

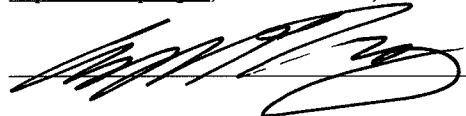
ESTTA Tracking number: **ESTTA246433**

Filing date: **11/03/2008**

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

| | |
|---------------------------|---|
| Proceeding | 91184852 |
| Party | Defendant SOLOTRAK HOLDING, S.A. |
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| Date | 11/03/2008 |
| Attachments | answer-11032008-024008PM.pdf (11 pages)(477412 bytes) |

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

| | | |
|-----------------------|---|--|
| SAE International |) | Opposition No. 91,184,852 |
| |) | Serial No. 77/010,934 |
| Opposer |) | |
| |) | I hereby certify that this paper is being deposited |
| v. |) | with the U.S. Patent and Trademark Office |
| |) | Trademark Trial and Appeal Board at |
| Solotrak Holding S.A. |) | http://estta.uspto.gov , on November 3, 2008. |
| |) | |
| Applicant. |) |  |

APPLICANT’S ANSWER TO NOTICE OF OPPOSITION

Applicant, Solotrak Holding S.A. (“Solotrak” or “Applicant”), having a principal place of business in Luxembourg, for its answer to the Notice of Opposition filed by SAE International (hereinafter “Opposer”) against Solotrak’s registration of SAE INSTITUTE, Serial No. 77/010,934, published on March 4, 2008, pleads and avers as follows:

1. Opposer is a world renowned international standards development and professional organization that has used the mark “SAE” in commerce since its founding in 1905 (the “SAE” mark together with the marks SAE & design and SAE with other words are collectively referred to herein as the “SAE MARKS”).

ANSWER: Answering paragraph 1 of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments of this paragraph, and thus, denies them.



2. Opposer publishes globally-recognized standards, magazines and other publications, provides membership services and offers educational services among other services under its family of SAE MARKS. Among the many services offered by Opposer under the SAE MARKS are science and engineering services, including seminars and workshops in the field of audio engineering, which Opposer has continuously provided since at least as early as 1909 – 89 years prior to the Applicant’s alleged use in commerce.





ANSWER: Answering paragraph 2 of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments of this paragraph, and thus, denies them.

3. Opposer is the owner of common law rights and numerous federal and international registrations for the SAE MARKS such as SAE, SAE design, SAE International and SAE with other words.

ANSWER: Answering paragraph 3 of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments of this paragraph, and thus, denies them.

4. The table set forth below lists some of the Opposer’s federally registered SAE MARKS. Printouts from the Patent and Trademark Office website showing proof of these registrations are annexed as Exhibit A to this Notice of Opposition.

| Trademark | Date of Registration | Registration No. | Description |
|---|----------------------|------------------|---|
|  | October 12, 1982 | 1,212,771 | “Educational Services-Namely, Conducting Seminars and Conferences Concerned with the Technology and Engineering of Self-Propelled Mechanisms, Prime Movers and Components Therefor, and Related Equipment and Materials,” in International Class 41 |
| SAE | September 18, 1984 | 1,296,121 | “Publications consisting of books, technical reports and technical reports related to the field of engineering and science,” in International Class 16 |
| SAE | October 12, 1982 | 1,212,826 | “Promoting advancement and interest in science and engineering practices in the design, construction, and utilization of self-propelled mechanisms, prime movers, components therefore, and related equipment and materials,” in International Class 42 |
|  | January 10, 1984 | 1,263,434 | “Microform consisting of microfiche and microfilm containing information related to the field of engineering and science including recommended practices, standards and compilations in these fields,” in International Class 09 and “Publications related to the field of engineering and science including recommended practices, standards and compilations in these fields, namely, monthly and yearly technical journals, newsletters, pamphlets, magazines, indexes, handbooks, technical papers, |

| | | | |
|---|-------------------|-----------|---|
| | | | information reports and technical books,” in International Class 16 |
|  | October 12, 1982 | 1,212,825 | “Promoting advancement and interest in science and engineering practices in the design, construction and utilization of self-propelled mechanisms, prime movers, components therefore, and related equipment and materials,” in International Class 42 |
|  | July 27, 1982 | 1,203,242 | “Indicating membership in an organization of engineers and scientists,” in International Class 200 |
| SAE INTERNATIONAL | November 27, 1990 | 1,625,795 | “Educational services, namely, conducting seminars and conferences, concerned with the technology and engineering of self-propelled mechanisms, and components thereof, and related equipment and materials,” in International Class 41, and others |
| FORMULA SAE | March 3, 1987 | 1,431,541 | “Educational student design competition,” in International Class 41 |
|  | December 18, 1990 | 1,628,262 | “Educational services, namely, conducting seminars and conferences concerned with the technology and engineering of self-propelled mechanisms, and components therefore, and related equipment and materials,” in International Class 41, and others |
|  | June 30, 1987 | 1,445,131 | “Educational services, namely, conducting seminars and conferences concerned with the technology and engineering of self-propelled mechanisms, prime movers and components therefore, and related equipment and materials,” in International Class 41, and others |
| BAJA SAE | June 12, 2007 | 3,252,483 | “Entertainment services, namely, conducting a student car design and racing competition,” in International Class 41 |
|  | November 21, 2006 | 3,174,171 | “Business consulting services, namely, business development services for automotive and aerospace industry specifications and standards, requirements documents and guidelines; business consulting services, namely, development of programs for certification and conformance, audit programs and education, accreditation and technology development,” in International Class 35 |
|  | June 1, 2004 | 2,847,329 | “Mail order catalog services featuring books in the field of auto racing” in International Class 35 and “Arranging and conducting education conferences and expositions in the field of racing,” in International Class 41 |

