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Filing date: **02/05/2008**

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

|                        |   |
|------------------------|---|
| Proceeding             | 91163836  |
| Party                  | Plaintiff<br>SMARTPOOLS INC.  |
| Correspondence Address | JAMES M. SLATTERY, ESQ.<br>BIRCH, STEWART, KOLASCH & BIRCH, LLP<br>P.O. BOX 747<br>FALLS CHURCH, VA 22040-0747<br>UNITED STATES<br>mailroom@bskb.com, wyckoffa@bskb.com, jms@bskb.com |
| Submission             | Answer to Counterclaim  |
| Filer's Name           | James M. Slattery   |
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| Signature              | /James M. Slattery/   |
| Date                   | 02/05/2008  |
| Attachments            | 2008-02-05 - Signed Response and Counterclaims.doc.pdf ( 9 pages )(1309713 bytes )  |

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

IN THE TRADEMARK APPLICATION OF  
Green Energy Inc.  
Application No.: 78/336,956  
Filed: December 5, 2003  
Mark: SUNWAVE  
Class: Int'l. Class 11  
Published in the Official Gazette dated September 14, 2004

|                         |   |
|-------------------------|---|
| SMARTPOOL, INC.         | ) |
|                         | ) |
| Opposer,                | ) |
|                         | ) |
| v.                      | ) |
|                         | ) |
| GREEN ENERGY INC.       | ) |
|                         | ) |
| Applicant or Registrant | ) |

Opposition No. 91163836  
(Serial No. 78/336,956)

**ATTN: BOX TTAB**

RESPONSE TO ANSWER TO NOTICE OF OPPOSITION AND  
COUNTERCLAIM TO CANCEL REGISTRATION

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Sir:

Pursuant to the Trademark Trial and Appeal Board ruling dated February 4, 2008, Smartpool, Inc. (herein "Opposer") by and through its attorneys, hereby responds to the Answer to Notice of Opposition and Counterclaim to Cancel registration by Green Energy Inc. (herein "Applicant".) The present Response is only for counterclaims to cancel registration as follows:

COUNTERCLAIMS

1. Applicant petitions to cancel Registration No. 2,731,607 owned by Opposer, on the grounds that the mark described in Registration No. 2,731,607 is generic for the goods provided thereunder by Opposer.

RESPONSE:

Opposer denies paragraph 1 of the Counterclaims. Procedurally, Applicant must file a Petition for Cancellation to actually cancel Registration No. 2,731,607. In addition, the Opposer's mark "SUNHEATER and Design" is a distinctive mark that can be recognized by the public to indicate the source or origin of the goods. The design portion of the Opposer's registered mark further distinguishes the Opposer's mark from other's marks.

2. Applicant petitions to cancel Registration No. 2,731,607 owned by Opposer, on the grounds that the mark described in Registration No. 2,731,607 is merely descriptive of the goods provided there under by Opposer.

RESPONSE:

The Opposer denies the allegation in paragraph 2 of the Counterclaim. Procedurally, Applicant must file a Petition for Cancellation to actually cancel Registration No. 2,731,607. In addition, the Opposer's mark is a registered mark that is suggestive not merely descriptive of Opposer's goods. When a customer sees the Opposer's registered mark, he or she cannot immediately associate the mark with goods, namely, swimming pool heating systems comprised of solar and naturally heated panels, sensors, valves, switches, transmitters and electrical connectors. In

addition, the Opposer has used the registered mark for more than five years in connection with the goods set forth in the registered mark in commerce.

3. Opposer's Registration No. 2,731,607 is less than five (5) years old.

RESPONSE:

Opposer denies the allegation in paragraph 3 of the Counterclaims. Although the Opposer's registered mark was registered on July 1, 2003, the Opposer has been using the mark as long as October, 1998 in connection with the goods in commerce.

4. Opposer's Registration No. 2,731,607 does not contain a disclaimer of any portion of the mark.

RESPONSE:

Opposer admits the allegation in paragraph 4 of the Counterclaims. More particularly, no disclaimer is necessary as the Opposer's registered mark is one word, created by a combination of the two words "SUN" and "HEATER" as one word.

5. Applicant is being damaged by the Registration because Opposer has asserted it against the Opposed Registration.

RESPONSE:

Opposer does not understand the allegation set forth in paragraph 5 of the Counterclaims, as the question included the term "the Opposed Registration." Particularly, the opposed registration should be the "opposed application of the Applicant." If this is correct, Opposer denies the allegation set forth in this

counterclaim.

6. Opposer's Registration No. 2,731,607 for "SUNHEATER and Design" is claimed for "Swimming pool heating systems comprised of solar and naturally heated panels, sensors, valves, switches, transmitters, and electrical connectors."

RESPONSE:

Opposer denies the allegations set forth in paragraphs 6-11 in the Counterclaims. More specifically, the Applicant repeats paragraph 1 of this counterclaim above. Opposer has already responded to the issue of generics of the Opposer's mark in paragraph 1 of the counterclaims.

7. The word "SUN" is synonymous with "SOLAR."

RESPONSE:

Opposer denies paragraphs 6-11 in the Counterclaims. More specifically, the Applicant repeats paragraph 1 of this counterclaim above. Opposer has already responded to the issue of generic in paragraph 1 of the counterclaims.

