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

Proceeding	91201631
Party	Defendant True Value Company
Correspondence Address	CHRISTOPHER J SCHULTE MERCHANT & GOULD PC PO BOX 2910 MINNEAPOLIS, MN 55402-0910 UNITED STATES
Submission	Answer and Counterclaim
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Signature	/Kristine M. Boylan/
Date	10/25/2011
Attachments	2011 10 25 Answer.PDF (6 pages)(223486 bytes)

Registration Subject to the filing

Registration No	1955591	Registration date	02/13/1996
Registrant	SWIMC, INC. PO Box 657 Newark, DE 197150657 UNITED STATES		
Grounds for filing	The registered mark has become the generic name for the goods.		

Goods/Services Subject to the filing

Class 002. First Use: 1994/05/17 First Use In Commerce: 1994/05/17 All goods and services in the class are requested, namely: clear and pigmented coatings in the nature of interior and exterior paint
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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SWIMC, INC.,)
)
)
Opposer,)
) Opposition No. 91201631
v.)
)
TRUE VALUE COMPANY,)
)
)
)
)
Applicant.)
_____)

ANSWER

COMES NOW, the Applicant, True Value Company (“Applicant”) to Answer the Notice of Opposition. Each and every allegation in the Notice of Opposition that is not specifically admitted below is denied. Applicant specifically denies any damage to Opposer from the registration of the mark shown in Application Serial No. 85/083225. No response is made to the first introductory paragraph. The numbered allegations will be answered below:

1. Opposer is the owner of U.S. Trademark Registration No. 1955591 for the mark PLATINUM for “clear and pigmented coatings in the nature of interior and exterior paint.” (“Opposer’s Registration”)

RESPONSE:

Applicant admits that Opposer purports to own the mark PLATINUM in connection with “clear and pigmented coatings in the nature of interior and exterior paint,” but disputes the validity of the purported mark.

2. Opposer’s Registration issued February 13, 1996 and is a valid, subsisting, enforceable and incontestable. A copy of the TARR report for the Opposer’s Registration is attached as Exhibit A.

RESPONSE:

Applicant admits that the TARR report appears to be an accurate record from the USPTO database and admits that the TARR record shows a Registration issuance date of February 13, 1996, but denies the allegation that the mark is valid, subsisting and/or enforceable.

3. Opposer's licensee, The Sherwin-Williams Company, is a leading manufacturer, retailer, wholesaler and distributor of paint and coating products, including, without limitation, architectural paints.

RESPONSE:

Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations of Paragraph 3 and, therefore, denies the same.

4. Opposer's PLATINUM mark has been used continuously in interstate commerce by and through Opposer's licensee from a date prior in time to the July 13, 2010 filing date of Applicant's trademark application for EASY CARE PLATINUM.

RESPONSE:

Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations of Paragraph 4 and, therefore, denies the same.

5. As a result of the use, promotion, and advertising of Opposer's PLATINUM mark and products bearing its PLATINUM mark, Opposer's PLATINUM has acquired significant goodwill.

RESPONSE:

Applicant denies the allegation in Paragraph 5.

6. The similarity of Applicant's EASY CARE PLATINUM mark to Opposer's PLATINUM mark is evident from comparison of the marks; and the goods described in Applicant's trademark application are related to the goods bearing Opposer's PLATINUM mark and may be encountered by the same class of consumers in similar channels of trade.

RESPONSE:

Applicant denies the allegation in Paragraph 6.

7. Applicant's mark so resembles Opposer's mark that its use is likely to deceive consumers or cause confusion or mistake in the minds of consumers by leading consumers to believe that Applicant's goods are endorsed, approved, associated with, or sponsored by Opposer or that Applicant utilizes Opposer's goods, all to the injury of consumers and to Opposer and its goodwill in the PLATINUM mark.

RESPONSE:

Applicant denies the allegation in Paragraph 7.

