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Filing date: **08/10/2015**

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

Proceeding	91222651
Party	Defendant Swiza S.A.
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Submission	Answer and Counterclaim
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Signature	/Bryce J. Maynard/
Date	08/10/2015
Attachments	Answer and Counterclaim.pdf(86122 bytes)

Registrations Subject to the filing

Registration No	3561647	Registration date	01/13/2009
Registrant	Swiss Army Brand Ltd. 7 Victoria Drive Monroe, CT 064681212 UNITED STATES		
Grounds for filing	The registration is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.		

Goods/Services Subject to the filing

Class 025. First Use: 2004/12/00 First Use In Commerce: 2004/12/00 All goods and services in the class are requested, namely: men's and women's clothing, namely, jackets, hats, sweaters, shirts, t-shirts, polo shirts, dress shirts, scarves, pants, shorts, coats, parkas, wind resistant jackets, rainwear, gloves, headwear
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Registration No	3769824	Registration date	04/06/2010
Registrant	WENGER S.A. ROUTE DE BALE 63 DELEMONT, CH-2800 SWITZERLAND		
Grounds for filing	The registration is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.		

Goods/Services Subject to the filing

Class 009. First Use: 2004/07/31 First Use In Commerce: 2004/07/31 All goods and services in the class are requested, namely: Computer carrying cases, camera cases, electronic travel accessories, namely, adapters, converters, transformers and battery chargers for electronic devices

Class 018. First Use: 2003/10/18 First Use In Commerce: 2003/10/18
 All goods and services in the class are requested, namely: All-purpose dry carrying bags, luggage, backpacks, daypacks, duffel bags; utility bags, namely, carry-all bags; shoulder bags; casual carry-all bags, and casual tote bags; briefcases; non-motorized wheeled packs, namely, back packs and sport packs; travel bags, small personal leather goods, namely, wallets, and shaving bags sold empty, umbrellas and name and calling card cases, cosmetic cases sold empty, toiletry cases sold empty, luggage tags, waistpacks; bags worn on the body, namely, fanny packs; business cases, all-purpose personal care toiletry bags sold empty, small personal leather goods, namely, billfolds, credit card cases, neck and necklace wallets

Registration No	4230244	Registration date	10/23/2012
Registrant	WENGER S.A. ROUTE DE BALE 63 DELEMONT, CH-2800 SWITZERLAND		

Goods/Services Subject to the filing

Class 025. First Use: 2011/09/25 First Use In Commerce: 2011/09/25
 All goods and services in the class are requested, namely: Clothing, namely, footwear, shoes, boots, hats, socks, hosiery, headwear

Registration No	3291272	Registration date	09/11/2007
Registrant	Wenger S.A. Route de Bâcle 63 CH-2800 Delemont, SWITZERLAND		
Grounds for filing	The registration is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.		

Goods/Services Subject to the filing

Class 009. First Use: 2004/07/00 First Use In Commerce: 2004/07/00
 All goods and services in the class are requested, namely: Computer carrying cases, camera cases, electronic travel accessories, namely, adapters, converters, transformers and battery chargers for electronic devices

Class 018. First Use: 2003/10/18 First Use In Commerce: 2003/10/18
 All goods and services in the class are requested, namely: All-purpose dry bags, luggage, backpacks, daypacks, duffel bags, utility bags, shoulder bags, casual bags, briefcases, [non-motorized wheeled packs,] cosmetic cases sold empty and toiletry cases sold empty, travel bags, small personal leather goods, namely, wallets, and shaving bags sold empty, umbrellas and name and calling card cases, cosmetic cases sold empty, toiletry cases sold empty, luggage tags, waistpacks, bags worn on the body, business cases, travel bags, all-purpose personal care bags, small personal leather goods, namely, billfolds, credit card cases, neck and necklace wallets

Class 025. First Use: 2006/10/00 First Use In Commerce: 2006/10/00
 All goods and services in the class are requested, namely: Clothing, namely, security money belts

Registration No	3291266	Registration date	09/11/2007
Registrant	Wenger S.A. Route de Bâcle 63 CH-2800 Delemont, SWITZERLAND		
Grounds for filing	The registration is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.		

