

ESTTA Tracking number: **ESTTA1063439**

Filing date: **06/22/2020**

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

Proceeding	91256394
Party	Defendant Continental Properties Company, Inc.
Correspondence Address	DANIEL E. KATTMAN REINHART BOERNER VAN DEUREN S.C. 1000 N. WATER STREET MILWAUKEE, WI 53202 UNITED STATES tmadmin@reinhardt.com no phone number provided
Submission	Answer
Filer's Name	Daniel E. Kattman
Filer's email	tmadmin@reinhardt.com
Signature	/dek/
Date	06/22/2020
Attachments	Answer to Notice of Opposition AUTHENTIX.pdf(18189 bytes)

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

AUTHENTIX, INC.

Opposer,

vs.

Opposition No. 91256394
Serial No. 88/639,661

CONTINENTAL PROPERTIES
COMPANY, INC.

Applicant.

APPLICANT'S ANSWER TO NOTICE OF OPPOSITION

Applicant, Continental Properties Company, Inc. ("Applicant"), by its attorneys, hereby answers the allegations set forth in the Opposer's Notice of Opposition as follows:

1. Opposer has for many years used and promoted a wide range of products and services, including business management and consulting services and advanced authentication solutions under the AUTHENTIX trademark and service marks (the "AUTHENTIX Marks"). Opposer's use of its AUTHENTIX Marks has been continuous and extensive.

ANSWER: Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations and conclusions of law contained in Paragraph 1 of the Notice of Opposition and, therefore, denies the same.

2. Opposer's AUTHENTIX Marks are inherently distinctive. Additionally, as a result of Opposer's use and promotion of its AUTHENTIX Marks, they have become

widely recognized by consumers. Since at least as early as 2003, Opposer has invested significant effort and resources in advertising and promoting its AUTHENTIX Marks and the goods and services sold under the marks, with the result that the purchasing public has come to know, rely on, and recognize the goods and services of Opposer by its marks, which have become well known. Opposer has established significant goodwill in its AUTHENTIX Marks.

ANSWER: Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations and conclusions of law contained in Paragraph 2 of the Notice of Opposition and, therefore, denies the same.

3. In addition to its extensive common law rights, Opposer owns numerous U.S. trademark registrations, including:

Mark/Applic. No./ Reg. No.	Status Date	Services (summary)
AUTHENTIX 77/223,598 3,796,039 (the “039 Registration”)	Renewal declaration filed March 19, 2020	Class 35: business consulting related to the enforcement of intellectual property rights; business consulting services in the field of managing intellectual properties; business risk management, namely, risk analysis of product supply chains, namely, raw material, and distributor and supply chains... Class 42: data automation and collection services using proprietary software to evaluate, analyze and collect service data; data automation and collection services, namely, analysis of revenue loss from counterfeiting, diversion and product tampering; product quality control sampling... Class 45: for private investigation services, namely, compiling chain of custody evidence for purposes of anticounterfeiting, anti-diversion, anti-product tampering actions... First use: at least as early as January 31, 2004

The “039 Registration is valid and subsisting and is incontestable pursuant to 15 U.S.C. § 1065. Attached as **Exhibit A** is a true and correct copy of Opposer’s ‘039 Registration and the associated TSDR record.

ANSWER: Applicant admits that U.S. Registration No. 3,796,039 identifies Opposer as the owner of such registration, but Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations and conclusions of law contained in Paragraph 3 and, therefore, denies the same.

4. Opposer also owns:

Mark/Applic. No./ Reg. No.	Status Date	Services (summary)
AUTHENTIX 78/327,628 3,159,814 (the “814 Registration”)	Renewed April 2, 2016	Business investigation and consultation, namely providing investigation and consultation regarding analysis, field sampling, tag development and investigation services to others First use: at least as early as January 5, 2004

The “814 Registration is valid and subsisting and is incontestable pursuant to 15 U.S.C. § 1065. Attached as **Exhibit B** is a true and correct copy of Opposer’s ‘814 Registration and the associated TSDR record.

ANSWER: Applicant admits that U.S. Registration No. 3,159,814 identifies Opposer as the owner of such registration, but Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations and conclusions of law contained in Paragraph 3 and, therefore, denies the same.

5. Upon information and belief, Continental Properties Company, Inc. (“Applicant”) is a Wisconsin corporation with a principal address at W134N8675 Executive Parkway, Menomonee Falls, Wisconsin 53051. On October 2, 2019,

Applicant filed U.S. Trademark Application Serial No. 88/639,661 (the "Application"), an intent to use application, for AUTHENTIX for "real estate services, namely, property management services for apartment buildings" in Class 36.

ANSWER: Admitted.

6. Applicant has not filed an amendment to allege use of the mark.

ANSWER: Admitted.

7. There is no issue as to Opposer's priority. Opposer's AUTHENTIX Marks have priority over Applicant's proposed mark because Opposer's dates of use and registration predate the Applicant's filing date or any other date on which the Applicant may rely for purposes of priority.

ANSWER: Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations and conclusions of law contained in Paragraph 7 of the Notice of Opposition and, therefore, denies the same.

8. Applicant's proposed mark AUTHENTIX is identical to Opposer's AUTHENTIX Marks.

ANSWER: Admitted.

9. The services covered by Applicant's Application are highly related to the services for which Opposer has used and registered its AUTHENTIX Marks. Opposer offers a wide range of services under its AUTHENTIX Marks, including business consulting and management services, while Applicant offers real estate management services.

ANSWER: Denied.

10. The proposed mark is barred from registration because it consists of or comprises a mark which is identical to Opposer's previously used and registered AUTHENTIX Marks, and is likely, when used in connection with the intended services of Applicant, to cause confusion, mistake, or deception within the meaning of 15 U.S.C. § 1052(d). Purchasers and prospective purchasers are likely to believe that the services that Applicant intends to offer under AUTHENTIX are sponsored, endorsed, or approved by Opposer, or are in some way affiliated, connected, or associated with Opposer or its goods and services. Registration of AUTHENTIX by Applicant would damage Opposer because purchasers would likely attribute source or sponsorship of Applicant's services under that mark to Opposer.

ANSWER: Denied.

11. In addition, registration of AUTHENTIX by Applicant would damage Opposer because it would confer upon Applicant statutory presumptions to which it is not entitled in view of Opposer's prior use and registration of its AUTHENTIX Marks.

ANSWER: Denied.

12. The services covered by the Application do not feature any restrictions or limitations as to channels of trade, and therefore Applicant's services are, or will, travel in the same or similar channels of trade as Opposer's goods and services

ANSWER: Denied.

13. Opposer has not given Applicant permission or approval to use or register AUTHENTIX.

ANSWER: Admitted.

Applicant respectfully requests that this Opposition proceeding be dismissed with prejudice without further delay.

Respectfully submitted,

/dek/

Daniel E. Kattman
Attorney for Applicant

Dated: June 22, 2020

Daniel E. Kattman
Reinhart Boerner Van Deuren s.c.
1000 North Water Street, Suite 2100
Milwaukee, WI 53202

