

ESTTA Tracking number: **ESTTA82452**

Filing date: **05/25/2006**

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

Name	North American Salt Company
Granted to Date of previous extension	05/31/2006
Address	9900 West 109th Street, Suite 600 Overland Park, KS 66210 UNITED STATES
Attorney information	Michael Elbein Hovey Williams LLP 2405 Grand Blvd., Suite 400 Kansas City, MO 64108 UNITED STATES mme@hoveywilliams.com, krb@hoveywilliams.com, lrg@hoveywilliams.com, jlw@hoveywilliams.com Phone:816-474-9050

Applicant Information

Application No	78376367	Publication date	01/31/2006
Opposition Filing Date	05/25/2006	Opposition Period Ends	05/31/2006
Applicant	Illinois Tool Works Inc. 3600 West Lake Avenue Glenview, IL 600255811 UNITED STATES		

Goods/Services Affected by Opposition

<p>Class 002. All goods and services in the class are opposed, namely: Paints, varnishes, lacquers; preservatives against rust; raw natural resins; metals in foil and powder form for painters and decorators; paints, varnishes, lacquers having anti-slip properties; anti-slip sprays and coatings in the nature of paints; primers; epoxy resins for use in covering floors, paths, roads, decks, ramps, stairs; epoxy resin anti-slip floor, path, road, deck, ramp, stair coverings; epoxy resins for use in repairing floors and flooring, paths, roads, decks, ramps, stairs; epoxy resins for use in repairing concrete and asphalt</p>
<p>Class 006. All goods and services in the class are opposed, namely: Anti-slip panels, boards, blocks, tiles and tile floorings for building construction; anti-slip stairs, stair treads, and stair inserts; all predominantly of metal</p>
<p>Class 017. All goods and services in the class are opposed, namely: Rubber, gutta-percha, gum, asbestos, mica for use in the manufacture of anti-slip stairs, stair-treads, and stair tread inserts in the form of self-adhesive tapes; rubber, gutta-percha, gum, asbestos, mica having anti-slip properties; anti-slip tapes; self-adhesive anti-slip tapes</p>

Class 019.

All goods and services in the class are opposed, namely: Anti-slip non-metal panels, boards, blocks, tiles and tile floorings for building construction, anti-slip stairs, stair-treads, and stair tread inserts and anti-slip tread inserts in the form of self-adhesive tapes

Attachments	Notice of Opposition - Executed.pdf (10 pages)(4302141 bytes)
Signature	/Michael Elbein/
Name	Michael Elbein
Date	05/25/2006

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

In the matter of Trademark Application Serial No. 78/376367
For the Mark: SAFE STEP
Published in the *Official Gazette* of January 31, 2006

NORTH AMERICAN SALT COMPANY)	
)	
Opposer,)	
)	
vs.)	Opposition No. _____
)	
ILLINOIS TOOL WORKS, INC.)	
)	
Applicant.)	

NOTICE OF OPPOSITION

Honorable Commissioner for Trademarks:

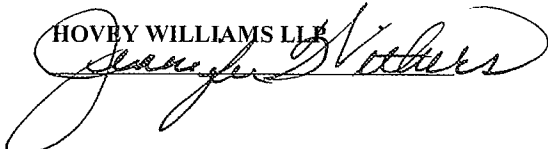
In the matter of Trademark Application Serial No. 78/376367 for the mark SAFE STEP filed March 1, 2004 and published for Opposition in the *Official Gazette* of January 31, 2006.

North American Salt Company, a Delaware Corporation having an address of 9900 West 109th Street, Suite 600, Overland Park, Kansas 66210 (“NASC”) believes that it will be damaged by registration of the mark shown in the above-identified application for the goods identified in the application and opposes the same. The grounds for the opposition are as follows:

1. Illinois Tool Works, Inc. (“Applicant”), seeks to register SAFE STEP as a trademark for:
 - a) Paints, varnishes, lacquers; preservatives against rust; raw natural resins; metals in foil and powder form for painters and decorators; paints, varnishes, lacquers having anti-slip properties; anti-slip sprays and coatings in the nature of paints;

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that the foregoing Notice of Opposition regarding U.S. Serial No. 78/376367 is being submitted via the ETTSA electronic filing system on this 25 day of May, 2006.

