

ESTTA Tracking number: **ESTTA445162**

Filing date: **12/07/2011**

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

Proceeding	91201631
Party	Plaintiff SWIMC, Inc.
Correspondence Address	DERON A COOK THE SHERWIN WILLIAMS COMPANY 101 W PROSPECT AVENUE , 1100 MIDLAND BUILDING LEGAL DEPT CLEVELAND, OH 44115-1075 UNITED STATES legal_ip@sherwin.com
Submission	Answer to Counterclaim
Filer's Name	Thad Chaloehtiarana
Filer's e-mail	tc@pattishall.com, sia@pattishall.com, tbm@pattishall.com
Signature	/s/ Thad Chaloehtiarana
Date	12/07/2011
Attachments	Answer to Counterclaim.111207.pdf ( 4 pages )(12137 bytes )



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.

**RESPONSE:**

Registrant/Opposer denies the allegations set forth in Paragraph 2 of the Counterclaim.

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.

**RESPONSE:**

Registrant/Opposer is without information sufficient to admit or deny the truth of the allegations contained in Paragraph 3 of the Counterclaim, and on that basis denies such allegations.

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.

**RESPONSE:**

Registrant/Opposer is without information sufficient to admit or deny the truth of the allegations contained in Paragraph 4 of the Counterclaim, and on that basis denies such allegations.

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.

**RESPONSE:**

Registrant/Opposer denies the allegations set forth in Paragraph 5 of the Counterclaim.

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.

**RESPONSE:**

Registrant/Opposer denies the allegations set forth in Paragraph 6 of the Counterclaim.

**AFFIRMATIVE DEFENSES**

**FIRST AFFIRMATIVE DEFENSE**

**(Failure to State a Claim)**

Petitioner/Applicant's Counterclaim fails to state a claim upon which relief can be granted.

**SECOND AFFIRMATIVE DEFENSE**

**(Incontestable Registration)**

Petitioner/Applicant's Counterclaim fails at least in part because Registrant's/Opposer's Registration No. 1,955,591 is incontestable.

**THIRD AFFIRMATIVE DEFENSE**

**(Laches)**

Petitioner/Applicant's Counterclaim is barred by the doctrine of laches.

**FOURTH AFFIRMATIVE DEFENSE**

**(Estoppel)**

Petitioner/Applicant is estopped from asserting the claims asserted in its Counterclaim.

**FIFTH AFFIRMATIVE DEFENSE**

**(Waiver)**

Petitioner/Applicant has waived the claims asserted in its Counterclaim.

WHEREFORE, Registrant/Opposer requests that this Counterclaim be dismissed.

Respectfully submitted,

PATTISHALL, McAULIFFE, NEWBURY,  
HILLIARD & GERALDSON LLP

Dated: December 7, 2011

By:           /s/ Thad Chaloeintiarana          

Thad Chaloeintiarana  
Seth I. Appel  
311 South Wacker Drive, Suite 5000  
Chicago, Illinois 60606  
(312) 554-8000

*Attorneys for Registrant/Opposer*

**CERTIFICATE OF TRANSMISSION**

I, Seth I. Appel, an attorney for Registrant/Opposer, hereby certify that a true and correct copy of the foregoing REGISTRANT/OPPOSER'S ANSWER TO PETITIONER/APPLICANT'S COUNTERCLAIM was electronically transmitted to the Trademark Trial and Appeal Board on this SEVENTH day of DECEMBER, 2011.

\_\_\_\_\_  
/s/ Seth I. Appel

Seth I. Appel

**CERTIFICATE OF SERVICE**

This is to certify that I have this day served the following named persons with the foregoing REGISTRANT/OPPOSER'S ANSWER TO PETITIONER/APPLICANT'S COUNTERCLAIM by placing a true and exact copy of said document in the United States mail, addressed to said counsel at her offices, with sufficient postage thereupon to carry the same to its destination at the following address:

Kristine M. Boylan  
Merchant & Gould P.C.  
PO Box 2910  
Minneapolis, MN 55402-0910

This SEVENTH day of DECEMBER, 2011.

\_\_\_\_\_  
/s/ Seth I. Appel

Seth I. Appel