



## **BULKY DOCUMENTS**

(Exceeds 100 pages)

Proceeding/Serial No: **91179480**

Filed: 11/04/2010

Title: *OPPOSER'S MOTION FOR SUMMARY  
JUDGMENT, AND EXHIBITS A-P*

Part 1 of 2

**91179480**

**townsend.**

Date of Deposit: 11/1/10

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TOWNSEND AND TOWNSEND AND CREW LLP

By: Kara E. Fielder  
Name: Kara E. Fielder

November 1, 2010

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

79 / 023, 935

**Re: Consolidated Opposition Nos. 91179480 (parent) and 91179482  
Our File No. 26694-000500US**

Dear Madam:

Enclosed in connection with the above-identified oppositions is the following document, to be filed with the Trademark Trial and Appeal Board:

**1. OPPOSER'S MOTION FOR SUMMARY JUDGMENT,  
AND EXHIBITS A-P (PUBLIC VERSION)**

Should you have any questions, please contact me at 303.571.4000. Thank you for your assistance.

Very truly yours,

*Miranda Martinez*  
Miranda Martinez

MM:kf  
Enclosures

61499240



11-04-2010

U.S. Patent & Trademark Office

**TRADEMARK**

Attorney Docket No. 26694-000500US

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

In re: *Application Ser. Nos. 79/023,935 and 79/023,934*  
Published: August 7, 2007, in the Official Gazette  
Applicant: Kobelco Construction Machinery Co., Ltd.  
Mark: **GEOSPEC and ACERA GEOSPEC (and design)**

PLASTI-FAB LTD.,

Opposer,

vs.

KOBELCO CONSTRUCTION  
MACHINERY CO., LTD.,

Applicant.

Consolidated Opposition Nos. 91179480  
(parent) and 91179482

**OPPOSER'S MOTION FOR  
SUMMARY JUDGMENT**

(PUBLIC VERSION)

October 28, 2010

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## **I. INTRODUCTION**

Opposer Plasti-Fab Ltd. (“Opposer”) hereby submits this Motion for Summary Judgment against Applicant Kobelco Construction Machinery Co., Ltd. (“Applicant”) because there is no genuine issue as to any material fact at issue in this case regarding the likelihood of confusion between the competing marks, and Opposer is entitled to judgment as a matter of law. As a result, Opposer respectfully requests that the Trademark Trial and Appeal Board (“Board”) grant summary judgment and refuse to register Application Serial Nos. 79/023,935 and 79/023,934.

## **II. STATEMENT OF FACTS**

Opposer filed an U.S. application for the mark GEOSPEC (“Opposer’s Mark” or GEOSPEC) on June 7, 2004, and began using the mark in the United States in 2005. Ex. A at ¶ 3a, Attachment A. On February 19, 2008, Opposer’s Mark was registered. *Id.* On March 30, 2006, almost two years after Opposer filed its application, Applicant filed Application Serial Nos. 79/023,935 and 79/023,934 for “Geospec” and “Acera Geospec” and design, respectively (“Applicant’s Marks” or “Geospec” and/or “Acera Geospec”). *Id.* at ¶¶ 3b, 3c, Attachments B and C.

On September 6, 2007, Opposer filed a Notice of Opposition with the Board, opposing Application Serial No. 79/023,935 for “Geospec.” Exhibit C. On September 10, 2007, Opposer filed a Notice of Opposition to Application Serial No. 79/023,934 for “Acera Geospec” and design. Exhibit D. Both oppositions were based on the priority of Opposer’s Mark and likelihood of confusion between Opposer’s Mark and Applicant’s Marks. Applicant filed answers to each opposition on October 23, 2007. Exhibits E and F, respectively. The proceedings were consolidated on June 30, 2008. Exhibit G.

During this Opposition, Applicant spent little to no effort in responding to the Board's Orders or Opposer's discovery requests. A brief summary of the proceedings is as follows:

- On September 2, 2008, Opposer served its First Set of Interrogatories, First Set of Requests for Production of Documents, and First Set of Requests for Admission. According to TBMP § 403.03, responses were due on October 7, 2008. Exhibit A at ¶ 4a, Attachment F.
- On October 7, 2008, Applicant filed a Motion for Extension of Time to Respond to Opposer's Discovery Requests. If granted, this motion would have given Applicant until November 6, 2008 to submit responses to Opposer's discovery requests. Exhibit H. The Board did not rule on Applicant's motion.
- Prior to the close of its discovery period on October 28, 2008, Opposer filed a Motion to Compel and renewed the motion on November 26, 2008 when Applicant failed to respond to Opposer's discovery requests within the extension of time that it requested in its October 7, 2008, Motion for Extension of Time. Exhibits I and J, respectively.
- On January 27, 2009, the Board granted Opposer's Motion to Compel and ordered Applicant to respond to Opposer's First Set of Interrogatories and First Set of Requests for Production of Documents within thirty (30) days of the Order, without interposing any objections. The Board also ordered that Opposer's First Set of Requests for Admission were deemed admitted for Applicant's failure to respond. Exhibit K.
- Applicant did not respond to Opposer's discovery requests by February 26, 2009, which was the deadline the Board gave Applicant in its January 27, 2009 Order.
- On March 9, 2009, the Board reiterated its Order granting Opposer's Motion to Compel, granting Applicant an additional thirty days from the date of the Order to respond to Opposer's First Set of Interrogatories and First Set of Requests for Production of Documents without objection. The Board also repeated that Opposer's First Set of Requests for Admission were deemed admitted by Applicant as a sanction for failure to respond. Exhibit L.
- On April 8, 2009, over six months after originally becoming due, Applicant served Opposer with its discovery responses. Exhibit A at ¶ 4b, Attachment G. However, these responses ignored the Board's Order of March 9, 2009, which required that Applicant respond to the discovery requests *without objection*. Moreover, Applicant submitted responses to Opposer's First Set of Requests for Admission, despite the Board having twice deemed admitted those unanswered requests.

- On April 20, 2009, Opposer filed a Motion for Default Judgment on the grounds that Applicant's discovery responses were inadequate and noncompliant with the Board's Orders. Exhibit M.
- On May 11, 2009, Applicant filed its response to Opposer's Motion for Default Judgment. To its response, Applicant attached supplemental responses to Opposer's First Set of Interrogatories and included ten pages of discovery. Exhibit N.
- On June 3, 2010, the Board issued its Order denying Opposer's Motion for Default Judgment. Exhibit O. The Board withdrew its previous two decisions to deem all unanswered Requests for Admission admitted by Applicant. However, the Board ordered that any of Applicant's objections to Opposer's discovery requests would be disregarded and the requests to which they pertain will be construed against Applicant. Finally, the Board granted leave to Opposer to file a motion for summary judgment prior to the opening of Opposer's reset testimony period, which was extended by the Board to October 29, 2010. Exhibit P.
- On July 30, 2010, Opposer submitted its Second Set of Interrogatories, Second Requests for Production of Documents, and Second Set of Requests for Admission. Exhibit A at ¶ 4c, Attachment H.
- On September 3, 2010, Applicant submitted its responses to Opposer's Second Set of Interrogatories, Second Request for Production of Documents, and Second Set of Requests for Admission. Exhibit A at ¶ 4d, Attachment I.

### III. LEGAL STANDARD

In most trademark disputes, including this case, likelihood of confusion between competing marks is the central inquiry. In analyzing the likelihood of confusion between two marks, the United States Court of Appeals for the Federal Circuit and the Board use the thirteen factors set out in *In re E.I. duPont de Nemours & Co.*, 177 U.S.P.Q. 563 (C.C.P.A. 1973). See *Maid to Order of Ohio, Inc. v. Maid-to-Order, Inc.*, 78 U.S.P.Q. 2d 1899, 1909 (T.T.A.B. 2006) ("Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E.I. duPont de Nemours & Co.* ...") The thirteen *duPont* factors are:

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
- (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use;
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels;
- (4) The conditions under which and buyers to whom sales are made, *i.e.* "impulse" vs. careful, sophisticated purchasing;
- (5) The fame of the prior mark (sales, advertising, length of use);
- (6) The number and nature of similar marks in use on similar goods;
- (7) The nature and extent of any actual confusion;
- (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion;
- (9) The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark);
- (10) The market interface between applicant and the owner of a prior mark;
- (11) The extent to which applicant has a right to exclude others from use of its mark on its goods;
- (12) The extent of potential confusion, *i.e.*, whether *de minimis* or substantial; and
- (13) Any other established fact probative of the effect of use.

*In re E.I. duPont*, 177 U.S.P.Q. at 567. The Board need not evaluate each likelihood of confusion factor, but is "required only to consider those factors that are relevant." *Shen Mfg. Co. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 1241 (Fed. Cir. 2004).

Summary judgment is appropriate "if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no

genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law.” *Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986); Fed. R. Civ. P. 56(c).

#### **IV. ARGUMENT**

In this case, *duPont* factors 1, 2, 3, 6 and 12 weigh heavily in favor of showing a likelihood of confusion between Opposer’s Mark and Applicant’s Marks, while the remaining *duPont* factors are either neutral or inapplicable to the instant dispute. When evaluating the relevant factors – factors 1, 2, 3, 6, and 12 – there is no genuine issue of material fact as to the likelihood of confusion between Opposer’s Mark and Applicant’s Marks. If registration of Applicant’s “Geospec” and “Acera Geospec” marks is allowed, customers likely will be confused as to the separate and distinct source of Applicant’s goods and Opposer’s goods.

##### **A. Factor 1 – Opposer’s Mark and Applicant’s Marks Are Confusingly Similar in Appearance, Sounds, Connotation and Commercial Impression.**

Opposer’s Mark and Applicant’s Marks are confusingly similar in appearance, sound, connotation and commercial impression. This first *duPont* factor, similarity of the marks at issue, is a “predominant inquiry.” *Herbko Int’l. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165 (Fed. Cir. 2002). This factor is so critical that the Federal Circuit has found it alone may be dispositive of the likelihood of confusion issue. *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373 (Fed. Cir. 1998); *Kellogg Co. v. Pack’Em Enters., Inc.*, 951 F.2d 330 (Fed. Cir. 1991).

The first of Applicant’s two marks, “Geospec,” is identical to Opposer’s Mark, GEOSPEC. As a result, the marks look and sound the same. There is no visual or aural difference whatsoever between Opposer’s Mark and Applicant’s Mark, “Geospec.” Regardless

of whether a customer sees Applicant's Mark in writing or hears Applicant's Mark stated out loud, there is a likelihood of confusion between it and Opposer's Mark. Further, Opposer's Mark and Applicant's Mark have the same connotation and commercial impression to the consuming public. Both marks include the first syllable "geo," which is a prefix meaning "earth, ground, soil."<sup>1</sup> The second syllable "spec," is typically an abbreviation for "specification" (e.g. "parts built according to *spec*").<sup>2</sup> Thus, both the connotation and commercial impression of these terms can trigger an image of tools and materials used in the building and construction industry.

The next similarity analysis looks to Applicant's second mark "Acera Geospec." In a likelihood of confusion analysis, the marks at issue should be evaluated in their entireties. *Shen*, 393 F.3d at 1242-43. However, the Federal Circuit and the Board have held that confusion is likely when two marks for related goods share the same distinctive dominant feature. *See Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1571 (Fed. Cir. 1983) (GIANT HAMBURGERS is confusingly similar to GIANT marks used in food and restaurant services and grocery and supermarket services); *In re Serman & Co., Inc.*, 223 U.S.P.Q. 52 (T.T.A.B. 1984) (CITY WOMAN for clothing is confusingly similar to CITY GIRL for clothing). Such is the case here.

In Applicant's "Acera Geospec" mark and design, as shown below, the term "Geospec" is significantly larger and clearly the dominant term in the mark.

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<sup>1</sup> <http://www.merriam-webster.com/dictionary/geo->

<sup>2</sup> <http://www.merriam-webster.com/dictionary/spec>



Indeed, the term “Geospec” literally dominates the mark and extends on either side of the word “Acera.” When a consumer first encounters this mark, the consumer certainly will notice the “Geospec” portion first. The “Geospec” term also includes shading and a double border, making it stand apart from “Acera,” which is filled with only one color. Accordingly, visual and aural analyses of Applicant’s Mark “Acera Geospec” and Opposer’s Mark leads to the conclusion that they are confusingly similar. Likewise, the connotation and commercial impression comparison of GEOSPEC to “Acera Geospec” is identical to that described above for Applicant’s “Geospec” mark. Specifically, consumers will visualize tools and materials used in the construction industry when exposed to both marks.

For these reasons, there is no genuine issue of material fact regarding the fact that Opposer’s Mark and Applicant’s Marks are confusingly similar.

**B. Factor 2 – The Nature of the Goods Offered Under Opposer’s Mark and Applicant’s Marks Is Confusingly Similar.**

The focus of the second *duPont* factor is the nature of goods offered under Opposer’s GEOSPEC mark and Applicant’s “Geospec” and “Acera Geospec” marks. In this case, there is significant overlap between the goods offered under Opposer’s Mark and Applicant’s Marks.

Specifically, Opposer’s GEOSPEC mark is used on “molded expanded polystyrene (EPS) blocks and boards designed to act as a lightweight fill material used in geotechnical applications and compressible inclusion against structures; expanded polystyrene (EPS) foundation drainage

boards designed to provide insulation and drainage to hydrostatic pressure on foundations; and insulation for walls, pipes, utility lines and vessels.” Exhibit A at ¶ 3a, Attachment A. As such, goods marked with Opposer’s GEOSPEC mark are used in geotechnical construction projects and on large scale construction sites. Exhibit B at ¶¶ 3c, 3d.

Similarly, Applicant claims that its “Geospec” and “Acera Geospec” marks are used in connection with “power shovels and cranes.” Exhibit A at ¶¶ 3b, 3c, Attachments B and C; *see also* Exhibit A, Attachment G. As Applicant claims on its website, the goods offered under Applicant’s Marks are used in construction projects, such as “heavy power plant, alternative energy construction, large-scale petrochemical, refinery plants and tank farms, and expansive bridge building.” Exhibit A at ¶ 3d, Attachment D. Therefore, based on Applicant’s own admissions, there is significant overlap between the goods offered under Opposer’s Mark and the goods offered under Applicant’s Marks. In fact, both kinds of goods are associated with construction projects, and could be found on the same construction sites.

Finally, even if the goods and services are not identical or related in kind, they may be sufficiently related in the mind of the consuming public to cause confusion concerning the source of origin of the goods and services. *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329 (Fed. Cir. 2000) (“Thus, even if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”). Here, consumers would categorize both types of goods into a general category, which includes tools and materials for construction projects. Because of the related nature of goods offered under both marks, there is no genuine issue of material fact that this *duPont* factor strongly favors Opposer.

**C. Factor 3 – Opposer and Applicant Use Similar Trade Channels to Target Similar Customers in Marketing the Goods Offered Under Their Respective Marks.**

The third *duPont* factor addresses the trade channels in which, and the consumers to whom, the marked goods are offered. Absent restrictions in a trademark application, goods and services under an applicant's mark are presumed to travel in the same channels of trade to the same class of purchasers as goods and services offered under an opposer's mark. *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268 (Fed. Cir. 2002). Applicant did not restrict trade channels or class of purchasers in its applications for "Geospec" and "Acera Geospec." Exhibit A at ¶¶ 3b, 3c, Attachments B and C. Therefore, Applicant's goods are presumed to be offered through the same trade channels and to the same purchasers as those of Opposer. Applicant has offered no evidentiary proof to rebut this presumption and states only that it "intends to sell its goods in the United States." Exhibit A, Attachment I.

Even without the benefit of the well-established presumption described above, Opposer and Applicant market their goods through the same channels of trade to the same class of customers. The purchasers and potential purchasers of Opposer's GEOSPEC goods include members of the construction industry, such as general contractors, engineers, and state and local governments and municipalities. Exhibit B at ¶ 3f. Opposer's sales revenues for materials sold under the GEOSPEC mark to its United States customers are [REDACTED] Exhibit B at ¶ 3g.

According to Applicant's interrogatory responses, it has "no current U.S. customers" of goods sold under its "Geospec" or "Acera Geospec" marks. Exhibit N. However, if Applicant's Marks were registered, it would market its "Geospec" and "Acera Geospec" goods to the

construction industry through typical channels of trade for this industry, including those used by Opposer. Indeed, information on Applicant's website shows that its current and potential customers frequently include construction contractors for large scale construction projects. Exhibit A at ¶ 3e, Attachment E.

As a result, there is no genuine issue of material fact as to whether Opposer's goods and Applicant's goods are offered, or will be offered, through the same trade channels to the same class of purchasers. Moreover, Applicant offered no evidence to contradict the facts presented by Opposer, and is precluded by the Board from doing so now. Exhibit O.

**D. Factor 6 – There Are Few Third Party Uses of Similar Marks on Similar Goods.**

There are essentially no third party uses of marks that are similar to Opposer's GEOSPEC mark. Applicant admitted that it is not aware of any other federal trademark registration for "Geospec" other than that owned by Opposer. Exhibit A, Attachment I. Applicant has offered only one third party use of a similar mark: [www.geospec.com](http://www.geospec.com). *Id.* This single use of "geospec" in a website address is insufficient to challenge the strength of Opposer's Mark. In fact, the scarcity of third party uses of the mark GEOSPEC, or a similar mark, increases the likelihood of confusion between Opposer's Mark and Applicant's Marks because consumers are more likely to associate the mark GEOSPEC solely with Opposer. Applicant is prohibited by the Board from introducing or relying on any additional evidence of third party use of the term "geospec." Exhibit O. Therefore, there is no genuine issue of material fact with respect to the lack of similar marks used on similar goods, and this factor weighs heavily in favor of Opposer.

**E. Factor 12 – The Potential for Confusion Between Opposer’s Mark and Applicant’s Marks Is Substantial.**

The risk of consumer confusion between Opposer’s GEOSPEC mark and Applicant’s “Geospec” and “Acera Geospec” marks is substantial. Because Applicant has yet to use its marks in the United States, Opposer cannot yet show actual confusion between the marks. However, in evaluating duPont factors 1, 2, 3 and 6 above, it is apparent that consumers likely will be confused between the origin of goods marked with Applicant’s “Geospec” and “Acera Geospec” given the confusingly similar nature of the competing marks.

**F. The Remaining duPont Factors are Inapplicable to this Dispute.**

Factors 7, 8, 9, 10 and 11 do not apply to this likelihood of confusion analysis because Applicant has admitted that it has yet to use its marks “Geospec” and “Acera Geospec” in the United States. Exhibit N. Thus, although the potential for confusion between the competing marks is high, there has not yet been any actual confusion. Factors 4 and 13 are not applicable because Applicant has not produced any evidence to support these factors in its favor, and as stated below, is precluded from offering any evidence at this point in the case.

**G. Applicant is Prevented From Introducing or Relying On Contradictory Evidence.**

In ruling upon Opposer’s Motion for Default Judgment, the Board ordered that any remaining objections to Opposer’s discovery requests were to be discarded, and the requests to which they pertain will be construed against Applicant. Exhibit O at 8. Applicant also is “precluded from introducing and otherwise relying at trial on any information responsive to the discovery requests that were not produced.” *Id.*

Opposer's Interrogatory No. 43 requests "all facts and the legal bases that Applicant believes support Applicant's contention in paragraph 1 of the 'Affirmative Defenses' section of Applicant's answers to Opposer's Notices of Opposition that there is no likelihood of confusion between Opposer's Mark and Applicant's Marks." Exhibit A at ¶ 4d, Attachment I. *Applicant failed to answer Interrogatory No. 43, and according to the Board, this interrogatory will be construed against Applicant.* Moreover, Applicant has failed to submit any evidence to rebut Opposer's position that customers will be confused between Opposer's Mark and Applicant's Marks. As a result, summary judgment for Opposer is appropriate.

#### V. CONCLUSION

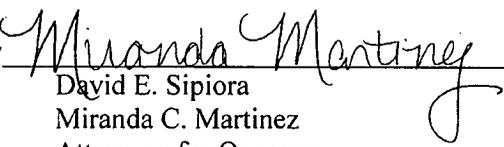
The record in this case demonstrates a likelihood of confusion between Opposer's Mark, GEOSPEC, and Applicant's Marks "Geospec" and "Acera Geospec." For the reasons stated above, there is no genuine issue of material fact as to whether there is a likelihood of confusion between the competing marks. As such, Opposer respectfully requests that the Board grant Opposer summary judgment and refuse registration to Applicant's Marks.

Respectfully submitted,

TOWNSEND AND TOWNSEND AND CREW LLP

Date: October 28, 2010

By

  
David E. Sipiora  
Miranda C. Martinez  
Attorneys for Opposer

**CERTIFICATE OF SERVICE**

I hereby certify that on November 1, 2010, I served the foregoing **OPPOSER'S MOTION FOR SUMMARY JUDGMENT (PUBLIC VERSION)** on counsel for Applicant by depositing a true and correct copy of the same with the United States Postal Service, first class mail, postage prepaid, in an envelope addressed to:

Bassam N. Ibrahim  
Buchanan Ingersoll & Rooney PC  
1737 King Street, Suite 500  
Alexandria, Virginia 22314-2727

*Kara E. Fielder*

---

Kara Fielder

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to:

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

*Kara E. Fielder*

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Kara Fielder

Dated: November 1, 2010

**EXHIBIT A**

**TRADEMARK**

Attorney Docket No. 26694-000500US

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re: *Application Ser. Nos. 79/023,935 and 79/023,934*

Published: August 7, 2007, and August 14, 2007, in the Official Gazette

Applicant: Kobelco Construction Machinery Co., Ltd.

Mark: **GEOSPEC and ACERA GEOSPEC (and design)**

PLASTI-FAB LTD.,

Opposer,

vs.

KOBELCO CONSTRUCTION  
MACHINERY CO., LTD.,

Applicant.

Consolidated Opposition Nos. 91179480  
(parent) and 91179482

**DECLARATION OF  
KARA E. FIELDER**

Pursuant to 28 U.S.C. § 1746, I, Kara E. Fielder, hereby declare as follows:

1. This declaration is in support of Opposer Plasti-Fab Ltd.'s ("Opposer") Motion for Summary Judgment in the above-captioned matter.
2. I am a paralegal with the law firm of Townsend and Townsend and Crew LLP representing Opposer in the above-captioned matter.
3. On October 27, 2010, I personally downloaded the following documents, appended to this declaration as attachments:
  - a. Attachment A – Registration Certificate of Opposer's GEOSPEC mark, downloaded from the United States Patent and Trademark Office ("USPTO") website.

