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

Proceeding	91223300
Party	Defendant Powergrid Solutions, Inc.
Correspondence Address	NICHOLAS A. KEES Godfrey Kahn 780 N Water St Ste 1500 Milwaukee, WI 53202-3590 docketing@gklaw.com
Submission	Answer
Filer's Name	Shane Delsman
Filer's e-mail	docketing@gklaw.com, sdelsman@gklaw.com
Signature	/Shane Delsman/
Date	09/23/2015
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application Ser. No. 86/524,572)	
GREGORY SHALLBETTER)	
Opposer,)	Opposition No. 91223300
v.)	
POWERGRID SOLUTIONS, INC.)	
Respondent.)	

ANSWER TO NOTICE OF OPPOSITION

Applicant, Powergrid Solutions, Inc., (“PSI”), hereby answers the Notice of Opposition filed Opposer, Gregory Shallbetter, as follows:

1. On February 4, 2015 Powergrid Solutions, Inc. (“Applicant”) filed an application for the mark SHALLBETTER on the principal register in connection with “Electrical conversion and control apparatus, namely, electrical fuse gear and circuit breakers, electrical termination equipment, electrical switchgear, electrical capacitors and meters, power management devices, and associated boxes and junction boxes and cabinets for housing or enclosing any such equipment” in International Class 009 and “Engineering and design services for electrical conversion and control apparatus” in International Class 42.

ANSWER: Admitted.

2. Opposer Greg Shallbetter has actively worked in the electrical power distribution industry for over 40 years.

ANSWER: PSI lacks knowledge or information sufficient to form a belief as to the truth of the allegations in this Paragraph and therefore denies them.

3. At all times, Greg Shallbetter has used his personal name “Shallbetter” in conducting his business interests.

ANSWER: PSI lacks knowledge or information sufficient to form a belief as to the truth of the allegations in this Paragraph and therefore denies them.

4. Greg Shallbetter is the owner, President, and CEO of Switchgear Power Systems, LLC (“Switchgear Power Systems”) a company that he formed in 2007. Switchgear Power Systems operates in the electrical power distribution industry, and is located just outside of Oshkosh, Wisconsin.

ANSWER: Admitted that Switchgear Power Systems operates in the electrical power distribution industry, and that the place where Switchgear Power Systems is located is Winneconne, Wisconsin, which is near Oshkosh, Wisconsin. PSI lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations in this Paragraph and therefore denies them.

5. Applicant is also a business that operates in the electrical power distribution industry, and is located in Oshkosh, Wisconsin.

ANSWER: Admitted that PSI operates in the electrical power distribution industry and that it is located in Oshkosh, Wisconsin, but denies any suggestion by use of the word “also” that Opposer is located in Oshkosh.

6. Switchgear Power Systems is a direct competitor of the Applicant.

ANSWER: Admitted that Switchgear Power Systems is a competitor of PSI’s with regards to some, but not all goods and services.

7. The business locations of the Applicant and Switchgear Power Systems are less than 15 miles apart and both companies operate within the same industry with respect to their products and operations and compete for the exact same customers. Upon information and belief, there are very few companies in the electrical distribution industry that service the same clients and provide the same products and services of Switchgear Power Systems and the Applicant and the two companies consistently bid on the exact same projects at the same time.

ANSWER: Admitted that the business locations of PSI and Opposer are less than 15 miles apart and that both operate within the same industry with respect to some, but not all of their products and operations. The remaining allegations in this Paragraph, to the extent PSI understands them, are denied.

8. Upon information and belief, Applicant is attempting to register Greg Shallbetter's name in a bad faith attempt to bar Greg Shallbetter from using his name in the industry and Applicant has no intent of actually using the mark SHALLBETTER on any of its goods or services.

ANSWER: Denied.

9. It is noted that there has been a history of bad will between Applicant and Greg Shallbetter, with Applicant and/or its affiliates seeking legal action against Greg Shallbetter on more than one occasion.

