

ESTTA Tracking number: **ESTTA627887**

Filing date: **09/18/2014**

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

Proceeding	91215426
Party	Defendant Fanning, Francis G.
Correspondence Address	SEAN C. FIFIELD LOCKE LORD LLP 111 S WACKER DR CHICAGO, IL 60606-4302 ipdocket-chi@lockelord.com
Submission	Answer and Counterclaim
Filer's Name	Sean C. Fifield
Filer's e-mail	sfifield@lockelord.com, mfurton@lockelord.com, kparr@lockelord.com
Signature	/scf/
Date	09/18/2014
Attachments	Answer to Opposition and Cancellation Counterclaim re Fanning Drop Logo - Executed.PDF(33904 bytes)

Registrations Subject to the filing

Registration No	2798028	Registration date	12/23/2003
Registrant	NORWEX HOLDING AS Nedre Hagaveg 17B Arnes, 2150 NORWAY		
Grounds for filing	The registered mark has been abandoned.		

Goods/Services Subject to the filing

Class 021. First Use: 1999/04/01 First Use In Commerce: 1999/04/01 All goods and services in the class are requested, namely: Mops and ergonomic attachments therefor; mop bases, namely, mopheads; stainlesssteel scrubbers for cleaning; stainlesssteel soap dishes; spray bottles sold empty; toilet cleaning kits consisting primarily of a toilet brush and plastic toilet brush holder; non-electric carpetsweeper; microfiber cleaning towels and cloths; mugs; thermal insulated containersfor food and beverages
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Registration No	3964282	Registration date	05/24/2011
Registrant	Norwex Holding AS Nedre Hagaveg 17B Arnes, 2150 NORWAY		

Goods/Services Subject to the filing

Class 003. First Use: 2000/01/00 First Use In Commerce: 2000/01/00 Requested goods and services in the class: Cleaning preparations for household purposes; dish-washing detergents; dishwasher detergents; facial lotion; foam soap for hands; hand, body and non-medicated foot lotion; laundry detergent; mattress cleaning preparation for elimination andremoval of all organic waste inside mattresses; hair conditioner; lime removing preparations; bath and shower gels; hair shampoo; fabric softeners for laundry use; laundrystain remover; drain opener; oven and


grill cleaners; cleaning preparations for fruit and vegetables; bath, shower and personal care products, namely, olive oil salt scrub; beauty serums; carpet stain remover
Class 005. First Use: 2000/01/00 First Use In Commerce: 2000/01/00 All goods and services in the class are requested, namely: Hand sanitizing and disinfecting preparation with anti-bacterial and anti-microbial properties; odor neutralizing preparations for use in litter boxes, garbage disposals, diaper pails, musty basements smells, shoes, clothing, and carpeting; air fresheners
Class 016. First Use: 1999/04/00 First Use In Commerce: 1999/04/00 All goods and services in the class are requested, namely: Newsletters, manuals, catalogs, printed flyers and printed advertisements in the field of cleaning products; writing instruments
Class 018. First Use: 2000/01/00 First Use In Commerce: 2000/01/00 All goods and services in the class are requested, namely: Tote bags
Class 021. First Use: 1999/04/00 First Use In Commerce: 1999/04/00 All goods and services in the class are requested, namely: Cleaning products, namely, stainless steel scrub sponges for cleaning; brushes for removing hair, lint and dust from textiles, car seats, and pets; cleaning cloths and towels for cleaning, wiping and dusting; abrasive pads for kitchen or domestic purposes; plastic water bottles sold empty; toilet cleaning kits consisting primarily of a toilet brush and plastic toilet brush holder
Class 025. First Use: 2000/08/00 First Use In Commerce: 2000/08/00 All goods and services in the class are requested, namely: Clothing, namely, bath robes, socks, t-shirts, jackets and men's neck ties
Class 035. First Use: 2005/01/00 First Use In Commerce: 2005/01/00 All goods and services in the class are requested, namely: Retail services by direct solicitation by sales agents in the field of cleaning products; providing on-line ordering services in the field of cleaning products; providing technical assistance in the establishment of and/or operation of independent direct sales businesses; business information services in the nature of providing information on business opportunities related to independent direct sales businesses
Class 041. First Use: 2005/01/00 First Use In Commerce: 2005/01/00 All goods and services in the class are requested, namely: Providing education services, namely, training services to independent sales representatives in the field of cleaning products and personal care products, and sales techniques

Registration No	4034517	Registration date	10/04/2011
Registrant	Norwex Holding AS Nedre Hagaveg 17B Arnes, 2150 NORWAY		