- b. Attachment B – Application Serial No. 79/023,935 for Applicant’s “Geospec” mark, downloaded from USPTO website.
  - c. Attachment C – Application Serial No. 79/023,934 for Applicant’s “Acera Geospec” mark and design, downloaded from USPTO website.
  - d. Attachment D – True and correct copies of images downloaded from Kobelco Cranes North America website, [www.kobelcocranesnorthamerica.com](http://www.kobelcocranesnorthamerica.com).
  - e. Attachment E – True and correct copies of images downloaded from Kobelco Construction Machinery America website, [www.kobelcoamerica.com](http://www.kobelcoamerica.com).
4. I have personal knowledge of the veracity and authenticity of the following documents, appended to this declaration as attachments:
- a. Attachment F – Opposer’s First Set of Requests for Production of Documents (Nos. 1-28), Opposer’s First Set of Interrogatories (Nos. 1-29), and Opposer’s First Set of Requests for Admission (Nos. 1-20).
  - b. Attachment G – Applicant’s Responses to Opposer’s First Set of Requests for Admission (Nos. 1-20), Applicant’s Responses to Opposer’s First Requests for Production of Documents (Nos. 1-28), and Applicant’s Responses to Opposer’s First Set of Interrogatories (Nos. 1-29).
  - c. Attachment H – Opposer’s Second Set of Requests for Admission (Nos. 21-55), Opposer’s Second Requests for Production of Documents (29-64), Opposer’s Second Set of Interrogatories (Nos. 30-59).
  - d. Attachment I – Applicant’s Responses to Opposer’s Second Set of Interrogatories (Nos. 30-59), Applicant’s Responses to Opposer’s Second Set of Requests for

Admission (Nos. 21-55), Applicant's Responses to Opposer's Second Requests for Production of Documents (29-64).

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct.

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

Dated: October 28, 2010

By: Kara E. Fielder  
Kara E. Fielder

62957546 v1

# **ATTACHMENT A**

Int. Cl.: 17

Prior U.S. Cls.: 1, 5, 12, 13, 35 and 50

Reg. No. 3,385,301

United States Patent and Trademark Office

Registered Feb. 19, 2008

TRADEMARK  
PRINCIPAL REGISTER

**GEOSPEC**

PLASTI-FAB LTD. (CANADA CORPORATION)  
SUITE 270  
3015 5TH AVENUE N.E.  
CALGARY, ALBERTA, CANADA T2A 6T8

FOR: MOLDED EXPANDED POLYSTYRENE (EPS) BLOCKS AND BOARDS DESIGNED TO ACT AS A LIGHTWEIGHT FILL MATERIAL USED IN GEOTECHNICAL APPLICATIONS AND COMPRESSIBLE INCLUSION AGAINST STRUCTURES; EXPANDED POLYSTYRENE (EPS) FOUNDATION DRAINAGE BOARDS DESIGNED TO PROVIDE INSULATION AND DRAINAGE TO HYDROSTATIC PRESSURE ON FOUNDATIONS; AND INSULATION FOR WALLS, PIPES, UTILITY LINES AND

VESSELS, IN CLASS 17 (U.S. CLS. 1, 5, 12, 13, 35 AND 50).

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

PRIORITY CLAIMED UNDER SEC. 44(D) ON CANADA APPLICATION NO. 1215984, FILED 5-6-2004, REG. NO. TMA672632, DATED 9-13-2006, EXPIRES 9-13-2021.

SER. NO. 78-431,217, FILED 6-7-2004.

CIMMERIAN COLEMAN, EXAMINING ATTORNEY

# **ATTACHMENT B**

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2010-10-15 16:12:54 ET

Serial Number: 79023935 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: (NOT AVAILABLE)

Mark

# Geospec

(words only): GEOSPEC

Standard Character claim: Yes

Current Status: An opposition is now pending at the Trademark Trial and Appeal Board.

Date of Status: 2007-09-13

Filing Date: 2006-03-30

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 114

Attorney Assigned:  
BLANE SUZANNE M

Current Location: 650 -Publication And Issue Section

Date In Location: 2007-07-05

---

**LAST APPLICANT(S)/OWNER(S) OF RECORD**

---

1. KOBELCO CONSTRUCTION MACHINERY CO., LTD.

Address:  
KOBELCO CONSTRUCTION MACHINERY CO., LTD.  
12-4, Gion 3-chome Asaminami-ku, Hiroshima-shi  
Hiroshima 7310138  
Japan

Legal Entity Type: Corporation  
State or Country of Incorporation: Japan

---

**GOODS AND/OR SERVICES**

---

**International Class:** 007  
**Class Status:** Active  
**POWER SHOVELS AND CRANES**  
**Basis:** 66(a)  
**First Use Date:** (DATE NOT AVAILABLE)  
**First Use in Commerce Date:** (DATE NOT AVAILABLE)

---

**ADDITIONAL INFORMATION**

---

(NOT AVAILABLE)

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**MADRID PROTOCOL INFORMATION**

---

**International Registration Number:** 0885067  
**International Registration Date:** 2006-03-30  
**Priority Claimed:** Yes  
**Date of Section 67 Priority Claim:** 2006-01-11  
**International Registration Status:** Request For Extension Of Protection Processed  
**Date of International Registration Status:** 2006-06-29  
**International Registration Renewal Date:** 2016-03-30  
**Notification of Designation Date:** 2006-06-29  
**Date of Automatic Protection:** 2007-12-29  
**Date International Registration Cancelled:** (DATE NOT AVAILABLE)  
**First Refusal:** Yes

---

**PROSECUTION HISTORY**

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**NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.**

2007-09-29 - Refusal Processed By IB  
2007-09-13 - Opposition instituted for Proceeding  
2007-09-12 - Opposition Notice (Ib Refusal) Sent To IB  
2007-09-11 - Opposition papers filed  
2007-09-07 - Opposition Notice (Ib Refusal) Created  
2007-08-07 - Published for opposition  
2007-07-18 - Notice of publication  
2007-05-14 - Law Office Publication Review Completed  
2007-05-12 - Approved for Pub - Principal Register (Initial exam)

2007-04-23 - Amendment From Applicant Entered  
2007-04-23 - Communication received from applicant  
2007-04-23 - Assigned To LIE  
2007-03-20 - PAPER RECEIVED  
2006-10-05 - Refusal Processed By IB  
2006-09-20 - Non-Final Action Mailed - Refusal Sent To IB  
2006-09-20 - Refusal Processed By MPU  
2006-09-19 - Non-Final Action (Ib Refusal) Prepared For Review  
2006-09-18 - Non-Final Action Written  
2006-09-12 - Assigned To Examiner  
2006-06-30 - New Application Entered In Tram  
2006-06-29 - Sn Assigned For Sect 66a Appl From IB

---

**ATTORNEY/CORRESPONDENT INFORMATION**

---

**Attorney of Record**  
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**Correspondent**  
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**Domestic Representative**  
BUCHANAN INGERSOLL & ROONEY PC  
Phone Number: 703.836.6620

---

# ATTACHMENT C

**Thank you for your request. Here are the latest results from the TARR web server.**

**This page was generated by the TARR system on 2010-10-15 16:14:22 ET**

**Serial Number:** 79023934 Assignment Information      Trademark Document Retrieval

**Registration Number:** (NOT AVAILABLE)

**Mark**



**(words only):** ACERA GEOSPEC

**Standard Character claim:** No

**Current Status:** An opposition is now pending at the Trademark Trial and Appeal Board.

**Date of Status:** 2007-09-13

**Filing Date:** 2006-03-30

**Transformed into a National Application:** No

**Registration Date:** (DATE NOT AVAILABLE)

**Register:** Principal

**Law Office Assigned:** LAW OFFICE 114

**Attorney Assigned:**  
BLANE SUZANNE M

**Current Location:** 650 -Publication And Issue Section

**Date In Location:** 2007-07-12

---

**LAST APPLICANT(S)/OWNER(S) OF RECORD**

---

1. KOBELCO CONSTRUCTION MACHINERY CO., LTD.

**Address:**  
KOBELCO CONSTRUCTION MACHINERY CO., LTD.  
12-4, Gion 3-chome Asaminami-ku, Hiroshima-shi  
Hiroshima 7310138  
Japan  
**Legal Entity Type:** Corporation

**State or Country of Incorporation:** Japan

---

**GOODS AND/OR SERVICES**

---

**International Class:** 007  
**Class Status:** Active  
**POWER SHOVELS AND CRANES**  
**Basis:** 66(a)  
**First Use Date:** (DATE NOT AVAILABLE)  
**First Use in Commerce Date:** (DATE NOT AVAILABLE)

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**ADDITIONAL INFORMATION**

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**Color(s) Claimed:** The color(s) orange, white, black and grey is/are claimed as a feature of the mark.

**Description of Mark and Any Color Part(s):** The color orange appears in the wording "acera," the color grey appears in the wording "geospec," and the colors black and white appear in the outline of all the wording.

**Prior Registration Number(s):**  
2235282

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**MADRID PROTOCOL INFORMATION**

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**International Registration Number:** 0885066  
**International Registration Date:** 2006-03-30  
**Priority Claimed:** Yes  
**Date of Section 67 Priority Claim:** 2006-01-11  
**International Registration Status:** Request For Extension Of Protection Processed  
**Date of International Registration Status:** 2006-06-29  
**International Registration Renewal Date:** 2016-03-30  
**Notification of Designation Date:** 2006-06-29  
**Date of Automatic Protection:** 2007-12-29  
**Date International Registration Cancelled:** (DATE NOT AVAILABLE)  
**First Refusal:** Yes

---

**PROSECUTION HISTORY**

---

**NOTE:** To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2007-09-29 - Refusal Processed By IB  
2007-09-13 - Opposition instituted for Proceeding  
2007-09-12 - Opposition Notice (Ib Refusal) Sent To IB  
2007-09-11 - Opposition Notice (Ib Refusal) Created  
2007-09-10 - Opposition papers filed

2007-08-14 - Published for opposition  
2007-07-25 - Notice of publication  
2007-07-11 - Withdrawn From Pub - Tqr/Non-Atty Request  
2007-05-14 - Law Office Publication Review Completed  
2007-05-12 - Approved for Pub - Principal Register (Initial exam)  
2007-04-23 - Amendment From Applicant Entered  
2007-04-23 - Communication received from applicant  
2007-04-23 - Assigned To LIE  
2007-03-20 - PAPER RECEIVED  
2006-10-05 - Refusal Processed By IB  
2006-09-20 - Non-Final Action Mailed - Refusal Sent To IB  
2006-09-20 - Refusal Processed By MPU  
2006-09-19 - Non-Final Action (Ib Refusal) Prepared For Review  
2006-09-18 - Non-Final Action Written  
2006-09-12 - Assigned To Examiner  
2006-06-30 - New Application Entered In Tram  
2006-06-29 - Sn Assigned For Sect 66a Appl From IB

---

**ATTORNEY/CORRESPONDENT INFORMATION**

---

**Attorney of Record**

Bassam Ibrahim

**Correspondent**

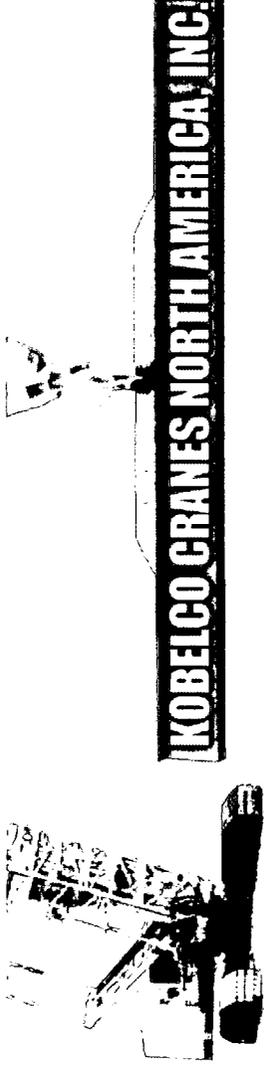
Bassam Ibrahim  
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Phone Number: 703.836.6620

**Domestic Representative**

BUCHANAN INGESOLL & ROONEY PC  
Phone Number: 703.836.6620

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# ATTACHMENT D



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## Lattice-Boom Crawler Cranes

### Lifting Your Operating Profit

Kobelco Cranes is a global leader in the manufacturing of hydraulic lattice-boom crawler cranes, servicing the North and South American markets.

The Kobelco lattice-boom crawler crane offers exceptional product value, quality and service and is unmatched in its ability to improve operating profitability for your business due to having the lowest cost of ownership in the market.

Over the life of the crane, Kobelco crane owners enjoy the cost-saving benefits of:

- Less Downtime – less repairs and replacing of parts over the lifetime of the crane
- Low Maintenance Costs – easiest machines in their class to maintain
- Lower Transportation Costs – lowest cost of transportation in the industry due to the design and configuration of the crane
- Crane design and configuration utilizes fewer trucks to transport the unit from one site to the next
- A counter self-handling system eliminates the need for an assist crane when assembling and disassembling

CK800-III CK850-III CK1000-III CK1600-III CK2000-III CK2500-III SL4500 SL6000

Max. Lift Capacity:  
80 US Tons  
Max. Boom Length:  
200 ft  
Max. Boom + Jib Length:  
180 ft + 60 ft

**MORE INFORMATION ▶**



**TRAINING VIDEO  
COMING SOON ▶**



Kobelco Lattice-Boom Crawler Crane Dealers

## **FOR SALES**

Kobelco distributes our lattice-boom crawler cranes through a network of regional crane specialist dealers selected for the high quality of their service, their ability to develop and sustain long-term business relationships and their integrity.

If a dealer is not available in your region, Kobelco will sell directly to the end user.

## **FOR SERVICE**

Kobelco has built its company based on a customer-centric culture. When you own a Kobelco crane, you are ensured a high level of customer support through our comprehensive and advanced service and support with expert diagnosis and repair on-site. You have access to parts, service, technical assistance and training 24/7 through our extensive network of Kobelco dealers.

Consider Kobelco when you need a lattice-boom crawler crane for your heavy power plant, alternative energy construction, large-scale petrochemical, refinery plants and tank farms, and expansive bridge building.

**DEALER LOCATOR** ▶

10845 Train Court • Houston, TX 77041  
Tel: 713-856-5755 • Fax: 713-856-9072

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[English](#) | [Español](#) | [Português](#)  
Design by: [Marion](#)

# **ATTACHMENT E**

PRODUCTS | PARTS & SERVICE | USED EQUIPMENT | NEWS | ABOUT US | CONTACT US | SHOP | FIND A DEALER

## News and Highlights

### Zero Tail Swing a Must at Metro General Services in Minneapolis, Minnesota

*"With the zero tail swing, wherever you can drive you can swing and work"*

The maneuverability of zero tail swing plays a big role in the daily routine of Metro General Services, a Minneapolis-St. Paul utility contractor. Metro's four crews operate three Kobelco zero-swing excavators plus a big Kobelco SK160 excavator.



If they can drive a zero-swing excavator into a tight location, it can work there, according to brothers Dale and Chuck Cazett, owners of Metro General.

"We're set up with good equipment and our crews are experienced," says Dale. For standard 50-foot connections, Metro crews do two and three jobs on a typical day.

Very detailed coordination enables them to work with some of the bigger homebuilders in the Twin Cities. Many job requests come in by e-mail and are integrated into complex building schedules.

"One of the keys is that we're able to react quickly," Dale says. "We have a six-by-ten foot erasable calendar on a wall in our shop to help us plan two weeks ahead. We get a file started when a customer calls us. We call in the utility locates, get the permits and then we put it on the schedule."

The Cazett brothers began working in utility construction in 1985. They purchased Metro General in 1995 from two brothers who were retiring. The deal included a pair of rubber-tired, tractor backhoes.

"They worked OK, but you could only swing from side to side," Dale recalls. They purchased a Kobelco 150 track hoe in 1998. "It was so much faster, so much more efficient. It was nice because you could put the dirt behind, on both sides. And it was easier to get in and do the job."

Their three zero-tail swing excavators today include the two Kobelco 135SRs and a Kobelco 70SR. "These machines range around 1,200 operating hours a year," he says. "They're working every day."

The 70SR is especially handy for tight areas and small jobs. Dale needed it for one of his first jobs in January 2005. The job was on a small lot near downtown Minneapolis.

"This house was being built on a side bank, probably 30 feet higher than the road. The road was almost at a 45-degree angle to the house. We got the machine up there, and used the blade to stabilize it as we came down the bank, digging in the sewer and water hookup," he says.

"It was perfect for the job because there was not a lot of room. With the zero tail swing, wherever you can drive you can swing and work."

The SR70 does a lot of rural septic systems, too, including drain fields and tank installation.

"Many of these lots are wooded, so you need a smaller machine in there. That SR70 works perfectly. With the zero tail swing, you don't have any overhang. It's fast, and the hydraulics are super fast. You can put on a good-sized 36-inch bucket. It has rubber tracks, so you can walk in over curbs and driveways that are already in place."

Metro's larger 135SR excavators have become the company's primary workhorses.

"To me, the 135SR is a unique machine," Dale says. "You don't have to worry about the overhang of the counterweight. Anywhere you can walk the machine into you can pretty much work. You can pull the boom up, so it spins inside the tracks. You lift it straight up in the air, turn and swing, but that's not all."

"To me, the hydraulics are so fast and so smooth it's like reaching out there with your arm and taking a handful of dirt and putting it where you want it - that's how smooth it is!"

For example, at least one of the 135SR excavators usually is at a townhouse project. A builder may have one townhouse with four to eight units only 20 feet away from a matching townhouse.

"When you've got a building on both sides, and only 15 or 20 feet where you can walk into, the 135SR is very convenient," Dale says. "When an area is that tight, and a lot of them are, the 135SR is the only machine for the job."

He's tried machines of similar size from two other manufacturers. "For the price, and the quality of the machine, there was just no comparison," he says.

Their biggest excavator, a 2003 Kobelco SK160, handles basement excavation for Metro and does the larger sewer and water jobs that often have deeper connections. It has more reach, and a bigger bucket, than the 135SR.

"Digging townhouses requires a lot of dirt moving," Dale says. "When you have a six or eight-unit townhouse project, and you dig one big hole for the foundation, that's a lot of dirt moving. The SK160's got good hydraulic response and a bigger bucket, so it makes a job go that much faster."

The Kobelco excavators have been reliable. His operators have preferred the Kobelco over other brands. Service from the Kobelco dealership has been good from the start.

He admits that, because they are so busy, keeping the service up to date can be a challenge. The dealership always seems to have a spare unit available.

"In predicaments, I've used a (spare) machine if I've had to get one in for service - there's not too many days that our machines aren't working. Our dealer has been a good partner."

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## News and Highlights

### Cut Through Solid Rock with Moss Construction in Wylie, Texas

#### Dallas excavators cut through rocks with Kobelco SK480

Trenching through solid rock is all in a day's work for Choya (RB) Barker, superintendent of an excavation crew for Moss Construction Company Inc. in Wylie, Texas.



It's hard on equipment and it's slow work Barker says. It took his crew five months to open a 12,000-foot trench and install a 60-inch water line between two small cities on the north side of Dallas. However, he expects to be moving on to a similar, and longer, job before 2004 ends. It's an \$8 million water project for the North Texas Municipal Water District, laying more than 30,000 feet of 42-inch pipe.

Moss Construction specializes in underground utilities --- water, sewer and storm sewer - in a 100-mile radius of the Dallas metroplex. When Hal Moss incorporated the company in 1989, the staff consisted of him and just two employees. Fifteen years later, it has pipe-laying crews (about 150 employees in total), 17 excavators and contracts for about \$30,000,000 in work to do.

The utility contractor's fleet of Kobelco excavators today includes five SK480s, two SK400s and two 135SRCL zero-swing excavators.

Moss's biggest project in 2004 was a \$4.3 million infrastructure project for the City of Greenville. It was a trunk sewer main with 36-inch and 48-inch pipe. "That was probably the deepest and most difficult job we've done. We were working on it for about a year," he says.

Whether it's trenching in rock or building a company, Moss says, "There's no real secret to it. We just keep hammering at it."

Barker had 13 workers and five excavators on the \$3.2 million Frisco-McKinney pipeline project for the North Texas Municipal Water District. They started at both ends in April and connected in the middle in September. The big poly-wrapped steel supply line averages 15 feet deep but plunges to 30 feet at some points.

The trenching sometimes had "good going" in dirt and sand. The crew could trench 600 feet on a day like that.

Other days, they were chipping through a blue stone that underlies the district. Bluestone is a variety of flagstone that is dense, hard and fine-grained.

"It's real hard," Barker says. "It's layered, but it doesn't break off in sheets. It chips out or breaks off in pieces. Some places, we'd have to cut through 20 feet of it. You might get 100 feet in a day."

To a layman, Barker explains, the deep trenching job "looks like a trench inside a trench." The excavator first digs a trench wide enough for itself to move into and work inside. Then it digs a second, lower trench for placing the pipe at whatever depth is needed. The lower trench usually is nine feet wide.

It's a technique required for laying the pipe in place safely. A steel trench box also is required for protecting crew members as they join pipe at the bottom of the trench.

Moss Construction uses twin "Tiger Teeth" on the bucket for trenching in rock. With the weight of the bucket and arm behind the two sharp points, eventually the stone gives way.

"You just keep cutting through it and cutting through it," Barker says. "You're just scraping it. You just keep digging and digging and it'll keep peeling off. It starts chipping away and next thing you know, you're at the bottom where you need to be.

"It's pretty tough. It'll wear your equipment down. You go through a lot of fuel when you're digging in that hard rock, and it's harder on the machine."

Barker has used both Cat and Kobelco excavators for this type of work over the past 10 years. He now prefers Kobelco.

"The Kobelco SK480 cuts rock as good as anything that I have ever used," he says. Moss Construction purchased the first Kobelco SK480 to arrive in the Dallas area in 2001. Today, they're gradually shifting over to Kobelco excavators.

The Kobelco SK480 excavator is the largest excavator that Kobelco offers in North America. It weighs about 110,000 pounds. It's a bit heavier than the Caterpillar 345 and 40,000 pounds lighter than Cat's 365.

Barker says, "Weight is important when you're digging in rock. The SK480 will cut and lift as much as a Cat 365 will. It's amazing that the SK480 will do as much as the Cat 365."

