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

Proceeding	91222533
Party	Defendant FERRO Baking Industry Ltd
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Submission	Answer
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Date	08/04/2015
Attachments	Applicants_Answer_and_Affirmative_Defenses_8_4_2015.pdf(1163821 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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-----X	:	
FERRERO S.P.A.	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No. 91222533
	:	
FERRO BAKING INDUSTRY LTD	:	
	:	
Applicant.	:	
	:	
-----X	X	

APPLICANT’S ANSWER AND AFFIRMATIVE DEFENSES

Applicant, Ferro Baking Industry Ltd hereby sets forth its Answer, Defenses, and Affirmative Defenses to the Notice of Opposition, the subject of Proceeding No. 91222533, filed by Ferrero S.p.A. (hereinafter “Opposer”) and specifically states as follows:

In response to the introductory, unnumbered paragraph, Applicant lacks sufficient knowledge or information to form a belief as to the truth of the allegations regarding Opposer’s entity structure, status, and principal place of business, and therefore denies the allegations. Applicant further denies Opposer’s allegation therein that Opposer will be damaged by registration of Applicant’s subject mark.

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of numbered Paragraph 1 of the Notice of Opposition, and therefore denies the allegations.
2. In response to numbered Paragraph 2, Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations therein, and therefore denies the allegations.

3. In response to numbered Paragraph 3, Applicant admits that the United States Patent and Trademark Office records indicate that Opposer is the purported owner of United States Trademark Registration Nos. 3,181,623 and 1,017,527 for the alleged mark FERRERO covering the goods as recited therein, respectively. Applicant admits that the corresponding United States Patent and Trademark Office records reflect that the alleged mark was registered effective December 05, 2006 and August 05, 1975, respectively, and based on underlying applications filed in the United States Patent and Trademark Office on August 10, 2004 and July 22, 1974, respectively. Further answering, Applicant is without knowledge or information sufficient to form a belief as to the validity of the alleged registrations, the truth of the facts stated therein or Opposer's allegations respecting the alleged registrations, and therefore denies the contentions and allegations
4. In response to numbered Paragraph 4, Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations therein, and therefore denies the allegations.
5. Applicant admits the allegations of numbered Paragraph 5.
6. In response to numbered Paragraph 6, Applicant admits that the United States Patent and Trademark Office records reflect that United States Trademark Registration Nos. 3,181,623 and 1,017,527 were based on applications filed in the United States Patent and Trademark Office prior to Applicant's subject application. Further answering, Applicant is without knowledge or information sufficient to form a belief as to the validity of the alleged registrations, the truth of the facts stated therein or Opposer's allegations respecting the alleged registrations, and therefore denies the contentions and allegations.
7. Applicant denies the allegations of numbered Paragraph 7.
8. In response to numbered Paragraph 8, Applicant admits that the United States Patent and Trademark Office records reflect that the goods in Applicant's subject application are

categorized in International Class 030. Further answering, Applicant is without knowledge or information sufficient to form a belief as to the validity of the alleged registrations, the truth of the facts stated therein or Opposer's allegations respecting the alleged registrations, and therefore denies the contentions and allegations.

9. Applicant denies the allegations of numbered Paragraph 9.
10. Applicant denies the allegations of numbered Paragraph 10.
11. In response to numbered Paragraph 11, Applicant admits that the parties are distinct and that Applicant is not affiliated with or connected with or sponsored by Opposer. Further answering, Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations therein, and therefore denies the allegations.
12. Applicant denies the allegations of numbered Paragraph 12.
13. Applicant denies the allegations of numbered Paragraph 13.

In response to the final, unnumbered paragraph of the Notice Opposition, Applicant denies the allegations, if any, therein and further responds that the Opposition should be dismissed and the Applicant's subject marks forwarded to registration.

APPLICANT'S AFFIRMATIVE DEFENSES

1. Opposer has not and will not suffer any damage or injury by the registrations of Applicant's marks for Applicant's services recited in Applicant's subject applications because Opposer does not have exclusive rights in and to the term or letters FERR or FERRO for goods that are the same, related or complimentary services as Applicant's goods recited in Applicant's subject application.
2. The Opposition should be denied and dismissed with prejudice because, on information and belief, Opposer, has with full knowledge and intention acquiesced to Applicant's use in commerce since December 10, 2002.

3. The Opposition should be denied and dismissed with prejudice because, on information and belief, Opposer, has with full knowledge and intention acquiesced to the use in commerce since 1993 of a slightly or nominally different form of Applicant's mark by Applicant's related company, Athenian Family Bakery S.A., and which nominally different form was also the subject of U.S. Trademark Registration No. 2,825,080, registered on March 23, 2004, for goods identified as "bakery products, biscuits, breadsticks, pastries, wafer rolls," in International Class 030, and which registration Opposer also acquiesced to, and which registration was inadvertently cancelled on October 29, 2010 for failure to timely file in the United States Patent and Trademark Office the continued use documentation under Section 8 of the Trademark Act, 15 U.S.C. §1058, resulting in the filing of Applicant's subject application to merely replace in a slightly updated form U.S. Trademark Registration No. 2,825,080.
4. Consumers and the relevant trade are not likely to confuse Applicant's subject mark and goods with Opposer's for numerous and compelling reasons, including, but not limited to: the co-existence for more than ten (10) years of Opposer's claimed mark with Applicant's subject mark; the co-existence for more than twenty (20) years of Opposer's claimed mark with the nominally different form of Applicant's subject mark, specifically, the inadvertently cancelled mark, the subject of U.S. Trademark Registration No. 2,825,080; the irrefutable fact that Applicant's mark in its entirety is distinctly different in appearance, sound, commercial meaning and overall commercial impression from Opposer's; and that no one would possibly confuse the source or origin of the respective goods which goods are not marketed to the same consumers under circumstances that could give rise to any mistaken belief that the goods emanate from the same source.
5. On information and belief, a number of third parties have used, applied for and registered marks featuring or containing the term or letters FERR or FERRO for goods categorized in

