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

00702372003TTAB

<p>Homer TLC, Inc., and Home Depot U.S.A., Inc.,</p> <p style="text-align: center;">Opposers,</p> <p>v.</p> <p>The New Sioux City Iron Company,</p> <p style="text-align: center;">Applicant.</p>	<p>Opposition No: 91156891</p> <p>In the matter of: Application No: 78/116,332 Mark: THE TOOL DEPOT &amp; Design Published in Official Gazette on: February 11, 2003</p>
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08-05-2003

U.S. Patent & TMO/TM Mail Rpt Dt. #74

ANSWER TO NOTICE OF OPPOSITION

**BOX TTAB - NO FEE**  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514

08/05/03 10:06:58  
COMM-FEDERAL

Commissioner:

Applicant, The New Sioux City Iron Company ("Applicant") hereby answers the Notice of Opposition filed by Opposers, Homer TLC, Inc. ("Homer") and Home Depot U.S.A., Inc. ("Home Depot") (Homer and Home Depot are collectively referred to herein as "Opposers"):

With respect to the preliminary averments in the unnumbered paragraphs of the opposition, Applicant responds as follows:

Applicant admits that it has filed an application in the United States Patent & Trademark Office, Serial No. 78/116,332 in International Class 35 for the mark THE TOOL DEPOT & Design. Applicant denies that Opposers will be in any way damaged by the registration of its

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THE TOOL DEPOT & Design mark. Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations and on that basis denies all such allegations.

### **SPECIFIC GROUNDS FOR OPPOSITION**

1. In response to paragraph 1 of the Notice of Opposition, Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegation in paragraph 1 of the Notice of Opposition and on that basis denies the allegations therein.

2. In response to paragraph 2 of the Notice of Opposition, Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegation in paragraph 2 of the Notice of Opposition and on that basis denies the allegations therein.

3. In response to paragraph 3 of the Notice of Opposition, Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegation in paragraph 3 of the Notice of Opposition and on that basis denies the allegations therein.

4. In response to paragraph 4 of the Notice of Opposition, Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegation in paragraph 4 of the Notice of Opposition and on that basis denies the allegations therein.

5. In response to paragraph 5 of the Notice of Opposition, Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegation in paragraph 5 of the Notice of Opposition and on that basis denies the allegations therein.

6. In response to paragraph 6 of the Notice of Opposition, Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegation in paragraph 6 of the Notice of Opposition and on that basis denies the allegations therein.

7. In response to paragraph 7 of the Notice of Opposition, Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegation in paragraph 7 of the Notice of Opposition and on that basis denies the allegations therein.

8. In response to paragraph 8 of the Notice of Opposition, Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegation in paragraph 8 of the Notice of Opposition and on that basis denies the allegations therein.

9. Applicant denies the allegations in paragraph 9 of the Notice of Opposition.

10. In response to paragraph 10 of the Notice of Opposition, Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegation in paragraph 10 of the Notice of Opposition and on that basis denies the allegations therein.

11. In response to paragraph 11 of the Notice of Opposition, Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegation in paragraph 11 of the Notice of Opposition and on that basis denies the allegations therein.

12. In response to paragraph 12 of the Notice of Opposition, Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegation in paragraph 12 of the Notice of Opposition and on that basis denies the allegations therein.

13. In response to paragraph 13 of the Notice of Opposition, Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegation in paragraph 13 of the Notice of Opposition and on that basis denies the allegations therein.

14. In response to paragraph 14 of the Notice of Opposition, Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegation in paragraph 14 of the Notice of Opposition and on that basis denies the allegations therein.

15. Applicant denies the allegations in paragraph 15 of the Notice of Opposition.

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16. In response to paragraph 16 of the Notice of Opposition, Applicant admits that it is an Iowa corporation, but denies the remainder of the allegations in paragraph 16.

