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**UNITED STATES PATENT AND TRADEMARK
OFFICE**

Trademark Trial and Appeal Board

2900 Crystal Drive
Arlington, Virginia 22202-3513

Mailed: July 21, 2004

Actek Enterprises, Inc.
11911 Hamden Place
Santa Fe Springs, CA 90670

Cancellation No. 92043520
Reg. No. 2724479

BRUCE A. JAGGER
P.O. BOX 2900
GLENDALE, CA 91209-9000

CBC INDUSTRIES, INC.

V.

Actek Enterprises, Inc.

George Woods, Legal Assistant:

A petition, a copy of which is attached, has been filed to cancel the above-identified registration.

Proceedings will be conducted in accordance with the Trademark Rules of Practice.

ANSWER IS DUE FORTY DAYS after the mailing date hereof. (See Trademark Rule 2.196 for expiration date falling on Saturday, Sunday or a holiday).

Proceedings will be conducted in accordance with the Trademark Rules of Practice, set forth in Title 37, part 2, of the Code of Federal Regulations. The parties are reminded of the recent amendments to the Trademark Rules that affect the rules of practice before the TTAB. See Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. R. 55,748 (September 26, 2003) (effective November 2, 2003); Reorganization of Correspondence and Other Provisions, 68 Fed. Reg. 48,286 (August 13, 2003) (effective September 12, 2003). Notices concerning the rules changes, as well as the

Trademark Trial and Appeal Board Manual of Procedure (TBMP), are available at www.uspto.gov.

The parties are particularly referred to Trademark Rule 2.126 pertaining to the form of submissions. Paper submissions, including but not limited to exhibits and depositions, not filed in accordance with Trademark Rule 2.126 may not be given consideration or entered into the case file.

Discovery and testimony periods are set as follows:

Discovery period to open:	August 10, 2004
Discovery period to close:	February 06, 2005
30-day testimony period for party in position of plaintiff to close:	May 07, 2005
30-day testimony period for party in position of defendant to close:	July 06, 2005
15-day rebuttal testimony period for plaintiff to close:	August 20, 2005

A party must serve on the adverse party a copy of the transcript of any testimony taken during the party's testimony period, together with copies of documentary exhibits, within 30 days after completion of the taking of such testimony. See Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

NOTE: The Board allows parties to utilize telephone conferences to discuss or resolve many interlocutory matters that arise in inter partes cases. See the *Official Gazette* notice titled "Permanent Expansion of Telephone Conferencing on Interlocutory Matters in Inter Partes Cases Before the Trademark Trial and Appeal Board," 1235 TMOG 68 (June 20, 2000). The notice is available at <http://www.uspto.gov>. Interlocutory matters which the Board agrees to discuss or decide by phone conference may

be decided adversely to any party which fails to participate.

If the parties to this proceeding are also parties to other Board proceedings involving related marks or, during the pendency of this proceeding, they become parties to such proceedings, they should notify the Board immediately, so that the Board can consider consolidation of proceedings.

New Developments at the Trademark Trial and Appeal Board

TTAB forms for electronic filing of extensions of time to oppose, notices of opposition, and inter partes filings are now available at <http://estta.uspto.gov>. Images of TTAB proceeding files can be viewed using TTABVue at <http://ttabvue.uspto.gov>.

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

In The Matter Of:
Trademark Registration No.: 2,724,479
For The Mark: ACTEK HEAVY DUTY
Date Registered: June 10, 2003

CBC Industries, Inc.

v.

Actek Enterprises, Inc.

Cancellation No.: _____

PETITION TO CANCEL

Your Petitioner:

CBC Industries, Inc.
a Maryland Corporation
licensed to do business in California as CBC Industries, Inc.
and having a place of business at
7141 A Paramount Blvd.
Pico Rivera, CA 90660

believes that it will be damaged by the above-identified registration, and hereby petitions to
cancel the same as to all Classes.

To the best of petitioner's knowledge, the name and address of the current owner of the
registration are:

Actek Enterprises, Inc.
11911 Hamden Place
Santa Fe Springs, CA 90670

The grounds for cancellation are as follows:

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1. Petitioner is a corporation in good standing of the State Of Maryland, licensed to do business in the State of California as CBC Industries, Inc.