8. Opposer will be injured by registration of Applicant's mark because Applicant's mark, when used in connection with Applicant's goods, is likely to:
- a. cause confusion or mistake in the minds of consumers or to deceive consumers as to an association between Applicant and Opposer and the goods provided by each;
 - b. falsely suggest a connection or association with Opposer and/or products bearing Opposer's mark;
 - c. damage Opposer's valuable goodwill in its PLATINUM trademark; and
 - d. threaten Opposer's rights to expand the scope and use of its trademark to related, analogous or equivalent goods or services and to undermine and injure Opposer's rights in its mark.

RESPONSE:

Applicant denies the allegation in Paragraph 8.

9. Applicant is not now, and was not at the time of filing the application, or at any other time entitled to the registration of the mark disclosed for the goods specified therein.

RESPONSE:

Applicant denies the allegation in Paragraph 9.

AFFIRMATIVE DEFENSES

For its Affirmative Defenses, Applicant alleges as follows:

FIRST AFFIRMATIVE DEFENSE

The Opposition fails to state a claim.

SECOND AFFIRMATIVE DEFENSE

There is no likelihood of confusion as to source, endorsement, sponsorship, or affiliation.

THIRD AFFIRMATIVE DEFENSE

Opposer has not suffered any damage.

COUNTERCLAIM

Respondent and Counterclaim-Plaintiff True Value Company for its Counterclaim against SWIMC, Inc. states and alleges as follows:

1. Registrant has obtained a Registration for the mark "PLATINUM" for use in connection with "clear and pigmented coatings in the nature of interior and exterior paint" under Registration No. 1,955,591.
2. The term "PLATINUM," however, is generic or highly descriptive when used in connection with home décor and home decoration, including but not limited to paint and clear and pigmented coatings in the nature of interior and exterior paint.
3. The term "PLATINUM" is a term in common parlance that is in frequent, widespread and longstanding common use to describe a high quality, premium product of excellence.
4. The term "PLATINUM" is a term in common parlance that is in frequent, widespread and longstanding common use to describe pigmentation and a certain color gradation.
5. Because of the foregoing frequent, widespread and common use of the term "PLATINUM," it is a mark that is generic and/or so highly descriptive of the goods and services for which it is registered and is incapable of acquiring distinctiveness.
6. The term "PLATINUM" is not now and has never been capable of functioning as an indicator of origin and fails to function as a trademark.

WHEREFORE, True Value Company respectfully requests that Registration No. 1,955,591 be cancelled according to Sections 14 and 18 of the Lanham Act, 15 U.S.C. Sections

1064 and 1068, and that this Petition for Cancellation be sustained in favor of Counterclaim-Plaintiff True Value Company.

Please direct all correspondence to:

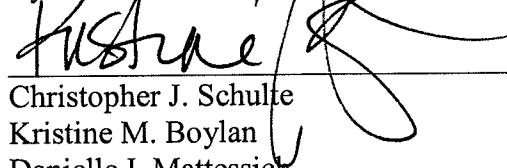
Kristine M. Boylan
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Petitioner herein appoints Kristine M. Boylan; John A. Clifford, Reg. No. 30,247; Gregory C. Golla; Andrew S. Ehard; Scott W. Johnston, Reg. No. 39,721; Heather J. Kliebenstein; Danielle I. Mattessich; Scott M. Oslick; Christopher J. Schulte; William D. Schultz and Anthony R. Zeuli, Reg. No. 45,255 and all other attorneys of the firm of Merchant & Gould P.C., its attorneys to transact all business in the U.S. Patent and Trademark Office relating to this matter with full power of substitution.

Accompanying the Petition for Cancellation is the required fee of \$300.00. Please charge any excess fees or credit overpayment to Deposit Account No. 13-2725 of Petitioner's counsel noted below.

TRUE VALUE COMPANY

By its Counsel



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Dated: October 25, 2011

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing ANSWER was served, via first-class mail, postage prepaid to:

Deron A Cook
The Sherwin-Williams Company
101 W Prospect Avenue
1100 Midland Building Legal Dept
Cleveland, OH 44115-1075

this 25th day of October, 2011.


Amanda Avery

CERTIFICATE OF FILING

I hereby certify that this ANSWER is being filed electronically with the United States Patent and Trademark Office's Electronic System for Trademark Trial & Appeals (ESTTA) on this 25th day of October, 2011.


Amanda Avery