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April 2, 2003

BY HAND

Jyll S. Taylor, Esquire
Trademark Trial and Appeal Board
United States Patent and Trademark Office
2900 Crystal Drive
Arlington, Virginia 22202

Box TTAB

Re: Kulkoni, Inc. v. USHA Martin Americas, Inc.
MISCELLANEOUS DESIGN, Serial No. 75/670,023
Opposition No. 121,228
Our File No. 21487-6017

Dear Ms. Taylor:

Our client Kulkoni has decided that further prosecution of its opposition to registration of the Violet & Gold Strand mark of USHA Martin Americas, Serial No. 75/670,023, is not sensible for the reasons explained below.

The Trademark Office has construed Wal-Mart Stores, Inc. v. Samara Brothers, Inc., 529 U.S. 205 (2000), to hold that color marks are never inherently distinctive. Accordingly, the Trademark Office has refused registration of color marks absent proof that the marks have acquired distinctiveness and are entitled to registration under Lanham Act section 2(f). The requirement of proof of acquired distinctiveness has been applied to applications for registration of color strand marks for wire rope. See, e.g., Red & Yellow Strand, Reg. No. 2,699,020 (published and registered under Lanham Act section 2(f)); Red & Green Strand, Serial No. 75/510,018 (published under Lanham Act section 2(f)).

The requirement of proof of acquired distinctiveness was not, however, applied to Violet & Gold Strand, Serial No. 75/670,023, which was published for opposition as an intent-to-use application on August 29, 2000, five months after issuance of Wal-Mart on March 22, 2000. The Violet & Gold Strand application was published before an allegation of use had been filed and with no proof of acquired distinctiveness whatsoever.

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When we brought this to the attention of the Office of the Assistant Commissioner, we were assured that the failure to apply the requirement of proof of acquired distinctiveness to the Violet & Gold Strand application was an error that would be rectified by returning the application to its assigned Examiner if it survived the instant opposition. We were assured further that the application would not be approved for registration absent the stringent proof of acquired distinctiveness required for registration of other color strand marks for wire rope under Lanham Act section 2(f).

Thus, the Violet & Gold Strand application will not register unless and until the applicant establishes that the mark is entitled to registration under Lanham Act section 2(f). Amendment of the application after publication to include a section 2(f) claim would alter its basis. This in turn would require republication under Trademark Manual of Examining Procedure 1505.01(f).

If our understanding of the foregoing points is correct, further prosecution of the instant opposition makes no sense. In the event that USHA Martin Americas fails to establish its 2(f) claim of acquired distinctiveness, registration of the Violet & Gold Strand mark will be refused at no cost to our client. In the event that USHA Martin Americas is held to have established its 2(f) claim, the application will be republished and our client will have the opportunity to oppose registration on, inter alia, the ground that the mark has not acquired the distinctiveness required for registration, on which USHA Martin Americas has refused discovery in the instant opposition as irrelevant.

We would be grateful if you could confirm (or deny) that we have understood the situation in respect of the Violet & Gold Strand application correctly. If our understanding is correct, please dismiss the instant opposition without prejudice.

Thank you for your attention to and assistance in this matter.

Yours sincerely,



Judith Sapp

cc: Mr. Hans W. Buhrfeind
John M. Adams, Esquire