

ESTTA Tracking number: **ESTTA525654**

Filing date: **03/08/2013**

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	Knaack LLC
Granted to Date of previous extension	03/09/2013
Address	420 E. Terra Cotta Ave. Crystal Lake, IL 60014 UNITED STATES

Attorney information	Anthoula Pomrening; Sydney R. Kokjohn McDonnell Boehnen Hulbert & Berghoff LLP 300 S. Wacker Drive Chicago, IL 60606 UNITED STATES pomrening@mbhb.com, kokjohn@mbhb.com
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**Applicant Information**

Application No	85630521	Publication date	01/08/2013
Opposition Filing Date	03/08/2013	Opposition Period Ends	03/09/2013
Applicants	Bricks & Bytes Information Technology Services Inc. c/o Stemp & Company 1100 - 8th Avenue S.W., Suite 233 Calgary, Alberta, T2P3T8 CANADA  1311709 Alberta Ltd. c/o Stemp & Company 1100 - 8th Avenue S.W., Suite 233 Calgary, Alberta, T2P3T8 CANADA		

**Goods/Services Affected by Opposition**

Class 035. All goods and services in the class are opposed, namely: Providing a website promoting the goods and services of others via referrals for homeowners in the field of building suppliers and skilled tradesmen for home renovations
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**Grounds for Opposition**

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

U.S. Registration No.	1182982	Application Date	09/02/1980
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Registration Date	12/22/1981	Foreign Priority Date	NONE
Word Mark	KNAACK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 020. First use: First Use: 1963/00/00 First Use In Commerce: 1963/00/00 Job-Site Storage Units-Namely, Cabinets, Chests, Benches and Structural Parts Thereof		

U.S. Registration No.	1897535	Application Date	03/07/1994
Registration Date	06/06/1995	Foreign Priority Date	NONE
Word Mark	K KNAACK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 020. First use: First Use: 1980/05/23 First Use In Commerce: 1980/05/23 job-site storage units, namely tool cabinets, tool chests, workbenches and tool boxes and structural parts thereof		

Attachments	74497454#TMSN.gif ( 1 page )( bytes ) Notice of Opposition for KNACKTHAT 2013 03 08.pdf ( 7 pages )(89312 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Sydney R. Kokjohn/
Name	Sydney R. Kokjohn
Date	03/08/2013

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

In the Matter of Trademark Application Serial No. 85/630,521  
Filed May 21, 2012  
For the Mark: KNACKTHAT  
Published in the Official Gazette (Trademarks) on January 8, 2013

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KNAACK LLC,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. _____
	)	
BRICKS & BYTES INFORMATION	)	
TECHNOLOGY SERVICES d/b/a/ KNACKTHAT,	)	
	)	
Applicant.	)	

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**Trademark Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1451  
Alexandria, VA 22313-1451**

**NOTICE OF OPPOSITION**

Opposer, Knaack LLC, hereby opposes the registration of the service mark KNACKTHAT filed by Bricks & Bytes Information Technology Services d/b/a KNACKTHAT in Application Serial No. 85/630,521 on May 21, 2012 and published for opposition on January 8, 2013. Opposer obtained an extension of time for filing the present Notice of Opposition, which is being timely filed.

## **Parties**

1. Opposer, Knaack LLC ("Knaack"), is a limited liability corporation organized under laws of the state of Delaware with its principal place of business at 420 E. Terra Cotta Ave., Crystal Lake, Illinois.

2. Applicant, Bricks & Bytes Information Technology Services, d/b/a KNACKTHAT ("Applicant"), on information and belief, is a corporation organized under the laws of Canada with a place of business at 8<sup>th</sup> Avenue, S.W., Suite 233, Calgary, Alberta, T2P3T8, Canada.

## **Opposer's Business And Trademarks**

3. Since at least as early as 1963, Knaack has been continuously and exclusively using the mark KNAACK throughout the United States in connection with a wide range of products, including jobsite storage units, used by contractors, carpenters, workman, and tradespeople generally. Knaack's use of the mark has never been abandoned. To the contrary, Knaack and the Knaack trademarks have become strongly respected among contractors, carpenters, workmen, and tradespeople generally.

4. Knaack is the owner of all rights in U.S. Federal Trademark Registration Nos. 1,182,982 and 1,897,535 for KNAACK in connection with jobsite storage units, namely cabinets, chests, benches and structural parts therefor.

5. In addition to jobsite storage units, Knaack is well-known for its manufacture and sale of a broad range of other products used by the contractor trade including, but not limited to, prepackaged van and minivan interior modules for storage and shelving; van shelves, cabinets and shelf accessories, namely, work tops, bin boxes and bin dividers, hard hat racks, fire extinguisher racks, retainer lips, stacking brackets, shelf mats, doors and back panels; freon tank

racks and wire spool racks; file boxes; window screens; vehicle bulkhead panels and bulkhead custom accessories, namely, binder files, spare tire chocks, literature holders, hard hat racks, fire extinguisher holders, extension cord brackets, spare tire brackets, first aid kit trays, window covers and safety reflectors; stabilizers; floor mats for vans and minivans; cab screens and cab protectors for attachment to rear windows of trucks; vehicle service body racks; ladder guides; sliding platforms and rails for all land vehicles; storage boxes, tool boxes, strong boxes, small parts boxes, ladder racks, storage racks, storage trays, storage cabinets, drawer storage units, conduit storage units, shelving units, transfer tanks for combustible and non-combustible liquids, and bulkheads, all for land vehicles.

