

ESTTA Tracking number: **ESTTA771290**

Filing date: **09/19/2016**

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

Proceeding	91229440
Party	Defendant Campagnolo S.r.l.
Correspondence Address	ANTHONY P. VENTURINO Vorys, Sater, Seymour And Pease LLP PO BOX 2255 Columbus, OH 43216-2255 iplaw@vorys.com;apventurino@vorys.com;ybourne@vorys.com
Submission	Answer and Counterclaim
Filer's Name	Vincent C. Lombardozi
Filer's e-mail	iplaw@vorys.com, vclombardozi@vorys.com, apventurino@vorys.com, ybourne@vorys.com
Signature	/vcl/
Date	09/19/2016
Attachments	Bridgestone Answer.pdf(1000279 bytes)

Registrations Subject to the filing

Registration No	1281463	Registration date	06/12/1984
Registrant	BRIDGESTONE CORPORATION 1-1, Kyobashi 3-chome, Chuo-ku Tokyo, JAPAN		

Goods/Services Subject to the filing

Class 012. First Use: 1981/01/01 First Use In Commerce: 1981/01/01
All goods and services in the class are requested, namely: Tires [and Tubes]

Grounds for Cancellation

Abandonment	Trademark Act Section 14(3)		
Registration No	2788718	Registration date	12/02/2003
International Registration No.	NONE	International Registration Date	NONE
Registrant	BRIDGESTONE CORPORATION 1-1, Kyobashi 3-chome, Chuo-ku Tokyo, JAPAN		

Goods/Services Subject to the filing

Class 012. First Use: 0 First Use In Commerce: 0
All goods and services in the class are requested, namely: VEHICLE TIRES [, INNER TUBES FOR VEHICLE TIRES]

Grounds for Cancellation

Abandonment	Trademark Act Section 14(3)		
Registration No	4013223	Registration date	08/16/2011
Registrant	BRIDGESTONE CORPORATION 1-1, Kyobashi 3-chome, Chuo-ku Tokyo, JAPAN		

Goods/Services Subject to the filing

Class 012. First Use: 2010/09/07 First Use In Commerce: 2010/09/07 All goods and services in the class are requested, namely: tires for vehicles			
Registration No	4013224	Registration date	08/16/2011
Registrant	BRIDGESTONE CORPORATION 1-1, Kyobashi 3-chome, Chuo-ku Tokyo, JAPAN		

Goods/Services Subject to the filing

Class 012. First Use: 2005/11/01 First Use In Commerce: 2005/11/01 All goods and services in the class are requested, namely: tires for vehicles			
Registration No	4013225	Registration date	08/16/2011
Registrant	BRIDGESTONE CORPORATION 1-1, Kyobashi 3-chome, Chuo-ku Tokyo, JAPAN		

Goods/Services Subject to the filing

Class 012. First Use: 2011/05/01 First Use In Commerce: 2011/05/01 All goods and services in the class are requested, namely: tires for vehicles			
Registration No	4013226	Registration date	08/16/2011
Registrant	BRIDGESTONE CORPORATION 1-1, Kyobashi 3-chome, Chuo-ku Tokyo, JAPAN		

Goods/Services Subject to the filing

Class 012. First Use: 2005/11/22 First Use In Commerce: 2005/11/22 All goods and services in the class are requested, namely: tires for vehicles			
Registration No	2842949	Registration date	05/18/2004
Registrant	BRIDGESTONE CORPORATION 1-1, Kyobashi 3-chome, Chuo-ku Tokyo, JAPAN		

Goods/Services Subject to the filing

Class 012. First Use: 1991/04/01 First Use In Commerce: 1991/04/01 All goods and services in the class are requested, namely: TIRES; [WHEELS FOR VEHICLES; INNER TUBES, RIMS AND COVERS FOR VEHICLE WHEELS; INNER TUBES FOR VEHICLE TIRES; PARTS THEREFOR]			
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Grounds for Cancellation

Abandonment		Trademark Act Section 14(3)	
Registration No	3169216	Registration date	11/07/2006
Registrant	BRIDGESTONE CORPORATION 1-1, Kyobashi 3-chome, Chuo-ku Tokyo, JAPAN		

Goods/Services Subject to the filing

<p>Class 012. First Use: 2005/03/00 First Use In Commerce: 2005/03/00 All goods and services in the class are requested, namely: vehicle tires [; inner tubes for vehicle tires; wheel rims for vehicles]</p>
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Grounds for Cancellation

Abandonment	Trademark Act Section 14(3)
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 77/031,099.

