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

Proceeding	91191644
Party	Defendant Pacific Sunwear of California, Inc.
Correspondence Address	MATTHEW D. MURPHEY GORDON & REES LLP 4675 MACARTHUR CT STE 800 NEWPORT BEACH, CA 92660-1844 mmurphey@gordonrees.com
Submission	Answer and Counterclaim
Filer's Name	Matthew D. Murphey
Filer's e-mail	mmurphey@gordonrees.com, estanley@gordonrees.com, ejaegers@gordonrees.com
Signature	/Matthew D. Murphey/
Date	09/29/2009
Attachments	Answer and Counterclaim.pdf (6 pages)(24085 bytes)

Registrations Subject to the filing

Registration No	2264266	Registration date	07/27/1999
International Registration No.	NONE	International Registration Date	NONE
Registrant	Willy Bogner GmbH & Co. Kommanditgesellschaft auf Aktien Sankt-Veit-Strasse 4 D-81673 Muenchen, GERMANY		
Grounds for filing	The registered mark has been abandoned.		

Goods/Services Subject to the filing

Class 025. Requested goods and services in the class: WEARING APPAREL, NAMELY, PANTS, TROUSERS, [RIDING PANTS,] GOLF PANTS, SPORTS JACKETS, JACKETS, DRESSES, COATS, SUITS, SKIRTS, BLOUSES, SHIRTS, PARKAS, SKI PANTS, SKI SUITS, PULLOVERS, CAPS, HATS, [STOCKINGS] AND GLOVES, SHAWLS, SCARVES, HEADBANDS, [SUSPENDERS,] SHOES, BELTS MADE FROM LEATHER AND IMITATION LEATHER, FOOTWEAR AND HEADWEAR
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Registration No	3233645	Registration date	04/24/2007
International Registration No.	NONE	International Registration Date	NONE
Registrant	Willy Bogner GmbH & Co.; Kommanditgesellschaft auf Aktien Sankt-Veit-Strasse 4 81673 MÃ¼nchen GERMANY		

Goods/Services Subject to the filing

Class 025. Requested goods and services in the class: Clothing, namely, cycling shorts, cycling shirts and

cycling jackets, pants, trousers, riding pants, golf pants, ski pants, ski suits, sports shirts, sports jackets, anoraks, gymnastic clothing, namely, leotards, bodysuits, tank shirts, exercise shorts, sweat socks and sports bras; raincoats, shorts, blousons, jackets, dresses, coats, suits, skirts, shirts, parkas, pullovers, stockings, evening dresses, ponchos, chasubles, blue jeans, capes, girdles, blouses, swimming caps, swimsuits, chemisettes, chemises, sweaters, sweatshirts, sweat pants, cardigans, underwear, polo shirts, pullovers, t-shirts, bandanas, ear muffs, gloves, mittens, shawls, shoulder wraps, scarves, socks, water proof clothing, namely, raincoats and trousers; overalls, overcoats; footwear and headwear

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

WILLY BOGNER GMBH & CO.,)	
KOMMANDITGESELLSCHAFT)	
AUF AKTIEN,)	
)	
Opposer,)	
)	
v.)	Opposition No. 91191644
)	
PACIFIC SUNWEAR)	
OF CALIFORNIA INC.,)	
)	
Applicant.)	
_____)	
)	
PACIFIC SUNWEAR)	
OF CALIFORNIA INC.,)	
)	
Counterclaim-Petitioner,)	
)	
v.)	
)	
WILLY BOGNER GMBH & CO.,)	
KOMMANDITGESELLSCHAFT)	
AUF AKTIEN)	
)	
Counterclaim-Respondent.)	

**APPLICANT PACIFIC SUNWEAR OF CALIFORNIA INC.’S ANSWER
TO OPPOSER’S NOTICE OF OPPOSITION AND COUNTERCLAIM FOR PARTIAL
CANCELLATION**

Pacific Sunwear of California, Inc. (“Applicant”), a corporation organized and existing under the laws of the State of California, by and through its attorneys, hereby answers the allegations set forth in the Notice of Opposition filed by Willy Bogner GmbH & Co. Kommanditgesellschaft auf Aktien (“Opposer”) and asserts its Counterclaim for Partial Cancellation.

Applicant states that it is the owner of the mark “B” in International Class 025 for the goods set forth in Applicant’s application (No. 77/646,025). Applicant denies that Opposer is entitled to the relief sought and denies that Opposer will be damaged as alleged.

The numbered Answers herein correspond to the numbered paragraphs set forth in Opposer’s Notice of Opposition.

1. Applicant admits the allegations set forth in paragraph 1 of the Notice of Opposition.
2. Applicant admits the allegations set forth in paragraph 2 of the Notice of Opposition.
3. Applicant is without knowledge and information sufficient to form a belief as to the truth of the allegations set forth in paragraph 3 of the Notice of Opposition and therefore denies same.
4. There is no paragraph 4 in the Notice of Opposition. To the extent Opposer intends the statement that “Registration No. 2,264,266 has been made incontestable under 15 U.S.C. § 1065” to comprise paragraph 4, Applicant is without knowledge and information sufficient to form a belief as to the truth of such allegation, and therefore denies same.
5. Applicant denies the allegations in paragraph 5 of the Notice of Opposition.
6. Applicant denies the allegations in paragraph 6 of the Notice of Opposition.
7. Applicant denies the allegations in paragraph 7 of the Notice of Opposition.
8. Regarding paragraph 8 of the Notice of Opposition, Applicant admits that registration of the applied-for mark would grant it the right to exclusive use of that mark. Applicant otherwise denies paragraph 8.
9. Applicant denies the allegations in paragraph of the Notice of Opposition.

