

ESTTA Tracking number: **ESTTA28734**

Filing date: **03/21/2005**

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

| | |
|-------------------------------|--|
| Proceeding | 92044173 |
| Party | Defendant Pliley, Larry E. Pliley, Larry E. 469 Newark Street Aurora, CO 80010 |
| Correspondence Address | Pliley, Larry E. 469 Newark Street Aurora, CO 80010 |
| Submission | Answer |
| Filer's Name | Ramon L. Pizarro |
| Filer's e-mail | pizarro@4dv.net |
| Signature | /Ramon L. Pizarro/ |
| Date | 03/21/2005 |
| Attachments | Pliley.pdf (13 pages) |

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

JOHN NARDOZZA,

Petitioner,

v.

LARRY E. PLILEY,

Registrant.

Petition for Cancellation No. 92044173

Mark: PORTAVISE

Registration No.: 2910183

S/N: 76565876

**ANSWER TO PETITION FOR CANCELLATION
AND
AFFIRMATIVE DEFENSES**

Registrant Larry E. Pliley, the owner of Registration No. 2910183 (the “Registration”) for the mark “PORTAVISE” hereby answers Petitioner’s Petition for Cancellation (“Petition”) as follows:

**COUNT I
ALLEGED PRIOR FIRST USE BY PETITIONER**

1. Registrant does not have sufficient information to form a belief as to the allegations contained in paragraph 1 of the Petition and therefore denies the allegations.
2. Registrant does not have sufficient information to form a belief as to the allegations contained in paragraph 2 of the Petition and therefore denies the allegations.
3. Registrant admits that he is the president of Portavise, Inc. of Aurora, Colorado.

4. Registrant admits that he claimed that the date of first use to be as early as April 22, 2003 on the application for trademark registration that he caused to be filed on December 18, 2003, but does not have sufficient information to form a belief as to any other allegations contained in paragraph 4 of the Petition and therefore denies these allegations.

5. Registrant does not have sufficient information to form a belief as to the allegations contained in paragraph 5 of the Petition and therefore denies the allegations.

6. Registrant admits that an application for trademark registration having Serial No. 78/552,893 for the mark "PORTA-VISE" is shown on the U.S. Patent and Trademark Office's Internet web site as being filed on January 24, 2005 by a John Nardoza, but does not have sufficient information to form a belief as to any other allegations contained in paragraph 6 of the Petition and therefore denies these allegations.

7. Registrant does not have sufficient information to form a belief as to the allegations contained in paragraph 7 of the Petition and therefore denies the allegations.

8. Registrant does not have sufficient information to form a belief as to the allegations contained in paragraph 8 of the Petition and therefore denies the allegations.

9. Registrant admits the allegations of paragraph 9 of the Petition.

10. Registrant admits the allegations of paragraph 10 of the Petition.

11. Registrant admits that the Registrant's registered trademark is for the mark "PORTAVISE". The balance of paragraph 11 of the Petition appear to be legal conclusions that do not require a response, and thus any other allegation contained in paragraph 11 is denied.

12. Registrant admits that he stated that he wrote the letter marked as Exhibit “P-2” in the Petition, and that this letter includes the words “can be generally called a clamp or vise” and “will cause considerable confusion in the market place”. Any other allegation of paragraph 12 is denied.

13. Registrant denies Petitioner’s allegation that Petitioner has the right to use the mark “PORTA-VISE” in conjunction with the goods alleged to be offered by Petitioner, and denies any other allegation found in paragraph 13 of the Petition.

14. Registrant denies the allegations of Paragraph 14 of the Petition.

AFFIRMATIVE DEFENSES

1. Registrant has been continuously using the mark "PORTAVISE" in interstate commerce as early as July 9, 2001, through face-to-face sales. Initially through Electronic Time of Colorado, Inc., a Colorado corporation owned and operated by the Registrant. The July 9, 2001 sale is evidenced by the accompanying receipt for one "PortaviseTM", and is attached hereto as Exhibit R-1. The "PortaviseTM" referenced in Exhibit R-1 is for the sale of a tool sold under the PORTAVISE trademark to a purchaser in Herford, Texas, on July 9, 2001. The tool sold referred to in the receipt shown in Exhibit R-1 is the vise that formed the basis for the Registration. This use in interstate commerce precedes Petitioner's alleged first use of December 4, 2002, and Petitioner's alleged first use in commerce of December 5, 2002. Attached hereto as Exhibit R-2 is documentation showing Registrant's state trade-name registration, filed on February 3, 2000, for registering that Electronic Time of Colorado, Inc. was to be doing business as Portavise, Inc. Exhibit R-3 shows that Electronic Time of Colorado, Inc. was to be doing business as Mr. Watch, Inc., and that the Registrant is the president of Electronic Time of Colorado, Inc.