17. Applicant admits that Application Serial No. 78/118,332 was filed on March 20, 2002 and that the mark THE TOOL DEPOT & Design mark was used in commerce for "retail store services for tools, hardware, construction supplies and home improvement supplies." The application was filed in International Class 35, as is evidenced by the publication of the application in the Official Gazette at TM390 on February 11, 2003.

18. Applicant admits the averments of paragraph 18.

19. Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 19 of the Notice of Opposition and on that basis denies the allegations therein.

20. Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 20 of the Notice of Opposition and on that basis denies the allegations therein.

21. Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 21 of the Notice of Opposition and on that basis denies the allegations therein.

22. Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 22 of the Notice of Opposition and on that basis denies the allegations therein.

23. Applicant denies the allegations in paragraph 23 of the Notice of Opposition.

24. In response to paragraph 24 of the Notice of Opposition, Applicant admits its THE TOOL DEPOT mark used for "retail store services for tools, hardware, construction

supplies and home improvements supplies." Applicant denies the remainder of the allegations in paragraph 24 of the Notice of Opposition.

25. Applicant denies the allegations in paragraph 25 of the Notice of Opposition.

26. Applicant admits the averments of paragraph 26.

27. Applicant denies the allegations in paragraph 27 of the Notice of Opposition.

28. In response to paragraph 28 of the Notice of Opposition, Applicant admits that upon it would obtain at least a prima facie exclusive right to the use of its THE TOOL DEPOT mark. Applicant denies the remainder of paragraph 28 of the Notice of Opposition.

#### **AFFIRMATIVE DEFENSES**

29. The Notice of Opposition fails to state a claim upon which any relief can be granted to Opposers.

30. There is no likelihood of confusion, mistake or deception because, among other things, Applicant's mark differs from Opposers' mark in terms of sight, sound, meaning and appearance.

31. Opposers' rights vis-à-vis other marks have been substantially diluted by the numerous unrelated third-party marks that include the term "depot" and the term "the" in context of retail store services, and for tools, hardware, construction supplies and home improvement supplies and other uses, all without objection by Opposers.

32. In the context of the famous mark statute, Opposers mark is not "famous."

33. In view of Moseley v. V Secret Catalogue, Inc., 537 U.S. 418 (2003), as a matter of law, Opposers have failed to plead a dilution case.

34. Opposer is estopped to assert its rights against Sioux City Iron.

35. In its area of usage, Sioux City Iron has priority of usage and therefore superior rights and is entitled to be a concurrent user.

36. Opposers actions are barred by the doctrine of laches or acquiescence.

WHEREFORE, Applicant prays:

- A. that Opposers' Notice of Opposition be dismissed with prejudice;
- B. that Applicant's registration for Application Serial No. 78/116,332 be granted; and
- C. that any such further relief be granted Applicant as may be deemed appropriate.

Dated: August 4, 2003

Respectfully submitted,




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ATTORNEYS FOR APPLICANT THE NEW  
SIOUX CITY IRON COMPANY

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**CERTIFICATE OF MAILING**

I hereby declare that the attached **Answer to Notice of Opposition** has been filed by depositing the same with the U.S. Postal Service "Post Office to Addressee" Express Mail service prior to 5:00 p.m. (Express Mail Certificate No. EL 987134419 US) this 4th day of August, 2003 to:

Commissioner for Trademarks  
Box TTAB No Fee  
2900 Crystal Drive  
Arlington, VA 22202-3514

  
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Edmund J. Sease

**CERTIFICATE OF SERVICE**

I hereby declare that the foregoing instrument was served upon the following this 4th day of August, 2003, via:

- |                                     |                                 |                          |                 |
|-------------------------------------|---------------------------------|--------------------------|-----------------|
| <input checked="" type="checkbox"/> | 1 <sup>st</sup> Class U.S. Mail | <input type="checkbox"/> | Federal Express |
| <input type="checkbox"/>            | Facsimile                       | <input type="checkbox"/> | Hand Delivery   |
| <input type="checkbox"/>            | Other _____                     |                          |                 |

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