

7203-83708

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

In the matter of Trademark Registration No. 2,205,373
Trademark: TRADESMAN

WMH TOOL GROUP, INC.,

PETITIONER,

v.

POWER TOOL SPECIALISTS, INC.,

REGISTRANT.

) I hereby certify that this paper is being deposited with the
) United States Postal Service as first class mail in an envelope
) addressed to:

) Commissioner for Trademarks
) P.O. Box 1451
) Arlington, Virginia 22313-1451

) on this date.

) 11/17/04
) Date

Edward E. Chen
Attorney for Opposer

) CANCELLATION No.:

PETITION FOR CANCELLATION

Petitioner, WMH Tool Group, Inc., ("WMH Tool") located at 2420 Vantage Drive, Elgin, Illinois 60123 believes that it is or will be damaged by Registration No. 2,205,373 of the mark TRADESMAN for "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" and hereby petitions to cancel the same. The grounds for cancellation are as follows:

1. On information and belief, Power Tool Specialists, Inc., (hereinafter, "Registrant"), located at 3 Craftsman Road, East Windsor, Connecticut, 06088, presently owns Registration 2,205,373 for the mark TRADESMAN, which specifies use of the mark in commerce on the goods "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."

2. On information and belief, Registrant filed its application for Registration No. 2,205,373 for the mark TRADESMAN on August 25, 1997, and the Patent and Trademark Office issued Registration 2,205,373 on the Principal Register November 24, 1998.

3. On information and belief, in its Application for Registration No. 2,205,373, Registrant filed a sworn statement in which it claimed first use dates for the mark TRADESMAN anywhere and in commerce on all of the specified goods as early as February 1, 1987.

4. On information and belief, on August 10, 2004, Registrant filed submissions with the Patent and Trademark Office under Section 8 and Section 15 of the Trademark Act to maintain Registration No. 2,205,373.

5. On information and belief, in its submission under Section 8 and Section 15 to maintain Registration No. 2,205,373, Registrant filed a sworn statement in which it claimed continuing use of the mark TRADESMAN in commerce on all of the goods specified in Registration No. 2,205,373.

6. Petitioner has used the term "tradesman" in connection with its goods, namely, tools since at least 1954, and has acquired rights in the term "tradesman" continuing from a date prior to the dates set forth in Registration No. 2,205,373.

7. Registrant is using Registration No. 2,205,373 to enforce its alleged rights in the designation TRADESMAN against Petitioner.

8. In enforcing its alleged rights, Registrant has not provided evidence purporting to show use of the mark TRADESMAN on each of the goods specified in Registration No. 2,205,373, but rather only has presented evidence, which at best purports to show use of the mark on power saws at the time that the application for Registration No. 2,205,373 was filed.

COUNT I - FRAUD ON THE OFFICE

9. Petitioner realleges and incorporates herein the allegations of paragraphs 1-8, inclusive.

10. On information and belief, at the time Registrant filed its application for Registration No. 2,205,373, Registrant was not using the mark TRADESMAN on each of the goods specified in Registration No. 2,205,373, with the possible exception of power saws.

11. At the time Registrant filed its application for Registration No. 2,205,373, Registrant knew, should have known, or had reason to believe that it had never used the mark TRADESMAN on each of the goods specified in its application, with the possible exception of power saws, and that the claim of use was false.

12. On information and belief, the false claim of use of the mark was a material fact reasonably relied upon by the Patent and Trademark Office and intended by Registrant to induce the Patent and Trademark Office to issue Registration No. 2,205,373.

13. On information and belief, by reason of Registrant's fraud on the Patent and Trademark Office, Registration No. 2,205,373 was issued, and has and is causing damage to Petitioner.

14. On information and belief, at the time Registrant filed its submissions under Section 8 and Section 15 to maintain Registration No. 2,205,373, Registrant was not using the mark TRADESMAN on each of the goods specified in Registration No. 2,205,373.

15. On information and belief, at the time Registrant filed its submissions under Section 8 and Section 15 to maintain Registration No. 2,205,373, Registrant knew, should have known, or had reason to believe that it had never used the mark TRADESMAN on each of the goods specified in Registration No. 2,205,373, and that the declaration of continuing use was a false claim.

16. On information and belief, the false claim of continuing use of the mark was a material fact reasonably relied upon by the Patent and Trademark Office and intended by Registrant to induce the Patent and Trademark Office to maintain Registration No. 2,205,373.

17. On information and belief, by reason of Registrant's fraud on the Patent and Trademark Office, Registration No. 2,205,373 was maintained, and has and is causing damage to the Petitioner.

COUNT II - FRAUD ON THE OFFICE

18. Petitioner realleges and incorporates herein the allegations of paragraphs 1-17 inclusive.

19. On information and belief, Registrant is a related company of, a subsidiary of, or otherwise associated with REXON Industrial Corporation, Ltd.

