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

Proceeding	91222434
Party	Plaintiff Invicta Wwatch Company Of America Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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INVICTA WATCH COMPANY OF AMERICA, INC.,

Opposer

vs.

INVICTA S.p.A.,

Applicant.

Consolidated

Opposition No. 91222434
(Parent Case)

--and--

Opposition No. 91224325

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**BRIEF IN OPPOSITION TO APPLICANT'S MOTION FOR
SUMMARY JUDGEMENT AND IN SUPPORT OF OPPOSER'S
CROSS-MOTION FOR SUMMARY JUDGEMENT**

Opposer, Invicta Watch Company of America, Inc. (IWCOA) submits this Brief in opposition to the Motion for Summary Judgement filed by Applicant, Invicta, S.p.A. (ISPA) and in support of its Cross-motion for Summary Judgement.

ISSUES PRESENTED

- (1) Whether contractual estoppel is an available defense to an opposition when the opposed goods are different from the agreed upon goods in the consent agreement.
- (2) Whether the *Morehouse* defense is available if the goods of the pre-existing registrations are not essentially identical to the goods of the opposed applications.
- (3) Whether lack of bona fide intent to use mark can be overcome by mere assertion of an intent to use without corroboration.

INTRODUCTION

The subject of this proceeding are two oppositions filed by IWCOA against ISPA's applications for registration of the mark INVICTA. Opposition No. 91224325 affects goods in classes 18 and 25 and Opposition No. 91222434 affects services in class 35.

The grounds of opposition, in both cases, are (1) fraud in that there was no intent to use the mark in commerce at the time of filing the applications; (2) likelihood of confusion and (3) dilution by blurring. The six IWCOA registrations that were pleaded in the consolidated oppositions are for goods in classes 14, 3, 9, 16 and services in class 35, as enumerated below:

<u>Mark</u>	<u>Reg. No.</u>	<u>Reg. Date</u>	<u>Goods</u>
(1) INVICTA and design	2,947,259	05/10/05	Watches, chronometers chronographs, clocks, watch bands, watch cases, watch chains in Class 014

(2) INVICTA YELLOW	3,331,253	11/6/07	Perfumes, colognes, and hand and body lotions in Class 003
(3) INVICTA	4,399,998	09/10/13	Retail store services featuring timepieces, eyewear, and writing instruments in Class 035
(4) INVICTA EYEWEAR	4,381,337	08/06/13	Eyeglasses; frames for spectacles and sunglasses; lenses for sunglasses; sunglasses in Class 009
(5) INVICTA	4,086,630	01/17/12	Sunglasses in Class 009 and Pens in Class 016
(6) INVICTA ELEMENTS YOUR BASIC CATALYSTS plus design	4,060,431	11/22/11	Jewelry in Class 014 and writing instruments in Class 016.

ISPA moved, in both oppositions, to consolidate, to amend its answer; and to amend the services in application Ser. No. 79/146,181 and the goods in Ser. No. 86/301,552. The motion to consolidate and to amend the answer was granted. The motion to amend the goods and services of the respective applications was deferred.

The terms of the previous nonjudicial settlement agreements do not create a contractual estoppel defense to the oppositions

ISPA has not raised this defense with regard to the class 35 opposition (Ser. No. 79/146,181).

The 2009 agreement, does not include any provisions nor has ISPA relied upon any provisions, that could be construed as estopping IWCOA from opposing ISPA's applications.

The 2010 agreement similarly has not been specifically relied upon as a defense for estopping the filing of the oppositions. Further, this settlement agreement does not relate to the class 18 or 25 goods or class 35 services.

With regard to the 2011 agreement, the relevant paragraph reads as follows:

“3. Each party agrees not to institute any action to oppose, cancel or otherwise interfere with the use and registration of the other party's respective mark pursuant to the above conditions” (emphasis added).

In order to determine the parameters of this agreement, the above conditions must be examined. The preamble of this consent agreement refers to ISPA's Reg. No. 3,976,519 for goods in classes 9, 16, 18, and 25 and the agreed upon goods for which each party shall not use the INVICTA mark, is recited in paragraph “2” of the agreement. The chart below provides side by side comparison.

