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

Proceeding	91172858
Party	Defendant GUARDIAN NEWSPAPERS LIMITED GUARDIAN NEWSPAPERS LIMITED 119 FARRINGDON ROAD GB2 LONDON, EC1R 3ER,
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Date	10/12/2006
Attachments	Answer Opp. No. 91172858.pdf ( 9 pages )(365124 bytes )

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

**IN THE MATTER OF APPLICATION**

Applicant: Guardian Newspapers Limited  
Serial No.: 76/280,638  
Mark: THE GUARDIAN  
Filed: July 5, 2001  
Published in  
the Official Gazette: May 16, 2006

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THE GUARDIAN LIFE INSURANCE  
COMPANY OF AMERICA, :

Opposer :

Opposition No.: 91172858

v. :

GUARDIAN NEWSPAPERS  
LIMITED, :

Applicant. :

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ANSWER AND AFFIRMATIVE DEFENSES

Applicant, Guardian Newspapers Limited (“Applicant”), through its attorneys, answers the Notice of Opposition filed by Opposer, The Guardian Life Insurance Company of America (“Opposer”) as follows, the paragraphs hereof being numbered to correspond with like number paragraphs of the Notice of Opposition:

Applicant denies that Opposer will be damaged by the registration of Applicant’s mark which is the subject of U.S. Application Serial No. 76/280,638. Applicant is otherwise without information or knowledge sufficient to form a belief as to the truth or falsity of the remaining introductory statements by Opposer that precede paragraph 1 of the Notice of Opposition and, therefore, denies same.

AS TO COUNT I - LIKELIHOOD OF CONFUSION  
UNDER 15 U.S.C. §§ 1114 AND 1125 (a)

1. Applicant is without information or knowledge sufficient to form a belief as to the truth or falsity of the allegations in paragraph 1 of the Notice of Opposition and, therefore, denies same.

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

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

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

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

6. Applicant admits only that on July 5, 2001, it filed an application to register the mark THE GUARDIAN on the Principal Register of the United States Patent and Trademark Office based on an intent-to-use the mark and under Section 44 of the Lanham Act, and that the application was assigned Serial No. 76/280,638. Applicant is otherwise without information or knowledge sufficient to form a belief as to the truth or falsity of the allegations in paragraph 6 of the Notice of Opposition and, therefore, denies same.

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

8. Applicant is without information or knowledge sufficient to form a belief as to the truth or falsity of the allegations in paragraph 8 of the Notice of Opposition and, therefore, denies same.

9. Applicant is without information or knowledge sufficient to form a belief as to the truth or falsity of the allegations in paragraph 9 of the Notice of Opposition and, therefore, denies same.

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

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

12. Applicant is without information or knowledge sufficient to form a belief as to the truth or falsity of the allegations in paragraph 12 of the Notice of Opposition and, therefore, denies same.

13. Applicant is without information or knowledge sufficient to form a belief as to the truth or falsity of the allegations in paragraph 13 of the Notice of Opposition and, therefore, denies same.

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

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

16. Applicant is without information or knowledge sufficient to form a belief as to the truth or falsity of the allegations in paragraph 16 of the Notice of Opposition and, therefore, denies same.

17. Applicant is without information or knowledge sufficient to form a belief as to the truth or falsity of the allegations in paragraph 17 of the Notice of Opposition and, therefore, denies same.

18. Applicant is without information or knowledge sufficient to form a belief as to the truth or falsity of the allegations in paragraph 18 of the Notice of Opposition and, therefore, denies same.

19. Applicant is without information or knowledge sufficient to form a belief as to the truth or falsity of the allegations in paragraph 19 of the Notice of Opposition and, therefore, denies same.

20. Applicant is without information or knowledge sufficient to form a belief as to the truth or falsity of the allegations in paragraph 20 of the Notice of Opposition and, therefore, denies same.

21. Applicant is without information or knowledge sufficient to form a belief as to the truth or falsity of the allegations in paragraph 21 of the Notice of Opposition and, therefore, denies same.

22. Applicant admits the allegations in paragraph 22 of the Notice of Opposition.

23. Applicant denies the allegations in paragraph 23 of the Notice of Opposition.

24. Applicant admits only that on January 17, 2001, it filed U.S. Application Serial No. 76/195,313 for MEDIA GUARDIAN for use in connection with, among other goods and services, “[p]roviding information relating to financial services and real estate services; sponsorship services, including, the financial and media sponsorship of events; real estate services,” and on May 25, 1999, Applicant filed U.S. Application Serial No. 75/713,488 for THE GUARDIAN for, among other goods and services, “[s]ponsorship services” and “[e]ducational and training services; publication services; publication of education materials; arranging and conducting seminars, exhibition conferences and trade shows, provision of interactive information; providing access to and leasing access time to computer databases or on-line.” Applicant otherwise denies the allegations in paragraph 24 of the Notice of Opposition.

