

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

**In the Matter of Registration Nos.  
534,259; 1,391,401; 1,927,755; 2,087,020**



11-14-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

**JOHN L. MINASIAN,**

Petitioner,

v.

**SEARS, ROEBUCK AND CO.,**

Respondent.

**Cancellation No. 92041607**

**ANSWER AND AFFIRMATIVE DEFENSES TO FIRST AMENDED  
PETITION FOR RESTRICTION OF INCONTESTABLE REGISTRATIONS**

Respondent Sears, Roebuck and Co. ("SEARS"), through its counsel, hereby ANSWERS Petitioner John L. Minasian's ("Petitioner") first amended petition to restrict, or petition to partially cancel or modify, SEARS' incontestable registrations, namely Reg. Nos. 534,259; 1,391,401; 1,927,755; and 2,087,020, under 15 U.S.C. Section 1068, as follows:

**ANSWER TO GENERAL ALLEGATIONS**

With respect to Petitioner's first introductory paragraph in its First Amended Petition for Restriction, SEARS is without information or knowledge sufficient to form a belief as to the truth of the allegations regarding Petitioner's principal place of business. Consequently, SEARS denies such allegations. SEARS admits the allegation that Petitioner is petitioning the Board to restrict SEARS' Registration Nos. 534,259; 1,391,401; 1,927,755; and 2,087,020 (the "Subject

Registrations”). Finally, the remaining allegation in the first introductory paragraph to the Petition to Restrict is a statement as to Petitioner’s opinion to which no answer is required. Consequently, SEARS does not respond to this final allegation in the first introductory paragraph.

With respect to the second introductory paragraph of the Petition to Restrict, SEARS states as follows: On February 1, 2003, SEARS assigned the Subject Registrations, and all common law rights associated therewith, and all goodwill symbolized thereby, to Sears Brands, LLC, an Illinois limited liability company. SEARS admits that it has a place of business at 3333 Beverly Road, Hoffman Estates, Illinois 60179.

1. SEARS is without information or knowledge sufficient to form a belief as to the truth of the allegations of paragraph 1 and therefore denies each allegation.
2. SEARS is without information or knowledge sufficient to form a belief as to the truth of the allegations in paragraph 2 and therefore denies each and every allegation in paragraph 2. SEARS admits that as of March 24, 2003, the U.S Patent and Trademark Office’s (“PTO”) online database reflects: that Ser. No. 76/266,055 was filed on June 4, 2001, that the PTO issued a non-final Office Action in connection with this application on August 1, 2001, and that the PTO issued a final Office Action in connection with this application on April 4, 2002.
3. SEARS is without information or knowledge sufficient to form a belief as to the truth of the allegations in paragraph 3 and therefore denies each and every allegation.
4. SEARS is without information or knowledge sufficient to form a belief as to the truth of the allegations in paragraph 4 and therefore denies each and every allegation.
5. SEARS denies the allegations in paragraph 5 that its use of the mark CRAFTSMAN for “chisels, files, hand drills, hammers, screwdrivers, hand wrenches, shovels”

and “shaping files, socket wrenches, ratchet wrenches, combination wrenches, ignition wrenches” and “clothing, namely suspenders, belts, hats, gloves” and “lug wrenches and spring clamps” “always has been, and continues to be” subject to the restrictions in paragraph 5(a), 5(b) and/or 5(c).

6. SEARS denies the allegations in paragraph 6 that the “aforementioned restrictions are well established in the marketplace and are generally known to the public” and that these “restrictions characterize the public’s image of the CRAFTSMAN trademark and of the exclusive relationship between the CRAFTSMAN trademark and SEARS ROEBUCK AND CO.”

7. SEARS admits the allegation in paragraph 7 that Petitioner is not affiliated with SEARS. SEARS is without information or knowledge sufficient to form a belief as to the truth of the remaining allegations of paragraph 7 and therefore denies such allegations.

8. SEARS denies the allegations of paragraph 8. Affirmatively, SEARS states that the restrictions Petitioner seeks in its First Amended Petition for Restriction will not avoid a “likelihood of confusion” between U.S. Registration Nos. 534,259; 576,891; 1,391,401; 1,923,340; 1,927,755; and 2,087,020; and Petitioner’s intent-to-use application for CRAFTSWOMAN, Ser. No. 76/266,055.

9. SEARS denies the allegations of paragraph 9. Affirmatively, SEARS states that (1) its use of the CRAFTSMAN mark is not limited to the “terms and conditions” identified by Petitioner; and (2) the restrictions Petitioner seeks in its First Amended Petition for Restriction will not avoid a “likelihood of confusion” between U.S. Registration Nos. 534,259; 576,891; 1,391,401; 1,923,340; 1,927,755; and 2,087,020; and Petitioner’s intent-to-use application for CRAFTSWOMAN, Ser. No. 76/266,055.

**AFFIRMATIVE DEFENSES**

In further response, SEARS asserts the following:

1. Pursuant to Federal Rule of Civil Procedure 12(f), SEARS moves to strike section (c) of paragraph 5 of the First Amended Petition for Restriction on the ground that the paragraph consists of allegations that are immaterial and impertinent to the First Amended Petition for Restriction.

2. The entry of the proposed restrictions to the goods in the Subject Registrations will not avoid a "likelihood of confusion" between U.S. Registration Nos. 534,259; 576,891; 1,391,401; 1,923,340; 1,927,755; and 2,087,020; and Petitioner's intent-to-use application for CRAFTSWOMAN, Ser. No. 76/266,055.

3. SEARS is using its CRAFTSMAN mark in the channels of trade that will be effectively excluded from the Subject Registrations, if the restrictions Petitioner is petitioning for are entered into the Subject Registrations.

4. Petitioner is barred from petitioning to restrict the Subject Registrations by waiver, estoppel, and acquiescence.

5. Petitioner is barred from petitioning to restrict the Subject Registrations by unclean hands.

6. Petitioner is barred from petitioning to restrict the Subject Registrations by fraud.

7. The Subject Registrations do not violate Petitioner's rights under the trademark laws of the United States or any other laws.

WHEREFORE, Respondent SEARS respectfully requests that (1) Petitioner's request for relief be denied in its entirety and (2) the First Amended Petition for Restriction be dismissed with prejudice.

Dated: 11/14/03

Respectfully submitted,



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ATTORNEY FOR RESPONDENT  
SEARS, ROEBUCK AND CO.

**Certificate of Service**

I hereby certify that on the 14<sup>th</sup> day of November, 2003, I mailed a true and correct copy of the foregoing ANSWER AND AFFIRMATIVE DEFENSES TO FIRST AMENDED PETITION FOR RESTRICTION OF INCONTESTABLE REGISTRATIONS in the United States Mail, proper postage prepaid, addressed to:

ROBERT LOUIS FINKEL  
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**CERTIFICATE OF MAILING BY EXPRESS MAIL**

Box TTAB  
Commissioner of Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

The undersigned hereby certifies that the attached ANSWER AND AFFIRMATIVE DEFENSES TO FIRST AMENDED PETITION FOR RESTRICTION OF INCONTESTABLE REGISTRATIONS, certificate of service to opposing counsel and return card were deposited as "Express Mail", Mailing Label No EV259741918US with the United States Postal Service, addressed to Assistant Commissioner of Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 on November 14, 2003.

11/14/2003  
Date

11/14/03  
Date

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