Michael Julius Anton (“Applicant”) answers Jesus Jeans S.R.L.’s (“Opposer”) Notice of Opposition as follows:

1. Applicant admits that Opposer owns U.S. Trademark Registration No. 3,232,057 for JESUS in connection with “Articles for clothing and sportswear, namely, jackets, vests, shirts, T-shirts, pants, skirts, shorts, and belts” in International Class 25. Except as admitted therein, the remaining allegations of paragraph 1 are denied.

2. The allegations of paragraph 2 are admitted.

3. The allegations of paragraph 3 are denied.

4. Opposer cites U.S. trademark applications the records of which are the best evidence of their content; therefore, reference is hereby made to the same. Except as admitted, denied.
FIRST AFFIRMATIVE DEFENSE

Estoppel

5. During prosecution of its JESUS trademark application before the United States Patent and Trademark Office (“USPTO”) Opposer argued that its application should be allowed to proceed over a likelihood of confusion rejection because the name “Jesus” is “highly diluted” in International Class 25.

6. In support of its dilution argument for registration Opposer cited thirty-five issued registrations for marks in International Class 25 containing the name “Jesus” or its phonetic equivalent.

7. Opposer relied on those thirty-five previous registrations to argue that “its JESUS mark is a satisfactory addition to the already robust field of JESUS marks already peacefully coexisting in the clothing field.”

8. Opposer represented to the USPTO that consumers “will distinguish between [Opposer’s JESUS mark and the other registered JESUS composite marks] easily.”

9. Opposer’s trademark application was allowed to proceed to registration.

10. In direct contradiction of its previous position before the USPTO, Opposer now asserts that Applicant’s JESUS SURFED, a composite JESUS mark, should be denied registration because of likelihood of confusion with Applicant’s JESUS registration in International Class 25.

11. Based on the equitable doctrine of estoppel, Opposer is barred from taking this contradictory, inconsistent position.

COUNTERCLAIM TO CANCEL OPPOSER’S REGISTRATION NO. 3,232,057

BACKGROUND

The grounds for cancellation of Opposer’s JESUS mark are as follows:
12. The name “Jesus” in Opposer’s mark refers to Jesus Christ, the founder of Christianity who is worshiped as God incarnate by more than 2 billion people in the world, including millions of Americans.

13. Opposer markets jeans using its JESUS mark under the brand name JESUS JEANS.

14. For many years Opposer and its predecessors-in-interest have tried to link its jeans with Jesus Christ in the minds of consumers through prominent display of the JESUS mark and use of advertising slogans which deliberately seek to play off text from the Old and New Testaments in an irreverent, sacrilegious manner.

15. Opposer’s tagline “freedom inside” for its JESUS JEANS brand is a sacrilegious attempt to compare the freedom a wearer of JESUS JEANS experiences to the freedom Jesus Christ promises in John 8:32 to those who place their trust in the Christian Gospel.

16. Opposer uses its JESUS mark in the marketplace in connection with sexually suggestive advertising. Upon information and belief, Opposer is the source of English language advertisements for JESUS JEANS published on the internet that feature sexually suggestive images adorned with parodied text from the Old and New Testaments as follows:
17. Opposer’s use of the phrase “Thou shalt not have any other jeans but me” in its sexually suggestive advertisement is an irreverent, sacrilegious attempt at word play on the King James Version’s rendering of the First Commandment (Exodus 20:30): “Thou shalt have no other gods before me.” The First Commandment is revered by billions of Christians, Jews, and Muslims.

18. Opposer’s use of the slogan “He who loves me follows me” is an irreverent, sacrilegious attempt at word play on Jesus Christ’s teaching in John 14:15 (NIV): “If you love me, keep my commands.”

19. Opposer’s parodic use of text from the Holy Bible to promote JESUS JEANS with sexual innuendo and images of scantily-clad women violates Jesus Christ’s call for sexual purity expressed in Matthew 5:27-28 (NIV): “You have heard that it was said, ‘You shall not commit adultery.’ But I tell you that anyone who looks at a woman lustfully has already committed adultery with her in his heart.”