HOVEY WILLIAMS LLP


primers; epoxy resins for use in covering floors, paths, roads, decks, ramps, stairs; epoxy resin anti-slip floor, path, road, deck, ramp, stair coverings; epoxy resins for use in repairing floors and flooring, paths, roads, decks, ramps, stairs; epoxy resins for use in repairing concrete and asphalt, in International Class 002;

- b) Anti-slip panels, boards, blocks, tiles and tile floorings for building construction; anti-slip stairs, stair treads, and stair inserts; all predominantly of metal, in International Class 006;
- c) Rubber, gutta-percha, gum, asbestos, mica for use in the manufacture of anti-slip stairs, stair-treads, and stair tread inserts in the form of self-adhesive tapes; rubber, gutta-percha, gum, asbestos, mica having anti-slip properties; anti-slip tapes; self-adhesive anti-slip tapes, in International Class 017; and
- d) Anti-slip non-metal panels, boards, blocks, tiles and tile floorings for building construction, anti-slip stairs, stair-treads, and stair tread inserts and anti-slip tread inserts in the form of self-adhesive tapes, in International Class 019,

as evidenced by the publication of the mark in the *Official Gazette* of January 31, 2006.

2. The application being opposed was filed March 1, 2004 on the basis of Section 1(b) (“intent to use”) of the Trademark Act.

3. NASC, on its own and through its predecessors in interest, is and has been engaged in the sale of ice melter for use on driveways, sidewalks, steps, parking lots, pavement and the like for more than thirty (30) years; and has built a successful business.

4. NASC, on its own and through its predecessors in interest, has used the SAFE STEP trademark in commerce in connection with its goods and its business since at least as early as 1971. Materials showing Opposer’s use its SAFE STEP trademark are attached as Exhibit 1, and incorporated by reference in this Notice of Opposition.

5. Since at least as early as 1971, Opposer's use of the SAFE STEP trademark in connection with its surface treatment products has been continuous, commercially significant and substantially exclusive.

6. NASC is the owner, via assignment, of U.S. Trademark Registration No. 1,070,471 directed to the SAFE STEP mark. This registration is valid, subsisting and incontestable. A copy of this Registration is attached as Exhibit 2 and incorporated by reference in this Notice of Opposition. The assignment of this registration to NASC is recorded with the United States Patent and Trademark Office at reel/frame 2399/0319, and a change of name recorded at reel/frame 2398/0882.

7. Opposer has, since long prior to the filing date of the application being opposed, used SAFE STEP as a mark in connection with its surface treatment goods and business.

8. Opposer's SAFE STEP mark is inherently distinctive as applied to Opposer's goods and business.

9. By virtue of Opposer's continuous use in commerce of its SAFE STEP mark, such mark has become well and favorably known to the relevant trade and public in connection with such products and business.

10. In the application being opposed, there are no restrictions on trade channels, so it must be assumed that the goods identified in that application will travel through all trade channels appropriate for goods of that type.

11. Applicant's SAFE STEP mark is confusingly similar to Opposer's SAFE STEP mark.

12. Applicant has appropriated the whole of Opposer's mark.

13. Opposer's products and business and the goods listed by Applicant in the application being opposed are closely related.

14. Applicant seeks registration of the SAFE STEP mark for floor finishing preparation and materials used to treat or construct floors and other surfaces rendering them slip resistant.

15. Opposer, under its SAFE STEP mark, provides surface treatment products and other related types of products to the same and overlapping classes of customers as those of Applicant's mark. The overlap in products is evident and strong.

16. Applicant's goods are such that they travel through the same and overlapping channels of trade as Opposer's goods.

17. Applicant's SAFE STEP trademark as applied to the goods listed in the application being opposed so resembles Opposer's SAFE STEP mark as used by Opposer and applied to Opposer's products, that it is likely to cause confusion, mistake and/or deception.

18. If Applicant is permitted to register SAFE STEP for the goods set forth in the application being opposed, confusion of the relevant trade and public is likely to result.

19. Purchasers or potential purchasers of Applicant's goods would likely believe in error that such goods are offered by or in association with or under license from Opposer, or that Opposer and Applicant are otherwise affiliated.

20. Any defect, objection to or fault found with Applicant's goods sold under the SAFE STEP mark would necessarily reflect on and seriously injure the reputation that Opposer has established for its products and business.

21. If Applicant is granted a registration for the SAFE STEP mark, it would obtain at least a *prima facie* exclusive right to use the mark. Such registration would be a source of damage and injury to the Opposer.

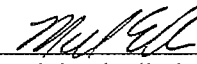
Opposition No. _____
Serial No. 78/376367

WHEREFORE, North American Salt Company prays that registration of the mark of Application Serial No. 78/376367, SAFE STEP, for the goods identified in that application be refused and that this Opposition be sustained.

The \$1200 filing fee for this Opposition may be charged to Deposit Account No. 19-0522. Any additional fees in connection with this Opposition may also be charged to this account, and any overpayment may be credited to this account.

Respectfully submitted,

Dated: May 25, 2006

By: 
Michael Elbein
Thomas H. Van Hoozer
Cheryl L. Burbach
HOVEY WILLIAMS LLP
2405 Grand Blvd. - Suite 500
Kansas City, MO 64108
(816) 474-9050 - Phone
(816) 474-9057 - Fax
Attorneys for Opposer

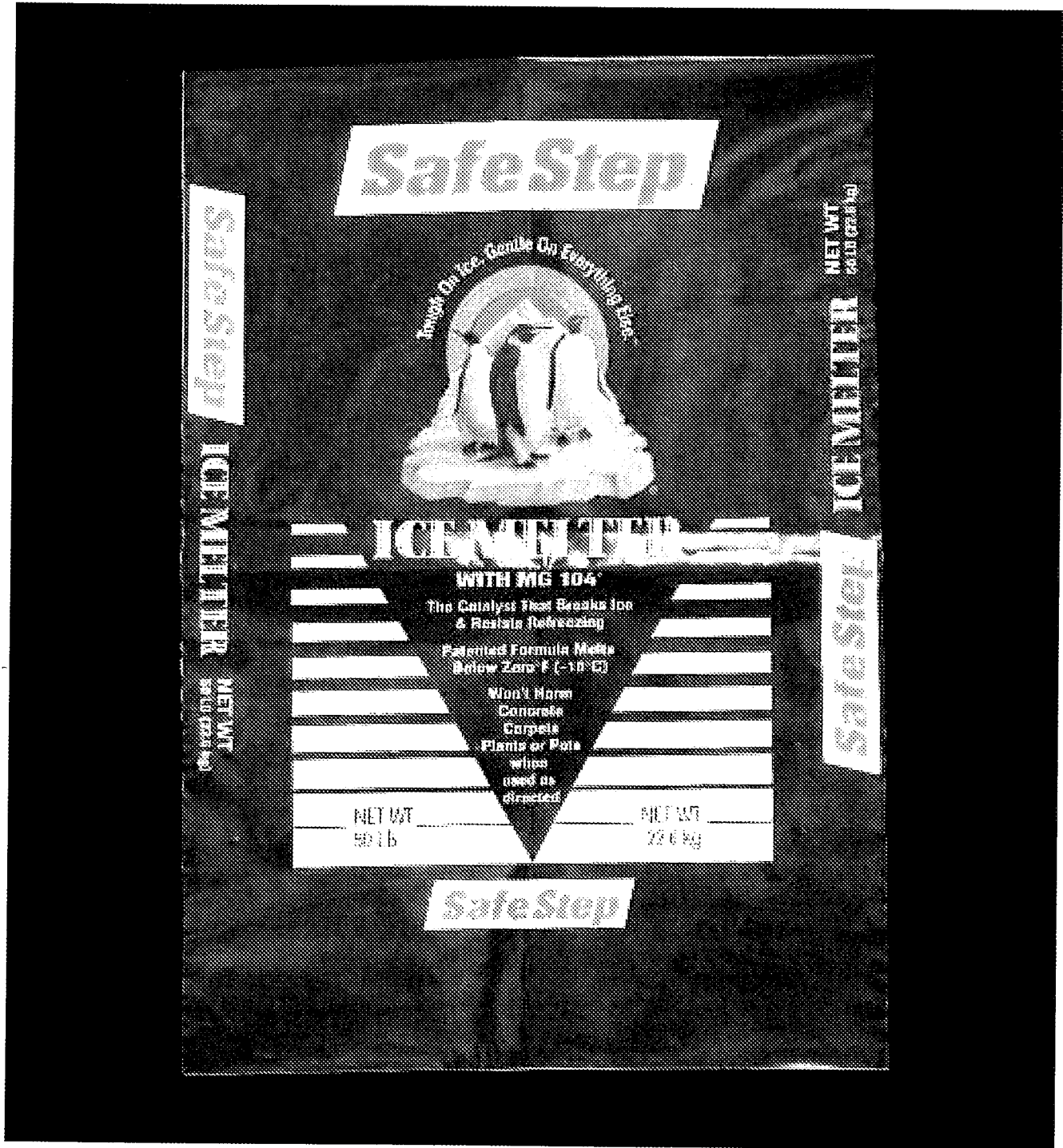


EXHIBIT 1

Opposition No. _____

Serial No. 78/376367

Int. Cl.: 1

Prior U.S. Cl.: 6

Reg. No. 1,070,471

United States Patent and Trademark Office

Registered Aug. 2, 1977

10 Year Renewal

Renewal Term Begins Aug. 2, 1997

**TRADEMARK
PRINCIPAL REGISTER**

SAFE STEP

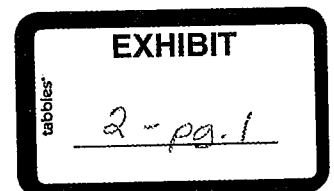
IMC AGRIBUSINESS INC. (DELAWARE
CORPORATION)
1503 3RD ST. SW
WINTER HAVEN, FL 33880. BY ASSIGN-
MENT AND CHANGE OF NAME
FROM KOOS, INC. (WISCONSIN COR-
PORATION) KENOSHA, WI

FOR: ICE MELTER FOR USE ON
DRIVEWAYS, SIDEWALKS, STEPS,
PARKING LOTS, PAVEMENT, AND
THE LIKE, IN CLASS 1 (U.S. CL. 6).
FIRST USE 1-7-1971; IN COMMERCE
