

ESTTA Tracking number: **ESTTA391721**

Filing date: **02/04/2011**

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

Proceeding	92053426
Party	Defendant Scientific Toys, Ltd.
Correspondence Address	SCIENTIFIC TOYS LTD NEW MANDARIN PLAZA 14 SCIENCE MUSEUM RD, RM 1108 11/F BLOCK B KOWLOON, HONG KONG
Submission	Answer and Counterclaim
Filer's Name	Chester Rothstein
Filer's e-mail	ptodocket@arelaw.com
Signature	/Chester Rothstein/
Date	02/04/2011
Attachments	Answer, Affirmative Defenses and Counterclaims - 426 Cancellation.pdf ( 34 pages )(3301594 bytes )

Registration Subject to the filing

Registration No	2225724	Registration date	02/23/1999
Registrant	Bachmann Industries, Inc. 1400 East Erie Avenue Philadelphia, PA 19124 UNITED STATES		
Grounds for filing	The registered mark has been abandoned.		
	The registration was obtained fraudulently.		

Goods/Services Subject to the filing

Class 028. First Use: 1994/01/00 First Use In Commerce: 1994/04/00  
All goods and services in the class are requested, namely: toy train sets; toy trains; accessories for toy trains, namely toy train tracks and couplers for toy railway carriages

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

-----X

BACHMANN INDUS., INC.,	:	
	:	
Petitioner/Counterclaim Respondent,	:	
	:	
v.	:	Cancellation No.: 92053426
	:	
SCIENTIFIC TOYS, LTD.,	:	
	:	
Respondent/Counterclaim Petitioner.	:	

-----X

**ANSWER, AFFIRMATIVE DEFENSES AND COUNTERCLAIM**

Respondent/Counterclaim Petitioner Scientific Toys, Ltd. (“Scientific”), through its attorneys Amster, Rothstein & Ebenstein LLP, answers the Petition for Cancellation filed by Petitioner/Counterclaim Respondent Bachmann Indus., Inc. (“Bachmann”), as follows:

1. Scientific admits the truth of the allegations contained in Paragraph 1 except to the extent “inter alia” is defined as “among others,” denies that Reg. No. 3,567,168 is among other registrations for the goods listed in Paragraph 1.

2. Scientific admits the truth of the allegations contained in the first sentence of Paragraph 2; and denies the truth of the allegations contained in the second sentence of Paragraph 2, namely that “Respondent claims no date earlier than July 20, 2006 for the purpose of priority”, and expressly alleges that the date of first use in commerce listed in Reg. No. 3,567,168 is July 20, 1996.

3. Scientific lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 3 of the Petition for Cancellation, and, accordingly, denies the same.

4. Scientific lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 4 of the Petition for Cancellation, and, accordingly, denies the same.

5. Scientific denies the truth of the allegations contained in Paragraph 5 of the Petition for Cancellation.

6. Scientific denies the truth of the allegations contained in Paragraph 6 of the Petition for Cancellation.

7. Scientific denies the truth of the allegations contained in Paragraph 7 of the Petition for Cancellation.

8. Scientific denies the truth of the allegations contained in Paragraph 8 of the Petition for Cancellation.

9. Scientific lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 9 of the Petition for Cancellation, and, accordingly, denies the same and specifically denies that Bachmann owns a “family of marks” under the law.

10. Scientific lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 10 of the Petition for Cancellation, and, accordingly, denies the same.

11. Scientific lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 11 of the Petition for Cancellation, and, accordingly, denies the same; except that Scientific admits that pursuant to the online records of the US Patent and Trademark Office, the listed registrations appear to be owned by Bachmann, and scientific specifically denies that Bachmann owns a “family of marks” under the law

12. Scientific denies the truth of the allegations contained in Paragraph 12 of the Petition for Cancellation and specifically denies that Bachmann owns a “family of marks” under the law.

13. Scientific denies the truth of the allegations contained in Paragraph 13 of the Petition for Cancellation and specifically denies that the term “tec” is descriptive.

14. Scientific denies the truth of the allegations contained in Paragraph 14 of the Petition for Cancellation.

15. Scientific denies the truth of the allegations contained in Paragraph 15 of the Petition for Cancellation and specifically denies that Bachmann owns a “family of marks” under the law.

16. Scientific lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 16 of the Petition for Cancellation, and, accordingly, denies the same and Scientific specifically denies that Bachmann owns a “family of marks” under the law.

17. Scientific lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 17 of the Petition for Cancellation, and, accordingly, denies the same.

18. Scientific denies the truth of the allegations contained in Paragraph 18 of the Petition for Cancellation.

19. Scientific denies the truth of the allegations contained in Paragraph 19 of the Petition for Cancellation.

20. Scientific denies the truth of the allegations contained in Paragraph 20 of the Petition for Cancellation and specifically denies that Bachmann owns a “family of marks” under the law.

21. Scientific denies the truth of the allegations contained in Paragraph 21 of the Petition for Cancellation and specifically denies that Bachmann owns a “family of marks” under the law.

