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

Proceeding	92069219
Party	Defendant Allbirds, Inc.
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Date	05/28/2019
Attachments	May 28 2019 - Answer to Petition to Cancel - WOOL RUNNERS.pdf(618950 bytes)

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

In the matter of Registration No. 5,149,527
For the Trademark WOOL RUNNERS
Registered on Feb. 28, 2017

GIESSWEIN WALKWAREN AG,)	
)	
Petitioner,)	
)	
v.)	Cancellation. No. 92069219
)	
ALLBIRDS, INC.,)	
)	
Respondent.)	
)	
_____)	

RESPONDENT ALLBIRDS, INC.’S ANSWER TO PETITION FOR CANCELLATION

In response to the Petition for Cancellation filed by Giesswein Walkwaren AG (“Petitioner”) regarding U.S. Reg. No. 5,149,527 for the WOOL RUNNERS trademark registered and used by Respondent Allbirds, Inc. (“Allbirds”), Allbirds hereby answers as set forth below. Unless specifically admitted, Allbirds denies each of the allegations in the Petition for Cancellation.

1. Allbirds admits that Petitioner is engaged in the sales of footwear. Allbirds lacks information and knowledge sufficient to form a belief as to the meaning of Petitioner’s “interest” as set forth in Paragraph 1 and on that basis denies such allegations. Except as expressly admitted, Allbirds denies the allegations in Paragraph 1.

2. Allbirds admits that the U.S. Patent and Trademark Office’s (“USPTO”) Trademark Status & Document Retrieval (“TSDR”) records currently identify Petitioner as the

registrant of U.S. Registration No. 5,326,486, and that no further response is necessary because the TSDR record speaks for itself.

3. Allbirds admits that Allbirds registered the WOOL RUNNERS mark in connection with the goods identified in the registration issued to Allbirds, which speaks for itself. Allbirds further admits that the TSDR records of the USPTO reflect that Allbirds included a disclaimer for the term “WOOL” apart from the mark as shown.

4. Allbirds denies the allegations in Paragraph 4.

5. Allbirds admits that the TSDR records of the USPTO reflect that Allbirds included a disclaimer for the term “WOOL” in the registration issued to Allbirds for the mark WOOL RUNNERS. Allbirds denies the remaining allegations in Paragraph 5.

6. Allbirds denies the allegations in Paragraph 6.

7. Allbirds denies the allegations in Paragraph 7.

8. Allbirds denies the allegations in Paragraph 8.

AFFIRMATIVE DEFENSES

In addition to the Answer set forth above, Allbirds asserts the following affirmative defenses, without assuming the burden of proof on such defenses that would otherwise fall on Petitioner.