2. The Registrant registered the Internet web address www.portavise.com on February 3, 2000, as shown on Exhibit R-4, which is the confirmation from the registration service of Verio, Inc. Exhibit R-5 shows that the Petitioner registered www.porta-vise.com with the same registration service (Verio, Inc.) on October 22, 2002. Based on information and belief, the Petitioner knew of the Registrant's registered domain name, but ignored the Registrant's prior steps to secure his trademark rights, and

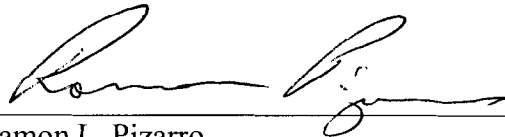
proceeded to simply add a hyphen to the Registrant's trademark and registered the www.porta-vise.com Internet web address.

3. After filing of this Petition for Cancellation, and before the filing of this Answer, Registrant made Petitioner aware of the fact that Registrant had evidence of prior use in commerce, and provided Petitioner with a copy of the receipt included in Exhibit R-1, but Petitioner ignored this evidence.

4. Petitioner's actions demonstrate willful or reckless disregard for the trademark rights of Registrant and by continuing the prosecution of his Petition for Cancellation is frivolous and shows a lack of respect for this forum.

WHEREFORE, Registrant respectfully requests that the Board dismiss the Petition with prejudice.

Respectfully submitted on this 21st day of March, 2005.



Ramon L. Pizarro
Attorney for Registrant
3515 South Tamarac Drive, STE 200
Denver, CO 80237
Telephone No. (303) 779-9551
Facsimile No. (303) 689-9627

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted electronically via the Internet to the United States Patent and Trademark Office (PTO) by the PTO Electronic System for Trademark Trials and Appeals (ESTTA) on this 21st day of March, 2005.

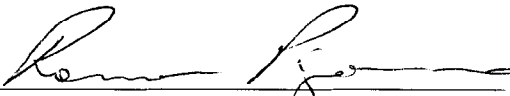


Ramon L. Pizarro

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the forgoing ANSWER TO PETITION FOR CANCELLATION AND AFFIRMATIVE DEFENSES was served on Walter F. Dawson, Petitioner's counsel of record, on March 21, 2005, via first class mail, postage prepaid, addressed as follows:

Mr. Walter F. Dawson
Pearson & Pearson
10 George Street
Lowell, MA 01852



Ramon L. Pizarro



Mr. Watch™

ELECTRONIC TIME CENTER

DATE 7-9-01

NAME

PHONE

H.

W.

CLAIM CHECK #

MC

ER

MR

79045

RECEIVING #

WATCH
DESCR.

DEFECTS

BAND. _____

CRYST. _____

CASE. _____

Deanna Jewelry
306364
5125
514 AVE, #2
HERFORD TEXAS

| DESCRIPTION | GOODS | SERVICES | \$ AMOUNT |
|---|--------------|----------|--------------|
| <input type="checkbox"/> BATTERY SERVICE | | | |
| <input type="checkbox"/> BATTERY/ BACK SEAL SERVICE | | | |
| <input type="checkbox"/> QUARTZ CLEANING SERVICE | | | |
| <u>1- Portawise™</u> | | | |
| <u>Abby Kit</u> | <u>59.00</u> | | <u>59.00</u> |
| <u>TEXAS TAX LIC.</u> | | | |

1. PROCESS FEE IS NOT REFUNDABLE OR TRANSFERABLE. IT INCLUDES DOCUMENTATION, DIAGNOSIS, STORAGE ESTIMATES, INSPECTIONS, NOTIFICATIONS, AND SECURITY OF YOUR WATCH.
2. PROCESS FEE IS CREDITED ONLY TOWARD A COMPLETED WATCH REPAIR WHEN AUTHORIZED IN PERSON OR BY PHONE.
3. GUARANTEES ARE CONSIDERED ONLY AGAINST ACTUAL WORK PERFORMED AS DESCRIBED ON THIS INVOICE. CRYSTALS, BANDS, CASES AND CASE PARTS CARRY NO GUARANTEE WHATSOEVER.
4. GUARANTEE TERM BEGINS ON THE DATE OF NOTIFICATION OF THE WORK BEING COMPLETE. NOTIFICATION DATE: _____
5. STORAGE, COLLECTION OR ATTORNEY FEES ARE APPLICABLE ON WATCHES NOT PICKED UP ON A TIMELY BASIS. \$2.00 PER DAY STORAGE WILL BE CHARGED 5 DAYS AFTER FIRST NOTIFICATION.