### **AFFIRMATIVE DEFENSES**

As Affirmative Defenses, Scientific alleges as follows:

22. Bachmann’s claims are barred by the doctrine of unclean hands.
23. Bachmann has failed to state a claim upon which relief may be granted.
24. There is no likelihood of confusion between Scientific’s Registration No. 3,567,168 (“Scientific’s Mark”) and any or all of the marks asserted by Bachmann in the Cancellation Proceeding (collectively and individually “Bachmann’s Marks”) since the marks are sufficiently distinguishable to avoid confusion.
25. Bachmann does not own a “family of marks” as that term is defined under the law.
26. Bachmann does not own rights in the term E-Z alone as alleged in the Petition.
27. Bachmann does not own rights in the term E-Z alone as alleged in the Petition because Bachmann has abandoned any rights it may have had in the term E-Z alone.
28. Bachmann does not own rights in the term E-Z alone as alleged in the Petition because Bachmann does not use E-Z alone as a mark.
29. Bachmann’s Registration No. 2,225,724 for E-Z alone is invalid.

30. There is no likelihood of confusion between Scientific's Mark and Bachmann's Marks since Scientific already owns another Registration for the same or similar mark for goods which are related to the goods covered by Scientific's Mark, namely Registration No. 2,161,782.

31. Bachmann's claims are barred under the Morehouse latches defense - i.e., Bachmann cannot be damaged by registration of Scientific's Mark within the meaning of the Lanham Act because Scientific already owns a Registration for a similar mark for related goods, specifically, Registration No. 2,161,782 for EZ TEC for toys, namely, toy typewriters, toy telephones, toy teaching clocks, and toy pre-recorded musical players.

32. There is no likelihood of confusion between Scientific's Mark and Bachmann's Marks since Bachmann's Marks are weak, as evidenced by extensive third party use of other E-Z formative marks for goods in International Class 28.

33. Bachmann's claim must fail under the doctrine of Laches, it being noted that the parties' marks have co-existed for 15 years for related goods.

34. Bachmann's claim must fail because there are no known instances of actual confusion despite extensive co-existence for 15 years, and a lack of actual confusion after substantial periods of co-existence is evidence that there is no likelihood of confusion.

35. The only point of similarity between Bachmann's Marks and Scientific's Mark is the element E-Z, which is immediately understood by the trade and relevant consumers as being a misspelling of the merely descriptive term "Easy."

36. Scientific has insufficient information upon which to form a belief as to whether it may have additional unstated Affirmative Defenses. Applicant reserves the right to assert additional Affirmative Defenses in the event discovery indicates that they are appropriate.

**COUNTERCLAIM TO CANCEL  
BACHMANN's REGISTRATION NO. 2,225,724**

In the matter of Trademark Registration No. 2,225,724 for E-Z issued February 23, 1999.

Respondent/Counterclaim Petitioner ("Scientific") by and through its attorneys Amster, Rothstein & Ebenstein LLP, believes that it will be damaged by the continued registration of U.S. Registration No. 2,225,724 ("the '724 Registration") for the mark E-Z owned by Bachmann Indus, Inc. ("Bachmann") and hereby counterclaims seeking cancellation of the same.

The grounds for cancellation are as follows:

1. Scientific incorporates each and every response of the foregoing answer and affirmative defenses into these counterclaims as though fully set forth herein.
2. Scientific is a corporation organized and existing under the laws of Hong Kong, having a place of business at RM 1108, 11/F., Block B New Mandarin Plaza, 14 Science Museum Rd, Kowloon, Hong Kong.
3. On or about December 17, 2010, Bachmann commenced Cancellation No. 92053426 seeking to cancel Scientific's Registration No. 3,567,168 for the mark EZTEC ("Scientific's Mark") for toys, namely, remote controlled, radio controlled, and battery operated vehicles, trains, train sets, helicopters, submarines, boats, musical instruments, pinball machines, animals, and insects in International Class 28 (the "Cancellation").
4. In the Cancellation, Bachmann asserted, among other things, that Scientific's Mark should be cancelled since confusion is likely between Scientific's Mark and certain marks owned by Bachmann, including the mark E-Z which is the subject of the '724 Registration.
5. Scientific has standing to bring the instant counterclaim to cancel the '724 Registration since Bachmann has asserted the '724 Registration against Scientific in the

Cancellation. *See* T.B.M.P. § 309.03(b) (“a counterclaimant’s standing to cancel a pleaded registration is inherent in its position as defendant in the original proceeding.”).

**NON-USE and ABANDONMENT**

6. Upon information and belief, Bachmann has never used the term E-Z covered by the ‘724 Registration as a mark.

7. Upon information and belief, Bachmann does not currently use the term E-Z covered by the ‘724 Registration as a mark.

8. Upon information and belief, Bachmann has discontinued use of the term E-Z covered by the ‘724 Registration.

9. Upon information and belief, at the time Bachmann discontinued use of the term E-Z covered by the ‘724 Registration, Bachmann did not have an intention to resume use.

10. Upon information and belief, Bachmann does not presently have an intention to resume use of the term E-Z covered by the ‘724 Registration as a mark.