ANSWER: Answering paragraph 4 of the Notice of Opposition, Applicant admits that the U.S. Patent and Trademark Office records reveal certain SAE federal registrations, and denies the remaining allegations because the registrations are self-evident of their coverage and details and Applicant is without knowledge or information sufficient to form a belief as to the truth thereof.

5. The foregoing marks have been continuously used by Opposer in commerce, and the registrations are valid and subsisting, uncancelled, unrevoked and in full force and effect.

ANSWER: Answering paragraph 5 of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments of this paragraph, and thus, denies them.

6. Registration Numbers 1,431,541; 1,203,242; 1,212,771; 1,212,771; 1,212,825; 1,212,826; 1,263,434; 1,296,121; 1,624,795; 1,628,262 and 1,445,131 are incontestable pursuant to 15 U.S.C. § 1065.

ANSWER: Answering paragraph 6 of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments of this paragraph, and thus, denies them.

7. As a result of extensive and widespread use, advertising, promotion, membership, and registration of the SAE MARKS on and in association with a wide range of products and services, including seminars and workshops, consumers and professionals in the engineering industry including audio engineering have come to know, rely upon and associate the SAE MARKS and marks containing SAE with Opposer and with services offered in connection with Opposer's SAE MARKS.

ANSWER: Answering paragraph 7 of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments of this paragraph, and thus, denies them.

8. Opposer's long-term, prominent usage of its SAE MARKS has generated goodwill and widespread consumer recognition for these marks as identifying exclusively Opposer and its products and services.

ANSWER: Answering paragraph 8 of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments of this paragraph, and thus, denies them.

9. By virtue of its efforts, the SAE MARKS now represent an asset of inestimable value to Opposer, with extremely valuable goodwill and valuable reputation worldwide.

ANSWER: Answering paragraph 9 of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments of this paragraph, and thus, denies them.

10. Opposer's SAE name and SAE MARKS have become distinctive and famous over the past one hundred years, and have been distinctive and famous since prior to Applicant's alleged first use of the term SAE International.

ANSWER: Answering paragraph 10 of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments of this paragraph, and thus, denies them.

11. Upon information and belief, the record owner of Trademark Application Serial No. 77/010,934 is Solotrak Holding S.A. ("Applicant"), having a principal place of business at 60, Grande Rue, Luxembourg L-1660.

ANSWER: Answering paragraph 11 of the Notice of Opposition, Applicant admits that the U.S. Patent and Trademark Office records reveal certain SAE federal registrations, and denies the remaining allegations because the registrations are self-evident of their coverage and details.

12. The identification of services included in Applicant's Trademark Application Serial No. 77/010,934 is "providing of theoretical and practical training and further training, and teaching, seminars and workshops, in the fields of sound engineering, multimedia design, digital films and 3D animations, and in practical and theoretical aspects of the entertainment industry" in International Class 041.

ANSWER: Answering paragraph 12 of the Notice of Opposition, Applicant admits that the

U.S. Patent and Trademark Office records reveal certain SAE federal registrations, and denies the remaining allegations because the registrations are self-evident of their coverage and details.

13. The services covered in Trademark Application Serial No. 77/010,934 are similar and/or related to the services contained in Opposer's SAE MARKS

ANSWER: Paragraph 13 of the Notice of Opposition is denied.

14. Applicant's mark incorporates in whole and plays upon Opposer's SAE MARKS.

ANSWER: Paragraph 14 of the Notice of Opposition is denied.

15. Applicant's mark is a colorable imitation of and/or confusingly similar to Opposer's SAE MARKS and so resembles its SAE MARKS as to be likely, when used in connection with services of Applicant, to cause confusion, mistake or deceive them with that of the Opposer.

ANSWER: Paragraph 15 of the Notice of Opposition is denied.

16. Upon information and belief, the services which are offered by Applicant in connection with its SAE Institute are similar, complementary or of a related nature to the products and services offered by Opposer in connection with the SAE MARKS including, but not limited to, its SAE (Registration Nos. 1,212,771 and 1,212,826) and SAE INTERNATIONAL (Registration No. 1,624,795) marks covering educational services similar to those of Applicant and known and registered at the time Applicant applied for Application Serial No. 77/010,934.

ANSWER: Paragraph 16 of the Notice of Opposition is denied.

