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

Proceeding	91215976
Party	Plaintiff Carl Walther GmbH, Umarex Sportwaffen GmbH & Co., KG
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Serial No.: 85/965,968
Filed: June 20, 2013
For the mark: Walther Ribbon Design
Published in the *Trademark Official Gazette* on December 24, 2013

In the matter of Application Serial No.: 85/965,933
Filed: June 20, 2013
For the mark: WALTHER
Published in the *Trademark Official Gazette* on January 21, 2014

Carl Walther GmbH and
Umarex Sportwaffen GmbH & Co. KG,

Opposers,

v.

Opposition No. 91215976

Catharina Herriger,

Applicant

**OPPOSERS' REPLY BRIEF IN SUPPORT OF MOTION FOR LEAVE TO AMEND
CONSOLIDATED NOTICE OF OPPOSITION AND MOTION FOR SUMMARY
JUDGMENT**

Opposers Carl Walther GmbH and Umarex Sportwaffen GmbH & Co. KG (collectively, "Walther") submit this Reply Brief in response to Applicant Catharina Herriger's Opposition to Motion to Amend [and] Opposition to Motion for Summary Judgment ("the "Herriger Opposition Brief"). Applicant fails to raise, much less demonstrate, the existence of any genuine dispute that Applicant lacked at the time of filing -- and continues to lack -- the requisite *bona fide* intent to use in commerce the WALTHER mark shown in Application Serial No. 85/965,933 or the mark (the "Walther Ribbon Design") shown in Application Serial No. 85/965,968 (collectively, the "Opposed Marks" or the "Opposed Applications") in connection with "jewellery and watches." Applicant also fails to raise, much less demonstrate, the existence of any genuine and material issue as to the

Opposed Marks' likelihood of confusion with Walther's pleaded registrations for the WALTHER mark, the Walther Ribbon Design mark, and combinations thereof (collectively, the "WALTHER® Marks"). Accordingly, Opposers reiterate that trial is not necessary or appropriate, and the Trademark Trial and Appeal Board (the "Board") should enter summary judgment in their favor.

I. The Board Should Grant Walther's Motion for Leave to Amend the Consolidated Notice of Opposition

Applicant's sole basis to oppose Walther's Motion for Leave to Amend the Consolidated Notice of Opposition is that Walther "lack[s] a good faith basis for alleging lack of bona fide intent by Applicant" for the reasons set forth in its opposition to Walther's summary judgment motion. (Herriger Opp'n Br. at 2.) Applicant does not cite the record or any authority to suggest that this is a sufficient ground to deny Walther's motion.

Walther's motion to amend meets each of the Board's standards, i.e., the absence of prejudice to the non-moving party, the legally sufficient nature of the amendment, and Walther's good-faith basis to amend. *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 U.S.P.Q. 2d 1540 (T.T.A.B. 2001) (citing *Foman v. Davis*, 371 U.S. 178, 182 (1962)); *see also Cool-Ray, Inc.*, 183 U.S.P.Q. at 621. A motion to amend is entirely separate from a motion for summary judgment.

Walther's good-faith basis to amend the Consolidated Notice of Opposition is based upon the lack of any information relating to bona fide intent in the discovery record, which Walther has already submitted to the board in its entirety. (*See Exhibits to Opposers' Mem. Supp. Mot. Summ. J.*) Applicant has no legal or factual basis to assert that Walther's motion to amend is in bad faith. Accordingly, Walther respectfully requests that the Board grant the Motion for Leave to Amend the Consolidated Notice of Opposition.

II. The Board Should Grant Walther's Motion for Summary Judgment

Applicant's brief is devoid of any authoritative precedent¹ or legitimate factual assertions that establish any genuine issue of material fact as to (i) Applicant's lack of bona fide intent to use the Opposed Marks and (ii) the likelihood of confusion among Walther's various trademark registrations for the WALTHER® Marks and the Opposed Marks.

