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

Proceeding	91172228
Party	Plaintiff Master Lock Company LLC
Correspondence Address	William A. Johnston Calfee, Halter & Griswold LLP 1400 McDonald Investment Center, 800 Superior Avenue Cleveland, OH 44114-2688 UNITED STATES wjohnston@calfee.com, rrundelli@calfee.com, ipdocket@calfee.com
Submission	Motion to Amend Pleading/Amended Pleading
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See Exh. A, Opposer's proposed Second Amended Notice of Opposition at ¶ 8 and Appendix 1 thereto.<sup>1</sup>

Amendments to pleadings in *inter partes* proceedings before the Trademark Trial and Appeal Board are governed by Fed. R. Civ. P. 15; Trademark Trial and Appeal Board Manual of Procedure Rule 507.01. Under Fed. R. Civ. P. 15(a), "leave shall be freely given when justice so requires." If the underlying facts or circumstances relied upon by a plaintiff may be a proper subject of relief, plaintiff ought to be afforded an opportunity to test its claims on the merits. *Foman v. Davis*, 371 U.S. 178, 182 (1962). Consistent with the Supreme Court's holding in *Foman*, the Trademark Trial and Appeal Board has recognized that "amendments to pleadings should be allowed with great liberality *at any stage of the proceeding* where necessary to bring about a furtherance of justice unless it is shown that entry of the amendment would violate settled law or be prejudicial to the rights of any opposing parties." *American Optical Corp. v. American Olean Tile Co., Inc.*, 168 U.S.P.Q. 471, 473 (TTAB 1971) (emphasis added). Accordingly, a motion for leave to amend should be granted where the amendment is legally sufficient and where there is no undue prejudice to the opposing party.

In the course of developing its case for presentation to the Board, Opposer determined that there are additional registrations and applications that are relevant to the determination of whether Applicant's '102 Application will create a likelihood of confusion as to the source, origin or sponsorship of Opposer's goods and Applicant's goods among potential purchasers of the goods of both parties. For example, one of the factors that will be relevant to the Board's analysis of those issues is the extent to which Applicant's and Opposer's customers overlap. On

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<sup>1</sup> On August 17, 2007, Opposer filed its Motion to Amend its Notice of Opposition, wherein Opposer seeks to add Applicant's lack of *bona fide* intent to use the applied-for mark as an additional grounds for opposition. That motion is also currently pending, however, the grounds Opposer seeks to add in both that motion and this present motion are included in the attached Exhibit A.

July 13, 2007, Opposer deposed Applicant. During the deposition, Applicant testified that potential end users for the goods identified in the '102 Application "could be anybody" and that "the list could go on forever." See Exh. B, Dep. Tr. Eidsmore at p. 32, ll. 15-19; p. 37, ll. 14-21. Based on Applicant's deposition testimony, the potential customers for Applicant's goods appears to be much broader than initially contemplated, thus implicating additional registrations and applications not originally thought to be implicated by this Opposition.

In view of the foregoing, the registrations and applications Opposer seeks to add are relevant to the Board's decision as to whether a likelihood of confusion exists, as well as whether registration of Applicant's applied-for mark will damage and injure Opposer. Accordingly, allowing the proposed amendment will bring about a furtherance of justice.

Furthermore, Opposer's proposed amendment will not unduly prejudice Applicant. The registrations Opposer seeks to add do not implicate any new legal issues. Moreover, all of the registrations are, and have been, a matter of public record. Thus, it is not contemplated that any additional discovery will be needed. If any prejudice is perceived by Applicant, Opposer would agree to extend the fact discovery deadline and adjourn the testimony periods to a later date.

### **CONCLUSION**

For the reasons set forth above, Opposer respectfully requests that leave to further amend its Notice of Opposition be granted.

August 30, 2007

Respectfully submitted,

/Georgia E. Yanchar/

Raymond Rundelli

William A. Johnston

Georgia E. Yanchar

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800 Superior Avenue

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(216) 622-8200

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Attorneys for Opposer

**CERTIFICATE OF SERVICE**

I hereby certify that the foregoing **OPPOSER MASTER LOCK COMPANY, LLC'S MOTION FOR LEAVE TO FURTHER AMEND ITS NOTICE OF OPPOSITION** was served by hand delivery, on August 30, 2007, on the following attorney for Applicant:

Sandra M. Koenig  
1100 Superior Avenue  
Seventh Floor  
Cleveland, Ohio 44114-2579  
Phone: (216) 861-5582  
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BY: /Georgia E. Yanchar/  
An Attorney for Opposer

# **EXHIBIT A**

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

In the matter of application Serial No. 78/433,102  
Published in the Official Gazette on June 6, 2006  
Request to Extend Time to Oppose granted to August 5, 2006

<b>MASTER LOCK COMPANY, LLC</b>	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No. 91/172,228
	:	
<b>THOMAS P. EIDSMORE</b>	:	
	:	
Applicant.	:	
	:	

**SECOND AMENDED NOTICE OF OPPOSITION**

Master Lock Company LLC (“Opposer”), a Delaware limited liability company with a place of business at 137 W. Forest Hill Avenue, Oak Creek, WI 53154, believes that it will be damaged by registration of the mark MASTERHAUL (the “Opposed Mark”) shown in the application of Thomas P. Eidsmore (“Applicant”) having Serial No. 78/433,102 in International Class 012 (the “102 Application”) and hereby opposes registration of the Opposed Mark.