Goods/Services Subject to the filing

Class 009. First Use: 2004/07/00 First Use In Commerce: 2004/07/00

All goods and services in the class are requested, namely: Computer carrying cases

Class 018. First Use: 2003/10/18 First Use In Commerce: 2003/10/18

All goods and services in the class are requested, namely: All-purpose dry bags, luggage, backpacks, daypacks, duffel bags, utility bags, shoulder bags, casual bags, briefcases, [non-motorized wheeled packs,] cosmetic cases sold empty and toiletry cases sold empty, travel bags, small personal leather goods, namely, wallets, shaving bags sold empty

5. Applicant denies that Opposers' retail store in New York City offers goods "from all product categories." Applicant lacks sufficient information to form a belief as to the other allegations in Paragraph 5, and therefore denies the same.

6. Applicant admits that the TSDR Electronic Database of the USPTO reflects that Opposers are the owners of the registrations specifically identified in Paragraph 6. Applicant lacks sufficient information to form a belief as to the other allegations in Paragraph 6, and therefore denies the same

7. Applicant admits that the TSDR Electronic Database of the USPTO reflects that Opposers are the owners of the registrations specifically identified in Paragraph 6, and that those registrations are unrevoked and uncanceled. Applicant denies the remaining allegations in Paragraph 7.

8. Denied.

9. Admitted.

10. Applicant admits that it has a licensing agreement with Switz Licensing S.A., and that Switz Licensing S.A. is the owner of the identified trademark applications. Applicant denies that these applications cover goods that are identical or closely related to the goods on which Opposers use or have used their purported marks.

11. Applicant admits that it filed Application Serial No. 86/423,254 covering the identified goods. Applicant denies that this application is for the word mark SWIZA.

12. Opposers' Paragraph 12 does not make any factual averments and does not require an admittance or denial.

13. Applicant incorporates by reference its responses to Paragraphs 1 through 12.

14. Denied.

15. Denied.

16. Denied.

17. Denied.
18. Denied.
19. Applicant incorporates by reference its responses to Paragraph 1 through 18.
20. Denied.
21. Denied.
22. Admitted.
23. Applicant admits that it has a licensing agreement with Switz Licensing SA, a company located in Switzerland.
24. Applicant has not yet sold any goods bearing Applicant's Mark in the United States. Applicant therefore denies the allegations in Paragraph 24.
25. Denied.
26. Denied.
27. Applicant incorporates by reference its responses to Paragraph 1 through 26.
28. Denied.
29. Applicant has not yet sold any goods bearing Applicant's Mark in the United States. Applicant therefore denies the allegations in Paragraph 29.
30. Denied.
31. Denied.

AFFIRMATIVE DEFENSES

1. Opposer has failed to state a claim on which relief may be granted.
2. Opposer's Marks are distinguishable from Applicant's Mark due to the significant differences in appearance, pronunciation, and commercial impression, as well as the differences in the parties' goods, channels of trade, channels of marketing, and the sophistication of the relevant consumers.

3. Opposer's Marks are weak and entitled to an extremely limited scope of protection.

4. Applicant's Mark SWIZA (Stylized) is not geographically descriptive because "Swiza" is not the word for "Swiss" in Spanish or any other language.

5. Applicant's Mark SWIZA (Stylized) is not geographically descriptive because there is no goods/place association between Switzerland and the goods listed in the application.

6. Applicant's Application Serial No. 86/423,254 covers a stylized form of the mark SWIZA, not the word mark itself. Therefore, even if the term "Swiza" is somehow considered geographically descriptive, Application Serial No. 86/423,254 is still entitled to registration on the Principal Register.

7. Opposer has abandoned its purported marks by failing to enforce them against the widespread use of SWISS marks by others.

