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

Proceeding	91166786
Party	Defendant EATON LEONARD ROBOLIX, INC. EATON LEONARD ROBOLIX, INC. Suite A 1391 Specialty Drive Vista, CA 92083
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Attachments	Eagle Precision Tech. v. Eaton Leonard Robolix - Answer to Opposition.pdf (5 pages)

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

In the matter of:

EAGLE PRECISION TECHNOLOGIES, INC.,

Opposer,

v.

EATON LEONARD ROBOLIX, INC.,

Applicant.

) Opposition No.: 91166786

) Mark: EATON LEONARD with
) design

) Serial No.: 78/462,211

) I hereby certify that this correspondence and all marked
) attachments are being transmitted by electronic mail to
) the United States Patent and Trademark Office at
) <http://www.uspto.gov> on

November 16, 2005

(Date)


Frederick S. Berretta

ANSWER TO OPPOSITION

SUBMITTED ELECTRONICALLY:

Assistant to Commissioner of Trademarks
P.O. Box 1451
Arlington, Virginia 22313-1451

Dear Sir:

Applicant EATON LEONARD ROBOLIX, INC., a California corporation (“Applicant”), hereby answers the opposition filed by EAGLE PRECISION TECHNOLOGIES, INC, a Canadian corporation (“Eagle”), with respect to the application for the mark EATON LEONARD with design (the “EATON LEONARD Logo”), Serial No.: 78/462,211, as follows:

1. Applicant admits that it is and has been engaged in the business of manufacture, sale, service and repair of tube bending machines and equipment for measurement of tubes

formed by tube bending machines, and is a competitor of Eagle. Except as expressly admitted above, Applicant denies the allegations of paragraph 1 of the Opposition.

2. Applicant admits that its predecessor in title (Eaton Leonard, Inc. or "ELI") and Applicant have used the EATON LEONARD Logo and the mark EATON LEONARD (the "EATON LEONARD trademark") since at least as early as August 19, 1974 in connection with automatic tube bending machines in International Class 7, and since at least as early as December 17, 1974, in interstate commerce. Applicant also admits that Applicant and its predecessor in title have used the EATON LEONARD trademark since at least as early as November 6, 1973 and the EATON LEONARD Logo since at least as early as August 19, 1974 in connection with measuring instruments for bent tubes and surfaces and for computing and printing data therefore in International Class 9, and since at least as early as December 12, 1973 and December 17, 2004, respectively, in interstate commerce. Applicant also admits that Applicant and its predecessor in title have used the EATON LEONARD Logo and the EATON LEONARD trademark since at least as early as December 17, 1974 in connection with repair and maintenance of automatic tube bending machines. Except as expressly admitted above, Applicant denies the allegations of paragraph 2 of the Opposition, and specifically denies that ELI is still a subsidiary of Eagle or that ELI still exists.

3. Applicant admits that Eagle acquired ELI sometime in 1997. Applicant also admits that an assignment was apparently recorded by Eagle on May 24, 1999 at Reel 1903, Frame 0548, but Applicant specifically denies that Eagle ever obtained the common law rights to the EATON LEONARD Logo and the EATON LEONARD trademark. Except as expressly admitted above, Applicant denies the allegations of paragraph 3 of the Opposition.

4. Applicant admits that, for a period of time, Eagle used the mark EAGLE EATON LEONARD in connection with certain goods and services, but then abandoned the mark in 2000. Except as expressly admitted above, Applicant denies the allegations of paragraph 4 of the Opposition.

5. Applicant admits that, for a period of time, Eagle used the mark EAGLE EATON LEONARD with a design in connection with certain goods and services, but then abandoned the mark in 2000. Except as expressly admitted above, Applicant denies the allegations of paragraph 5 of the Opposition.

6. Applicant admits the allegations of paragraph 6 of the Opposition.

7. Applicant admits the allegations of paragraph 7 of the Opposition.

8. Applicant admits the allegations of paragraph 8 of the Opposition.

9. Applicant admits the allegations of paragraph 9 of the Opposition.

10. Applicant admits that the EATON LEONARD Logo and the EATON LEONARD trademark are famous in the tube bending industry and have acquired great value as identifiers of Applicant's goods. Except as expressly admitted above, Applicant denies the allegations of paragraph 10 of the Opposition.

11. Applicant admits that in or about May 2000, Applicant was formed as a result of a transaction between Eagle, its creditors/bankers CIBC, ELI, and Financiere Robolix S.A.R.L. Except as expressly admitted above, Applicant denies the allegations of paragraph 11 of the Opposition.

12. Applicant admits filing trademark applications for the EATON LEONARD trademark and the EATON LEONARD Logo and that Applicant's ownership rights in the marks is an issue in a pending action in the United States District Court for the Southern District of California. Except as expressly admitted above, Applicant denies the allegations of paragraph 12 of the Opposition.

13. Applicant denies the allegations of paragraph 13 of the Opposition.

FIRST AFFIRMATIVE DEFENSE

14. The Opposition fails to state facts sufficient to oppose the application of Applicant for trademark registration of the EATON LEONARD Logo.

SECOND AFFIRMATIVE DEFENSE

15. The Opposition is barred by reason of the Opposer's intentional and unintentional abandonment of the EATON LEONARD Logo and trademark.

THIRD AFFIRMATIVE DEFENSE

16. The Opposition is barred by reason of Opposer's unclean hands with respect to Applicant.

FOURTH AFFIRMATIVE DEFENSE

17. The Opposition is barred by reason of Opposer's contractual, legal and equitable estoppel.

FIFTH AFFIRMATIVE DEFENSE

18. The Opposition is barred by reason of Opposer's acquiescence in Applicant's ownership and exclusive use of the EATON LEONARD Logo and trademark.

SIXTH AFFIRMATIVE DEFENSE

19. Opposer has no ownership rights in the EATON LEONARD Logo or trademark and lacks standing to oppose the present application.

SEVENTH AFFIRMATIVE DEFENSE

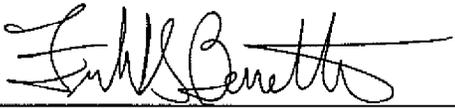
20. The Opposition fails because Applicant owns the common law rights to the EATON LEONARD Logo and the EATON LEONARD trademark.

WHEREFORE, Applicant prays that the Opposition be ruled in favor of Applicant, and that registration be allowed to issue on Application Serial No. 78/462,211.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: November 16, 2005

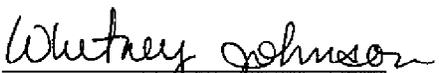
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CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **ANSWER TO OPPOSITION** upon Opposer's counsel by placing it in a sealed envelope, via First Class Mail, postage prepaid, on November 16, 2005, addressed as follows:

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