Goods/Services Subject to the filing

Class 003. First Use: 2007/09/01 First Use In Commerce: 2007/09/01 All goods and services in the class are requested, namely: Organic leg cream; organic face and neck gel; organic herbs skin cream; organic day skin cream; organic night skin cream; organic hand cream
Class 021. First Use: 1999/04/01 First Use In Commerce: 2000/08/01 All goods and services in the class are requested, namely: Eyeglass cleaning cloths

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

Norwex Malta Ltd., Norwex Holdings, AS, Norwex USA, Inc., Norwex Canada, Inc.)	
)	Opposition No. 91215426
Opposer,)	
)	Application Serial No. 86/020,758
)	Mark:
vs.)	
)	
Francis G. Fanning)	
)	
Applicant.)	
)

APPLICANT’S ANSWER AND COUNTERCLAIM

Francis G. Fanning (“Applicant”), by his attorneys, Locke Lord LLP, hereby submits his Answer to the Opposition filed by Norwex Malta Ltd., Norwex Holdings, AS, Norwex USA, Inc. and Norwex Canada, Inc. (collectively, the “Opposers”) against the droplet & design mark (the “Applicant’s Mark”) shown in Application Serial No. 86/020,758 (the “Application”), filed July 26, 2013, by Applicant.

1. Applicant seeks to obtain under the provisions of the Trademark Act of 1946 as amended, registration on the Principal Register of the Applicant’s Mark for: International Class 3: After sun creams; After-sun lotions; Age retardant lotion; Anti-aging cream; Anti-freckle creams; Anti-wrinkle cream; Body cream; Body lotion; Cosmetic creams; Cosmetic creams for skin care; Cosmetic suntan lotions; Face and body beauty creams; Face and body creams; Face and body lotions; Face creams; Face creams for cosmetic use; Facial cream; Facial lotion; Fair complexion cream; Hand cream; Lotions for cosmetic purposes; Lotions for face and body care; Moisturizing creams; Non-medicated skin care creams and lotions; Non-medicated skin creams; Skin cream; Skin lotion; Sun care lotions; Sun creams; Sun-block lotions; Sunscreen cream; Wrinkle resistant cream (the “Applicant’s Goods”)

ANSWER: Applicant admits that he seeks to obtain under the provisions of the Trademark Act of 1946 as amended, registration on the Principal Register of the Applicant’s Mark for the goods listed in Application Serial No. 86/020,758 and refers to and incorporates herein Application No. 86/020,758, which speaks for itself. Applicant denies all allegations in this paragraph inconsistent with that Application.

2. The Application is based on Applicant's purported first use of Applicant's Mark in commerce on or after March 4, 2011.

ANSWER: Applicant admits that the Application claims 15 U.S.C. §1051(a) as the filing basis and identifies first use of Applicant's Mark in commerce on or before March 4, 2011. Applicant denies that the Applicant identifies the date of first use of Applicant's Mark in commerce as "on or after March 4, 2011."

3. Applicant's Mark published for opposition on January 14, 2014. On February 13, 2014, within the time allowed for opposition of Applicant's Mark, each of the Opposers filed a Request for Extension of Time to Oppose (the "Requests"). On February 13, 2014, the Board granted the Requests and extended the time to oppose the Applicant's Mark to March 15, 2014. This Notice of Opposition is therefore timely filed.

ANSWER: Applicant admits that Applicant's Mark was published for opposition on January 14, 2014. Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the remaining allegations in this paragraph.

4. Opposer Norwex Holding AS is the owner of the following U.S. Trademark Registrations (the "Registered Marks"):



Reg. No. 2,798,028



Reg. No. 3,964,282



Reg. No. 4,034,517



ANSWER: Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations in this paragraph.

5. Opposer Norwex Holding AS licensed the use of the Registered Marks to Opposer Norwex Malta Limited, which in turn has sub-licensed the Registered Marks to each of Norwex Canada, Inc. (formerly known as Norwex Enviro Products, Inc.) and Norwex USA Inc.

ANSWER: Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations in this paragraph.

