

ESTTA Tracking number: **ESTTA958902**

Filing date: **03/08/2019**

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

Proceeding	91246335
Party	Defendant Gentex Corporation
Correspondence Address	KRISTEN PORTER 600 N. CENTENNIAL ST. ZEELAND, MI 49464 trademarks@gentex.com no phone number provided
Submission	Answer and Counterclaim
Filer's Name	Matthew J. Gipson
Filer's email	mgipson@priceheneveld.com, awong@priceheneveld.com, trentz@priceheneveld.com, ptomail@priceheneveld.com
Signature	/Matthew J. Gipson/
Date	03/08/2019
Attachments	Answer ADs CC.pdf(124973 bytes)

Registration Subject to the filing

Registration No.	4447933	Registration date	12/10/2013
Registrant	Kwikset Corporation 19701 DaVinci Lake Forest, CA 92610 UNITED STATES		

Goods/Services Subject to the filing

Class 009. First Use: 2009/10/00 First Use In Commerce: 2009/10/00
All goods and services in the class are requested, namely: Electronic locks; electronic locks that wirelessly connect to other electronic devices within a residence

Grounds for Cancellation

Fraud on the USPTO	Trademark Act Section 14(3); In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)
--------------------	---

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

<p>SPECTRUM BRANDS, INC.,</p> <p style="text-align: center;">Opposer,</p> <p>v.</p> <p>GENTEX CORPORATION,</p> <p style="text-align: center;">Applicant.</p>	<p>Opposition No. 91246335 Serial No. 87827534</p>
--	--

ANSWER, AFFIRMATIVE DEFENSES, AND COUNTERCLAIM

Applicant, Gentex Corporation (Gentex), by and through its counsel, hereby responds to Opposer, Spectrum Brands Inc.'s (Spectrum) Notice of Opposition as follows:

INTRODUCTION:

Gentex is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in the introductory paragraph with regards to Spectrum as an entity, and therefore, denies the same. Gentex admits that it filed Application Serial No. 87827534 (the Application) for the mark HOMELINK CONNECT. Gentex admits to the address information given for Gentex and admits to the publication date stated for the Application. Gentex denies that Spectrum will be damaged by the registration of the Application.

LIKELIHOOD OF CONFUSION

1. In response to Paragraph 1, Gentex is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth therein and, therefore, denies the same.

2. In response to Paragraph 2, Gentex admits that Spectrum purports to be the owner of U.S. Trademark Registration No. 4,447,933 (the '933 Registration). Gentex is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations set forth therein and, therefore, denies the same.

3. In response to Paragraph 3, Gentex is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth therein and, therefore, denies the same.

4. In response to Paragraph 4, Gentex admits that Spectrum purports to be the owner of the '933 Registration. It is denied that the '933 Registration was properly granted, as set forth in the Counterclaim. For the remaining allegations set forth in Paragraph 4, Gentex is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth therein and, therefore, denies the same.

5. Denied as to any allegation or implication that Spectrum's "HOME CONNECT and Design" mark is incontestable. Denied as to any allegation or implication that Spectrum is the exclusive user of the HOME CONNECT mark. For the remaining allegations set forth in Paragraph 5, Gentex is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth therein and, therefore, denies the same.

6. Denied as to any allegation or implication that Spectrum is the exclusive user of the HOME CONNECT mark, or that the HOME CONNECT mark has acquired secondary meaning. For the remaining allegations in Paragraph 6, Gentex is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth therein and, therefore, denies the same.

7. Admitted.

8. Admitted.

9. It is admitted that Spectrum's filing and registration for the "HOME CONNECT and Design" mark predates the Application filing. It is denied that this registration was properly granted, as set forth in the Counterclaim. For the remaining allegations in Paragraph 9, Gentex is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth therein and, therefore, denies the same.

10. Denied.

11. Denied.

12. Denied.

13. Denied.

14. Denied.

15. Denied.

AFFIRMATIVE DEFENSES

AS AND FOR ITS SEPARATE AND AFFIRMATIVE DEFENSES, Gentex alleges as follows:

FIRST AFFIRMATIVE DEFENSE

Spectrum lacks standing to oppose the Application because Spectrum will not be damaged by the registration of the HOMELINK CONNECT mark.

SECOND AFFIRMATIVE DEFENSE

Spectrum lacks standing to oppose the Application because Spectrum has not alleged facts sufficient to support rights in and to any trademark which is confusingly similar to the HOMELINK CONNECT mark.