Bridgestone Corporation, and)	
Bridgestone Americas Tire)	
Operations, LLC)	
)	
Opposers,)	
)	Opposition No. 91229440
v.)	
)	
Campagnolo S.r.l.,)	
)	
Applicant.)	
_____)	

ANSWER, AFFIRMATIVE DEFENSES AND COUNTERCLAIMS

Applicant Campagnolo S.r.l submits this Answer to the Notice of Opposition to Application Serial Number 77/031,099 that was filed by Opposers Bridgestone Corporation and Bridgestone Americas Tire Operations, LLC (individually and collectively, “Opposers”). With regard to the preamble language, Applicant admits that Application Serial No. 77/031,099 recites the goods indicated. However, Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the remaining allegations contained in the preamble and therefore denies them. With respect to the remaining allegations, Applicant responds as follows:

Bridgestone and Its Products

1. Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations contained in Paragraph 1 and therefore denies the allegations.
2. Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations contained in Paragraph 2 and therefore denies the allegations.
3. Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations contained in Paragraph 3 and therefore denies the allegations.
4. Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations contained in Paragraph 4 and therefore denies the allegations.

5. Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations contained in Paragraph 5 and therefore denies the allegations.

6. Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations contained in Paragraph 6 and therefore denies the allegations.

7. Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations contained in Paragraph 7. Therefore, Applicant denies the allegations except as to Opposers' admission that BRIDGESTONE "bicycles and parts ... are currently not directly available in the U.S.," which Applicant accepts as true and admits.

Bridgestone's POTENZA, TURANZA, and ALENZA Marks

8. Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations contained in Paragraph 8 and therefore denies the allegations.

9. Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations contained in Paragraph 9 and therefore denies the allegations.

10. Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations contained in Paragraph 10 and therefore denies the allegations.

11. Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations contained in Paragraph 11 and therefore denies the allegations.

12. Applicant admits that records for these registrations exist in the United States Patent and Trademark Office's online database. Otherwise, Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations contained in Paragraph 12 and therefore denies the allegations.

Bridgestone's Sales and Promotional Activities

13. Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations contained in Paragraph 13 and therefore denies the allegations.

14. Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations contained in Paragraph 14 and therefore denies the allegations.

15. Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations contained in Paragraph 15 and therefore denies the allegations.

16. Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations contained in Paragraph 16 and therefore denies the allegations.

17. Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations contained in Paragraph 17 and therefore denies the allegations.

18. Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations contained in Paragraph 18 and therefore denies the allegations.

19. Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations contained in Paragraph 19 and therefore denies the allegations.

20. Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations contained in Paragraph 20 and therefore denies the allegations.

21. Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations contained in Paragraph 21 and therefore denies the allegations.

22. Applicant denies the allegations of Paragraph 22.

The Federal Circuit's Decision

23. Applicant admits that Opposer Bridgestone Corporation, joined by Bridgestone Firestone North American Tire, LLC, opposed registration of Federal Corporation's mark MILANZA in 2006 (the "MILANZA Opposition"). Applicant admits that in the Trademark Trial and Appeal Board's ("TTAB") opinion for the MILANZA Opposition, it used the words "impressive under any standard." Applicant admits that the TTAB did not find a likelihood of confusion. Applicant admits that Opposers appealed the TTAB's decision to the Federal Circuit. Applicant denies the remaining allegations of Paragraph 23, including, but not limited to, Opposers' characterization of the TTAB's decision.

24. Applicant admits that the Federal Circuit reversed the TTAB's decision in the MILANZA Opposition in March 2012. Applicant admits that, in its ruling, the Federal Circuit used the words "The prolonged exclusive use of these marks, the extensive promotion and marketing, the billions of dollars of

sales, of tires bearing these marks, shows commercial strength.” Applicant denies the remaining allegations of Paragraph 24, including, but not limited to, Opposers’ characterization of the Federal Circuit decision.