ANSWER: Admitted that legal action has been taken against the Opposer for matters unrelated hereto. The remaining allegations in this Paragraph are denied.

Count I: No Bona Fide Use of Mark in Commerce

15 U.S.C. § 1051(a)(1)

10. Greg Shallbetter hereby repeats and realleges the allegations above as though fully set forth herein.

ANSWER: PSI realleges and reincorporates the allegations contained in paragraphs 1 through 9.

11. Applicant filed for registration of the mark SHALLBETTER on the principal register pursuant to 15 U.S.C. §1051(a)(1).

ANSWER: Admitted.

12. Upon information and belief, as of the application filing date, Applicant was not using and does not intend to use the mark SHALLBETTER in commerce for any of its goods and services, including the recited goods and services under application Serial No. 86524572.

ANSWER: Denied.

13. As a result, no registration may issue in connection with Applicant's claim for the goods and services listed and the application Serial No. 86524572 is void ab initio.

ANSWER: Denied.

14. Upon information and belief, the application for registration of the SHALLBETTER mark has been done solely to harass Greg Shallbetter, impermissibly reserve rights in a mark, and prevent him from using his own surname.

ANSWER: Denied.

Count II: Name of Individual Without Written Consent

15 U.S.C. § 1052(c)

15. Greg Shallbetter hereby repeats and realleges the allegations above as though fully set forth herein.

ANSWER: PSI realleges and reincorporates the allegations contained in paragraphs 1 through 14.

16. Pursuant to 15 U.S.C. § 1052(c), a trademark shall not be registered if it consists of a name of a particular living individual, unless written consent is given by the individual.

ANSWER: Admitted that 15 U.S.C. § 1052 provides “[n]o trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it . . . (c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent.” PSI denies any suggestion that 15 U.S.C. § 1052 is the complete understanding of the law. For example, written consent can be implied.

17. The current application submitted by Applicant for registration of the mark SHALLBETTER specifically represents and refers to the Opposer Greg Shallbetter.

ANSWER: Denied.

18. In 1982, Greg Shallbetter actually co-founded Applicant’s company. During his tenure with Applicant, Greg Shallbetter served in various capacities, including the VP of Marketing, the National Sales Manager, and eventually the President and CEO of the Applicant.

ANSWER: Admitted that the Opposer co-founded PSI under its original name Shallbetter Bros., Inc. PSI lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations in this Paragraph and therefore denies them.

19. Not only was Greg Shallbetter the founder of Applicant's company, but the fame reputation, and awareness of Greg Shallbetter in the electrical power distribution industry is substantial. Greg Shallbetter has been well-known within the upper levels of the electrical power distribution industry for over forty (40) years. He has successfully founded two multi-million dollar companies within the industry. He also frequently attends and makes appearances at conferences and conventions in the electrical power distribution industry, including the annual IEEE Transmission and Distribution Conference and Exposition.

ANSWER: Admitted that Greg Shallbetter was, but no longer is, one of the co-founders, not the founder, of PSI. PSI lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations in this Paragraph and therefore denies them.

20. Greg Shallbetter has not at any time, nor does he now, consent or agree to his last name being registered as a trademark by any person, including the Applicant.

ANSWER: Denied.

21. The registration of the Applicant's mark without the permission of Greg Shallbetter would cause Greg Shallbetter to be falsely identified with the Applicant, causing damage to fame, reputation, and awareness of Greg Shallbetter.

ANSWER: Denied.

22. By reason of the foregoing, Greg Shallbetter will be severely damaged by the registration of the SHALLBETTER mark.

ANSWER: Denied.

23. As a result, and pursuant to 15 U.S.C. § 1052(c), registration of the mark SHALLBETTER must be refused and denied.

ANSWER: Denied.