He had three SK480s and two Cat 345s on the Frisco-McKinney job. Two 480s had the 16-foot optional arm for deep trenching (to a maximum 30-foot depth) while the third had the standard 11-foot arm.

For lifting power and cutting speed, Barker says, there's no contest between the SK480 and the 345. "I've had them on the same jobs and had them dig side by side," he says. "You can put in two operators that are pretty equal and, in ordinary material, you can probably cut 100 feet more a day with the SK480 than with the 345."

Lifting and placing in a trench an 8 x 10-foot concrete box culvert is a good test for lifting power. When he needs the box culvert, he used the SK480 with the short stick to put it into position.

"The 345 won't budge it - I was real surprised when I saw that. What I was surprised at was when the 365 wouldn't pick it up with the long stick on it and the SK480 would—but the SK480 had a short stick on it. That makes a lot of difference in lifting power."

Reliability is a third factor that's important to Barker. "We work those backhoes, anywhere from 40 to 60 hours a week, year-round," he says. "Nothing goes wrong with those Kobelco machines. You don't blow hose and an O-ring. It's just an all-round great machine."

Reliability of crews and equipment goes hand-in-hand with being successful as the low bidder on municipal contracts. Kobelco machines are integral to that, says Moss.

"On a daily basis, a Kobelco excavator will out-perform a Caterpillar," says Moss. "A Kobelco just doesn't have that many mechanical problems. Any failures, or things like that, are very, very minimal. That's what we like."

"We want something that will dig every day. We work an average of 10 hours daily, easily five days a week and a lot of times six. We're probably pushing 3,000 hours a year on those machines."

Reliability from the dealership is at least as important as from the machine, and that's where Hal Moss believes the Kobelco name really shines.

"Their customer service at the Kobelco dealership is unbelievable," he says. "If something breaks down, whatever it is, they're there. They respond very quickly. They don't tell you it's going to be noon tomorrow or something. That's very hard to find, and that's one of the biggest reasons I'm fading Caterpillars out."

The Kobelco dealer responds to a call, almost always, the same day. The equipment may be fifty miles away but "they respond quicker than any other dealership I've ever used for construction equipment," Moss says.

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## News and Highlights

### Excavating with a Squeaky Clean Approach - Mathews Sewer System in Green Isle, Minnesota

*Mathews Sewer System in Green Isle, Minnesota, has built a thriving business by referrals from happy customers. Word gets around fast that they do a great job, and leave an exceptionally clean jobsite.*

Larry Mathews and his wife, Jan, launched their company, more than 30 years ago. Today, their son Sheldon has become the third crew member. Their Kobelco SK160LC is the latest in a long line of Kobelco equipment they've owned.



"We do mostly rural and town jobs, like digging basements, water and sewer systems," says Larry. Most of it is private work. As a secondary service they also have a truck for pumping out septic tanks.

"We've always had a reputation for the cleanliness and quality of our work," Jan says. That reputation has earned them the trust of faithful customers who pass along the Mathews name to friends and neighbors.

Larry says, "People get to know you over the years. Homeowners don't want dirt laying all over creation when you leave. We don't do things like that, although most of the contractors around here leave dirt all over the place!"

He adds, "The competition probably does it faster than we do, but they don't do as nice a job. When we're done putting in a septic mound, we put the sod on it. Most of them just get the work done as fast as they can. Slam, bang and they're gone. When they leave, the mound looks like the ocean on a windy day."

Replacing a private septic system takes some sensitivity to the customer's interests, Jan says. "Most contractors leave all the dirty leftover rock (from the previous system) laying someplace on the lawn - and the homeowner has to try to get rid of it. We clean it up, and that's not easy to do. We use a skid loader and a lot of handwork."

#### Zero tail swing compact excavator

Mathews Sewer Systems currently use two Kobelco machines for excavation work.

The Kobelco SK 45SR compact excavator was a perfect fit, they discovered, for work in a nearby village where 103 connections were needed for a new sewer service.

Larry says, "There were a lot of trees on the yards, and no place to stand. We used the big excavator out on the street, but there was no way we could have it up by the house. There just wasn't that kind of space.

"We use it a lot for digging up water lines. We do a lot of trenching, too. We'd do 600 to 700 hours a year on that one."

The rubber-track machine is only 77 inches wide and 9' 4" long. The zero-tail-swing feature allows the 45SR-2 to easily move and work in tight places without damage to the machine or the job site. The boom also can swing 58 degrees to the right and 73 degrees to the left, helping the operator dig around obstacles and against walls.

"You can dig right alongside a house! That is slick!" Larry says. "You can go straight down beside a basement wall, and still swing the dirt all the way up and all the way out because the back end won't hit the house.

"You can have the track right up to the house, move the boom over hydraulically to dig straight in front of the track, and still swing around. The back end does not go over the track base at all!"

The little excavator had other surprises for the veteran contractor. It didn't jerk him around.

"It's just the smoothest operating machine," Larry says. "There's no jerking. They're well balanced, and the back end is short. I don't know where they get the weight so they don't pull down or jerk up in the back, but they don't, not a bit!"

Dumping the dirt on an existing lawn still would have been messy. Mathews has avoided that potential problem, too. They brought in a dumpster on a skid loader and filled it as the hole and trench progressed. The job site stayed clean – and so did their reputation.

Three excavator companies offered services in that town that year. Larry says, "We did 67 jobs there. We could have done more."

#### **The big one**

For bigger work, like an 18-foot hole in the street or an 1,800-gallon concrete septic tank or a big basement on a narrow lot, Mathews relies on their Kobelco SK 160LC excavator. He's tested Kobelco's claim that nothing in its class out-lifts the SK 160LC, front or side. It's also a quiet, comfortable ride. Visibility is excellent and the controls are convenient to help reduce operator fatigue.

For sheer volume, he says, about ten "heaping scoops" with his 42" bucket on this machine will fill a 14-yard dump truck. As a loader, he says, it "does excellent work."

Sometimes, when he was putting in those 67 sewer lines, the connections at the street were 18 feet deep. The big excavator was just what he needed. It has a vertical wall digging depth of nearly 20 feet.

"Another thing we do with the SK160LC is to lift septic tanks into a hole for a septic system with an iron frame. Some of them are 12 feet long, six feet wide and six deep. We can pick up an 1,800-gallon tank, with the top on, and swing it right on in. The SK160LC doesn't have any problems at all with that," he says. "You're coming on the side with all the weight. That's about the smoothest machine there is."

Maximum lift capacity, on the side, is 8,100 pounds.

Digging wide basements on lots that are very, very narrow is one of the more challenging jobs, he adds. The site plan allows six feet between the property line and basement wall on each side. To provide workers access for laying blocks and tile, the hole must be two feet wider all around.

It's not beyond reach for the 36,000-pound excavator.

Its reach at ground is 30' 7" with the standard arm, and it has an industry-leading breakout force of 24,800 pounds.

"Those are pretty tight areas to work in, for a fairly good-sized machine," Larry says. Still, he stays inside the property line, gets the dirt out and leaves the site clean when he's finished.

#### **Good PR**

Having good relations with his customers and his equipment supplier still goes a long way in a fast-changing world.

Jan and Larry like the Kobelco line of excavators but their loyalty is to "the salesmen and the dealer." That's why they've been faithful to their Kobelco dealer for many years.

"I've had good luck. I've never had any major problems with Kobelco machines," says Larry. "The first year, they change the filters and if something isn't working quite right, they'll just bring another machine out and pick this one up and have it for a week or two. You have something to use and it doesn't cost you a dime. They were just out here, less than a month ago. They pulled the filters all the way, and the hydraulic oil. And, they're pretty clean guys."

Especially in the dirt business, Jan suggests, it's important to be clean. They clean and degrease machines on a weekly schedule.

"People like cleanliness," she says. "It means a lot to have clean equipment. The equipment is clean when we drive up to a place and it's clean when we leave."

Jan's secret for keeping the Mathews equipment looking new is old-fashioned – a coat of wax.

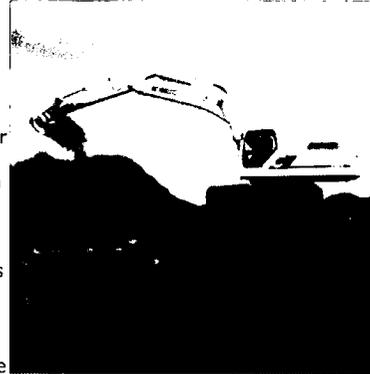
"It's a lot of fun, waxing one of those excavators," she says. "We wax the smaller ones before they come home. I try to wax the big ones about every two years, but I'm getting too old for this stuff. It takes two days, at least."

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## News and Highlights

### **Kobelco Excavators at Work on Arrowhead Stadium Expansion**

A Kobelco SK 330 excavator could be seen this summer hard at work at Kansas City's Arrowhead Stadium, home of the Chiefs football team. It was taking part in a major structural renovation project that foresees doubling the stadium's concourse space, additional concession stands, new suite, club and lounge areas, and a Hall of Fame to celebrate the team's past players and coaches.



Kobelco customer George Shaw Construction was contracted to carry out ground preparation work for the \$375 million project, which is scheduled for completion in 2010. The contractor, who runs a fleet of Kobelco excavators, dedicated an SK330 to complete this job, which required precision and high productivity.

For more information on the current line-up of Kobelco full-size excavators, please [click here](#).

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## News and Highlights

### Kobelco Excavators At Work On Fort Dix US Military Base Expansion

Kobelco customer Giberson Construction was contracted to carry out site preparation work for new housing on the Fort Dix military base in New Jersey. The entity of the project and tight schedule required equipment capable of ensuring the highest levels of productivity and Giberson brought in three Kobelco excavators to do the job: an SK350, a short-radius SK235SR, and the star spangled SK485 model that was on show on the Kobelco booth at this year's ConExpo show, and was later purchased by Giberson Construction.



New housing is required to accommodate military personnel following recent reorganization plans, which will bring to Fort Dix staff and troops from all major US military branches – Army, Navy, Air Force, Marines and Coast Guard. The house-building project foresees tearing down existing facilities to make room for 1,600 new homes for the additional military personnel to be housed at the base.

The Kobelco SK485 and SK350 excavators, made in Calhoun, GA, are making short work of all the jobs requiring large capacity and high precision, such as soil removal, leveling and pipe lining, while the short-radius SK235SR is carrying out the work that needs to be done in tight spaces.

"This build is a complex and large scale project, which will take three years to complete, so it is important to have all the site preparation work carried out efficiently and on time. Thanks to our Kobelco excavators, we are doing so well that we are three weeks ahead of schedule!" stated Larry Giberson, Vice President of Giberson Construction.

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## News and Highlights

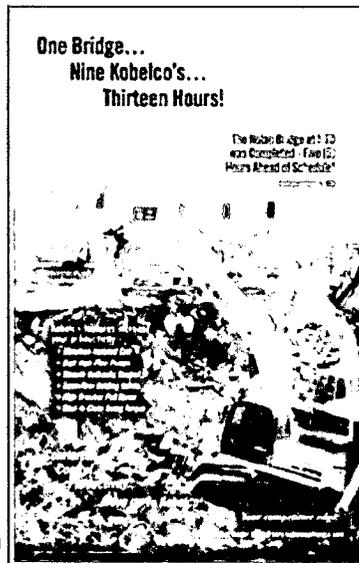
### Kobelco Excavators Prove Their Worth in Bridge Demolition

Contractor Greg Bair Track Hoe Service put their fleet of Kobelco excavators to the test in the demolition of the Nolan Road Bridge, west of Kansas City, Missouri. Time was of the essence: demolition of the four-lane interstate overpass, which started at 3 am on a Saturday had to be completed in 18 hours, before the Monday morning rush hour.

Greg Bair, founder and president of Greg Bair Track Hoe Service, decided to direct this operation himself, as the extreme time pressure on such a complex project required extra attention to coordination. He put his crew to work with twelve Kobelco excavators mounted with breakers, crushers, buckets and cutters, and the demolition was completed ahead of schedule by 3 am on Sunday morning.

"The Kobelco excavators gave an outstanding performance- even the brand new SK295 I had to bring to the job with less than 12 hours of break-in time!" stated Greg Bair. "I know I can always depend on them for the hardest jobs."

Greg Bair started his company in 1992 with one excavator. Over the years he has grown his business and today he runs a fleet of 21 Kobelco excavators ranging in from 15 tons to 40 tons.



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## News and Highlights

### **Kobelco SK 480 LC at work in Glory Park “frames” the new Dallas Cowboys stadium**

Kobelco customer Ark Contracting Services of Kennendale, Texas, have put 6 of their 14 Kobelco excavators hard at work in Glory Park, home of the Texas Rangers Ballpark and the new Dallas Cowboys stadium, currently in construction. As work on the stadium proceeds in the background, the Kobelco excavators are carrying out excavation work and heavy earth moving jobs for site preparation for the Glory Park Expansion – a \$500 million project which foresees channeling Johnson Creek and the construction of a new sewer. Ark Contracting’s fleet of Kobelco excavators is serviced by their dealer, Bane Machinery, which has been serving Texas for over forty years from their family-owned dealership in Dallas.



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# **ATTACHMENT F**

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

In re Application Serial Nos. 79/023,935 and 79/023,934  
Published: August 7, 2007  
Applicant: Kobelco Construction Machinery Co., Ltd.  
Mark: GEOSPEC and ACERA GEOSPEC (and design)  
Filed: March 30, 2006

PLASTI-FAB LTD.,

Opposer,

vs.

KOBELCO CONSTRUCTION MACHINERY  
CO., LTD,

Applicant.

Opposition No. 91179480 (parent)  
Opposition No. 91179482

**OPPOSER'S FIRST REQUESTS FOR PRODUCTION OF DOCUMENTS (1-28)**

Opposer Plasti-Fab Ltd. ("Opposer"), by counsel, requests that Applicant Kobelco Construction Machinery Co., Ltd. ("Applicant") produce for inspection and copying the documents listed below, at the offices of Applicant's counsel, Townsend and Townsend and Crew LLP, 1200 Seventeenth Street, Suite 2700, Denver, Colorado 80202, within thirty (30) days of the date of service hereof, or at such other time and place as may be mutually agreed upon by the parties, in accordance with Rule 2.120 of the Trademark Rules of Practice and Rules 26 and 34 of the Federal Rules of Civil Procedure.

**INSTRUCTIONS AND DEFINITIONS**

A. Opposer hereby incorporates by reference the Instructions and Definitions set forth in Opposer's First Set of Interrogatories (Nos. 1-29).

B. If Applicant is aware, with respect to any Request, that any responsive document once existed but has been destroyed, Applicant should describe the document, identify who destroyed it, why it was destroyed, and the date and circumstances under which it was destroyed.

C. The term "concerning" means referring to, relating to, containing, embodying, mentioning, evidencing, constituting or describing.

**REQUESTS FOR PRODUCTION OF DOCUMENTS**

**REQUEST NO. 1**

All documents that Applicant was required to identify or did identify in its response to Opposer's First Set of Interrogatories to Applicant.

**REQUEST NO. 2**

All documents evidencing the transfer, assignment or licensing of Applicant's Marks, or use of Applicant's Marks as security or collateral, from the date of first adoption and use of Applicant's Marks to the present.

**REQUEST NO. 3**

All documents on which Applicant intends to rely in this Opposition proceeding, including, but not limited to, all exhibits and documents Applicant may use for impeachment.

**REQUEST NO. 4**

All documents concerning the acquisition, selection, availability, adoption, creation, design, proposal to use or attempt to register Applicant's Marks, including, but not limited to, documents concerning any investigation to determine the availability of Applicant's Marks.

**REQUEST NO. 5**

Representative documents showing the manner in which Applicant's Marks have been displayed or used, including, but not limited to, advertisements, product packaging, signs, brochures, posters, stationary, business cards, promotional materials, contracts, decals, labels, badges, mail order solicitations, billing and order forms, computer software, pages or sites on the Internet's world wide web, and computer screens or screen printouts.

**REQUEST NO. 6**

Documents sufficient to show the formation or organizational structure of Applicant's business and any predecessor-in-interest that owned Applicant's Marks, including, but not limited to, articles of incorporation or articles of organization and any amendments thereto, and any written operating agreements and amendments thereto.

**REQUEST NO. 7**

Documents sufficient to explain or describe Applicant's Goods and Services, including, but not limited to, advertisements, brochures, fliers, sales tools, catalogs, order forms, price lists, training materials, memoranda and bulletins.

**REQUEST NO. 8**

All documents concerning any searches, studies, distinctiveness surveys, likelihood of confusion surveys, market studies, focus group studies or other surveys or studies performed by

or for Applicant in connection with the availability, selection, creation, acquisition, evaluation of strength or weakness, valuation, protection or defense of Applicant's Marks.

**REQUEST NO. 9**

Documents sufficient to describe the geographic scope of the use of Applicant's Marks.

**REQUEST NO. 10**

All documents concerning the first use of Applicant's Marks (a) in commerce and (b) in interstate commerce, including, but not limited to, representative documents depicting such use of Applicant's Marks, the date and location of such use, and the identities of all Persons with knowledge of such use.

**REQUEST NO. 11**

All documents concerning any state or federal trademark registration or application to register Applicant's Marks.

**REQUEST NO. 12**

Representative documents showing any state or county corporate, partnership, company name or assumed name filing by Applicant that incorporates "GEOSPEC."

**REQUEST NO. 13**

All documents concerning any policy relating to the use, display, or promotion of Applicant's Marks or the goods or services offered under Applicant's Marks.

**REQUEST NO. 14**

All documents from or to any advertising or other outside agency or service used in developing or placing advertisements for Applicant's Goods or Services.

**REQUEST NO. 15**

All documents evidencing the ownership or a right to use Applicant's Marks, including without limitation partnership agreements, distributor agreements, marketing agreements, assignments, licenses, security agreements, settlements, consent agreements, or any other form of agreement, whether pertaining to Applicant, any predecessor-in-interest, or any other party.

**REQUEST NO. 16**

All documents concerning any instance of misdirected (i) mail, (ii) email, (iii) telephone calls or (iv) other communications or inquiries, including via the Internet, or other instances wherein any person may have been confused or mistaken regarding the source of the goods or services associated with the Applicant's Marks, Opposer's Mark, or any mark substantially similar to either.

**REQUEST NO. 17**

Documents sufficient to show the amount of revenue received by Applicant (a) for all of Applicant's Goods and Services and (b) for each different type of such good or service on an annual basis, for each year since Applicant's Marks were first used.

**REQUEST NO. 18**

Documents sufficient to show the dollar amount of advertising and promotional expenditures, on an annual basis, for each year since Applicant's Marks were first used, (a) for all of Applicant's Goods and Services and (b) for each particular such good or service, including, but not limited to, construction related products and services.

**REQUEST NO. 19**

Documents sufficient to show the publication of Applicant's Marks in any media, whether such media is electronic (*e.g.*, Internet) or conventional (*e.g.*, paper), including, but not limited to, publications at tradeshow, magazines, and trade journals.

**REQUEST NO. 20**

Documents sufficient to show any periods of non-use of Applicant's Marks in connection with any of Applicant's Goods and Services, from the date of first use to the present.

**REQUEST NO. 21**

Documents sufficient to show any resumption of use of Applicant's Marks that followed any period of nonuse identified in the documents responsive to Request No. 20.

**REQUEST NO. 22**

Documents sufficient to show any third-party use, application or registration of a trade name, trademark or service mark incorporating "GEOSPEC" or a term similar thereto for the time period from May 6, 2004, to the present.

**REQUEST NO. 23**

All documents concerning any objection, challenge, proceeding, dispute or litigation between Applicant (or any predecessor-in-interest) and any third party concerning a mark containing the element "GEOSPEC."

**REQUEST NO. 24**

Documents sufficient to show Applicant's past, present and future marketing plans for Applicant's Goods and Services.

**REQUEST NO. 25**

All documents concerning Opposer or Opposer's use of Opposer's Mark including, but not limited to, documents reflecting the date or circumstances of Applicant's first awareness of (i) Opposer and (ii) Opposer's Mark.

**REQUEST NO. 26**

All documents relied upon as a basis for each opinion by all experts whom Applicant intends to call as witnesses in this action, or from whom Applicant has obtained or may obtain any statements, affidavits or declarations relevant to this action.

**REQUEST NO. 27**

Documents sufficient to show or describe the potential or actual customers or end-users of Applicant's Goods and Services.

**REQUEST NO. 28**

Documents sufficient to show the channels of distribution of Applicant's Goods or Services.

Dated: September 2, 2008

TOWNSEND AND TOWNSEND AND CREW LLP



David. E. Sipiora  
Shelley B. Mixon

1200 Seventeenth Street, Suite 2700  
Denver, CO 80202  
(303) 571-4000  
(303) 571-4321 (fax)

Attorneys for Opposer Plasti-Fab Ltd.

**CERTIFICATE OF SERVICE**

I hereby certify that on this 2nd day of September 2008, a true and correct copy of the foregoing **APPLICANT'S FIRST REQUEST FOR PRODUCTION OF DOCUMENTS (1-28)** was served by placing the same in the United States mail, postage prepaid and addressed to the following:

Bassam N. Ibrahim  
Bryce J. Maynard  
Buchanan Ingersoll PC  
1737 King Street  
Suite 500  
Alexandria, VA 22314-2727

*Attorneys for Applicant Kobelco Construction Machinery Co., Ltd.*

Carrie M. O'Connell

61463003 v3

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

In re Application Serial Nos. 79/023,935 and 79/023,934  
Published: August 7, 2007  
Applicant: Kobelco Construction Machinery Co., Ltd.  
Mark: GEOSPEC and ACERA GEOSPEC (and design)  
Filed: March 30, 2006

PLASTI-FAB LTD.,

Opposer,

vs.

KOBELCO CONSTRUCTION  
MACHINERY CO., LTD,

Applicant.

Opposition No. 91179480 (parent)  
Opposition No. 91179482

**OPPOSER'S FIRST SET OF INTERROGATORIES (Nos. 1-29)**

Opposer Plasti-Fab Ltd. ("Opposer") propounds the following written interrogatories ("Interrogatories") to be fully and separately answered in writing, under oath, by an officer or duly authorized agent of Kobelco Construction Machinery Co., LTD ("Applicant"), within thirty (30) days of the date of service hereof, or at such other time and place as may be mutually agreed upon by the parties, in accordance with Rule 2.120 of the Trademark Rules of Practice and Rules 26 and 33 of the Federal Rules of Civil Procedure.

