

TTAB

CUMMINGS & LOCKWOOD LLC



09-26-2002

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #77

September 26, 2002

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BOX TTAB
FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

**Re: Power Tool Specialists, Inc. v. IXL Manufacturing Co.
Petition to Cancel Registration No. 2,296,733
TRADESMAN
Our Ref.: 731117.0001 PTSI-124**

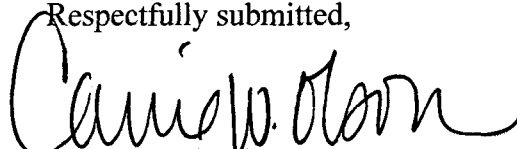
Dear Madam:

We enclose herewith for filing one original and copy of the Petition to Cancel and Certificate of Express Mailing for the above-captioned cancellation proceeding.

Please charge the \$300.00 Petition fee to our Deposit Account No. 11-0231.

Kindly indicate your receipt of this document by applying your date stamp to the enclosed postage-prepaid postcard and drop it in the mail to us.

Respectfully submitted,


Carrie Webb Olson

CWO:cl
Enclosures

cc: Mr. Anthony J. Borgatti
Ms. Judi Bryskiewicz
Mark D. Giarratana, Esq.

.StmLib1:975281.1 09/26/02

PTS-124

TRADEMARK

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

In the matter of Trademark Registration No.: 2,296,733
For the Mark: TRADESMAN
Date of Registration: November 30, 1999



09-26-2002

U.S. Patent & TMO/TM Mail Ropt Dt. #77

-----	X	
Power Tool Specialists, Inc.	:	
Petitioner,	:	
	:	Cancellation No.:
v.	:	
	:	
IXL Manufacturing Company, Inc.,	:	
Registrant.	:	
-----	X	

11/01/2002 KGIBBONS 00000086 110231 2296733

01 FC:6401 300.00 CH

PETITION TO CANCEL

Petitioner, Power Tool Specialists, Inc., a Massachusetts corporation, having its principal place of business at 3 Craftsman Road, East Windsor, Connecticut 06088, believes that it is being damaged by Registration No. 2,296,733 of IXL Manufacturing Company, Inc., which according to official PTO records, is a Missouri corporation, located at 522 South Walnut Street P.O. Box 700, Bernie, Missouri 63822 ("Registrant"), and hereby petitions to cancel same.

The grounds for cancellation are as follows:

1. Petitioner is the owner of U.S. Trademark Registration Nos. 1,565,504 and 2,205,373 on the Principal Register for TRADESMAN covering (see Exhibit A, attached hereto):

"Stationary/bench electric power tools, namely; table saws, floor drill presses, miter saws, floor band saws, floor jointers and parts therefor," in International Class 7; and

“Power tools, namely, nailers, sanders, lathes, saws, mortising machines, drill presses, shapers, planers, grinders, jointers, dust collectors, and parts and accessories therefor, including chucks, blades, bits, chisels, knives, discs, drums, wheels, belts, sleeves, abrasive attachments, arbors, dados, moulding inserts, hex keys, brackets, plates, vises, jaws, clamps, gauges, rip fences, guides, extensions, jigs, blocks, work supports, rollers, stands, casters, tables, tool collectors, dust chutes, vacuum attachments, control switches, cleaners, chuck adapters, and push blocks,” in International Class 7.

2. Petitioner is the owner of U.S. Trademark Application Serial Nos. 78/104,874 and 78/131,558 on the Principal Register for TRADESMAN covering (see Exhibit B, attached hereto):

“Hand-held electric, cordless, and pneumatic power tools, namely, drill, single speed drill, variable speed drill, driver, drill/driver, screw driver, grinder, angle grinder, hammer, hammer drill, nailer, nailing gun, brad nailer, brad nailer-stapler, angle finish nailer, roofing coil nailer, finish nailer, framing nailer, sander, orbit sander, random orbit sander, palm grip sander, sheet finishing sander, saw, circular saw, reciprocating saw, stapler, crown stapler, and staple gun, and parts and accessories therefor, namely, air compressors, rechargeable batteries, battery charges, power packs and chargers therefor, bits blades, chucks, drivers, hammers, nails, staples, grinding wheels, abrasive attachments, abrasive belts and abrasive discs,” in International Class 7; and

“Door openers, remote controls for door openers, control consoles for door openers, sensor for door openers, keyless entry systems for door openers, and parts and accessories for the foregoing,” in International Class 9.

3. Petitioner manufactures and markets in the United States numerous tools and related hardware products using the trademark TRADESMAN on or in connection with these products. Petitioner has spent substantial sums in commercializing and otherwise promoting its TRADESMAN products throughout the United States. As a result of the expenditure of considerable sums and efforts in connection with such activities, and by virtue of the excellence of its products, petitioner has garnered a valuable reputation for its TRADESMAN products.

4. Petitioner commenced use of its TRADESMAN mark in connection with the goods in Registration No. 2,205,373 at least as early as February 1987.

5. Petitioner commenced use of its TRADESMAN mark in connection with the goods in Registration No. 1,565,504 at least as early as February 1987.