Count III: False Suggestion of Connection with Person

15 U.S.C. § 1052(a)

24. Greg Shallbetter hereby repeats and realleges the allegations above as though fully set forth herein.

ANSWER: PSI realleges and reincorporates the allegations contained in paragraphs 1 through 23.

25. Pursuant to 15 U.S.C. § 1052(a), a trademark shall not be registered if it falsely suggests a connection with persons, living or dead.

ANSWER: PSI admits that 15 U.S.C. § 1052 provides “[n]o trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it . . . (a) Consists of or comprises . . . matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols.” PSI denies any suggestion that 15 U.S.C. § 1052 is the complete understanding of the law. For example, there are factors used to determine whether a proposed mark falsely suggests a connection with a person or an institution which are not included in this Paragraph.

26. Here, Applicant’s application is for the mark SHALLBETTER. Due to the fame, reputation, and specific awareness of Greg Shallbetter in the electrical power distribution industry, the mark SHALLBETTER would suggest a connection, association or sponsorship by Greg Shallbetter

ANSWER: Admitted that the application for which this opposition has been initiated is for the mark SHALLBETTER. The remaining allegations in this Paragraph are Denied.

27. Upon information and belief, there are not any individuals with the name “Shallbetter” currently employed by or associated with Applicant.

ANSWER: Admitted that there are not any individuals with the name “Shallbetter” currently employed by PSI.

28. The mark SHALLBETTER, when used in connection with the applied-for goods and services, is likely to confuse the consuming public to believe that the Applicant’s goods and services are authorized, sponsored, licensed, or manufactured by Greg Shallbetter.

ANSWER: Denied.

29. By reason of the foregoing, Greg Shallbetter will be severely damaged by the registration of the mark SHALLBETTER.

ANSWER: Denied.

30. As a result, and pursuant to 15 U.S.C. § 1052(a), registration of the mark SHALLBETTER should be refused.

ANSWER: Denied.

Count IV: Merely a Surname

15 U.S.C. § 1052(e)(4)

31. Greg Shallbetter hereby repeats and realleges the allegations above as though fully set forth herein.

ANSWER: PSI realleges and reincorporates the allegations contained in paragraphs 1 through 30.

32. Pursuant to 15 U.S.C. § 1052(e)(4), a trademark shall not be registered that consists solely of a mark which is primarily merely a surname.

ANSWER: PSI admits that 15 U.S.C. § 1052 provides “[n]o trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it . . . (e) Consists of a mark which . . . (4) is primarily merely a surname.” PSI denies any suggestion that 15 U.S.C. § 1052 is the complete understanding of the law. For example, 15 U.S.C. § 1052(f) provides “[e]xcept as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce.”

33. If it is determined that the mark SHALLBETTER does not specifically identify Greg Shallbetter, Opposer alternatively alleges that the mark SHALLBETTER is primarily merely a surname that should not be registered on the principal register pursuant to 15 U.S.C. § 1052(e)(4).

ANSWER: Denied.

34. The registration of the mark SHALLBETTER would be severely damaging to Greg Shallbetter, as such registration would confer evidentiary benefits that are inconsistent with Greg Shallbetter’s rights at common law.

ANSWER: Denied.

35. As a result, and pursuant to 15 U.S.C. § 1052(e)(4), registration of the mark SHALLBETTER should be refused.

ANSWER: Denied.

PSI'S AFFIRMATIVE DEFENSES

First Affirmative Defense:

Opposer Transferred his Rights in the SHALLBETTER Mark to PSI

36. Upon information and belief, in 1982, PSI was formed under its original name Shallbetter Bros., Inc.

37. Upon information and belief, the Opposer was a co-founder of Shallbetter Bros., Inc.

38. Upon information and belief, "Shallbetter" as used in Shallbetter Bros., Inc., was selected at least in part and authorized by the Opposer.

39. Upon information and belief, under the name Shallbetter Bros., Inc., PSI advertised, offered for sale and/or sold electrical conversion and control apparatus and engineering and designs services for electrical conversion and control apparatus in connection with the mark "Shallbetter."

