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

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| Proceeding | 91170552 |
| Party | Plaintiff Honda Motor Co., Ltd. |
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| Signature | /emh/ |
| Date | 09/30/2008 |
| Attachments | Winkelmann Reply.pdf (8 pages)(306552 bytes) Winkelmann Exhibit 1.pdf (2 pages)(538430 bytes) Winkelmann Exhibit 2.pdf (2 pages)(620246 bytes) |

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

In the matter of Application Serial No. 76/587,840
For the Mark **V.I.C.**
Published in the Official Gazette on October 25, 2005

HONDA MOTOR CO., LTD.,

Opposer,

v.

FRIEDRICH WINKELMANN,

Applicant.

Opposition No. 91170552

**OPPOSER'S REPLY TO APPLICANT'S RESPONSE
TO OPPOSER'S MOTION FOR SUMMARY JUDGMENT**

Honda Motor Co., Ltd. ("Opposer"), submits the following Reply to Applicant's Response to Opposer's Motion for Summary Judgment.

This Reply will focus on the only issue under consideration in this proceeding – whether or not Applicant had a *bona fide* intent to use the designation **V.I.C.** in United States commerce on or in connection with *each* of the following goods when he applied to register the designation on April 21, 2004: “vehicles for transportation on land, air or water, namely, motor propelled and self-propelled vehicles for use on land and on water and motor propelled and glider aircraft; parts used in vehicles for transportation on land, air or water, namely, motor

propelled and self-propelled vehicles for use on land and on water and motor propelled and glider aircraft.”¹

I. Summary of Argument

To plead sufficient standing to maintain an opposition, “all that is required is that [an opposer] allege facts sufficient to show a ‘real interest’ in the proceeding, and a ‘reasonable basis for its belief of damage.’” TBMP § 309.03(b) and case citations therein.

. . . To plead a “real interest,” [Opposer] must allege a “direct and personal stake” in the outcome of the proceeding. The allegations in support of [Opposer’s] belief of damage must have a reasonable basis “in fact.”

* * *

A real interest in the proceeding and a reasonable belief of damage may be found, for example, where [Opposer] pleads (and later proves):

A claim of likelihood of confusion that is not wholly without merit. . . .

Id. and cases cited.

Once standing has been pled and proven, “a[n Opposer] may raise any available statutory ground . . . for opposition . . . that negates the defendant’s right to registration.” TBMP § 309.03(c) and case citations therein.

Opposer has pled (and proven) standing to oppose U.S. Application Serial No. 76/587,840 for **V.I.C.** because it has an interest in preventing the registration of marks, such as **V.I.C.**, which it believes to be confusingly similar to its **CIVIC** trademark. This belief is not unreasonable. The mark **CIVIC** is a palindrome, which in the marketplace has been and

¹ See 37 C.F.R. § 2.127(a); see also, e.g., *Seculus da Amazonia S/S v. Toyota Jidosha Kabushiki Kaisha*, 66 U.S.P.Q.2d 1154, n.4 (T.T.A.B. 2003) (reply brief considered because it clarified the issues under consideration).

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continues to be emphasized by increasing the height of the letter V, drawing the eye to the center of the word [V] from which the letters "I" and "C" proceed, in sequence, outward to both left and right. Two illustrations of this use of "ci_vic" are to be found in the 1972 TDR specimen submitted supporting Opposer's Registration No. 1,045,160 and the 2008 TDR specimen supporting Opposer's Registration No. 2,573,521, copies of which are annexed hereto as Exhibits 1 and 2. This display makes Honda's concern greater than it otherwise might be, and certainly makes Opposer's concern over V.I.C. for identical goods "not wholly without reason," which is all that is necessary.

Accordingly, Opposer has standing to oppose the registration of the designation V.I.C. on any legitimate ground. That Applicant did not have a *bona fide* intent to use the mark in United States commerce when he applied to register the designation is as legitimate a reason as any (and is amenable to summary judgment).

Since Opposer has chosen to challenge Applicant's *bona fide* intent to use the mark as its basis for moving for summary judgment, Applicant has to come forward with at least some documentation that corroborates his alleged *bona fide* intent. He has not. Instead, Applicant has advanced, in his response to Opposer's Motion for Summary Judgment, two conclusory declarations by attorneys, neither of which explains in any way the declarant's basis for stating that Applicant had a *bona fide* intent to use the designation on or in connection with any, let alone all, of the applied-for goods "in commerce".² Applicant has also produced a handful of documents that have no apparent relevance to Applicant's alleged *bona fide* intent to

² Opposer is contemporaneously herewith moving to strike both attorney declarations.

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use **V.I.C.** in connection with any (let alone all) of the applied- for goods (and, if the documents have some non-apparent relevance to that issue, he should have explained same in response to Opposer's discovery requests or, at the least, in his response to Opposer's Motion for Summary Judgment). Applicant's response to Opposer's Motion for Summary Judgment – just like his responses to Opposer's discovery requests – does nothing but disprove Applicant's alleged *bona fide* intent to use the designation **V.I.C.** in United States commerce at the time he applied to register the mark on April 21, 2004.