6. Opposers use the Registered Marks in connection with, among others, mops and ergonomic attachments therefor; mop bases, namely, mopheads; stainless steel scrubbers for cleaning; stainless steel soap dishes; spray bottles sold empty; toilet cleaning kits consisting primarily of a toilet brush and plastic toilet brush holder; non-electric carpetsweeper; microfiber cleaning towels and cloths; mugs; thermal insulated containers for food and beverages; cleaning preparations for household purposes; dishwashing detergents; dishwasher detergents; facial lotion; foam soap for hands; pumice stone for personal use; hand, body and foot lotion; lip balm; laundry detergent; mattress cleaning preparation for elimination and removal of all organic waste inside mattresses; deodorant for personal use; hair conditioner; lime removing preparations; bath and shower gels; hair shampoo; fabric softeners for laundry use; laundry stain remover; drain opener; oven and grill cleaners; cleaning preparations for fruit and vegetables; bath, shower and personal care products, namely, olive oil salt scrub; beauty serums; carpet stain remover; hand sanitizing and disinfecting preparation with anti-bacterial and anti-microbial properties; odor neutralizing preparations for use in litter boxes, garbage disposals, diaper pails, musty basement smells, shoes, clothing, and carpeting; air fresheners; newsletters, manuals, catalogs, printed flyers and printed advertisements in the field of cleaning products; writing instruments; Tote bags; Cleaning products, namely, stainless steel scrub sponges for cleaning; brushes for removing hair, lint and dust from textiles, car seats, and pets; cleaning cloths and towels for cleaning, wiping and dusting; abrasive pads for kitchen or domestic purposes; plastic water bottles sold empty; toilet cleaning kits consisting primarily of a toilet brush and plastic toilet brush holder; clothing, namely, bath robes, socks, t-shirts, jackets and men's neck ties, Retail services by direct solicitation by sales agents in the field of cleaning products; providing on-line ordering services in the field of cleaning products; providing technical assistance in the establishment of and/or operation of independent direct sales businesses; business information services in the nature of providing information on business opportunities related to independent direct sales businesses; providing education services, namely, training services to independent sales representatives in the field of cleaning products and personal care products, and sales techniques; organic leg cream; organic face and neck gel; organic herbs skin cream; organic day skin cream; organic night skin cream; organic hand cream, eyeglass cleaning cloths, and other related goods and services (“Opposers’ Goods and Services”).

ANSWER: Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations in this paragraph.

7. The Registered Marks are valid and subsisting, and are prima facie evidence of Opposers' exclusive rights to use said marks in commerce on the goods and services specified in each registration.

ANSWER: Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations in this paragraph.

8. Since at least as early as April 1999, one or more of the Opposers, themselves and/or through licensees, have used the Registered Marks in the United States for one or more of the Opposers' Goods and Services. Said use has been continuous since the date of first use and has not been abandoned.

ANSWER: Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations in this paragraph.

9. Opposers have advertised and promoted the Registered Marks extensively. Opposers have also made substantial sales of Opposers' Goods and Services using the Registered Marks. As a result of such use and promotion, the Registered Marks have developed and represent valuable goodwill inuring to the benefit of Opposers.

ANSWER: Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations in this paragraph.

10. The Registered Marks had priority over Applicant's Mark long before the March 4, 2011 filing date of the Application.

ANSWER: Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations in this paragraph.

11. Applicant's Mark is essentially identical to and otherwise deceptively and confusingly similar to each of the Registered Marks. Applicant's Mark has an overall confusingly similar appearance, sound, meaning and/or commercial impression.

ANSWER: Denied.

12. Further, Applicant's Goods are related to Opposers' Goods and Services, and Applicant's Goods marketed and sold under Applicant's Mark are within the zone of natural expansion of Opposers' Goods and Services marketed and sold under the Registered Marks. Opposers' Goods and Services are designed to improve quality of life by radically reducing the

use of chemicals in personal care and cleaning while Applicant's Goods involve the promotion of environmentally conscious research. Consumers are therefore likely to mistakenly believe that Applicant's Goods are offered by, affiliated with and/or sponsored by Opposers, when such is not true.

ANSWER: Applicant denies that Applicant's Goods are related to Opposers' Goods and Services. Applicant further denies that Applicant's Goods marketed and sold under Applicant's Mark are within the zone of natural expansion of Opposers' Goods and Services. Applicant further denies that consumers are likely to mistakenly believe that Applicant's Goods are offered by, affiliated with and/or sponsored by Opposers. Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the remaining allegations in this paragraph.

13. Due to the virtually identical nature of Applicant's Mark and the Registered Marks, the closely related nature of the goods and services provided by the respective parties, and the fact that Applicant's Goods are within the zone of natural expansion of Opposers' Goods and Services, consumer and potential consumers are likely to believe that Applicant's Goods originate from Opposers, resulting in a likelihood of confusion in the marketplace, and damage to Opposers.

ANSWER: Denied.

14. Upon information and belief, Opposers' Goods and Services marketed and sold under the Registered Marks and Applicant's Goods sold under Applicant's Mark will be promoted and sold in similar channels of trade to the same consumers or class of consumers.

