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

Proceeding	91212244
Party	Defendant LF, LLC
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Submission	Answer
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Date	10/07/2013
Attachments	Applicant's Answer to Opposer Utilitech's Opposition.pdf(280795 bytes)

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

UTILITECH, INC.,)	
)	
Opposer,)	Opposition No. 91212244
)	
v.)	Mark: Utilitech
)	Application Ser. No. 85/896,167
LF, LLC,)	Date of Publication: August 6, 2013
)	
Applicant.)	

LF, LLC'S ANSWER TO OPPOSITION

Applicant LF, LLC (“Applicant”), through its undersigned counsel, hereby timely files its Answer to the Opposition of UtiliTech, Inc. (“Opposer”). All allegations in the Opposition are denied unless expressly admitted in the following responses:

With respect to the preface of the Notice of Opposition, Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations regarding Opposer’s status as a Pennsylvania Corporation or the location of its principal place of business, and therefore denies the same. Applicant also denies Opposer’s belief “that it will be damaged by the registration of Ser. No. 85/896,167 for the mark Utilitech . . . covering ‘LED light bulbs, decorative LED bulbs, and incandescent light bulbs’ in U.S. Class 013, 021, 023, 031, 034, and International Class 011” Applicant admits that it filed the above-referenced application, and that it is a Delaware Limited Liability Company having an address at 1000 Lowe’s Boulevard, Mooresville, NC 28117. To the extent the preface of the Notice of Opposition contains other factual allegations, Applicant denies them.

With respect to Opposer’s grounds of the opposition, Applicant answers as follows:

1. Opposer is the owner of the mark UTILITECH to identify its business, having an online presence on the World Wide Web as a business conducting energy and business

auditing and energy audits of commercial and institutional facilities for the purpose of improving energy efficiency.

ANSWER: Those portions of Paragraph 1 of the Opposition alleging Opposer's ownership of a mark contain a legal conclusion to which no response is required. Applicant is without sufficient knowledge or information to form a belief as to the truth of the remaining allegations contained in Paragraph 1, and therefore denies those allegations.

2. The mark UTILITECH has been continuously used by Opposer since at least as early as January 1, 1993 in connection with energy and business auditing and energy audits of commercial and institutional facilities for the purpose of improving energy efficiency.

ANSWER: Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations contained in Paragraph 2 of the Opposition, and therefore denies those allegations.

3. Prior to the Application filing date of April 5, 2013, Opposer has used the UTILITECH mark to identify energy and business auditing and energy audits of commercial and institutional facilities for the purpose of improving energy efficiency.

ANSWER: Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations contained in Paragraph 3 of the Opposition, and therefore denies those allegations.

4. Opposer is the owner of:

Reg. No. 4,066,588-UTILITECH for "business auditing; conducting energy audits of commercial and institutional facilities for the purpose of improving energy efficiency; Energy auditing" in U.S. Class 100, 101, 102 and International Class 035; registered December 6, 2011; based on use since January 1, 1993.

This registration is valid, subsisting, unrevoked, and has not been canceled. A copy of the registration certificate and its corresponding TSDR status report are attached hereto as Exhibit A.

ANSWER: Applicant denies that Opposer owns a federally registered “UTILITECH” word mark, as Paragraph 4 implies. Instead, Opposer’s Reg. No. 4,066,588 appears as follows, as shown in Opposer’s Exhibit A:



Applicant admits that Opposer’s federally registered mark is unrevoked and has not been canceled. The remaining allegations in Paragraph 4, concerning the validity and subsistence of Opposer’s registration contain legal conclusions to which no response is required.

5. Opposer has extensively advertised its UTILITECH mark throughout the range of available media, including but not limited to print publications, point-of-sale advertising on a regional and national level and via the Internet.

ANSWER: Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations contained in Paragraph 5 of the Opposition, and therefore denies those allegations.

6. By virtue of its extensive use, sales, marketing and promotion, Opposer’s UTILITECH mark has acquired a high degree of distinctiveness to companies seeking energy auditing and business auditing services, indicating source in the Opposer.

ANSWER: Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations in Paragraph 6 concerning the extent of Opposer’s use, sales, marketing, or promotion of any claimed mark, and therefore denies those allegations. The allegations in Paragraph 6 concerning “distinctiveness” is a legal conclusion to which no response is required. To the extent Paragraph 6 contains additional factual allegations, they are denied.

7. The services for which Applicant seeks to register Applicant’s Mark are related to and encompassed in the services identified in Opposer’s UTILITECH mark registration in that Opposer provides energy auditing services to energy providers.

ANSWER: Applicant denies that it is seeking to register its mark for any

“services” whatsoever; instead, Applicant seeks to register its mark for “LED light bulbs, decorative LED bulbs, and incandescent light bulbs.” Applicant therefore also denies that these goods are “encompassed in the services” identified in any mark associated with Opposer. To the extent Paragraph 7 contains additional factual allegations, they are denied.