STORAGE OF \$2.00 DAY IS CHARGED 5 DAYS AFTER THE FIRST NOTIFICATION, AND CONTINUES UNTIL REPAIR. COLLECTION & STORAGE CHARGES ARE PAID IN FULL.

ALL SALES ARE FINAL. YOUR RECEIPT MUST BE PRESENTED TO CONSIDER EXCHANGES OR GUARANTEES. THANK YOU FOR YOUR COOPERATION.

| | |
|-------------|----------------------|
| SUR TOTAL | <u>59.00</u> |
| PROCESS FEE | () |
| BALANCE | |
| SALES TAX | <u>TEXAS Use Tax</u> |
| AMOUNT PAID | <u>59.00</u> |
| DATE PAID | <u>7-9-01</u> |

SIG. _____

№ 13619

COMPLETE SERVICE OR REPAIRS ARE GUARANTEED FOR 45 DAYS SUBJECT TO MOISTURE OR SHOCK DAMAGE.

Mail to: Secretary of State
 Corporations Section
 1560 Broadway, Suite 200
 Denver, CO 80202
 (303) 894-2251
 Fax (303) 894-2242

For office use only 045

MUST BE TYPED
FILING FEE: \$10.00
MUST SUBMIT TWO COPIES

Please include a typed
 self-addressed envelope

JDC
19871345002

FILED
 BONITA DAVIDSON
 CLERK OF SECRETARY OF STATE
 20001023445 C
 10.00
 SECRETARY OF STATE
 02-03-2000 12:38:11

**CERTIFICATE OF
 ASSUMED OR TRADE NAME**

Electronic Time of Colorado, Inc., a corporation,

limited partnership or limited liability company under the laws of Colorado,
 being desirous of transacting a portion of its business under an assumed or trade name as permitted
 by 7-71-101, Colorado Revised Statutes, hereby certifies:

- The location of its principal office is: 469 Newark Street, Aurora, CO 80010
 (Include city, state, zip)
- The name, other than its own, under which the business is carried on is: _____
Portavise, Inc.
- A brief description of the kind of business transacted under such assumed or trade name is:
manufacturing and sales of small tools

| Limited Partnership or Limited Liability Companies complete this section. | Corporations complete this section |
|---|--|
| Name of Entity | Electronic Time of Colorado, Bnc. Name of Corporation |
| by _____ Signature | by <i>Dianne Pliley</i> Signature Dianne Pliley |
| Title, General Partner, or Manager | Its Secretary Title |

COMPUTER UPDATE COMPLETE
 MJ
 Revised 7/95 *MA*

SS: AN-TN 1
(Rev. 7/91)
SUBMIT ONE
Filing fee: \$10.00

Mail to: Secretary of State
Corporations Section
1560 Broadway, Suite 200
Denver, Colorado 80202
(303) 894-2251

for office use only

This document must be typewritten.

**CERTIFICATE OF
ASSUMED OR TRADE NAME**

DP 871345002

921079986 \$10.00
305 08-13-92 10:42

Electronic Time of Colorado, Inc., a corporation,
limited partnership or limited liability company under the laws of Colorado
being desirous of transacting a portion of its business under an assumed or trade name as permitted by 7-71-101, Colorado
Revised Statutes hereby certifies:

1. The location of its principal office is: 13172 E. Mississippi, Aurora, CO 80012
2. The name, other than its own, under which business is carried on is (Note 1): Mr. Watch, Inc.
3. A brief description of the kind of business transacted under such assumed or trade name is: watch repair, service and sales

| Limited Partnerships or Limited Liabilities Companies complete this section | Corporations complete this section |
|---|--|
| IN WITNESS WHEREOF, the undersigned general partner or manager of said limited partnership or limited liability company has this day executed this certificate _____ 19 ____ (Note 2) by _____ (Note 3) Title, General Partner or Manager Title, General Partner or Manager | IN WITNESS WHEREOF, the undersigned officers of said corporation have this day executed this certificate <u>August 12</u> 19 <u>92</u> <u>Electronic Time of Colorado, INC</u> by <u>Larry E. Pliley</u> (Note 3) <u>Larry E. Pliley</u> President Attest: <u>Dianne McCauley</u> <u>Dianne McCauley</u> Secretary |

STATE OF Colorado

COUNTY OF Windsor ss.