AFFIRMATIVE DEFENSES

10. Applicant hereby incorporates by reference all of the preceding paragraphs.
11. Opposer fails to state a claim upon which relief can be granted.

12. On information and belief, Opposer has waived its alleged right to seek relief as set forth in the Opposition.
13. On information and belief, Opposer is barred by estoppel from maintaining said Opposition.
14. On information and belief, Opposer is barred by laches from maintaining said Opposition.
15. On information and belief, Opposer is barred by acquiescence from maintaining such Opposition.
16. On information and belief, Opposer's purported trademarks do not distinguish Opposer's goods from the goods of others.
17. On information and belief, Opposer has failed to continuously use its purported trademarks in commerce.
18. On information and belief, Opposer's purported trademarks have been abandoned by Opposer in that they have ceased to indicate (if they ever did indicate) Opposer as the source of any goods or services.
19. Many similar trademarks have been applied for, registered, and used by others including Applicant, for the same goods and services in the United States, without objection from Opposer, such that Opposer has no exclusive right to use its marks (or preclude others from using similar marks) in connection with such goods and services. Registration of Applicant's mark is consistent with prior registrations.
20. Due to such prior third party use and Applicant's use of such marks, and due to Opposer's failure to monitor and object to such use and registration, Opposer has abandoned any rights it had in its marks in connection with such goods and services.
21. Many similar trademarks have been applied for, registered, and used by others including Applicant, for the same goods and services in the United States, without objection from

- Opposer, such that Opposer has abandoned any rights it had in its marks in connection with such goods and services by Opposer's failure to monitor said uses and registrations.
22. Applicant's mark does not, will not, and is not likely to cause confusion, mistake, or deception as to the source of any goods or services, including those of Opposer, as is evidenced by the significant overall differences in the appearance, meaning, connotation and suggestion of the parties' respective marks.
23. Opposer has not suffered nor is it likely to suffer any injury or harm to its business or property by reason of Applicant's application and subsequent registration, and it therefore lacks standing to oppose Applicant's application.
24. Opposer's marks have acquired no secondary meaning or distinctiveness as used with the goods and services alleged by Opposer, and they cannot function as an indicator of source in connection with such goods and services.
25. Applicant reserves the right to develop further defenses during the Discovery Phase of the Opposition.

COUNTERCLAIM FOR PARTIAL CANCELLATION

26. Applicant hereby incorporates by reference all of the preceding paragraphs.
27. Applicant seeks a partial cancellation of both of Opposer's asserted trademark registrations, Registration Nos. 2,264,266 and 3,233,645, pursuant to Section 18 of the Trademark Act (15 U.S.C. § 1068). As grounds for such partial cancellation, Applicant states that Opposer has abandoned its marks for, among other things, jeans, cargo pants, denims, pants, skirts, shorts and belts, and many other items in International Class 025.
28. Opposer has abandoned its marks for such goods and services by allowing the use and registration of similar and nearly-identical marks by third parties and Applicant for the same goods and services in International Class 025 in the United States.

29. Opposer's abandonment is evidenced by its failure to monitor and attempt to block such third party use and registrations such that it has no exclusive right to use its marks or preclude others from using similar and nearly-identical marks in connection with such goods and services.
30. Applicant seeks such partial cancellations in order to limit or restrict the goods and services covered by Opposer's marks to those goods and services it has not previously abandoned.
31. Applicant has standing to bring this counterclaim because Registration Nos. 2,264,266 and 3,233,645 are being asserted against Applicant in Opposer's Notice of Opposition, such that the existence of these registrations are causing damage to Applicant.
32. The statutory fee of \$300.00 (\$300.00 per class) as prescribed in Trademark Rule 2.6(a)(16) is to be charged to Deposit Account No. 50-1990.

WHEREFORE, Applicant prays the Notice of Opposition be dismissed in its entirety with prejudice, that the Board grant Applicant the relief requested in its counterclaim, that the Board agree that a registration should be issued to Applicant for its trademark application Serial No. 77/646,025 for the mark "B" in International Class 025, and that the Trademark Trial and Appeal Board grant such other relief as it deems just and proper.

Respectfully submitted by:

/s/Matthew D. Murphey
Matthew D. Murphey
California State Bar No. 194111
Texas State Bar. No. 24049166
Eric M. Jaegers
Texas State Bar No. 24005037
Elizabeth K. Stanley
Texas State Bar No. 24060651
GORDON & REES LLP
2100 Ross Avenue, Suite 2800
Dallas, Texas 75201

Opposition No. 91191644
Application No. 77/646,025

Telephone: (214) 231-4660
Facsimile: (214) 461-4053
mmurphey@gordonrees.com
jaegers@gordonrees.com
estanley@gordonrees.com

**ATTORNEYS FOR APPLICANT
PACIFIC SUNWEAR OF CALIFORNIA, INC.**

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that the above document was filed electronically with the Trademark Trial and Appeal Board on this the 29th day of September, 2009.

/s/Matthew D. Murphey
Matthew D. Murphey

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the above and foregoing has been served on counsel for the Opposer Willy Bogner GmbH & Co. Kommanditgesellschaft auf Aktien via facsimile and certified first-class U.S. mail, return receipt requested on this the 29th day of September, 2009:

John L. Welch
Lando & Anastasi, LLP
One Main Street, Eleventh Floor
Cambridge, Massachusetts 02142
Telephone: 617.395.7000
Facsimile: 617.395.7070
Attorneys for Opposer

/s/Matthew D. Murphey
Matthew D. Murphey