## INSTRUCTIONS AND DEFINITIONS

A. These Interrogatories seek answers as of the date on which Applicant responds and, as to those Interrogatories addressed to matters falling within Rules 26(e)(1) and (2) of the Federal Rules of Civil Procedure, shall be deemed to be continuing, requiring Applicant to serve upon Opposer such further answers promptly after Applicant has acquired additional knowledge or information relating in any way to those interrogatories.

B. Where the interrogatories request the identity of:

1. a person, state the name and current or last known address of each person, employer or business affiliation, and occupation and business position held;

2. a company, state the name, place of incorporation or organization, principal place of business, and the identity of the persons having knowledge of the matter with respect to which the company is named;

3. a document, state:

- a) the identity of the person or persons who prepared it, the sender and recipient, if any;
- b) the title or a description of the general nature of its subject matter;
- c) the date of preparation;
- d) the date and manner of distribution and publication, if any;
- e) the location of each copy and the identity of the present custodian;
- f) the identity of the person or persons who can identify it;
- g) the contents of the document verbatim (or, in lieu thereof, a copy of the document); and

- h) if privilege is claimed, the specific basis for the claim;
- 4. an act or event, state:
  - a) a description of the act or event;
  - b) when it occurred;
  - c) where it occurred;
  - d) the identity of the person or persons performing said act (or, in case of an omission, the identity of the person or persons failing to act) or involved in said event;
  - e) the identity of all persons who have knowledge, information or belief about the act;
  - f) when the act, event or omission first became known; and
  - g) the circumstances and manner in which such knowledge was first obtained.

C. To the extent that Applicant has any objection to answering any of the Interrogatories or producing responsive documents on the basis that the requested information or responsive documents are privileged or otherwise protected by the attorney-client privilege or work-product immunity, Applicant is requested to identify the subject matter and date of the information or document; identify the person who authored the information or documents; identify each person who ever received or had access to the information or document, or a copy thereof; identify the person or persons who presently have custody of the information or document; and state the basis of the alleged privilege or work-product immunity.

J

D. The term "document" encompasses all items subject to discovery within the scope of Rule 34 of the Federal Rules of Civil Procedure and includes, without limitation, the following items, whether printed, or recorded, or filmed, or reproduced by any process, or written or produced by hand, and whether or not claimed to be privileged against discovery on any ground, and whether original, master or copy; whether printed or stored on any medium, including audiotape, videotape, CD-ROM, CD-RW, floppy disk, zip disk, hard disk, memory chip, servers, or via any other electronic or magnetic means of storage, including without limitation: agreements; communications, including intra-company communications and correspondence; electronic mail, voice mail, faxes, cablegrams, radio-grams and telegrams; notes and memoranda; summaries, minutes and records of telephone conversations, meetings and conferences, including lists of persons attending meetings or conferences; summaries and records of personal conversations or interviews; books, manuals, publications and diaries; laboratory and engineering reports and notebooks; charts; plans; sketches and drawings; photographs; reports and/or summaries of investigations and/or surveys; opinions and reports of consultants; opinions of counsel; reports and summaries of negotiations; brochures; pamphlets, catalogs and catalog sheets; advertisements, including storyboard and/or scripts for radio or television commercials; circulars; trade letters; press publicity and trade and product releases; drafts of original or preliminary notes on, and marginal comments appearing on, any document; and any other information-containing paper, writing or physical thing; letters, notes, memoranda, records, minutes, bills, contracts, agreements, orders, receipts, drawings, sketches, advertising or promotional literature, operating manuals, instruction bulletins, test data, and reports, and each version thereof.

E. "Referring or relating to" means comprising, concerning, relating to, pertaining to, referring to or in any way relevant within the meaning of Rule 26(b)(1) of the Federal Rules of Civil Procedure.

F. "Communication(s)" when used in these Interrogatories includes the disclosure, transfer, or exchange of information by any means, written, verbal, electronic, or otherwise.

G. "And," or "or" or "and/or" shall be construed conjunctively or disjunctively as necessary to make the request inclusive rather than exclusive.

H. "Date" means the exact day, month, and year, if ascertainable and, if not, Applicant's best approximation thereof.

I. "Applicant" means Kobelco Construction Machinery Co., LTD., all predecessors or successors-in-interest, all predecessor or successor owners of U.S. Trademark Application Serial Nos. 79/023,935 and 79/023,934 and/or Applicant's Marks, as defined in paragraph K below, and the officers, employees, attorneys, agents, consultants and representatives of all such entities. Absent contrary express notice, it is understood and anticipated that all answers and responses to these Interrogatories and to Opposer's First Request for Production of Documents will include information and documents from and pertaining to all such predecessor and successor entities.

J. "Person(s)" means both natural persons, living or deceased, and to corporate or other business entities, whether or not in the employ of Applicant, and the acts and knowledge of a person are defined to include the acts and knowledge of a corporate or other business entity "person's" directors, officers, members, employees, representatives, agents, and attorneys.

K. "Applicant's Marks" or the "Marks" means the marks which are the subject matter of U.S. Trademark Application Serial Nos. 79/023,935 and 79/023,934 whether used as a trademark, service mark, trade name, or corporate name, either alone or in association with other words or designs.

L. "Opposer's Mark" means the mark which is the subject of U.S. Trademark Registration No. 3,385,301.

M. "Applicant's Goods and Services" means the goods and services identified by Applicant in response to Interrogatory No. 1.

### **INTERROGATORIES**

#### **INTERROGATORY NO. 1**

Identify and describe all of the goods and/or services Applicant has sold, is currently selling, or intends to sell, under Applicant's Marks. The identified goods and services shall hereinafter be referred to as "Applicant's Goods and Services."

#### **INTERROGATORY NO. 2**

Identify all Persons affiliated with Applicant who have any knowledge concerning the following issues:

- (a) the adoption of Applicant's Marks;
- (b) Applicant's knowledge of Opposer's Mark;
- (c) the sale of Applicant's Goods and Services;
- (d) the advertising of Applicant's Goods and Services;
- (e) the trade channels through which Applicant's Goods and Services travel;
- (f) any actual confusion between Applicant's Marks and Opposer's Mark;

- (g) the alleged likelihood of confusion between Applicant's Marks and Opposer's Mark.

**INTERROGATORY NO. 3**

State the date when Applicant first became aware of Opposer's Mark, and identify all facts relating thereto.

**INTERROGATORY NO. 4**

Describe all facts relating to the adoption of Applicant's Marks by Applicant.

**INTERROGATORY NO. 5**

To the extent Applicant claims to have acquired any rights in Applicant's Marks through any predecessor-in-interest, describe the facts pertaining to said acquisition.

**INTERROGATORY NO. 6**

Describe with particularity any searches or surveys performed on Applicant's behalf in connection with the Applicant's Marks or Opposer's Mark.

**INTERROGATORY NO. 7**

Describe with particularity the date and circumstances of first use of Applicant's Marks in connection with Applicant's Goods and Services (a) in commerce of any sort and (b) in interstate commerce.

**INTERROGATORY NO. 8**

Identify all federal and state trademark registration(s) or application(s) filed and/or obtained on behalf of Applicant for marks that include "GEOSPEC" and describe in detail the status of each application or registration.

**INTERROGATORY NO. 9**

Describe any policy Applicant has regarding the use of Applicant's Marks.

**INTERROGATORY NO. 11**

Describe all instances of actual confusion between Applicant's Marks and Opposer's Mark.

**INTERROGATORY NO. 12**

Identify, on an annual basis for each year since Applicant's Marks were first used, the amount of revenue received by Applicant for each of Applicant's Goods and Services.

**INTERROGATORY NO. 13**

Identify, on an annual basis for each year since Applicant's Marks were first used, the dollar amount of advertising and promotional expenditures for each of Applicant's Goods and Services.

**INTERROGATORY NO. 14**

Identify all advertising methods used by Applicant in advertising Applicant's Goods and Services.

**INTERROGATORY NO. 15**

Identify all web sites that are operated on behalf of Applicant that display or use Applicant's Marks in any way.

**INTERROGATORY NO. 16**

Identify the geographical areas, by city, county, region and state as applicable, in which Applicant's Goods and Services are currently being offered for sale under Applicant's Marks

and, for each area, identify all such goods or services and the date on which they were first offered for sale.

**INTERROGATORY NO. 17**

Describe the channels of trade through which Applicant offers Applicant's Goods and Services.

**INTERROGATORY NO. 18**

Identify at least ten (10) representative customers to whom Applicant has sold Applicant's Goods and Services, including one or more representatives of each class of customers to whom Applicant markets or offers Applicant's Goods and Services.

**INTERROGATORY NO. 19**

Describe in detail the facts relating to any periods of non-use of Applicant's Marks in connection with any of Applicant's Goods and Services.

**INTERROGATORY NO. 20**

Identify and explain in detail any formal or informal objections that Applicant has ever received in connection with its use of Applicant's Marks.

**INTERROGATORY NO. 21**

Describe all oral or written agreements entered into by Applicant referring or relating to Applicant's Marks, including without limitation, partnerships, distributorships, marketing agreements, assignments, licenses, security agreements, or agreements settling disputes.

**INTERROGATORY NO. 22**

Identify all experts with whom Applicant has consulted or who Applicant intends to call as witnesses in this action and state the subject matter on which each expert is expected to testify.

**INTERROGATORY NO. 23**

Identify all fact or percipient witnesses who Applicant may call or will call in this action, and state the subject matter on which each individual is expected to testify.

**INTERROGATORY NO. 24**

Identify any instances in which Applicant's Goods and Services were offered for sale in the same trade channel as goods and services sold under Opposer's Mark.

**INTERROGATORY NO. 25**

Identify all other uses of which Applicant is aware of the term "GEOSPEC" by any third party in relation to goods and services used in the construction industry for the time period from May 6, 2004 to the present.

**INTERROGATORY NO. 26**

Identify each instance in which Applicant has asserted that a third party's use of any mark incorporating the element "GEOSPEC" is likely to result in confusion as to the source of the goods or services offered by that party and any of Applicant's Goods and Services.

**INTERROGATORY NO. 27**

Identify each instance in which Applicant has asserted that a third party's use of any mark incorporating the element "GEOSPEC" is likely to dilute or has diluted Applicant's Marks.

INTERROGATORY NO. 28

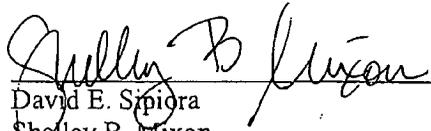
Identify all lawsuits or administrative proceedings, if any, past or present, regarding Opposer's Marks.

INTERROGATORY NO. 29

Identify all facts that Applicant believes supports Applicant's contention in paragraph 1 of the "Affirmative Defenses" section of Applicant's answers to Opposer's Notice of Opposition that there is no likelihood of confusion between Opposer's Mark and Applicant's Marks.

Dated: September 2, 2008

TOWNSEND AND TOWNSEND AND CREW LLP

  
\_\_\_\_\_

David E. Spigora

Shelley B. Mixon

1200 Seventeenth Street, Suite 2700

Denver, CO 80202

(303) 571-4000

(303) 571-4321 (fax)

Attorneys for Opposer Plasti-Fab LTD.

**CERTIFICATE OF SERVICE**

I hereby certify that on this 2nd day of September 2008, a true and correct copy of the foregoing **OPPOSER'S FIRST SET OF INTERROGATORIES (Nos. 1-29)** was served by placing the same in the United States mail, postage prepaid and addressed to the following:

Bassam N. Ibrahim  
Bryce J. Maynard  
Buchanan Ingersoll PC  
1737 King Street  
Suite 500  
Alexandria, VA 22314-2727

Attorneys for Applicant Kobelco Construction Machinery Co., Ltd.

Carrie M. O'Leary

61462866 v3

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

In re Application Serial Nos. 79/023,935 and 79/023,934  
Published: August 7, 2007  
Applicant: Kobelco Construction Machinery Co., Ltd.  
Mark: GEOSPEC and ACERA GEOSPEC (and design)  
Filed: March 30, 2006

PLASTI-FAB LTD.,

Opposer,

v.

KOBELCO CONSTRUCTION MACHINERY  
CO., LTD,

Applicant.

Opposition No. 91179480 (parent)

Opposition No. 91179482

**OPPOSER'S FIRST SET OF REQUESTS FOR ADMISSION (NOS. 1- 20)**

Opposer Plasti-Fab Ltd. ("Opposer"), by counsel, propounds the following requests for admission ("RFAs") to be fully and separately answered in writing by an officer or duly authorized agent of Applicant Kobelco Construction Machinery Co., Ltd. ("Applicant"), within thirty (30) days of the date of service hereof, or at such other time and place as may be mutually agreed upon by the parties, in accordance with Rule 2.120 of the Trademark Rules of Practice and Rules 26 and 36 of the Federal Rules of Civil Procedure.

**INSTRUCTIONS AND DEFINITIONS**

A. These RFAs seek answers as of the date on which Applicant responds and, as to those RFAs addressed to matters falling within Rules 26(e)(1) and (2) of the Federal Rules of Civil Procedure, shall be deemed to be continuing, requiring Applicant to serve upon Opposer such further answers promptly after Applicant has acquired additional knowledge or information relating in any way to those RFAs.

B. Where the RFAs request the identity of:

1. a person, state the name and current or last known address of each person, employer or business affiliation, and occupation and business position held;

2. a company, state the name, place of incorporation or organization, principal place of business, and the identity of the persons having knowledge of the matter with respect to which the company is named;

3. a document, state:

a) the identity of the person or persons who prepared it, the sender and recipient, if any;

b) the title or a description of the general nature of its subject matter;

c) the date of preparation;

d) the date and manner of distribution and publication, if any;

e) the location of each copy and the identity of the present custodian;

f) the identity of the person or persons who can identify it;

g) the contents of the document verbatim (or, in lieu thereof, a copy of the document); and

- h) if privilege is claimed, the specific basis for the claim;
4. an act or event, state:
- a) a description of the act or event;
  - b) when it occurred;
  - c) where it occurred;
  - d) the identity of the person or persons performing said act (or, in case of an omission, the identity of the person or persons failing to act) or involved in said event;
  - e) the identity of all persons who have knowledge, information or belief about the act;
  - f) when the act, event or omission first became known; and
  - g) the circumstances and manner in which such knowledge was first obtained.

C. "Referring or relating to" means comprising, relating to, pertaining to, referring to or in any way relevant within the meaning of Rule 26(b)(1) of the Federal Rules of Civil Procedure.

D. To the extent that Applicant has any objection to answering any of the RFAs or producing responsive documents on the basis that the requested information or responsive documents are privileged or otherwise protected by the attorney-client privilege or work-product immunity, Applicant is requested to identify the subject matter and date of the information or document; identify the person who authored the information or documents; identify each person who ever received or had access to the information or document, or a copy thereof; identify the person or persons who presently have custody of the information or document; and state the basis of the alleged privilege or work-product immunity.

E. If Applicant is aware, with respect to any Interrogatory, or any Request listed in Opposer's First Request for Production of Documents served herewith, or any subsequent Interrogatory or Document Request that may be served on Applicant in this proceeding, that any responsive document once existed but has been destroyed, please identify the document, who destroyed it, why it was destroyed, and the date and circumstances under which it was destroyed.

F. Each matter of which an admission is requested will be deemed admitted pursuant to Federal Rule of Civil Procedure 36(a) unless a written answer or objection is served within 30 days of service of these requests.

G. All objections to individual requests for admission shall specifically state the reasons for the objections.

H. Answers to individual requests for admission shall specifically admit the matter, specifically deny the matter, or set forth in detail the reasons why the matter cannot be truthfully admitted or denied.

I. When good faith requires that you qualify your answer or deny only part of the matter for which an admission is requested, you must specify those portions of the request which you admit, and qualify or deny the remainder.

J. You may not give lack of information or knowledge as a reason for failure to admit or deny a particular request for admission unless you have made reasonable inquiry into the matter which is the subject of the request for admission and unless the information known or readily available to you is insufficient to enable you to admit or deny the matter and your answer so states.

K. If you believe that a matter for which an admission is requested presents a genuine issue for trial, you may not, on that ground alone, object to that request for admission.

L. With respect to each written response to these requests for admission, please restate each request immediately before your written response to that request.

M. Opposer incorporates herein by reference the definitions set forth in *Opposer's First Set of Interrogatories*.

**REQUESTS FOR ADMISSION**

1. Admit that the term "GEOSPEC" is not found in a dictionary.
2. Admit that Opposer provides construction related goods under Opposer's Mark.
3. Admit that you have no knowledge that the mark GEOSPEC is used in association with any good and/or services other than the goods and services provided by Opposer.
4. Admit that Opposer has used Opposer's Mark for over four years in association with construction related goods.
5. Admit that the term "GEOSPEC" has no common meaning in the English language.
6. Admit that Applicant is providing or intends to provide construction related goods under Applicant's Marks.
7. Admit that the term "GEOSPEC" has no meaning other than as trademark used by Opposer in association with the goods and services provided by Opposer.
8. Admit that the filing dates of the federal trademark applications for Opposer's Mark and the registration dates based on those applications predate the filing date of U.S. Trademark Application Serial Nos. 79/023,934 and 79/023,935 for Applicant's Marks.

9. Admit that Opposer's Mark is used in association with construction related goods in the United States.

10. Admit that the public has come to associate Opposer's Mark as a source of high quality construction related goods.

11. Admit that you are not aware of anyone other than Opposer who uses the mark "GEOSPEC."

12. Admit that there are no federal trademark registrations for the term "GEOSPEC" other than that owned by Opposer.

13. Admit that Opposer has not in any way authorized Applicant's use of Opposer's Mark for the goods set forth in U.S. Trademark Application Serial Nos. 79/023,934 and 79/023,935.

14. Admit that consumers of Applicant's Goods and Services are consumers of construction related materials.

15. Admit that "GEOSPEC" is a unique word and not a common word.

16. Admit that Opposer's Mark is distinctive.

17. Admit that the construction related goods provided by Opposer and the construction related goods intended to be provided by Applicant will be provided to persons or entities in the same industry.

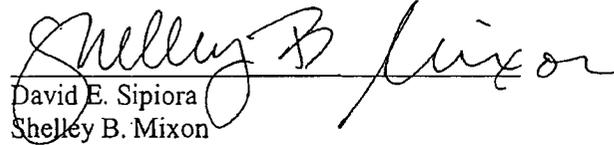
18. Admit that the word portions of all of Applicant's Marks and Opposer's Mark begin with "GEOSPEC."

19. Admit that the construction related goods provided by Opposer and the construction related goods provided by, or that are intended to be provided by, Applicant are provided to consumers through the same channels of trade.

20. Admit that Applicant provides or intends to provide construction related goods under Applicant's Marks.

Dated: September 2, 2008

TOWNSEND AND TOWNSEND AND CREW LLP



David E. Sipiora  
Shelley B. Mixon

1200 Seventeenth Street, Suite 2700  
Denver, CO 80202  
(303) 571-4000  
(303) 571-4321 (fax)

Attorneys for Opposer Plasti-Fab Ltd.

**CERTIFICATE OF SERVICE**

I hereby certify that on this 2nd day of September 2008, a true and correct copy of the foregoing **OPPOSER'S FIRST SET OF REQUESTS FOR ADMISSION** was served by placing the same in the United States mail, postage prepaid and addressed to the following:

Bassam N. Ibrahim  
Bryce J. Maynard  
Buchanan Ingersoll PC  
1737 King Street  
Suite 500  
Alexandria, VA 22314-2727

Attorneys for Applicant Kobelco Construction Machinery Co., Ltd.

  
\_\_\_\_\_

# **ATTACHMENT G**



**RESPONSE TO REQUEST FOR ADMISSION NO. 2**

Applicant lacks sufficient information to form a belief as to Request No. 2 and therefore denies the same.

3. Admit that you have no knowledge that the mark GEOSPEC is used in association with any good and/or services other than the goods and services provided by Opposer.

**RESPONSE TO REQUEST FOR ADMISSION NO. 3**

Denied.

4. Admit that Opposer has used Opposer's Mark for over four years in association with construction related goods.

**RESPONSE TO REQUEST FOR ADMISSION NO. 4**

Applicant lacks sufficient information to form a belief as to Request No. 4 and therefore denies the same.

5. Admit that the term "GEOSPEC" has no common meaning in the English language.

**RESPONSE TO REQUEST FOR ADMISSION NO. 5**

Applicant lacks sufficient information to form a belief as to Request No. 5 and therefore denies the same.

6. Admit that Applicant is providing or intends to provide construction related goods under Applicant's Marks.

**RESPONSE TO REQUEST FOR ADMISSION NO. 6**

Applicant admits that it has applied for the mark GEOSPEC for the goods claimed in Applicant's applications that are the subject of these oppositions.

7. Admit that the term "GEOSPEC" has no meaning other than as trademark used by Opposer in association with the goods and services provided by Opposer.

**RESPONSE TO REQUEST FOR ADMISSION NO. 7**

Denied.

8. Admit that the filing dates of the federal trademark applications for Opposer's Mark and the registration dates based on those applications predate the filing date of U.S. Trademark Application Serial Nos. 79/023,934 and 79/023,935 for Applicant's Marks.

**RESPONSE TO REQUEST FOR ADMISSION NO. 8**

Admitted that the dates in the applications that are the subject of this request speak for themselves.

9. Admit that Opposer's Mark is used in association with construction related goods in the United States.

**RESPONSE TO REQUEST FOR ADMISSION NO. 9**

Applicant lacks sufficient information to form a belief as to Request No. 9 and therefore denies the same.

10. Admit that the public has come to associate Opposer's Mark as a source of high quality construction related goods.

**RESPONSE TO REQUEST FOR ADMISSION NO. 10**

Denied.

11. Admit that you are not aware of anyone other than Opposer who uses the mark "GEOSPEC."

**RESPONSE TO REQUEST FOR ADMISSION NO. 11**

Denied.

12. Admit that there are no federal trademark registrations for the term "GEOSPEC" other than that owned by Opposer.

**RESPONSE TO REQUEST FOR ADMISSION NO. 12**

Applicant lacks sufficient information to form a belief as to Request No. 12 and therefore denies the same.

13. Admit that Opposer has not in any way authorized Applicant's use of Opposer's Mark for the goods set forth in U.S. Trademark Application Serial Nos. 79/023,934 and 79/023,935.

**RESPONSE TO REQUEST FOR ADMISSION NO. 13**

Applicant lacks sufficient information to form a belief as to Request No. 13 and therefore denies the same.