25. Applicant admits that the Federal Circuit ruled that the mark MILANZA was likely to cause consumer confusion, and that it reversed the TTAB’s decision. Applicant otherwise denies the remaining allegations of Paragraph 25, including, but not limited to, Opposers’ characterization of the Federal Circuit’s ruling, especially their omission of the Federal Circuit’s emphasis on the “the identity of the goods.”

26. Applicant admits that the quoted words appear in the Federal Circuit’s decision regarding the MILANZA Opposition.

Applicant and Its Mark

27. Applicant admits the allegations of Paragraph 27.

28. Applicant admits the allegations of Paragraph 28.

29. Applicant denies that Application Serial Number 77/031,099 initially claimed priority under Section 44(d). Rather, Application Serial Number 77/031,099 was filed as a Section 1(b) intent-to-use application on October 27, 2006. A Section 44(d) basis was added to the 1(b) intent-to-use basis by way of preliminary amendment on December 22, 2006. Applicant also denies that, on June 17, 2013, it elected not to claim priority based on any foreign application. On that date, Applicant stated that Application Serial Number 77/031,099 would not proceed to registration under Section 44(e). Moreover, on February 19, 2016, Applicant indicated that it “maintains the claim of priority from the OHIM Application No 005423264 used for the 44d basis.”

30. Applicant admits the allegations of Paragraph 30.

31. Applicant admits the allegations of Paragraph 31.

Count One
Likelihood of Confusion, 15 U.S.C. § 1052(d)

32. Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations contained in Paragraph 32 and therefore denies the allegations.

33. Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations contained in Paragraph 33 and therefore denies the allegations.

34. Applicant admits that its POTENZA mark is identical to Opposers' standalone POTENZA mark, as depicted in Registration No. 1,281,463. Applicant denies the remaining allegations of Paragraph 34.

Count Two
Dilution, 15 U.S.C. § 1125(c)

35. Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations contained in Paragraph 21 and therefore denies the allegations.

36. Applicant denies the allegations of Paragraph 36.

37. Applicant denies the allegations of Paragraph 37.

38. Applicant denies the allegations of Paragraph 38.

39. Applicant denies the allegations of Paragraph 39.

AFFIRMATIVE DEFENSES

Affirmative Defense No. 1
Partial Abandonment

40. On information and belief, since at least 1994 Opposers have not sold or offered bicycles, bicycle wheels, bicycle tires or bicycle parts in United States commerce.

41. As a result of Opposers' cessation of the sale or offering of bicycles, bicycle wheels, bicycle tires or bicycle parts in United States commerce, on information and belief Opposers have not used any of the marks cited in support of their Notice of Opposition in connection with bicycle wheels or tires since at least 1994.

42. Further, on information and belief, Opposers have not intended and do not intend to resume use of the marks cited in support of the Notice of Opposition for bicycles, bicycle wheels, bicycle tires or bicycle parts, as evidenced by decades of non-use.

43. Therefore, Opposers abandoned their marks as to these goods, and consumers encountering Opposers' POTENZA, ALANZA or TURANZA marks will not identify Opposers as the source of bicycle products. For this reason, there is no likelihood of confusion.

Affirmative Defense No. 2
Priority

44. Applicant filed Application Serial No. 77/031,099 as an intent-to-use application on October 27, 2006. On December 22, 2006, Applicant amended Application Serial No. 77/031,099 to add a Section 44(d) basis based upon European Community Application No. 005423264, which had a filing date of October 27, 2006.

45. Opposers applied to register the mark POTENZA S-04 POLE POSITION on February 16, 2010. The mark registered as Registration No. 4,013,223 on August 16, 2011 with a claimed first use in commerce date of September 7, 2010.

46. Opposers applied to register the mark POTENZA RE960AS POLE POSITION on February 16, 2010. The mark registered as Registration No. 4,013,225 on August 16, 2011 with a claimed first use in commerce date of May 1, 2011.