2. Registrant is on information and belief a corporation of the State of California.

3. Beginning at least as early as 1989, and continuously at all times since, Petitioner's has used the mark HEAVY DUTY in connection with the sales, distribution, and marketing in commerce of its host rings and components therefor. Such use has been valid, substantial, and continuous since at least as early as 1989, and has not been abandoned. Petitioner's HEAVY DUTY trademark is symbolic of, has at all times mentioned herein been symbolic of, or has come since prior to 1998 to symbolize extensive goodwill and consumer recognition built up by Petitioner through substantial amounts of time, effort and expense in advertising and promotion. Petitioner has continuously since 1989 extensively advertised and promoted and made substantial sales throughout the United States and elsewhere of its goods bearing its HEAVY DUTY trademark. Respondent's registered mark so resembles Petitioner's mark as to be likely to cause confusion, or to cause mistake, or to deceive.

4. Petitioner's mark so resembles Registrant's mark as to be likely, when applied to the goods of Petitioner, to cause confusion, or to cause mistake, or to deceive, and Registrant's Registration No. 2,724,479 should be cancelled because Petitioner has priority of use.

5. Registrant's mark so resembles Petitioner's mark as to be likely, when applied to the goods of Registrant, to cause confusion, or to cause mistake, or to deceive, and Registrant's Registration No. 2,724,479 should be cancelled because Petitioner has priority of use.

6. Registrant's mark so resembles Petitioner's Mark that, when these marks are applied to the goods of Petitioner and Registrant, respectively, as to cause customers and potential customers to mistakenly assume that the goods of Petitioner are those of Registrant or are sponsored by Registrant, and the goods of Registrant are those of Petitioner or are sponsored by Petitioner, and Registrant's Registration No. 2,724,479 should be cancelled because Petitioner has priority of use.

7. Registrant applied for and received a Registration on the Principal Register for a Trademark as follows:

Mark: ACTEK HEAVY DUTY
 Registration No.: 2,724,479
 Registered: June 10, 2003
 Filing Date: May 6, 1998
 Serial No.: 75/480,112
 Goods: metal fasteners, namely bolts, nuts, screws, eye-bolts, hoist rings, lifting rings, and related accessories, namely, bushings, washers, drill bushings, and replacement parts for the aforesaid goods, in International Class 006
 Alleging For All Goods:
 First Use: July 1, 2000
 First Use In Commerce: July 1, 2000

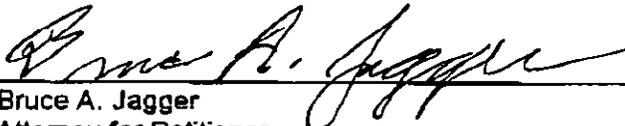
8. Petitioner filed an application to register a Trademark on the Principal Register as follows:

Mark: HEAVY DUTY
 Serial No.: 76/484,025
 Filing Date: January 21, 2003
 Goods: hoist rings and components thereof, in International Class 007

Alleging:
First Use: 1989
First Use In Commerce: 1989

9. On or about July 3, 2003, the Trademark Examining Attorney refused registration of Petitioner's Trademark, HEAVY DUTY, on the grounds that, "...applicant's mark, when used on or in connection with the identified goods/services, so resembles the mark in U.S. Registration No. 2724479 as to be likely to cause confusion, to cause mistake, or to deceive..."

10. Registrant's registration and use of "HEAVY DUTY" in a trademark sense is unlawful and in violation of Consent Decrees stipulated to by CBC Industries, Inc. and Actek Enterprises, Inc., and entered in United States Federal District Courts.

By 
Bruce A. Jagger
Attorney for Petitioner,
CBC Industries, Inc.

Date: December 26, 2003

Bruce A. Jagger
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Patent, Trademark, and Copyright Causes

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FACSIMILE TRANSMITTAL SHEET
FROM FACSIMILE NO. (310) 846-4799

Please deliver to: Examiner George Woods

Firm or Company Name: Trademark Trial and Appeal Board

Telecopier No. (703) 308-9333

From: Bruce A. Jagger, Esq.

Date: 7/20/2004 **Time:** 2:37 PM

Total number of pages including cover sheet: 5

Re: Petition to Cancel **Our Client:** Petitioner CBC Industries, Inc.

MESSAGE

**Dear Examiner Woods: Per your telephonic request, attached please find a copy of the
Petition to Cancel which was filed on December 29, 2003. Thank you for your
assistance with this matter.**

**Denise Kellogg,
Secretary to Bruce A. Jagger**

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[Handwritten signature]

92043520

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11971 HAMDEN PLACE
SANTA FE SPRINGS, CA 90670**

