

DT-6325

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

In the matter of Application Serial No. 75/831,328  
Published in the *Official Gazette* on September 17, 2002

HILTI INC.,	)	
	)	
Opposer,	)	Opposition No.
	)	
v.	)	
	)	
MILWAUKEE ELECTRIC	)	
TOOL CORPORATION,	)	
	)	
Applicant.	)	

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**NOTICE OF OPPOSITION**

Hilti Inc. ("Opposer"), a company having its principal place of business at 5400 South 122<sup>nd</sup> East Avenue, Tulsa, OK, believes it will be damaged by the registration of the color mark as shown in application serial no. 75/831,328, published in the *Official Gazette* on September 17, 2002 and hereby opposes the same.

The grounds for opposition are as follows:

1. Opposer is and has been engaged in the business of marketing and selling a variety of goods with the colors red and black, including but not limited to, the electrical power tools listed in the application since long prior to the date of first use claimed by Applicant in the application.

2. To the extent that any party has trademark rights in the colors red and black as applied to power tools, Opposer rights are senior based on its extensive prior use of these colors as trademark in the United States and abroad.
3. Opposer has expended, and continues to expend, both abroad and in the United States, substantial amounts of money, time and effort in advertising, promoting and popularizing its goods and the colors black and red as associated thereto.
4. The purchasing public have come to know and recognize Opposer's trademark and products and to know that the same originate with, and belong to, Opposer.
5. The goods for which Applicant seeks registration of the colors black and red are identical to the goods for which and in connection with which Opposer's black and red mark has been extensively used for many years. Goods marketed by Opposer necessarily would travel in the same channels of trade as, the goods marketed and sold by Applicant.
6. Applicant's claimed mark is confusingly and deceptively similar to Opposer's prior use of the colors red and black as a trademark. Thus, to the extent that these colors have trademark value they are associated with the Opposer and not the Applicant. Thus, Applicant's registration of these colors as a trademark for itself is likely to cause confusion and mistake in the minds of the purchasing public and to deceive the purchasing public as to the source or origin of Applicant's goods. Any such confusion in the trade could seriously injure Opposer to the extent that any defect, objection or fault found with Applicant's goods marketed under its

mark would necessarily reflect upon the reputation which the Opposer has established for its products merchandised under its trademark.

7. If the Applicant is granted registration for the subject mark it would thereby obtain at least *prima facie* exclusive right to the use of its mark. Such registration and use would be a source of damage and injury to Opposer and Opposer's customers.

**WHEREFORE**, Opposer requests that this opposition be sustained and that application serial. no. 75/831,328 be refused.

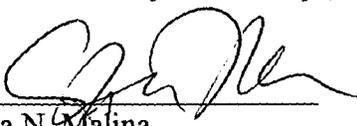
Please charge the filing fee in connection with this Notice of Opposition to our firm's Deposit Account No. 50-0955.

Please direct all correspondence to the law firm of SIDLEY AUSTIN BROWN & WOOD, LLP, 787 Seventh Avenue, New York, New York 10019.

Petitioner herein appoints David Toren, Peter Toren, Shifra N. Malina and Ronit Gillon, its attorneys to transact all business in the U.S. Patent and Trademark Office relating to this matter with full power of substitution.

Respectfully submitted,  
Hilti Inc.  
By its attorneys,

Dated: October 16, 2002

By:   
Shifra N. Malina  
SIDLEY AUSTIN BROWN & WOOD, LLP  
787 Seventh Avenue  
New York, New York 10019  
(212) 839-5300

Express Mail No. EU512448143US Date: October 16, 2002:

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated above and is addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.



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TAB



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U.S. Patent & TMOfc/TM Mail RcptDt. #26

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TRADEMARK TRIAL AND  
APPEAL BOARD

LETTER

Dear Sir:

Enclosed please find a Notice of Opposition in duplicate. Please charge our deposit  
account no. 50-0955 for the filing fee.

Respectfully submitted,

David Toren  
Sidley Austin Brown & Wood, LLP  
787 Seventh Avenue  
New York, New York 10019

Dated: October 16, 2002

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