8. Opposer's claims are barred on the grounds of trademark misuse and unclean hands.

COUNTERCLAIM FOR CANCELLATION

Applicant Swiza S.A. ("Applicant"), a Swiss corporation located and doing business at Rue St-Maurice 1, 2800 Delemont, Switzerland, believes that it will be damaged by the continued registration of Opposer Swiss Army Brand Ltd.'s U.S. Reg. No. 3,561,647 and Opposer Wenger S.A.'s U.S. Reg. Nos. 3,769,824; 4,230, 244; 3,291,272; and 3,291,266 in Classes 9, 18, and 25, and hereby petitions for cancellation of said registrations for the reasons set forth herein.

1. Applicant repeats and realleges each and every allegation set forth in the Answer and Affirmative Defenses as if set forth herein.

2. Opposer Swiss Army Brand Ltd. is the owner of U.S. Reg. Nos. 3,561,647 for the mark SWISS ARMY.

3. Opposer Swiss Army Brand Ltd.'s use of the term SWISS in the mark SWISS ARMY in connection with clothing products in Class 25 is likely to cause consumers to believe that Opposer's clothing products sold under the SWISS ARMY mark originate in Switzerland.

4. Upon information and belief, Opposer Swiss Army Brand Ltd.'s clothing products sold under the SWISS ARMY mark are not made in Switzerland and do not originate in Switzerland.

5. Opposer Swiss Army Brand Ltd.'s use of the mark SWISS ARMY in connection with clothing products that are not made in Switzerland and do not originate in Switzerland is likely to confuse and deceive the public as to the geographic source of the clothing products sold under Opposer's SWISS ARMY mark.

6. Opposer Swiss Army Brand Ltd.'s U.S. Reg. No. 3,561,647 is geographically deceptive in violation of 15 U.S.C. §1052(e)(3).

7. Opposer Wenger S.A. is the owner of U.S. Reg. Nos. 3,769,824; 4,230, 244; 3,291,272; and 3,291,266 for the mark SWISSGEAR. These registrations cover, among other goods and services, computer carrying cases in Class 9; bags, cases, and small leather goods in Class 18; and clothing products in Class 25.

8. Opposer Wenger S.A.'s use of the term SWISS in the mark SWISSGEAR in connection with computer carrying cases; bags, cases, and small leather goods; clothing products; and related products is likely to cause consumers to believe that these products sold under the SWISSGEAR mark originate in Switzerland.

9. Upon information and belief, Opposer Wenger S.A.'s computer carrying cases; bags, cases, and small leather goods; clothing products; and related products sold under the SWISSGEAR mark are not made in Switzerland and do not originate in Switzerland.

10. Opposer Wenger S.A.'s use of the mark SWISSGEAR in connection with computer carrying cases; bags, cases, and small leather goods; clothing products; and related

products that are not made in Switzerland and do not originate in Switzerland is likely to confuse and deceive the public as to the geographic source of the products sold under Opposer's SWISSGEAR mark.

11. Opposer Wenger S.A.'s U.S. Reg. Nos. 3,769,824; 4,230, 244; 3,291,272; and 3,291,266 are geographically deceptive in violation of 15 U.S.C. §1052(e)(3).

12. Applicant will be harmed by the continued registration of Opposer Swiss Army Brand Ltd.'s U.S. Reg. No. 3,561,467 and Opposer Wenger S.A.'s U.S. Reg. Nos. 3,769,824; 4,230,244; 3,291,272; and 3,291,266 because Opposer Swiss Army Brand Ltd. and Opposer Wenger S.A. are relying upon these registrations as a basis for their opposition against Applicant's pending Application Serial No. 86/423,254.

WHEREFORE, Applicant requests that the Opposition be denied; that Application Serial No. 86/423,254 be allowed to register; that Opposer Swiss Army Brand Ltd.'s U.S. Reg. No. 3,561,467 be cancelled; that Opposer Wenger S.A.'s U.S. Reg. Nos. 3,769,824; 4,230,244; 3,291,272; and 3,291,266 be cancelled; and for such further relief as may be proper.

Respectfully submitted,

SWIZA S.A.

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Date: August 10, 2015

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIM FOR CANCELLATION was served this 10th day of August, 2015 by U.S. mail and electronic mail on:

David Weild, III
Locke Lord LLP
FDR Station, PO Box 130
New York, NY 10150

Florence Goodman