that a likelihood of confusion or dilution exists as between Opposer's and Applicant's marks, Applicant further requests that Registration No. 3,326,880 in Class 41 be canceled.

Respectfully submitted,

ORRICK, HERRINGTON & SUTCLIFFE LLP

Dated: January 17, 2012

By: _____



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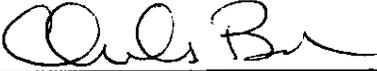
CERTIFICATE OF SERVICE

I certify that a copy of the foregoing ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIM FOR CANCELLATION was served by First Class Mail, on January 17, 2012, on Opposer and counsel for Opposer at the following addresses:

Viking Range Corporation
111 Front Street
Greenwood, MS 38930

Sarah Anne Keefe
Marcy L. Sperry
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Dated: January 17, 2012

By: 
Chelsea E. L. Bush