20. Opposer’s predecessor-in-interest published sexually suggestive advertisements featuring the JESUS JEANS brand name in Italy and Europe. Those advertisements were condemned by the Roman Catholic Church.

21. Opposer has praised “the creative-thinking of the youngsters Maurizio Vitale and Oliviero Toscani,” the pair responsible for JESUS JEANS and those advertisements. In an explicit acknowledgement that it stands in this sacrilegious, prurient tradition, Opposer has noted that JESUS JEANS have “always been accompanied by campaigns as much creative as irreverent.”

22. Despite objections from Christians, Opposer has continued to distribute sexually suggestive JESUS JEANS advertisements.
23. Opposer has been refused registration for its JESUS mark in the United Kingdom, Ireland, Australia and other nations around the world on the grounds that its mark is offensive.

24. Opposer’s parent company BasicNet S.p.A. (“BasicNet”) is a publicly traded company headquartered in Turin, Italy. In 2012, BasicNet made €434 million in gross sales. BasicNet’s current market capitalization is €90.9 million. BasicNet has a demonstrated pattern of irreverent and offensive brands amongst its subsidiaries.

25. Opposer’s sister company Basic Trademark S.A. (“Basic Trademark”) markets sportswear alongside JESUS JEANS under the ROBE DI KAPPA brand. Like JESUS JEANS, the advertising for ROBE DI KAPPA clothing appeals to prurient interests. The ROBE DI KAPPA logo features the silhouette of a naked man and woman positioned back-to-back with respect to each other. Like Opposer, Basic Trademark markets its ROBE DI KAPPA products with photographs of models in sexually suggestive poses:

26. Through its advertising efforts, Opposer and its sister company have cultivated a sexualized corporate image of which JESUS JEANS and ROBE DI KAPPA are a part.
FIRST CLAIM FOR CANCELLATION  
Disparagement  
15 U.S.C. § 1052(a)  

27. Applicant repeats and realleges, as if fully set forth herein, each and every allegation contained in the foregoing paragraphs.  
28. Opposer’s JESUS mark refers to Jesus Christ.  
29. Opposer’s use of its JESUS mark in the marketplace alongside sexually suggestive images and messaging is irreverent, sacrilegious, blasphemous, and offensive to a substantial composite of Christians.  
30. Opposer’s mark is disparaging to Jesus Christ, Christianity, and Christians, violates section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), and is therefore not registerable.  

SECOND CLAIM FOR CANCELLATION  
False Suggestion of Connection with a Person and/or Belief  
15 U.S.C. § 1052(a)  

31. Applicant repeats and realleges, as if fully set forth herein, each and every allegation contained in the foregoing paragraphs.  
32. Opposer’s JESUS mark is the same as the name of Jesus Christ.  
33. Through Opposer’s adoption of its mark and its actions in the marketplace, the JESUS mark is recognized as pointing to or creating an association with Jesus Christ and/or the teaching of Jesus Christ.  
34. Through its sacrilegious advertising, Opposer’s JESUS mark and its use of the mark in the marketplace falsely suggests an association with the teachings of Jesus Christ and Christianity.  
35. Given the visibility and recognition of Jesus Christ, an association between Opposer’s JESUS mark and Jesus Christ and Christianity is likely to be presumed in the minds of consumers.
36. Opposer’s mark suggests a false connection with Jesus Christ and Christianity, violates section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), and is therefore not registrable.

WHEREFORE, Applicant respectfully prays that the mark sought to be registered be accepted and that Opposer’s mark be cancelled.

Respectfully submitted, this the 1st day of April, 2013.

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CERTIFICATE OF SERVICE

I hereby certify that on this the 1st day of April, 2013, a copy of the foregoing ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIM TO CANCEL OPPOSER’S REGISTRATION NO. 3,232,057 was served upon the correspondent of record for applicant via U.S. mail, postage prepaid, and addressed as follows:

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