17. Registration of Applicant's mark in Trademark Application Serial No. 77/010,934 would likely cause dilution by blurring or tarnishment to Opposer's well-known and famous SAE MARKS because it feeds upon the reputation of Opposer and its services and related products provided and sold under the SAE MARKS. Applicant's mark in Trademark Application Serial No. 77/010,934 could likely blur the distinctiveness of Opposer's mark and could potentially tarnish or disparage Opposer's name and SAE MARKS by being considered associated to the Applicant and Opposer's products and/or services. Particularly, any faults and/or deficiencies in Applicant's products and/or services would reflect negatively on Opposer unless this opposition is sustained according to 15 U.S.C. § 1125 and the 2006 Trademark Dilution Revision Act (TDRA).

ANSWER: Paragraph 17 of the Notice of Opposition is denied.

18. Registration of Trademark Application Serial No. 77/010,934 would further damage Opposer, as the registration would confer upon Applicant various statutory presumptions to which it is not entitled in view of Opposer's long prior use of its SAE MARKS.

Registration of Applicant's Application should therefore be canceled pursuant to 15 U.S.C. §§ 1052(d) and 1063.

ANSWER: Paragraph 18 of the Notice of Opposition is denied.

GENERAL DENIAL

Any allegations in the Notice of Opposition not expressly admitted by Applicant are hereby denied. Having answered the Notice of Opposition, Applicant denies that Opposer is entitled to the relief requested in Opposer's prayer for relief or any relief whatsoever.

AFFIRMATIVE DEFENSES

First Affirmative Defense

26. Educational services, namely educational seminars and workshops in the field of audio engineering are the services rendered under the SAE mark that is the subject of U.S. Trademark Application Serial No. 77/010,934, and not automotive engineering that Opposer's mark covers. Conversely, none of the services provided by Society of Automotive Engineers concern audio engineering or the media and entertainment industry.

27. Applicant affirmatively alleges that as a result of continuous use of its mark by Applicant since its adoption, this mark is a valuable asset of Applicant and carries considerable goodwill and consumer acceptance of Applicant's services rendered under the mark. Such goodwill and widespread usage has made the mark distinctive to Applicant alone.

Applicant affirmatively alleges that there is no likelihood of confusion between Applicant's and Opposer's marks.

Second Affirmative Defense

28. Applicant affirmatively alleges that it has used the mark at issue for 10 years in the United States, providing educational services in the audio, media and entertainment industry as opposed to the automotive engineering industry, without any instance of actual confusion.

Third Affirmative Defense

29. After a reasonable opportunity for further investigation and discovery, there is likely to be evidence that Applicant's services, as described on their website <http://www.sae.edu/>, are audio engineering that covers careers in entertainment management, as a studio manager, mastering engineer, broadcast engineer, audio post-production, recording executive, music producer, music industry consultant, or digital media entrepreneur.

30. After a reasonable opportunity for further investigation and discovery, there is likely to be evidence that other common names for the Audio Engineering Bachelors Degree include: Bachelors Degree of Recording Arts, Bachelors Degree of Music Industry, Sound Engineering Degree and also Bachelors Degree of Music Production.

31. Applicant affirmatively alleges that its services are not confusingly similar to Opposer's services as they differ in nature, in their intended purpose.

Fourth Affirmative Defense

32. Applicant affirmatively alleges that the target purchaser for Applicant's services is sufficiently distinct from that of Opposer's services so as to eliminate any likelihood of confusion.

Fifth Affirmative Defense

33. The Notice of Opposition and each count thereof are barred in whole or in part by the doctrine of laches.

Sixth Affirmative Defense

34. The Notice of Opposition and each count thereof are barred in whole or in part by the doctrine of estoppel.

Seventh Affirmative Defense

35. The Notice of Opposition and each count thereof are barred in whole or in part by the doctrine of acquiescence.

Eighth Affirmative Defense

36. After a reasonable opportunity for further investigation and discovery, there is likely to be evidence that the Notice of Opposition and each count thereof are barred in whole or in part by reason of Opposer's misuse of its claimed registrations, in its abusive utilization of the U.S. trademark cancellation procedures in violation of the boundaries of fair competition.

Ninth Affirmative Defense

37. The Notice of Opposition and each count thereof are barred in whole or in part by reason of Opposer's own unclean hands.

Tenth Affirmative Defense

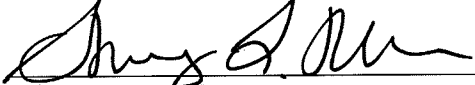
38. Applicant affirmatively alleges that registration of the mark at issue as a whole is not likely to damage Opposer.

Eleventh Affirmative Defense

39. Applicant affirmatively alleges that Opposer lacks standing to bring this Notice of Opposition.

WHEREFORE, Applicant contends that this opposition is groundless and baseless in fact; that Opposer has failed to show wherein it will be, or is likely to be, damaged by registration of Applicant's mark; and Applicant prays that this cancellation be dismissed and that registration of Applicant's mark remain.

Dated: November 3, 2008

SOLOTRAK HOLDINGS S.A.
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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing APPLICANT'S ANSWER TO NOTICE OF OPPOSITION is being served on November 3, 2008, on the following by United States first class mail, postage prepaid, and by email:

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