1-7-1971.

SER. NO. 73-088,671, FILED 5-27-1976.

*In testimony whereof I have hereunto set my hand
and caused the seal of The Patent and Trademark
Office to be affixed on Oct. 14, 1997.*

COMMISSIONER OF PATENTS AND TRADEMARKS



Int. Cl.: 1

Prior U.S. Cl.: 6

United States Patent Office

Reg. No. 1,070,471
Registered Aug. 2, 1977

TRADEMARK
Principal Register

SAFE STEP

Koos, Inc. (Wisconsin corporation)
4500 13th Court
Kenosha, Wis. 53140

For: ICE MELTER FOR USE ON DRIVEWAYS,
SIDEWALKS, STEPS, PARKING LOTS, PAVEMENT,
AND THE LIKE, in CLASS 1 (U.S. CL. 6).
First use Jan. 7, 1971; in commerce Jan. 7, 1971.

Ser. No. 88,671, filed May 27, 1976.

D. E. SHALLANT, Examiner

EXHIBIT

tabbles

2 - pg. 2

Int. Cl.: 1

Prior U.S. Cl.: 6

United States Patent Office

Reg. No. 1,070,471
Registered Aug. 2, 1977

TRADEMARK

Principal Register

SAFE STEP

Koos, Inc. (Wisconsin corporation)
4500 13th Court
Kenosha, Wis. 53140

For: ICE MELTER FOR USE ON DRIVEWAYS,
SIDEWALKS, STEPS, PARKING LOTS, PAVEMENT,
AND THE LIKE, in CLASS 1 (U.S. CL. 6).
First use Jan. 7, 1971; in commerce Jan. 7, 1971.

Ser. No. 88,671, filed May 27, 1976.

D. E. SHALLANT, Examiner

EXHIBIT

tabbles

2-pg 3

Int. Cl.: 1

Prior U.S. Cl.: 6

United States Patent Office

Reg. No. 1,070,471
Registered Aug. 2, 1977

TRADEMARK

Principal Register

SAFE STEP

Koos, Inc. (Wisconsin corporation)
4500 13th Court
Kenosha, Wis. 53140

For: ICE MELTER FOR USE ON DRIVEWAYS,
SIDEWALKS, STEPS, PARKING LOTS, PAVEMENT,
AND THE LIKE, in CLASS 1 (U.S. CL. 6).
First use Jan. 7, 1971; in commerce Jan. 7, 1971.

Ser. No. 88,671, filed May 27, 1976.

D. E. SHALLANT, Examiner

EXHIBIT

tabbles

2 - pg 4