A. Applicant Cannot Support any Genuine Issue of Material Fact as to the Lack of a Bona Fide Intent to Use in Commerce the Opposed Marks

Applicant concedes that she does not have any declarations, business plans, marketing plans, prototype products, or product development information relating to a bona fide intent to use in commerce the Opposed Marks in connection with jewelry and watches. (Herriger Opp'n Br. at 3.) Yet Applicant, citing no specific authority, argues that no such documentary evidence is required "under the circumstances" – i.e., in the context of jewelry and watches. This unsupported argument does not preclude summary judgment to her lack of bona fide intent to use the Opposed Marks.

A litany of prior Board decisions establish that documentary materials are necessary to establish an applicant's bona fide intent to use a mark in commerce. *See, e.g., Honda Motor Co., Ltd. v. Winkelmann*, 90 U.S.P.Q.2d 1660 (T.T.A.B. 2009) (granting summary judgment where applicant failed to provide responsive documents to support intent to use mark and stated "no such documents exist"). These documentary materials include items that are commonplace in any industry, including the jewelry and watch industries, to support a bona fide intent to produce goods that will bear the applied-for mark. *See Diageo North Am., Inc. v. Captain Russell Corp.*, Opp'n No. 91203745, at 7-8 (T.T.A.B. 2013) (non-precedential) (granting summary judgment on lack of bona fide intent where there was no business plan, budget, market research, focus group testing, recipes, discussions with advertising agencies or marketing plans). Applicant has failed to produce any such items.

¹ Applicant's 13-page brief contains a total of two case citations: *Lane Ltd. v. Jackson Int'l Trading Co.*, which is cited as part of quoting Walther's own citation, and *In re du Pont de Nemours & Co.* for the *du Pont* factors. (Herriger Opp'n Br. at 2, 7.)

Applicant then argues that she need not develop any documentary evidence because watches and jewelry have “readily and cheaply available” suppliers and because the goods can be “easily and quickly marketed.” (Herriger Opp’n Br. at 4.) In essence, Applicant’s argument is that watches and jewelry are so simple to manufacture, and wholesalers so widely available, that anyone with a background in watch design automatically has a per se bona fide intent to use any trademark upon filing. However, these arguments speak merely to the *ability*, in the abstract, to produce the goods identified in the Opposed Applications. They provide no objective support for a bona fide *intent* to produce those goods – let alone a bona fide intent to also use the Opposed Marks in connection with those goods, as required.

What’s more, these arguments flatly contradict the Board’s established precedent. Assertions of “a generalized intention or desire to license the mark or partner with others at some indefinite time in the future” do not establish a bona fide intent to use in commerce. *Lincoln Nat’l Corp. v. Anderson*, Consolidated Opp’n Nos. 91192939 and 91194817 (T.T.A.B. 2014); *see also L’Oreal S.A. v. Marcon*, 102 U.S.P.Q.2d 1434, 1443 (T.T.A.B. 2012) (“Applicant’s very generalized and non-specific reference to licensing and outsourcing as potential strategies to bring the product to market at an unspecified time in the future [is] woefully deficient in showing a bona fide intent to use the mark.”). The Board has recently held that an applicant must present documentary evidence to establish a bona fide intent to use *specifically in the context of watches*. *Swatch AG v. M.Z. Berger & Co., Inc.*, 108 U.S.P.Q.2d 1463 (finding lack of bona fide intent to use IWATCH mark in connection with watches and clocks including “jewelry watches” where applicant presented a trademark search report, email regarding discussion with examining attorney, and internal emails with renderings).

Applicant then reveals, for the first time in this proceeding and contrary to her discovery responses, that Applicant’s counsel performed a clearance search before filing the Opposed Applications. (Herriger Opp’n Br. at 4; Weyer Decl. ¶ 2.) Walther’s discovery requests specifically sought information relating to any clearance searches, to which Applicant stated that the information