As grounds of opposition, Opposer states that:

1. Opposer is, *inter alia*, in the business of manufacturing and distributing truck and Sport Utility Vehicle accessories, including vehicle security, towing, cargo carrying, cargo securing, and accessory products.
2. Opposer has used the marks MASTER and MASTER LOCK in commerce since on or in connection with the following goods: vehicle hitch receiver pins and clips at least as early as May 2000; vehicle hitch receiver locks at least as early as October 1999; towing couplers and locks and hatch locks therefor at least as early as February 2003; trailer locks,



trailer hitches at least as early as February 2000, trailer hitch balls, trailer hitch ball locks at least as early as February 2003; trailer hitch ball mounts at least as early as February 2003; vehicle hitch ball mounts and vehicle hitch ball covers at least as early as February 2004.

3. Opposer is the owner of U.S. Trademark Application Serial No. 78/404,759 (the “759 Application”), filed on April 20, 2004, in which it requests registration on an intent-to-use basis of the mark MASTER for “vehicle security, towing, cargo carrying, cargo securing, and accessory products, namely, vehicle steering wheel locks, vehicle airbag locks, anti-theft locks for use on automobile pedals, spare tire locks, vehicle hitch receiver pins and clips, vehicle hitch receiver locks, towing couplers and locks and hatch locks therefor, trailer locks, safety chains in the nature of towing security chains for vehicles, trailer hitches, trailer hitch balls, trailer hitch ball locks, trailer hitch ball mounts, vehicle hitch ball mounts, vehicle hitch ball covers, automotive vehicle wheel parts, namely, lug nuts, wheel locks, wheel spacers for trailers, wheel bearing protectors for vehicles; automotive vehicle parts, namely hitch ball reducer bushings, receiver covers, tow hooks for vehicles, tow straps, bicycle racks for vehicles, tow bars for vehicles, cargo carriers for vehicles, fold-away cleats for vehicles, and pocket stack anchors for vehicles” in Internatiuonal Class 012.

4. A Notice of Allowance was issued for the ‘759 application on January 3, 2006. With a bona fide intent to use some or all of the goods included in the goods description, Opposer filed a request for an Extension of Time to File a Statement of Use on June 27, 2006. The Extension was granted on June 27, 2006.

5. Opposer is also the owner of U.S. Trademark Application Serial No. 78/404,793 (the “793 Application”), filed on April 20, 2004, in which it requests registration on an intent-to-use basis of the mark MASTER LOCK for the same goods listed in paragraph 3.

6. A Notice of Allowance was issued for the ‘793 application on December 20, 2005. With a bona fide intent to use some or all of the goods included in the goods description, Opposer filed a request for an Extension of Time to File a Statement of Use on June 20, 2006. The Extension was granted on July 15, 2006.

7. Opposer has expended considerable sums of money over a substantial period of time to develop significant and valuable goodwill and promote the products and programs on or in connection with which the MASTER and MASTER LOCK marks are used by or on behalf of Opposer.

8. Opposer also has extensive related and valuable rights in the marks MASTER and MASTER LOCK with federal registrations dating back to September 1926. These registrations include but are not limited to the registrations listed in Appendix 1 hereto.

9. Applicant filed the '102 Application on June 10, 2004. Applicant's services are currently identified as "truck and sport utility vehicle accessories, namely, truck bed liners, cargo storage bins, mechanically assisted self-contained insert dump units for pickup trucks, body panels and tail gates."

10. Upon information and belief, Applicant did not have a *bona fide* intent to use the mark in commerce on the specified goods when he filed his application for the goods specified therein.

11. The '102 Application was published in the *Official Gazette* on June 6, 2006. A request to Extend Time to Oppose was filed by the Opposer and granted until August 5, 2006.

12. On information and belief, there is no issue as to priority as between Opposer and Applicant. Applicant applied for registration of the Opposed Mark on an intent-to-use basis pursuant to Section 1(b) of the Trademark Act, and the constructive priority date of the '102 Application is subsequent to Opposer's first use in commerce of the MASTER and MASTER LOCK marks. On information and belief, Applicant's first use in commerce, if any, of the Opposed Mark for goods in International Class 012 commenced after Applicant's first date of use. Further, Opposer has substantial use and goodwill established in MASTER and MASTER LOCK in International Class 006.