Comparison Chart

List of goods that IWCOA agreed not to use mark as per ¶2 of the 2011 consent agreement	List of goods of the opposed application Ser. No. 86/301,552
Leather and imitation leather bags, suitcases, shoulder bags, wallets, coin purses, rucksacks, school bags, sports bags, waistpacks, umbrellas; in Class 18	Rucksacks; backpacks; school bags, shoulder bags for carrying infants, reusable shopping bags; travelling bags and duffle bags; bags and holdalls for sports; handbags; beach bags; backpacks for hiking and climbing, satchels, briefcases, pocket wallets; purses; key cases; hip bags; suitcases; umbrellas, trunks; walking sticks; overnight suitcases; vanity cases sold empty, wheeled shopping bags and wheeled suitcases, in Class 18
Clothing, namely jackets, insulated jackets, down jackets, rain jackets, fleece jackets, wind jackets, vests, insulated vests, down vests, fleece vests, wind vests, pants, short pants, jerseys, shirts, T-shirts, gloves, mittens, headbands; headgear, namely caps; footwear, namely sports shoes, boots, sneakers; in Class 25	Technical apparel for maintaining physical shape, namely, trousers, sport suits, shorts; swimwear, bathing suits, bikinis, slippers, swimsuit shorts, swimming caps; pareos, bras, ponchos; underwear, namely, body shapers, boxers, T-shirts, tank tops, bras, leotards, shorts, slippers, thongs; leather wear and lounge wear, namely, leather hats and lounge pants; bathrobes, nightdresses, pajamas; pants, trousers, overalls, jeans, shorts, jackets, coats, waistcoats, overcoats, waterproof clothing, namely, jackets and pants; hosiery, knitwear, namely, sweaters, cardigans, fleece pullover tops, jumpers, woven shirts; dresses, track suits, shirts, polo shirts, nightshirts for men, T-shirts, undershirts, dresses, skirts, trousers, skirts, gowns; socks; dressing gowns; waist bands; balaclavas, scarves, silk scarves, neckwear, neckerchiefs, neck scarves, bandanas, roll necks, namely, neck gaiters; gloves and mittens, ski gloves; headwear, namely, hats, caps, bandanas, visors, wrist bands; belts and ties; shoes, sneakers, boots, sandals, slippers, sport and athletic shoes, studs for golf shoes or sport shoes, mountaineering shoes; ski boots and trekking boots, gaiters, bands for protecting face and ears from cold, in Class 25

List of goods that IWCOA agreed not to use mark as per ¶2 of the 2011 consent agreement	List of goods of the opposed application Ser. No. 86/301,552
Scuba masks and underwater sport goggles, safety goggles, safety helmets, in Class 9	n/a
Paper and cardboard, stationery, note books, note pads, school diaries; soft and hard school supply pouches for holding pens and pencils among other articles; pencil sharpeners, drawing rulers, erasers, personal organizers, address books, folders; in Class 16	n/a

It should be apparent that ISPA’s opposed application covers goods that are broader in scope and substantially different from the goods for which IWCOA is contractually barred from using the mark. This is clearly shown on the comparison chart. ISPA is seeking registration for goods not identified in the consent agreement, that was prepared by ISPA’s attorneys, and is seeking rights beyond those enumerated in the consent agreement. Opposition no 91224325 therefore falls outside of the parameters of the parties’ consent agreement and IWCOA is not bared from opposing the application. This opposition does not interfere with the use of ISPA’S mark or its registration no. 3,976,519 as contemplated by the agreement. This explanation is consistent with the parties previous agreements wherein the parties meticulously carved out mutually exclusive rights to use the INVICTA mark; the language of this agreement must therefore be interpreted as not barring this opposition. Any other interpretation would be patentably unreasonable.

**ISPA’S pre-existing registrations are not a sufficient
Morehouse defense to the oppositions in view of the differences
in the scope of the goods**

The scope of the opposed class 18 and 25 goods have been expanded from those goods of the pre-existing registrations.

A comparison of the registered goods in classes 18 and 25 goods with the goods of the opposed application (Ser. No. 86/301,552), is shown below with the added goods underlined:

Goods of ISPA’s existing registrations including deleted goods in brackets	Goods of opposed application with the added goods underlined
<p>Registration No. 2,109,407</p> <p>Bags, namely, [handbags, athletic bags,] school bags, traveling bags; rucksacks, wallets, luggage; [pouches, namely, drawstring pouches and felt pouches; cases, namely, key cases, passport cases, business card cases, briefcases, document cases,] class 18</p> <p>Registration No. 1,031,461</p> <p>Luggage in class 18</p> <p>Registration No. 3,976,519</p> <p>Leather and imitation leather bags, suitcases, shoulder bags, wallets, coin purses, rucksacks, school bags, sports bags, waistpacks, umbrellas, class 18</p>	<p>Rucksacks; <u>backpacks</u>; school bags, <u>shoulder bags for carrying infants</u>, <u>reusable shopping bags</u>; travelling bags and <u>duffle bags</u>; bags and holdalls for sports; <u>handbags</u>; <u>beach bags</u>; <u>backpacks for hiking and climbing</u>, <u>satchels</u>, <u>briefcases</u>, pocket wallets; purses; <u>key cases</u>; <u>hip bags</u>; suitcases; umbrellas, <u>trunks</u>; <u>walking sticks</u>; <u>overnight suitcases</u>; <u>vanity cases sold empty</u>, <u>wheeled shopping bags</u> and <u>wheeled suitcases</u>, class 18</p>