In his response to Opposer's Motion for Summary Judgment, Applicant purports to address the following three issues: (1) whether Applicant had alleged *bona fide* intent to use the designation **V.I.C.** in commerce when he applied to register it; (2) whether the mark **CIVIC** and the designation **V.I.C.** are confusingly similar; and (3) whether Opposer has shown that it will be damaged by the registration of the designation **V.I.C.** Opposer only addresses Applicant's alleged *bona fide* intent to use the designation **V.I.C.** in this Reply as it is the *only* issue germane to this proceeding at this time.

II. Argument

In his response to Opposer's Motion for Summary Judgment, Applicant submits, in support of his alleged *bona fide* intent to use the designation **V.I.C.** in commerce, the very documents that Opposer challenged in its Motion for Summary Judgment. And as Opposer explained in its Motion for Summary Judgment, none of these documents provides a shred of evidence to support Applicant's alleged *bona fide* intent to use the designation **V.I.C.** in

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commerce. Applicant's Exhibits 100-1, 100-2, 101, and 102³ appear to be printouts from Applicant's website; the documents are not in English, but in German. And again, while the printouts appear to show Applicant's use of the designation V.I.C. in Germany somehow in connection with automobiles, they do nothing to corroborate Applicant's alleged *bona fide* intent to use the designation V.I.C. in the United States for the applied- for goods. In particular, it appears that the designation V.I.C. is used to designate a care package for automobiles (for example, a package that includes car washes). None of the documents shows use of the V.I.C. designation in connection with "vehicles for transportation on land, air or water, namely, motor propelled and self-propelled vehicles for use on land and on water and motor propelled and glider aircraft; parts used in vehicles for transportation on land, air or water, namely, motor propelled and self-propelled vehicles for use on land and on water and motor propelled and glider aircraft." As such, none of Applicant's documents even remotely supports Applicant's alleged *bona fide* intent to use V.I.C.

Applicant's remaining document production (Applicant's Exhibits 105-1, 105-2, 106-1, 106-2, 106-3, and 107⁴) merely are copies of Applicant's foreign Certificates of Registration of the mark V.I.C. While Applicant's foreign Certificates of Registration of the mark V.I.C. may allow Applicant to claim priority in the United States, they do not support Applicant's alleged *bona fide* intent to use the mark in the United States.

In addition to resubmitting irrelevant documents, Applicant also submits declarations from his attorney in Germany and his attorney in the United States to support his

³ See Exhibit D to Opposer's Motion for Summary Judgment.

⁴ See *id.*

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alleged *bona fide* intent to use the designation in United States commerce. Each declaration, though, was sworn to just weeks ago – on August 25, 2008 – more than four years after Applicant applied to register the designation V.I.C., and more than a month after Opposer amended its Notice of Opposition to include a claim that Applicant lacked a *bona fide* intent to use the designation V.I.C. in United States commerce. The declarations are not even remotely contemporaneous with the filing of Applicant's V.I.C. application and, as such, cannot support Applicant's alleged *bona fide* intent to use the designation when he applied to register the mark.⁵ And even if they were contemporaneous with the filing of the application, neither declaration was produced during discovery, and neither provides a basis for how the declarant allegedly "knows" Applicant had a *bona fide* intent to use the designation when he applied to register it. This is why Opposer simultaneously has moved to strike the declarations from the record.⁶

By Applicant's own admission (*see* Applicant's September 18, 2008 Answer to Amended Notice of Opposition), automobiles are encompassed by the applied-for goods. The undersigned can think of only a handful of consumer products that require more pre-production and pre-sale activity than automobiles. It is inconceivable that an applicant with a genuine intent to use a mark for automobiles four years ago would wholly be unable to support its *bona fide* intent to use a trademark in connection with automobiles or other vehicles for transportation on land, air or water with nothing more than a handful of non-English documents from a website of a German automobile dealership.

⁵ *See Boston Red Sox Baseball Club Limited Partnership v. Brad Sherman*, Opposition No. 91172,268 (T.T.A.B. Sept. 9, 2008).

⁶ *See* Opposer's Objections to and Motions to Strike Applicant's Declarations in Support of Applicant's Response to Opposer's Motion for Summary Judgment simultaneously filed herewith.

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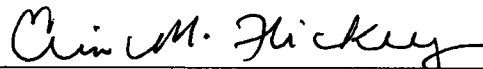
III. Conclusion

Applicant has failed to produce documentary or other evidence sufficient to prove that he had a *bona fide* intent to use the designation V.I.C. in commerce on or in connection with *any* of the applied- for goods when it applied to register the mark on April 21, 2004. Opposer respectfully requests that the Trademark Trial and Appeal Board grant its Motion for Summary Judgment, sustain its Opposition, and reject Applicant's U.S. Application Serial No. 76/587,840 for the mark V.I.C. as void *ab initio*.

Respectfully submitted,

FISH & RICHARDSON P.C.

Dated: September 30, 2008

By: 

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CERTIFICATE OF SERVICE

This is to certify that, on this 30th day of September, 2008, a true copy of the foregoing **OPPOSER'S REPLY TO APPLICANT'S RESPONSE TO OPPOSER'S MOTION FOR SUMMARY JUDGMENT** has been sent by first-class mail, postage prepaid, to Applicant's Agent for Service of Record:

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Exhibit 1

CIVIC

Exhibit 2