14. Admit that consumers of Applicant's Goods and Services are consumers of construction related materials.

**RESPONSE TO REQUEST FOR ADMISSION NO. 14**

Denied.

15. Admit that "GEOSPEC" is a unique word and not a common word.

**RESPONSE TO REQUEST FOR ADMISSION NO. 15**

Denied.

16. Admit that Opposer's Mark is distinctive.

**RESPONSE TO REQUEST FOR ADMISSION NO. 16**

Denied.

17. Admit that the construction related goods provided by Opposer and the construction related goods intended to be provided by Applicant will be provided to persons or entities in the same industry.

**RESPONSE TO REQUEST FOR ADMISSION NO. 17**

Denied.

18. Admit that the word portions of all of Applicant's Marks and Opposer's Mark begin with "GEOSPEC."

**RESPONSE TO REQUEST FOR ADMISSION NO. 18**

Applicant lacks sufficient information to form a belief as to Request No. 18 and therefore denies the same.

19. Admit that the construction related goods provided by Opposer and the construction related goods provided by, or that are intended to be provided by, Applicant are provided to consumers through the same channels of trade.

**RESPONSE TO REQUEST FOR ADMISSION NO. 19**

Denied.

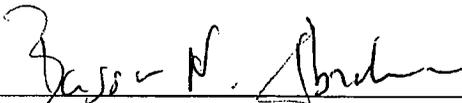
20. Admit that Applicant provides or intends to provide construction related goods under Applicant's Marks.

**RESPONSE TO REQUEST FOR ADMISSION NO. 20**

Applicant admits that it has applied for the marks in U.S. Application Nos. 79/023,934 and 79/023,935 for the goods claimed therein.

Respectfully submitted,

KOBELCO CONSTRUCTION  
MACHINERY LTD.

By   
Bassam N. Ibrahim  
Bryce J. Maynard  
Attorneys for Opposer

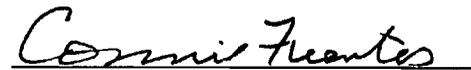
Date: 4/9/09

BUCHANAN INGERSOLL & ROONEY PC  
1737 King Street  
Alexandria, VA 22314-2727  
Telephone: 703/836-6620  
Facsimile: 703/836-2021

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing **KOBELCO CONSTRUCTION MACHINERY CO., LTD. RESPONSES TO OPPOSER'S FIRST SET OF REQUESTS FOR ADMISSIONS (NOS. 1-20)** was served this 8th day of April, 2009, by first-class mail, postage prepaid, on:

David E. Sipiora  
Townsend and Townsend and Crew LLP  
1200 17th Street, Suite 2700  
Denver, CO 80202

  
\_\_\_\_\_  
Connie Fuentes



**RESPONSES TO REQUESTS FOR PRODUCTION OF DOCUMENTS**

**REQUEST NO. 1**

All documents that Applicant was required to identify or did identify in its response to Opposer's First Set of Interrogatories to Applicant.

**RESPONSE TO REQUEST NO. 1**

Applicant incorporates its responses and objections to Opposer's First Set of Interrogatories.

**REQUEST NO. 2**

All documents evidencing the transfer, assignment or licensing of Applicant's Marks, or use of Applicant's Marks as security or collateral, from the date of first adoption and use of Applicant's Marks to the present.

**RESPONSE TO REQUEST NO. 2**

Applicant objects to production of these documents as premature prior to entry of the Protective Order.

**REQUEST NO. 3**

All documents on which Applicant intends to rely in this Opposition proceeding, including, but not limited to, all exhibits and documents Applicant may use for impeachment.

**RESPONSE TO REQUEST NO. 3**

Applicant objects to this request as premature.

**REQUEST NO. 4**

All documents concerning the acquisition, selection, availability, adoption, creation, design, proposal to use or attempt to register Applicant's Marks, including, but not limited to, documents concerning any investigation to determine the availability of Applicant's Marks.

**RESPONSE TO REQUEST NO. 4**

Applicant objects to production of these documents as premature prior to entry of a

Protective Order. Applicant further objects to this request to the extent it calls for production of attorney client privilege information.

**REQUEST NO. 5**

Representative documents showing the manner in which Applicant's Marks have been displayed or used, including, but not limited to, advertisements, product packaging, signs, brochures, posters, stationary, business cards, promotional materials, contracts, decals, labels, badges, mail order solicitations, billing and order forms, computer software, pages or sites on the Internet's world wide web, and computer screens or screen printouts.

**RESPONSE TO REQUEST NO. 5**

Applicant objects to production of these documents as premature prior to entry of the Protective Order.

**REQUEST NO. 6**

Documents sufficient to show the formation or organizational structure of Applicant's business and any predecessor-in-interest that owned Applicant's Marks, including, but not limited to, articles of incorporation or articles of organization and any amendments thereto, and any written operating agreements and amendments thereto.

**RESPONSE TO REQUEST NO. 6**

Applicant objects to production of these documents as premature prior to entry of the Protective Order.

**REQUEST NO. 7**

Documents sufficient to explain or describe Applicant's Goods and Services, including, but not limited to, advertisements, brochures, fliers, sales tools, catalogs, order forms, price lists, training materials, memoranda and bulletins.

**RESPONSE TO REQUEST NO. 7**

Applicant objects to this request to the extent it concerns Goods or Services not in Applicant's marks.

**REQUEST NO. 8**

All documents concerning any searches, studies, distinctiveness surveys, likelihood of confusion surveys, market studies, focus group studies or other surveys or studies performed by or for Applicant in connection with the availability, selection, creation, acquisition, evaluation of strength or weakness, valuation, protection or defense of Applicant's Marks.

**RESPONSE TO REQUEST NO. 8**

Applicant objects to production of these documents as premature prior to entry of a Protective Order. Applicant further objects to this request to the extent it calls for production of attorney client privilege information.

**REQUEST NO. 9**

Documents sufficient to describe the geographic scope of the use of Applicant's Marks.

**RESPONSE TO REQUEST NO. 9**

Applicant objects to production of these documents as premature prior to entry of a Protective Order. Applicant further objects to this request to the extent it calls for production of attorney client privilege information.

**REQUEST NO. 10**

All documents concerning the first use of Applicant's Marks (a) in commerce and (b) in interstate commerce, including, but not limited to, representative documents depicting such use of Applicant's Marks, the date and location of such use, and the identities of all Persons with knowledge of such use.

**RESPONSE TO REQUEST NO. 10**

Applicant objects to production of these documents as premature prior to entry of the Protective Order.

**REQUEST NO. 11**

All documents concerning any state or federal trademark registration or application to register Applicant's Marks.

**RESPONSE TO REQUEST NO. 11**

Applicant objects to production of these documents as premature prior to entry of a Protective Order. Applicant further objects to this request to the extent it calls for production of attorney client privilege information.

**REQUEST NO. 12**

Representative documents showing any state or county corporate, partnership, company name or assumed name filing by Applicant that incorporates "GEOSPEC."

**RESPONSE TO REQUEST NO. 12**

Applicant objects to production of these documents as premature prior to entry of the Protective Order.

**REQUEST NO. 13**

All documents concerning any policy relating to the use, display, or promotion of Applicant's Marks or the goods or services offered under Applicant's Marks.

**RESPONSE TO REQUEST NO. 13**

Applicant objects to production of these documents as premature prior to entry of the Protective Order.

**REQUEST NO. 14**

All documents from or to any advertising or other outside agency or service used in developing or placing advertisements for Applicant's Goods or Services.

**RESPONSE TO REQUEST NO. 14**

Applicant objects to production of these documents as premature prior to entry of the Protective Order.

**REQUEST NO. 15**

All documents evidencing the ownership or a right to use Applicant's Marks, including without limitation partnership agreements, distributor agreements, marketing agreements, assignments, licenses, security agreements, settlements, consent agreements, or any other form of agreement, whether pertaining to Applicant, any predecessor-in-interest, or any other party.

**RESPONSE TO REQUEST NO. 15**

Applicant objects to production of these documents as premature prior to entry of the Protective Order.

**REQUEST NO. 16**

All documents concerning any instance of misdirected (i) mail, (ii) email, (iii) telephone calls or (iv) other communications or inquiries, including via the Internet, or other instances wherein any person may have been confused or mistaken regarding the source of the goods or services associated with the Applicant's Marks, Opposer's Mark, or any mark substantially similar to either.

**RESPONSE TO REQUEST NO. 16**

Applicant objects to production of these documents as premature prior to entry of the Protective Order.

**REQUEST NO. 17**

Documents sufficient to show the amount of revenue received by Applicant (a) for all of Applicant's Goods and Services and (b) for each different type of such good or service on an annual basis, for each year since Applicant's Marks were first used.

**RESPONSE TO REQUEST NO. 17**

Applicant objects to production of these documents as premature prior to entry of the Protective Order.

**REQUEST NO. 18**

Documents sufficient to show the dollar amount of advertising and promotional expenditures, on an annual basis, for each year since Applicant's Marks were first used, (a) for all of Applicant's Goods and Services and (b) for each particular such good or service, including, but not limited to, construction related products and services.

**RESPONSE TO REQUEST NO. 18**

Applicant objects to production of these documents as premature prior to entry of the Protective Order.

**REQUEST NO. 19**

Documents sufficient to show the publication of Applicant's Marks in any media, whether such media is electronic (e.g., Internet) or conventional (e.g., paper), including, but not limited to, publications at tradeshows, magazines, and trade journals.

**RESPONSE TO REQUEST NO. 19**

Applicant objects to production of these documents as premature prior to entry of the Protective Order.

**REQUEST NO. 20**

Documents sufficient to show any periods of non-use of Applicant's Marks in connection with any of Applicant's Goods and Services, from the date of first use to the present.

**RESPONSE TO REQUEST NO. 20**

Applicant objects to production of these documents as premature prior to entry of the Protective Order.

**REQUEST NO. 21**

Documents sufficient to show any resumption of use of Applicant's Marks that followed any period of nonuse identified in the documents responsive to Request No. 20.

**RESPONSE TO REQUEST NO. 21**

Applicant objects to production of these documents as premature prior to entry of the Protective Order.

**REQUEST NO. 22**

Documents sufficient to show any third-party use, application or registration of a trade name, trademark or service mark incorporating "GEOSPEC" or a term similar thereto for the time period from May 6, 2004, to the present.

**RESPONSE TO REQUEST NO. 22**

Applicant objects to production of these documents as premature prior to entry of the Protective Order.

**REQUEST NO. 23**

All documents concerning any objection, challenge, proceeding, dispute or litigation between Applicant (or any predecessor-in-interest) and any third party concerning a mark containing the element "GEOSPEC."

**RESPONSE TO REQUEST NO. 23**

Applicant objects to production of these documents as premature prior to entry of the Protective Order.

**REQUEST NO. 24**

Documents sufficient to show Applicant's past, present and future marketing plans for Applicant's Goods and Services.

**RESPONSE TO REQUEST NO. 24**

Applicant objects to production of these documents as premature prior to entry of the Protective Order.

**REQUEST NO. 25**

All documents concerning Opposer or Opposer's use of Opposer's Mark including, but not limited to, documents reflecting the date or circumstances of Applicant's first awareness of (i) Opposer and (ii) Opposer's Mark.

**RESPONSE TO REQUEST NO. 25**

Applicant objects to production of these documents as premature prior to entry of the Protective Order.

**REQUEST NO. 26**

All documents relied upon as a basis for each opinion by all experts whom Applicant intends to call as witnesses in this action, or from whom Applicant has obtained or may obtain any statements, affidavits or declarations relevant to this action.

**RESPONSE TO REQUEST NO. 26**

Applicant objects to this request as premature prior to the deadline for expert disclosure.

**REQUEST NO. 27**

Documents sufficient to show or describe the potential or actual customers or end-users of Applicant's Goods and Services.

**RESPONSE TO REQUEST NO. 27**

Applicant objects to production of these documents as premature prior to entry of the Protective Order.

**REQUEST NO. 28**

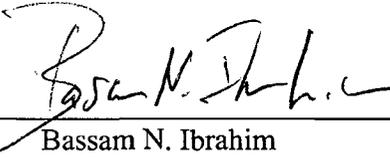
Documents sufficient to show the channels of distribution of Applicant's Goods or Services.

**RESPONSE TO REQUEST NO. 28**

Applicant objects to production of these documents as premature prior to entry of the Protective Order.

Respectfully submitted,

KOBELCO CONSTRUCTION  
MACHINERY LTD.

By   
Bassam N. Ibrahim  
Bryce J. Maynard  
Attorneys for Opposer

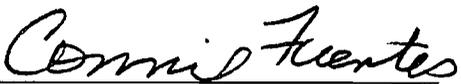
Date: 4/8/09

BUCHANAN INGERSOLL & ROONEY PC  
1737 King Street  
Alexandria, VA 22314-2727  
Telephone: 703/836-6620  
Facsimile: 703/836-2021

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing **KOBELCO CONSTRUCTION MACHINERY CO., LTD. RESPONSES TO OPPOSER'S FIRST REQUESTS FOR PRODUCTION OF DOCUMENT S (NOS. 1-28)** was served this 8th day of April, 2009, by first-class mail, postage prepaid, on:

David E. Sipiora  
Townsend and Townsend and Crew LLP  
1200 17th Street, Suite 2700  
Denver, CO 80202

  
Connie Fuentes  
Connie Fuentes



applicable federal rules and the rules of the Trademark Trial and Appeal Board. Applicant also objects to these requests to the extent they seek information or documents subject to attorney-client privilege and/or the work product doctrine.

## **INTERROGATORY RESPONSES**

### **INTERROGATORY NO. 1**

Identify and describe all of the goods and/or services Applicant has sold, is currently selling, or intends to sell, under Applicant's Marks. The identified goods and services shall hereinafter be referred to as "Applicant's Goods and Services."

### **RESPONSE TO INTERROGATORY NO. 1**

Applicant objects to this interrogatory to the extent it does not concern goods or services identified in the applications that are the subject of these oppositions. Applicant's goods are identified in U.S. Application Nos. 79/023,934 and 79/023,935.

### **INTERROGATORY NO. 2**

Identify all Persons affiliated with Applicant who have any knowledge concerning the following issues:

- (a) the adoption of Applicant's Marks;
- (b) Applicant's knowledge of Opposer's Mark;
- (c) the sale of Applicant's Goods and Services;
- (d) the advertising of Applicant's Goods and Services;
- (e) the trade channels through which Applicant's Goods and Services travel;
- (f) any actual confusion between Applicant's Marks and Opposer's Mark;
- (g) the alleged likelihood of confusion between Applicant's Marks and Opposer's Mark.

### **RESPONSE TO INTERROGATORY NO. 2**

Applicant objects to this interrogatory as overly broad and unduly burdensome in its inquiry for all persons. Applicant further objects to production of this information prior to entry of a Protective Order.

**INTERROGATORY NO. 3**

State the date when Applicant first became aware of Opposer's Mark, and identify all facts relating thereto.

**RESPONSE TO INTERROGATORY NO. 3**

Applicant objects to production of this information prior to entry of a Protective Order.

**INTERROGATORY NO. 4**

Describe all facts relating to the adoption of Applicant's Marks by Applicant.

**RESPONSE TO INTERROGATORY NO. 4**

Applicant objects to production of this information prior to entry of a Protective Order.

**INTERROGATORY NO. 5**

To the extent Applicant claims to have acquired any rights in Applicant's Marks through any predecessor-in-interest, describe the facts pertaining to said acquisition.

**RESPONSE TO INTERROGATORY NO. 5**

Applicant objects to production of this information prior to entry of a Protective Order.

**INTERROGATORY NO. 6**

Describe with particularity any searches or surveys performed on Applicant's behalf in connection with the Applicant's Marks or Opposer's Mark.

**RESPONSE TO INTERROGATORY NO. 6**

Applicant objects to production of this information prior to entry of a Protective Order.

**INTERROGATORY NO. 7**

Describe with particularity the date and circumstances of first use of Applicant's Marks in connection with Applicant's Goods and Services (a) in commerce of any sort and (b) in interstate commerce.

**RESPONSE TO INTERROGATORY NO. 7**

Applicant objects to production of this information prior to entry of a Protective Order.

**INTERROGATORY NO. 8**

Identify all federal and state trademark registration(s) or application(s) filed and/or obtained on behalf of Applicant for marks that include "GEOSPEC" and describe in detail the status of each application or registration.

**RESPONSE TO INTERROGATORY NO. 8**

Applicant objects to this interrogatory as irrelevant to the extent it does not concern applications that are the subject of these consolidated oppositions. Subject to these objections, Applicant identifies U.S. Applications 79/023,934 and 79/023,935.

**INTERROGATORY NO. 9**

Describe any policy Applicant has regarding the use of Applicant's Marks.

**RESPONSE TO INTERROGATORY NO. 9**

Applicant objects to this interrogatory as vague and ambiguous. Applicant further objects to production of this information prior to entry of a Protective Order.

**INTERROGATORY NO. 11**

Describe all instances of actual confusion between Applicant's Marks and Opposer's Mark.

**RESPONSE TO INTERROGATORY NO. 11**

None.

**INTERROGATORY NO. 12**

Identify, on an annual basis for each year since Applicant's Marks were first used, the amount of revenue received by Applicant for each of Applicant's Goods and Services.

**RESPONSE TO INTERROGATORY NO. 12**

Applicant objects to production of this information prior to entry of a Protective Order.

**INTERROGATORY NO. 13**

Identify, on an annual basis for each year since Applicant's Marks were first used, the dollar amount of advertising and promotional expenditures for each of Applicant's Goods and Services.

**RESPONSE TO INTERROGATORY NO. 13**

Applicant objects to production of this information prior to entry of a Protective Order.

**INTERROGATORY NO. 14**

Identify all advertising methods used by Applicant in advertising Applicant's Goods and Services.

**RESPONSE TO INTERROGATORY NO. 14**

Applicant objects to production of this information prior to entry of a Protective Order.

**INTERROGATORY NO. 15**

Identify all web sites that are operated on behalf of Applicant that display or use Applicant's Marks in any way.

**RESPONSE TO INTERROGATORY NO. 15**

Applicant objects to production of this information prior to entry of a Protective Order.

**INTERROGATORY NO. 16**

Identify the geographical areas, by city, county, region and state as applicable, in which Applicant's Goods and Services are currently being offered for sale under Applicant's Marks and, for each area, identify all such goods or services and the date on which they were first offered for sale.

**RESPONSE TO INTERROGATORY NO. 16**

Applicant objects to production of this information prior to entry of a Protective Order.

**INTERROGATORY NO. 17**

Describe the channels of trade through which Applicant offers Applicant's Goods and Services.

**RESPONSE TO INTERROGATORY NO. 17**

Applicant objects to production of this information prior to entry of a Protective Order.

**INTERROGATORY NO. 18**

Identify at least ten (10) representative customers to whom Applicant has sold Applicant's Goods and Services, including one or more representatives of each class of customers to whom Applicant markets or offers Applicant's Goods and Services.

**RESPONSE TO INTERROGATORY NO. 18**

Applicant objects to production of this information prior to entry of a Protective Order.

**INTERROGATORY NO. 19**

Describe in detail the facts relating to any periods of non-use of Applicant's Marks in connection with any of Applicant's Goods and Services.

**RESPONSE TO INTERROGATORY NO. 19**

Applicant objects to production of this information prior to entry of a Protective Order.

**INTERROGATORY NO. 20**

Identify and explain in detail any formal or informal objections that Applicant has ever received in connection with its use of Applicant's Marks.

**RESPONSE TO INTERROGATORY NO. 20**

Applicant objects to this interrogatory as vague and ambiguous. Applicant further objects to production of this information prior to entry of a Protective Order.

**INTERROGATORY NO. 21**

Describe all oral or written agreements entered into by Applicant referring or relating to Applicant's Marks, including without limitation, partnerships, distributorships, marketing agreements, assignments, licenses, security agreements, or agreements settling disputes.

**RESPONSE TO INTERROGATORY NO. 21**

Applicant objects to this interrogatory as overly broad and unduly burdensome in its inquiry for all persons. Applicant further objects to production of this information prior to entry of a Protective Order.

**INTERROGATORY NO. 22**

Identify all experts with whom Applicant has consulted or who Applicant intends to call as witnesses in this action and state the subject matter on which each expert is expected to testify.

**RESPONSE TO INTERROGATORY NO. 22**

None.

**INTERROGATORY NO. 23**

Identify all fact or percipient witnesses who Applicant may call or will call in this action, and state the subject matter on which each individual is expected to testify.

**RESPONSE TO INTERROGATORY NO. 23**

Applicant objects to this interrogatory as premature prior to the testimony period.

**INTERROGATORY NO. 24**

Identify any instances in which Applicant's Goods and Services were offered for sale in the same trade channel as goods and services sold under Opposer's Mark.

**RESPONSE TO INTERROGATORY NO. 24**

None.

**INTERROGATORY NO. 25**

Identify all other uses of which Applicant is aware of the term "GEOSPEC" by any third party in relation to goods and services used in the construction industry for the time period from May 6, 2004 to the present.

**RESPONSE TO INTERROGATORY NO. 25**

Applicant objects to production of this information prior to entry of a Protective Order.

**INTERROGATORY NO. 26**

Identify each instance in which Applicant has asserted that a third party's use of any mark incorporating the element "GEOSPEC" is likely to result in confusion as to the source of the goods or services offered by that party and any of Applicant's Goods and Services.

**RESPONSE TO INTERROGATORY NO. 26**

Applicant objects to production of this information prior to entry of a Protective Order.

**INTERROGATORY NO. 27**

Identify each instance in which Applicant has asserted that a third party's use of any mark incorporating the element "GEOSPEC" is likely to dilute or has diluted Applicant's Marks.

**RESPONSE TO INTERROGATORY NO. 27**

Applicant objects to production of this information prior to entry of a Protective Order.

**INTERROGATORY NO. 28**

Identify all lawsuits or administrative proceedings, if any, past or present, regarding Opposer's Marks.

**RESPONSE TO INTERROGATORY NO. 28**

Applicant objects to production of this information prior to entry of a Protective Order.

**INTERROGATORY NO. 29**

Identify all facts that Applicant believes supports Applicant's contention in paragraph 1 of the "Affirmative Defenses" section of Applicant's answers to Opposer's Notice of Opposition that there is no likelihood of confusion between Opposer's Mark and Applicant's Marks.