did not exist and invoked the attorney-client privilege. (Applicant's Resp. to Opposer's First Set of Disc. Reqs., at 2-3, 9.) According to Applicant, this search existed well before the discovery period. (Weyer Decl. ¶ 2.) Black-letter law states that clearance searches are discoverable information, and that attorney opinions as to searches are not discoverable unless the attorney-client privilege is waived. TBMP § 414. A party responding to a discovery request by indicating that it does not have certain information cannot later introduce that information as part of the evidence in the proceeding. *See Panda Travel, Inc. v. Resort Option Enterprises, Inc.*, 94 U.S.P.Q.2d 1789 (TTAB 2009). It is equally impermissible for a party to invoke the attorney-client privilege and subsequently rely upon the heretofore privileged information. *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 U.S.P.Q.2d 1895, 1896 n.5 (TTAB 1988). Put bluntly, this information should have been produced during discovery in response to specific discovery requests, there is no excuse for why it wasn't, so it cannot be relied on now or considered in Applicant's misguided attempt to defeat summary judgment.

Even if Applicant had disclosed the search, the Board has held that a clearance search does not constitute sufficient documentary evidence to support a bona fide intent to use the Opposed Marks. *Swatch AG*, 108 U.S.P.Q.2d at 1473. The clearance search, and Applicant's counsel's opinion thereon, merely speaks to whether Applicant applied for the Opposed Marks in good faith – as such, it cannot create a genuine issue of material fact as to the lack of a bona fide intent to use in commerce the Opposed Marks. Applicant's improper disclosure does not preclude summary judgment.

Applicant then improperly reveals yet more stale facts: Applicant registered the domain name "walther.us" around the same time that the Opposed Applications were filed. (Herriger Opp'n Br. at 4-5.) Applicant then makes the entirely unsupported assertion that the domain name is the "most important, objective issue" and "the most crucial, valuable, and important resource needed" to market jewelry and watches. (*Id.* at 4.) Applicant claims that "none" of Walther's discovery requests were directed at this information. (*Id.*)

Yet again, Applicant is mistaken. Walther requested “[a]ll documents that evidence, refer, or relate to Applicant’s bona fide intent to use” the Opposed Marks. (Applicant’s Resp. to Opposer’s First Set of Disc. Reqs. at 15 (emphasis added).) Walther also submitted a specific interrogatory requesting “all facts that support or evidence” a bona fide intent to use the Opposed Marks. (*Id.* at 12 (emphasis added).) Just as with the clearance search, the “walther.us” domain name had already been registered at the time of these requests. (Weyer Decl. ¶ 7.) Yet Applicant responded that “[n]o additional responsive and discoverable documents exist” aside from the application files for the Opposed Marks. To the extent Applicant considered the domain name to be of paramount importance with respect to establishing her bona fide intent, this information relating to the domain name should have been produced in her discovery responses. Applicant failed to do so, and indeed claimed that such information did not exist. Therefore, Applicant cannot rely upon this evidence. *See Panda Travel*, 94 U.S.P.Q.2d 1789.

Even if the information relating to the domain name was properly produced, it is not nearly as compelling or “crucial” as Applicant argues, and it does not create a genuine and material issue of fact about Applicant’s lack of the requisite bona fide intent. A domain name registration, or even multiple domain name registrations, is not sufficient to establish a bona fide intent to use a mark in commerce. *Saul Zaentz Co. v. Bumb*, 95 U.S.P.Q.2d 1723 (T.T.A.B. 2010) (finding lack of intent to use where applicant produced only the application record and several domain name registrations). It simply does not follow that a domain name registration alone suffices to establish intent to use a mark for “watches and jewelry.” Accordingly, Applicant’s attempts to improperly introduce information that existed and should have been produced during discovery cannot conjure a genuine issue of material fact as to her lack of bona fide intent to use the claimed marks in commerce.

B. There Is No Genuine Issue of Material Fact as to Likelihood of Confusion

Applicant’s arguments as to the likelihood of confusion among the WALTHER® marks and the Opposed Marks are unsupported by the record and contrary to the correct application of the *du*

Pont factors. See generally, *In re E. I. du Pont de Nemours & Co.*, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). Applicant relies in particular on a “table” of the factors to argue that Applicant “wins” 12 of the factors, and suggests that the unmistakable identity among the Opposed Marks and the WALTHER® Marks is only “neutral” to the analysis. It is well settled that the list of factors is not a “score-card,” and whether a party “wins” a majority of the factors is not the point. *Thane Int’l v. Trek Bicycle*, 305 F.3d 894, 901 (9th Cir. 2002).