25. Applicant denies the allegations in paragraph 25 of the Notice of Opposition.

26. Applicant denies the allegations in paragraph 26 of the Notice of Opposition.

27. Applicant denies the allegations in paragraph 27 of the Notice of Opposition.

28. Applicant denies the allegations in paragraph 28 of the Notice of Opposition.

29. Applicant denies the allegations in paragraph 29 of the Notice of Opposition.

30. Applicant denies the allegations in paragraph 30 of the Notice of Opposition.

31. Applicant denies the allegations in paragraph 31 of the Notice of Opposition.

32. Applicant denies the allegations in paragraph 32 of the Notice of Opposition.

33. Applicant denies the allegations in paragraph 33 of the Notice of Opposition.

34. Applicant denies the allegations in paragraph 34 of the Notice of Opposition.

AS TO COUNT II - DILUTION UNDER 15 U.S.C. § 1125 (C)

35. Applicant repeats and realleges its responses and/or denials of the allegations in the Notice of Opposition set forth in paragraphs 1-34 hereof as if fully set forth herein.

36. Applicant is without information or knowledge sufficient to form a belief as to the truth or falsity of the allegations in paragraph 36 of the Notice of Opposition and, therefore, denies same.

37. Applicant is without information or knowledge sufficient to form a belief as to the truth or falsity of the allegations in paragraph 37 of the Notice of Opposition and, therefore, denies same.

38. Applicant admits only that it has a bona fide intention to use in commerce the mark which is the subject of U.S. Application Serial No. 76/280,638. Applicant otherwise is without information or knowledge sufficient to form a belief as to the truth or falsity of the allegations in paragraph 38 of the Notice of Opposition as it is unclear what is being alleged and, therefore, denies same.

39. Applicant admits only on July 5, 2001, it filed an application to register the mark THE GUARDIAN which was assigned U.S. Application Serial No. 76/280,638. Applicant otherwise is without information or knowledge sufficient to form a belief as to the truth or falsity of the allegations in paragraph 39 of the Notice of Opposition and, therefore, denies same.

40. Applicant denies the allegations in paragraph 40 of the Notice of Opposition.

41. Applicant denies the allegations in paragraph 41 of the Notice of Opposition.

42. Applicant denies the allegations in paragraph 42 of the Notice of Opposition.

In response to Opposer's prayer for relief, Applicant submits that the Opposition should be dismissed in its entirety on the grounds that there is no likelihood of confusion or dilution that will arise from the use or registration of its mark THE GUARDIAN which is the subject of U.S. Application Serial No. 76/280,638.



**AFFIRMATIVE DEFENSES**

1. The Notice of Opposition fails to state a claim upon which relief can be granted.
2. Applicant's use and registration of THE GUARDIAN on the Principal Register of the United States Patent and Trademark Office is not likely to cause confusion, mistake, deception or dilution of or otherwise damage Opposer, or Opposer's alleged names or marks.

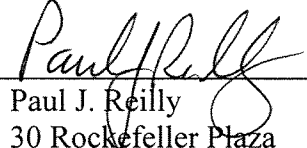
WHEREFORE, Applicant respectfully requests that Opposition No. 91172858 be dismissed in its entirety and that Application Serial No. 76/280,638 for THE GUARDIAN be approved for registration.

Respectfully submitted,

BAKER BOTTS L.L.P.

Date: October 12, 2006

By: \_\_\_\_\_

  
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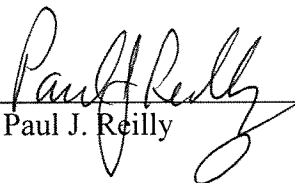
Attorneys for Applicant

**CERTIFICATE OF MAILING AND SERVICE**

I hereby certify that a copy of the foregoing, ANSWER AND AFFIRMATIVE DEFENSES, was served on the Attorneys for Opposer via the United States Postal Service as first class mail, in an envelope with sufficient postage addressed to:

Virginia R. Richard, Esq.  
Lana C. Marina, Esq.  
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Winston & Strawn LLP  
200 Park Avenue  
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on October 12, 2006

By:   
Paul J. Reilly