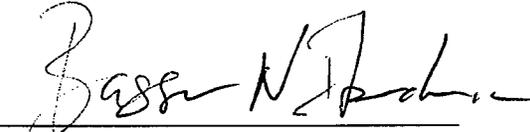
**RESPONSE TO INTERROGATORY NO. 29**

Applicant objects to this interrogatory as premature prior to the testimony period.

Respectfully submitted,

KOBELCO CONSTRUCTION  
MACHINERY LTD.

By



Bassam N. Ibrahim  
Bryce J. Maynard  
Attorneys for Opposer

Date:

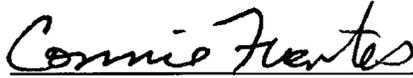
6/8/09

BUCHANAN INGERSOLL & ROONEY PC  
1737 King Street  
Alexandria, VA 22314-2727  
Telephone: 703/836-6620  
Facsimile: 703/836-2021

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing **KOBELCO CONSTRUCTION MACHINERY CO., LTD. RESPONSES TO OPPOSER'S FIRST SET OF INTERROGATORIES (NOS. 1-29)** was served this 8th day of April, 2009, by first-class mail, postage prepaid, on:

David E. Sipiora  
Townsend and Townsend and Crew LLP  
1200 17th Street, Suite 2700  
Denver, CO 80202

  
\_\_\_\_\_  
Connie Fuentes

# ATTACHMENT H

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

In re Application Serial Nos. 79/023,935 and 79/023,934  
Published: August 7, 2007  
Applicant: Kobelco Construction Machinery Co., Ltd.  
Mark: GEOSPEC and ACERA GEOSPEC (and design)  
Filed: March 30, 2006

PLASTI-FAB LTD.,

Opposer,

v.

KOBELCO CONSTRUCTION MACHINERY  
CO., LTD,

Applicant.

Opposition No. 91179480 (parent)  
Opposition No. 91179482

**OPPOSER'S SECOND SET OF REQUESTS FOR ADMISSION (NOS. 21-55)**

Pursuant to the Trademark Trial and Appeal Board's Order of June 3, 2010, Opposer Plasti-Fab Ltd. ("Opposer"), by counsel, propounds the following requests for admission ("RFAs") to be fully and separately answered in writing by an officer or duly authorized agent of Applicant Kobelco Construction Machinery Co., Ltd. ("Applicant"), within thirty (30) days of the date of service hereof, or at such other time and place as may be mutually agreed upon by the parties, in accordance with Rule 2.120 of the Trademark Rules of Practice and Rules 26 and 36 of the Federal Rules of Civil Procedure.

### **INSTRUCTIONS AND DEFINITIONS**

A. These RFAs seek answers as of the date on which Applicant responds and, as to those RFAs addressed to matters falling within Rules 26(e)(1) and (2) of the Federal Rules of Civil Procedure, shall be deemed to be continuing, requiring Applicant to serve upon Opposer such further answers promptly after Applicant has acquired additional knowledge or information relating in any way to those RFAs.

B. Where the RFAs request the identity of:

1. a person, state the name and current or last known address of each person, employer or business affiliation, and occupation and business position held;
2. a company, state the name, place of incorporation or organization, principal place of business, and the identity of the persons having knowledge of the matter with respect to which the company is named;
3. a document, state:
  - a) the identity of the person or persons who prepared it, the sender and recipient, if any;
  - b) the title or a description of the general nature of its subject matter;
  - c) the date of preparation;
  - d) the date and manner of distribution and publication, if any;
  - e) the location of each copy and the identity of the present custodian;
  - f) the identity of the person or persons who can identify it;

g) the contents of the document verbatim (or, in lieu thereof, a copy of the document); and

h) if privilege is claimed, the specific basis for the claim;

4. an act or event, state:

a) a description of the act or event;

b) when it occurred;

c) where it occurred;

d) the identity of the person or persons performing said act (or, in case of an omission, the identity of the person or persons failing to act) or involved in said event;

e) the identity of all persons who have knowledge, information or belief about the act;

f) when the act, event or omission first became known; and

g) the circumstances and manner in which such knowledge was first obtained.

C. “Referring or relating to” means comprising, relating to, pertaining to, referring to or in any way relevant within the meaning of Rule 26(b)(1) of the Federal Rules of Civil Procedure.

D. To the extent that Applicant has any objection to answering any of the RFAs or producing responsive documents on the basis that the requested information or responsive documents are privileged or otherwise protected by the attorney-client privilege or work-product immunity, Applicant is requested to identify the subject matter and date of the information or document; identify the person who authored the information or documents; identify each person who ever received or had access to the information or document, or a copy thereof; identify the

person or persons who presently have custody of the information or document; and state the basis of the alleged privilege or work-product immunity.

E. If Applicant is aware, with respect to any Interrogatory, or any Request listed in Opposer's Second Request for Production of Documents and Opposer's Second Set of Interrogatories served herewith, or any subsequent Interrogatory or Document Request that may be served on Applicant in this proceeding, that any responsive document once existed but has been destroyed, please identify the document, who destroyed it, why it was destroyed, and the date and circumstances under which it was destroyed.

F. Each matter of which an admission is requested will be deemed admitted pursuant to Federal Rule of Civil Procedure 36(a) unless a written answer or objection is served within 30 days of service of these requests.

G. All objections to individual requests for admission shall specifically state the reasons for the objections.

H. Answers to individual requests for admission shall specifically admit the matter, specifically deny the matter, or set forth in detail the reasons why the matter cannot be truthfully admitted or denied.

I. When good faith requires that you qualify your answer or deny only part of the matter for which an admission is requested, you must specify those portions of the request which you admit, and qualify or deny the remainder.

J. You may not give lack of information or knowledge as a reason for failure to admit or deny a particular request for admission unless you have made reasonable inquiry into the matter which is the subject of the request for admission and unless the information known or

readily available to you is insufficient to enable you to admit or deny the matter and your answer so states.

K. If you believe that a matter for which an admission is requested presents a genuine issue for trial, you may not, on that ground alone, object to that request for admission.

L. With respect to each written response to these requests for admission, please restate each request immediately before your written response to that request.

M. Opposer incorporates herein by reference the definitions set forth in Opposer's Second Set of Interrogatories.

#### **REQUESTS FOR ADMISSION**

21. Admit that Applicant's Marks are confusingly similar to Opposer's Mark.
22. Admit that registration of Applicant's Marks are likely to cause confusion with Opposer's Mark.
23. Admit that Applicant's Marks should not be registered because it will cause confusion with Opposer's Mark.
24. Admit that Opposer's Mark have priority over Applicant's Marks.
25. Admit that Opposer's Mark are well-known.
26. Admit that Opposer's Marks are famous.
27. Admit that Applicant has no knowledge of the term "GEOSPEC" being found in a dictionary.
28. Admit that Opposer provides under Opposer's Mark goods used in the construction industry.

29. Admit that Applicant has no knowledge that the mark GEOSPEC is used in association with any good and/or services other than the goods and services provided by Opposer and allegedly Applicant.

30. Admit that Opposer's Mark is a strong mark.

31. Admit that Applicant is not aware of any common meaning in the English language for the term "GEOSPEC."

32. Admit that Applicant is providing under Applicant's Marks goods used in the construction industry.

33. Admit that Applicant intends to provide under Applicant's Marks goods used in the construction industry.

34. Admit that the public has come to associate Opposer's Mark as a source of high quality construction related goods.

35. Admit that Applicant is not aware of anyone other than Opposer and allegedly Applicant who uses the term "GEOSPEC."

36. Admit that Applicant is not aware of any federal trademark registration for the term "GEOSPEC" other than that owned by Opposer.

37. Admit that Applicant has no knowledge of Opposer authorizing Applicant's use of "GEOSPEC" for the goods set forth in U.S. Trademark Application Serial Nos. 79/023,934 and 79/023,935.

38. Admit that consumers of the goods and services offered under Opposer's Mark are the same as the consumers to whom Applicant intends to offer its goods and services under Applicant's Marks.

39. Admit that consumers of the goods and services offered under Opposer's Mark overlap with the consumers to whom Applicant intends to offer its goods and services under Applicant's Marks.

40. Admit that "GEOSPEC" is a strong trademark when used in connection with the goods and services offered under Opposer's Mark.

41. Admit that Opposer's Mark is distinctive.

42. Admit that Opposer's Mark is not descriptive.

43. Admit that Opposer's Mark is not suggestive.

44. Admit that the goods provided by Opposer and the goods intended to be provided by Applicant will be provided to persons or entities in the same industry.

45. Admit that the word portions of Applicant's Marks and Opposer's Mark incorporate the term "GEOSPEC."

46. Admit that the goods provided by Opposer and the goods that Applicant intends to provide are provided to consumers through the same channels of trade.

47. Admit that the goods provided by Opposer and the goods provided by Applicant are provided to consumers through the same channels of trade.

48. Admit that Applicant is not aware of any third-party who uses "GEOSPEC" as a trademark.

49. Admit that Applicant was aware of Opposer's Mark when it applied for Applicant's Marks.

50. Admit that Opposer has spent a substantial amount of money promoting Opposer's Mark.

51. Admit that consumers have come to associate “GEOSPEC” with goods and services associated with Opposer.
52. Admit that consumers are likely to consider the goods and services provided under Applicant’s Mark as emanating from or associated with or endorsed by Opposer.
53. Admit that Opposer is the owner of Opposer’s Mark.
54. Admit that Applicant’s intended use of Applicant’s Marks will induce purchasers to believe that the goods and services provided under Applicant’s Marks are in some way associated with Opposer.
55. Admit that Applicant’s use of Applicant’s Marks induces purchasers to believe that the goods and services provided under Applicant’s Marks are in some way associated with Opposer.

Dated: July 30, 2010

TOWNSEND AND TOWNSEND AND CREW LLP

/s/ David E. Sipiora  
David E. Sipiora  
Shelley B. Mixon  
1400 Wewatta Street, Suite 600  
Denver, CO 80202  
(303) 571-4000  
(303) 571-4321 (fax)

Attorneys for Opposer Plasti-Fab Ltd.



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

In re Application Serial Nos. 79/023,935 and 79/023,934  
Published: August 7, 2007  
Applicant: Kobelco Construction Machinery Co., Ltd.  
Mark: GEOSPEC and ACERA GEOSPEC (and design)  
Filed: March 30, 2006

PLASTI-FAB LTD.,

Opposer,

vs.

KOBELCO CONSTRUCTION MACHINERY  
CO., LTD,

Applicant.

Opposition No. 91179480 (parent)  
Opposition No. 91179482

**OPPOSER'S SECOND REQUESTS FOR PRODUCTION OF DOCUMENTS (29-64)**

Pursuant to the Trademark Trial and Appeal Board's Order of June 3, 2010, Opposer Plasti-Fab Ltd. ("Opposer"), by counsel, requests that Applicant Kobelco Construction Machinery Co., Ltd. ("Applicant") produce for inspection and copying the documents listed below, at the offices of Applicant's counsel, Townsend and Townsend and Crew LLP, 1200 Seventeenth Street, Suite 2700, Denver, Colorado 80202, within thirty (30) days of the date of service hereof, or at such other time and place as may be mutually agreed upon by the parties, in accordance with Rule 2.120 of the Trademark Rules of Practice and Rules 26 and 34 of the Federal Rules of Civil Procedure.

## **INSTRUCTIONS AND DEFINITIONS**

A. Opposer hereby incorporates by reference the Instructions and Definitions set forth in Opposer's Second Set of Interrogatories.

B. If Applicant is aware, with respect to any Request, that any responsive document once existed but has been destroyed, Applicant should describe the document, identify who destroyed it, why it was destroyed, and the date and circumstances under which it was destroyed.

C. The term "concerning" means "referring to," "relating to," "containing," "embodying," "mentioning," "evidencing," "constituting," "describing," or in any way relevant within the meaning of Rule 26(b)(1) of the Federal Rules of Civil Procedure.

## **REQUESTS FOR PRODUCTION OF DOCUMENTS**

### **REQUEST NO. 29**

All documents that Applicant was required to identify or did identify in its response to Opposer's First and Second Set of Interrogatories to Applicant.

### **REQUEST NO. 30**

All documents concerning the transfer, assignment or licensing of Applicant's Marks, or use of Applicant's Marks as security or collateral, from the date of first adoption and use of Applicant's Marks to the present.

### **REQUEST NO. 31**

All documents concerning the acquisition, selection, availability, adoption, creation, design, proposal to use or attempt to register Applicant's Marks, including without limitation documents concerning any investigation to determine the availability of Applicant's Marks or any similar mark.

**REQUEST NO. 32**

One copy of each document on which Applicant's Marks have been displayed, including without limitation advertisements, product packaging, signs, brochures, posters, stationery, business cards, promotional materials, contracts, decals, labels, badges, mail order solicitations, billing and order forms, computer software, pages or sites on the Internet's world wide web, and computer screens or screen printouts.

**REQUEST NO. 33**

All documents concerning the formation or organizational structure of Applicant's business and any predecessor-in-interest that owned Applicant's Marks, including without limitation articles of incorporation or articles of organization and any amendments thereto, and any written operating agreements and amendments thereto.

**REQUEST NO. 34**

All documents that explain or describe the goods or services offered under Applicant's Marks, including without limitation advertisements, brochures, fliers, sales tools, catalogs, order forms, price lists, training materials, memoranda and bulletins.

**REQUEST NO. 35**

All documents concerning any searches, studies, distinctiveness surveys, likelihood of confusion surveys, market studies, focus group studies or other surveys or studies performed by or for Applicant in connection with the availability, selection, creation, acquisition, evaluation of strength or weakness, valuation, protection or defense of Applicant's Marks.

**REQUEST NO. 36**

All documents concerning the geographic scope of the use or intended use of Applicant's Marks.

**REQUEST NO. 37**

All documents concerning the first use of Applicant's Marks (a) in commerce and (b) in interstate commerce, including but not limited to documents depicting such use of Applicant's Marks, the date and location of such use.

**REQUEST NO. 38**

All documents concerning any state or federal trademark registration or application to register Applicant's Marks.

**REQUEST NO. 39**

All documents concerning any state or county corporate, partnership, company name or assumed name filing that includes Applicant's Marks.

**REQUEST NO. 40**

All documents concerning any policy relating to the use, display, or promotion of Applicant's Marks, or goods or services offered under Applicant's Marks.

**REQUEST NO. 41**

All documents concerning any advertising or other outside agency or service used in developing or placing advertisements for goods or services offered under Applicant's Marks.

**REQUEST NO. 42**

All documents concerning ownership or use of Applicant's Marks, including without limitation partnership agreements, distributor agreements, marketing agreements, assignments, licenses, security agreements, settlements, consent agreements, or any other form of agreement, whether pertaining to Applicant, any predecessor-in-interest, or any other party.

**REQUEST NO. 43**

All documents concerning any instance of misdirected (i) mail, (ii) email, (iii) telephone calls or (iv) other communications or inquiries, including via the Internet, or other instances wherein any person may have been confused or mistaken regarding Applicant's Marks or use thereof, Opposer's Marks or use thereof, or any substantially similar mark or use thereof.

**REQUEST NO. 44**

All documents sufficient to show the amount of revenue received by Applicant (a) for all goods or services and (b) for each different type of good or service sold under Applicant's Marks on an annual basis, for each year since Applicant's Marks was first used.

**REQUEST NO. 45**

All documents sufficient to show the dollar amount of advertising and promotional expenditures, on an annual basis, for each year since Applicant's Marks was first used, (a) for all goods and services offered under Applicant's Marks and (b) for each particular good or service offered under Applicant's Marks.

**REQUEST NO. 46**

All documents concerning the publication of Applicant's Marks in any media, whether such media is electronic (*e.g.*, Internet) or conventional (*e.g.*, paper), including but not limited to publication at tradeshows, magazines, trade journals, and elsewhere.

**REQUEST NO. 47**

All documents concerning any periods of non-use of Applicant's Marks in connection with any of the goods and services listed in response to Interrogatory No. 30, from the date of first use to the present.

**REQUEST NO. 48**

All documents concerning any resumption of use of Applicant's Marks that followed any period of nonuse of the mark.

**REQUEST NO. 49**

All documents concerning any discussions, proposals (whether adopted or not), recommendations (whether adopted or not), plans (whether adopted or not), or decisions to commence use of any mark, other than Applicant's Marks, in connection with the goods and services listed in response to Interrogatory No. 30, as a substitute or replacement of Applicant's Marks, regardless of whether such substitution or replacement was intended to be temporary or permanent.

**REQUEST NO. 50**

All documents concerning any use of any other mark by Applicant, during any period of nonuse of Applicant's Marks, in connection with the goods and services listed in response to Interrogatory No. 30.

**REQUEST NO. 51**

Documents sufficient to show Applicant's past, present and future marketing plans for Applicant's goods and services offered under Applicant's Marks.

**REQUEST NO. 52**

All documents concerning any mark selected, acquired, adopted, created or designed for use in connection with the goods and services listed in response to Interrogatory No. 30, as a substitute or replacement of or alternative to Applicant's Marks, regardless of whether such substitution or replacement was intended to be temporary or permanent.

**REQUEST NO. 53**

All documents concerning any present or prior third-party use, application or registration of a trade name, trademark or service mark comprised in whole or in part of Applicant's Marks, or any name or mark similar thereto.

**REQUEST NO. 54**

All documents concerning any objection, challenge, proceeding, dispute or litigation between Opposer or any predecessor-in-interest and any third party concerning use of Applicant's Marks, including but not limited to docket sheets, pleadings, motions, and judgments.

**REQUEST NO. 55**

All documents concerning any customer complaint concerning goods or services offered under Applicant's Marks.

**REQUEST NO. 56**

All documents concerning Applicant's past, present or future marketing plans concerning goods or services offered or to be offered under Applicant's Marks.

**REQUEST NO. 57**

All documents relied upon as a basis for each opinion by all experts whom Applicant intends to call as witnesses in this action, or from whom Applicant has obtained or may obtain any statements, affidavits or declarations relevant to this action.

**REQUEST NO. 58**

All documents concerning Opposer or Opposer's use of Opposer's Marks including, without limitation, documents reflecting the date or circumstances of Applicant's first awareness of Opposer's Marks.

**REQUEST NO. 59**

All documents concerning the packaging material, label, container, sign, advertisement or sales, marketing or other promotional material and the like that Applicant has ever used or intended or intends to use in the sale of offer for sale of any product or service sold under Applicant's Marks.

**REQUEST NO. 60**

All documents concerning Applicant's present market and channels of trade and intended markets and channels of trade.

**REQUEST NO. 61**

All documents concerning users of products sold under Applicant's Marks.

**REQUEST NO. 62**

All documents concerning governmental approval, if any, necessary to sell any product that is sold bearing Applicant's Marks.

**REQUEST NO. 63**

All documents concerning complaints, petitions, oppositions, objections, cancellations, administrative proceedings, office actions, legal opinions, cease and desist letters or civil actions make by or against Applicant concerning Applicant's Marks in the United States.

All documents concerning Applicant's Marks.

**REQUEST NO. 64**

Documents sufficient to identify the persons whom Applicant permits to use Applicant's Marks.

Dated: July 30, 2010

TOWNSEND AND TOWNSEND AND CREW LLP

/s/ David E. Sipiora

David. E. Sipiora  
Shelley B. Mixon  
1400 Wewatta Street, Suite 600  
Denver, CO 80202  
(303) 571-4000  
(303) 571-4321 (fax)

Attorneys for Opposer Plasti-Fab Ltd.

**CERTIFICATE OF SERVICE**

I hereby certify that on this 30th day of July 2010, a true and correct copy of the foregoing **APPLICANT'S SECOND REQUEST FOR PRODUCTION OF DOCUMENTS (Nos. 29-64)** was served via email and by placing the same in the United States mail, postage prepaid and addressed to the following:

Bassam N. Ibrahim  
Bryce J. Maynard  
Buchanan Ingersoll PC  
1737 King Street  
Suite 500  
Alexandria, VA 22314-2727

*Attorneys for Applicant Kobelco Construction Machinery Co., Ltd.*

\_\_\_\_\_  
*/s/ Kara E. Fielder*

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

In re Application Serial Nos. 79/023,935 and 79/023,934  
Published: August 7, 2007  
Applicant: Kobelco Construction Machinery Co., Ltd.  
Mark: GEOSPEC and ACERA GEOSPEC (and design)  
Filed: March 30, 2006

PLASTI-FAB LTD.,

Opposer,

vs.

KOBELCO CONSTRUCTION  
MACHINERY CO., LTD,

Applicant.

Opposition No. 91179480 (parent)  
Opposition No. 91179482

**OPPOSER'S SECOND SET OF INTERROGATORIES (Nos. 30-59)**

Pursuant to the Trademark Trial and Appeal Board's Order of June 3, 2010, Opposer Plasti-Fab Ltd. ("Opposer") propounds the following written interrogatories ("Interrogatories") to be fully and separately answered in writing, under oath, by an officer or duly authorized agent of Kobelco Construction Machinery Co., LTD ("Applicant"), within thirty (30) days of the date of service hereof, or at such other time and place as may be mutually agreed upon by the parties, in accordance with Rule 2.120 of the Trademark Rules of Practice and Rules 26 and 33 of the Federal Rules of Civil Procedure.

## INSTRUCTIONS AND DEFINITIONS

A. These Interrogatories seek answers as of the date on which Applicant responds and, as to those Interrogatories addressed to matters falling within Rules 26(e)(1) and (2) of the Federal Rules of Civil Procedure, shall be deemed to be continuing, requiring Applicant to serve upon Opposer such further answers promptly after Applicant has acquired additional knowledge or information relating in any way to those interrogatories.

B. Where the interrogatories request the identity of:

1. a person, state the name and current or last known address of each person, employer or business affiliation, and occupation and business position held;

2. a company, state the name, place of incorporation or organization, principal place of business, and the identity of the persons having knowledge of the matter with respect to which the company is named;

3. a document, state:

- a) the identity of the person or persons who prepared it, the sender and recipient, if any;
- b) the title or a description of the general nature of its subject matter;
- c) the date of preparation;
- d) the date and manner of distribution and publication, if any;
- e) the location of each copy and the identity of the present custodian;
- f) the identity of the person or persons who can identify it;

- g) the contents of the document verbatim (or, in lieu thereof, a copy of the document); and
  - h) if privilege is claimed, the specific basis for the claim;
4. an act or event, state:
- a) a description of the act or event;
  - b) when it occurred;
  - c) where it occurred;
  - d) the identity of the person or persons performing said act (or, in case of an omission, the identity of the person or persons failing to act) or involved in said event;
  - e) the identity of all persons who have knowledge, information or belief about the act;
  - f) when the act, event or omission first became known; and
  - g) the circumstances and manner in which such knowledge was first obtained.