6. Registrant obtained Registration No. 2,296,733 for TRADESMAN covering "replacement handles for heavy and light striking hand tools for industrial use," on November 30, 1999.

7. Registrant asserts that it commenced use of TRADESMAN in connection with the goods in Registration No. 2,296,733 on September 22, 1998.

8. Petitioner's use of TRADESMAN predates Registrant's alleged use of TRADESMAN, and therefore, Petition has priority vis-à-vis Registrant's alleged use.

9. Upon information and belief, Registrant's TRADESMAN mark has been abandoned, rendering the registration void.

10. Petitioner is likely to be damaged by the continued existence of Registration No. 2,296,733. Petitioner has continuously used its TRADESMAN mark in U.S. commerce since at least as early as February 1987, while the Registrant's mark is not in use in commerce. The assertion of a registration covering an abandoned mark is a cloud on Petitioner's legal right and ability to further expand its use and to register its mark TRADESMAN. Such registration would thus be a source of damage and injury to petitioner.

A duplicate of this petition is enclosed herewith.

The statutory fee of \$300 as prescribed in Rule 2.6(a)(16) should be charged to Deposit Account No. 11-0231.

WHEREFORE, Petitioner prays that this Petition to Cancel be sustained in favor of Petitioner, and that Registration No. 2,296,733 be cancelled.

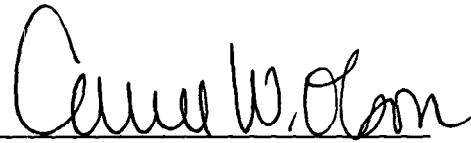
Respectfully submitted:

Power Tool Specialists, Inc.

Dated: _____

9/26/02

By: _____



Mark D. Giarratana
Carrie Webb Olson
Attorneys for Petitioner
Cummings & Lockwood
700 State Street
New Haven, CT 06511
203-351-4176
colson@cl-law.com

CERTIFICATE OF EXPRESS MAILING

I hereby certify that this Petition to Cancel is being deposited with the United States Postal Service as Express Mail (EL872983098US) addressed to the Commissioner for Trademarks, BOX TTAB/FEE, 2900 Crystal Drive, South Tower, Arlington, Virginia 22202-3513 on this 26th day of September, 2002.



Christina M. London

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 09/26/2002 16:24:46 ET

Serial Number: 73774976

Registration Number: 1565504

Mark (words only): TRADESMAN

Current Status: Registered.

Date of Status: 2000-04-24

Filing Date: 1989-01-17

Registration Date: 1989-11-14

Law Office Assigned: TMEO Law Office # 8

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2002-07-31

CURRENT APPLICANT(S)/OWNER(S)

1. POWER TOOL SPECIALISTS, INC.

Address:

POWER TOOL SPECIALISTS, INC.

3 CRAFTSMAN ROAD

EAST WINDSOR, CT 06088

United States

State or Country of Incorporation: Massachusetts

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

STATIONARY/BENCH ELECTRIC POWER TOOLS, NAMELY; TABLE SAWS, FLOOR DRILL PRESSES, MITER SAWS, FLOOR BAND SAWS, FLOOR JOINTERS AND PARTS THEREFOR

International Class: 007

First Use Date: 19870200

First Use in Commerce Date: 19870200

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2002-07-30 - Cancellation terminated for Proceeding
2002-07-30 - Cancellation dismissed for Proceeding
2000-04-24 - Cancellation instituted for Proceeding
2000-04-24 - Cancellation instituted for Proceeding
1996-08-30 - Section 8 (6-year) accepted & Section 15 acknowledged
1996-06-27 - Section 7 correction issued
1995-12-11 - Response received for Post Registration action
1995-12-11 - Section 7 amendment filed
1995-08-24 - Post Registration action mailed Section 8 & 15
1994-12-22 - Section 8 (6-year) and Section 15 Filed
1989-11-14 - Registered - Principal Register
1989-08-22 - Published for opposition
1989-07-22 - Notice of publication
1989-06-06 - Approved for Pub - Principal Register (Initial exam)
1989-06-01 - Examiner's amendment mailed
1989-03-27 - Communication received from applicant
1989-03-15 - Non-final action mailed

CONTACT INFORMATION

Correspondent (Owner)

JOHN J. DEMPSEY (Attorney of record)

MARK D. GIARRATANA
CUMMINGS & LOCKWOOD
GRANITE SQUARE
700 STATE STREET, P.O. BOX 1960
NEW HAVEN, CT 06509-1960
United States

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 09/26/2002 16:24:59 ET

Serial Number: 75345996

Registration Number: 2205373

Mark (words only): TRADESMAN

Current Status: Registered.