Walther is under no requirement to address each and every *du Pont* factor. To the contrary, the *du Pont* factors are non-exhaustive, interrelated, often overlap, and must be considered as an “amalgam.” *Sun-Fun Prods., Inc. v. Suntan Research & Dev., Inc.*, 656 F.2d 186, 189 (5th Cir. 1981). The Board has repeatedly made clear that, in any likelihood of confusion analysis, “two key considerations are the similarities between the marks and the similarities between the goods.” *In re Thor Tech, Inc.*, Proceeding No. 85667188 (TTAB 2015); see also *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098 (C.C.P.A. 1976). The undisputed record indicates that each of the Opposed Marks are identical, in tandem, to the WALTHER® Marks; that the WALTHER® Marks are famous and widely-known and that the identified goods and trade channels are closely related.

Applicant’s applied-for WALTHER and Walther Ribbon Design marks are each unmistakably identical to Walther’s corresponding prior registrations for WALTHER and the Walther Ribbon Design, respectively. Applicant’s argument that the identity among the marks is “neutral” to the likelihood of confusion analysis is flatly untrue. The similarity among the marks is the “hallmark of consumer confusion” and “the most important consideration” in a likelihood of confusion analysis. See *Al-Site Corp. v. VSI Int’l, Inc.*, 174 F.3d 1308, 1330 (Fed. Cir. 1999); *Armstrong Cork. Co. v. World Carpets, Inc.*, 597 F.2d 496, 501 (5th Cir. 1979). Because each of the marks at issue are identical to the marks in Walther’s pleaded registrations in every possible respect, this factor couldn’t weigh more strongly in favor of finding a likelihood of confusion as a matter of law. *In re Shell Oil Co.*, 26 U.S.P.Q.2d 1687, 1689 (Fed. Cir. 1993).

Applicant concedes that its WALTHER mark is “similar” to Walther’s senior registrations for the WALTHER mark in standard characters. (Herriger Opp’n Br. at 7.) Applicant points to an unauthenticated list of 21 live registrations (ostensibly copied from the TESS database) to suggest that the WALTHER mark is a “common given name” and is interchangeable with “WALTER.” Applicant does not provide any specifics as to the goods or services cited in these registrations, nor does Applicant make any showing that these third-party marks have the required impact on consumer perceptions of the WALTHER mark. *See Charles Jacquin et Cie, Inc. v. Destileria Seralles, Inc.*, 730 F. Supp. 662 (E.D. Pa. 1989) (holding it is not necessary to prove “absence of possible sources of confusion with its product” aside from the infringer’s use). This argument is also incompatible with Applicant’s admission that she is a distant relative of Walther’s founder, Carl Walther, and that she has known of the WALTHER® Marks since childhood. (Applicant’s Resp. to Opposer’s First Set of Disc. Reqs. at 11.)

As to the Walther Ribbon Design, Applicant claims, without a properly authenticated record, the existence of 5,204 records on the TESS database for marks identifying “ribbon” in the design description. (Herriger Opp’n Br. at 12.) The existence of other registrations describing a “ribbon” in the design description, however voluminous, ignores the fact that Applicant has applied to register a ribbon design which resembles *exactly* the marks in Walther’s pleaded registrations for the Walther Ribbon Design.