40. Upon information and belief, in 1997, the domain name www.shallbetter.com was registered by PSI.

41. Upon information and belief, www.shallbetter.com was selected and authorized, at least in part, by the Opposer.

42. Upon information and belief, PSI, under the name Shallbetter Bros., Inc., used www.shallbetter.com to advertise, offer for sale and/or sell goods and services in connection with the mark "Shallbetter" for at least some time between 1997 and 2002.

43. Upon information and belief, PSI's advertising, offering for sale and sale of goods and services in connection with the mark "Shallbetter" between 1982 and 2002, including through www.shallbetter.com, was authorized by Opposer.

44. In 2002, Shallbetter Bros., Inc., changed its name to Shallbetter, Inc.
45. Upon information and belief, the change in corporate names and continued use of Shallbetter in the corporate name was selected at least in part and authorized by the Opposer.
46. Upon information and belief, between 2002 and 2003, under the name Shallbetter, Inc., PSI continued to advertise, offer for sale and/or sell electrical conversion and control apparatus and engineering and designs services for electrical conversion and control apparatus in connection with the mark "Shallbetter."
47. Upon information and belief, between 2002 and 2003, PSI, under the name Shallbetter, Inc., continued to use www.shallbetter.com to advertise, offer for sale and/or sell goods and services in connection with the mark "Shallbetter."
48. Upon information and belief, between 2002 and 2003, PSI's advertising, offering for sale and sale of goods and services in connection with the mark "Shallbetter," including through the www.shallbetter.com, was authorized by Opposer.
49. Upon information and belief, the Opposer was at least a co-founder of Shallbetter Recapitalization, Inc.
50. Upon information and belief, "Shallbetter" as used in Shallbetter Recapitalization, Inc., was selected at least in part and authorized by the Opposer.
51. In 2003, Shallbetter Recapitalization, Inc. merged with Shallbetter, Inc. and kept the name Shallbetter, Inc.
52. The Articles of Merger was signed by the Opposer as president of Shallbetter Recapitalization, Inc.
53. Upon information and belief, the merger and continued use of "Shallbetter" in PSI's former corporate name was authorized by the Opposer.

54. Upon information and belief, between 2003 and 2005, under the name Shallbetter, Inc., PSI continued to advertise, offer for sale and/or sell electrical conversion and control apparatus and engineering and designs services for electrical conversion and control apparatus in connection with the mark “Shallbetter.”

55. Upon information and belief, between 2003 and 2005, PSI, under the name Shallbetter, Inc., continued to use www.shallbetter.com to advertise, offer for sale and/or sell goods and services in connection with the mark “Shallbetter.”

56. Upon information and belief, between 2003 and 2005, PSI’s advertising, offering for sale and sale of goods and services in connection with the mark “Shallbetter,” including through the www.shallbetter.com, was authorized by Opposer.

57. In 2005, the Opposer sold all his right, title and interest in Shallbetter, Inc. through a Purchase and Sale Agreement dated March 24, 2005.

58. Nothing in the Purchase and Sale Agreement prohibited PSI from continuing to use the name Shallbetter, Inc., www.shallbetter.com or the mark “Shallbetter.”

59. Nothing in the Purchase and Sale Agreement prohibited PSI from continuing to advertise, offer for sale and/or sell electrical conversion and control apparatus and engineering and designs services for electrical conversion and control apparatus in connection with the mark “Shallbetter.”

60. Nothing in the Purchase and Sale Agreement prohibited PSI from continuing to use www.shallbetter.com to advertise, offer for sale and/or sell electrical conversion and control apparatus and engineering and designs services for electrical conversion and control apparatus in connection with the mark “Shallbetter.”

