

ESTTA Tracking number: **ESTTA288590**

Filing date: **06/08/2009**

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

Proceeding	92050129
Party	Defendant Hays Automotive, Inc.
Correspondence Address	Hays Automotive, Inc. 955 Calle Higuera Camarillo, CA 93010 UNITED STATES pbromaghim@nchc.com, mclark@nchc.com, tbryant@nchc.com
Submission	Answer
Filer's Name	Peter Bromaghim
Filer's e-mail	pbromaghim@nchc.com, mclark@nchc.com, tbryant@nchc.com
Signature	/PeterBromaghim/
Date	06/08/2009
Attachments	Response to Cancellation - Hays Auto (10415332).PDF ( 7 pages )(118196 bytes )

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

---

PRESTOLITE WIRE LLC,

Opposer,

v.

HAYS AUTOMOTIVE, INC.,

Registrant.

Cancellation No. 92050129

Mark: HAYS AUTOMOTIVE

Registration No. 2772755

---

Trademark Trial and Appeal Board  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

<b>CERTIFICATE OF TRANSMISSION UNDER CFR 1.8</b>
I hereby certify that this correspondence is being filed via ESTTA electronic transmission with the Trademark Trial and Appeal Board at <a href="mailto:esta@uspto.gov">esta@uspto.gov</a> , P.O. Box 1451, Alexandria, VA 22313-1450.
on June 8, 2009
by <u>/PeterBromaghim/</u> Peter B. Bromaghim

**RESPONSE TO CANCELLATION**

Registrant Hays Automotive, Inc. (“Hays”), responds as follows to the Cancellation initiated by Prestolite Wire LLC (“Prestolite”), regarding U.S. Supplemental Trademark Registration No. 2772755 (registered October 7, 2003) for the mark HAYS AUTOMOTIVE (“the mark”).

Hays generally denies that Prestolite will in any way be damaged by the continued registration of the mark for use on the services identified in the

registration. Hays further responds to the allegations of the Cancellation as follows:

1. Hays lacks sufficient information or knowledge to admit or deny the allegations of paragraph 1 of the Opposition, and on that basis denies the allegations.
2. Hays admits the allegations of paragraph 2 of the Opposition.
3. Hays denies the allegations of paragraph 3 of the Opposition.

#### **FURTHER ALLEGATIONS**

1. Hays began using the mark HAYS AUTOMOTIVE in commerce on “automotive repair services” at least as early as March 1999. This first use date appears on its registration, Reg. No. 2,772,755.

2. Hays is informed and believes that the HAYS AUTOMOTIVE mark is distinctive of its services in commerce, and that its registration on the Supplemental Register does not affect its distinctiveness.

3. At the time of adopting the HAYS AUTOMOTIVE mark, Hays was not aware of any similar mark being used in commerce that might possibly be considered confusing to HAYS AUTOMOTIVE.

4. Prestolite has not asserted any trademark rights in its petition on which to base the cancellation of the HAYS AUTOMOTIVE mark. It has further not asserted that it has used HAYS AUTOMOTIVE or any portion of the mark prior to the use in commerce by Hays. Prestolite asserts only a refusal of a subsequent

application, filed April 30, 2008, as grounds for this Cancellation. Given the prior rights of Hays, the refusal of this application alone cannot be grounds for cancellation of the mark.

5. Hays is currently not aware of any registered trademark rights of Prestolite in the United States that would be grounds for cancellation of its mark. After the institution of this proceeding, Hays became aware of a design mark incorporating the word “Hays,” Reg. No. 2514329, for “clutches and flywheels for use in land vehicles, namely trucks,” of which Prestolite Wire Corporation is the assignee. This registration is limited to the stylized design therein. Based on its registration date, this registration was in existence at the time Hays applied for its HAYS AUTOMOTIVE trademark. The examining attorney did not refuse the HAYS AUTOMOTIVE application based on Reg. No. 2514329. Neither Prestolite nor its alleged predecessor in interest opposed registration of the HAYS AUTOMOTIVE mark. This is evidence that the Office has previously determined that these marks could coexist in their respective fields.

