

ESTTA Tracking number: **ESTTA34987**

Filing date: **06/06/2005**

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

Proceeding	92044455
Party	Defendant Von Schrader Company Von Schrader Company 1600 Junction Avenue Racine, WI 53403
Correspondence Address	Von Schrader Company 1600 Junction Avenue Racine, WI 53403
Submission	Answer and Counterclaim
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Date	06/06/2005
Attachments	2005-06-06 ans - ad and cc.pdf (6 pages)

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

In the Matter of Trademark Registration No. 2,344,023

For: ESPRIT

Registered: April 18, 2000

ESPRIT IP LIMITED,)
Petitioner,)
)
v.) Cancellation No. 92044455
)
VON SCHRADER COMPANY)
Registrant.)

REGISTRANT'S ANSWER TO PETITION TO CANCEL

Registrant, VON SCHRADER COMPANY ("Von Schrader"), hereby responds to the Cancellation filed by Petitioner, ESPRIT IP LIMITED, as follows:

1. Registrant is without sufficient knowledge or information to admit or deny Petitioner's allegations of Paragraph 1 and therefore denies same.
2. Registrant is without sufficient knowledge or information to admit or deny Petitioner's allegations of Paragraph 2 and therefore denies same.
3. Registrant is without sufficient knowledge or information to admit or deny the allegations of Paragraph 3 and therefore denies same.
4. Petitioner is without sufficient knowledge or information to admit or deny the allegations of Paragraph 4 and therefore denies same.
5. Registrant denies that any ESPRIT marks allegedly owned by Petitioner are famous or distinctive. Registrant is without sufficient knowledge or information to admit or deny the remaining allegations of Paragraph 5 and therefore denies same.

6. Registrant fails to understand what constitutes a “lifestyle brand” and therefore lacks sufficient information to admit or deny said allegation and therefore denies the same. Registrant is without sufficient knowledge or information to admit or deny the remaining allegations of Paragraph 6 and therefore denies the same.
7. Registrant admits that Registrant is a limited liability partnership and denies the remainder of the allegations of Paragraph 7.
8. Registrant denies that Petitioner’s alleged ESPRIT mark or marks are famous. Registrant lacks sufficient information to admit or deny the remaining allegations and therefore denies same.
9. Registrant admits it had constructive notice of ESPRIT mark registrations, which registrations were in existence prior to Registrant’s application for registration, but lacks sufficient information to admit or deny whether Petitioner had any rights to any of the marks as alleged by Petitioner and therefore denies same. Registrant denies the remaining allegations of Paragraph 9.
10. Registrant admits that Registrant’s ESPRIT mark has a similar sound to the word marks in Petitioner’s paragraph 3, but maintains its position that Registrant lacks sufficient information to admit or deny whether Petition owns all of the registrations listed in Petitioner’s paragraph 3. Registrant lacks sufficient information to admit or deny whether Petitioner has any “prior-used ESPRIT marks”, and therefore denies same. Registrant denies that its ESPRIT mark is identical and/or confusingly similar to any mark allegedly used or owned by Petitioner. Registrant denies that Registrant’s ESPRIT mark has a similar connotation, appearance and/or commercial impression to any mark

- allegedly used or owned by Petitioner. Registrant denies all remaining allegations of Paragraph 10.
11. Registrant denies each and every allegation, whether expressed or implied, of Paragraph 11.
 12. Registrant realleges its answers to Paragraphs 1-11 as if fully stated herein.
 13. Registrant lacks sufficient information to admit or deny the allegations of Paragraph 13 and therefore denies same.
 14. Registrant denies each allegation of Paragraph 14, whether expressed or implied.
 15. Registrant fails to understand what constitutes a “lifestyle brand” and therefore lacks sufficient information to admit or deny said allegation and therefore denies the same. Registrant denies each and every allegation of Paragraph 15, whether expressed or implied.
 16. Registrant denies each and every allegation of Paragraph 16.
 17. Registrant realleges its answers to Paragraphs 1-16 as if fully stated herein.
 18. Registrant denies the allegations of Paragraph 18, whether expressed or implied.
 19. Registrant denies the allegations of Paragraph 19, whether expressed or implied.
 20. Registrant denies allegations of Paragraph 20, whether expressed or implied.
 21. Registrant denies allegations of Paragraph 21, whether expressed or implied.

