

ESTTA Tracking number: **ESTTA518369**

Filing date: **01/28/2013**

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

Proceeding	91208511
Party	Defendant Sundek, LLC
Correspondence Address	NICOLETTE R. HUDSON BARNES & THORNBURG LLP 21 E STATE ST STE 1850 COLUMBUS, OH 43215-4219  nhudson@btlaw.com;TMINDOCKET@btlaw.com
Submission	Answer and Counterclaim
Filer's Name	Brian J. Downey
Filer's e-mail	brian.downey@btlaw.com
Signature	/Brian J. Downey/
Date	01/28/2013
Attachments	NS(000547-1-28-2013 1-20-45 PM).pdf ( 7 pages )(1164501 bytes )

Registration Subject to the filing

Registration No	975546	Registration date	12/25/1973
Registrant	BATA LIMITED 59 WYNFORD DRIVE NORTH YORK (TORONTO), ONTARIO, M3C 1K3 CANADA		
Grounds for filing	The registration was obtained contrary to Trademark Act section 2(a)		

Goods/Services Subject to the filing

Class U039 (International Class 025). First Use: 1961/09/00 First Use In Commerce: 1970/06/00 All goods and services in the class are requested, namely: FOOTWEAR
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Bata Brands S.a.r.l. Luxembourg, Succursale De Lausanne	:	Mark: SUNDEK
	:	
	:	
Opposer,	:	Opp. No.: 91208511
	:	
v.	:	Serial No.: 85/569,536
	:	
Sundek, LLC	:	
	:	
	:	
Applicant.	:	

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**APPLICANT'S ANSWER TO NOTICE OF OPPOSITION  
AND COUNTERCLAIM**

Applicant, Sundek, LLC, ("Applicant") by and through its counsel, makes the following Answer to the Notice of Opposition filed by Bata Brands S.a.r.l. Luxembourg, Succursale De Lausanne ("Opposer"):

**ANSWER**

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 1 of the Notice of Opposition.
2. Applicant admits the allegations contained in Paragraph 2 of the Notice of Opposition.
3. Applicant admits the allegations contained in Paragraph 3 of the Notice of Opposition.
4. Applicant admits the allegations contained in Paragraph 4 of the Notice of Opposition.

5. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 5 of the Notice of Opposition, and therefore denies those allegations.

6. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 6 of the Notice of Opposition, and therefore denies those allegations.

7. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 7 of the Notice of Opposition, and therefore denies those allegations.

8. Applicant denies the allegations contained in Paragraph 8 of the Notice of Opposition.

9. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 9 of the Notice of Opposition, and therefore denies those allegations.

10. Applicant denies the allegations contained in Paragraph 10 of the Notice of Opposition.

11. Applicant denies the allegations contained in Paragraph 11 of the Notice of Opposition.

12. Applicant denies each and every other allegation set forth in the Notice of Opposition not specifically admitted to herein and specifically denies that Opposer is entitled to the prayed for relief.

### **FIRST AFFIRMATIVE DEFENSE**

1. The Notice of Opposition fails to state a claim upon which relief can be granted.

### **SECOND AFFIRMATIVE DEFENSE**

2. Opposer cannot demonstrate that they will suffer any harm from the registration of the Applicant's mark because the Applicant's mark has coexisted with Opposer's cited mark for decades without confusion.

### **THIRD AFFIRMATIVE DEFENSE**

3. Applicant has priority of use of its mark over Opposer.

### **FOURTH AFFIRMATIVE DEFENSE**

4. Opposer's claims are barred, in whole or in part, by the equitable doctrines of laches, acquiescence, waiver and/or estoppel.

### **FIFTH AFFIRMATIVE DEFENSE**

5. The Opposition is barred under the prior registration (Morehouse) doctrine because Applicant owns U.S. Registration No. 984,566, a substantially similar mark for substantially similar goods.

WHEREFORE, Applicant prays for judgment against the Opposer, dismissing the Notice of Opposition in its entirety.