11. Upon information and belief, Bachmann has abandoned the mark E-Z covered by the ‘724 Registration.

12. Upon information and belief, as a result of said abandonment, the mark E-Z covered by the ‘724 Registration has lost all capacity as a source indicator.

13. Since there is a contention by Bachmann in the Cancellation that there is a likelihood of confusion between Scientific’s Mark and Bachmann’s Marks, including the mark E-Z covered by the ‘724 Registration, then the continued existence of the ‘724 Registration on the Principal Register has damaged and will continue to damage Scientific.

**FRAUD ON THE PATENT AND TRADEMARK OFFICE**

14. On or about December 31, 1997, Bachmann filed Application Serial No. 75/412,444 (“the ‘444 Application”), which eventually matured into the ‘724 Registration.

15. Upon information and belief, the '444 Application listed the following description of goods: "toy train sets; toy trains; accessories for toy trains, namely toy train tracks and couplers for toy railway carriages."

16. The '724 Registration lists the same description of goods, namely "toy train sets; toy trains; accessories for toy trains, namely toy train tracks and couplers for toy railway carriages."

17. On or about September 27, 2004, Bachmann filed a Combined Declaration under Section 8 & 15 (the "2004 Declaration"), a copy of which was downloaded from the file history of the '724 Registration available at [www.uspto.gov](http://www.uspto.gov) and is attached as Exhibit A.

18. On or about January 26, 2009, Bachmann filed a Combined Declaration of Use in Commerce & Application for Renewal of Registration of a Mark under Sections 8 & 9 (the "2009 Renewal"), a copy of which was downloaded from the file history of the '724 Registration available at [www.uspto.gov](http://www.uspto.gov) and is attached as Exhibit B.

19. The Specimen of Use filed with the 2004 Declaration does not show the Registered mark E-Z, but instead shows the distinguishable mark E-Z TRACK.

20. The Specimen of Use filed with the 2009 Renewal does not show the Registered mark E-Z, but instead shows the distinguishable marks E-Z COMMAND and E-Z TRACK SYSTEM.

21. Upon information and belief, at the time Bachmann filed the '444 Application, Bachmann knew that it was not using the mark E-Z alone on at least the following goods recited in the '444 Application:

- a. toy train sets;
- b. toy trains; and
- c. accessories for toy trains, namely toy train tracks.

22. Upon information and belief, at the time Bachmann filed the 2004 Declaration, Bachmann knew that it was not using the mark E-Z alone on at least the following goods recited in the '444 Application and the '724 Registration:

- a. toy train sets;
- b. toy trains; and
- c. accessories for toy trains, namely toy train tracks.

23. Upon information and belief, at the time Bachmann filed the 2009 Renewal, Bachmann knew that it was not using the mark E-Z alone on at least the following goods recited in the '444 Application and the '724 Registration:

- a. toy train sets;
- b. toy trains; and
- c. accessories for toy trains, namely toy train tracks.

24. Bachmann's inclusion of "toy train sets"; "toy trains"; and "accessories for toy trains, namely toy train tracks" in the '444 Application and in the 2004 Declaration and in the 2009 Renewal constitutes a fraudulent misrepresentation to the US Patent and Trademark Office.

25. On or about May 27, 1998, the US Patent and Trademark Office issued an Office Action No. 1, a true and correct copy of which was downloaded from the file history of the '724 Registration available at [www.uspto.gov](http://www.uspto.gov) and is attached as Exhibit C, which rejected the Specimen of Use which was filed with the application which matured into the '724 Registration on the ground that:

The specimens are unacceptable as evidence of actual trademark use because they do not show use of the mark as it appears on the drawing page. The drawing displays the mark as E-Z. However, this differs from the display of the mark on the specimens where it appears as E-ZMATE. The applicant cannot amend the drawing to conform to the display on the specimens because the character of the mark would be altered. [Citations omitted].

26. Upon information and belief, in response to the May 27, 1998 Office Action No. 1, counsel for Bachmann had a telephone conversation with the US Patent and Trademark Office Trademark Attorney, Laura Gorman Kovalsky, Esq.

27. Attached as Exhibit D is a true and correct copy of Trademark Attorney Kovalsky's "Memorandum of Telephone Communication - For File" which memorialized her conversation on or about July 6, 1998 with counsel for Bachmann and which was downloaded from the file history of the '724 Registration available at [www.uspto.gov](http://www.uspto.gov).

28. The above referenced "Memorandum of Telephone Communication - For File" reads:

Reason for Call: OA [Office Action] issue re: Sub. specs [substitute specimens] needed -- Appl's [Applicant's] attorney noted the correct mark is imprinted on the goods themselves, though not necessarily on packaging.

29. Based on the rejection in Office Action No. 1, Bachmann knew that specimens of use which included additional terms after the term E-Z, in that case the additional term "MATE," were not sufficient to support the '444 Application for E-Z, it being noted that Bachmann did not refute the rejection but instead argued that the mark E-Z alone was in fact included directly on the products within the specimen originally submitted.

