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

Proceeding	91224325
Party	Defendant Invicta S.p.A.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of U.S. Trademark Application Serial No. 86/301,552  
For the mark INVICTA  
Published in the *Official Gazette* on June 16, 2015

INVICTA WATCH COMPANY OF AMERICA, INC.,

Opposer,

vs.

INVICTA S.P.A.,

Applicant.

Opposition No. 91224325

**APPLICANT'S REPLY IN SUPPORT OF ITS MOTION FOR  
LEAVE TO AMEND GOODS AND TO CONSOLIDATE PROCEEDINGS**

In its opposition to Applicant's motions to amend identification of goods in the application in issue, and to consolidate this and another proceeding involving the same mark, the same parties and highly related goods and services, Opposer makes a series of baseless arguments. There is little reason for Opposer to contest these motions so early in the proceedings before any discovery requests have been served by either party, except to drive up Applicant's costs and needlessly consume the Board's resources in deciding routine issues that might have been resolved with Opposer's consent. Granting the motions will enable the Board to efficiently adjudicate this proceeding and would not result in any prejudice to Opposer. It is also consistent with past consolidations by the Board of proceedings involving the same mark and parties even where the goods/services were less related than they are here.

## ARGUMENT

### **I. Applicant Should Be Allowed to Amend its Class 18 and Class 25 Identifications Early in this Proceeding to Focus on Goods to be Sold by Applicant because Such Amendment Does Not Impact the Validity of the Application and There is Thus No Prejudice to Opposer**

Opposer speciously argues that Applicant may not delete *any* of the goods from its identifications in Classes 18 and 25 because at the time of filing, Applicant purportedly did not intend to offer such goods for sale. In fact, Applicant *did* have a good faith intent to use the mark for *all* the goods identified in Class 18 and Class 25. However, for purpose of streamlining this proceeding, and consistent with its changed plans, it has narrowed its identification in these classes to feature a smaller list of goods.

The Board has recognized that an applicant can amend the description of services set forth in an application where the mark will be used with some but not all of the recited services. *See Grand Canyon West Ranch, LLC v. Hualapai Tribe*, 78 USPQ2d 1696, 1698 (TTAB 2006) (granting applicant's motion to amend application to delete services from use-based application, where a basis for opposition included claim of applicant's lack of bona fide intent to use, and where applicant had not yet used mark in connection with such services); *see also Spirits Int'l, B.V. (Formerly Spirits Int'l N.V.) v. S.S. Taris Zeytin Ve Zeytinyagi Tarim Satis Kooperatifleri Birliđi*, 99 USPQ2d 1545, 1547 n.3 (TTAB 2011) (recognizing that, in opposition involving claim by opposer that applicant lacked a bona fide intent to use mark for certain goods, applicant could have moved to delete those goods which it no longer intended to use under the mark). Consistent with these decisions, the Board should not be tasked with adjudicating whether Applicant intended to sell certain identified goods at the time of filing, if this is not Opposer's present intent. Opposer is not prejudiced in any way by such amendment which is being made early in this proceeding before any discovery requests have been served by either party. Indeed

the only pleading Opposer has served in this proceeding (apart from papers relating to this motion) is its Notice of Opposition. This pleading can be amended if warranted by the narrowed identification.

Further, even if Opposer were able to prove that Applicant did not intend to engage in sales of *some* of the goods identified under Classes 18 and 25 at the time of filing, this would have no effect on the validity of the application with respect to those *remaining* goods in Classes 18 and 25 which it did have the intention of offering. The Federal Circuit has made clear that a U.S. trademark application or registration should not be voided in its entirety even if the applicant or registrant did not use the mark for some of the goods/services in a given class (or indeed even all the goods in one class). This is the law even if the applicant or registrant falsely declared they *were* in use in a Statement of Use or Section 8 declaration. *See In re Bose Corp.*, 91 USPQ2d 1938, 1942 (Fed. Cir. 2009) (finding that even where registrant's affiant submitted Section 8 affidavit attesting to use of mark on goods where company had stopped manufacturing such products, registration shall only be restricted only as to those goods no longer in use); *see also M.C.I. Foods Inc. v. Bunte*, 96 USPQ2d 1544, 1549-50 (TTAB 2010). Thus, there is no reason to deny Applicant's motion to amend the identification of goods in Classes 18 and 25. Opposer's behavior in opposing the motion to amend cannot be justified by any real prejudice; instead it is clearly obstreperous.

