

Karen L. Feisthamel
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April 4, 2005

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

TTAB

Re: *Euronda S.p.A. v. Claudio Zanelli*
Opposition No. 91164317

Dear Sir/Madam:

Enclosed for filing in the above-referenced matter, please find the following documents:

1. Answer to Notice of Opposition and Counterclaim for Cancellation
2. Check for \$900.00 for filing fee for Cancellation Counterclaim.

Please charge any additional required fees associated with this proceeding, to the undersigned's Deposit Account 50-0485. A duplicate copy of this letter is enclosed for this purpose.

Kindly stamp the enclosed postcard acknowledging receipt of the above documents and return same to me. Thank you for your cooperation in this matter.

Very truly yours,




Karen L. Feisthamel

Enclosures

Certificate of Mailing

I hereby certify that this correspondence and attached Petition to Cancel is being deposited with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313 on April 4, 2005.


Karen L. Feisthamel
04-06-2005

U.S. Patent & TMOtc/TM Mail Ropt Dt. #72

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

_____)	
EURONDA S.P.A.)	
)	
Opposer,)	
)	Opposition No. 91164317
v.)	
)	
CLAUDIO ZANELLI,)	
)	
Applicant.)	
_____)	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIM FOR
CANCELLATION

Applicant, Claudio Zanelli, (“Applicant”), by and through his attorneys, hereby answers the Notice of Opposition filed by Euronda S.p.A. (“Opposer”), the paragraph numbers hereof corresponding to those of the Notice of Opposition.

Introductory Paragraph. Applicant denies Opposer’s allegations that it will be damaged by the registration of U.S. Trademark Application Serial No. 76/440,631 in International Class 10.

1. Admit.

2. Applicant is without sufficient knowledge or information upon which to form a belief as to the truth of the allegations of paragraph 2, and, therefore denies the same.

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3. Applicant is without sufficient knowledge or information upon which to form a belief as to the truth of the allegations of paragraph 3, and, therefore denies the same.

4. Applicant is without sufficient knowledge or information upon which to form a belief as to the truth of the allegations of paragraph 4, and, therefore denies the same.

5. Applicant is without sufficient knowledge or information upon which to form a belief as to the truth of the allegations of paragraph 5, and, therefore denies the same.

6. Applicant is without sufficient knowledge or information upon which to form a belief as to the truth of the allegations of paragraph 6, and, therefore denies the same.

7. Applicant is without sufficient knowledge or information upon which to form a belief as to the truth of the allegations of paragraph 7, and, therefore denies the same.

8. Applicant denies the allegations of this paragraph.

9. Applicant is without sufficient knowledge or information upon which to form a belief as to the truth of the allegations of paragraph 9 relating to the goodwill and consumer recognition built by Opposer, and, therefore denies the same. Applicant denies the remaining allegations of paragraph 9.

10. Applicant is without sufficient knowledge or information upon which to form a belief as to the truth of the allegations of paragraph 10, and, therefore denies the same.

11. Applicant is without sufficient knowledge or information upon which to form a belief as to the truth of the allegations of paragraph 11, and, therefore denies the same.

12. Applicant denies the allegations of this paragraph.

13. Applicant denies the allegations of this paragraph.

14. Applicant is without sufficient knowledge or information upon which to form a belief as to the truth of the allegations of paragraph 14, and, therefore denies the same.

15. Applicant is without sufficient knowledge or information upon which to form a belief as to the truth of the allegations of paragraph 15, and, therefore denies the same.

16. Applicant denies the allegations of this paragraph.

17. Applicant admits that it has no license, consent or permission from Opposer to use or register its mark, ONDA. Applicant denies the implications that such license, consent or permission is required.

18. Applicant admits that if the registration is granted, that such registration will constitute *prima facie* evidence of its rights to its mark. Applicant denies the allegations that such registration will damage or otherwise injure Opposer.