30. At the times Bachmann filed the '444 Application and the 2004 Declaration and the 2009 Renewal, Bachmann knew that it was not using the mark E-Z alone on at least the following goods:

- a. toy train sets;
- b. toy trains; and
- c. accessories for toy trains, namely toy train tracks.

31. At the time they were made, Bachmann's false statements constituted fraud, or reckless disregard for the truth.

32. On information and belief, Bachman's statements to the US Patent and Trademark Office attesting it was using EZ on toy train sets"; "toy trains"; and "accessories for toy trains, namely toy train tracks" in the '444 Application and in the 2004 Declaration and in the 2009 Renewal were material misrepresentations that were intended to deceive the US Patent and Trademark Office into believing that Bachman was using EZ as a mark on these goods and that a Registration could thus issue (with respect to the statement for the '444 Application), and be maintained (with respect to the statements for the 2004 Declaration and in the 2009 Renewal). Such statements were material because the US Patent and Trademark Office would not have granted the '724 Registration (with respect to the statement for the '444 Application), and maintained the '724 Registration (with respect to the statements for the 2004 Declaration and in the 2009 Renewal) in the absence of such statements.

33. The US Patent and Trademark Office reasonably relied on the truth of such false statements and did in fact grant and maintain the '724 Registration.

34. For at least the reasons stated herein, the continued registration of the '724 Registration is damaging to Scientific.

35. If Bachmann is permitted to maintain the '724 Registration for E-Z as a mark for the goods set forth in the registration which is the subject matter of this counterclaim for cancellation, Bachmann obtains thereby at least a prima facie exclusive right to use the mark. Such registration is a source of damage and injury to Scientific, whose registration of EZ TEC is under attack by Bachmann.

\* \* \*

Based on all of the foregoing, Registration No. 2,225,724 should be canceled.

Respectfully submitted,

AMSTER, ROTHSTEIN & EBENSTEIN LLP  
Attorneys for Scientific Toys, Ltd.  
90 Park Avenue  
New York, New York 10016  
(212) 336-8000

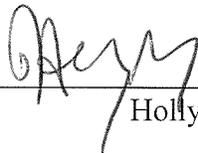
Dated: New York, New York  
February 4, 2011

By:   
\_\_\_\_\_  
Chester Rothstein  
Holly Pekowsky

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that she is one of the attorneys for Respondent/Counterclaim Petitioner Scientific Toys, Ltd., in the above-captioned cancellation proceeding and that on the date which appears below, she caused a copy of the foregoing ANSWER, AFFIRMATIVE DEFENSES AND COUNTERCLAIMS to be served on the attorneys for Petitioner/Counterclaim Respondent Bachmann Indus., Inc. by first class mail by causing a copy thereof to be placed in a depository under the care and custody of the United States Postal Service, in the State of New York, postage pre-paid, in a wrapper addressed as follows:

Roberta Jacobs-Meadway, Esq.  
Eckert Seamans  
Two Liberty Place  
50 South 16th Street, 22d floor  
Philadelphia PA 19102

  
\_\_\_\_\_  
Holly Pekowsky

Dated: New York, New York  
February 4, 2011

# **EXHIBIT A**

LAW OFFICES

**BALLARD SPAHR ANDREWS & INGERSOLL, LLP**

1735 MARKET STREET, 51ST FLOOR  
PHILADELPHIA, PENNSYLVANIA 19103-7599  
215-665-8500  
FAX: 215-864-8999  
WWW.BALLARDSPAHR.COM

BALTIMORE, MD  
DENVER, CO  
SALT LAKE CITY, UT  
VOORHEES, NJ  
WASHINGTON, DC  
WILMINGTON, DE

JAY K. MEADWAY  
DIRECT DIAL: 215-864-8101  
PERSONAL FAX: 215-864-9803  
MEADWAYJ@BALLARDSPAHR.COM

September 27, 2004

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

Re: Combined Declaration Under Section 8 & 15  
Mark: E-Z  
Registration No.: 2,225,724  
Bachmann Industries, Inc.  
Our File No.: 069787

Dear Madam:

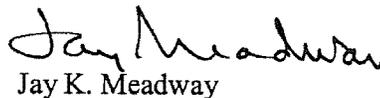
Enclosed please find the following for filing:

1. Combined Declaration Under Section 8 & 15,
2. Specimen.

The Commissioner is hereby authorized to charge the \$300 filing fee to our Miscellaneous Deposit Account 02-0755. Please charge any additional fees or credit any overpayments to Miscellaneous Deposit Account 02-0755. A duplicate copy of this letter is attached.

It is requested that the Patent and Trademark Office confirm receipt of the Combined Declaration Under Section 8 & 15 by date stamping the enclosed acknowledgement card and returning it to the undersigned.