47. On information and belief, neither POTENZA S-04 POLE POSITION nor POTENZA RE960AS POLE POSITION, as depicted in Registration Nos. 4,013,223 or 4,013,225, were in use in United States commerce prior to Applicant's priority date of October 27, 2006. Moreover, neither registration has an application filing date prior to October 27, 2006, the application date of Applicant's Application Serial No. 77/031,099. Therefore, Registrations No. 4,013,223 and 4,013,225 are irrelevant to Opposers' claims and should be excluded from consideration.

COUNTERCLAIMS

48. Applicant seeks partial cancellation and modification of Bridgestone Corporation's registrations cited in support of Opposers' Notice of Opposition. Applicant's standing for to bring these counterclaims arises from Opposers' reliance on the referenced registrations to oppose Applicant's application in this Opposition, No. 91229440. TBMP 313.03. As grounds for the counterclaims, Applicant alleges the following:

49. On information and belief, since at least 1994 Opposers have not sold or offered bicycles, bicycle wheels, bicycle tires or bicycle parts in United States commerce.

Counterclaim No. 1 Partial Cancellation - POTENZA (Reg. No. 1,281,463)

50. On information and belief, Opposers have not used the mark POTENZA in United States commerce in connection with the sale or offering of bicycles, bicycle wheels, bicycle tires or bicycle parts since at least 1994. Rather, Opposers have only used the mark for automotive vehicle tires or parts since that time.

51. Further, on information and belief, Opposers have not intended and do not intend to resume use of the mark POTENZA for bicycles, bicycle wheels, bicycle tires or bicycle parts, as evidenced by decades of non-use.

52. Modifying the identification of goods in Registration No. 1,281,463 to read "automotive vehicle tires, excluding bicycle tires or bicycle wheels" will more accurately reflect Opposers' actual use of their mark, and will avoid a finding of likelihood of confusion in this proceeding.

53. The addition of the restrictive language "automotive vehicle" and "excluding bicycle tires or bicycle wheels" to the identification of goods in Registration No. 1,281,463 is commercially significant not only because it would avoid a likelihood of confusion finding in this proceeding, but also because fairness requires that Opposers' registration accurately reflect the niche automotive tire product they sell.

54. Moreover, this modification would be consistent with Opposers' own actions to ensure that Registration No. 1,281,463 better reflects the niche automotive tire product they sell. Specifically, on April 8, 2014, Opposers deleted from Registration No. 1,281,463 the following goods: "and tubes."

55. Pursuant to 15 U.S.C. §§ 1064 and 1068, Applicant respectfully requests that Registration No. 1,281,463 be modified so that the identification of goods reads "automotive vehicle tires, excluding bicycle tires or bicycle wheels" which more accurately describes the niche automotive tire product that Opposers sell and/or offer under the mark POTENZA. Applicant submits the appropriate filing fee for the counterclaim.

Counterclaim No. 2
Partial Cancellation - POTENZA RE050A SCUDERIA (Reg. No. 2,788,718)

56. On information and belief, Opposers have not used the mark POTENZA RE050A SCUDERIA in United States commerce in connection with the sale or offering of bicycles, bicycle wheels, bicycle tires or bicycle parts since at least 1994. Rather, Opposers have only used the mark for automotive vehicle tires or parts since that time.

57. Further, on information and belief, Opposers have not intended and do not intend to resume use of the mark POTENZA RE050A SCUDERIA for bicycles, bicycle wheels, bicycle tires or bicycle parts, as evidenced by decades of non-use.

58. Modifying the identification of goods in Registration No. 2,788,718 to read "automotive vehicle tires, excluding bicycle tires or bicycle wheels" will more accurately reflect Opposers' actual use of their mark, and will avoid a finding of likelihood of confusion in this proceeding.

59. The addition of the restrictive language "automotive" and "excluding bicycle tires or bicycle wheels" to the identification of goods in Registration No. 2,788,718 is commercially significant not only because it would avoid a likelihood of confusion finding in this proceeding, but also because fairness requires that Opposers' registration accurately reflect the niche automotive tire product they sell.

60. Moreover, this modification would be consistent with Opposers' own actions to ensure that Registration No. 2,788,718 better reflects the niche automotive tire product they sell. Specifically, on

June 3, 2016, Opposers deleted from Registration No. 2,788,718 the following goods: “inner tubes for vehicle tires.”