C. To the extent that Applicant has any objection to answering any of the Interrogatories or producing responsive documents on the basis that the requested information or responsive documents are privileged or otherwise protected by the attorney-client privilege or work-product immunity, Applicant is requested to identify the subject matter and date of the information or document; identify the person who authored the information or documents; identify each person who ever received or had access to the information or document, or a copy

thereof; identify the person or persons who presently have custody of the information or document; and state the basis of the alleged privilege or work-product immunity.

D. The term “document” encompasses all items subject to discovery within the scope of Rule 34 of the Federal Rules of Civil Procedure and includes, without limitation, the following items, whether printed, or recorded, or filmed, or reproduced by any process, or written or produced by hand, and whether or not claimed to be privileged against discovery on any ground, and whether original, master or copy; whether printed or stored on any medium, including audiotape, videotape, CD-ROM, CD-RW, floppy disk, zip disk, hard disk, memory chip, servers, or via any other electronic or magnetic means of storage, including without limitation: agreements; communications, including intra-company communications and correspondence; electronic mail, voice mail, faxes, cablegrams, radio-grams and telegrams; notes and memoranda; summaries, minutes and records of telephone conversations, meetings and conferences, including lists of persons attending meetings or conferences; summaries and records of personal conversations or interviews; books, manuals, publications and diaries; laboratory and engineering reports and notebooks; charts; plans; sketches and drawings; photographs; reports and/or summaries of investigations and/or surveys; opinions and reports of consultants; opinions of counsel; reports and summaries of negotiations; brochures; pamphlets, catalogs and catalog sheets; advertisements, including storyboard and/or scripts for radio or television commercials; circulars; trade letters; press publicity and trade and product releases; drafts of original or preliminary notes on, and marginal comments appearing on, any document; and any other information-containing paper, writing or physical thing; letters, notes, memoranda, records, minutes, bills, contracts, agreements, orders, receipts, drawings, sketches, advertising or

promotional literature, operating manuals, instruction bulletins, test data, and reports, and each version thereof.

E. "Referring or relating to" means comprising, concerning, relating to, pertaining to, referring to or in any way relevant within the meaning of Rule 26(b)(1) of the Federal Rules of Civil Procedure.

F. "Communication(s)" when used in these Interrogatories includes the disclosure, transfer, or exchange of information by any means, written, verbal, electronic, or otherwise.

G. "And," or "or" or "and/or" shall be construed conjunctively or disjunctively as necessary to make the request inclusive rather than exclusive.

H. "Date" means the exact day, month, and year, if ascertainable and, if not, Applicant's best approximation thereof.

I. "Applicant" means Kobelco Construction Machinery Co., LTD., all predecessors or successors-in-interest, all predecessor or successor owners of U.S. Trademark Application Serial Nos. 79/023,935 and 79/023,934 and/or Applicant's Marks, as defined in paragraph K below, and the officers, employees, attorneys, agents, consultants and representatives of all such entities. Absent contrary express notice, it is understood and anticipated that all answers and responses to these Interrogatories and to Opposer's Second Request for Production of Documents will include information and documents from and pertaining to all such predecessor and successor entities.

J. "Person(s)" means both natural persons, living or deceased, and to corporate or other business entities, whether or not in the employ of Applicant, and the acts and knowledge of

a person are defined to include the acts and knowledge of a corporate or other business entity “person’s” directors, officers, members, employees, representatives, agents, and attorneys.

K. “Applicant’s Marks” or the “Marks” means the marks which are the subject matter of U.S. Trademark Application Serial Nos. 79/023,935 and 79/023,934 whether used as a trademark, service mark, trade name, or corporate name, either alone or in association with other words or designs.

L. “Opposer’s Mark” means the mark which is the subject of U.S. Trademark Registration No. 3,385,301.

### **INTERROGATORIES**

#### **INTERROGATORY NO. 30**

Describe all of the goods or services which Applicant has sold, is currently selling, or intends to sell under Applicant’s Marks, explaining in detail what the goods and services consist of.

#### **INTERROGATORY NO. 31**

Identify by name, address, and title all persons, including but not limited to the members, owners, officers, directors and managing agents of Applicant, who have any knowledge concerning the following issues:

- (a) the selection and adoption of Applicant’s Mark;
- (b) the sale or offer for sale of goods or services under Applicant’s Marks;
- (c) the advertising, promotion, and marketing of goods or services under Applicant’s Marks;
- (d) the trade channels through which Applicant’s goods or services travel;

- (e) the nature and extent of any actual confusion between Applicant's Marks and Opposer's Marks;
- (f) the alleged absence of likelihood of confusion between Applicant's Marks and Opposer's Marks.

**INTERROGATORY NO. 32**

Describe the selection process Applicant used to select Applicant's Marks.

**INTERROGATORY NO. 33**

To the extent Applicant claims to have acquired any rights in Applicant's Marks through any predecessor-in-interest, describe the facts pertaining to said acquisition.

**INTERROGATORY NO. 34**

Describe with particularity the circumstances of the first use in commerce of Applicant's Marks in connection with each good or service listed in response to Interrogatory No. 30.

**INTERROGATORY NO. 35**

Describe Applicant's policies regarding the use of Applicant's Marks.

**INTERROGATORY NO. 36**

Identify the amount of revenue received by Applicant for the sale of the goods or services sold under Applicant's Marks.

**INTERROGATORY NO. 37**

Identify the dollar amount of Applicant's advertising expenditures for all goods or services offered under Applicant's Marks.

**INTERROGATORY NO. 38**

Identify all advertising methods used by or intended to be used by Applicant in advertising or promoting the sale of any goods or services under Applicant's Marks.

**INTERROGATORY NO. 39**

Identify the geographical areas in which goods or services are currently being offered or intend to be offered for sale under Applicant's Marks.

**INTERROGATORY NO. 40**

Identify the name, date and location of all trade shows at which Applicant's goods or services have been promoted or offered under Applicant's Marks.

**INTERROGATORY NO. 41**

Identify and describe the channels of trade through which Applicant offers or intends to offer goods or services under Applicant's Marks (*e.g.*, directly to consumers, directly to businesses, to other companies providing wall covering products).

**INTERROGATORY NO. 42**

Identify all witnesses who Applicant may call or will call in this action, and state the subject matter on which each individual is expected to testify.

**INTERROGATORY NO. 43**

Identify all facts and the legal bases that Applicant believes support Applicant's contention in paragraph 1 of the "Affirmative Defenses" section of Applicant's answers to Opposer's Notices of Opposition that there is no likelihood of confusion between Opposer's Mark and Applicant's Marks.

**INTERROGATORY NO. 44**

Identify all facts that Applicant believes support Applicant's denial in Applicant's answers to Opposer's Notice of Opposition that Opposer would not be harmed by Applicant's registration of its Marks.

**INTERROGATORY NO. 45**

Describe the formation or organizational structure of Applicant's business and any predecessor-in-interest that owned Applicant's Mark.

**INTERROGATORY NO. 46**

Identify all persons whom Applicant permits to use its Marks.

**INTERROGATORY NO. 47**

Describe in detail Applicant's intended use of Applicant's Marks.

**INTERROGATORY NO. 48**

Describe all meanings of the term "GEOSPEC" of which Applicant is aware.

**INTERROGATORY NO. 49**

Identify all facts and the legal bases for Applicant's denial of Applicant's Request for Admission No. 16, *i.e.*, that Opposer's Mark is distinctive.

**INTERROGATORY NO. 50**

Identify the factual bases for Applicant's denial of Applicant's Request for Admission No. 3, *i.e.*, that Applicant has no knowledge that the mark "GEOSPEC" is used in association with any good and/or services other than the goods and services provided by Opposer.

**INTERROGATORY NO. 51**

Identify the factual bases for Applicant's denial of Applicant's Request for Admission

No. 7, *i.e.*, that the term “GEOSPEC” has no meaning other than as a trademark used by Opposer in association with the goods and services provided by Opposer.

**INTERROGATORY NO. 52**

Identify the factual bases for Applicant’s denial of Applicant’s Request for Admission No. 10, *i.e.*, that the public has come to associated Opposer’s Mark as a source of high quality construction related goods.

**INTERROGATORY NO. 53**

Identify the factual bases for Applicant’s denial of Applicant’s Request for Admission No. 11, *i.e.* that you are not aware of anyone other than Opposer who uses the mark “GEOSPEC.”

**INTERROGATORY NO. 54**

Identify the factual bases for Applicant’s denial of Applicant’s Request for Admission No. 14, *i.e.*, that consumers of Applicant’s goods and services are consumers of construction related materials.

**INTERROGATORY NO. 55**

Identify the factual bases for Applicant’s denial of Applicant’s Request for Admission No. 14, *i.e.*, that GEOSPEC is a unique word and not a common word.

**INTERROGATORY NO. 56**

Identify the factual bases for Applicant’s denial of Applicant’s Request for Admission No. 17, *i.e.*, that construction related goods provided by Opposer and the construction related goods intended to be provided by Applicant will be provided to persons or entities in the same industry.

**INTERROGATORY NO. 57**

Identify the factual bases for Applicant's denial of Applicant's Request for Admission No. 19, *i.e.*, that the goods provided by Opposer and the goods provided by, or that are intended to be provided by, Applicant are provided to consumers through the same channels of trade.

**INTERROGATORY NO. 58**

Describe all oral or written agreements entered into by Applicant referring or relating to Applicant's Marks.

**INTERROGATORY NO. 59**

Identify all uses, of which Applicant is aware, of the term "GEOSPEC" by any third party in relation to goods and services used in the construction industry for the time period from May 6, 2004 to the present.

Dated: July 30, 2010

TOWNSEND AND TOWNSEND AND CREW LLP

/s/ David E. Sipiora  
David E. Sipiora  
Shelley B. Mixon  
1400 Wewatta Street, Suite 600  
Denver, CO 80202  
(303) 571-4000  
(303) 571-4321 (fax)

Attorneys for Opposer Plasti-Fab LTD.

**CERTIFICATE OF SERVICE**

I hereby certify that on this 30th day of July 2010, a true and correct copy of the foregoing **OPPOSER'S SECOND SET OF INTERROGATORIES (Nos. 30-59)** was served by placing the same in the United States mail, postage prepaid and addressed to the following:

Bassam N. Ibrahim  
Bryce J. Maynard  
Buchanan Ingersoll PC  
1737 King Street  
Suite 500  
Alexandria, VA 22314-2727

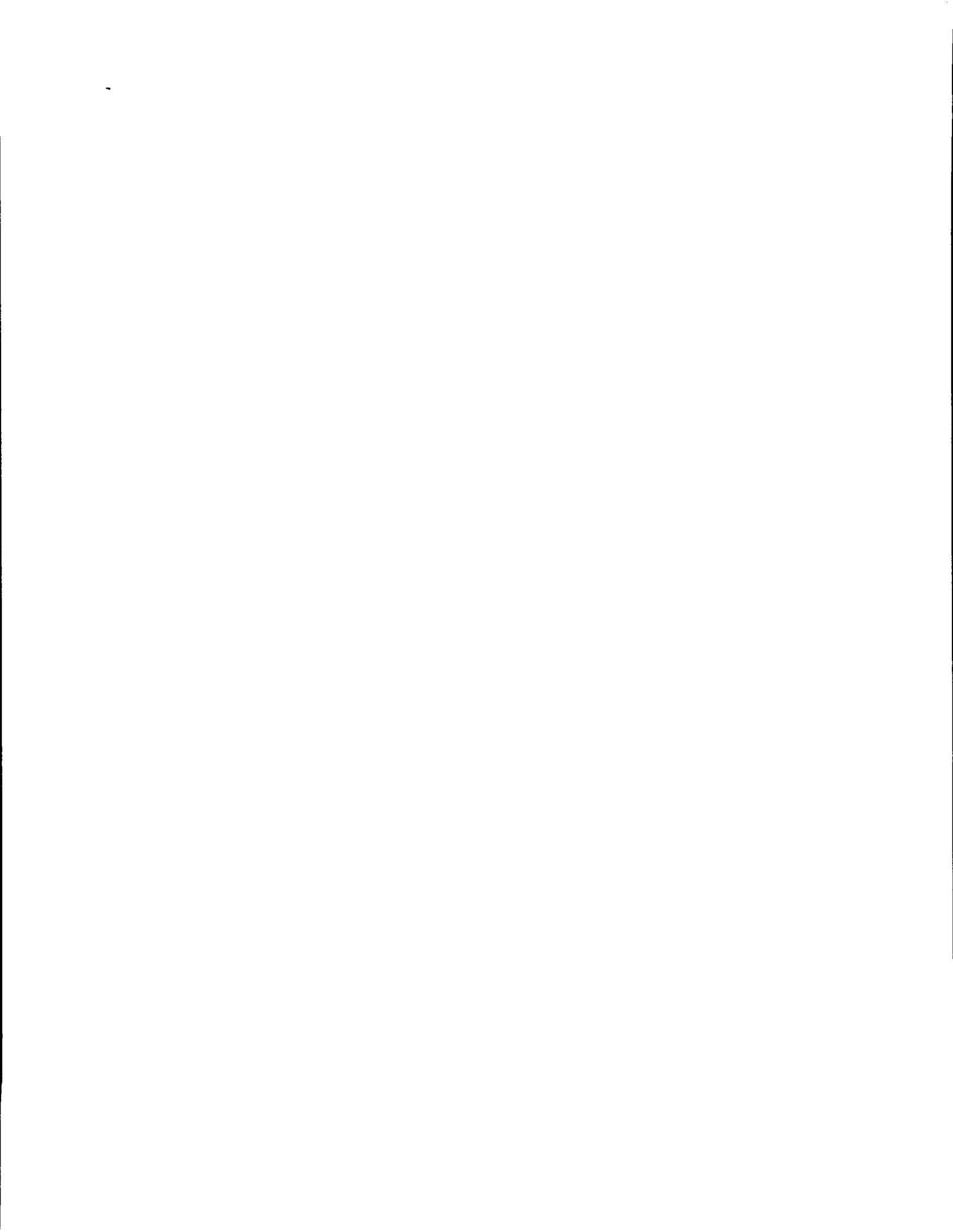
Attorneys for Applicant Kobelco Construction Machinery Co., Ltd.

*/s/ Kara E. Fielder*

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62801637 v3

# ATTACHMENT I



# **EXHIBIT B**

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

In re: *Application Ser. Nos. 79/023,935 and 79/023,934*  
Published: August 7, 2007, and August 14, 2007, in the Official Gazette  
Applicant: Kobelco Construction Machinery Co., Ltd.  
Mark: **GEOSPEC and ACERA GEOSPEC (and design)**

PLASTI-FAB LTD.,

Opposer,

vs.

KOBELCO CONSTRUCTION  
MACHINERY CO., LTD.,

Applicant.

Consolidated Opposition Nos. 91179480  
(parent) and 91179482

**DECLARATION OF**

**Bruce M. Carruthers**

Pursuant to 28 U.S.C. § 1746, I, Bruce M. Carruthers hereby declare as follows:

1. This declaration is submitted in support of Opposer Plasti-Fab Ltd.'s ("Opposer") Motion for Summary Judgment in the above-captioned matter.
2. I have been employed by Opposer since 1971. I presently hold the position of Chief Operating Officer.
3. Based on my employment with Opposer, including review of records of the company as necessary, I have personal knowledge of the following facts:
  - a. Opposer is the current owner of the mark GEOSPEC®.

- b. The GEOSPEC® mark has been in use worldwide since 2003, and in use in the United States since 2005.
- c. The GEOSPEC® mark is used on products such as lightweight fill materials for geotechnical construction projects, including road embankments, soil stabilization, lightweight fill material for landscaping over structural slabs.
- d. Materials on which the GEOSPEC® mark is used can be found on large scale construction sites such as Interstate I-94 at Rotunda specified by the Michigan Department of Transportation.
- e. Opposer advertises and markets its products through various trade channels, including website and geotechnical conferences and trade shows in the United States.
- f. The purchasers and potential purchasers of Opposer's GEOSPEC® goods include members of the construction industry, such as general contractors, engineers, and state and local governments and municipalities.
- g. Opposer's sales revenues for materials sold under the GEOSPEC® mark in the United States from 2005 to the present are [REDACTED].

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct.

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. section 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own

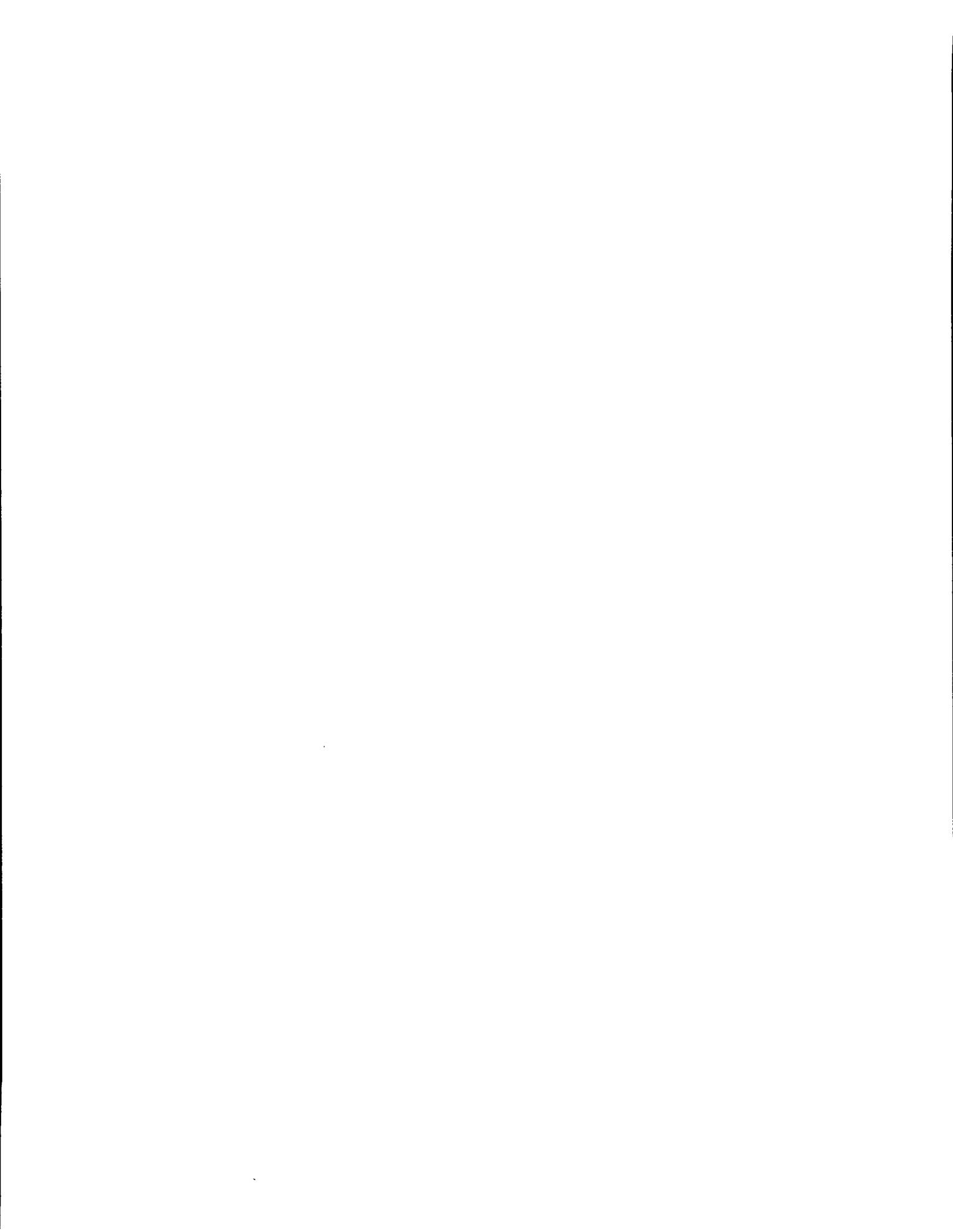
knowledge are true; and all statements made on information and belief are believed to be true.

PLASTI-FAB LTD.

Dated: October 26, 2010

By:   
Name: Bruce M. Carruthers  
Title: Chief Operating Officer

62942181 v1



# **EXHIBIT C**

ESTTA Tracking number: **ESTTA161073**

Filing date: **09/06/2007**

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

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	Plasti-Fab Ltd.		
Entity	Corporation	Citizenship	Canada
Address	3015 5th Avenue N.E., Suite 270 Calgary, AB T2A 6T8 CANADA		

Attorney information	David E. Sipiora Townsend and Townsend and Crew LLP 1200 17th Street, Suite 2700 Denver, CO 80202 UNITED STATES denverteas@townsend.com Phone:303.571.4000		
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**Applicant Information**

Application No	79023935	Publication date	08/07/2007
Opposition Filing Date	09/06/2007	Opposition Period Ends	09/06/2007
International Registration No.	0885067	International Registration Date	03/30/2006
Applicant	KOBELCO CONSTRUCTION MACHINERY CO., LTD. 12-4, Gion 3-chome Asaminami-ku, Hiroshima-shi Hiroshima, 7310138 JAPAN		

**Goods/Services Affected by Opposition**

Class 007. All goods and services in the class are opposed, namely: POWER SHOVELS AND CRANES
---

**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
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**Mark Cited by Opposer as Basis for Opposition**

U.S. Application No.	78431217	Application Date	06/07/2004
Registration Date	NONE	Foreign Priority Date	05/06/2004
Word Mark	GEOSPEC		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 017. First use: molded expanded polystyrene (EPS) blocks and boards designed to act as a lightweight fill material used in geotechnical applications and compressible inclusion against structures; expanded polystyrene (EPS) foundation drainage boards designed to provide insulation and drainage to hydrostatic pressure on foundations; and insulation for walls, pipes, utility lines and vessels

Attachments	78431217#TMSN.jpeg ( 1 page )( bytes ) GEOSPEC_opposition.pdf ( 5 pages )(1129630 bytes )
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Signature	/des/
Name	David E. Sipiora
Date	09/06/2007

TTAB

Atty. File No. 26694-000500

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

In the Matter of Application Serial No. 79/023935  
Published in the Official Gazette on August 7, 2007

PLASTI-FAB LTD.,	)	
	)	
Opposer,	)	Opposition No.
	)	
v.	)	
	)	
KOBELCO CONSTRUCTION MACHINERY CO., LTD,	)	
	)	
Applicant.	)	
	)	
	)	
	)	
	)	

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**NOTICE OF OPPOSITION**

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Plasti-Fab Ltd. ("Opposer"), a corporation duly organized and existing under the laws of the Canada, having its headquarters at 3015 5th Avenue N.E., Suite 270, Calgary, Alberta T2A 6T8 Canada, believes that it will be damaged by registration of the mark shown in Application Serial No. 79/023,935, and hereby opposes the same.

