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

Proceeding	91191320
Party	Defendant Wayne/Scott Fetzer Company
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Apex, LLC,)	
)	
Opposer,)	
v.)	Opposition No. 91191320
)	
Wayne/Scott Fetzer Company)	
)	
Applicant.)	
)	
Serial No.: 77/399,578)	
Filed: February 18, 2008)	
Mark: APEX)	
Published: February 3, 2009)	

ANSWER TO NOTICE OF OPPOSITION

Wayne/Scott Fetzer Company, Applicant in the above-identified Opposition, hereby responds to the Notice of Opposition filed by Apex, LLC ("Opposer") opposing registration of the mark APEX, Application Serial No. 77/399578. Any and all allegations in the Notice of Opposition not specifically admitted herein are denied. Applicant responds to the numbered allegations as follows:

1. Since at least as early as 1924, Opposer and its predecessors and their affiliates (collectively, "Apex") have used the mark "APEX" and other marks incorporating the word "APEX" (collectively the "Apex Marks"). Over the past 85 years, Apex has used the Apex Marks on and in connection with a variety of products and services, including, among others, retail services, retail stores, on-line retail stores and services, home and garden products and affiliated services, online services, automotive services and sales of automotive parts and accessories, consulting services, educational services, manufacturing services, wholesale services, commercial and residential real estate development and construction services, real estate management services, and advertising and marketing business services, among others.

ANSWER: Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 1 of the Notice of Opposition, and, therefore, denies same.

2. Opposer is the owner of common law rights in the mark "APEX," as a result of the continuous use of the APEX mark by Apex since at least as early as 1924.

ANSWER: Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 2 of the Notice of Opposition, and, therefore, denies same.

3. Opposer owns the following U.S. applications and registrations for its APEX trademarks and service marks, among others:

ANSWER: Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 3 of the Notice of Opposition, and, therefore, denies same.

4. Registration No. 1,847,961 for the mark APEX, and Registration No. 2,155,905 for the mark APEX have both been renewed pursuant to the applicable provisions of the Lanham Act, and affidavits of incontestability have been filed and acknowledged.

ANSWER: Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 4 of the Notice of Opposition, and, therefore, denies same.

5. Affidavits of incontestability have been filed and acknowledged in connection with Registration No. 2,562,812 for the mark APEX ONLINE, Registration No. 2,443,933 for the mark APEX STORES, Registration No. 2,657,639 for APEX MALL, and Registration No. 2,454,720 for APEX.

ANSWER: Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 5 of the Notice of Opposition, and, therefore, denies same.

6. Apex has spent a considerable amount of money, time and energy in connection with the advertising, marketing and promotion of products and services bearing the APEX trademark. As a result, the APEX trademark has become famous, and the public has come to identify the APEX trademark with Apex.

ANSWER: Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 6 of the Notice of Opposition, and, therefore, denies same.

7. Upon information and belief, Wayne/Scott Fetzer Company ("Applicant") is a Delaware corporation with an address at 101 Production Drive, Harrison, Ohio 45030.

ANSWER: Admitted.

8. Applicant is the record owner of the following U.S. Trademark Application for the mark APEX:

<u>Application No.</u>	<u>Filing Date</u>	<u>Goods and Services</u>
77/399,578	2/18/2008	Pool and spa equipment, namely, electric pumps and compressors and parts therefore, in International Class 7; and Pool and spa equipment, namely, filters, heaters and pumps sold in combination, hot air blowers and swimming pool and whirlpool chlorinating units and parts therefore, in International Class 11.

ANSWER: Admitted.

9. Apex repeats and incorporates herein by reference the averments in the preceding paragraphs.

ANSWER: Applicant repeats and incorporates by reference its responses in the preceding paragraphs.

10. Applicant's APEX mark is very similar in appearance and commercial impression to Apex's Marks.

ANSWER: As to the allegation that Applicant's APEX mark is similar in appearance to Apex's Marks, Applicant admits that Applicant's mark APEX is similar in spelling to the word "Apex" as that word appears in Apex's Marks. As to the allegation that Applicant's APEX mark has a similar commercial impression to Apex's Marks, Applicant lacks knowledge or information sufficient to form a belief as to the truth of such allegation contained in Paragraph 10 of the Notice of Opposition, and, therefore, denies same.

11. The goods recited in Application No. 77/399,578 are closely related to those of Apex, in particular, to Apex's services and products sold via those services.

ANSWER: Applicant denies the allegations contained in paragraph 11 of the Notice of Opposition.

12. On information and belief, Apex is the prior user of the APEX mark. Consequently, Applicant's date of first use for their mark is subsequent to Apex's actual date of first use of its Apex Marks for the identical or closely related goods and services.

ANSWER: Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 12 of the Notice of Opposition, and, therefore, denies same.

13. In light of the foregoing, Applicant's APEX trademark for the services recited in the opposed application is confusingly similar to Opposer's Apex Marks and is likely to cause confusion or mistake, and to deceive the public into believing that Applicant's goods or services originate or are in some manner sponsored, licensed, associated or otherwise authorized by Apex in violation of Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d).

ANSWER: Applicant denies the allegations contained in paragraph 13 of the Notice of Opposition.

14. Apex repeats and incorporates herein by reference the averments in the preceding paragraphs.

ANSWER: Applicant repeats and incorporates by reference its responses in the preceding paragraphs.

15. Apex is damaged and will continue to be damaged because Applicant's future use and registration of the mark APEX would dilute the distinctive quality of Apex's Apex Marks.

ANSWER: Applicant denies the allegations contained in paragraph 15 of the Notice of Opposition.

AFFIRMATIVE DEFENSES

For its affirmative defenses to the Notice of Opposition, Applicant states as follows:

1. The Notice of Opposition fails to state a claim upon which relief may be granted.
2. On information and belief, Opposer fails to state a cause of action for dilution upon which relief may be granted. Opposer fails to plead that its mark became famous prior to Applicant's use of or application for Applicant's mark.
3. On information and belief, Opposer's marks are not famous.
4. There is no likelihood of confusion between Applicant's use of the mark in Application Serial No. 77/399,578 in connection with the goods recited in such application and Opposer's

use of the mark APEX or APEX formative marks in connection with the goods and services set forth in the table listed in paragraph 3 of the Notice of Opposition.

5. Opposer has not suffered nor is likely to suffer any injury or harm to its business or property by reason of Applicant's Application Serial No. 77/399,578.

6. On information and belief, Opposer does not have the exclusive right to use APEX formative trademarks. Numerous third parties own applications or registrations with the U.S. Patent and Trademark Office for APEX formative marks for a wide variety of goods and services.


7. On information and belief, one or more of Opposer's registrations is invalid.

8. On information and belief, Opposer's claims are barred by the doctrine of unclean hands.

THEREFORE, Applicant respectfully prays that opposition to registration of its APEX mark, Application Serial No. 77/399,578, be dismissed; that registration for Application Serial No. 77/399,578 be issued, and that Applicant be granted such other and further relief as the Board deems just and proper.

Respectfully submitted,
WAYNE/SCOTT FETZER COMPANY

April 12, 2010


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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing ANSWER TO NOTICE OF OPPOSITION was served by electronic mail, upon:

Gailyc C. Sonia at GSonia@theapexcompanies.com

Attorney for Opposer

on this 12th day of April, 2010.



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