Sincerely,

  
Jay K. Meadway

JKM/cj  
Enclosures

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO THE COMMISSIONER FOR TRADEMARKS, 2900 CRYSTAL DRIVE, ARLINGTON, VA 22202-3513, BOX POST REG. - FEE ON THE DATE INDICATED BELOW

BY: Sensen

DATE: 9.27.04

**BOX POST REG - FEE**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Mark: E-Z  
Registration No.: 2,225,724  
Owner: Bachmann Industries, Inc.  
Registration Date: February 23, 1999  
International Class: 28 Our Ref.: 069787

**COMBINED DECLARATION UNDER SECTIONS 8 & 15**

Walter Reece states that he is an authorized signatory of Bachmann Industries, Inc., a Pennsylvania corporation having a place of business at 1400 East Erie Avenue, Philadelphia, Pennsylvania 19124, which owns Registration No. 2,225,724 issued on February 23, 1999; that the mark shown therein has been in continuous use in interstate commerce for five consecutive years from at least as early as February 23, 1999, to the present for all goods recited in the registration; that said mark is still in use in interstate commerce as evidenced by the attached specimen showing the mark as currently used; that there has been no final decision adverse to Registrant's claim of ownership of the mark or to its right to register the same or maintain it on the Register; and that there is no proceeding involving any of said rights pending and not disposed of either in the Patent and Trademark Office or in the Courts.

Registrant hereby appoints the law firm of Ballard Spahr Andrews & Ingersoll, LLP with offices at 1735 Market Street, 51<sup>st</sup> Floor, Philadelphia, PA 19103 which has associated with it Roberta Jacobs-Meadway, a member of the bars of Pennsylvania and New Jersey; Jay K. Meadway, a member of the bar of Pennsylvania; and Richard E. Peirce, a member of the bar of Pennsylvania as our attorneys, with full power of substitution and revocation, to prosecute this Combined Declaration and to transact all business in connection therewith.

10/04/2004 ZCLIFT01 00000139 020735 2225724

01 FC:6295 100.00 BA  
02 FC:6298 200.00 BA

The Patent and Trademark Office is requested to direct all communications with respect to this Combined Declaration to the following attorneys: Roberta Jacobs-Meadway and Jay K. Meadway.

The required fee is to be charged to our Miscellaneous Account 02-0755.

The undersigned declares: That all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the registration identified above.

Bachmann Industries, Inc.

Date: Sep. 24, 2004

By: Walter W. Reece  
Walter Reece

Thank you for your request. Here are the latest results from the TARR web server.

069787

This page was generated by the TARR system on 2004-02-23 15:33:32 ET

Serial Number: 75412444 Assignment Information

Registration Number: 2225724 Assignment Information

Mark (words only): E-Z

Standard Character claim: No

Current Status: Registered.

Date of Status: 1999-02-23

Filing Date: 1997-12-31

Transformed into a National Application: No

Registration Date: 1999-02-23

Register: Principal

Law Office Assigned: LAW OFFICE 106

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2000-01-14

---

**LAST APPLICANT(S)/OWNER(S) OF RECORD**

---

1. Bachmann Industries, Inc.

**Address:**

Bachmann Industries, Inc.  
1400 East Erie Avenue  
Philadelphia, PA 19124  
United States

**Legal Entity Type:** Corporation

**State or Country of Incorporation:** Pennsylvania

---

**GOODS AND/OR SERVICES**

---

toy train sets; toy trains; accessories for toy trains, namely toy train tracks and couplers for toy railway carriages

**International Class:** 028  
**First Use Date:** 1994-01-00  
**First Use in Commerce Date:** 1994-04-00

**Basis:** 1(a)

---

**ADDITIONAL INFORMATION**

---

**Prior Registration Number(s):**  
2053073  
2061990

---

**MADRID PROTOCOL INFORMATION**

---

(NOT AVAILABLE)

---

**PROSECUTION HISTORY**

---

1999-02-23 - Registered - Principal Register  
1998-09-15 - Published for opposition  
1998-08-14 - Notice of publication  
1998-07-07 - Approved for Pub - Principal Register (Initial exam)  
1998-05-27 - Non-final action mailed  
1998-05-12 - Case file assigned to examining attorney

---

**CONTACT INFORMATION**

---

**Correspondent (Owner)**  
MICHAEL L LOVITZ (Attorney of record)  
  
MICHAEL L LOVITZ  
PANITCH SCHWARZE JACOBS & NADEL PC  
1 COMMERCE SQ 22ND FL  
2005 MARKET ST  
PHILADELPHIA PA 19103-7086

---

1 of 1 Complete record  
05412444 -- TRADEMARKSCAN(x)-Federal

E-Z

INTL CLASS: 28 (Toys & Sporting Goods)  
US CLASS: 22 (Games, Toys, & Sporting Goods)  
23 (Cutlery, Machines, & Tools, Parts Therof)  
38 (Prints & Publications)  
50 (Merchandise Not Otherwise Classified)

STATUS: Registered; Section 2(F)

GOODS/SERVICES: TOY TRAIN SETS; TOY TRAINS; ACCESSORIES FOR TOY TRAINS, NAMELY TOY TRAIN  
TRACKS AND COUPLERS FOR TOY RAILWAY CARRIAGES