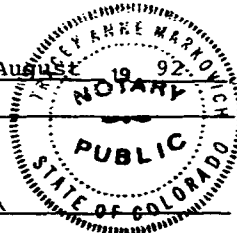
Acknowledged before me this 12th day of August 19 92

by Larry E. Pliley, President
(Insert name(s) as signed above, title(s).)

In witness whereof I have hereunto set my hand and seal

My commission expires October 19, 1993
13731 E. Mississippi Ave
Aurora, Colorado 80012

Conrad Markinich
Notary Public



Note 1: Any assumed name used by any corporation shall contain one of the words "Corporation", "Incorporated", "Limited", or one of the abbreviations "Corp.", "Inc.", or "Ltd."
Any assumed name used by any limited partnership shall contain one of the words "Limited Partnership", "Limited", or "Company" or one of the abbreviations "L.P.", "Ltd.", or "Co."
Any assumed name used by a Limited Liability Company must contain the words Limited Liability Company. The words Limited and Company may be abbreviated as Ltd. and Co., but the word Liability cannot be abbreviated.

Note 2: Exact name of corporation, limited partnership or limited liability company making the statement.

Note 3: Signature and title of officers signing (for the corporation, must be president or vice president; and secretary or assistant secretary, for a limited partnership must be general partner for a limited liability company must be a manager.)



Exhibit R-4

WHOIS information for **portavise.com**:

[whois.melbourneit.com]

```

Domain Name..... portavise.com
  Creation Date..... 2000-02-03
  Registration Date.... 2000-02-03
  Expiry Date..... 2006-02-03
  Organisation Name.... PORTAVISE, INC
  Organisation Address. 469 NEWARK STREET
  Organisation Address.
  Organisation Address. AURORA
  Organisation Address. 80010
  Organisation Address. CO
  Organisation Address. UNITED STATES

Admin Name..... DIANNE PLILEY
  Admin Address..... 469 NEWARK STREET
  Admin Address.....
  Admin Address..... AURORA
  Admin Address..... 80010
  Admin Address..... CO
  Admin Address..... UNITED STATES
  Admin Email..... AVEOINC@AOL.COM
  Admin Phone..... 303341-1327
  Admin Fax.....

Tech Name..... Verio Hostmaster
  Tech Address..... 5050 Blue Lake Dr.
  Tech Address.....
  Tech Address..... Boca Raton
  Tech Address..... 33431
  Tech Address..... FL
  Tech Address..... UNITED STATES
  Tech Email..... hostmaster@VERIO-HOSTING.COM
  Tech Phone..... 888-663-6648
  Tech Fax.....
  Name Server..... ns11a.verio-web.com
  Name Server..... ns11b.verio-web.com

```

Search WHOIS records:

Submit

Domain Registration

Domain Pricing, Suggest-A-Name
[Search by Keyword](#), [Search Deleted Domains](#)

Hosting Resources

[Web Plans](#), [E-Commerce](#), [Custom Websites](#)
[VPS](#), [Managed Hosting](#), [Reseller Programs](#)

Copyright © 1997-2003

To see who's visiting your web site

porta-vise.com (Commercial)

Exhibit R-5

The domain that you requested, **porta-vise.com**, has already been registered by the organization below. Please [click here](#) to see other options for this name.

```

Domain Name..... porta-vise.com
  Creation Date..... 2002-10-22
  Registration Date... 2002-10-22
  Expiry Date..... 2007-10-22
  Organisation Name... Chester Industries
  Organisation Address. PO Box 52
  Organisation Address.
  Organisation Address. Chester
  Organisation Address. 03036
  Organisation Address. NH
  Organisation Address. UNITED STATES

Admin Name..... John Nardozza
  Admin Address..... PO Box 52
  Admin Address.....
  Admin Address..... Chester
  Admin Address..... 03036
  Admin Address..... NH
  Admin Address..... UNITED STATES
  Admin Email..... johnnard@gsinet.net
  Admin Phone..... (603)4907973
  Admin Fax.....

Tech Name..... Verio Hostmaster
  Tech Address..... 5050 Blue Lake Dr.
  Tech Address.....
  Tech Address..... Boca Raton
  Tech Address..... 33431
  Tech Address..... FL
  Tech Address..... UNITED STATES
  Tech Email..... hostmaster@VERIO-HOSTING.COM
  Tech Phone..... 888-663-6648
  Tech Fax.....
  Name Server..... ns19a.nameservers.net
  Name Server..... ns19b.nameservers.net
    
```

Check this domain:

