

TTAB



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Signature

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

RYOBI TECHNOLOGIES, INC.,

Opposer,

v.

MILWAUKEE ELECTRIC TOOL
CORPORATION,

Applicant.

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Opposition No. 153,447

TM OFFICE TRIAL AND
APPEAL BOARD
MAR 13 2003 9:33 AM

AMENDED ANSWER TO NOTICE OF OPPOSITION

BOX TTAB
NO FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Applicant, Milwaukee Electric Tool Corporation ("Milwaukee"), hereby answers the Notice of Opposition filed by Ryobi Technologies, Inc. ("Opposer") as follows:

1. Milwaukee admits that Opposer markets and sells certain electric power tools in interstate commerce. Milwaukee lacks knowledge or information sufficient to

[Handwritten mark]

form a belief as to the truth of the remaining allegations contained in Paragraph 1 of the Notice of Opposition and therefore denies them.

2. Milwaukee admits that it is engaged in the business of marketing and selling electric power tools and selected related goods in interstate commerce in retail stores, through internet retailers, catalog distributors, industrial and construction distributors, and in hardware and home improvement centers.

3. Milwaukee admits that it and Opposer are competitors with respect to the sale of certain electric power tools in selected channels of trade.

4. Milwaukee admits that it is the owner of the trademark that is the subject of the application at issue, Serial No. 75/830,888, and that it has applied to register the mark for the identified goods sold in the identified channels of trade. Milwaukee expressly denies the allegation that its trademark is merely “a decorative and ornamental red-and-black color scheme.”

5. Other than apparently *de minimus* use, Milwaukee denies that others have used confusingly similar marks or trade dress in Milwaukee’s channels of trade prior to Milwaukee’s acquisition of rights to its trademark. Accordingly, Milwaukee objects to the allegations in Paragraph 5 as being either ambiguous or not relevant. To the extent that the allegations relate to the use of red and black in proportions that do not create a similar overall commercial impression to the trademark of the present application, such allegations are not relevant to this proceeding. To the extent that the allegations relate to the use in Milwaukee’s channels of trade of red and black in proportions that create a similar overall commercial impression to Milwaukee’s

trademark, such use is an infringement of Milwaukee's trademark. Milwaukee admits that certain other entities have recently begun using a combination of red and black in a manner having a similar overall commercial impression to the mark of the present application in Milwaukee's channels of trade. Milwaukee denies the remaining allegations of paragraph 5.

6. Milwaukee avers that its mark is indeed capable of functioning as a trademark, and does in fact function as a trademark for Milwaukee's products. Milwaukee objects to the allegations in the second sentence of Paragraph 6 as being ambiguous or irrelevant, as they incorrectly suggest that the statute requires "exclusive" use for evidencing acquired distinctiveness, rather than "substantially exclusive" use. *See* 15 USC 1052(f). Milwaukee denies any implication that its use of its mark has not been substantially exclusive, denies the allegation that its mark is not distinctive of Milwaukee's products, and denies the remaining allegations of paragraph 6.

7. Milwaukee admits that registration of its trademark would provide it with prima facie evidence of the exclusive right to use that mark in commerce on or in connection with the applied-for goods, as provided under the Lanham Act, 15 U.S.C. §§1057(b) and 1115(a). Milwaukee further admits that Opposer would be, and is, prohibited from using a confusingly similar trademark under American trademark law. Milwaukee denies that Opposer would be "seriously damaged" by either the registration of Milwaukee's trademark, or the prohibition under American trademark law against the use of confusingly similar marks. Opposer would still have a multitude of color combinations available for use on its products.

8. Except as expressly admitted herein, Milwaukee denies each and every allegation in the Notice of Opposition.

AFFIRMATIVE DEFENSE

9. Opposer has failed to state a claim for which relief can be granted.

WHEREFORE, Milwaukee requests that the opposition be dismissed and that its application be passed on to registration.

Respectfully submitted,



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Date: March 13, 2003

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing was served by First Class U.S. Mail, on this the 13th day of March, 2003, to:

Jerome Gilson, Esq.
Brinks Hofer Gilson & Lione
P.O. Box 10395
Chicago, Illinois 60611

A handwritten signature in black ink, consisting of several overlapping, stylized loops and strokes, positioned above a horizontal line.