61. Between 2005 and 2014, under the name Shallbetter, Inc., PSI has continued to advertise, offer for sale and/or sell electrical conversion and control apparatus and engineering and designs services for electrical conversion and control apparatus in connection with the mark "Shallbetter."

62. Between 2005 and 2014, PSI, under the name Shallbetter, Inc., has continued to use www.shallbetter.com to advertise, offer for sale and/or sell goods and services in connection with the mark "Shallbetter."

63. Between 2005 and 2014, the Opposer did not object to PSI's advertising, offering for sale and sale of goods and services in connection with the mark "Shallbetter," including through www.shallbetter.com.

64. Upon information and belief, between 2005 and 2014, PSI's advertising, offering for sale and sale of goods and services in connection with the name and mark "Shallbetter" including through www.shallbetter.com, was authorized by Opposer.

65. In 2014, Shallbetter, Inc. changed its name to Powergrid Solutions, Inc.

66. Since 2014, PSI has continued to advertise, offer for sale and/or sell electrical conversion and control apparatus and engineering and designs services for electrical conversion and control apparatus in connection with the mark "Shallbetter."

67. Since 2014, PSI has continued to use www.shallbetter.com to advertise, offer for sale and/or sell goods and services in connection with the mark "Shallbetter."

68. Upon information and belief, since 2014, PSI's advertising, offering for sale and sale of goods and services in connection with the mark "Shallbetter," including through the www.shallbetter.com, has been authorized by Opposer.

69. The Opposer has seen PSI at at least one of the IEEE Transmission and Distribution Conference and Expositions since 2005.

70. The Opposer has seen PSI's advertising goods and services, including electrical conversion and control apparatus and engineering and designs services for electrical conversion and control apparatus, in connection with the name and mark "Shallbetter" at at least one of the IEEE Transmission and Distribution Conference and Expositions since 2005.

71. The Opposer did not object to PSI's use of the Shallbetter mark during the IEEE Transmission and Distribution Conference and Exposition.

72. PSI intends to continue to advertise, offer for sale and sell goods and services, including electrical conversion and control apparatus and engineering and designs services for electrical conversion and control apparatus in connection with the mark "Shallbetter."

73. PSI's registration of the mark "SHALLBETTER" should not be refused or denied at least because Opposer provided written consent to PSI's continued use of the mark "SHALLBETTER," including through the Purchase and Sale Agreement.

74. PSI's registration of the mark "SHALLBETTER" should not be refused or denied at least because Opposer authorized PSI's continued use of the mark "SHALLBETTER," including through the Purchase and Sale Agreement.

Second Affirmative Defense:

Opposer has Unclean Hands

75. PSI hereby repeats and realleges the allegations above as though fully set forth herein.

76. The Opposer now inequitably and in bad faith opposes PSI's registration for the mark "SHALLBETTER" after selling any right the Opposer had left in the mark and knowing PSI's valid rights to such mark.

77. PSI's registration of the mark "SHALLBETTER" should not be refused or denied at least because Opposer is barred from claiming or recovering any relief set forth in the Notice of Opposition and each and every count alleged therein because of its inequitable and bad faith conduct.

Third Affirmative Defense:

SHALLBETTER has Acquired Secondary Meaning

78. PSI hereby repeats and realleges the allegations above as though fully set forth herein.

79. PSI's mark "SHALLBETTER" is not primarily merely a surname.

80. "SHALLBETTER" is not a common surname.

81. "SHALLBETTER" is a rare surname.

82. PSI was founded at least in part by the Opposer, Greg Shallbetter.

83. "SHALLBETTER" does not look and sound like a surname.

84. PSI, formerly Shallbetter, Inc. and Shallbetter Recapitalization, Inc., and before that Shallbetter Bros., Inc., was founded in 1982.

85. PSI has made substantially exclusive and continuous use of the mark "SHALLBETTER" from at least 1982 to present.

86. "SHALLBETTER" has acquired secondary meaning under 15 U.S.C. § 1052(f) and should not be refused registration.