THIRD AFFIRMATIVE DEFENSE

There is no likelihood of confusion, mistake, or dilution because, *inter alia*, Gentex's HOMELINK CONNECT mark and the pleaded marks of Spectrum are not confusingly similar and/or the goods marketed under the allegedly conflicting mark are not sufficiently related and are marketed through distinct channels of trade.

FOURTH AFFIRMATIVE DEFENSE

The scope of Spectrum's trademark rights, if any, is not broad enough to preclude Gentex from registering the HOMELINK CONNECT mark.

FIFTH AFFIRMATIVE DEFENSE

The literal element of Spectrum's purported mark is merely descriptive and unprotectable.

SIXTH AFFIRMATIVE DEFENSE

Spectrum and/or its predecessor in interest obtained the '933 Registration using knowingly false and/or fraudulent declarations and representations, with an intent to deceive. Those false/fraudulent declarations were material to the grant and/or renewal of the '933 Registration. Thus, the '933 Registration is invalid.

SEVENTH AFFIRMATIVE DEFENSE

Gentex registered the mark HOMELINK on May 23, 1995 (Registration No. 1,894,865, hereinafter the '865 Registration) in IC009 for "Electrical control system using a remote transmitter comprising trainable transmitters, vehicle interface [sic] modules, lamp modules, switch modules, switch control modules, plug-in lamp modules, and garage door status indicators." The '865 Registration is based upon use dating back to at least as early as May 1994. The '865 Registration is incontestable (Section 15 accepted by the USPTO on January 8, 2001) and predates the use, filings, and registration of all marks asserted by Spectrum in the present Opposition. In addition, Gentex registered the mark HOMELINK on April 6, 2004 (Registration No. 2,829,726, hereinafter the '726 Registration) in IC009 for "Wireless control devices, integrated into vehicles or portable transceivers, for activation of garage door openers, gates, entry door locks, interior and exterior lighting, security systems, heating and cooling systems, filing systems and electrical appliances," and in IC035 for "Customer support services for wireless control devices, integrated into vehicles or portable transceivers, for activation of garage door openers, gates, entry door locks, interior and exterior lighting, security systems, heating and cooling systems, filing systems and electrical appliances." The '726 Registration is also based upon use dating back to at least as early as May, 1994. The '726 Registration is incontestable (Section 15 accepted by the USPTO on August 1, 2009) and predates the use, filings, and registration of all marks asserted by Spectrum in the present Opposition. In addition to Gentex's HOMELINK word marks, Gentex registered its Home Design mark on January 21, 1997 (Registration No. 2,032,716, hereinafter the '716 Registration) in IC009 for "Electrical control system using a remote transmitter comprising trainable transmitters, vehicle interface modules, lamp modules, switch modules, switch control modules, plug-in lamp modules, and garage door status indicators." The '716 Registration is based upon use dating back to at least as early as March 1996. The '716 Registration is incontestable (Section 15 accepted by the USPTO on April 4, 2003) and predates the use, filings, and registration of all marks Spectrum is asserting in the pending opposition. Still further, Gentex registered its Home Design mark on June 15, 2004 (Registration No. 2,853,065, hereinafter the '065 Registration) in IC009 for "Wireless control devices, integrated into vehicles or portable transceivers, for activation of

garage door openers, gates, entry door locks, interior and exterior lighting, security systems heating and cooling systems, filing systems and electrical appliances,” and in IC035 for “Customer support services for wireless control devices, integrated into vehicles or portable transceivers, for activation of garage door openers, gates, entry door locks, interior and exterior lighting, security systems heating and cooling systems, filing systems and electrical appliances.” The ‘065 Registration is based upon use dating back to at least as early as March 1996. The ‘065 Registration is incontestable (Section 15 accepted by the USPTO on August 12, 2009) and predates the use, filings, and registration of all marks Spectrum is asserting in the pending opposition. Gentex’s HOMELINK and Home Design marks are distinctive due to the inherent strength and distinctive nature of the marks. In addition, the marks have become famous within the channels of trade and customers of the HOMELINK products due to the distinctive nature of the marks, widespread advertising, publicity, promotion and sales, and longstanding and extensive use. The HOMELINK and Home Design marks are commonly used together to identify the source of Gentex’s goods. Thus, the present Opposition is barred under the doctrine of laches, estoppel, and/or acquiescence due to Gentex’s use of other marks with the word HOMELINK as used on similar goods and services found in the presently opposed application (U.S. Serial No. 87827534). In addition, these facts illustrate the absence of a likelihood of confusion.

