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

Proceeding	91167243
Party	Defendant Porter-Cable Corporation Porter-Cable Corporation 4825 Highway 45 North Jackson, TN 38305
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL**

SENCO PRODUCTS, INC.)	
)	
Opposer,)	Opposition No. 91167243
)	Serial No. 76/566,313
v.)	
)	
PORTER-CABLE CORPORATION,)	
)	
Applicant.)	

ANSWER AND AFFIRMATIVE DEFENSES TO NOTICE OF OPPOSITION

Applicant, Porter-Cable Corporation, responds to the Notice of Opposition of Opposer, Senco Products, Inc., as follows:

1. Opposer, directly and through related companies, has for several decades manufactured, marketed and sold power tools and related goods in interstate commerce.

Response:

Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations and therefore, the allegations as stated therein are denied.

2. Opposer markets and sells power tools and related goods in various colors, including a gray-and-black color scheme, which have been and are extensively advertised and promoted throughout the United States.

Response:

Admitted that Opposer markets and sells pneumatic nailers, pneumatic staplers, electric power screw guns, trim nailers and finish nailers in various colors; otherwise denied.

3. Opposer has a valid and legal right to manufacture and/or distribute power tools using the colors gray and black, and the right to distribute such goods in any industry or market.

Response:

Denied on the ground that this paragraph is not an assertion of fact, but seeks an admission with respect to an ultimate legal conclusion.

4. Upon information and belief, Applicant also is engaged in the manufacture, marketing and sale of power tools and related goods in interstate commerce.

Response:

Admitted that Applicant manufactures, markets and sells power tool products and related good in interstate commerce; otherwise denied.

5. Opposer and Applicant are competitors with respect to the manufacture, marketing and sale of power tools and related goods.

Response:

Denied.

6. Applicant's goods and Opposer's power tools and related goods sold under gray and black color schemes are competitive, overlapping and/or related.

Response:

Denied.

7. Applicant has applied to register Applicant's design, a decorative and ornamental gray-and-black color scheme, as a trademark for "power tools, namely, sanders." This application was given Serial No. 76/566,313.

Response:

Admitted that the Applicant has applied to register its distinctive, non-functional and famous gray and black color scheme as a trademark for power tools, namely, sanders in application Serial no. 76/566,313; otherwise denied.

8. The design which is the subject of the Application is generic, ornamental and/or functional.

Response:

Denied.

9. A number of other entities, including Opposer, have used and are using similar ornamental gray-and-black color schemes for power tools and related goods. Like Applicant's Design, these other designs have been used and are being used in a decorative manner covering the surface of the power tools and related goods. As a result of this widespread use of such decorative designs, the consuming public perceives Applicant's Design merely as a decorative or ornamental feature of the goods and not as an indicator of the source of the goods. Thus Applicant's Design does not function as a mark as required under Sections 1, 2 and 45 of the Lanham Act, 15 U.S.C. §§ 1051, 1052 and 1127, but serve as ornamentation on power tools and related goods emanating from different companies.

Response:

Denied.

10. Upon information and belief, the gray and black color scheme is used on a wide variety of power tools and related goods because of the function it serves.

Response:

Denied.

11. In particular, both of the colors gray and black are effective in making dirt, grease and fingerprints less visible; further, the color black is typically used on rubberized surfaces subject to high-wear or potential impact and functions to hide or diminish scuff and wear marks. Finally, black is an inexpensive colorant.

Response:

Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations and therefore, the allegations as stated therein are denied.

12. On information and belief, Applicant has not been the exclusive user of the colors gray and black for power tools and related goods.

Response:

Denied.

13. On information and belief, numerous third-party manufacturers have advertised and used the gray over black color scheme in connection with power tools and related goods for many years.

Response:

Denied.

14. Applicant's use of a gray and black color scheme for power tools, namely, sanders is not distinctive within markets where Opposer and other third party power tool manufacturers commonly use gray and black on power tools.

Response:

Denied.

15. In light of the continuous use of a gray-and-black color scheme in commerce by Opposer in connection with power tools and related goods for several decades, and in light of third party uses of gray and black for similar power tools and related goods, the gray and black color scheme is not distinctive to Applicant, and therefore does not and can not function as a mark.

Response:

Denied.

16. Based on the above, the gray and black color scheme as applied to power tools and related goods does not serve as a source indicator and cannot qualify for trademark protection.

Response:

Denied.

17. Moreover, even if Applicant's Design was capable of functioning as a trademark, Applicant's evidence submitted in support of its request for registration under Section 2(f) of the Lanham Act, 15 U.S.C. § 1052(f), is insufficient. Applicant's Design has not been used exclusively, and has not become distinctive of the Applicant's goods in commerce.

Response:

Denied.

18. In view of the above, Applicant is not entitled to federal registration of its alleged gray-and-black color design mark as Applicant is not entitled to exclusive use of the gray and black color design in commerce in connection with power tools and related goods.

Response:

Denied.

19. Opposer and others are entitled to use the colors gray and black in connection with their power tools and related goods, and registration to Applicant of those colors would be inconsistent with the right of Opposer and others to continue their aforesaid use.

Response:

Denied.

20. Registration of Applicant's Design would provide applicant with prima facie evidence of an exclusive right to use Applicant's Design in commerce on or in connection with the applied-for goods. Consequently, Opposer will be seriously damaged by registration of Applicant's Design because a registration could be used to inhibit and interfere with Opposer's current right to ongoing use of a gray-and-black color scheme in connection with power tools or other goods related to those identified in Application Serial No. 76/566,313.

Response:

Admitted that the registration of Application Serial No. 76,566,313 grants Applicant certain rights; otherwise denied.

21. For the reasons noted above, Applicant is not entitled to a federal registration of the gray-and-black color scheme for power tools, namely, sanders and is not entitled to the exclusive use of the gray-and-black color scheme for such products.

Response:

Denied.

22. Opposer is also opposing Applicant's registration of the similar and related designs in Application Serial Nos. 76/566,311, 76,566,312, 76/566,326, 76/566,327, 76/566,329, 76/566,330, 76/566,331, 76/566,333 and 76/566,335.

Response:

Admitted that Opposer filed Oppositions for applications bearing Serial Nos. 76/566,311, 76,566,312, 76/566,326, 76/566,327, 76/566,329, 76/566,330, 76/566,331, 76/566,333 and 76/566,335; otherwise denied.

Affirmative Defenses

1. Opposer has failed to state a cause of action upon which relief can be granted.
2. Opposer does not have standing to pursue its present Opposition.
3. Applicant's trademark identified in Application Serial No. 76/566,313 is distinctive, non-functional and has acquired secondary meaning.
4. The goods associated with Applicant's trademark identified in Application Serial No. 76/566,313 are not likely to be confused with Opposer's goods.

WHEREFORE, applicant prays that Opposer's opposition be dismissed and the mark of the subject application be registered.

Respectfully submitted,



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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **ANSWER AND AFFIRMATIVE DEFENSES TO NOTICE OF OPPOSITION** was served upon the below listed counsel by Federal Express on this 9th day of October, 2006.

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