Date of Status: 2000-04-24

Filing Date: 1997-08-25

Registration Date: 1998-11-24

Law Office Assigned: TMEG Law Office 107

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2002-08-01

CURRENT APPLICANT(S)/OWNER(S)

1. Power Tool Specialists, Inc.

Address:

Power Tool Specialists, Inc.
3 Craftsman Road
East Windsor, CT 06088
United States

State or Country of Incorporation: Massachusetts

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

power tools, namely, nailers, sanders, lathes, saws, mortising machines, drill presses, shapers, planers, grinders, jointers, dust collectors, and parts and accessories therefor, including chucks, blades, bits, chisels, knives, discs, drums, wheels, belts, sleeves, abrasive attachments, arbors, dados, moulding inserts, hex keys, brackets, plates, vises, jaws, clamps, guages, rip fences, guides, extensions, jigs, blocks, work supports, rollers, stands, casters, tables, tool collectors, dust chutes, vacuum attachments, control switches, cleaners, chuck adaptors, and push blocks

International Class: 007

First Use Date: 19870201

First Use in Commerce Date: 19870201

Basis: 1(a)

ADDITIONAL INFORMATION

Prior Registration Number(s):

1565504

PROSECUTION HISTORY

-
- 2002-07-30 - Cancellation terminated for Proceeding
 - 2002-07-30 - Cancellation dismissed for Proceeding
 - 2000-04-24 - Cancellation instituted for Proceeding
 - 1998-11-24 - Registered - Principal Register
 - 1998-09-01 - Published for opposition
 - 1998-07-31 - Notice of publication
 - 1998-06-07 - Approved for Pub - Principal Register (Initial exam)
 - 1998-06-03 - Case file assigned to examining attorney
 - 1998-05-18 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

MARK D GIARRATANA (Attorney of record)

MARK D GIARRATANA
MCCORMICK PAULDING & HUBER LLP
CITYPLACE II
185 ASYLUM ST
HARTFORD CT 06103-4102
United States

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 09/26/2002 16:25:20 ET

Serial Number: 78104874

Registration Number: (NOT AVAILABLE)

Mark (words only): TRADESMAN

Current Status: A non-final action has been mailed. This is a letter from the examining attorney requesting additional information and/or making an initial refusal. However, no final determination as to the registrability of the mark has been made.

Date of Status: 2002-07-30

Filing Date: 2002-01-25

Registration Date: (DATE NOT AVAILABLE)

Law Office Assigned: TMEG Law Office 104

Attorney Assigned: YARD JOHN S Employee Location

Current Location: L4D -TMEG Law Office 104 - Docket Clerk

Date In Location: 2002-07-31

CURRENT APPLICANT(S)/OWNER(S)

1. Power Tool Specialists, Inc.

Address:

Power Tool Specialists, Inc.
3 Craftsman Road
East Windsor, CT 06088
United States

State or Country of Incorporation: Massachusetts

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

Hand-held electric, cordless, and pneumatic power tools, namely, drill, single speed drill, variable speed drill, driver, drill/driver, screw driver, grinder, angle grinder, hammer, hammer drill, nailer, nailing gun, brad nailer, brad nailer-stapler, angle finish nailer, roofing coil nailer, finish nailer, framing nailer, sander, orbit sander, random orbit sander, palm grip sander, sheet finishing sander, saw, circular saw, reciprocating saw, stapler, crown stapler, and staple gun, and parts and accessories therefor, namely, air compressors, rechargeable batteries, battery chargers, power packs and chargers therefor, bits, blades, chucks, drivers, hammers, nails, staples, grinding wheels, abrasive attachments, abrasive belts and abrasive discs.

International Class: 007

First Use Date:

First Use in Commerce Date:

Basis: 1(b)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2002-07-30 - Non-final action mailed

2002-07-18 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

Mark D. Giarratana, Esq. (Attorney of record)

MARK D. GIARRATANA, ESQ.
CUMMINGS & LOCKWOOD, LLC
700 STATE STREET, P.O. BOX 1960
NEW HAVEN CT 06509-1960
United States

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 09/26/2002 16:25:47 ET

Serial Number: 78131558

Registration Number: (NOT AVAILABLE)

Mark (words only): TRADESMAN

Current Status: New application assigned to an examining attorney for examination

Date of Status: 2002-09-20

Filing Date: 2002-05-28

Registration Date: (DATE NOT AVAILABLE)

Law Office Assigned: TMO Law Office 112

Attorney Assigned: POWELL STEVEN B Employee Location

Current Location: M30 -TMO Law Office 112

Date In Location: 2002-09-20

CURRENT APPLICANT(S)/OWNER(S)

1. Power Tool Specialists, Inc.

Address:

Power Tool Specialists, Inc.

3 Craftsman Road

East Windsor, CT 06088

United States

State or Country of Incorporation: Massachusetts

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

Door openers, remote controls for door openers, control consoles for door openers, sensors for door openers, keyless entry systems for door openers, and parts and accessories for the foregoing

International Class: 009

First Use Date:

First Use in Commerce Date:

Basis: 1(b)

ADDITIONAL INFORMATION

Prior Registration Number(s):

78

104874

1565504

2205373

PROSECUTION HISTORY

2002-09-20 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

Mark D. Giarratana, Esq. (Attorney of record)

MARK D. GIARRATANA, ESQ.
CUMMINGS & LOCKWOOD, LLC
700 STATE STREET, P.O. BOX 1960
NEW HAVEN CT 06509-1960
United States
