



TAB

11-02-2001

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #26

Priority Doc. No. 7222-69477

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

In the Matter of Application Serial No. 75/457,081:

MISCELLANEOUS DESIGN
(Bezel)

Published in the Official Gazette of June 5, 2001 in International Class 9

OLD WORLD INDUSTRIES, INC.,)

and)

SPLITFIRE INTERNATIONAL, INC.)

Opposers)

AUTO METER PRODUCTS, INC.,)

Applicant.)

Opposition No. 150,094

DI NOV - 7 PM 6:53

ANSWER TO NOTICE OF OPPOSITION

Applicant, Auto Meter Products, Inc. ("Auto Meter"), answers Opposers' Old World Industries, Inc. ("Old World") and SplitFire International, Inc. ("SplitFire"), Notice of Opposition as follows:

Count I

1. SplitFire, a wholly-owned subsidiary of Old World, manufactures and intends to continue manufacturing, marketing and selling automotive accessories, including automobile gauges having a bezel to hold and protect the cover of the gauge, in commerce between the United States and foreign nations, which gauges are sold under the trademark SPLITFIRE.

ANSWER: Auto Meter is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 1, and therefore denies same.

AK

2. Old World intends to manufacture, market and sell automobile gauges in commerce. Said gauges will have a bezel to hold and protect the cover of the gauge.

ANSWER: Auto Meter is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 2, and therefore denies same.

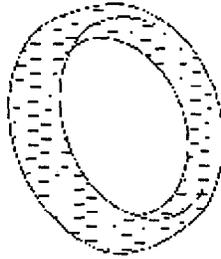
3. Applicant manufactures, markets and sells automotive accessories, including automobile gauges having a bezel to hold and protect the cover of the gauge sold under the trademark AUTO METER.

ANSWER: Auto Meter admits that it sells automotive gauges, tachometers and accessories, and that certain of those products are advertised, promoted and sold in connection with Auto Meter's distinctive Super Bezel mark, which is the subject of the above Registration Application No. 75/457,081. Auto Meter denies all remaining allegations of paragraph 3.

4. Applicant's gauges are sold in competition with SplitFire's gauges and would also compete with those the Old World intends to manufacture.

ANSWER: Auto Meter admits that SplitFire has advertised and offered to sell certain gauge products. Auto Meter is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations of paragraph 4, and therefore denies same.

5. The Opposed Application seeks to register the following bezel:



as a trademark for “automotive measuring instruments, namely, oil pressure, water temperature, vacuum, ammeter, volt meter, fuel pressure, fuel level, and oil temperature gauges, hourmeters, speedometers and tachometers for the automotive aftermarket.”

ANSWER: Auto Meter admits that it has filed the above-referenced Registration Application Serial No. 75/457,081 and the contents thereof. Auto Meter denies all remaining allegations of paragraph 5.

6. Applicant’s Opposed Application claims that the bezel has acquired secondary meaning as a trademark and is therefore entitled to registration under Section 2(f) of the Trademark Act.

ANSWER: Auto Meter admits that its Super Bezel mark has acquired secondary meaning and that the above-referenced Registration Application Serial No. 75/457,081 is entitled to registration on the Principal Register of the United States Patent and Trademark Office pursuant to 15 U.S.C. § 1051 *et seq.* Auto Meter denies all remaining allegations of paragraph 6.

7. SplitFire and others have for many years sold automotive gauges that include the bezel for which Applicant is seeking registration and claiming secondary meaning.

ANSWER: Auto Meter is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 7, and therefore denies same.

8. Applicant's use of the bezel shown in the Opposed Application has not been substantially exclusive and does not indicate Applicant as the source of the gauges.

ANSWER: Auto Meter denies the allegations of paragraph 8.

9. The bezel shown in the Opposed Application has therefore not acquired secondary meaning as a trademark of the Applicant.

ANSWER: Auto Meter denies the allegations of paragraph 9.

10. Applicant is therefore not entitled to registration of the bezel shown in the Opposed Application.

ANSWER: Auto Meter denies the allegations of paragraph 10.

11. If Applicant were to obtain registration for the bezel shown in the Opposed Application, it would obtain legal benefits, including but not limited to, a presumption that Applicant owns the design and has the right to prevent others from using the same or a similar design on goods that compete with those sold by the Applicant.