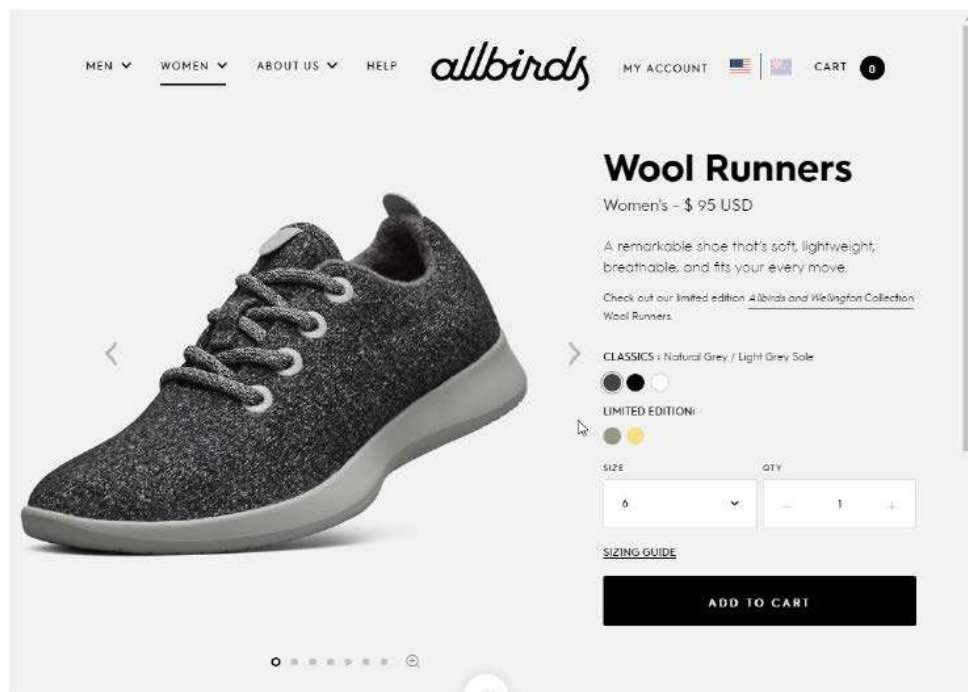
FACTUAL BACKGROUND

1. Allbirds re-alleges and incorporates herein the Factual Background from its MOTION FOR RELIEF FROM JUDGMENT UNDER FED. R. CIV. P. 60(B) filed on December 21, 2018 as if duly set forth here.

2. As stated in its WOOL RUNNERS US Registration No. 5149527, Allbirds has used

its WOOL RUNNERS mark in connection with footwear in U.S. commerce since at least as early as February 29, 2016.

3. On March 9, 2017, Allbirds sent a cease and desist letter to Petitioner's counsel regarding Petitioner's use of MERINO RUNNERS and OUTDOOR RUNNERS in connection with wool sneakers. The letter also objected to Petitioner's advertisement, then available at <https://www.youtube.com/watch?v=IQWycxq0CYo>, where Petitioner's designers inaccurately claimed to have invented the wool sneaker. Allbirds also objected to the many similarities with Allbirds' own wool sneaker, including having similar wool upper and sole color combinations, having a replaceable insole made of castor beans, a thick but lightweight sole, and a wool body that regulates temperature and allows the shoe to be worn without socks. Screenshots from <https://www.giesswein.com/us/merino-runners> and <https://www.allbirds.com/>, which were included in the March 9, 2017 letter are shown here below:





WOMEN ▢ MEN ▢ KIDS ▢ HOME COLLECTION ▢

WORLD OF GIESSWEIN

NATURAL | LIGHT | COMFORT
GIESSWEIN Merino Runners

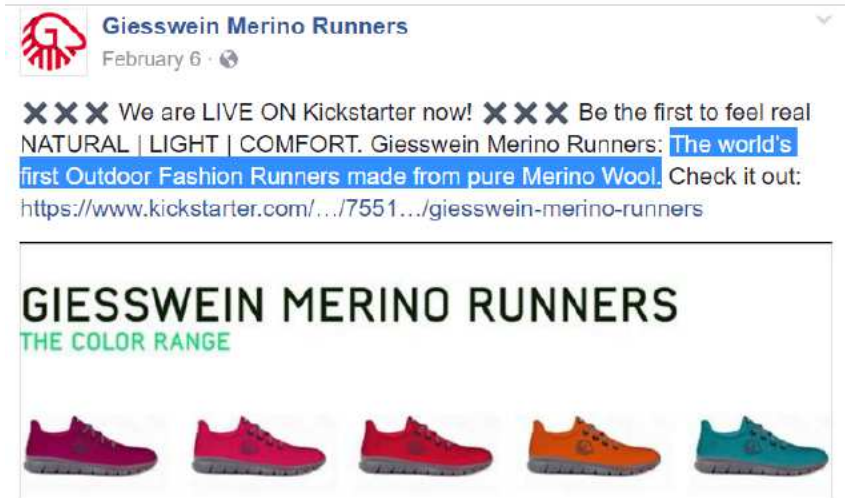
Introducing the World's first Fashion Outdoor Runners made from pure Merino Wool.