61. Pursuant to 15 U.S.C. §§ 1064 and 1068, Applicant respectfully requests that Registration No. 2,788,718 be modified so that the identification of goods reads “automotive vehicle tires, excluding bicycle tires or bicycle wheels” which more accurately describes the niche automotive tire product that Opposers sell and/or offer under the mark POTENZA RE050A SCUDERIA. Applicant submits the appropriate filing fee for the counterclaim.

Counterclaim No. 3

Partial Cancellation - POTENZA S-04 POLE POSITION (Reg. No. 4,013,223)

62. On information and belief, Opposers have not used the mark POTENZA S-04 POLE POSITION in United States commerce in connection with the sale or offering of bicycles, bicycle wheels, bicycle tires or bicycle parts since at least 1994. Rather, Opposers have only used the mark for automotive vehicle tires or parts since that time.

63. Further, on information and belief, Opposers have not intended and do not intend to resume use of the mark POTENZA S-04 POLE POSITION for bicycles, bicycle wheels, bicycle tires or bicycle parts, as evidenced by decades of non-use.

64. Modifying the identification of goods in Registration No. 4,013,223 to read “tires for automotive vehicles, excluding bicycle tires or bicycle wheels” will more accurately reflect Opposers’ actual use of their mark, and will avoid a finding of likelihood of confusion in this proceeding.

65. The addition of the restrictive language “automotive” and “excluding bicycle tires or bicycle wheels” to the identification of goods in Registration No. 4,013,223 is commercially significant not only because it would avoid a likelihood of confusion finding in this proceeding, but also because fairness requires that Opposers’ registration accurately reflect the niche automotive tire product they sell.

66. Pursuant to 15 U.S.C. §§ 1064 and 1068, Applicant respectfully requests that Registration No. 4,013,223 be modified so that the identification of goods reads “tires for automotive vehicles, excluding bicycle tires or bicycle wheels” which more accurately describes the niche automotive tire

product that Opposers sell and/or offer under the mark POTENZA S-04 POLE POSITION. Applicant submits the appropriate filing fee for the counterclaim.

Counterclaim No. 4

Partial Cancellation - POTENZA RE050A POLE POSITION (Reg. No. 4,013,224)

67. On information and belief, Opposers have not used the mark POTENZA RE050A POLE POSITION in United States commerce in connection with the sale or offering of bicycles, bicycle wheels, bicycle tires or bicycle parts since at least 1994. Rather, Opposers have only used the mark for automotive vehicle tires or parts since that time.

68. Further, on information and belief, Opposers have not intended and do not intend to resume use of the mark POTENZA RE050A POLE POSITION for bicycles, bicycle wheels, bicycle tires or bicycle parts, as evidenced by decades of non-use.

69. Modifying the identification of goods in Registration No. 4,013,224 to read “tires for automotive vehicle, excluding bicycle tires or bicycle wheels” will more accurately reflect Opposers’ actual use of their mark, and will avoid a finding of likelihood of confusion in this proceeding.

70. The addition of the restrictive language “automotive” and “excluding bicycle tires or bicycle wheels” to the identification of goods in Registration No. 4,013,224 is commercially significant not only because it would avoid a likelihood of confusion finding in this proceeding, but also because fairness requires that Opposers’ registration accurately reflect the niche automotive tire product they sell.

71. Pursuant to 15 U.S.C. §§ 1064 and 1068, Applicant respectfully requests that Registration No. 4,013,224 be modified so that the identification of goods reads “tires for automotive vehicles, excluding bicycle tires or bicycle wheels” which more accurately describes the niche automotive tire product that Opposers sell and/or offer under the mark POTENZA RE050A POLE POSITION. Applicant submits the appropriate filing fee for the counterclaim.

Counterclaim No. 5

Partial Cancellation - POTENZA RE960AS POLE POSITION (Reg. No. 4,013,225)

72. On information and belief, Opposers have not used the mark POTENZA RE960AS POLE POSITION in United States commerce in connection with the sale or offering of bicycles, bicycle

wheels, bicycle tires or bicycle parts since at least 1994. Rather, Opposers have only used the mark for automotive vehicle tires or parts since that time.