As grounds for opposition, Opposer alleges:

1. The mark GEOSPEC is in use by the Opposer for "molded expanded polystyrene (EPS) blocks and boards designed to act as a lightweight fill material used in geotechnical applications and compressible inclusion against structures; expanded polystyrene (EPS) foundation drainage boards designed to provide insulation and drainage to hydrostatic pressure on foundations; and insulation for walls, pipes, utility lines and vessels." As a result of such use, Opposer's GEOSPEC mark is well known to purchasers. By virtue of such use, Opposer has

established valuable goodwill in the mark, and the public has come to associate the GEOSPEC mark with Opposer and to know GEOSPEC as an indication of goods that emanate from Opposer

2. Opposer is the owner of the valid and subsisting U.S. Trademark Application Serial Number 78/431,217 for "GEOSPEC" for "molded expanded polystyrene (EPS) blocks and boards designed to act as a lightweight fill material used in geotechnical applications and compressible inclusion against structures; expanded polystyrene (EPS) foundation drainage boards designed to provide insulation and drainage to hydrostatic pressure on foundations; and insulation for walls, pipes, utility lines and vessels." A copy of the USPTO TESS database printout for this mark is attached hereto and incorporated herein as Exhibit A. The application was filed on June 7, 2004, based on priority of May 6, 2004, and was allowed for registration on July 10, 2007.

3. Applicant filed Serial No. 79/023,935 which is the subject of this Opposition, on March 30, 2006, for "Geospec" for use in connection with "power shovels and cranes." The application was filed based on § 66(a) of the Lanham Act (*i.e.*, extension of protection of a Madrid Protocol filing).

4. Opposer filed to register, and adopted and used the GEOSPEC mark, prior to Applicant's filing date of March 30, 2006.

5. The goods identified in Application Serial No. 79/023,935, for "Geospec" are substantially similar, overlap with, are sold to similar customers, and/or travel in the same channels of commerce as Opposer's goods sold under its well known GEOSPEC mark.

6. As a result of the public association of the well known GEOSPEC mark with Opposer, consumers are likely to consider Applicant's goods sold under the mark "Geospec" as emanating from or associated with or endorsed by Opposer, and to confuse those goods with those of Opposer.

7. Registration of the mark in Application Serial No. 79/023,935, and use of Applicant's mark is likely to cause confusion, or to cause mistake, or to deceive, particularly as to

the source or origin of the goods with which Applicant uses its mark, to induce purchasers to believe that the goods of Applicant are those of Opposer, or are endorsed by, or are in some way affiliated or associated with Opposer.

8. If Application Serial No. 79/023,935, for "Geospec" is permitted to register, the registration by Applicant would presumptively entitle it to *prima facie* exclusive ownership and rights to the mark "Geospec" and would, therefore, cause confusion among consumers of the relevant services as to the separate and distinct sources of Applicant's goods and Opposer's services and goods and the relationship of Opposer to Applicant, thereby damaging Opposer's goodwill in its GEOSPEC marks, diluting the value thereof and causing Opposer's business and reputation irreparable harm, all to the detriment of Opposer who has expended considerable sums and effort in promoting its mark.

Wherefore, Opposer prays that this Opposition be sustained and that registration of Application Serial No. 79/023,935, for "Geospec" be denied. The filing fee of \$300.00 should be charged to this firm's Deposit Account No. 20-1430 as required by 37 CFR §§ 2.101 and 2.6(a)(1'). The Commissioner also is authorized to charge any additional fees which may be required or credit any overpayment, to that Deposit Account.

Respectfully submitted,

TOWNSEND AND TOWNSEND AND CREW LLP

Date: September 6, 2007

By:

  
\_\_\_\_\_  
David E. Sipione  
1200 Seventeenth Street, Suite 2700  
Denver, CO 80202  
(303) 571-4000

Attorney for Opposer PLASTI-FAB LTD.

EXHIBIT A



United States Patent and Trademark Office

Home | Site Index | Search | FAQ | Glossary | Guides | Contacts | eBusiness | eBiz alerts | News | Help

Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Thu Sep 6 04:06:17 EDT 2007

TESS HOME NEW USER STRUCTURED FREE FORM BROWSER DICT SEARCH OG BOTTOM HELP

Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

TARR Status ASSIGN Status TDR TTAB Status ( Use the "Back" button of the Internet Browser to return to TESS)

GEOSPEC

Word Mark GEOSPEC  
 Goods and Services IC 017. US 001 005 012 013 035 050. G & S: molded expanded polystyrene (EPS) blocks and boards designed to act as a lightweight fill material used in geotechnical applications and compressible inclusion against structures; expanded polystyrene (EPS) foundation drainage boards designed to provide insulation and drainage to hydrostatic pressure on foundations; and insulation for walls, pipes, utility lines and vessels

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 78431217

Filing Date June 7, 2004

Current Filing Basis 1B;44E

Original Filing Basis 1B;44D;44E

Published for Opposition April 17, 2007

Owner (APPLICANT) Plasti-Fab Ltd. CORPORATION CANADA Suite 270 3015 5th Avenue N.E. Calgary, Alberta CANADA T2A 6T8

Attorney of Record Jessica Stone Levy

Priority Date May 6, 2004

Type of Mark TRADEMARK

Register PRINCIPAL

# EXHIBIT A

Live/Dead  
Indicator      LIVE

[TESS HOME](#) [NEW USER](#) [STRUCTURED](#) [FREE FORM](#) [BROWSER DICT](#) [SEARCH OG](#) [TOP](#) [HELP](#)

[| HOME](#) | [SITE INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [HELP](#) | [PRIVACY POLICY](#)



**EXHIBIT D**

ESTTA Tracking number: **ESTTA161613**

Filing date: **09/10/2007**

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

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	Plasti-Fab Ltd.		
Entity	Corporation	Citizenship	Canada
Address	3015 5th Avenue N.E., Suite 270 Calgary, AB T2A 6T8 CANADA		

Attorney information	David E. Sipiora Townsend and Townsend and Crew LLP 1200 17th Street, Suite 2700 Denver, CO 80202 UNITED STATES denverteas@townsend.com Phone:303.571.4000		
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**Applicant Information**

Application No	79023934	Publication date	08/14/2007
Opposition Filing Date	09/10/2007	Opposition Period Ends	09/13/2007
International Registration No.	0885066	International Registration Date	03/30/2006
Applicant	KOBELCO CONSTRUCTION MACHINERY CO., LTD. 12-4, Gion 3-chome Asaminami-ku, Hiroshima-shi Hiroshima, 7310138 JAPAN		

**Goods/Services Affected by Opposition**

Class 007. All goods and services in the class are opposed, namely: POWER SHOVELS AND CRANES
---

**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
--------------------------------------	----------------------------

**Mark Cited by Opposer as Basis for Opposition**

U.S. Application No.	78431217	Application Date	06/07/2004
Registration Date	NONE	Foreign Priority Date	05/06/2004
Word Mark	GEOSPEC		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 017. First use: molded expanded polystyrene (EPS) blocks and boards designed to act as a lightweight fill material used in geotechnical applications and compressible inclusion against structures; expanded polystyrene (EPS) foundation drainage boards designed to provide insulation and drainage to hydrostatic pressure on foundations; and insulation for walls, pipes, utility lines and vessels

Attachments	78431217#TMSN.jpeg ( 1 page )( bytes ) ACERAGEOSPEC_opposition.pdf ( 5 pages )(168776 bytes )
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Signature	/des/
Name	David E. Sipiora
Date	09/10/2007

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

In the Matter of Application Serial No. 79/023,934  
Published in the Official Gazette on August 14, 2007

PLASTI-FAB LTD.,	)	
	)	
Opposer,	)	Opposition No.
	)	
v.	)	
	)	
KOBELCO CONSTRUCTION	)	
MACHINERY CO., LTD,	)	
	)	
Applicant.	)	
	)	
	)	
	)	
	)	
	)	

---

**NOTICE OF OPPOSITION**

---

Plasti-Fab Ltd. ("Opposer"), a corporation duly organized and existing under the laws of the Canada, having its headquarters at 3015 5th Avenue N.E., Suite 270, Calgary, Alberta T2A 6T8 Canada, believes that it will be damaged by registration of the mark shown in Application Serial No. 79/023,934, and hereby opposes the same.

As grounds for opposition, Opposer alleges:

1. The mark GEOSPEC is in use by the Opposer for "molded expanded polystyrene (EPS) blocks and boards designed to act as a lightweight fill material used in geotechnical applications and compressible inclusion against structures; expanded polystyrene (EPS) foundation drainage boards designed to provide insulation and drainage to hydrostatic pressure on foundations; and insulation for walls, pipes, utility lines and vessels." As a result of such use, Opposer's GEOSPEC mark is well known to purchasers. By virtue of such use, Opposer has

established valuable goodwill in the mark, and the public has come to associate the GEOSPEC mark with Opposer and to know GEOSPEC as an indication of goods that emanate from Opposer.

2. Opposer is the owner of the valid and subsisting U.S. Trademark Application Serial Number 78/431,217 for GEOSPEC for "molded expanded polystyrene (EPS) blocks and boards designed to act as a lightweight fill material used in geotechnical applications and compressible inclusion against structures; expanded polystyrene (EPS) foundation drainage boards designed to provide insulation and drainage to hydrostatic pressure on foundations; and insulation for walls, pipes, utility lines and vessels." A copy of the USPTO TESS database printout for this mark is attached hereto and incorporated herein as Exhibit A. The application was filed on June 7, 2004, based on priority of May 6, 2004, and was allowed for registration on July 10, 2007.

3. Applicant filed Serial No. 79/023,934 which is the subject of this Opposition, on March 30, 2006, for "ACERA GEOSPEC (stylized)" for use in connection with "power shovels and cranes." The application was filed based on § 66(a) of the Lanham Act (*i.e.*, extension of protection of a Madrid Protocol filing).

4. Opposer filed to register, and adopted and used the GEOSPEC mark, prior to Applicant's filing date of March 30, 2006.

5. The goods identified in Application Serial No. 79/023,934, for "ACERA GEOSPEC (stylized)" are substantially similar, overlap with, are sold to similar customers, and/or travel in the same channels of commerce as Opposer's goods sold under its well known GEOSPEC mark.

6. As a result of the public association of the well known GEOSPEC mark with Opposer, consumers are likely to consider Applicant's goods sold under the mark "ACERA GEOSPEC (stylized)" as emanating from or associated with or endorsed by Opposer, and to confuse those goods with those of Opposer.

7. Registration of the mark in Application Serial No. 79/023,934, and use of Applicant's mark is likely to cause confusion, or to cause mistake, or to deceive, particularly as to the source or origin of the goods with which Applicant uses its mark, to induce purchasers to believe that the goods of Applicant are those of Opposer, or are endorsed by, or are in some way affiliated or associated with Opposer.

8. If Application Serial No. 79/023,934, for "ACERA GEOSPEC (stylized)" is permitted to register, the registration by Applicant would presumptively entitle it to *prima facie* exclusive ownership and rights to the mark "ACERA GEOSPEC (stylized)" and would, therefore, cause confusion among consumers of the relevant services as to the separate and distinct sources of Applicant's goods and Opposer's services and goods and the relationship of Opposer to Applicant, thereby damaging Opposer's goodwill in its GEOSPEC mark, diluting the value thereof and causing Opposer's business and reputation irreparable harm, all to the detriment of Opposer who has expended considerable sums and effort in promoting its mark.

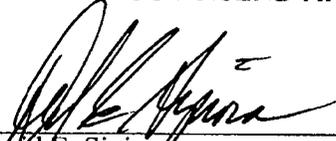
Wherefore, Opposer prays that this Opposition be sustained and that registration of Application Serial No. 79/023,934, for "ACERA GEOSPEC (stylized)" be denied. The filing fee of \$300.00 should be charged to this firm's Deposit Account No. 20-1430 as required by 37 CFR §§ 2.101 and 2.6(a)(17). The Commissioner also is authorized to charge any additional fees which may be required, or credit any overpayment, to that Deposit Account.

Respectfully submitted,

TOWNSEND AND TOWNSEND AND CREW LLP

Date: September 7, 2007

By:

  
\_\_\_\_\_  
David E. Sipiora  
1200 Seventeenth Street, Suite 2700  
Denver, CO 80202  
(303) 571-4000

Attorney for Opposer PLASTI-FAB LTD.



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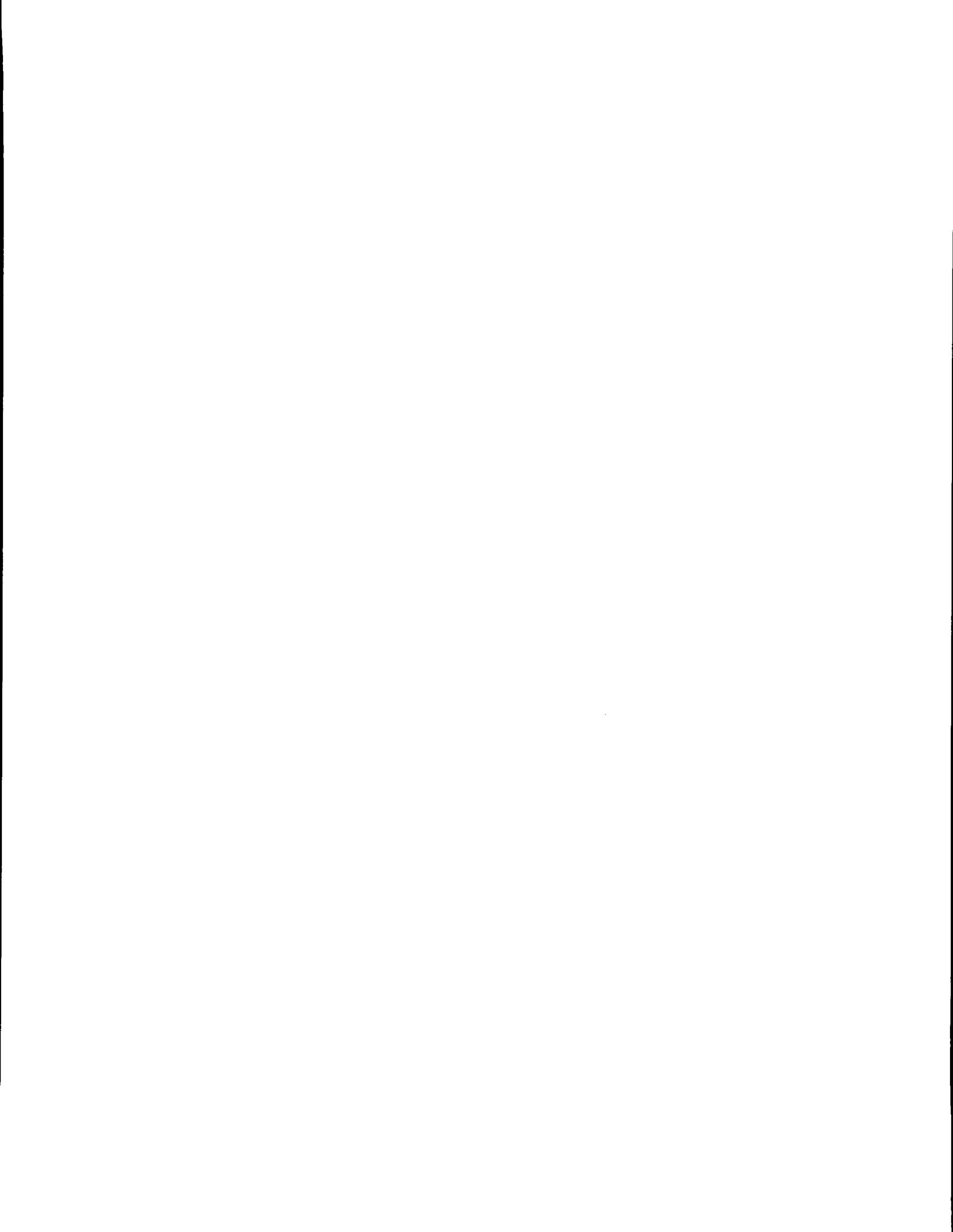
**GEOSPEC**

**Word Mark** GEOSPEC  
**Goods and Services** IC 017. US 001 005 012 013 035 050. G & S: molded expanded polystyrene (EPS) blocks and boards designed to act as a lightweight fill material used in geotechnical applications and compressible inclusion against structures; expanded polystyrene (EPS) foundation drainage boards designed to provide insulation and drainage to hydrostatic pressure on foundations; and insulation for walls, pipes, utility lines and vessels  
**Standard Characters Claimed**  
**Mark Drawing Code** (4) STANDARD CHARACTER MARK  
**Serial Number** 78431217  
**Filing Date** June 7, 2004  
**Current Filing Basis** 1B;44E  
**Original Filing Basis** 1B;44D;44E  
**Published for Opposition** April 17, 2007  
**Owner** (APPLICANT) Plasti-Fab Ltd. CORPORATION CANADA Suite 270 3015 5th Avenue N.E. Calgary, Alberta CANADA T2A 6T8  
**Attorney of Record** Jessica Stone Levy  
**Priority Date** May 6, 2004  
**Type of Mark** TRADEMARK  
**Register** PRINCIPAL

Live/Dead  
Indicator      LIVE

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**EXHIBIT E**



3. Applicant admits that it is the owner of the mark in U.S. Application No. 79/023,935.
4. Applicant lacks sufficient knowledge and information to form a belief as to the allegations in Paragraph 4 and therefore denies the same.
5. Denied.
6. Denied.
7. Denied.
8. Applicant admits that registration of the mark in U.S. Application Serial No. 79/023,935 would presumptively entitle it to *prima facie* exclusive ownership and rights to the mark 'GEOSPEC (stylized).'" Applicant denies the remaining allegations in Paragraph 8.

#### AFFIRMATIVE DEFENSES

1. There is no likelihood of confusion because the marks are distinguishable, the parties' goods and services are different and distinguishable, the consumers and trade channels are different, and the consumers of both parties' goods and services are knowledgeable and sophisticated.

WHEREFORE, Applicant requests that the Opposition be denied; that Application Serial No. 79/023,935 be allowed to register; and for such further relief as may be proper.

Respectfully submitted,

Kobelco Construction Machinery Co., Ltd.

By 

Bassam N. Ibrahim

Bryce J. Maynard

Jennifer L. Williston

Attorneys for Applicant

Date: 10/23/2007

Buchanan Ingersoll & Rooney PC  
1737 King Street, Suite 500  
Alexandria, Virginia 22314-2727  
Telephone: 703-836-6620

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing Applicant's **ANSWER TO NOTICE OF OPPOSITION** was served this 23rd day of October, 2007 by first-class mail, postage prepaid, on:

David E. Sipiora  
Townsend and Townsend and Crew LLP  
1200 17th Street, Suite 2700  
Denver, CO 80202

  
Mary E. Harrison



**EXHIBIT F**

**TTAB**



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

Plasti-Fab Ltd., )  
)

Opposer, )  
)

v. )  
)

Kobelco Construction Machinery Co., Ltd., )  
)

Applicant )  
)

Attorney Docket: 1033715-000032 )  
)

79023934

Opposition No. 91179482

**ANSWER TO NOTICE OF OPPOSITION**

Applicant Kobelco Construction Machinery Co., Ltd. ("Applicant") hereby responds to the allegations in Opposer Plasti-Fab Ltd.'s ("Opposer") Notice of Opposition as follows:

1. Applicant denies that Opposer's mark is well known to purchasers. Applicant denies that Opposer has established goodwill in the mark and that the public has come to associate the GEOSPEC mark with Opposer. Applicant denies that the public has come to know the GEOSPEC mark as an indication of goods that emanate from Opposer. Applicant lacks sufficient knowledge and information to form a belief as to the remaining allegations in Paragraph 1, and therefore denies same.

2. Applicant admits that USPTO records reflect that Opposer is the owner of the mark GEOSPEC in U.S. Application Serial No. 78/431,217. Applicant lacks sufficient knowledge and information to form a belief as to the remaining allegations in Paragraph 2, and therefore denies same.



10-23-2007

3. Applicant admits that it is the owner of the mark in U.S. Application No. 79/023,934.
4. Applicant lacks sufficient knowledge and information to form a belief as to the allegations in Paragraph 4 and therefore denies the same.
5. Denied.
6. Denied.
7. Denied.
8. Applicant admits that registration of the mark in U.S. Application Serial No. 79/023,394 would presumptively entitle it to *prima facie* exclusive ownership and rights to the mark 'ACERA GEOSPEC (stylized).'" Applicant denies the remaining allegations in Paragraph 8.

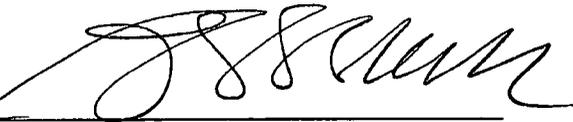
#### **AFFIRMATIVE DEFENSES**

1. There is no likelihood of confusion because the marks are distinguishable, the parties' goods and services are different and distinguishable, the consumers and trade channels are different, and the consumers of both parties' goods and services are knowledgeable and sophisticated.

WHEREFORE, Applicant requests that the Opposition be denied; that Application Serial No. 79/023,934 be allowed to register; and for such further relief as may be proper.

Respectfully submitted,

Kobelco Construction Machinery Co., Ltd.,

By 

Bassam N. Ibrahim  
Bryce J. Maynard  
Jennifer L. Williston  
Attorneys for Applicant

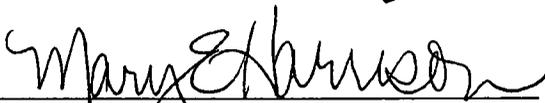
Date: 10/23/2007

Buchanan Ingersoll & Rooney PC  
1737 King Street, Suite 500  
Alexandria, Virginia 22314-2727  
Telephone: 703-836-6620

**CERTIFICATE OF SERVICE**

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1200 17th Street, Suite 2700  
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\_\_\_\_\_  
Mary E. Harrison

