TTAB

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CERTIFICATE OF MAILING
37 C.F.R 1.8

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on the date below:

4/21/03
Date

Signature

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

HILTI AKTIENGESELLCHAFT,	§	
	§	
Opposer,	§	
	§	
v.	§	Opposition No. 155,456
	§	
MILWAUKEE ELECTRIC TOOL CORPORATION,	§	
	§	
	§	
Applicant.	§	

ANSWER TO NOTICE OF OPPOSITION

BOX TTAB
NO FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Applicant, Milwaukee Electric Tool Corporation ("Milwaukee"), hereby answers the Notice of Opposition filed by Hilti Aktiengesellschaft ("Opposer") as follows:

1. Milwaukee admits that selected electric power tools bearing the mark "HILTI" and using the colors red and black have been marketed in the United States in different channels of trade than the tools recited in the present application. Milwaukee lacks knowledge or information sufficient to form a belief as to whether these "HILTI"

products are manufactured and marketed by Opposer or another entity, such as Hilti Inc. To the extent that these "HILTI" products are now being sold in Milwaukee's channels of trade, on information and belief, this use has occurred only recently, long after Milwaukee had acquired its rights in its mark. Additionally, on information and belief, the effect of any alleged prior use by Hilti of the colors red and black on consumers has been *de minimis,* and has not affected Milwaukee's rights or its acquisition of those rights in Milwaukee's channels of trade. To the extent that the allegations of Paragraph 1 are inconsistent with the above, Milwaukee lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 1 of the Notice of Opposition and therefore denies them.

2. Milwaukee expressly denies the allegation that Opposer has senior trademark rights in the colors red and black as applied to the portable electric power tools described in the application. Milwaukee lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 2 of the Notice of Opposition and therefore denies them.

3. Milwaukee lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 3 of the Notice of Opposition and therefore denies them.

4. With regard to the "purchasing public" to which Milwaukee promotes its products, assuming that "Opposer's trademark and products" is intended to refer to the red and black color combination in which Hilti alleges rights, and assuming that "recognize" is intended to refer to secondary meaning (acquired distinctiveness), the

allegations contained in Paragraph 4 of the Notice of Opposition are denied. With regard to any other "purchasing public" and/or with regard to any other construction of "Opposer's trademark and products" or "recognize," Milwaukee lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 4 of the Notice of Opposition and therefore denies them.

5. The allegations contained in Paragraph 5 of the Notice of Opposition are denied. Milwaukee's description of goods are limited to goods traveling through particular channels of trade in which, on information and belief, neither Hilti, Inc., nor Hilti Aktiengesellschaft sold product until relatively recently -- long after Milwaukee acquired its rights in its mark.

6. Applicant currently lacks knowledge or information sufficient to form a belief as to the truth of the allegations of the first sentence contained in Paragraph 6 of the Notice of Opposition and therefore denies them. Applicant denies the second and fourth sentences of Paragraph 6. Applicant also denies the third sentence of Paragraph 6, in part, because the "registration" of a mark in not likely to cause consumer confusion. Additionally, if there is a likelihood of confusion within Milwaukee's channels of trade, Milwaukee has superior rights in such channels of trade.

7. Milwaukee admits that registration of its trademark would provide it with *prima facie* evidence of the exclusive right to use that mark in commerce on or in connection with the applied-for goods, as provided under the Lanham Act, 15 U.S.C. §§1057(b) and 1115(a). Milwaukee denies that such registration would be a source of damage or injury to Opposer and/or Opposer's customers.

8. Except as expressly admitted herein, Milwaukee denies each and every allegation in the Notice of Opposition.

WHEREFORE, Milwaukee requests that the opposition be dismissed and that its application be passed on to registration.

Respectfully submitted,

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Date: April 21, 2003

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Answer to Notice of Opposition in Opposition No. 155,456 was served by First Class U.S. Mail, on this the 21st day of April, 2003, to:

Shifra N. Malina, Esq.
Sidley, Austin, Brown & Wood, L.L.P.
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New York, New York 10019