

ESTTA Tracking number: **ESTTA1179760**

Filing date: **12/20/2021**

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

Proceeding no.	91269337
Party	Defendant Wheeler Fleet Solutions, Co.
Correspondence address	AMY (SALOMON) MCFARLAND 1717 K STREET, NW WASHINGTON, DC 20006 UNITED STATES Primary email: tmdocket@arentfox.com Secondary email(s): amy.mcfarland@arentfox.com, thorne.maginnis@arentfox.com, natasha.farah@arentfox.com 202-857-6000
Submission	Answer
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Signature	/Thorne Maginnis/
Date	12/20/2021
Attachments	91269337 Opp Answer.pdf(271072 bytes)

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

6. Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations contained in Paragraph 6 of the Notice of Opposition, and therefore denies the allegations.

7. Applicant admits the allegations contained in Paragraph 7 of the Notice of Opposition.

8. Applicant denies the allegations contained in Paragraph 8 of the Notice of Opposition.

9. Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations contained in Paragraph 9 of the Notice of Opposition, and therefore denies the allegations.

10. Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations contained in Paragraph 10 of the Notice of Opposition, and therefore denies the allegations.

11. Applicant admits the allegations contained in Paragraph 11 of the Notice of Opposition.

12. Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations contained in Paragraph 12 of the Notice of Opposition, and therefore denies the allegations.

13. Applicant denies the allegations contained in Paragraph 13 of the Notice of Opposition.

14. Applicant denies the allegations contained in Paragraph 14 of the Notice of Opposition.

15. Applicant denies the allegations contained in Paragraph 15 of the Notice of Opposition. Moreover, Opposer and Applicant operate in different industries and offer different goods and services. Specifically, Opposer claims to offer goods and services for heavy industrial jobs in fields such as construction, agriculture, mining, and oil and gas. By contrast, as recited in Applicant's description of services, Applicant operates in the automotive and trucking industry, distributing parts and supplies for vehicles involved in the movement of goods. The Notice of Opposition lists dozens of types of equipment to allege the goods sold by Opposer, *see* goods described as "Wheeler Fleets" in Paragraph 10 of the Notice of Opposition, none of which are offered by Applicant.

16. Applicant denies the allegations contained in Paragraph 16 of the Notice of Opposition. Moreover, in addition to the significant differences in the parties' goods and services, Opposer and Applicant likewise target different classes of purchasers and their goods and services are advertised and travel in different channels of trade. In particular, the goods and services that Opposer claims to offer are purchased by companies that handle heavy industrial jobs, whereas Applicant serves customers primarily concerned with the transportation and sale of goods. Applicant's customers are not likely to be customers of Opposer, and *vice versa*. Consequently, the possibility of a purchaser mistakenly believing that the parties' goods and services emanate from the same source is purely theoretical and extremely remote.

17. Applicant denies the allegations contained in Paragraph 17 of the Notice of Opposition.

18. Applicant denies the allegations contained in Paragraph 18 of the Notice of Opposition.

19. Applicant denies the allegations contained in Paragraph 19 of the Notice of Opposition.

20. Applicant denies the allegations contained in Paragraph 20 of the Notice of Opposition.

Applicant otherwise denies each and every allegation contained in the Notice of Opposition that is not specifically and expressly admitted herein.

AFFIRMATIVE DEFENSES

Applicant hereby states the following for its Affirmative Defenses:

1. Opposer's Notice of Opposition fails to state a claim upon which relief can be granted.

2. There is no likelihood of confusion between Opposer's alleged marks and Applicant's mark in view of, *inter alia*, the overall differences between Opposer's alleged marks and goods and services and Applicant's mark and services. First, Opposer's alleged mark and Applicant's mark have notable visual and aural differences, resulting in different commercial impressions. Moreover, Opposer and Applicant operate in different industries and offer different goods and services. Specifically, Opposer claims to offer goods and services for heavy industrial jobs in fields such as construction, agriculture, mining, and oil and gas. By contrast, as recited in Applicant's description of services, Applicant operates in the automotive and trucking industry, distributing parts and supplies for vehicles involved in the movement of goods. The Notice of Opposition lists dozens of types of equipment to allege the goods sold by Opposer, *see* goods described as "Wheeler Fleets" in Paragraph 10 of the Notice of Opposition, none of which are

offered by Applicant. In addition to the significant differences in the parties' goods and services, Opposer and Applicant likewise target different classes of purchasers and their goods and services are advertised and travel in different channels of trade. In particular, the goods and services that Opposer claims to offer are purchased by companies that handle heavy industrial jobs, whereas Applicant serves customers primarily concerned with the transportation and sale of goods. Applicant's customers are not likely to be customers of Opposer, and *vice versa*. Consequently, the possibility of a purchaser mistakenly believing that the parties' goods and services emanate from the same source is purely theoretical and extremely remote.

3. Opposer will not be damaged by the registration of Applicant's mark.

4. Opposer's Notice of Opposition is barred by one or more of the doctrines of estoppel, laches, unclean hands, waiver, acquiescence, and the *Morehouse* doctrine. For example, Applicant has been using marks containing "WHEELER" in United States commerce since 1960, without any objection from Opposer or any evidence of actual consumer confusion. In addition, Applicant owns a prior registration for a mark containing the term WHEELER, namely, incontestable Registration No. 3267054 for the mark WHEELER BROS., INC. (Stylized) for "Distributorship services for automotive, truck, heavy equipment and industrial parts and supplies" in Class 35, issued on July 24, 2007. Opposer has never objected to, opposed, or petitioned to cancel Applicant's registration of the foregoing mark. The services listed in Applicant's prior registration for WHEELER BROS., INC. (Stylized) are identical to the services listed in the currently opposed application for WHEELER FLEET SOLUTIONS, namely, "Distributorship services for automotive, truck, heavy equipment and industrial parts and supplies." In addition, the marks in Applicant's prior registration and the currently opposed

application both contain the term “WHEELER,” while disclaiming all other wording in the marks.

5. Applicant reserves the right to amend its answer and to assert additional defenses and/or supplement, alter or change its answer and defenses upon the discovery of more definitive facts and upon the completion of a continuing investigation and discovery.

WHEREFORE, Applicant prays that the Notice of Opposition be dismissed with prejudice.

Dated: December 20, 2021

WHEELER FLEET SOLUTIONS

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CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing ANSWER TO NOTICE OF OPPOSITION (re Opposition No. 91269337) has been served on Opposer's counsel via email at the following address: tzenger@durenip.com.

/Ross Panko/
Ross Q. Panko