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

Proceeding	91227595
Party	Defendant Pabst Brewing Company, LLC
Correspondence Address	Anne H. Peck Cooley LLP 1299 Pennsylvania Avenue, NW, Suite 700 Washington, DC 20004-2400 trademarks@cooley.com
Submission	Answer and Counterclaim
Filer's Name	Anne H. Peck
Filer's e-mail	trade- marks@cooley.com,peckah@cooley.com,jpo@cooley.com,cvcamp@cooley.co m
Signature	/Anne H. Peck/
Date	06/08/2016
Attachments	pabst answer to ANDEKER notice of opposition defenses and counterclaim 132630499_2.pdf(33880 bytes)

Registration Subject to the filing

Registration No	4823056	Registration date	09/29/2015
Registrant	Klosterbrauerei Andechs Bergstrasse 2 Andechs, 82346 GERMANY		

Goods/Services Subject to the filing

Class 032. First Use: 1455/00/00 First Use In Commerce: 2013/00/00
All goods and services in the class are requested, namely: beer

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

In the matter of Application Serial No. 86/634,099
For the mark: ANDEKER
Published in the *Official Gazette*: November 10, 2015

KLOSTERBRAUEREI ANDECHS)	
)	
Opposer-Counterdefendant,)	Opposition No. 91227595
)	
v.)	
)	
PABST BREWING COMPANY, LLC,)	
)	
Applicant-Counterclaimant.)	
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**ANSWER TO NOTICE OF OPPOSITION WITH
AFFIRMATIVE DEFENSES AND COUNTERCLAIM**

Applicant Pabst Brewing Company, LLC (“Applicant” or “Pabst”) answers the Notice of Opposition filed by Klosterbrauerei Andechs (“Opposer”) against Applicant’s application for the ANDEKER mark, Serial No. 86/634,099, (the “ANDEKER Mark”) as follows:

In response to the first unnumbered paragraph of the Notice of Opposition, Applicant denies that Opposer will be damaged by the registration of the ANDEKER Mark.

1. Denied. Applicant Pabst Brewing Company, LLC is a Delaware limited liability company having an address of 10635 Santa Monica Boulevard, Suite 350, Los Angeles, CA 90025.

2. Admitted.

3. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 3 of the Notice of Opposition, and on that basis denies the same.

4. Applicant admits that U.S. Patent and Trademark Office (“PTO”) records indicate that Opposer is the owner of record for U.S. Trademark Reg. No. 4,823,056 for the mark ANDECHS. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegation that Opposer actually owns the referenced registration, and on that basis denies the remaining allegations contained in Paragraph 4 of the Notice of Opposition.

5. Applicant admits that PTO records indicate that Opposer is the owner of record for U.S. Trademark Reg. No. 3,700,617 for the mark KLOSTER ANDECHS SEIT 1455 GENUß FÜR LEIB & SEELE and Design. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegation that Opposer actually owns the referenced registration, and on that basis denies the remaining allegations contained in Paragraph 5 of the Notice of Opposition.

6. Applicant admits that PTO records indicate that Opposer is the owner of record for U.S. Trademark Application Serial No. 86/204,324 for the mark KLOSTER ANDECHS. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegation that Opposer actually owns the referenced application, and on that basis denies the same and the remaining allegations contained in Paragraph 6 of the Notice of Opposition.

7. Paragraph 7 contains no allegations of fact to which an answer is required. To the extent an answer is required, Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegation that the identified goods are “Opposer’s Goods”, and on that basis denies the allegations in Paragraph 7 of the Notice of Opposition.

8. Applicant admits that the asserted registrations ANDECHS and KLOSTER ANDECHS SEIT 1455 GENUß FÜR LEIB & SEELE are currently shown as “live” on the

PTO's trademark registry. The remaining allegations contain legal conclusions to which no response is required. To the extent a response is required, Applicant denies the remaining allegations contained in Paragraph 8 of the Notice of Opposition.

9. Denied. Opposer's consent includes, but is not limited to, the acknowledgement of the long term concurrent use of the respective marks in a letter agreement dated September 29, 2009.

10. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 10 of the Notice of Opposition, and on that basis denies the same.

11. Admitted.

12. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 12 of the Notice of Opposition, and on that basis denies the same.

13. Denied.

14. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 14 of the Notice of Opposition, and on that basis denies the same.

15. Denied.

16. Denied.

17. In response to Paragraph 17 of the Notice of Opposition, Applicant asserts that no response is required because the paragraph consists of legal assertions and conclusions. To the extent a response is required, Applicant denies that the Trademark Trial and Appeal Board

should refuse registration of the ANDEKER Mark under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

AFFIRMATIVE DEFENSES

Applicant asserts the following separate and additional defenses to the Notice of Opposition, without assuming the burden of proof on such defenses that would otherwise fall on Opposer. Applicant reserves the right to seek leave to amend these defenses based on its ongoing investigation and discovery into the matters alleged in the Notice of Opposition. Applicant does not knowingly or intentionally waive any applicable defense.