SERIAL NO.: 75-412,444

REG. NO.: 2,225,724

REGISTERED: February 23, 1999

FIRST USE: January 1994 (Intl Class 28)

FIRST COMMERCE: April 1994 (Intl Class 28)

FILED: December 31, 1997

PUBLISHED: September 15, 1998

ORIGINAL APPLICANT: BACHMANN INDUSTRIES, INC. (Pennsylvania Corporation), 1400 EAST ERIE  
AVENUE, PHILADELPHIA, PA (Pennsylvania), 19124, USA (United States of America)

OWNER AT PUBLICATION: BACHMANN INDUSTRIES, INC. (Pennsylvania Corporation), 1400 EAST ERIE  
AVENUE, PHILADELPHIA, PA (Pennsylvania), 19124, USA (United States of America)

OTHER U.S. REGISTRATIONS: 2053073; 2061990

FILING CORRESPONDENT: MICHAEL L LOVITZ, PANITCH SCHWARZE JACOBS & NADEL PC, 1 COMMERCE SQ  
22ND FL, 2005 MARKET ST, PHILADELPHIA PA 19103-7086

9" Straight  
Track  
(4 Pieces)

Item No.  
44411

# E-Z TRACK SYSTEM

- QUICK, EASY ASSEMBLY
- SNAPS TOGETHER & STAYS TOGETHER
- OPERATES ON FLOORS, TABLES AND CARPETS
- NO SCREWS, NAILS OR SPECIAL TOOLS NEEDED FOR ASSEMBLY



BACHMANN, INC.  
PHILADELPHIA, PA.  
MADE IN CHINA

Bachmann Industries, Inc., Philadelphia, PA, USA E-Z Track  
U.S. Patent Nos. 4,953,785; 4,503,330; D392,607 and other Foreign  
Patents, plus other U.S. Patents Pending. E-Z Track and the E-Z Track  
configuration are registered trademarks property of Bachmann  
Industries, Inc., Philadelphia, PA, USA.

# **EXHIBIT B**

## Combined Declaration of Use in Commerce & Application for Renewal of Registration of a Mark under Sections 8 & 9

**The table below presents the data as entered.**

Input Field	Entered
<b>REGISTRATION NUMBER</b>	2225724
<b>REGISTRATION DATE</b>	02/23/1999
<b>SERIAL NUMBER</b>	75412444
<b>MARK SECTION</b>	
<b>MARK</b>	E-Z
<b>OWNER SECTION (current)</b>	
<b>NAME</b>	Bachmann Industries, Inc.
<b>STREET</b>	1400 East Erie Avenue
<b>CITY</b>	Philadelphia
<b>STATE</b>	Pennsylvania
<b>ZIP/POSTAL CODE</b>	19124
<b>COUNTRY</b>	US
<b>ATTORNEY SECTION (new)</b>	
<b>NAME</b>	Roberta Jacobs-Meadway
<b>FIRM NAME</b>	Eckert Seamans Cherin & Mellott, LLC
<b>INTERNAL ADDRESS</b>	50 South 16th Street, 22nd Floor
<b>STREET</b>	Two Liberty Place
<b>CITY</b>	Philadelphia
<b>STATE</b>	Pennsylvania
<b>POSTAL CODE</b>	19102

<b>COUNTRY</b>	United States
<b>EMAIL</b>	rjacobsmeadway@eckertseamans.com
<b>AUTHORIZED TO COMMUNICATE VIA E-MAIL</b>	Yes
<b>ATTORNEY DOCKET NUMBER</b>	297775.00080
<b>OTHER APPOINTED ATTORNEY</b>	Jay K. Meadway, Richard E. Peirce, Sean P. McConnell
<b>DOMESTIC REPRESENTATIVE SECTION (new)</b>	
<b>NAME</b>	Roberta Jacobs-Meadway
<b>INTERNAL ADDRESS</b>	50 South 16th Street, 22nd Floor
<b>STREET</b>	Two Liberty Place
<b>CITY</b>	Philadelphia
<b>STATE</b>	Pennsylvania
<b>POSTAL CODE</b>	19102
<b>COUNTRY</b>	United States
<b>EMAIL</b>	rjacobsmeadway@eckertseamans.com
<b>AUTHORIZED TO COMMUNICATE VIA E-MAIL</b>	Yes
<b>GOODS AND/OR SERVICES SECTION</b>	
<b>INTERNATIONAL CLASS</b>	028
<b>GOODS OR SERVICES</b>	KEEP ALL LISTED
<b>SPECIMEN FILE NAME(S)</b>	
<b>ORIGINAL PDF FILE</b>	SPN0-1218010878-135553568 _ _Spec_Bachmann_E-Z.pdf
<b>CONVERTED PDF FILE(S) (2 pages)</b>	\\TICRS\EXPORT5\IMAGEOUT5\754\124\75412444\xml1\S890002.JPG
	\\TICRS\EXPORT5\IMAGEOUT5\754\124\75412444\xml1\S890003.JPG
<b>SPECIMEN</b>	webpage screenshot