✓ No Sweat. No Smell. ✓ Super comfortable Merino Wool. ✓ Temperatureregulating

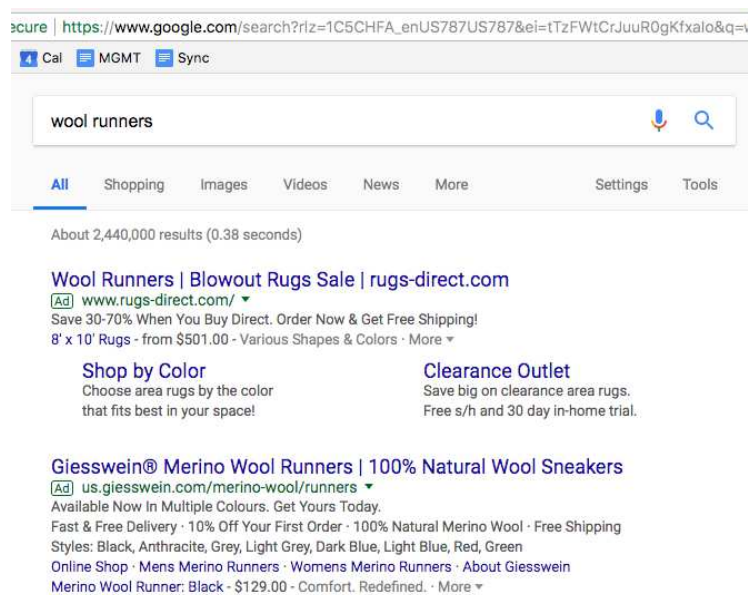


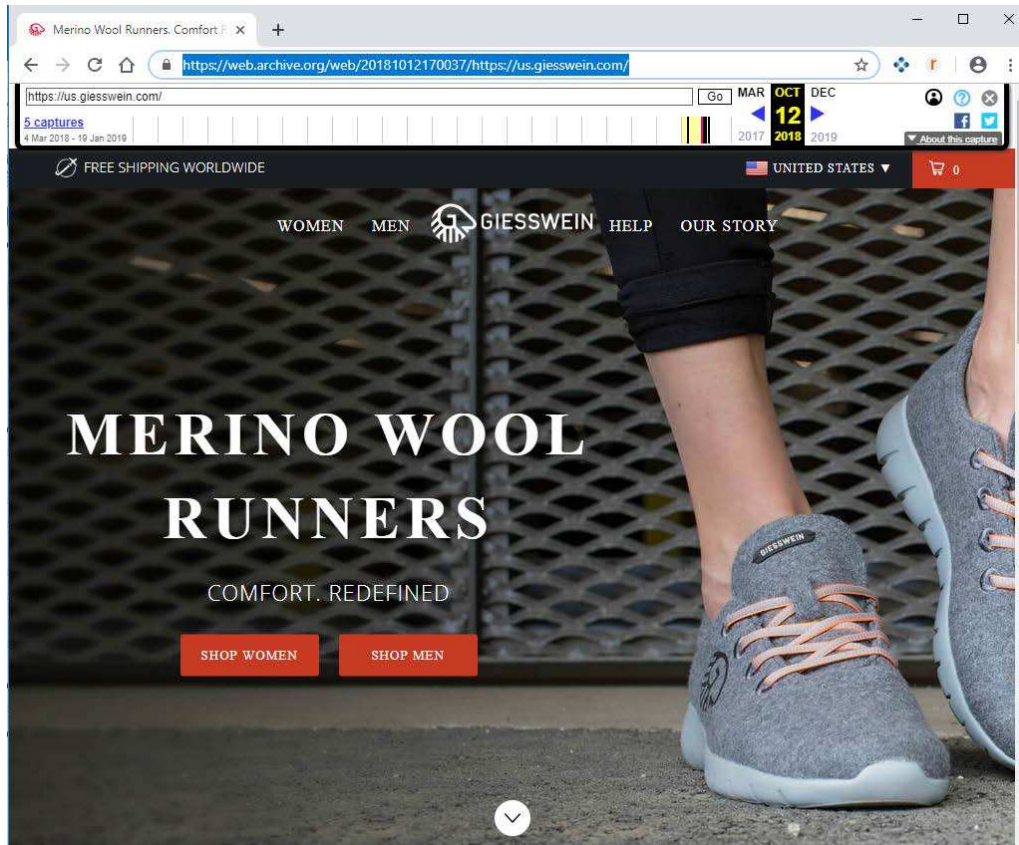
4. Petitioner's counsel replied on March 20, 2017 and defended Petitioner's advertisements, sneaker similarities, and use of MERINO RUNNERS, OUTDOOR RUNNERS and its advertisements.

