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

Proceeding	91172057
Party	Defendant Life Automotive Products
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Submission	Answer and Counterclaim
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Signature	/Michael R. Annis/
Date	01/30/2008
Attachments	Life Automotive Answer and Counterclaim.pdf (7 pages)(24148 bytes)

Registrations Subject to Cancellation

Registration No	1387200	Registration date	03/25/1986
Registrant	TOP OIL PRODUCTS COMPANY 851 BURLWAY ROAD, SUITE 600 BURLINGAME, CA 94010 UNITED STATES		
Goods/Services Subject to Cancellation	Class 004. First Use: 1982/08/20 , First Use In Commerce: 1982/08/20 Goods/Services:		
Grounds for Cancellation	The registered mark has been abandoned.		
	The registration was obtained fraudulently.		
Registration No	1428019	Registration date	02/10/1987
Registrant	TOP OIL PRODUCTS COMPANY 851 BURLWAY ROAD SUITE 600 BURLINGAME, CA 94010 UNITED STATES		
Goods/Services Subject to Cancellation	Class 001. First Use: 1983/04/12 , First Use In Commerce: 1983/04/12 Goods/Services:		
Grounds for Cancellation	The registered mark has been abandoned.		
	The registration was obtained fraudulently.		
Registration No	2017159	Registration date	11/19/1996
Registrant	Top Oil Products Company 851 Burlway Road, Suite 600 Burlingame, CA 94010 UNITED STATES		

Goods/Services Subject to Cancellation	Class 001. First Use: 1983/04/12 , First Use In Commerce: 1983/04/12 Goods/Services:
	Class 004. First Use: 1982/08/20 , First Use In Commerce: 1982/08/20 Goods/Services:
Grounds for Cancellation	The registered mark has been abandoned.
	The registration was obtained fraudulently.

CERTIFICATE OF MAILING VIA ELECTRONIC TRANSMISSION

I hereby certify that this correspondence is being filed with the United States Patent and Trademark Office via the Electronic System for Trademark Trials and Appeals on January 30, 2008.

/s/ Michael R. Annis

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

Mark: SMART BLEND SYNTHETICS ONE
ADVANCED FORMULA and Design

U.S. Application Serial No. 78/449,903

TOP OIL PRODUCTS COMPANY,)	
)	
Opposer/Counterclaim)	Opposition No. 91/172,057
Registrant,)	
)	
v.)	
)	
LIFE AUTOMOTIVE PRODUCTS,)	
)	
Applicant/Counterclaim)	
Petitioner.)	

APPLICANT’S ANSWER TO NOTICE OF OPPOSITION;
COUNTERCLAIM FOR CANCELLATION OF U.S. TRADEMARK
REGISTRATION NOS. 1,387,200; 1,428,019; AND 2,017,159

Life Automotive Products (“LAP” or “Applicant”), as its response to the Notice of Opposition filed by Opposer Top Oil Products Company (“Top Oil” or “Opposer”), states as follows:

1. Applicant is without information sufficient to form a belief as to the truth of the allegations contained in Paragraph 1, and accordingly denies the same.

2. Applicant admits that it seeks to register the stated mark for the noted goods in International Class 1, and that it filed its application on or about July 13, 2004, and that the same

was published for opposition by the PTO in the *Official Gazette* on page TM223 on or about February 28, 2006. Except as so expressly admitted, Applicant denies the allegations of Paragraph 2.

3. Applicant denies that Top Oil has acquired any rights in or to any “[NUMERAL ONE]” trade or service mark. Applicant is without information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 3, and accordingly denies the same.

4. Applicant denies that Top Oil has acquired any rights in or to any “[NUMERAL ONE]” trade or service mark. Applicant is without information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 4, and accordingly denies the same.

5. Applicant is without information sufficient to form a belief as to the truth of the allegations contained in Paragraph 5, and accordingly denies the same.

6. Applicant is without information sufficient to form a belief as to the truth of the allegations contained in Paragraph 6, and accordingly denies the same.

7. Applicant denies that the registrations noted and the marks depicted therein can in any way be defined as “the [NUMERAL ONE] Trademarks” in that Opposer has previously stated to the PTO that the most dominant portions of the marks at issue was the term “TOP”. Applicant is without information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 7, and accordingly denies the same.

8. Denied.

9. Denied.

10. Applicant is without information sufficient to form a belief as to the truth of the allegations contained in the first sentence of Paragraph 10, and accordingly denies the same. Sentence two of Paragraph 10 is a statement of law, not an allegation of fact, and as such, no

answer is required. To the extent that the Board deems any portion of the second sentence of Paragraph 10 to be an allegation of fact, such allegation is denied.

11. Applicant is without information sufficient to form a brief as to the truth of the allegations contained in Paragraph 11, and accordingly denies the same.

12. Applicant is without information sufficient to form a brief as to the truth of the allegations contained in Paragraph 12, and accordingly denies the same.

13. Denied.

AFFIRMATIVE DEFENSES

First Affirmative Defense: Opposer's Notice of Opposition fails to state a claim upon which relief may be granted.

Second Affirmative Defense: The Opposition is barred by the doctrine of laches, acquiescence, estoppel, fraud, mistake, and/or the doctrine of unclean hands.

Third Affirmative Defense: Opposer will not be damaged by registration of the mark that is the subject of Applicant's U.S. Application Serial No. 78/449,903.

Fourth Affirmative Defense: There is no likelihood of confusion pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d), between the marks that are the subjects of Applicant's Application Serial No. 78/449,903 and U.S. Trademark Registration Nos, 1,387,200; 1,428,019; and 2,017,159.