ANSWER: Auto Meter admits that it is entitled to the registration of its Super Bezel mark on the Principal Register of the Patent and Trademark Office, and is entitled to all of the legal rights provided by 15 U.S.C. § 1051 *et seq.*, as well as Auto Meter's common law rights to Auto Meter's Super Bezel mark. Auto Meter denies all remaining allegations of paragraph 11.

12. Registration of the bezel shown in the Opposed Application would therefore harm Opposers by potentially exposing Opposers to a threat of liability should they use the non-distinctive, functional bezel for which Applicant is seeking registration.

ANSWER: Auto Meter admits that infringers of Auto Meter's aforementioned legal rights in Auto Meter's Super Bezel mark will be subject to legal liability and damages for such infringement. Auto Meter denies all remaining allegations of paragraph 12.

Count II

13. Opposers repeat and reallege Paragraphs 1-5 and 11-12 as though fully set forth herein.

ANSWER: Auto Meter repeats its answers to paragraphs 1-5 and 11-12.

14. The bezel shown in the Opposed Application holds the protective cover of the face of a gauge in place and reduces the likelihood that the protective cover will break.

ANSWER: Auto Meter admits that its Super Bezel mark is used in connection with gauges and tachometers. Auto Meter denies all remaining allegations of paragraph 14.

15. The bezel shown in the Opposed Application serves as ornamentation for a gauge.

ANSWER: Auto Meter denies the allegations of paragraph 15.

16. The bezel shown in the Opposed Application is merely functional and does not serve as a trademark.

ANSWER: Auto Meter denies the allegations of paragraph 16.

17. The bezel shown in the Opposed Application is not entitled to registration as a trademark.

ANSWER: Auto Meter denies the allegations of paragraph 17.

AFFIRMATIVE DEFENSES

1. Opposers fail to adequately state a claim upon which relief may be granted.
2. Opposers fail to state a claim for relief based on any alleged intended use of a bezel on gauges.
3. Upon information and belief, Opposer, SplitFire International, Inc., has knowingly and willfully infringed Auto Meter's Super Bezel trademark, and is therefore estopped and/or barred by unclean hands from stating a claim upon which relief can be granted.

PRAYER FOR RELIEF

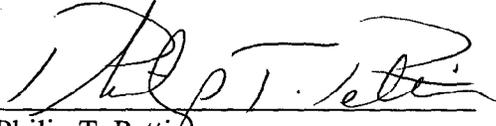
WHEREFORE, Applicant, Auto Meter Products, Inc., prays that Counts I and II of Opposers' Notice of Opposition be dismissed; that Application No. 75/457,081 proceed to registration; and that Auto Meter be granted such other and further relief as the Board deems just and proper.

Respectfully submitted,

AUTO METER PRODUCTS, INC.

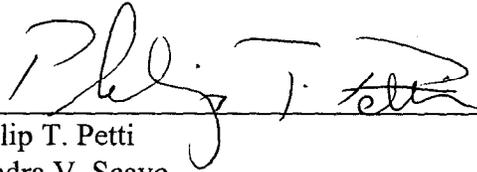
Date: October 30, 2001

By


Philip T. Petti
Sandra V. Scavo
FITCH, EVEN, TABIN & FLANNERY
120 South LaSalle Street
Suite 1600
Chicago, IL 60603-3406
(312) 577-7000

CERTIFICATE OF SERVICE

I, Philip T. Petti, one of the Attorneys for Registrant, hereby certify that a copy of the foregoing **ANSWER TO NOTICE OF OPPOSITION** was caused to be served by first class mail, postage prepaid, upon David C. Hilliard and Sanjiv D. Sarwate, Pattishall, McAuliffe, Newbury, Hilliard & Geraldson, 311 South Wacker Drive, Suite 5000, Chicago, Illinois 60606, on this 30th day of October 2001.



Philip T. Petti
Sandra V. Scavo
FITCH, EVEN, TABIN & FLANNERY
120 South LaSalle Street
Suite 1600
Chicago, IL 60603-3406
(312) 577-7000
(312) 577-7007

Attorneys for Applicant
Auto Meter Products, Inc.

#265187