

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



USM HOLDING AG)
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 Opposer,)
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 THE UNIVERSITY OF SOUTHERN MISSISSIPPI)
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 Applicant.)
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10-24-2002
U.S. Patent & TMO/ TM Mail Rcpt Dt. #22

Opposition No.
91151629

APPLICATION SERIAL NO.: 76/195,353
FILING DATE: January 17, 2001
SERVICE MARK: USM
PUBLISHED: January 8, 2002

02 OCT 31 AM 9:30
TRADEMARK TRIAL AND
APPEAL BOARD

ANSWER TO COUNTERCLAIMS

Opposer, USM Holding AG ("Opposer") a Swiss corporation doing business at 39 Schlossgutweg, 3073 Guemligen, Switzerland, hereby answers to the allegations set forth in the First Petition for Cancellation and Second Petition for Cancellation filed by The University of Southern Mississippi ("Petitioner").

ANSWER TO FIRST PETITION FOR CANCELLATION

1. ADMISSION. Opposer admits that Opposer filed a Notice of Opposition to registration of the mark "USM" to

Petitioner for educational services based upon Petitioner's U.S. application Serial No. 76/195,353.

2. ADMISSION. Opposer admits that Opposer is the owner of U.S. Registration No. 2,514,218 and that the rights petitioner claims in the mark "USM" by U.S. Application Serial No. 76/195,353 would be likely to cause confusion with and dilute the rights granted to Opposer by U.S. Registration No. 2,514,218.

3. DENIAL. Opposer is without knowledge or information sufficient to form a belief as to the truth of the averments in the third numbered paragraph of petitioner's first counterclaim. Pursuant to Rule 2.144(b)(1) and TBMP 318.02, this has the effect of a denial.

4. DENIAL. Opposer is without knowledge or information sufficient to form a belief as to the truth of the averments in the third numbered paragraph of petitioner's counterclaim. Pursuant to Rule 2.144(b)(1) and TBMP 318.02, this has the effect of a denial.

5. ADMISSION. Opposer admits the assertions made in the fifth numbered paragraph of petitioner's first counterclaim; that is, if petitioner's mark "USM" filed under U.S. Application Serial No. 76/195,353 would be likely to cause confusion or dilute Opposer's rights under U.S.

Registration No. 2,514,218 as alleged in the Notice of Opposition No. 91151629 then petitioner's claims in the mark "USM" by U.S. Application Serial No. 76/194,528¹ would also likely cause confusion with or dilute the rights granted to Opposer under U.S. Registration No. 2,514,218.

ANSWER TO SECOND PETITION FOR CANCELLATION

1. ADMISSION. Opposer admits that Opposer filed a Notice of Opposition to registration of the mark "USM" to Petitioner for educational services based upon Petitioner's U.S. application Serial No. 76/195,353.

2. ADMISSION. Opposer admits that Opposer is the owner of U.S. Registration No. 1,708,225 and that the rights petitioner claims in the mark "USM" by U.S. Application Serial No. 76/195,353 would be likely to cause confusion with and dilute the rights granted to Opposer by U.S. Registration No. 1,708,225.

3. DENIAL. Opposer is without knowledge or information sufficient to form a belief as to the truth of the averments in the third numbered paragraph of petitioner's second counterclaim. Pursuant to Rule 2.144(b)(1) and TBMP 318.02, this has the effect of a denial.

¹Upon Opposer's information and belief this application has not yet been published for opposition.

4. DENIAL. Opposer is without knowledge or information sufficient to form a belief as to the truth of the averments in the third numbered paragraph of petitioner's second counterclaim. Pursuant to Rule 2.144(b)(1) and TBMP 318.02, this has the effect of a denial.

5. ADMISSION. Opposer admits the assertions made in the fifth numbered paragraph of petitioner's second counterclaim; that is, if petitioner's mark "USM" filed under U.S. Application Serial No. 76/195,353 would be likely to cause confusion or dilute Opposer's rights under U.S. Registration No. 1,708,225 as alleged in the Notice of Opposition No. 91151629 then petitioner's claims in the mark "USM" by U.S. Application Serial No. 76/194,528² would also likely cause confusion with or dilute the rights granted to Opposer under U.S. Registration No. 1,708,225.

AFFIRMATIVE PLEADINGS

Pursuant to TBMP 318.02(c) affirmative assertions are permitted by the Board when they serve to give the petitioner fuller notice of the position which the counterclaim defendant/Opposer plans to take in defense of its right to oppose. Counterclaim defendant/Opposer includes the

²Upon Opposer's information and belief this application has not yet been published for opposition.

Following affirmative assertions which amplify counterclaim defendant/Opposer's denial of one or more of the allegations in the first petition for cancellation and second petition for cancellation.

First Affirmative Defense. Petitioner has failed to state a claim for which relief can be granted.

WHEREFORE, Opposer respectfully requests that

(i) petitioner's first petition for cancellation be denied;

(ii) petitioner's second petition for cancellation be denied;

(iii) petitioner's application under Serial No. 76/195,353 be denied;

(iv) Opposer's opposition be sustained; and

(v) Opposer be granted leave to amend its Opposition No. 91151629 if petitioner's Application Serial No. 76/194,528 and referred to in petitioner's petitions is published for opposition.

Dated: October 21, 2002

USM HOLDING AG
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