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

Proceeding	91183238
Party	Defendant Jim Koons Management Company
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Submission	Answer
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Date	05/06/2008
Attachments	Answer.pdf (10 pages)(32035 bytes)

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

In re: Application No.: 77/263,036
For the Mark: WE'RE GONNA WOW YA!
In International Class: 36

In re: Application No.: 77/263,026
For the Mark: WE'RE GONNA WOW YA!
In International Class: 39

In re: Application No.: 77/263,043
For the Mark: WE'RE GONNA WOW YA!
In International Class: 35

In re: Application No.: 77/263,022
For the Mark: WE'RE GONNA WOW YA!
In International Class: 35

Commerce Bancorp., Inc.

Opposer,

v.

Opposition No. 91183238

Jim Koons Management Company,

Applicant.

ANSWER

The above-identified Applicant, Jim Koons Management Company, a corporation, organized and existing under the laws of Maryland, by counsel, denies that Opposer, Commerce Bancorp., Inc. is and/or will be damaged by the registration of the marks WE'RE GONNA WOW YA! as set forth in U.S. Trademark Application No. 77/263036 for FINANCIAL SERVICES, NAMELY, PROVIDING FINANCING FOR THE

PURCHASE OF NEW AND USED VEHICLES in International Class 36, WE'RE GONNA WOW YA! as set forth in U.S. Trademark Application No. 77/263026 for LEASING OF VEHICLES, AUTOMOBILES AND TRUCKS; RENTAL OF VEHICLES, AUTOMOBILES AND TRUCKS in International Class 39, WE'RE GONNA WOW YA! as set forth in U.S. Trademark Application No. 77/263043 for VEHICLE DEALERSHIP SERVICES in International Class 35, and WE'RE GONNA WOW YA! as set forth in U.S. Trademark Application No. 77/263022 for RETAIL STORE SERVICES FEATURING VEHICLES, AUTOMOBILES AND TRUCKS; RETAIL STORES FEATURING VEHICLE TIRES, OIL, PETROLEUM PRODUCTS, LUBRICANTS AND VEHICLE PARTS AND ACCESSORIES in International Class 35 hereby answers the Notice of Opposition filed in this proceeding by Commerce Bancorp., Inc. and admits, denies and alleges as follows:

Applicant admits that it is a corporation, organized and existing under the laws of Maryland, with a place of business address at 2000 Chain Bridge Road Vienna, Virginia 22182.

Applicant admits that it is the owner of U.S. Trademark Application No. 77/263036 for WE'RE GONNA WOW YA! for FINANCIAL SERVICES, NAMELY, PROVIDING FINANCING FOR THE PURCHASE OF NEW AND USED VEHICLES in International Class 36, U.S. Trademark Application No. 77/263026 for WE'RE GONNA WOW YA! for LEASING OF VEHICLES, AUTOMOBILES AND TRUCKS; RENTAL OF VEHICLES, AUTOMOBILES AND TRUCKS in International Class 39, U.S. Trademark Application No. 77/263043 for WE'RE GONNA WOW YA! for VEHICLE DEALERSHIP

SERVICES in International Class 35, and U.S. Trademark Application No. 77/263022 for WE'RE GONNA WOW YA! for RETAIL STORE SERVICES FEATURING VEHICLES, AUTOMOBILES AND TRUCKS; RETAIL STORES FEATURING VEHICLE TIRES, OIL, PETROLEUM PRODUCTS, LUBRICANTS AND VEHICLE PARTS AND ACCESSORIES in International Class 35. In further response, Applicant's application for registration of the marks subject of U.S. Trademark Application Nos. 77/263036, 77/263026, 77/263043, and 77/263022 were examined by the United States Patent and Trademark Office and approved for publication and then issuance. Publication occurred in the Official Gazette. Applicant's application for registration as a part of the evidence in this proceeding speaks for itself with regard to the information contained within them.

1. Answering paragraph 1 of the Notice of Opposition, based on the review of a TESS database search result from the United States Patent and Trademark Database, information within the allegations set forth in Opposer's paragraph 1 and its subparts appear to be representative of the information contained within that database. Applicant otherwise lacks sufficient information to admit or deny the factual allegations contained in paragraph 1. Other allegations contained in paragraph 1 are conclusions of law to which no answer is required. To the extent that an answer to any of these allegations is required, Applicant denies the allegations contained in paragraph 1.

2. Answering paragraph 2 of the Notice of Opposition, Applicant notes that the factual allegations of Opposer in paragraph 2 with respect to the first date of use in commerce directly contradict the factual allegations of Opposer in paragraph 1 with

respect to the same facts. Otherwise, Applicant lacks sufficient information to admit or deny the factual allegations contained in paragraph 2. Other allegations contained in paragraph 2 are conclusions of law to which no answer is required. To the extent that an answer to any of these allegations is required, Applicant denies the allegations contained in paragraph 2.

3. Answering paragraph 3 of the Notice of Opposition, Applicant lacks sufficient information to admit or deny the factual allegations contained in paragraph 3. Other allegations contained in paragraph 3 are conclusions of law to which no answer is required. To the extent that an answer to any of these allegations is required, Applicant denies the allegations contained in paragraph 3.

4. Answering paragraph 4 of the Notice of Opposition, Applicant admits the allegations contained in paragraph 4.

5. Answering paragraph 5 of the Notice of Opposition, Applicant lacks sufficient information to admit or deny the factual allegations contained in paragraph 5. Other allegations contained in paragraph 5 are conclusions of law to which no answer is required. To the extent that an answer to any of these allegations is required, Applicant denies the allegations contained in paragraph 5.