FIRST AFFIRMATIVE DEFENSE

(Acquiescence)

1. Opposer's claims are barred because of Opposer's intentional acts, the inexcusable delay between the intentional acts and the assertion of the right or claim, and the resulting undue prejudice to Applicant.

2. In 2009, Opposer requested an extension of time to oppose, but did not oppose, Applicant's Application Serial No. 77/638,290 for ANDEKER.

3. In a letter agreement by and between Opposer and Applicant, dated September 29, 2009 (the "2009 Letter Agreement"), countersigned by a representative of Applicant on October 7, 2009, counsel for Opposer wrote:

We are aware of the long term concurrent use of our clients' respective marks [ANDECHS and ANDEKER] for beer. And we are aware of no instances of confusion. We believe that the same situation will be true with respect to water.

4. The delay between Opposer's intentional acts and the assertions of the alleged rights and claims in the Notice of Opposition was not excusable.

5. The delay has caused Applicant undue prejudice, including but not limited to harm to Applicant in that it made an investment in expanding its business relating to the ANDEKER trademark and filing the presently opposed trademark application, after Opposer actively represented that it would not assert a right or claim.

6. Accordingly, the doctrine of acquiescence bars the claim in the Notice of Opposition completely.

SECOND AFFIRMATIVE DEFENSE

(Laches)

7. Applicant realleges and incorporates herein by reference paragraphs 1 through 6 of these Affirmative Defenses as if fully set forth here.

8. Applicant, through its predecessors-in-interest, first used in commerce and applied to register the ANDEKER trademark for beer in 1938.

9. Upon information and belief, Opposer's ANDEKER trademark and Applicant's ANDECHS trademark have coexisted for many years.

10. The 2009 Letter Agreement acknowledges the long term concurrent use of the respective marks. Opposer has had actual knowledge since at least the 2009 Letter Agreement, and upon information and belief for many years prior to the 2009 Letter Agreement, regarding Applicant's ANDEKER mark.

11. Opposer has not did not challenge any of Applicant's ANDEKER trademark applications or registrations in the years prior to the filing of the instant Notice of Opposition and

a separate Petition for Cancellation, both filed on April 26, 2016, with associated correspondence starting in or about March 2016.

12. Opposer further delayed in not bringing its claim promptly after the November 10, 2015 publication of the presently opposed mark.

13. Upon information and belief, Opposer has no legitimate excuse for its delay.

14. Applicant has invested significant time, money, and other resources in pursuit of its ANDEKER trademark, including but not limited to an investment in expanding its business relating to the ANDEKER trademark and filing the presently opposed trademark application, in reliance on the absence of a challenge from Opposer.

15. Opposer's delay has therefore prejudiced Applicant.

16. Accordingly, the doctrine of laches bars the claim in the Notice of Opposition completely.

THIRD AFFIRMATIVE DEFENSE

(Equitable Estoppel)

17. Applicant realleges and incorporates herein by reference paragraphs 1 through 16 of these Affirmative Defenses as if fully set forth here.

18. Opposer's misleading conduct, which include not only its statements in the 2009 Letter Agreement but also its longstanding silence and inaction, led Applicant to reasonably infer that rights would not be asserted against it.

19. Applicant relied upon this conduct in expanding its plans for the ANDEKER trademark, including but not limited to making an investment in expanding its business relating to the ANDEKER trademark and filing the presently opposed trademark application.

20. Due to this reliance, prejudice would result to Applicant if the delayed assertion of rights were permitted. For example, Applicant would not be able to enjoy the benefits of federal registration for its ANDEKER trademark that would otherwise result from the presently opposed application and Applicant's investment in the ANDEKER trademark would be jeopardized.

21. Accordingly, the doctrine of equitable estoppel bars the claim in the Notice of Opposition completely.

FOURTH AFFIRMATIVE DEFENSE

(Prior Registration *Morehouse* Defense)

22. Applicant realleges and incorporates herein by reference paragraphs 1 through 21 of these Affirmative Defenses as if fully set forth here.

23. Applicant already owns a substantially similar registered mark for substantially similar goods such that the second registration causes no added injury to Opposer.

24. Specifically, Applicant owns U.S. Trademark Registration No. 363,733 for ANDEKER (Stylized) in connection with "beer," and the currently opposed U.S. Trademark Application Serial No. 86634099 is for ANDEKER in connection with "beer, malt beer."