Fifth Affirmative Defense: Opposer has not acquired a "family" of "[NUMERAL ONE]" marks and, as such, is not entitled to aggregate the pleaded registrations for purposes this Opposition.

Sixth Affirmative Defense: To the extent that Opposer has any rights in the pleaded registrations, which Applicant does not admit, pervasive third-party use of certain aspects of the

same, including other's use of the term "ONE," "1," "I," and the like on the same or similar goods preclude any confusion for the mark appearing in Applicant's U.S. Application Serial No. 78/449,903 for use on its stated goods, particularly those elements that include the term "ONE," "1" and/or "I."

WHEREFORE, Applicant Life Automotive Products prays that the opposition against U.S. Application Serial No. 78/449,903 be dismissed in its entirety, that a registration issue to Applicant for its mark and that judgment be entered in Life Automotive Products' favor.

COUNTERCLAIM/PETITION FOR CANCELLATION
OF U.S. REGISTRATION NOS. 1,387,200; 1,428,019; and 2,017,159

Pursuant to 37 C.F.R. 2.106, Applicant/Counterclaim Petitioner Life Automotive Products ("LAP" or "Applicant") believes that it is or will be damaged by continued registration of the marks that are the subjects of U.S. Trademark Registration Nos. 1,387,200; 1,428,019; and 2,017,159, and hereby petitions to cancel the same.

As grounds for cancellation, it is alleged that:

1. Applicant LAP filed Application Serial No. 78/449,903 for SMART BLEND SYNTHETIC ONE ADVANCED FORMULA and Design on July 13, 2004, which application was published for opposition on February 28, 2006.

2. On or about July 27, 2006, Top Oil Products Company ("Top Oil") filed a Notice of Opposition against Applicant's pending application for the SMALL BLEND SYNTHETIC ONE ADVANCED FORMULA and Design mark (Serial No. 78/449,903) on the basis of Top Oil's U.S. Registration Nos. 1,387,200; 1,428,019; and 2,017,159 ("the Subject Registrations") for TOP FORMULA ONE (and Design) ("the Subject Marks").

3. Applicant is informed and believes, and there upon alleges that Top Oil represented to United States Patent and Trademark Office ("PTO"), at the time that it filed the

applications leading to the Subject Registrations, or at the time it filed the respective §§ 8 & 15 submissions for the Subject Registrations, and/or at the time it filed its respective §§ 8 & 9 submissions for the Subject Registrations, that it was using the marks shown in the Subject Registrations on each and every of the goods identified in the Subject Registrations.

4. Upon information and belief, at the time Top Oil made its representations, noted above, it was aware, or should have been aware, that it was not using the Subject Registrations on each and every of the goods identified in the respective registrations.

5. For instance, and by way of example, as it relates to U.S. Registration No. 1,387,200, Opposer submitted a specimen of use with its combined §§ 8 & 9 on or about October 20, 2005, that was not use of the mark shown in that registration.

6. Similarly, and by way of example, with U.S. Registration No. 1,28,019, Opposer submitted a specimen of use with its combined §§ 8& 9 on or about January 23, 2007, that was not use of the mark shown in that registration and certainly not directed to any of the goods specified in the registration. In addition, at the time Opposer submitted its combined §§ 8 & 15 filing for that registration on or about November 20, 1992, it likewise submitted specimens of use that were not of the mark shown in the registration or for the goods identified in the registration.

7. Top Oil's statements made in its applications leading to the Subject Registrations, and/or made in its combined §§ 8 & 15 and/or combined §§ 8 & 9 submissions for the Subject Registrations, were false and/or misleading, were made by Top Oil with knowledge that they were false, and such statements were material to issuance and/or maintenance of the Subject Registrations.

8. Top Oil's continued registration of the Subject Marks should be refused because Top Oil has committed fraud and/or inequitable conduct upon the PTO and/or has unclean hands.

9. Top Oil has abandoned the marks that are the subject of U.S. Registration Nos. 1,387,200; 1,428,019; and 2,017,159 due to non-use with intent not to resume use, has not adequately policed its marks and/or has abandoned the Subject Marks due to a course of conduct that has caused them to lose all significance as an indicator of source.

WHEREFORE, Applicant/Counterclaim Petitioner Life Automotive Products prays that its Petition to Cancel U.S. Registration Nos. 1,387,200; 1,428,019; and 2,017,159 be granted in its entirety and that judgment be granted in favor of Life Automotive Products, and that U.S. Registration Nos. 1,387,200; 1,428,019; and 2,017,159 be cancelled. Applicant additionally asks that Top Oil's opposition proceeding against U.S. Application Serial No. 78/449,903 be dismissed and that Applicant's registration issue forthwith for the mark that is the subject of U.S. Applicant Serial No. 78/449,903.

DATED: January 30, 2008.

LIFE AUTOMOTIVE PRODUCTS

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CERTIFICATE OF SERVICE

The undersigned counsel hereby certifies that a copy of the foregoing APPLICANT'S ANSWER TO NOTICE OF OPPOSITION, AFFIRMATIVE DEFENSES AND COUNTERCLAIM was served via the United States Patent and Trademark Office's Electronic System for Trademark Trials and Appeals and/or by first class mail, postage prepaid on this 30th day of January, 2008, upon:

Gary J. Nelson
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Christie Parker & Hale LLP
P.O. Box 7068
Pasadena, CA 91109-7068

_____/s/ Michael R. Annis_____