## **II. The Motion to Consolidate Should Be Granted**

Opposer frivolously argues that, because there are some minor differences in the bases for its oppositions, that two proceedings involving the same parties and mark, the same legal issues and identical procedural postures, should not be consolidated. Contrary to Opposer's contentions, it makes little difference whether Applicant claims intent to use under Section 44(e)

(as in the present proceeding) or under Section 66(a) (as in Opp. No. 91222434). The issue—Applicant’s good faith intent to use the mark for all the goods/services—is the same. Moreover, proceedings need not involve identical applications with the same filing bases and identifications in the same classes for consolidation to be appropriate. *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1297 (TTAB 1997) (granting motion to consolidate as found “sufficient commonality of factual issues” where both proceedings involved the same mark and virtually identical pleadings); *Ritchie v. Simpson*, 41 USPQ2d 1859 (TTAB 1996), *rev’d on other grounds*, 50 USPQ2d 1023 (Fed. Cir. 1999) (“Inasmuch as the notices of opposition are virtually identical and present common questions of law and fact, despite the variations in the marks and goods involved, the Board has found it appropriate to consolidate the cases.”). Indeed, applications in issue in related oppositions will never be identical as such trademark applications would be duplicative and thus not concurrently allowed by the Trademark Office. Here, the parties and the marks are identical, and the goods/services are highly related (Class 18 and 25 goods and Class 35 services featuring the same or highly similar goods). The legal issues in both cases are also identical; both in this proceeding and in the related proceeding Opposer claims likelihood of confusion, dilution and Applicant’s lack of intention to use the mark. *See, e.g.*, Notice of Opposition in present proceeding at ¶¶ 11 (asserting Applicant’s lack of good faith to use mark for goods in Classes 18 and 25), 13 (claiming fame of Opposer’s mark), 15 (asserting claim of likelihood of confusion), 16 (asserting dilution claim) and *compare with* Notice of Opposition in Opp. No. 91222434 ¶¶ 9 (asserting Applicant’s lack of good faith intent to use mark for service in Class 35), 10 (asserting likelihood of confusion), 12 (claiming fame of Opposer’s marks), 13 (asserting dilution claim). Moreover, after numerous prior Board

proceedings and a court action, the parties have negotiated and entered into a series of settlement agreements addressing coexistence which is dispositive of the issues in both cases.

Notwithstanding Opposer's arguments, the presence of a registration owned by Opposer for services in the same class (35) as in the sister proceeding, No. 91222434, but its lack of ownership of a registration for goods (classes 18/25) in this proceeding, is no reason to deny a motion to consolidate. Rather the key issue is that the goods/services in both cases are indisputably related if not identical. *A-I-A Corp. v. The Gillette Co.*, 199 USPQ 118 (TTAB 1978) (granting motion to consolidate on the basis that goods in each proceeding were similar, as well as finding similarities between marks at issue and identity of the parties). It would simply be more efficient to address these identical claims all at once. This is consistent with the Board's prior consolidation of disputes between these very same parties and involving the very same mark, INVICTA (or marks including the term INVICTA) where those proceedings were in a similar procedural posture as here and even where they involved goods or services arguably less related than those in the present case. *See* Opposition Nos. 91173241, 91181405, and 91192448.<sup>1</sup>

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<sup>1</sup> Indeed, Applicant and Opposer's prior proceedings were consolidated despite variations between the proceedings. Opposition No. 91173241 (which involved Opposer's opposition to Applicant's application for the mark INVICTA in Classes 9, 18, 25) was consolidated with Opposition No. 91181405 (involving Applicant's opposition to Opposer application for I INVICTA RESERVE FOR THE FEW WHO KNOW BEST in Class 25), following the filing of a contested motion to consolidate by Applicant. Through a Board Order dated July 11, 2008, such proceedings were consolidated despite the fact that proceedings were initiated over one year apart and differences in the marks and goods at issue. In addition, through a consented motion, Applicant and Opposer jointly sought to consolidate Opposition No. 91173241 with Opposition No. 91192448 (involving Applicant's opposition to Opposer's application for INVICTA ELEMENTS YOUR BASIC CATALYSTS for goods in Class 16), again despite different procedural postures and variations the marks and goods at issue.

**CONCLUSION**

For the foregoing reasons, Applicant's motions should be granted.

Dated: New York, New York  
January 29, 2016

NORRIS, McLAUGHLIN & MARCUS, P.A.



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**CERTIFICATE OF SERVICE**

I hereby certify that on January 29, 2016 a copy of the foregoing Applicant's Reply in Support of its Motion to Amend Goods and Consolidation is being deposited with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to the attorneys for Opposer as follows:

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