73. Further, on information and belief, Opposers have not intended and do not intend to resume use of the mark POTENZA RE960AS POLE POSITION for bicycles, bicycle wheels, bicycle tires or bicycle parts, as evidenced by decades of non-use.

74. Modifying the identification of goods in Registration No. 4,013,225 to read “tires for automotive vehicle, excluding bicycle tires or bicycle wheels” will more accurately reflect Opposers’ actual use of their mark, and will avoid a finding of likelihood of confusion in this proceeding.

75. The addition of the restrictive language “automotive” and “excluding bicycle tires or bicycle wheels” to the identification of goods in Registration No. 4,013,225 is commercially significant not only because it would avoid a likelihood of confusion finding in this proceeding, but also because fairness requires that Opposers’ registration accurately reflect the niche automotive tire product they sell.

76. Pursuant to 15 U.S.C. §§ 1064 and 1068, Applicant respectfully requests that Registration No. 4,013,225 be modified so that the identification of goods reads “tires for automotive vehicles, excluding bicycle tires or bicycle wheels” which more accurately describes the niche automotive tire product that Opposers sell and/or offer under the mark POTENZA RE960AS POLE POSITION. Applicant submits the appropriate filing fee for the counterclaim.

Counterclaim No. 6

Partial Cancellation - POTENZA RE970AS POLE POSITION (Reg. No. 4,013,226)

77. On information and belief, Opposers have not used the mark POTENZA RE970AS POLE POSITION in United States commerce in connection with the sale or offering of bicycles, bicycle wheels, bicycle tires or bicycle parts since at least 1994. Rather, Opposers have only used the mark for automotive vehicle tires or parts since that time.

78. Further, on information and belief, Opposers have not intended and do not intend to resume use of the mark POTENZA RE970AS POLE POSITION for bicycles, bicycle wheels, bicycle tires or bicycle parts, as evidenced by decades of non-use.

79. Modifying the identification of goods in Registration No. 4,013,226 to read “tires for automotive vehicle, excluding bicycle tires or bicycle wheels” will more accurately reflect Opposers’ actual use of their mark, and will avoid a finding of likelihood of confusion in this proceeding.

80. The addition of the restrictive language “automotive” and “excluding bicycle tires or bicycle wheels” to the identification of goods in Registration No. 4,013,226 is commercially significant not only because it would avoid a likelihood of confusion finding in this proceeding, but also because fairness requires that Opposers’ registration accurately reflect the niche automotive tire product they sell.

81. Pursuant to 15 U.S.C. §§ 1064 and 1068, Applicant respectfully requests that Registration No. 4,013,226 be modified so that the identification of goods reads “tires for automotive vehicles, excluding bicycle tires or bicycle wheels” which more accurately describes the niche automotive tire product that Opposers sell and/or offer under the mark POTENZA RE970AS POLE POSITION. Applicant submits the appropriate filing fee for the counterclaim.

Counterclaim No. 7
Partial Cancellation - TURANZA (Reg. No. 2,842,949)

82. On information and belief, Opposers have not used the mark TURANZA in United States commerce in connection with the sale or offering of bicycles, bicycle wheels, bicycle tires or bicycle parts since at least 1994. Rather, Opposers have only used the mark for automotive vehicle tires or parts since that time.

83. Further, on information and belief, Opposers have not intended and do not intend to resume use of the mark TURANZA for bicycles, bicycle wheels, bicycle tires or bicycle parts, as evidenced by decades of non-use.

84. Modifying the identification of goods in Registration No. 2,842,949 to read “automotive vehicle tires, excluding bicycle tires or bicycle wheels” will more accurately reflect Opposers’ actual use of their mark, and will avoid a finding of likelihood of confusion in this proceeding.

85. The addition of the restrictive language “automotive vehicle” and “excluding bicycle tires or bicycle wheels” to the identification of goods in Registration No. 2,842,949 is commercially significant

not only because it would avoid a likelihood of confusion finding in this proceeding, but also because fairness requires that Opposers' registration accurately reflect the niche automotive tire product they sell.