6. Hays is unaware of any instances of confusion between its HAYS AUTOMOTIVE mark and any trademarks or service marks of Prestolite.

7. Hays does not believe that there is any likelihood of confusion between its HAYS AUTOMOTIVE mark and any mark of Prestolite, including Reg. No. 2514329. The marks are not identical, and are unlikely to be confused with one another. Importantly, the channels of trade for the goods and services here are completely distinct. Hays provides services to customers seeking general repairs to

their cars. On information and belief, Prestolite is a manufacturer of wire and cable for automotive and industrial applications, and markets its goods to third-party suppliers and third-party manufacturers of goods, not general consumers. Even if Prestolite is basing its cancellation on the “clutches and flywheels” for trucks listed in Reg. No. 2514329, consumers are unlikely to encounter these distinct marks at the same time, or believe that they otherwise emanate from the same source. There is very little possibility for any confusion between these marks on these goods and services, let alone a likelihood of confusion, necessary to support the cancellation of Hays’ mark.

#### **AFFIRMATIVE DEFENSES**

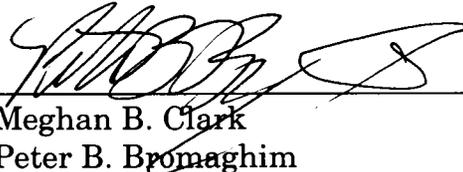
1. The opposition fails to state a ground for cancellation.
2. The opposition is barred by the doctrine of laches.
3. The opposer is estopped from pursuing its claims by reason of the opposer’s own actions and course of conduct.
4. The opposer has acquiesced in the use of marks similar to those of which the opposer now complains.
5. The opposer has waived its claims by reason of the opposer’s own actions and course of conduct.
6. The opposer’s action is barred by reason of the opposer’s consent.
7. Registrant reserves all affirmative defenses not stated here in the event that discovery reveals that they may be appropriate.

**PRAYER**

Registrant Hays therefore requests that the Cancellation be denied.

Registrant submits this Response to Cancellation via the e-filing procedure of the Trademark Trial and Appeal Board. Please direct all notices, pleadings and correspondence in this matter to the undersigned counsel for Registrant Hays Automotive, Inc.

Respectfully submitted,



Date: June 8, 2009

---

Meghan B. Clark  
Peter B. Bromaghim  
Attorneys for Registrant Hays Automotive  
Nordman Cormany Hair & Compton LLP  
P.O. Box 9100  
Oxnard, CA 93031-9100  
Tel: (805) 485-1000  
Fax: (805) 988-8387  
Email: [mclark@nchc.com](mailto:mclark@nchc.com); [pbromaghim@nchc.com](mailto:pbromaghim@nchc.com)

**CERTIFICATE OF SERVICE**

I hereby certify that I am a resident of the State of California and over the age of eighteen years, and not a party to the within action; my business address is Nordman Cormany Hair & Compton, LLP, P.O. Box 9100, Oxnard, California 93031-9100.

On **June 8, 2009**, I served the foregoing document described as **Response to Cancellation** on the interested parties in this action

by placing  the original  a true copy thereof enclosed in a sealed envelope addressed as follows:

Michael D. Fishman  
Linda E. Monge  
RADER, FISHMAN & GRAUER, PLLC  
39533 Woodward Avenue, Suite 140  
Bloomfield Hills, MI 48304

**BY MAIL**

I deposited such envelope in the mail at Oxnard, California. The envelope was mailed with postage thereon fully prepaid.

I caused such envelope to be deposited in the mail at Oxnard, California. The envelope was mailed with postage thereon fully prepaid. I am "readily familiar" with the firm's practice of collection and processing correspondence for mailing. Under that practice it would be deposited with the U.S. Postal Service on that same day with postage thereon fully prepaid at Oxnard, California, in the ordinary course of business. I am aware that on motion of the party served, service is presumed invalid if postal cancellation date or postage meter date is more than one day after date of deposit for mailing in affidavit.