<b>DESCRIPTION</b>	
<b>PAYMENT SECTION</b>	
<b>NUMBER OF CLASSES</b>	1
<b>NUMBER OF CLASSES PAID</b>	1
<b>SUBTOTAL AMOUNT</b>	500
<b>TOTAL FEE PAID</b>	500
<b>SIGNATURE SECTION</b>	
<b>SIGNATURE</b>	/Roberta Jacobs-Meadway/
<b>SIGNATORY'S NAME</b>	Roberta Jacobs-Meadway
<b>SIGNATORY'S POSITION</b>	Attorney of Record
<b>DATE SIGNED</b>	01/26/2009
<b>PAYMENT METHOD</b>	CC
<b>FILING INFORMATION</b>	
<b>SUBMIT DATE</b>	Mon Jan 26 14:18:12 EST 2009
<b>TEAS STAMP</b>	USPTO/S08N09-12.180.108.7 8-20090126141812675057-22 25724-440a4899948c397aaa1 47ca240392cc39e-CC-11014- 20090126135553568191

**Combined Declaration of Use in Commerce & Application for Renewal of  
Registration of a Mark under Sections 8 & 9  
To the Commissioner for Trademarks:**

**REGISTRATION NUMBER:** 2225724

**REGISTRATION DATE:** 02/23/1999

**MARK:** E-Z

The owner, Bachmann Industries, Inc., having an address of  
1400 East Erie Avenue  
Philadelphia, Pennsylvania 19124  
US

is filing a Combined Declaration of Use in Commerce & Application for Renewal of Registration of a Mark under Sections 8 & 9.

For International Class 028, the mark is in use in commerce on or in connection with **all** goods or services listed in the existing registration for this specific class; or, the owner is making the listed excusable nonuse claim.

The owner is submitting one specimen showing the mark as used in commerce on or in connection with any item in this class, consisting of a(n) webpage screenshot.

**Original PDF file:**

SPN0-1218010878-135553568\_.\_Spec\_Bachmann\_E-Z.pdf

**Converted PDF file(s)** (2 pages)

Specimen File1

Specimen File2

The registrant hereby appoints Roberta Jacobs-Meadway, having an address of  
50 South 16th Street, 22nd Floor  
Two Liberty Place  
Philadelphia, Pennsylvania 19102  
United States

as registrant's representative upon whom notice or process in the proceedings affecting the mark may be served.

A fee payment in the amount of \$500 will be submitted with the form, representing payment for 1 class(es), plus any additional grace period fee, if necessary.

**Declaration**

**Section 8: Declaration of Use in Commerce**

*Unless the owner has specifically claimed excusable non-use, the mark is in use in commerce on or in connection with the goods and/or services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce.*

**Section 9: Application for Renewal**

*The registrant requests that the registration be renewed for the goods and/or services identified above.*

The undersigned being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the Owner; and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.

Signature: /Roberta Jacobs-Meadway/ Date: 01/26/2009

Signatory's Name: Roberta Jacobs-Meadway

Signatory's Position: Attorney of Record

Mailing Address:

Eckert Seamans Cherin & Mellott, LLC  
Two Liberty Place  
Philadelphia, Pennsylvania 19102

Serial Number: 75412444

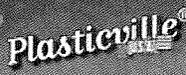
Internet Transmission Date: Mon Jan 26 14:18:12 EST 2009

TEAS Stamp: USPTO/S08N09-12.180.108.78-2009012614181

2675057-2225724-440a4899948c397aaa147ca2

40392cc39e-CC-11014-20090126135553568191

# BACHMANN TRAINS®



[Home](#)

[Products](#)

[Find a Retailer](#)

[Ask the Bach Man](#)

[FAQ](#)

[Order a Catalog](#)

[Gift Shop](#)

[Order Parts](#)

[Service Department](#)

Enter a keyword or item number here:

To browse a scale or category, click on a tab below.

- [HO Scale](#)
- [N Scale](#)
- [O Scale](#)
- [On30 Scale](#)
- [Large Scale](#)
- [Accessories](#)
- [E-Z Command®/DCC](#)
- [Williams](#)
- [SceneScapes™](#)

## Accessories

Products in: / E-Z Command® / DCC / Accessories

2 pages [1] 2 >

Image	Description	Price
	E-Z Command DCC Turnout - Left manual or DCC operation* conforms to all applicable NMRA standards compatible with all NMRA-...	\$50.00 <a href="#">More</a>
	E-Z Command Walk-Around Companion Connector Panel (with Conn Used in conjunction with the E-Z Command® Walk-Around Companion, multiple connector panels let you establish a serie...	\$40.00 <a href="#">More</a>
	E-Z Command 5 Amp Power Booster Our 5 amp power booster provides extra current to track for an increased number of DCC locomotives on your HO, N, O, or ...	\$290.00 <a href="#">More</a>

**Newsletter Signup**

**E-Z Command®**

**Product Reference**

**Contact Us**

**Site Map**

**Links**

**Calendar of Events**

January 2009						
S	M	T	W	T	F	S
26	29	30	31	1	2	3
4	5	6	7	8	9	10
11	12	13	14	15	16	17
18	19	20	21	22	23	24
25	26	27	28	29	30	31
1	2	3	4	5	6	7