### **COUNTERCLAIM**

Sundek, LLC believes that it is being damaged by Bata Brands S.a.r.l. Luxembourg, Succursale De Lausanne's ("Bata") Registration No. 975,546 for SANDAK for use on footwear (the "Registration"). Sundek, LLC hereby petitions to cancel the Registration pursuant to Section 14 of the Trademark Act of 1946 (15 U.S.C. §1064) and as grounds therefore, alleges:

1. In the 1940s, SUN-DEK of California, Applicant's predecessor (Applicant and its predecessors in interest, collectively, "Sundek"), began use of the SUN-DEK mark on swimwear.

2. In 1958, Sundek expanded its product offerings to include SUNDEK branded shorts specifically designed for surfing, making SUNDEK one of the first brands dedicated to the sport.

3. Throughout the 1960s, the SUNDEK brand expanded through the use of innovative solutions and designs for surf wear and swimming apparel.

4. During this same time period, the surfer lifestyle became popularized in U.S. culture through movies and music. Sundek both seized upon, and assisted, this growing popularity through its sponsorship of surfers and surfing contests. These sponsorships and promotion of the SUNDEK brand helped SUNDEK become a household name for surf, swimming and beach apparel.

5. The 1972 introduction of Sundek's now iconic rainbow broadshorts, cemented the SUNDEK brand's longstanding fame and recognition.

6. Since Sundek's initial use of the SUNDEK mark, it has continuously used, promoted and offered SUNDEK branded apparel in the United States. Due to this long-standing, continuous use of the SUNDEK mark, Sundek enjoys tremendous goodwill in connection with the use of its SUNDEK mark on all kinds of apparel.

7. Bata has opposed Sundek's application for the SUNDEK mark for use on "clothing, namely, swimsuits, broadshorts, sweatshirts, knit shirts, t-shirts, tank tops, jackets, coats, dresses, dress shirt, pants, Capri pants, and shorts; footwear; headwear".

8. As grounds for its opposition, Bata has alleged that all of the goods in Sundek's opposed application are identical to, or related to, Bata's own goods sold under the mark covered by the Registration.

9. Upon information and belief, Bata uses its SANDAK mark on, among other types of footwear, flip-flops and other shoes that would be commonly worn at a beach.

10. The Registration claims a date of first use September, 1961 with a date of first use in U.S. Commerce of June, 1970.

11. Sundek has, since prior to Bata's claimed date of first use, continuously used the SUNDEK mark in commerce.

12. Sundek is damaged by the continuance of the Registration because Bata has opposed Sundek's application under Section 2(d) of the Trademark Act, alleging that Sundek's mark is likely to cause confusion with the subject mark of the Registration.

13. Sundek is further damaged by the continuance of the Registration because Bata uses its SANDAK mark on flip flops and other beach-type footwear, which will lead to a false suggestion of a connection between Bata and Sundek.

14. If Bata's allegations of likelihood of confusion are true, then Sundek, as a prior user, will continue to suffer harm through such likelihood of confusion or false suggestion of a connection with Sundek.

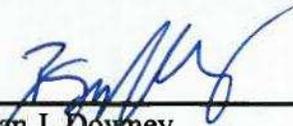
15. Those seeing Bata's use of SANDAK on flip flops and other beach-type footwear will assume an association between Bata and Sundek, which is false.

16. Given Sundek's priority of use of its mark, Sundek prays that Registration No. 975,546 be cancelled under Trademark Act Section 2(a), 15 U.S.C. §1052(a), as falsely suggesting a connection with Sundek.

By reason of the foregoing, Sundek is, and will continue to be, damaged by Registration No. 975,546 and prays that the Registration be cancelled, or, in the alternative, restricted.

This Cancellation Petition is accompanied by the filing fee as provided by Sections 14 and 31 of the Trademark Act and is being paid through a deposit account.

Respectfully submitted,



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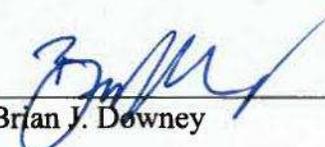
*Attorney for Sundek, LLC*

Dated: January 28, 2013

**CERTIFICATE OF SERVICE**

I, Brian J. Downey, hereby certify that on January 28, 2013, I caused a true and correct copy of the foregoing Applicant's Answer to Notice of Opposition and Counterclaim be served upon Opposer's Attorney of Record via first class mail, postage pre-paid, at the following address:

John Clarke Holman  
Jacobson Holman PLLC  
400 7<sup>th</sup> St., NW  
Washington, DC 20004

  
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Brian J. Downey