International Classes 030. The U.S. Patent and Trademark Office (“PTO”) has already determined that no likelihood of confusion exists to bar the registration co-existence of such marks featuring or containing the term or letters FERR or FERRO.

6. On information and belief, in view of the contemporaneous registration and use by third parties of marks featuring or containing the term or letters FERR or FERRO for goods categorized in International Classes 030, consumers and the relevant trade have been conditioned to distinguish between and among the various uses of the term or letters FERR or FERRO as an identifier of source or mark. Accordingly, Opposer's claimed mark is not sufficiently strong, famous, or distinctive to bar the use or registration of Applicant's distinct mark for Applicant's goods.
7. The Notice of Opposition should be denied and dismissed with prejudice under the doctrine of unclean hands arising from the irrefutable fact that Opposer has with full knowledge and intention acquiesced to the use in commerce of Applicant's subject mark.
8. The Notice of Opposition should be denied and dismissed with prejudice arising from the irrefutable fact of Opposer's acquiescence to the use in commerce for more than twenty (20) years of the nominally different form of Applicant's subject mark, specifically, the inadvertently cancelled mark, the subject of U.S. Trademark Registration No. 2,825,080, and which registration Opposer acquiesced to dating from the corresponding registration date of March 23, 2004, and of which inadvertently cancelled mark in the name of Applicant's related company, Athenian Family Bakery S.A., is substantially similar to Applicant's subject mark and the corresponding goods are closely similar, related or are complimentary, such that Applicant's subject mark sought for registration also cause no potential injury or harm to Opposer.

9. The Notice of Opposition should be denied and dismissed with prejudice under the doctrine of laches arising from the irrefutable fact of Opposer's acquiescence to the use in commerce for more than ten (10) years of Applicant's subject mark.
10. The Notice of Opposition should be denied and dismissed with prejudice under the doctrine of laches arising from the irrefutable fact of Opposer's acquiescence to the use in commerce for more than twenty (20) years of the nominally different form of Applicant's subject mark, specifically, the inadvertently cancelled mark, the subject of U.S. Trademark Registration No. 2,825,080 in the name of Applicant's related company, Athenian Family Bakery S.A, and which registration Opposer acquiesced to dating from the corresponding registration date of March 23, 2004.
11. The Notice of Opposition should be denied and dismissed with prejudice under the doctrine of waiver arising from the irrefutable fact of Opposer's acquiescence to the use and registration co-existence for more than ten (10) years of Applicant's subject mark.
12. The Notice of Opposition should be denied and dismissed with prejudice under the doctrine of waiver arising from the irrefutable fact of Opposer's acquiescence to the use and registration co-existence for more than twenty (20) years of the nominally different form of Applicant's subject mark, specifically, the inadvertently cancelled mark, the subject of U.S. Trademark Registration No. 2,825,080 in the name of Applicant's related company, Athenian Family Bakery S.A, and which registration Opposer acquiesced to dating from the corresponding registration date of March 23, 2004.
13. The Notice of Opposition should be denied and dismissed with prejudice because Opposer's claimed rights in and to its alleged marks are weak and diluted arising from the contemporaneous registration and use by third parties of marks featuring or containing the term or letters FERR or FERRO for goods categorized in International Classes 030, such that

consumers and the relevant trade have been conditioned to distinguish between and among the various uses of the term or letters FERR or FERRO as an identifier of source or mark that Applicant's subject mark sought for registration also cause no potential injury or harm to Opposer.

WHEREFORE, Applicant respectfully requests that this Opposition be dismissed with prejudice and that Applicant's subject applications be allowed to registration.

Respectfully submitted,

FERRO BAKING INDUSTRY LTD

Dated: August 4, 2015

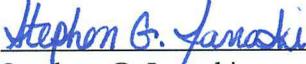
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Attorneys for Applicant

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that an electronic copy of the foregoing Applicant's ANSWER, DEFENSES, AND AFFIRMATIVE DEFENSES was filed with the U.S. Patent and Trademark Office through ESTTA this 4^m day of August 2015.



Stephen G. Janoski

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Applicant's ANSWER, DEFENSES, AND AFFIRMATIVE DEFENSES was deposited with the U.S. Postal Service, postage prepaid for delivery via First Class Mail this 4th day of August 2015 on attorney for Opposer at the following address:

Leo M. Loughlin, Esq.
Rothwell Figg Ernst & Manbeck PC
607 14th Street, N.W., 8th Floor
Washington, D.C. 20005

Stephen G. Janoski
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