

ESTTA Tracking number: **ESTTA719640**

Filing date: **01/11/2016**

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.
Correspondence Address	HOWARD NATTER NATTER & NATTER 501 5TH AVE, SUITE 808 NEW YORK, NY 10017 UNITED STATES hnatter@natterip.com
Submission	Opposition/Response to Motion
Filer's Name	Howard Natter
Filer's e-mail	hnatter@natterip.com
Signature	/Howard Natter/
Date	01/11/2016
Attachments	Opposer's Brief in Opposition to Applicant's Motion to Amend Services - 011116.pdf(18004 bytes)

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

-----X
INVICTA WATCH COMPANY OF AMERICA, INC.,

Opposer,

Opposition No. 91222434

v.

Serial No. 79146181

INVICTA S.p.A.

Applicant.

-----X

**OPPOSER’S BRIEF IN OPPOSITION TO
APPLICANT’S MOTIONS TO AMEND THE SERVICES,
TO AMEND THE ANSWER AND TO CONSOLIDATE**

Opposer, Invicta Watch Company of America, Inc. (“Opposer”) by its attorneys, Natter & Natter, hereby responds to Applicant’s motion to amend services and concurrently filed motions to amend the answer and to consolidate this opposition with another pending opposition.

Background

Applicant, an Italian company, and holder of international registration (I.R. No. 1201001) filed the opposed application (request) for extension of protection to the U.S. pursuant to Section 66(a) of the Trademark Act for the mark INVICTA in Class 35. Section 66(a) requires that the request include a declaration of bona fide intention to use the mark in commerce that can be controlled by the United States Congress.

In the notice of opposition it was alleged, in Paragraph “9” that “Applicant has not used the mark INVICTA for services in Class 35 in commerce controlled by U.S. Congress and does not have a good faith intention to use the mark in commerce”. The Answer admitted that Applicant has not yet used the mark INVICTA for services in Class 35 but denies that it does not have a good faith intention-to-use the mark. Applicant has concurrently moved to amend its answer so as to now deny all of the allegations in paragraph “9” and to consolidate this opposition with another pending opposition between the same parties.

**Reasons why the motion to amend the services
should be denied**

A primary issue alleged in this opposition is that Applicant did not have a bona fide intent-to-use the mark in commerce for all services at the time the Section 66(a) request was filed. Applicant did not attempt to amend the services prior to registration at the International Bureau or attempt to amend the International Bureau registration prior to filing its request for extension of protection under Section 66 (a). Applicant cannot now amend to delete services for which Applicant had no intention of using the mark. Such amendment constitutes a material change in substance that would be prejudicial to Opposer.

Reasons why the motion to amend the answer should be denied

Applicant seeks to amend its answer to paragraph “9” of the notice of opposition. The answer filed on September 25, 2015 is in the form of direct, positive, and affirmative statement, namely, that “...(a)pplicant has not yet used the mark INVICTA for services in Class 35 in commerce controlled by U.S. Congress...”.

The reason given for the amended answer was that “(t)hrough inadvertence, mistake, or oversight, Applicant incorrectly partially admitted the allegations contained in this paragraph that it has not yet used the mark in the United States”. Applicant should not be permitted to retract its answer without a full and substantive explanation. Furthermore, Applicant should have uncovered this “error” prior to this late date and amended its answer.

The motion to amend the answer should therefore be denied.

Reason why the motion to consolidate should be denied

With regard to consolidation, the respective oppositions present different issues and do not involve a common question of law or fact.

Applicant’s lack of intent to use mark has been challenged in both of these oppositions, but under the different statutory provisions that constitute separate issues.

Opposition No. 91224325 concerns an intent-to-use-application filed under Sect. 44(e) of the Trademark Act for goods in Classes 18 and 25. Opposer does not have registrations of its mark in either of these classes. The grounds of opposition include dilution as a result of the fame of Opposer’s mark.

Opposition No. 91222434 involves a request for extension of protection to the US of an international registration under Section 66(a) for services in class 35. Opposer has pleaded the registration of its mark in class 35 among other registrations in support of likelihood of confusion. The facts and issues do not warrant consolidation and the motion should be denied.

Conclusion

In view of the foregoing, Applicant's motions should be denied.

Dated: New York, New York
January 11, 2016

Respectfully submitted,

NATTER & NATTER
Attorneys for Opposer
501 Fifth Avenue, Suite 808
New York, NY 10017
(212) 840-8300

By /Howard Natter/
Howard Natter

CERTIFICATE OF SERVICE

This will certify that on the 11th day of January, 2016 a true and correct copy of **OPPOSER'S BRIEF IN OPPOSITION TO APPLICANT'S MOTIONS TO AMEND THE SERVICES, TO AMEND THE ANSWER AND TO CONSOLIDATE** was mailed, first class, postage prepaid to attorneys for Applicant as follows:

Bruce S. Londa, Esq.
Norris McLaughlin & Marcus PA
875 Third Avenue
New York, NY 10022.

/Howard Natter/
Howard Natter