

ESTTA Tracking number: **ESTTA29986**

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

Proceeding	92044257
Party	Defendant PORTER INTERNATIONAL CO., LTD. PORTER INTERNATIONAL CO., LTD. 2F, NO. 86, SEC 1, HUAMEI WEST ST. TWX SHI CHIU, TAICHUNG,
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Date	04/07/2005
Attachments	Answer petition 7Apr05.pdf (8 pages)

(b) As to the allegations contained in subparagraph 4(b) of the Petition, Registrant admits that on June 2, 1993, January 30, 1996, and May 31, 2000, Gallant and Petitioner entered into subsequent agreements, but Registrant denies the remainder of the allegations contained in subparagraph 4(b) of the Petition.

(c) Registrant denies the allegations contained in subparagraph 4(c) of the Petition.

(d) As to the allegations contained in subparagraph 4(d) of the Petition, Registrant admits that Gallant registered the marks "PORTER" and design (Registration No. 1,602,298) and "PORTER DASH!" and design (Registration No. 2,131,161), under its own name. Registrant denies the remainder of the allegations contained in subparagraph 4(d) of the Petition.

(e) Registrant denies the allegations contained in subparagraph 4(e) of the Petition.

(f) As to the allegations contained in subparagraph 4(f) of the Petition, Registrant admits that Gallant sent a letter dated April 4, 2001 to Petitioner that served as the formal, written notice of termination of the Agreement between Gallant and Yoshida dated May 31, 2000, but Registrant denies the remainder of the allegations contained in subparagraph 4(f) of the Petition.

(g) Registrant denies the allegations contained in subparagraph 4(g) of the Petition.

5. (a) As to the allegations contained in subparagraph 5(a), Registrant admits that Gallant and Registrant are separate and independent corporate entities. Registrant further admits that there are shareholders and at least one director that are common to Registrant and to Gallant. Registrant also admits that Ming-Teng Lin acts as the president of Gallant and a supervisor of Registrant, his son I-Hsiung Lin acts as a director for both Gallant and Registrant, a second of his sons, I-Sheng Lin acts as a director for Registrant, and Ming-Teng Lin and his two sons hold a majority of Registrant's shares. Registrant admits that Ming-Teng Lin signed the declaration in Application S.N. 75/095,238, and the statement of use in the same application as president of Gallant. Registrant denies the remainder of the allegations in paragraph 5(a).

(b) Registrant denies the allegations contained in paragraph 5(b) of the Petition.

(c) Registrant admits that Gallant assigned the mark PORTER & design in Reg. No. 1,602,298 to Registrant on February 22, 2002 and that Registrant submitted to the United States Patent and Trademark Office Assignment Division a request for recordation of this assignment. Registrant denies the remainder of the allegations contained in subparagraph 5(c) of the Petition.

(d) Registrant denies the allegations contained in subparagraph 5(d) of the Petition.

(e) Registrant admits that Gallant assigned the mark PORTER DASH! & design in Reg. No. 2,131,161 to the Registrant on February 22, 2002 and that the assignment was recorded with the United States Patent and Trademark Office Assignment Division on March 29, 2002, at Reel/Frame: 002474/0528. Registrant denies the remainder of the allegations contained in subparagraph 5(e) of the Petition.

(f) Registrant denies the allegations contained in subparagraph 5(f) of the Petition.

(g) Registrant denies the allegations contained in subparagraph 5(g) of the Petition.

6. Registrant denies the allegations contained in paragraph 6 of the Petition.

7. Registrant denies the allegations contained in paragraph 7 of the Petition.

8. Registrant denies the allegations contained in paragraph 8 of the Petition.

(a) As to the allegations contained in subparagraph 8(a), Registrant admits that it applied for registration of the "PORTER" and design mark. Registrant denies the remainder of the allegations contained in subparagraph 8(a) of the Petition.

(b) As to the allegations contained in subparagraph 8(b), Registrant admits that its counsel stated in the response to the office action filed with the U.S. Patent and Trademark Office on November 30, 1989 that:

"Counsel is informed by the applicant that the Japanese OEM manufacture which manufactured some of the products bearing the instant trademark printed the swing tags and placed "Made in Tokyo" on them. It is quite usual and acceptable for a company to have others manufacture their products and the instant applicant controls the nature and quality of the products by giving instructions to the OEM or manufacturer. In circumstances such as these the manufacturer does not own the mark, but rather simply makes the goods on contract for the owner of the mark and it is counsel's understanding that the manufacturer of these goods does not use the mark as its own."

Registrant denies the remainder of the allegations contained in subparagraph 8(b) of the Petition.

(c) As to the allegations contained in subparagraph 8(c), Registrant admits that Gallant submitted a Declaration under Sections 8 and 15 signed by Mr. Ming-Teng Lin on March 5, 1996 identifying Gallant as the owner of Reg. No. 1,602,298. Registrant denies the remainder of the allegations contained in subparagraph 8(c) of the Petition.

(d) As to the allegations contained in subparagraph 8(d), Registrant admits that Gallant submitted a Declaration under Section 8 and Application for Renewal under Section 9 signed by Mr. Ming-Teng Lin on June 8, 2000, identifying Gallant as the owner of Registration No. 1,602,298. Registrant denies the remainder of the allegations contained in subparagraph 8(d) of the Petition.

9. Registrant denies the allegations contained in paragraph 9 of the Petition.

10. Registrant denies the allegations contained in paragraph 10 of the Petition.

11. Registrant denies the allegations contained in paragraph 11 of the Petition.

12. Registrant denies the allegations contained in paragraph 12 of the Petition.

13. Registrant admits that if Registrant's registration is not cancelled, Registrant would be awarded the prima facie right to exclusive use of the mark on the goods described in the Registration. Registrant denies the remainder of the allegations contained in paragraph 13 of the Petition.

14. Registrant denies the allegations contained in paragraph 14, including all of subparts (a)-(d) of the Petition.

15. Registrant denies the allegations contained in paragraph 15 of the Petition.

16. Registrant denies the allegations contained in paragraph 16 of the Petition.

17. Registrant denies the allegations contained in paragraph 17 of the Petition.

18. Registrant denies the allegations contained in paragraph 18 of the Petition

AFFIRMATIVE DEFENSES

19. Claims in the petition are barred by the doctrine of laches.

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20. Claims in the petition are barred by the doctrine of acquiescence.

Respectfully submitted,

Date: April 7, 2005

Aoi Nawashiro

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CERTIFICATE OF DELIVERY


I hereby certify that the foregoing was submitted to the Trademark Trial and Appeal Board, via the on-line filing system on the USPTO website, on this 7th day of April 2005.

Aoi Nawashiro

Aoi Nawashiro

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing **Answer to Petition for Cancellation** was mailed by depositing with the U.S. Postal Service, with postage pre-paid via first-class mail, addressed to counsel for Opposer, Paul A. Welter, Esquire, Merchant & Gould P.C., 3200 IDS Center, 80 South Eighth Street, Minneapolis, MN 55402, on this 7th day of April 2005.



Aoi Nawashiro