19. Applicant denies the allegations of this paragraph.

AFFIRMATIVE DEFENSES

1. There is no confusion, nor likelihood of confusion, between Applicant's use of ONDA and Opposer's alleged uses of EURONDA and EURONDA and design.
2. Opposer has lost what rights it may assert by abandonment.
3. Opposer's mark lacks fame to support any allegations of dilution under Section 43(c).
4. Opposer's mark was not famous prior to Applicant's use of its mark, nor Applicant's filing of its application, and thus lacks the fame necessary to support any allegations of dilution under Section 43(c).

COUNTERCLAIM

Applicant hereby counterclaims seeking cancellation of U.S. Registration No. 1,383,117 for EURONDA and Design in Classes 9 and 10, and U.S. Registration No. 2,685,907 for EURONDA in Class 10 pursuant to 10 U.S.C. § 1064. As grounds of cancellation, it is alleged that:

1. U.S. Registration No. 1,383,117 which issued to Opposer on February 18, 1986 is for the mark EURONDA and the design being the depiction of dental tools (EURONDA and Design).
2. U.S. Registration No. 2,685,907 which issued to Opposer on February 11, 2003 is for the mark EURONDA.
3. Upon information and belief, Opposer has discontinued use of the mark EURONDA and Design covered by U.S. Registration No. 1,383,117. Upon further information and belief, Opposer does not intend to resume use of such mark.

4. Opposer's discontinued use of the EURONDA and Design Mark, with the intent not to resume use constitutes abandonment of the mark.

5. Upon information and belief, Opposer has discontinued use of the mark EURONDA covered by U.S. Registration No. 2,685,907. Upon further information and belief, Opposer does not intend to resume use of such mark.

6. Opposer's discontinued use of the EURONDA mark, with the intent not to resume such use constitutes abandonment of the mark.

7. Opposer has asserted rights alleged to derive from U.S. Registration Nos. 1,383,117 and 2,685,907 as grounds to oppose registration of Applicant's mark ONDA as set forth in Application Ser. No. 76/440,631.

8. Applicant believes that it is, and will be, damaged by the continued existence of U.S. Registration Nos. 1,383,117 and 2,685,907, in view of the fact that these registrations have been asserted against the registration of Applicant's mark., despite the abandonment of the marks set forth in such registrations.

WHEREFORE, Applicant prays as follows:

(a) that this opposition be dismissed; and,

(b) that the petition for cancellation be sustained, and Registration Nos. 1,383,117 and 2,685,907 for the marks EURONDA and Design and EURONDA be canceled.


Please address all future correspondence in this proceeding:

Karen L. Feisthamel, Esq.
Hinckley, Allen & Snyder
1500 Fleet Center
Providence, Rhode Island 02903
Tel: (401)274-2000
Fax: (401)277-9600

That statutory filing fee of \$900.00 accompanies this counterclaim for cancellation. Please charge any additional fees, or credit any over charges, associated with this proceeding to the undersigned's Deposit Account 50-0485.

Respectfully submitted,

DATED: Apr. 4, 2005

By: 
Karen L. Feisthamel, Esq.
Hinckley, Allen & Snyder LLP
1500 Fleet Center
Providence, Rhode Island 02903
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Attorney for Claudio Zanelli

Co-Counsel:
Shirley L Church, Esq.
502 Waverly Street, Suite 300
Palo Alto, California 94301
Tel: (650) 473-9700
Fax: (650) 473-0130

CERTIFICATE OF SERVICE


I hereby certify that a copy of the foregoing Answer to Notice of Opposition and Counterclaim for Cancellation was mailed via first class mail, postage prepaid, this 4th day of April, 2005, addressed to Opposer's attorneys:

Thomas M. Champagne, Esq.
IP Strategies, P.C.
1730 N. Lynn Street
Suite 500
Arlington, Virginia 22209

By: 
Karen L. Feisthamel

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451 on Apr. 4, 2005


Karen L. Feisthamel