Goods of ISPA's existing registrations including deleted goods in brackets	Goods of opposed application with the added goods underlined
<p>Registration No. 2,151,279</p> <p>[Shorts, Bermuda shorts,] clothes, trousers, [overalls, track suits, top, body suits, T-shirts,] shirts, polo-neck shirts, plush shirts, [tricot shirts, pile shirts, waistcoats, sports jackets in different fabrics, jackets in different fabrics, cloaks, swimsuits, scarfs, hats,] gloves, [caps, gaiters, spats, shoes, ponchos,] ski gloves in class 25</p> <p>Registration No. 3,976,519</p> <p>Clothing, namely jackets, insulated jackets, down jackets, rain jackets, fleece jackets, wind jackets, vests, insulated vests, down vests, fleece vests, wind vests, pants, short pants, jerseys, shirts, T-shirts, gloves, mittens, headbands; headgear, namely caps; footwear, namely sports shoes, boots, sneakers, class 25</p>	<p><u>Technical apparel for maintaining physical shape, namely, trousers, sport suits, shorts; swimwear, bathing suits, bikinis, slips, swimsuit shorts, swimming caps; pareos, bras, ponchos; underwear, namely, body shapers, boxers, T-shirts, tank tops, bras, leotards, shorts, slips, thongs; leather wear and lounge wear, namely, leather hats and lounge pants; bathrobes, nightdresses, pajamas; pants, trousers, overalls, jeans, shorts, jackets, coats, waistcoats, overcoats, waterproof clothing, namely, jackets and pants; hosiery, knitwear, namely, sweaters, cardigans, fleece pullover tops, jumpers, woven shirts; dresses, track suits, shirts, polo shirts, nightshirts for men, T-shirts, undershirts, dresses, skirts, trousers, skirts, gowns; socks; dressing gowns; waist bands; balaclavas, scarves, silk scarves, neckwear, neckerchiefs, neck scarves, bandanas, roll necks, namely, neck gaiters; gloves and mittens, ski gloves; headwear, namely, hats, caps, bandanas, visors, wrist bands; belts and ties; shoes, sneakers, boots, sandals, slippers, sport and athletic shoes, studs for golf shoes or sport shoes, mountaineering shoes; ski boots and trekking boots, gaiters, bands for protecting face and ears from cold, class 25.</u></p>
<p>Registration No. 3,976,519</p> <p>Scuba masks and underwater sport goggles, safety goggles, safety helmets in class 9</p>	<p>n/a</p>
<p>Registration No. 3,976,519</p> <p>Paper and cardboard, stationery, note books, note pads, school diaries; soft and hard school supply pouches for holding pens and pencils among other articles; pencil sharpeners, drawing rulers, erasers, personal organizers, address books, folders in class 16</p>	<p>n/a</p>

ISPA argues that the goods of the opposed application are substantially the same as the registered goods. If that were the case, why would there be a need to file a new application or to file based on intent to use rather than use in commerce.

It should be apparent that the opposed application not only includes overlapping goods but also includes a wide variety of additional goods such as the technical apparel, the swimwear, the underwear, in class 25 and the trunks, the beach bags and other items in class 18, etc. The *Morehouse* defense is not applicable where the opposed application also includes goods which are different from those listed in the registration. *La Fara Importing Co. v. F. Lle de Cecco di Filippo Fara S. Martino S.p.A.*, 8 USPQ2d 1143, 1147 (TTAB 1988) (*Morehouse* defense inapplicable where “the identification of goods in the application at issue is not only for alimentary pastes [listed in the prior registration], but also includes a wide variety of additional items such as coffee, sugar, rice, cakes, and sauces, excluding cranberry sauce and applesauce.” *Accord DC Comics Inc. v. Scholastic Magazines, Inc.*, 210 USPQ 299, 301 (TTAB 1980) (*Morehouse* defense inapplicable where “the goods set forth in the involved applications cover goods such as educationally oriented magazines, records and tape cassettes, which are not encompassed by the listing of goods in the registration.”). Since the goods in the opposed application include goods that are clearly different from the goods listed in the prior registrations, the *Morehouse* defense is not available to ISPA.