EIGHTH AFFIRMATIVE DEFENSE

Gentex owns a family of HOMELINK marks as evidenced by Gentex’s HOMELINK Registrations referred to above, the HOMELINK CONNECT Application Serial No. 87642836 (the ‘836 Application) for “Computer application software for mobile devices, namely, software for home automation, including controlling, actuating and adjusting settings of garage door openers, gates, entry door locks, interior and exterior lighting, and security systems; Downloadable software programs and applications via the internet and wireless devices; Wireless transmitters and receivers” (IC009), which Opposer did not oppose, and the present Application.

NINTH AFFIRMATIVE DEFENSE

Gentex reserves the right to amend its Answer and Affirmative Defenses to raise and assert any additional affirmative that discovery and Gentex's investigations may reveal.

COUNTERCLAIM

Gentex hereby submits its counterclaim for cancellation of Spectrum's HOME CONNECT and Design mark (U.S. Trademark Registration No. 4,447,933).

1. Gentex hereby incorporates the allegations set forth in the Affirmative Defenses as if fully set forth herein.

2. Gentex hereby incorporates the allegations set forth in the Affirmative Defenses as if fully set forth herein.

3. The trademark application that registered as U.S. Trademark Registration No. 4,447,933 was filed with the USPTO as a use-based application pursuant to 15 U.S.C. § 1051(a) on June 3, 2013. The trademark application referenced above received the Serial No. 85948,834 (hereinafter the '834 Application) and claimed a date of first use "[a]t least as early as 10/00/2009."

4. In connection with the '834 Application, the then applicant, Kwikset Corporation (Spectrum's alleged predecessor in interest), submitted a sworn declaration to the USPTO, wherein Kwikset Corporation's Assistant Secretary & Chief Intellectual Property, Thomas M. Parker, swore "he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true."

5. The '834 Application was filed 19 years after Gentex began use of its HOMELINK marks, and 17 years after Gentex began using its Home Design mark. As such, at the time of making the declaration noted above, Spectrum and/or its predecessor in interest knew or should have known about the marks owned and in use by Gentex.

6. On February 6, 2019, Spectrum filed a Combined Declaration of Use and Incontestability under Sections 8 and 15, failing to acknowledge the fact that it had filed an extension to oppose the Application or that it had raised a likelihood of confusion with Applicant's family of HOMELINK marks.

7. Upon information and belief, Spectrum and/or its predecessor in interest made the representations to the USPTO about the right to use the HOME CONNECT and Design mark in commerce with the intent to deceive the USPTO.

8. Spectrum and/or its predecessor in interest thus procured U.S. Trademark Registration No. 4,447,933 by false means and/or by knowingly making false and/or fraudulent declarations and representations to the USPTO.

9. Because of Spectrum's and/or its predecessor in interest's knowingly false and/or fraudulent declarations and representations, Spectrum and/or its predecessor in interest committed fraud on the USPTO in procuring U.S. Trademark Registration No. 4,447,933.

10. Spectrum's U.S. Trademark Registration No. 4,447,933 was obtained contrary to the provisions of 15 U.S.C. § 1052 and should be canceled pursuant to 15 U.S.C. § 1064.

11. Spectrum's HOME CONNECT mark is likely to be confused with Gentex's prior registrations of HOMELINK, as evidenced by the facts set forth above and Opposer's own likelihood of confusion arguments.

12. Spectrum's U.S. Trademark Registration No. 4,447,933 was obtained contrary to the provisions of 15 U.S.C. § 1052(d) and should be canceled pursuant to 15 U.S.C. § 1064.

13. In light of Spectrum's reliance on its purported rights in U.S. Trademark Registration No. 4,447,933 to support its claims against Gentex in this action, Gentex reasonably believes that it has been or will be damaged by the continued registration of the alleged mark found in U.S. Trademark Registration No. 4,447,933.

14. Gentex is thus entitled to cancellation of U.S. Trademark Registration No. 4,447,933.

WHEREFORE, Gentex denies that Spectrum is entitled to the relief prayed for in its Opposition and further prays that this Opposition be dismissed with prejudice and that Gentex's HOMELINK CONNECT mark be registered. In addition, Gentex requests that its counterclaim for cancellation be granted and that Registration No. 4,447,933 be canceled.

Respectfully submitted,

Dated: March 8, 2019

/Matthew J. Gipson/

Matthew J. Gipson, Reg. 45631
mgipson@priceheneveld.com
Aaron J. Wong, Reg. 61871
awong@priceheneveld.com
PRICE HENEVELD LLP
695 Kenmoor, S.E. | P.O. Box 2567
Grand Rapids, MI 49501 | 616.949.9610
Attorneys for Gentex Corporation.