The record further supports an undisputed finding that the WALTHER® Marks – including the Walther Ribbon Design – are strong, and have attained significant fame and consumer recognition. Applicant’s brief devises a variety of spurious and derogatory arguments² to suggest that

² The more outlandish statements in Applicant’s brief repeatedly associate Opposers with Nazi Germany and the Holocaust, and characterize Opposers as “dubious,” “despicable,” and “ruthless.” (*See generally* Herriger Opp’n Brief at 5-6, 9-10; Weyer Decl. ¶ 7-8.) It is self-evident that such statements have no bearing on this proceeding, to say nothing of their falsity, ignorance, and inflammatory purpose. Opposers note that the Board may strike *sua sponte* these impertinent, immaterial, and scandalous elements of Applicant’s brief and exhibits pursuant to Fed. R. Civ. P. 12(f).

the WALTHER® Marks are not as famous as the “legendary American arms companies” such as “Remington [*sic*].” (Herriger Opp’n Br. at 9.) Applicant also claims that fame “can only be earned by a trademark owner’s own acts.” (*Id.*) The record establishes that Walther has taken a host of actions to support the fame of the WALTHER® Marks. But fame does not depend upon the source of the “acts,” only whether there is “widespread recognition of a mark among consumers.” *Daddy’s Junky Music Stores, Inc. v. Big Daddy’s Family Music Ctr.*, 109 F.3d 275 (6th Cir. 1997). It is not even necessary that the public actually be familiar with the source for a mark to be famous. *Paddington Corp. v. Attiki Imps. & Distrib., Inc.*, 996 F.2d 577. Applicant has not and cannot contradict the undisputed record or create any genuine dispute as to the fame or scope of protection for the WALTHER® marks.

Applicant then contends that the goods at issue are distinct because Walther’s “deadly, violent handguns” are produced “to kill and destroy,” while Applicant’s applied-for goods are meant “to decorate, pamper, and please.” (Herriger Opp’n Br. at 10.) This rather misguided characterization ignores the appropriate and routinely-formulated test that does not consider the “purpose” of the goods, but whether consumers would believe that Applicant’s goods, sold under identical marks, emanate from or are sponsored by Walther. *See, e.g., In re Hal Leonard Publ’g Corp.*, 15 U.S.P.Q.2d 1574 (T.T.A.B. 1990). The evidence of record indicates that many of Walther’s contemporaries and competitors sell under the same mark both personal defense products and personal accessories such as jewelry and watches. Applicant also ignores that the WALTHER® Marks are registered in connection with a variety of goods for a variety of purposes aside from handguns, including knives, machine tools, telescopes, pistols, rifles, guns, and toy weapons. Therefore, Applicant’s arguments fail to raise any genuine issue of material fact as to the relatedness of the goods.

There also is no genuine dispute as to the overlapping channels of trade among Walther’s products and Applicant’s applied-for goods. Applicant goes so far as to suggest, without factual support, that it is “legally impossible for Opposers’ weapons [*sic*] to be sold in the same channels of

trade as Applicant's proposed products." Walther already has cited numerous examples of stores that sell both firearms (and related goods and accessories) and jewelry and/or watches. (Opposers' Mem. Supp. Mot. Summ. J., Anderson Decl. ¶¶ 35-41, Exs. Z-AE.). The goods are therefore presumed to travel in overlapping channels of trade.

Walther's summary judgment motion establishes that the *du Pont* factors point squarely to a likelihood of confusion among the marks as a matter of law. In light of the above, Opposers respectfully request that the Board enter summary judgment in their favor, sustain the opposition, and refuse registration of Application Serial Nos. 85/936,968 and 85/965,933.

Respectfully Submitted,

WINTHROP & WEINSTINE, P.A.

Date: March 13, 2015

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CERTIFICATE OF SERVICE BY MAIL

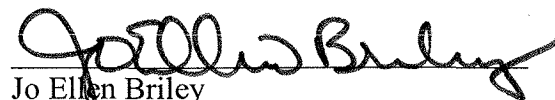
STATE OF MINNESOTA)
) ss.
COUNTY OF HENNEPIN)

Jo Ellen Briley, of the City of Minneapolis, County of Hennepin, in the State of Minnesota, says that on the 13th day of March, 2015, she mailed by First Class mail, a true and correct copy of Opposers':

1. Reply Brief in Support of Motion for Leave to Amend Consolidated Notice of Opposition and Motion for Summary Judgment.

in the above-captioned action to the following last known correspondence address of record identified in the Trademark Status and Document Retrieval online database for Applicant's representative, to-wit:

Frank Michael Weyer
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Jo Ellen Briley