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

Proceeding	91220292
Party	Defendant The Spark Agency, Inc.
Correspondence Address	ANNETTE P HELLER HELLER & ASSOCIATES 400 CHESTERFIELD CTR, STE 400 CHESTERFIELD, MO 63017-4800 UNITED STATES tmattorneypto@aol.com
Submission	Opposition/Response to Motion
Filer's Name	Annette P. Heller
Filer's e-mail	tmattorneyheller@aol.com,tmattorneypto@aol.com,tmattorneyturek@aol.com
Signature	/aph72met/
Date	10/20/2015
Attachments	Switch Response to Motion for Partial Reconsideration.pdf(44467 bytes )

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

Swatch AG (Swatch SA) (Swatch Ltd) )  
Opposer, )  
v. ) Opposition No. 91220292  
The Spark Agency, Inc. )  
Applicant. )  
\_\_\_\_\_ )

**APPLICANT’S RESPONSE TO OPPOSER’S MOTION FOR PARTIAL  
RECONSIDERATION OF THE BOARD’S SEPTEMBER 9, 2015  
ORDER DENYING SUMMARY JUDGMENT**

Applicant hereby files its Response to Opposer’s Motion for Partial Reconsideration of the Board’s September 9, 2015 Order Denying Summary Judgment. Applicant respectfully requests that the Board deny Opposer’s Motion in its entirety.

Applicant agrees with Opposer’s statement of the law regarding claims for abandonment of marks registered under Section 44(e). To reiterate, a mark is abandoned when use has been discontinued and there is no intent to resume such use. For a mark that is registered under Section 44(e), an abandonment defense may be claimed at any time after the mark registers. If a party can show at least three years of non-use of the mark, the party is entitled to a presumption that there was no intent to resume such use of the mark. However, if a party pursues an abandonment claim before the three year period has elapsed, the party must show that use of the mark has been discontinued *and* there is no intent to resume such use.

In the Board’s decision denying Opposer’s Motion for Summary Judgment, the Board noted that “it is Opposer’s burden to show that Applicant became aware of the underlying facts

that constitute the basis for its abandonment claim” during the prior opposition between the parties. Board Order, 9. Opposer did not carry its burden and, therefore, the Board found that “the circumstances here do not establish that Applicant violated the compulsory counterclaim rule” by not raising its abandonment claim in the prior opposition. *Id.* at 10. To be sure, nowhere in the prior opposition’s evidentiary record does it indicate that Applicant became aware of specific facts showing that Opposer had no intent to resume use of its SWATCH mark in connection with “advertising agencies.”

In its Motion for Reconsideration, Opposer essentially argues that Applicant became aware during the prior opposition that Opposer was not using its SWATCH mark in connection with “advertising agencies” and, therefore, was required to bring the counterclaim for abandonment in the prior opposition during the testimony period. But, that argument only addresses the non-use aspect of an abandonment claim. It does not address the second half of an abandonment claim, which is intent not to resume use. Because the presumption of intent not to resume use had not yet been triggered prior to the close of Applicant’s trial period in the prior opposition, Applicant would have needed specific facts to prove Opposer’s intent not to resume use. Not surprisingly, Opposer fails to indicate in its Motion for Reconsideration where such facts exist in the prior opposition’s evidentiary record.

For the reasons set forth above, Applicant respectfully requests that the Board deny Applicant’s Motion for Partial Reconsideration and allow Applicant’s counterclaim for cancellation of Registration No. 3,799,562 to proceed to trial.

Respectfully submitted,

THE SPARK AGENCY, INC.

By:                     /aph72/                    

Dated:           10/20/2015          

Annette P. Heller  
Heller & Associates  
400 Chesterfield Center, Suite 400  
Chesterfield, MO 63017  
Tel: (314) 469-2610  
Fax: (314) 469-4850  
[tmattorneyheller@aol.com](mailto:tmattorneyheller@aol.com)

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing has been served by mailing said copy on   10/20/2015   via U.S. Mail, postage pre-paid, to:

Jeffrey A. Lindenbaum  
Collen IP  
The Holyoke-Manhattan Building  
80 S. Highland Ave.  
Ossining, NY 10562

                    /aph72/                      
Annette P. Heller, Attorney for Applicant