13. On information and belief, Applicant's registration and use of the mark MASTERHAUL for the services specified in the '102 Application will create a likelihood of confusion as to the source, origin or sponsorship of Opposer's goods and Applicant's goods among potential purchasers of the goods of both parties.

14. If Applicant is granted a registration for the Opposed Mark as a result of the '102 Application, Applicant will obtain at least a *prima facie* exclusive right to the use of the word MASTERHAUL as a mark throughout the United States in connection with the services identified in the '102 Application. Such registration would damage and injure Opposer.

WHEREFORE, Opposer prays that the '102 Application be rejected, and that Opposer's Opposition be sustained and registration of the Opposed Mark be refused to Applicant.

Respectfully submitted,

Dated: August 30, 2007

/Georgia E. Yanchar/  
Raymond Rundelli  
William A. Johnston  
Georgia E. Yanchar  
**CALFEE, HALTER & GRISWOLD LLP**  
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Counsel for Opposer

**CERTIFICATE OF SERVICE**

I hereby certify that the foregoing **SECOND AMENDED NOTICE OF OPPOSITION** was served by hand delivery, on August 30, 2007, on the following attorney for Applicant:

Sandra M. Koenig  
1100 Superior Avenue  
Seventh Floor  
Cleveland, Ohio 44114-2579  
Phone: (216) 861-5582  
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/Georgia E. Yanchar/  
An Attorney for Opposer

**Appendix 1**  
**to Second Amended Notice of Opposition of Master Lock Company LLC**

Registration or Application Number	Mark	Goods
2,911,827	MASTER LOCK	“Metal u-bar locks; metal cable wire and metal cable locks; metal chains and metal chain locks; metal door locks; metal door latches and hasps; metal chain door locks; door hardware, namely keys and key cylinders; metal door latches and hasps; metal chain door guards; metal window guards, comprising protective metal bars and mounting brackets therefore; metal window hardware, namely, frames, sash fasteners, pulleys, screens, shutters and sills; metal door bolts; metal safes and metal hotel safes; bicycle locks; metal trailer locks; metal motorcycle and scooter locks; metal tie downs; metal doors; metal garage doors and garage door rollers; metal storm doors; freestanding and wall-mounted metal tool racks; metal bicycle storage racks; metal vehicle storage racks; automobile cargo carriers primarily made of metal; metal trunk boxes; metal storage sheds; metal chain link fencing; metal luggage locks; metal windows and metal window frames; metal mailboxes and parts thereof” in International Class 006
1,867,974	MASTER LOCK	“metal locks” in International Class 006
2,140,275	MASTER	“metal bicycles locks, scooter locks and motorcycle locks” in International Class 006
1,643,334	MASTER	“locks” in International Class 006
230,311	MASTER	“locks” in International Class 006
218,153	MASTER	“padlocks, hasp locks and door guards and door bolts” in International Class 006
78595000	MASTER LOCK	“tie down straps, bungee cords, towing straps, cargo nets and lashing straps in the nature of straps for handling loads and canvas cash bags” in International Class 006
78594994	MASTER	“tie down straps, bungee cords, towing straps, cargo nets, and lashing straps in the nature of straps for handling loads, and canvas cash bags” in International Class 006
78697389	MASTER	“electronic framed-door locks, namely, RF operated framed-door hardware, electronic keys for framed-door locks, and parts thereof, excluding electronic key pads and card readers; electronic padlocks; and electronic keys for electronic padlocks” in International Class 009