AFFIRMATIVE DEFENSES

As and for affirmative defenses, Registrant alleges that:

FIRST AFFIRMATIVE DEFENSE

22. Petitioner's petition is barred by the statute of limitations. The TTAB lacks jurisdiction to hear the petition in this matter.

SECOND AFFIRMATIVE DEFENSE

23. Registrant affirmatively alleges that it is entitled to the equitable defense of laches. Petitioner has unreasonably delayed in asserting or enforcing its rights, if any, against Registrant, and Registrant has relied on this delay to its detriment. Registrant will be prejudiced if Petitioner is now permitted to assert or enforce its rights, if any.

THIRD AFFIRMATIVE DEFENSE

24. Registrant affirmatively alleges that it is entitled to the equitable defense of estoppel. Petitioner has unreasonably delayed in asserting or enforcing its rights, if any, against Registrant, and Registrant has relied on this delay to its detriment. Petitioner should be estopped from challenging Registrant's use of Registrant's registered ESPRIT trademark.

FOURTH AFFIRMATIVE DEFENSE

25. Registrant affirmatively alleges that it is entitled to the equitable defenses of acquiescence and waiver. Petitioner has unreasonably delayed in asserting or enforcing its rights, if any, against Registrant, and Registrant has relied on this delay to its detriment. Petitioner's conduct amounts to an expressed or implied consent and has encouraged Registrant's belief that its use of Registrant's registered ESPRIT trademark would not be challenged.

FIFTH AFFIRMATIVE DEFENSE

26. Registrant affirmatively alleges that it is entitled to the equitable defense of unclean hands. Petitioner should be barred from the relief it seeks.

SIXTH AFFIRMATIVE DEFENSE

27. Petitioner fails to own some or all of the registrations Petitioner has alleged in its petition, having either never acquired said rights or, in the alternative, lost such rights through abandonment or other actions of law.

SEVENTH AFFIRMATIVE DEFENSE

28. Registrant asserts that its registered ESPRIT trademark is not likely to cause confusion or mistake with any of Petitioner's purported marks.

EIGHTH AFFIRMATIVE DEFENSE

29. Registrant asserts that its registered ESPRIT trademark does not dilute any mark allegedly owned by Petitioner.

NINTH AFFIRMATIVE DEFENSE

30. Registrant asserts that its registered ESPRIT trademark does not infringe or dilute any alleged rights putatively owned by Petitioner in any of the alleged Registration Nos.: 1,351,743; 1,401,275; 1,419,245; 1,485,327; 1,532,974; 1,673,462; and 1,898,850.

COUNTERCLAIM

31. In Paragraph 3 of Petitioner's petition, Petitioner alleges ownership of twenty (20) listed registrations.

32. On information and belief, the owner of Registration Nos.: 1,056,960; 1,080,349; 1,340,608; 1,342,393; 1,496,788; and 1,898,850 has abandoned such marks.

33. Said abandoned marks, if they are owned by Petitioner, should be cancelled.

WHEREFORE, Registrant requests that Petitioner's petition to cancel be denied in its entirety. Registrant further requests that the Trademark Trial and Appeal Board grant Registrant's counterclaim in the event it is ascertained that Petitioner owns title to the purported registrations.

Please debit or credit account #10-0270 for the counterclaim filing fee in this matter.

Respectfully submitted,
VON SCHRADER COMPANY

By s/Edward R. Antaramian
Edward R. Antaramian (WI Bar #1019160)

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing REGISTRANT'S ANSWER TO PETITION TO CANCEL has been served on counsel for Petitioner by First Class Mail, postage prepaid, this 6th day of June, 2005, addressed as follows:

Lisa Pearson
Evan Gourvitz
FROSS ZELNICK LEHRMAN & ZISSU, P.C.
866 United Nations Plaza
New York, New York 10017

By s/Dawn MacDonald-Wolff