5. On May 10, 2017, Allbirds sent a second letter to Petitioner's counsel regarding the use of MERINO RUNNERS and advertisements that inaccurately claimed that Petitioner was the first to create a wool sneaker. A snapshot of the relevant advertisement, which was included in the May 10, 2017 letter and was available at <https://www.facebook.com/merinorunners>, is shown here below:

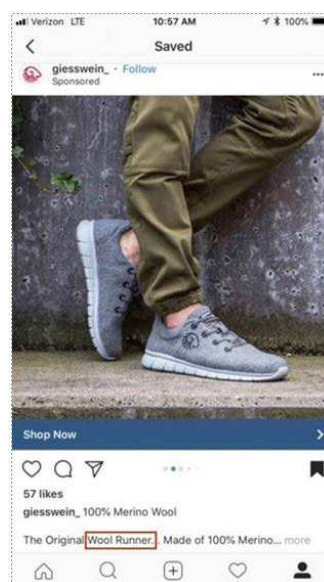


6. After Allbirds sent its March 9, 2017 and May 10, 2017 letters to Petitioner regarding its use of MERINO RUNNERS and OUTDOOR RUNNERS and making Petitioner aware of Allbirds' federally registered rights to the WOOL RUNNERS mark, Petitioner began consistent use of WOOL RUNNERS on its social media platforms, Google® Ads and website. Below is a screenshot of Petitioner's Google ® Ad from April 5, 2018 and a screenshot of Petitioner's archived website from October 12, 2018, available at <https://web.archive.org/web/20181012170037/https://us.giesswein.com/>:






7. From May 10, 2017 onward, Allbirds took steps to enforce its WOOL RUNNERS mark, including reporting Petitioner's use of Allbirds' WOOL RUNNERS mark on social media platforms such as Instagram, as shown in the June 20, 2018 screenshot below:



8. As noted in the Board’s MOTION FOR RELIEF FROM JUDGMENT GRANTED, despite having been in communication with Petitioner about the use of MERINO RUNNERS and having taken enforcement actions against use of MERINO RUNNERS and WOOL RUNNERS, Petitioner did not send a courtesy copy to Allbirds of either the petition to cancel filed on August 10, 2018 against Allbirds’ WOOL RUNNERS registration or the notice of default issued on October 4, 2018.

9. Petitioner, in its OPPOSITION TO MOTION FOR RELIEF FROM JUDGMENT, stated that it has used terms such as “merino runners” and “wool runners” to describe its footwear made from merino wool for a significant period of time, including following the Board’s entry of default judgment on October 4, 2018. Allbirds confirms that even after Allbirds filed its MOTION FOR RELIEF FROM ENTRY OF DEFAULT JUDGMENT on December 21, 2018 and its REPLY TO THE PETITIONER’S OPPOSITION TO MOTION FOR RELIEF FROM JUDGMENT on January 22, 2019, Petitioner continued to use Allbirds’ WOOL RUNNERS mark, as shown by the following Google® Ads screenshots from February 8, 2019, and continues to use MERINO WOOL RUNNERS on its website, as shown on the below screenshot from May 28, 2019.

Giesswein® Merino Wool Runner | The New Sneaker Innovation

 us.giesswein.com/merino-runners

★★★★★ Rating for giesswein.com: 4.6 - 443 reviews

100% Merino **Wool**, Super Comfortable, Hyper Lightweight & Temperature Regulating. Enjoy 10% Off...

Womens Merino Runners

Temperature Regulating. Odour Free.

Antibacterial. 3D Stretch Tech.