Registration or Application Number	Mark	Goods
3147816	TOUGH UNDER FIRE MASTER	“vehicle security, towing, cargo carrying, and accessory products, namely, vehicle steering wheel locks, anti-theft locks for use on automobile pedals, anti-theft locks for use on spare tire locks, parts of automobiles and trailers, namely, receiver pins and clips, parts of automobiles and trailers, namely, receiver locks, trailer hitch couplers, metal locking device for trailer hitch coupler latches, metal locking device for trailer hitch coupler, anti-theft locks for use on trailers, parts of automobiles and trailers, namely, safety cables, safety links, hitches, hitch balls, hitch ball locks, ball mounts, hitch ball covers, lug nuts, anti-theft locks for use on wheels, wheel spacers, bearing protectors, hitch ball reducer bushings, receiver covers, tow hooks; bicycle racks; tow bars; parts of automobiles and trailers, namely, fold-away cleats, pocket stake anchors; cargo carriers for automobiles and trailers” in International Class 012
2911826	MASTER TOUGH UNDER FIRE	“metal u-bar locks; metal cable wire and metal cable locks; metal chains and metal chain locks; metal door locks; door hardware, namely keys and key cylinders; metal door latches and hasps; metal chain door guards; metal window guards, comprising protective metal bars and mounting brackets therefore; metal window hardware, namely, frames, sash fasteners, pulleys, screens, shutters and sills; metal door bolts; metal safes and metal hotel safes; bicycle locks; metal trailer locks; metal motorcycle and scooter locks; metal tie downs; metal doors; metal garage doors and garage door rollers; metal storm doors; freestanding and wall-mounted metal tool racks; metal bicycle storage racks; metal vehicle storage racks; automobile cargo carriers primarily made of metal; metal trunk boxes; metal storage sheds; metal chain link fencing; metal luggage locks; metal windows and metal window frames; metal mailboxes and parts thereof” in International Class 006
77126473	MASTER LOCK STARTER SENTRY	“anti-theft devices for vehicles in the nature of electronic vehicle immobilizers” in International Class 009
77218060	MASTER LOCK	“electronic security devices, namely, proximity detection devices, motion detection devices, and infrared and radio frequency devices; electronic door locks and electronic devices, electronic door openers, electronic garage door openers, electronic computer locks, electronic safe and storage units, and biometric lock systems; electronic lock systems, namely, electronic key pads, electronic keys and electronic locks; alarm systems, namely, anti-intrusion alarms, personal security alarms, biometric systems, namely, biometric door and window locks, biometric keys and key pads for vehicle, residential, commercial and industrial use” in International Class 009

Registration or Application Number	Mark	Goods
77218044	MASTER	“electronic security devices, namely, proximity detection devices, motion detection devices, and infrared and radio frequency devices; electronic door locks and electronic devices, electronic door openers, electronic garage door openers, electronic computer locks, electronic safe and storage units, and biometric lock systems; electronic lock systems, namely, electronic key pads, electronic keys and electronic locks; alarm systems, namely, anti-intrusion alarms, personal security alarms, biometric systems, namely, biometric door and window locks, biometric keys and key pads for vehicle, residential, commercial and industrial use” in International Class 009
77218082	MASTER LOCK	“metal locks and door hardware” in International Class 006
1892927	MASTER LOCK	“[metal door hardware, namely knobs and levers], locks and [handles, accessory trim, latches, strikes and strikes boxes, keys, tumbler pins and springs]” in International Class 006
1592739	IF IT'S WORTH LOCKING, IT'S WORTH A MASTER LOCK	“locks” in International Class 006

# **EXHIBIT B**



**ORIGINAL OF TRANSCRIPT**

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

In the matter of Application Serial No. 78/433,102

For the mark: MASTERHAUL

Published in the Official Gazette on June 6, 2006

MASTER LOCK COMPANY, LLC,

Opposer,

vs.

No. 91/172,228

THOMAS P. EIDSMORE,

Applicant.

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**CONFIDENTIAL**

**DEPOSITION OF THOMAS P. EIDSMORE**

Taken on Friday, July 13, 2007 at 9:04 a.m.

At the offices of:

621-A Water Street

Santa Cruz, California

Reported By: KATHLYN E. WIRICK, CSR 2875, CP



**Cefaratti Group**  
THE LITIGATION SUPPORT COMPANY

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1 Q. In the description you just  
2 read, there were 4 categories of truck  
3 and sport utility vehicle accessories.

4 A. Uh-huh.

5 Q. I'd like to just learn from  
6 you about your understanding of what's  
7 in those categories.

8 A. Okay.

9 Q. So what would you understand  
10 "cargo storage bins" to mean?

11 A. Any kind of separate  
12 container that you could store tools in,  
13 or whatever it is that you would keep  
14 in the back of a truck.

15 Q. And who would you anticipate  
16 the end users of cargo storage bins to  
17 be?

18 A. I think anybody that -- any  
19 -- could be anybody.

20 Q. Are you aware of any  
21 products that might be used in place of  
22 a cargo storage bin?

23 A. No.

24 Q. Do you have any idea in your  
25 head as to what the cargo storage bin



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1           A. I would ask somebody that  
2 would use something like that, or  
3 perhaps search on the internet.

4           Q. Who would be somebody that  
5 would use something like that?

6           A. Somebody that uses their  
7 truck frequently.

8           Q. I think you used the term a  
9 "local contractor." Do you mean like a  
10 construction contractor?

11          A. Or anybody -- yeah, like a  
12 -- Somebody that, you know, has a lot  
13 of tools.

14          Q. So you would anticipate an  
15 end user of cargo storage bins to be  
16 like a contractor?

17          A. That's one of many.

18          Q. Who else?

19          A. Well, the list could go on  
20 forever. It could be somebody that is  
21 a traveling salesman and so on.

22          Q. Going back to paragraph 9,  
23 "mechanically assisted self-contained  
24 insert dump units for pickup trucks" --

25          A. Uh-huh.



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