

ESTTA Tracking number: **ESTTA759732**

Filing date: **07/21/2016**

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

| | |
|------------------------|--|
| Proceeding | 91227595 |
| Party | Plaintiff Klosterbrauerei Andechs |
| Correspondence Address | MICHAEL J LEONARD FOX ROTHSCHILD LLP 997 LENOX DRIVE , BLDG 3 LAWRENCEVILLE, NJ 08648-2311 UNITED STATES ipdocket@foxrothschild.com, mleonard@foxrothschild.com |
| Submission | Answer to Counterclaim |
| Filer's Name | Chritopher D. Olszyk, Jr. |
| Filer's e-mail | ipdocket@foxrothschild.com, colszyk@foxrothschild.com, mleonard@foxrothschild.com |
| Signature | /CDO/ |
| Date | 07/21/2016 |
| Attachments | 91227595 - Answer and Affirmative Defenses to Counterclaim - AN-DEKER.pdf(19033 bytes) |

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

| | | |
|----------------------------|---|-------------------------|
| KLOSTERBRAUEREI ANDECHS, | : | |
| | : | |
| Opposer-Counterdefendant, | : | |
| | : | |
| v. | : | |
| | : | Opposition No. 91227595 |
| PABST BREWING COMPANY LLC, | : | |
| | : | |
| Applicant-Counterclaimant | : | |

**ANSWER AND AFFIRMATIVE DEFENSES TO
COUNTERCLAIM PETITION TO CANCEL**

In response to the Counterclaim of Applicant-Counterclaimant, Pabst Brewing Company, LLC, filed 8 June 2016, and pursuant to the Board’s Order of 22 June 2016, for its Answer to the Counterclaim Petition to Cancel Registration No. 4,823,056, Registrant and Opposer-Counterdefendant Klosterbrauerei Andechs, responds as follows:

Regarding the allegations contained in the preamble of the Counterclaim Petition to Cancel, Registrant denies that Counterclaim Petitioner will be damaged by the continued registration of the mark ANDECHS as shown in Registration No. 4,823,056, as the mark is not geographically descriptive under Section 2(e)(2) of the Lanham Act.

1. Registrant Admits the allegations contained in Paragraph 1 of the Counterclaim.
2. Registrant denies the allegation contained in Paragraph 2 of the Counterclaim.
3. Registrant denies the allegation contained in Paragraph 3 of the Counterclaim.

The trademark ANDECHS has a primary significance as a brand of beer of the Registrant.

4. Registrant Admits the allegations contained in Paragraph 4 of the Counterclaim.

5. The allegations contained in Paragraph 5 of the Counterclaim constitute legal conclusions to which no answer is required. To the extent an answer is required, Registrant denies a goods/place association presumption exists.

6. Registrant denies the allegation contained in Paragraph 6 of the Counterclaim.

7. Registrant denies the allegation contained in Paragraph 7 of the Counterclaim.

8. Registrant is without knowledge and information sufficient to form a belief as to the allegations contained in Paragraph 8 of the Counterclaim, specifically the extent to which Andechs is “remote, minor or obscure” and therefore denies same, leaving Petitioner to strict proof thereof.

9. Registrant denies the allegation contained in Paragraph 9 of the Counterclaim.

AFFIRMATIVE DEFENSES

By asserting these affirmative defenses, Registrant does not admit that it necessarily bears the burden of proof or persuasion for any of the defenses or issues raised therein. Moreover, at this time, Registrant has insufficient knowledge upon which to form a belief as to whether additional defenses are presently available to them. Registrant reserves its right to amend the Answer to the Counterclaim Petition to Cancel so as to add, delete, or modify defenses based on legal theories which may or will be divulged through clarification of the Counterclaim Petition to Cancel, through discovery, or through further legal analysis of Petitioner’s position in this counterclaim cancellation action. Subject to the foregoing, for its affirmative defenses in this action, Registrant hereby asserts and alleges the following:

FIRST AFFIRMATIVE DEFENSE

The Counterclaim Petition to Cancel fails to state a cause of action upon which relief may be granted in law or equity, as Petitioner has previously, via Letter Agreement of the Parties, in 2009, acknowledged Registrant's rights in and to the trademark ANDECHS.

SECOND AFFIRMATIVE DEFENSE

Registrant's ANDECHS and KLOSTER ANDECHS and design marks have become distinctive and acquired secondary meaning by way of their continued and exclusive use in the ordinary course of trade in the U.S. marketplace since at least as early as 2009, and internationally for over 500 years, since 1455.

THIRD AFFIRMATIVE DEFENSE

Petitioner's claims are barred by equitable doctrines of waiver and estoppel, as Petitioner has previously, via agreement, affirmatively acknowledged Registrant's rights in and to the term ANDECHS as a trademark and source identifier for Registrant and its goods.

FOURTH AFFIRMATIVE DEFENSE

Petitioner's claims are barred in whole or in part by the unclean hands doctrine, specifically on account of explicit representations made by Petitioner via Letter Agreement of 2009 wherein Petitioner acknowledged coexisting use of the ANDECHS and ANDEKER marks in the marketplace prior to 2009. Petitioner may not now claim a mark to be geographically descriptive where it has previously recognized distinctiveness via longstanding coexistence of the foregoing brands. Moreover, Petitioner is also barred by the doctrine of unclean hands to the extent certain representations made by Petitioner in 2009 as to its claimed use of the ANDEKER mark in the ordinary course of trade appear, upon information and belief, to be inaccurate, as Registrant's subsequent investigations have not only failed to identify any current use of the

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Answer and Affirmative Defenses to Counterclaim Petition to Cancel on counsel for Counterclaim Petitioner on this 21st day of July 2016 by sending same via electronic mail and First Class Mail, postage prepaid, to:

Anne H. Peck
Cooley LLP
1299 Pennsylvania Avenue, NW, Suite 700
Washington, DC 20004
trademarks@cooley.com

/Christopher D. Olszyk, Jr./