3D Stretch Merino Wool

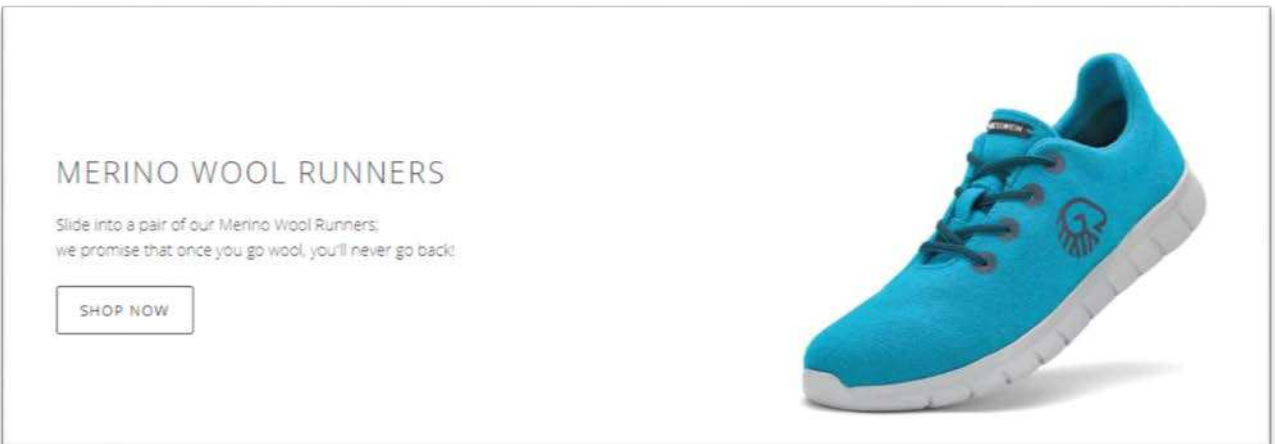
Our Ultimate Knitted Superfabric.

Maximum Comfort.

Merino Wool Runners | Women's Wool Sneakers - | Giesswein ...

<https://us.giesswein.com/products/womens-merino-wool-runners>

Made of 100% Merino **Wool** and featuring a unique 3D Stretch technology, the women's **Giesswein Runners** are hyper lightweight, super comfy and incredibly flexible. The natural properties of merino **wool** ensure your feet are warm in Winter, and cool in Summer, providing perfect ...



FIRST AFFIRMATIVE DEFENSE

(Failure to State a Claim)

1. Petitioner has failed to state a claim upon which relief can be granted.

SECOND AFFIRMATIVE DEFENSE

(Lack of Standing)

1. Petitioner lacks standing to seek cancellation of registration of the WOOL RUNNERS mark in that Petitioner is not likely to be damaged by the continued registration of the Mark.

THIRD AFFIRMATIVE DEFENSE

(Unclean Hands)

1. The unclean hands doctrine is a vehicle for affirmatively enforcing the requirements of conscience and good faith which closes the doors of a court of equity to one tainted with inequity or bad faith relative to the matter in which he seeks relief.

2. Petitioner should not obtain a cancellation of the WOOL RUNNERS mark because it has continued to use and leverage Allbirds' registered mark in order to confuse, attract and mislead consumers. Petitioner has committed inequitable conduct and conduct in bad faith regarding the trademark at issue in this case.

Dated: May 28, 2019

COOLEY LLP

BY: *Ariana G. Hiscott*

Anne. H. Peck, Esq.
Ariana G. Hiscott, Esq.
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Washington, DC 20005
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CERTIFICATE OF TRANSMITTAL

I hereby certify that this **REGISTRANT'S ANSWER AND AFFIRMATIVE DEFENSES** is being electronically transmitted in PDF format to the Trademark Trial and Appeal Board through the Electronic System for Trademark Trials and Appeals (ESTTA) on the date indicated below and a copy is being sent to Petitioner's Counsel via electronic correspondence to the following addresses: pb@pattishall.com, sia@pattishall.com, kab@pattishall.com, jin@pattishall.com, lrb@pattishall.com, lkn@pattishall.com and via U.S. first class mail to the following address:

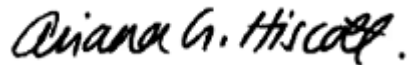
Seth I. Appel, Esq.

Pattishall McAuliffe Newbury Hilliard & Geraldson LLP

200 South Wacker Dr , Ste 2900

Chicago, IL 60606

Date: May 28, 2019



Ariana G. Hiscott