

ESTTA Tracking number: **ESTTA1109242**

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

Proceeding	91266553
Party	Defendant E & K Companies, Inc.
Correspondence Address	DANIEL J. WATERS 10306 REGENCY PARKWAY DRIVE OMAHA, NE 68114 UNITED STATES Primary Email: dwaters@ldmlaw.com No phone number provided.
Submission	Answer
Filer's Name	David J. Schmitt
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Signature	/David J. Schmitt/
Date	01/21/2021
Attachments	2021-01-21 applicant answer to opposition.pdf(92148 bytes)

6. Admits Opposer attached what it identified as a printout on December 16, 2020 from the USPTO's TSDR database for US Registration Number 3130069; denies the remaining allegations in paragraph 6.

7. Denies the allegations in paragraph 7.

8. Denies the allegations in paragraph 8.

9. Denies the allegations in paragraph 9.

10. Denies the allegations in paragraph 10.

11. Denies the allegations in paragraph 11.

COUNT I
LIKELIHOOD OF CONFUSION
(15 U.S.C. § 1052(D))

12. E & K realleges and incorporates its responses to paragraph 1 through 11 as if fully set forth herein.

13. Denies the allegations in paragraph 13.

14. Denies the allegations in paragraph 14.

15. E & K denies each and every other allegation in the Consolidated Notice of Opposition, except to the extent specifically admitted and those allegations which may constitute admissions against the interests of Opposer.

16. Further affirmatively answering, E & K Companies, Inc. has been in existence since 1956. E & K delivers the highest quality services and it is currently one of the largest union interior and exterior finish contractors in the United States. E & K has developed significant goodwill and consumer acceptance of its services. Applicant's use of "E & K", which is the mark that is the subject of the Application, is the name by which Applicant is commonly referenced and identified by the public. Applicant's widespread usage of the mark

“E & K” has caused it to acquire distinctiveness with respect to Applicant, and has caused the mark to become a valuable asset of Applicant.

17. Further affirmatively answering, E & K’s mark “E & K” is sufficiently different than Opposer’s alleged mark “E K”. E & K’s mark uses two letters and a third character, whereas Opposer’s alleged mark simply uses two generic letters. As such, there is no likelihood of confusion, mistake or deception.

18. Further affirmatively answering, E & K identified its marks in the Applications as International Class 037 as follows:

Building construction services, namely, installation of interior drywall systems, ceiling systems, and interior building construction, the aforesaid not to include installation, repair and maintenance of heating and air conditioning equipment.

Id. To the contrary, Opposer identified its alleged mark in its description as International Class 006, International Class 020, and International Class 040. Opposer’s alleged mark primarily relates to the manufacture of parts, whereas E & K’s marks primarily relate to building construction services. As such, they are sufficiently dissimilar and there is no likelihood of confusion, mistake or deception.

AFFIRMATIVE DEFENSES

19. The Consolidated Notice of Opposition fails to state a claim upon which relief can be granted.

20. There is no likelihood of confusion, mistake, or deception between Opposer’s alleged mark and Applicant’s marks.

21. As a result of Applicant’s continuous use of “E & K” since 1956, which is the subject of the Application, it has developed consumer recognition, significant goodwill among the consuming public, and consumer acceptance of the services offered by Applicant in conjunction with its use. Such goodwill and widespread usage has caused E & K to acquire

distinctiveness with respect to Applicant, and has caused it to become a valuable asset of Applicant.

22. Applicant's continuous use of "E & K" since 1956 has been open, notorious and known to Opposer. During this time Opposer failed to take meaningful action to assert the claims on which it bases this opposition, on which inaction Applicant has relied to its detriment. Opposer's claims are consequently barred by the doctrine of estoppel.

23. Opposer's claims are barred by the doctrine of laches.

24. Opposer's claims are barred by the doctrine of acquiescence.

25. As a result of its own acts and omission, Opposer's claims are barred by the doctrine of waiver.

24. Any and all acts alleged to have been committed by E & K were performed with lack of knowledge and lack of willful intent.

WHEREFORE, E & K Companies, Inc. requests that the Consolidated Notice of Opposition be dismissed with prejudice along with such further relief as the Board may deem appropriate.

E & K COMPANIES, INC., Applicant

By: s/ David J. Schmitt

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ATTORNEYS FOR APPLICANT

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Answer and Affirmative Defenses has been served on Larry H. Trunco and Lauren C. Concepcion by forwarding said copy on January 21, 2021, via e-mail to:

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