6. Answering paragraph 6 of the Notice of Opposition, Applicant's Applications to the US Patent and Trademark Office subject of this matter are available in the US Patent and Trademark Office and each speaks for itself Applicant lacks sufficient information to admit or deny the factual allegations contained in paragraph 6. Other allegations contained in paragraph 6 are

conclusions of law to which no answer is required. To the extent that an answer to any of these allegations is required, Applicant denies the allegations contained in paragraph 6.

7. Answering paragraph 7 of the Notice of Opposition, Applicant lacks sufficient information to admit or deny the factual allegations contained in paragraph 7. Other allegations contained in paragraph 7 are conclusions of law to which no answer is required. To the extent that an answer to any of these allegations is required, Applicant denies the allegations contained in paragraph 7.

8. Answering paragraph 8 of the Notice of Opposition, Applicant lacks sufficient information to admit or deny the factual allegations contained in paragraph 8. Other allegations contained in paragraph 8 are conclusions of law to which no answer is required. To the extent that an answer to any of these allegations is required, Applicant denies the allegations contained in paragraph 8.

9. Answering paragraph 9 of the Notice of Opposition, Applicant lacks sufficient information to admit or deny the factual allegations contained in paragraph 9. Other allegations contained in paragraph 9 are conclusions of law to which no answer is required. To the extent that an answer to any of these allegations is required, Applicant denies the allegations contained in paragraph 9.

10. Answering paragraph 10 of the Notice of Opposition, Applicant lacks sufficient information to admit or deny the factual allegations contained in paragraph 10. Other allegations contained in paragraph 10 are conclusions of law to which no

answer is required. To the extent that an answer to any of these allegations is required, Applicant denies the allegations contained in paragraph 10.

11. Answering paragraph 11 of the Notice of Opposition, Applicant lacks sufficient information to admit or deny the factual allegations contained in paragraph 11. Other allegations contained in paragraph 11 are conclusions of law to which no answer is required. To the extent that an answer to any of these allegations is required, Applicant denies the allegations contained in paragraph 11.

12. Answering paragraph 12 of the Notice of Opposition, as a request for relief, Applicant lacks sufficient information to admit or deny the factual allegations contained in paragraph 12. Other allegations contained in paragraph 12 are conclusions of law to which no answer is required. To the extent that an answer to any of these allegations is required, Applicant denies the allegations contained in paragraph 12 and all right to relief requested therein.

13. Unless specifically admitted herein, Applicant denies all allegations stated or implied in the Notice of Opposition.

AFFIRMATIVE DEFENSES

FIRST AFFIRMATIVE DEFENSE

The Notice of Opposition fails to state a claim upon which relief can be granted.

SECOND AFFIRMATIVE DEFENSE

Due to the differences in appearance, sound, meaning and commercial impression between Applicant's marks and Opposer's claimed marks, Applicant's

marks are not likely to be confused with Opposer's claimed marks and incapable of diluting any claimed distinctive quality of Opposer's claimed marks.

THIRD AFFIRMATIVE DEFENSE

Due to the differences in the specific services covered by Applicant's marks and Opposer's claimed marks, Applicant's marks are not likely to be confused with Opposer's claimed marks and incapable of diluting any claimed distinctive quality of Opposer's claimed marks.

FOURTH AFFIRMATIVE DEFENSE

The term WOW is widely used in the United States, as partially evidenced by the numerous marks co-existing in registrations in the names of separate parties at the USPTO, whereby no one party can claim exclusive rights to the use of WOW on a nationwide basis.

FIFTH AFFIRMATIVE DEFENSE

The United States Patent and Trademark Office ("USPTO") did not cite Opposer's claimed registrations, nor any other registration or pending application, against Applicant's applications for the WE'RE GONNA WOW YA! marks. Applicant alleges that if there was any reason to believe that consumers would be confused as to the source of the respective services of the subject marks, the USPTO would certainly have refused registration, or at a minimum, issued at least an initial refusal, based on Opposer's claimed prior existing registrations.

SIXTH AFFIRMATIVE DEFENSE

The Opposer's claims are barred, in whole or in part, by the Opposer's failure to maintain the trademark significance/secondary meaning for the marks and names in question in this matter.

SEVENTH AFFIRMATIVE DEFENSE

The Opposer's claims are barred, in whole or in part, by the lack of sufficient secondary meaning in the marks and names in question in this matter.

EIGHTH AFFIRMATIVE DEFENSE

The Opposer's claims are barred, in whole or in part, by the abandonment of the marks and names in question in this matter.

NINTH AFFIRMATIVE DEFENSE

The Opposer's claims are barred, in whole or in part, by the Opposer's failure to achieve fame for the marks and names in question in this matter.

TENTH AFFIRMATIVE DEFENSE

Applicants are informed and believe, and upon such basis allege, that the Opposer's claims are barred by a failure to join indispensable parties.

ELEVENTH AFFIRMATIVE DEFENSE

Applicant reserves the right to assert any and all other affirmative defenses of which it becomes aware during the pendency of this matter.

WHEREFORE, in consideration of the foregoing, Applicant respectfully requests that this Court dismiss Opposer's claim and enter judgment for the Applicant and

CERTIFICATE OF MAILING

I HEREBY CERTIFY that this Answer is being electronically filed with the Trademark Trial and Appeal Board this 6th day of May, 2008, in the ESTTA system and is mailed, first class, postage prepaid this 6th day of May, 2008, to:

Meredith D. Pikser, Esq.
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/s/
Kevin T. Oliveira
Counsel for Applicant

#944309v1 Answer 49621/00028