- 

**E-Z Command DCC Automatic Reverse Loop Module**  
 This E-Z Command® accessory eliminates the complicated wiring previously needed to operate analog reverse-loop track... \$73.00 [More](#)
- 

**E-Z Command DCC Turnout - Right**  
 manual or DCC operation\* conforms to all applicable NMRA standards compatible with all NMRA-... \$50.00 [More](#)
- 

**E-Z Command DCC # 5 Turnout - Right**  
 manual or DCC operation\* conforms to all applicable NMRA standards compatible with all NMRA-... \$63.50 [More](#)
- 

**E-Z Command DCC # 5 Turnout - Left**  
 manual or DCC operation\* conforms to all applicable NMRA standards compatible with all NMRA-... \$63.50 [More](#)
- 

**E-Z Command DCC # 5 Wye Turnout**  
 manual or DCC operation\* conforms to all applicable NMRA standards compatible with all NMRA-... \$63.50 [More](#)
- 

**E-Z Command DCC # 6 Turnout - Left**  
 manual or DCC operation\* conforms to all applicable NMRA standards compatible with all NMRA-... \$67.00 [More](#)
- 

**E-Z Command DCC # 6 Turnout - Right**  
 manual or DCC operation\* conforms to all applicable NMRA standards compatible with all NMRA-... \$67.00 [More](#)

# **EXHIBIT C**

D

O

**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

<b>SERIAL NO.</b> 75/412444		<b>APPLICANT</b> Bachmann Industries, Inc.		<b>PAPER NO.</b>	
<b>MARK</b>					
<b>ADDRESS</b> MICHAEL L LOVITZ PANITCH SCHWARZE JACOBS & NADEL PC 1 COMMERCE SQ 1 COMMERCE SQ2005 MARKET ST 22ND FL PHILADELPHIA PA 19103-7086		<b>ACTION NO.</b> 01		<b>ADDRESS:</b> Assistant Commissioner for Trademarks 2900 Crystal Drive Arlington, VA 22202-3513	
		<b>MAILING DATE</b> 05/27/98		If no fees are enclosed, the address should include the words "Box Responses - No Fee."	
		<b>REF. NO.</b>		Please provide in all correspondence:	
<b>FORM PTO-1525 (5-90)</b>		<b>U.S. DEPT. OF COMM. PAT. &amp; TM OFFICE</b>		1. Filing Date, serial number, mark and Applicant's name. 2. Mailing date of this Office action. 3. Examining Attorney's name and Law Office number. 4. Your telephone number and ZIP code.	
		7311-42			

**A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED WITHIN 6 MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO AVOID ABANDONMENT.**  
*For your convenience and to ensure proper handling of your response, a label has been enclosed. Please attach it to the upper right corner of your response. If the label is not enclosed, print or type the Trademark Law Office No., Serial No., and Mark in the upper right corner of your response.*

RE: Serial Number: 75/412444

The assigned examining attorney has reviewed the referenced application and determined the following.

**No Conflicting Marks Noted**

The examining attorney has searched the Office records and has found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). TMEP section 1105.01.

**Specimens Unacceptable**

The specimens are unacceptable as evidence of actual trademark use because they do not show use of the mark as it appears on the drawing page. The drawing displays the mark as E-Z. However, this differs from the display of the mark on the specimens, where it appears as E-ZMATE. The applicant cannot amend the drawing to conform to the display on the specimens because the character of the mark would be materially altered. 37 C.F.R. Section 2.72(a); TMEP section 807.14(a).

Therefore, the applicant must submit three substitute specimens which show use of the mark as it appears on the drawing. 37 C.F.R. Section 2.51; TMEP section 807.14. The applicant must verify, with an affidavit or a declaration under 37 C.F.R. Section 2.20, that the substitute specimens were

in use in commerce at least as early as the filing date of the application. 37 C.F.R. Sections 2.59(a) and 2.72(b); TMEP section 905.10

The following is a properly worded declaration under 37 C.F.R. Section 2.20. At the end of the response, the applicant should insert the declaration signed by Richard N. Maddox.

*The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that the facts set forth in this application are true; all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.*

\_\_\_\_\_  
(Signature)

\_\_\_\_\_  
(Print or Type Name and Position)

\_\_\_\_\_  
(Date)

  
Laura Gorman Kovalsky  
Trademark Attorney  
Law Office 106  
(703) 308-9106, x147 

# **EXHIBIT D**



MEMORANDUM OF TELEPHONE COMMUNICATION - For File

Date: 7/6/98 Mark/Serial No. E-Z 75412444

Call To  Michael Kovitz  
From

Area Code: (215) Telephone No. 965-1247

Examining Attorney: Laura Kowalsky

Reason for Call: OA issued re: Sub. specs needed -- App'l's attorney noted the correct mark is imprinted on the goods themselves, though not necess. on packaging

Comments: NO RESPONSE REQUIRED

AKK.