

TTAB

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Express Mail No. EL699481275US

**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**

03-25-2003
U.S. Patent & TMO/TM Mail Rcpt Dt. #58
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JOHN L. MINASIAN,

Petitioner,

v.

SEARS, ROEBUCK AND CO.,

Respondent.

Cancellation No. 92041607

**ANSWER AND AFFIRMATIVE DEFENSES TO PETITION TO RESTRICT
INCONTESTABLE REGISTRATIONS, UNDER 15 U.S.C. SECTION 1068**

Respondent Sears, Roebuck and Co. ("SEARS"), through its counsel, hereby ANSWERS Petitioner John L. Minasian's ("Petitioner") 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.

1. With respect to Petitioner's first introductory paragraph in its Petition to Restrict, 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

[Handwritten mark]

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.

2. With respect to the second introductory paragraph of the Petition to Restrict, SEARS denies that it is the owner of the Subject Registrations. 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.

3. SEARS is without information or knowledge sufficient to form a belief as to the truth of the allegations in the first numbered paragraph, or paragraph 1, of the Petition to Restrict and therefore denies such allegations.

4. SEARS is without information or knowledge sufficient to form a belief as to the truth of the allegations in paragraph 2 of the Petition to Restrict 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.

5. SEARS is without information or knowledge sufficient to form a belief as to the truth of the allegations in paragraph 3 of the Petition to Restrict and therefore denies each and every allegation.

6. SEARS is without information or knowledge sufficient to form a belief as to the truth of the allegations in paragraph 4 of the Petition to Restrict and therefore denies each and every allegation.

7. SEARS denies that its use of the mark CRAFTSMAN for “chisels, files, hand drills, hammers, screwdrivers, hand wrenches, shovels, shaping files, socket wrenches, ratchet wrenches, combination wrenches, ignition wrenches, clothing, namely suspenders, belts, hats, gloves, 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) of the Petition to Restrict.

8. SEARS denies the allegations in paragraph 6 of the Petition to Restrict that “The aforementioned restrictions are well-established in the marketplace and are generally known to the public.”; and that “These restrictions characterize the public image of SEARS and SEARS ROEBUCK AND CO.” SEARS is without information or knowledge sufficient to form a belief as to the truth of the allegation in paragraph 6 of the Petition to Restrict that the proposed restrictions “auger against a likelihood of confusion” as SEARS does not understand the use of the term “auger” in this context, and therefore, denies this allegation. Finally, SEARS denies that the restrictions Petitioner seeks in its Petition to Restrict will 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 that the restrictions Petitioner seeks in its Petition to Restrict will 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 to the Petition to Restrict, SEARS asserts the following affirmative defenses:

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

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 the doctrines of waiver, estoppel, and acquiescence.

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

6. Petitioner is barred from petitioning to restrict the Subject Registrations by the doctrine of 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 judgment in its favor, dismissing Applicant’s Petition to Restrict with prejudice.

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Dated: 3/25/2003

Respectfully submitted,



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SEARS, ROEBUCK AND CO.

Certificate of Service

I hereby certify that on the 25 day of March, 2003, I mailed a true and correct copy of the foregoing ANSWER AND AFFIRMATIVE DEFENSES TO PETITION TO RESTRICT INCONTESTABLE REGISTRATIONS, UNDER 15 U.S.C. SECTION 1068 in the United States Mail, proper postage prepaid, addressed to:

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