

ESTTA Tracking number: **ESTTA50409**

Filing date: **10/26/2005**

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

### Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

#### Opposer Information

<b>Name</b>	Senco Products, Inc.
<b>Granted to Date of previous extension</b>	11/02/2005
<b>Address</b>	8485 Broadwell Road Cincinnati, OH 45244 UNITED STATES

<b>Attorney information</b>	Louis K. Ebling; Glenn D. Bellamy Greenebaum, Doll & McDonald PLLC 2800 Chemed Center 255 E. 5th Street Cincinnati, OH 45202 UNITED STATES gdb@gdm.com Phone: 513-455-7625
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#### Applicant Information

<b>Application No</b>	76566327	<b>Publication date</b>	07/05/2005
<b>Opposition Filing Date</b>	10/26/2005	<b>Opposition Period Ends</b>	11/02/2005
<b>Applicant</b>	Porter-Cable Corporation 4825 Highway 45 North Jackson, TN 38305		

UNITED STATES
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**Goods/Services Affected by Opposition**

Class 007. First Use: 19960100 First Use In Commerce: 19960100

All goods and services in the class are opposed, namely: POWER TOOLS, NAMELY, PNEUMATIC AND ELECTRIC NAILERS

**Related Proceedings**

S/N 76/566,311; S/N 76/566,312; S/N 76/566,313; S/N 76/566,326;  
S/N 76/566,329; S/N 76/566,330; S/N 76/566,331; S/N 76/566,333;  
S/N 76/566,335

**Attachments**

327.pdf ( 6 pages )

**Signature**

/Glenn D. Bellamy/

**Name**

Glenn D. Bellamy

**Date**

10/26/2005



1. Opposer, directly and through related companies, has for several decades manufactured, marketed and sold power tools and related goods in interstate commerce.
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.
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.
4. Upon information and belief, Applicant also is engaged in the manufacture, marketing and sale of power tools and related goods in interstate commerce
5. Opposer and Applicant are competitors with respect to the manufacture, marketing and sale of power tools and related goods.
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.
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, pneumatic and electric nailers." This application was given Serial No. 76/566,327.
8. The design which is the subject of the Application is generic, ornamental and/or functional
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.

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.

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.

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

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.

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

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.

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.

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.

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.

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.

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. 76/566,327.

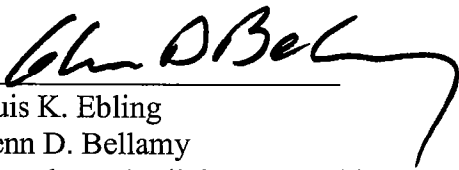
21. For the reasons noted above, Applicant is not entitled to a federal registration of the gray-and-black color scheme for power tools, namely, pneumatic and electric nailers and is not entitled to the exclusive use of the gray- and-black color scheme for such products.

22. Opposer is also opposing Applicant's registration of the similar and related designs in Application Serial Nos. 76/566,311, 76/566,312, 76/566,313, 76/566,326, 76/566,329, 76/566,330, 76/566,331, 76/566,333 and 76/566,335.

WHEREFORE, Opposer, Senco Products, Inc., prays that its Opposition be sustained and that Application Serial No. 76/566,327 be denied registration.

Please charge the filing fee of \$300 and any additional fees to Greenebaum Doll & McDonald PLLC's Deposit Account, No. 50-2904, the account of Opposer's counsel noted below.

Respectfully submitted,

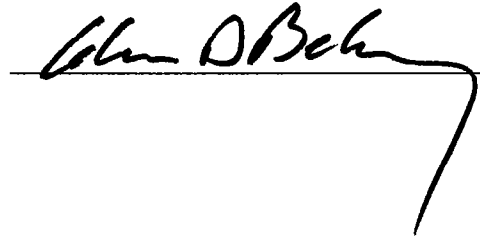


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Date: 26 October 2005

**CERTIFICATE OF MAILING**

I hereby certify that a copy of this NOTICE OF OPPOSITION is being submitted electronically to: Commissioner for Trademarks, P.O. Box 1451, Alexandria VA 22313-1451 on this 26<sup>th</sup> day of October, 2005.

A handwritten signature in black ink, appearing to read "John O'Behr", is written above a horizontal line. The signature is cursive and extends to the right, ending in a long, sweeping tail that curves downwards.