86. Moreover, this modification would be consistent with Opposers' own actions to ensure that Registration No. 2,842,949 better reflects the niche automotive tire product they sell. Specifically, on April 5, 2010, Opposers deleted from Registration No. 2,842,949 the following goods: "wheels for vehicles; inner tubes, rims and covers for vehicle wheels; inner tubes for vehicle tires; parts therefor."

87. Pursuant to 15 U.S.C. §§ 1064 and 1068, Applicant respectfully requests that Registration No. 2,842,949 be modified so that the identification of goods reads "automotive vehicle tires, excluding bicycle tires or bicycle wheels" which more accurately describes the niche automotive tire product that Opposers sell and/or offer under the mark TURANZA. Applicant submits the appropriate filing fee for the counterclaim.

Counterclaim No. 8
Partial Cancellation - ALENZA (Reg. No. 3,169,216)

88. On information and belief, Opposers have not used the mark ALENZA in United States commerce in connection with the sale or offering of bicycles, bicycle wheels, bicycle tires or bicycle parts since at least 1994. Rather, Opposers have only used the mark for automotive vehicle tires or parts since that time.

89. Further, on information and belief, Opposers have not intended and do not intend to resume use of the mark ALENZA for bicycles, bicycle wheels, bicycle tires or bicycle parts, as evidenced by decades of non-use.

90. Modifying the identification of goods in Registration No. 3,169,216 to read "automotive vehicle tires, excluding bicycle tires or bicycle wheels" will more accurately reflect Opposers' actual use of their mark, and will avoid a finding of likelihood of confusion in this proceeding.

91. The addition of the restrictive language "automotive vehicle" and "excluding bicycle tires or bicycle wheels" to the identification of goods in Registration No. 3,169,216 is commercially significant

not only because it would avoid a likelihood of confusion finding in this proceeding, but also because fairness requires that Opposers' registration accurately reflect the niche automotive tire product they sell.

92. Moreover, this modification would be consistent with Opposers' own actions to ensure that Registration No. 3,169,216 better reflects the niche product they sell. Specifically, on February 25, 2013, Opposers deleted from Registration No. 3,169,216 the following goods: "inner tubes for vehicle tires; wheel rims for vehicles."

93. Pursuant to 15 U.S.C. §§ 1064 and 1068, Applicant respectfully requests that Registration No. 3,169,216 be modified so that the identification of goods reads "automotive vehicle tires, excluding bicycle tires or bicycle wheels" which more accurately describes the niche automotive tire product that Opposers sell and/or offer under the mark ALENZA. Applicant submits the appropriate filing fee for the counterclaim.

Therefore, Applicant requests that Opposers' above-cited registrations be partially cancelled and that the Notice of Opposition be dismissed. The required fee for the counterclaims accompanies this Answer. Please charge any additional fees to Deposit Account No. 50-6424.

Respectfully submitted,



Anthony P. Venturino
Vincent C. Lombardozzi
Vorys, Sater, Seymour and Pease LLP
1909 K Street, NW, Ninth Floor
Washington, DC 20006
Telephone: 202.467.8800
E-Mail: iplaw@vorys.com,

Attorneys for Applicant

Dated: September 19, 2016

CERTIFICATE OF SERVICE

I, Vincent C. Lombardozi, hereby certify that a copy of the foregoing ANSWER, AFFIRMATIVE DEFENSES AND COUNTERCLAIMS was served by first class mail on September 19, 2016 on the following:

Bridgestone Corporation
1-1, Kyobashi 3-chome, chuo-ku
Tokyo, Japan

Procopio, Cory, Hargreaves & Savitch LLP
Attn: Mainak H. Mehta and/or Sugure Mion, PLLC
1020 Marsh Road
Suite 200
Menlo Park, CA 94025

Bridgestone Americas, Inc.
Attn: Sughrue Mion, PLLC and/or Lynn Hsu
535 Marriott Drive
Nashville, TN 37214

Cynthia C. Weber
Sughrue Mion, PLLC
2100 Pennsylvania Ave. NW
Washington, DC 20037-3202

Douglas A. Rettew
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
901 New York Avenue, NW
Washington, DC 20001