6. Knaack also offers under the KNAACK mark a Dealer Locator service at [www.provantage.knaack.com/DealerLocator](http://www.provantage.knaack.com/DealerLocator), which can be accessed via the Knaack and Weather Guard websites. This service allows a contractor to locate a nearby dealer who sells KNAACK and WEATHER GUARD brand products.

7. Knaack promotes all of its products and services via its websites at [www.knaack.com](http://www.knaack.com) and [www.weatherguard.com](http://www.weatherguard.com).

8. Knaack has invested substantial time, effort, and money in using and promoting its KNAACK mark and the goods bearing it. By virtue of Knaack's development efforts, considerable promotional expenditures, and high quality of its products, the purchasing public of the United States has come to and does recognize the KNAACK mark as being used by Knaack or by a single source, and to associate and identify the KNAACK mark with Knaack, or a single source, such that Knaack derives substantial goodwill and value from identification by the consuming public and trade.

### **Applicant's Activities**

9. Subsequent to Knaack's establishment of its trademark rights, on information and belief, Applicant filed Application Serial No. 85/630,521 and sought to obtain registration on the Principal Register for the service mark KNACKTHAT for "providing a website promoting the goods and services of others via referrals for homeowners in the field of building suppliers and skilled tradesmen for home renovations."

10. On information and belief, Applicant appears to be using the KNACKTHAT mark in the United States and the earliest priority date upon which Applicant can rely is May 21, 2012, the filing date of Application Serial No. 85/630,521.

11. On information and belief, Applicant sought to register the KNACKTHAT mark without the consent of Knaack.

12. Knaack is not affiliated in any manner with Applicant, and Knaack has not authorized Applicant's use or application to register KNACKTHAT.

13. Applicant's KNACKTHAT mark is confusingly similar in sight, sound, connotation, and commercial impression to the KNAACK mark used by Knaack.

14. The services identified in Applicant's KNACKTHAT application, "providing a website promoting the goods and services of others via referrals for homeowners in the field of building suppliers and skilled tradesmen for home renovations," are similar to or related to the goods offered by Knaack, including job-site storage units, namely cabinets, chests, benches and structural parts therefor, and the services offered by Knaack that are promoted by Knaack on its websites to contractors and tradespeople.

15. Registration of KNACKTHAT by Applicant is likely to cause the public to be confused, misled, or deceived, and to falsely believe that Applicant's services are affiliated,

connected, or associated with; originate from; or are approved or sponsored by Knaack or others authorized or licensed by Knaack to use the KNAACK mark. Persons familiar with Knaack's mark are likely to purchase Applicant's services believing they are marketed by, affiliated with or endorsed by Knaack, when in fact they are not.

16. Registration and use of KNACKTHAT by Applicant is likely to cause Knaack damage, including financial harm.

### **GROUND I – LIKELIHOOD OF CONFUSION**

17. Knaack incorporates by reference the allegations of Paragraphs 1 through 16 as if fully set forth herein.

18. Through actual use in commerce, Knaack has established prior use of the KNAACK mark well before Applicant's application to register the mark KNACKTHAT.

19. Knaack's nationwide use of the KNAACK mark in connection with services and products used by the contractor trade, including, but not limited to, jobsite storage units, namely cabinets, chests, benches and structural parts therefor, and has generated extensive good will and consumer recognition.

20. Applicant's KNACKTHAT mark so closely resembles Knaack's KNAACK mark that, if used in connection with the applied-for services, it would be likely to cause confusion, mistake or deception of the relevant trade and public.

21. By reason of the foregoing, Knaack believes that it will be damaged by registration of Applicant's KNACKTHAT mark.

**Claim for Relief**

22. In light of the above, Opposer requests that the Office refuse registration of the mark KNACKTHAT in Application Serial No. 85/630,521.

23. The filing fee for this Opposition in the amount of \$300.00 is being filed online.

Respectfully submitted,

Dated: March 8, 2013

/Sydney R. Kokjohn/  
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Attorneys for the Opposer,  
KNAACK LLC.

**CERTIFICATE OF TRANSMITTAL**

I hereby certify that on March 8, 2013, this correspondence is being electronically transmitted in PDF format the Trademark Trial and Appeal Board through the Electronic System for Trademark Trials and Appeals (ESTTA).

/Sydney R. Kokjohn/  
Sydney R. Kokjohn

**CERTIFICATE OF SERVICE**

I hereby certify that on March 8, 2013, this correspondence is being served via email communication and First Class mail, postage prepaid, to Applicant's Attorney of Record as reflected in the TARR database:

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