8. The intended use and registration by Applicant of Applicant’s Mark for the services identified in the Application is likely to cause confusion, mistake or deception by having the public erroneously assume or believe that the services offered in connection with the confusingly similar Applicant’s Mark emanate from the same source or origin as Opposer’s UTILITECH services, or are in some other way associated, endorsed, licensed, authorized or sponsored by Opposer, all to Opposer’s irreparable damage in violation of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

ANSWER: The allegations in Paragraph 8 concerning likelihood of confusion, mistake, or deception, and the possibility of damage to Opposer are all legal conclusions to which no response is required. Applicant denies that it is seeking to register its mark for any “services” whatsoever; instead, Applicant instead seeks to register its mark for “LED light bulbs, decorative LED bulbs, and incandescent light bulbs.” To the extent Paragraph 8 contains additional factual allegations, they are denied.

9. Moreover, Applicant’s proposed use and registration of Applicant’s Mark is likely to dilute the distinctive quality of the Opposer’s UTILITECH mark, and, thus, injure Opposer.

ANSWER: Paragraph 9 contains legal conclusions to which no response is required. To the extent Paragraph 9 contains factual allegations, they are denied.

10. Accordingly, registration for the mark applied for under Ser. No. 85/896,167 should be refused.

ANSWER: Applicant admits that Opposer requests that its opposition be sustained and that registration of the mark set forth in Application Serial Number 85/896,167 be denied. Applicant denies that Opposer is entitled to such relief.

For the reasons set forth in paragraphs 1 through 10, Opposer believes and asserts it will be damaged by the registration of Ser. No. 85/896,167 for the mark UTILITECH.

Therefore, Opposer prays that his Opposition be sustained, and that Applicant be refused registration of Applicant's Mark for the goods and services set forth in application Ser. No. 85/896,167.

ANSWER: Applicant admits that Opposer requests that its opposition be sustained and that registration of the mark set forth in Application Serial Number 85/896,167 be denied. Applicant denies that Opposer is entitled to such relief.

This notice is being filed electronically accompanied by payment of the \$300.00 filing fee.

ANSWER: Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations contained in the foregoing statement contained in the Opposition, and therefore denies the allegation.

DEFENSES

11. Applicant's mark is not likely to cause confusion with Opposer's alleged mark based on, *inter alia*, the differences between the marks; the differences between Applicant's goods and Opposer's services involved; the differences between the channels of trade and respective customers; the long coexistence of Opposer's alleged mark and other similar marks; the lack of evidence of actual or potential consumer confusion; and the degree of care likely to be exercised by purchasers of Opposer's services.

12. Opposer has not engaged in substantially exclusive use of its alleged mark(s).

13. Opposer's mark is not famous.

AFFIRMATIVE DEFENSES

14. **First Affirmative Defense – Estoppel and Laches:** Opposer's opposition is barred by the doctrines of estoppel and laches because Opposer inexcusably delayed its

opposition of any of Applicant's related UTILITECH® marks, causing material prejudice to Applicant.

15. **Second Affirmative Defense – Estoppel by Acquiescence:** Opposer's opposition is barred by Opposer's acquiescence because Opposer, by affirmative words and deeds, conveyed its implied consent to Applicant's use of its related UTILITECH® marks.

16. **Third Affirmative Defense – Waiver:** Opposer's opposition is barred by waiver because Opposer relinquished a known right by waiting as long as it did to oppose any of Applicant's related UTILITECH® marks.

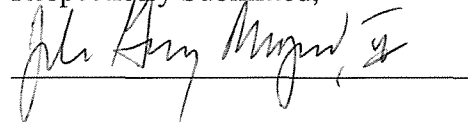
17. **Fourth Affirmative Defense – Unclean Hands:** Opposer's opposition is barred by the doctrine of unclean hands because Opposer acted in egregious bad faith, which was injurious to Applicant.

18. **Fifth Affirmative Defense – Failure to Mitigate Damages:** Opposer's opposition is barred by its failure to mitigate damages because Opposer refused to adopt reasonable and effective measures proposed by Applicant that would reduce or eliminate misdirected inquiries from customers inquiring about any of Applicant's related UTILITECH® marks, including the mark that is the subject of this opposition.

WHEREFORE, Applicant asks that the opposition be **DENIED.**

October 7, 2013

Respectfully Submitted,




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CERTIFICATE OF SERVICE

I hereby certify that I have caused a true and correct copy of the foregoing **LF, LLC'S ANSWER TO OPPOSITION** to Application Serial No. 85/896,167 to be served by first-class U.S. Mail upon counsel for UtiliTech, Inc., Gavin P. Lentz and Todd S. McGarvey, Bochetto & Lentz, P.C., 1524 Locust Street, Philadelphia, PA 19102, and by electronic mail at the following addresses:

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John Gary Maynard, III, Esq.