20. On information and belief, during a period prior to Registrant's use or adoption of the designation TRADESMAN, and certainly well before the filing date of its application, which resulted in the issuance of Registration No. 2,205,373 or other registration, Petitioner had communications

and placed orders for tools with Raxon Industrial Corporation, Ltd. in which Petitioner's use of the term "Tradesman" in commerce was disclosed and became known to Registrant.

21. On information and belief, at the time Registrant filed its application for Registration No. 2,205,373, Registrant submitted a sworn statement that to the best of his knowledge and belief no other person, firm, corporation, or association has the right to use said mark in commerce, either in identical form or in such near resemblance thereto as may be likely, when applied to the goods of such other corporation, to cause confusion or to cause mistake, or to deceive, or like sworn statement.

22. On information and belief, at the time Registrant filed its application for Registration No. 2,205,373, Registrant knew, should have known, or had reason to believe that its sworn statement was a material false statement upon which the Patent and Trademark Office would reasonably rely, and Registrant made the false statement with the intent to induce the Patent and Trademark Office to issue Registration No. 2,205,373.

23. On information and belief, by reason of Registrant's bad faith in the adoption of the designation TRADESMAN and fraud on the Patent and Trademark Office, Registration No. 2,205,373 was issued and maintained, and has and is causing damage to the Petitioner.

COUNT III - FRAUD ON THE OFFICE

24. Petitioner realleges and incorporates herein the allegations of paragraphs 1-23, inclusive.

25. On information and belief, in its Application for Registration No. 2,205,373, Registrant claimed ownership of Registration No. 1,565,504 as a prior registration for the mark TRADESMAN specifying the goods "stationary/bench electric power tools, namely; table saws, floor drill presses, miter saws, floor band saws, floor jointers and parts therefor."

26. On information and belief, Registrant filed its application for Registration No. 1,565,504 for the mark TRADESMAN on January 17, 1989, and the Patent and Trademark Office issued Registration 1,565,504 on the Principal Register November 14, 1989.

27. In its Application for Registration No. 1,565,504, Registrant claimed first use dates for the mark TRADESMAN anywhere and in commerce on the specified goods as early as February 1987.

28. The Patent and Trademark Office initially refused to register Registration No. 1,565,504 based on likelihood of confusion with Registration Nos. 1,460,651 and 1,262,851.

29. In response to this initial refusal, in a letter to the Patent and Trademark Office dated March 23, 1989, Registrant submitted evidence claiming use of its mark as early as a time around March 23, 1981.

30. The Patent and Trademark Office thereafter withdrew its initial refusal and allowed the application for Registration No. 1,565,504 to proceed to registration.

31. Petitioner has used the term "tradesman" in connection with its goods, namely, tools since at least 1954, and has acquired rights in the term "tradesman" continuing from a date prior to the date of Registration No. 1,565,504.

32. Registrant is using Registration No. 1,565,504 to enforce its alleged rights in the designation TRADESMAN against Petitioner.

33. In enforcing its alleged rights, Registrant has not alleged or offered any evidence, despite Petitioner's repeated requests, purporting to show use of the mark TRADESMAN on the specified goods earlier than 1986, which date is substantially later than the claim of use submitted to the Patent and Trademark Office in the letter of March 23, 1989.

34. In enforcing its alleged rights, Registrant has provided Petitioner with scant evidence supporting use of its mark prior to filing the application for Registration No. 1,565,504, and has not

alleged or offered any evidence, purporting to show use of the mark TRADESMAN on the goods specified in Registration No. 1,565,504, with the possible exception of power saws, at any time prior to the filing date of the application for Registration No. 1,565,504.

35. On information and belief, at the time Registrant submitted the letter dated March 23, 1989 to the Patent and Trademark Office, Registrant knew, should have known, or had reason to believe that it had not started to use the designation TRADESMAN on the goods specified in Registration No. 1,565,504 at a time around March 23, 1981, and that the statement was false.

36. On information and belief, the false claim of use of the mark was a material fact reasonably relied upon by the Patent and Trademark Office and intended by the Registrant to induce the Patent and Trademark Office to issue Registration No. 1,565,504.

37. On information and belief, at the time Registrant filed its application for Registration No. 1,565,504, Registrant was not using the mark TRADESMAN on each of the goods specified in Registration No. 1,565,504, with the possible exception of power saws.

38. At the time Registrant filed its application for Registration No. 1,565,504, it knew, should have known, or had reason to believe that it had never used the mark TRADESMAN on each of the goods specified in its application, with the possible exception of power saws.

39. On information and belief, the false claim of use of the mark was a material fact reasonably relied upon by the Patent and Trademark Office and intended by Registrant to induce the Patent and Trademark Office to issue Registration No. 1,565,504.