ANSWER: Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations in this paragraph.

15. The use and registration by Applicant of Applicant's Mark for Applicant's Goods are likely to cause confusion or to cause mistake or deception among consumers and potential consumers, with the Registered Marks, again resulting in damage to Opposers.

ANSWER: Denied.

16. Because of the highly related nature of the goods and services, the fact that the Applicant's Goods are within the zone of natural expansion of Opposers' Goods and Services, and the highly similar nature of the marks in overall appearance, sound, meaning and commercial impression, the use and registration of the Applicant's Mark is likely to cause

confusion, mistake, or deception that Applicant's Services are those of Opposers, or are otherwise endorsed, sponsored, or approved by Opposers causing further damage to Opposers.

ANSWER: Denied.

17. The Registered Marks are famous and distinctive, and were famous prior to any first use of the Applicant's Mark. Applicant's Mark is likely to cause dilution and is likely to harm the reputation of the Registered Marks.

ANSWER: Denied.

18. If Applicant is granted registration of Applicant's Mark, it would thereby obtain at least a prima facie exclusive right to use of its alleged mark. Such registration would be a source of further damage and injury to Opposers.

ANSWER: Applicant admits that if Applicant is granted registration of Applicant's Mark, it would thereby obtain at least a prima facie exclusive right to use of its alleged mark. Applicant denies the remaining allegations in this paragraph.

19. Registration of the Applicant's Mark will result in damage to Opposers under the provisions of §2(a), §2(d) §43(c) and of the U.S. Trademark Act, 15 U.S.C. §1052, §1125 pursuant to the allegations stated above.

ANSWER: Denied.

Affirmative Defense No. 1

The doctrines of waiver, estoppel, laches and acquiescence bar the Opposition.

WHEREFORE, Applicant prays that the Opposition be dismissed with prejudice.

APPLICANT'S COUNTERCLAIM

Applicant believes that it is and will continue to be damaged by Opposers' pleaded Registration Nos. 2,798,028, 3,964,282 and 4,034,517 and hereby counterclaims for cancellation of Registration Nos. 2,798,028 and 4,034,517 in their entirety on the grounds that the marks shown in such registrations have been abandoned and for cancellation of Registration No. 3,964,282 with respect to all goods except "deodorant for personal use" on the grounds that the

mark shown in such registration has been abandoned with respect to all goods except “deodorant for personal use.”

As grounds for this counterclaim, it is alleged that:

1. Opposers maintain a website for their United States operations at www.norwex.biz. At some point between November 25, 2013 and February 7, 2014, Opposers removed all use of the Registered Marks on its website, except for the display of a single photograph of deodorant bearing a Registered Mark in Opposers’ 2014 catalog.
2. Opposers’ 2014 catalog displaying a wide variety of the Opposers’ goods shows no use of the Registered Marks except for the display of a single photograph of deodorant bearing a Registered Mark.
3. Opposers’ 2014 Fall Catalog displaying a wide variety of the Opposers’ goods shows no use of the Registered Marks.
4. On information and belief, Opposers discontinued use in commerce of the Registered Marks on all goods except “deodorant for personal use” on or before February 7, 2014. On information and belief, Opposers are not currently using the Registered Marks in commerce on any goods except “deodorant for personal use.”
5. On information and belief, Opposers’ discontinuance of their use in commerce of the Registered Marks on all goods except “deodorant for personal use” and their sudden and complete discontinuance (except on deodorant for personal use) of the use of the Registered Marks on the United States webpage and in their catalog materials reflects an intent to discontinue use of the Registered Marks with an intent not to resume such use. Therefore, because Opposers ceased use of the Registered Marks in commerce on all of the goods (except “deodorant for personal use”) identified in Registration Nos. 2,798,028, 3,964,282 and 4,034,517

with an intent not to resume such use, Opposers have abandoned the Registered Marks with respect to all goods other than “deodorant for personal use.”


WHEREFORE, Applicant prays that Registration Nos. 2,798,028 and 4,034,517 be cancelled in their entirety and Registration No. 3,964,282 be cancelled with respect to all goods except “deodorant for personal use.”

Please recognize the undersigned as counsel for the Applicant in this proceeding.

Dated: September 18, 2014

Respectfully submitted,

FRANCIS G. FANNING

By: 

Sean C. Fifield
One of his attorneys

Sean C. Fifield
Matthew T. Furton
Keith D. Parr
LOCKE LORD LLP
111 South Wacker Drive
Chicago, IL 60606
312.443.1787 (SCF)
sfifield@lockelord.com