8. The goods offered by Opposer are heaters powered by the sun.

RESPONSE:

Opposer denies paragraphs 6-11 in the Counterclaims. Specifically, the Applicant repeats paragraph 1 of this counterclaim above. Opposer has already responded to the issue of generic in paragraph 1 of the counterclaims.

9. Opposer's registration is an extension of generic terms as evidenced by its own recitation of goods and services.

RESPONSE:

Opposer denies paragraphs 6-11 in the Counterclaims. More specifically, the Applicant repeats paragraph 1 of this counterclaim above. Opposer has already responded to the issue of generic in paragraph 1 of the counterclaims.

10. The stylized rendition of SUNHEATER is not sufficiently unusual or distinctive to distinguish it as anything other than a generic term indicating a solar heater and as such does not qualify for registration.

RESPONSE:

Opposer denies paragraphs 6-11 in the Counterclaims. More specifically, the Applicant repeats paragraph 1 of this counterclaim above. Opposer has already responded to the issue of generic in paragraph 1 of the counterclaims.

11. Relevant consumers of pool supplies associate the term "sun heater," not with a particular source of goods, but with solar heating technology that permeates the pool heating industry as a whole. The term sun heater generically refers to solar heaters and as such Registration No. 2,731,607 is invalid under 15 U.S.C. §1064(3).

RESPONSE:

Opposer denies paragraphs 6-11 in the Counterclaims. More specifically, the Applicant repeats paragraph 1 of this counterclaim above. Opposer has already responded to the issue of generic in paragraph 1 of the counterclaims.

12. Applicant re-alleges all the facts set forth in paragraphs 1 through 11.

RESPONSE:

Opposer denies the allegations set forth in paragraphs 12-15 in the Counterclaims. Specifically, the Applicant repeats its counterclaims regarding the issue of descriptiveness in paragraph 2 of this counterclaim above. Opposer has already responded to the Applicant's response to the counterclaim raised by the Applicant regarding the issue of descriptiveness of the Opposer's registered mark. Therefore, Opposer denies every one of the counterclaims set forth in paragraphs 12-15.

13. Opposer's registration is an extension of terms which merely describes the goods offered as evidenced by its own recitation of goods and services.

RESPONSE:

Opposer denies the allegations set forth in paragraphs 12-15 in the Counterclaims. More specifically, the Applicant repeats its counterclaims regarding the issue of descriptiveness in paragraph 2 of this counterclaim above. Opposer has already responded to the Applicant's response to the counterclaim raised by the Applicant regarding the issue of descriptiveness of the Opposer's registered mark. Therefore, Opposer denies every one of the counterclaims set forth in paragraphs 12-15.

14. The stylized rendition of SUNHEATER is not sufficiently unusual or distinctive to distinguish it as anything other than a merely descriptive term indicating

a solar heater and as such does not qualify for registration.

RESPONSE:

Opposer denies the allegations set forth in paragraphs 12-15 in the Counterclaims. More specifically, the Applicant repeats its counterclaims regarding the issue of descriptiveness in paragraph 2 of this counterclaim above. Opposer has already responded to the Applicant's response to the counterclaim raised by the Applicant regarding the issue of descriptiveness of the Opposer's registered mark. Therefore, Opposer denies every one of the counterclaims set forth in paragraphs 12-15.

15. Relevant consumers of pool supplies associate the term sun heater, not with a particular source of goods, but as a description of a particular kind of heater. The term sun heater merely describes the type of heater provided and as such Registration No. 2,731,607 is invalid under 15 U.S.C. §1052(e)(1).

RESPONSE:

Opposer denies the allegations set forth in paragraphs 12-15 in the Counterclaims. More specifically, the Applicant repeats its counterclaims regarding the issue of descriptiveness in paragraph 2 of this counterclaim above. Opposer has already responded to the Applicant's response to the counterclaim raised by the Applicant regarding the issue of descriptiveness of the Opposer's registered mark. Therefore, Opposer denies every one of the counterclaims set forth in paragraphs 12-15.



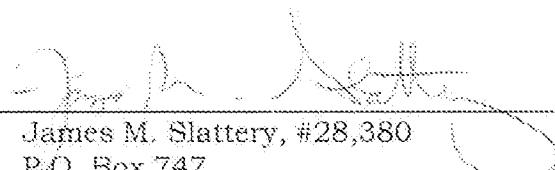
16. The mark which is the subject of Registration No. 2,731,607 should not be registered without a disclaimer of the word "SUN."

RESPONSE:

Opposer denies the allegation set forth in paragraph 16 of the Counterclaim. Specifically, Applicant repeats in its counterclaim which appears in paragraph 4 of its counterclaims. Opposer has already responded to the counterclaim regarding the issue of disclaimer. Therefore, Opposer denies this counterclaim in paragraph 16.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By:   
James M. Slattery, #28,380  
P.O. Box 747  
Falls Church, VA 22040-0747

**CERTIFICATE OF SERVICE**

It is hereby certified that a true and correct copy of the foregoing Response To Answer To Notice Of Opposition And Counterclaim To Cancel Registration has been served upon the attorney for the Applicant:

Thomas E. Toner  
SMITH & HOPEN, P.A.  
180 Pine Avenue North  
Oldsmar, FL 34677  
(813) 925-8505

Via first-class mail, postage prepaid, on this 5<sup>th</sup> day of February, 2008.

By Ann Thomas  
Ann Thomas