ISPA has not raised the *Morehouse* defense to the class 35 services.

**Objection to facts stated in Declaration of Jeanne Hamburg
that is not supported by admissible evidence**

The declaration of Jeanne Hamburg in Support of ISPA's motion alleges a breach of a prior settlement agreement, in paragraphs 13 through 15 and Exhibits F (IWCOA's C.E.O. declaration explaining alleged breach) and G (copy of IWCOA's settlement check).

Objection is made to the introduction of these facts under the Federal Rules of Civil Procedure, Rule 56 (c)(2) for the reason that it is not supported by admissible evidence.

The Statements and Exhibits concern a compromise offer and negotiations wherein it was indicated that it was being made pursuant to Federal Rules of Evidence Rule 408, that resulted in the settlement.

The use of this evidence to prove the merit of ISPA's claim or for showing IWCOA's intent to breach the agreement, or for similar purposes, is inadmissible, should be stricken from the record, and should not be considered by this Board.

Additionally, the evidence is irrelevant since the offer was motivated more by a desire for peace rather than from any concession of weakness of position, or wrongdoing and was intended to expeditiously dispose of this de minimus issue.

CROSS-MOTION FOR SUMMARY JUDGEMENT
BASED ON LACK OF INTENT TO USE MARK
FOR ALL OF THE GOODS AND SERVICES
AT TIME OF FILING

Background

IWCOA's opposition to applications Ser. No. 86/301,552 and Ser. No. 79/146,181, filed under §44(e) and §66(a) respectively of the Trademark Act, was grounded, in part, on the lack of a bona fide intent to use the mark in commerce for all of the goods in classes 18 and 25 and services in class 35 at the time of filing the application.

ISPA, responded by motion to amend the goods in class 18 and 25 with the following: "...Applicant did have a good faith intent to use the mark for all the goods identified in Class 18 and Class 25. However, for purpose of streamlining this proceeding, and consistent with its changed plans, it has narrowed its identification in these classes to feature a smaller list of goods."

Further the response in the motion to amend the services in class 35 states: "...Applicant did have a good faith intent to use the mark for all the Class 35 services and is presently using the mark in Class 35 in the U.S. However, for purpose of streamlining this proceeding, and consistent with its changed plans, it has narrowed its Class 35 retail store services to feature a smaller list of goods."

The motions to amend the goods and services were obviously motivated in response to the challenge to the applications and is a tacit acknowledgment that there was no intent to use the mark, at least for the goods and services to be deleted from the applications.

**Lack of bona fide intent to use cannot be overcome
by mere assertions without corroboration**

ISPA has not produced any objective documentary evidence of intent to use the mark or a valid explanation as to why no such evidence has been produced. In *Honda Motor Co v. Winkelmann*, 90 USPQ 2d 1660 (TTAB 2009) wherein summary judgement was granted for lack of bona fide intent to use mark, the Board held that the absence of any documentary evidence regarding an applicant's bona fide intention to use a mark in commerce is sufficient to prove that an applicant lacks such intention as required by Section 1(b) of the Trademark Act, unless other facts are presented which adequately explain or outweigh applicant's failure to provide such documentary evidence. See *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ 2d 1503, 1507 (TTAB 1993). ISPA has not provided any documentary evidence or other satisfactory explanation. In *L.C. Licensing Inc. v. Berman*, 86 USPQ 2d 1883 (TTAB 2008) the Board sustained in part an opposition based on lack of bona fide intent to use upon applicant's failure to have documents to support intent to use mark when application was filed.

The mere assertion of an intent to use the mark is not credible evidence to establish a bona fide intention to use the mark and the Board should thus sustain both oppositions.

Conclusion

ISPA's motion for summary judgement should be denied and IWCOA's cross-motion for summary judgement should be granted.

Dated: New York, New York
June 15, 2016

Respectfully submitted,

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CERTIFICATE OF SERVICE

This will certify that on the 15th day of June, 2016 a true and correct copy of **BRIEF IN OPPOSITION TO APPLICANT'S MOTION FOR SUMMARY JUDGEMENT AND IN SUPPORT OF OPPOSER'S CROSS-MOTION FOR SUMMARY JUDGEMENT** was mailed, first class, postage prepaid to attorneys for Applicant as follows:

Jeanne Hamburg, Esq.
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/Howard Natter/

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