40. On information and belief, during a period prior to Registrant's use or adoption of the designation TRADESMAN, and certainly well before the filing date of its application, which resulted in the issuance of Registration No. 1,565,504, Petitioner had communications and placed orders for tools with Rexon Industrial Corporation, Ltd. in which Petitioner's use of the term "Tradesman" in commerce was disclosed and became known to the Registrant.

41. On information and belief, at the time Registrant filed its application for Registration No. 1,565,504, Registrant submitted a sworn statement that "to the best of his knowledge and belief no other person, firm, corporation, or association has the right to use said mark in commerce, either in identical form or in such near resemblance thereto as may be likely, when applied to the goods of such other corporation, to cause confusion or to cause mistake, or to deceive".

42. On information and belief, at the time Registrant filed its application for Registration No. 1,565,504, Registrant knew, should have known, or had reason to believe that its sworn statement was a material false statement upon which the Patent and Trademark Office would reasonably rely, and Registrant made the false statement with the intent to induce the Patent and Trademark Office to issue Registration No. 1,565,504.

43. On information and belief, by reason of Registrant's bad faith in the adoption of the designation TRADESMAN and fraud on the Patent and Trademark Office, Registration No. 1,565,504 was issued and maintained, and has and is causing damage to Petitioner.

44. On information and belief, at the time Registrant filed its application for Registration No. 2,205,373, Registrant knew, should have known, or had reason to believe that Registration No. 1,565,504 was obtained by fraud, and maintained by fraud.

45. On information and belief, at the time Registrant filed its application for Registration No. 2,205,373, Registrant failed to disclose to the Patent and Trademark Office that Registration No. 1,565,504 was obtained by fraud, and maintained by fraud, and the failure to disclose was material and made to induce the Patent and Trademark Office to issue Registration No. 2,205,373.

46. On information and belief, at the time Registrant filed its application for Registration No. 2,205,373, Registrant knew, should have known, or had reason to believe that the Patent and Trademark Office would reasonably rely on the claim of ownership in Registration No. 1,565,504 to issue Registration No. 2,205,373.

COUNT IV - NON-USE OF THE MARK

47. Petitioner realleges and incorporates herein the allegations of paragraphs 1-46, inclusive.

48. On information and belief, at the time Registrant filed its application for Registration No. 2,205,373, it had not used the mark TRADESMAN on the specified goods in commerce, with the possible exception of power saws.

COUNT V - ABANDONMENT OF THE MARK

49. Petitioner realleges and incorporates herein the allegations of paragraphs 1-48, inclusive.


50. Registrant has not and did not use its mark TRADESMAN in commerce on each of the goods specified in Registration No. 2,205,373 for a period of three (3) years, with the possible exception of power saws.

51. Registrant abandoned its mark TRADESMAN with the intent not to resume use on each of the goods specified in Registration No. 2,205,373, with the possible exception of power saws.

WHEREFORE, Petitioner is damaged by the continued maintenance of Registrant's mark and respectfully prays that Registration No. 2,205,373 be canceled.

Respectfully submitted,

November 17, 2004



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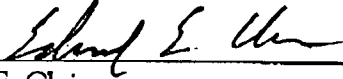
Attorneys for Petitioner

CERTIFICATE OF PETITIONER'S ATTORNEY

We hereby certify that we are the trademark Attorneys for WMH Tool Group, Inc., Petitioner herein, and that we have been instructed to file the foregoing Petition for Cancellation. We are, therefore, filing this Petition for Cancellation under Section 14 of the Trademark Act of 1946 and under Trademark Rule 2.111.

FITCH, EVEN, TABIN & FLANNERY

November 17, 2004



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Hon. Commissioner of Patents
and Trademarks
Alexandria, Virginia 22313-1451
BOX TTAB FEE

Re: Transmittal of Petition for Cancellation for:
WMH Tool Group, Inc. v. Power Tool Specialists, Inc.
Trademark: TRADESMAN
Registration No. 2,205,373 Issued: November 24, 1998
Our File No. 7203/83708

Honorable Sir:

Please file the enclosed Petition for Cancellation. The Commissioner is hereby authorized to charge the filing fee of \$300.00 and any other fees which may be required in this proceeding during its entire pendency, or credit any overpayment, to Deposit Account No. 06-1135.

Respectfully Submitted,



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EEC:ddc
Enclosure

WMH Tool Group, Inc.

v.

Power Tool Specialists, Inc.

Mark: TRADESMAN

Registration No. 2,205,373

PETITION FOR CANCELLATION (0+2)



11-22-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #11

EEC:ddc

11/17/04

7203-83708

Sir:

Please acknowledge receipt of the above-identified documents by applying the Patent and Trademark Office receipt stamp hereto and mailing this card.

Respectfully,

FITCH, EMMETT, TABIN & FLANNERY