25. Accordingly, the prior registration defense recognized in *Morehouse Manufacturing Corp v. J. Strickland and Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969) bars the claim in the Notice of Opposition completely.

FIFTH AFFIRMATIVE DEFENSE

(Contractual Estoppel)

25. Applicant realleges and incorporates herein by reference paragraphs 1 through 24 of these Affirmative Defenses as if fully set forth here.

26. In the 2009 Letter Agreement, Opposer explicitly agreed not to oppose Applicant's then pending application for "Andeker," and not to contest in any way Applicant's use of the "Andeker" mark for bottled water or distilled water.

27. In the 2009 Letter Agreement, Opposer went on to say that the situation for water would be the same as the situation for beer.

28. Contractual estoppel bars the claim in the Notice of Opposition completely.

SIXTH AFFIRMATIVE DEFENSE

(Unclean Hands)

29. Applicant realleges and incorporates herein by reference paragraphs 1 through 29 of these Affirmative Defenses as if fully set forth here.

30. One of fundamental principles upon which equity jurisdiction is founded requires that complainant must show not only that it has good and meritorious cause of action, but that it comes into court with clean hands, before it has standing in court.

31. Opposer's misconduct described above, including stating in the 2009 Letter Agreement that Opposer would not oppose or contest in any way Applicant's application for ANDEKER for water because of a lack of confusion with ANDECHS that is the same situation as the lack of confusion arising from the concurrent use of the respective marks for beer, pertains to Opposer's present claim for likelihood of confusion.

31. Accordingly, the claim is barred by the doctrine of unclean hands.

WHEREFORE, Applicant requests that the Opposition be dismissed in its entirety with prejudice.

COUNTERCLAIM

PETITION TO CANCEL U.S. REGISTRATION NO. 4,823,056

Pabst Brewing Company, LLC, a Delaware limited liability company having its principal place of business at 10635 Santa Monica Boulevard, Suite 350, Los Angeles, California, 90025 United States (hereafter, “Counterclaim Petitioner”) believes it is being damaged by the continued registration on the Principal Register of the mark ANDECHS shown in Registration No. 4,823,056 and hereby petitions to cancel the same on the ground that the mark is geographically descriptive under Section 2(e)(2) of the Lanham Act.

As grounds for its petition, Counterclaim Petitioner alleges as follows.

1. Registrant, Klosterbrauerei Andechs (“Registrant”), a German corporation having its principal place of business at Bergstrasse 2, Andechs, Germany 82346, obtained U.S. Registration No. 4,823,056 on September 29, 2015, claiming a first use date of 2013, for the trademark ANDECHS on or in connection with “beer” in Class 32 (hereafter “Registrant’s Mark”).

2. Counterclaim Petitioner is being damaged by continued registration of Registrant’s Mark in that Registrant relies upon Registration No. 4,823,056 as grounds for Opposition No. 91227595, an opposition against Counterclaim Petitioner’s pending Application No. 86/634,099 to register the mark ANDEKER.

3. On information and belief, the primary significance to relevant consumers of the term “ANDECHS” is the name of a place known generally to the public. It is a municipality in the district of Stamberg in Bavaria in Germany.

4. On information and belief, Registrant’s Mark is used in connection with goods, namely beer, that are brewed in the Andechs municipality in Germany.

5. Because the goods do come from the location named, a goods/place association may be presumed.

6. The relevant public would be likely to make a goods/place association.

7. The term “ANDECHS” does not have secondary meaning associated with Registrant.

8. Andechs is not sufficiently remote, minor, or obscure that the goods/place association would not be made.

9. Thus, the term “ANDECHS” is understood by relevant consumers as referring to the geographic location where Registrant’s beer is brewed and it is a geographically descriptive term.

* * * *

CERTIFICATE OF SERVICE

I hereby certify that on June 8, 2016, I mailed the foregoing **ANSWER TO NOTICE OF OPPOSITION WITH AFFIRMATIVE DEFENSES AND COUNTERCLAIM** by depositing true and correct copies of the same with the United States Postal Service, postage prepaid, first class mail, in envelopes addressed to Opposer/Registrant Klosterbrauerei Andechs's USPTO addresses of record:

Klosterbrauerei Andechs
Bergstrasse 2
Andechs, 82346
Germany

(Klosterbrauerei Andechs's USPTO Address of Record)

Michael J. Leonard
Fox Rothschild LLP
997 Lenox Drive, Bldg. 3
Lawrenceville, NJ 08648-2311
U.S.A.

(Klosterbrauerei Andechs's Attorney of Record)

Date: June 8, 2016

/John Paul Oleksiuk/
John Paul Oleksiuk

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ANSWER & COUNTERCLAIM
OPPOSITION NO. 91227595