

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

Speedplay, Inc.,)
)
 Petitioner,)
)
 v.)
)
 American Sports Design Company,)
)
 Registrant.)
)
)
)

Cancellation No. _____

Registration No. 2,861,672

78, 253, 774

Registered: July 6, 2004

Mark: X-1



07-29-2005

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

PETITION FOR CANCELLATION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

08/02/2005 SWILSON1 00000001 78253774
01 FC:6401 300.00 OP

Sir:

Petitioner, Speedplay, Inc., a corporation organized and existing under the laws of the State of California, having a place of business at 10151 Pacific Mesa Blvd., San Diego, California 92121 ("Speedplay"), believes that it will be damaged by the existence on the Principal Register of the mark "X-1", in International Class 12, shown in Registration No. 2,861,672, registered July 6, 2004 by Registrant, American Sports Design Company, a corporation organized and existing under the laws of the State of Ohio, having a place of business at 901 Pleasant Valley Drive Springboro Ohio 45066 ("American Sports"), and hereby petitions to cancel the same.

As grounds for cancellation, Petitioner Speedplay alleges that:

1. Petitioner Speedplay is engaged, among other things, in the business of manufacturing and selling bicycling products.

2. Petitioner Speedplay is the owner of a federal trademark application, U.S. application Serial No. 76/557,543, for the mark "X/1" in connection with "bicycle parts and accessories, namely pedals" in International Class 12.

3. Petitioner Speedplay has been using the mark "X/1" continuously in commerce, throughout the United States, as its trademark for bicycle parts and accessories, as set forth in the above-identified application since at least as early as the dates set forth therein, and intends to continue so using the mark "X/1" in the future. Petitioner Speedplay uses the mark "X/1" by applying it to the packaging, literature and in other ways customary in the trade.

4. On May 23, 2003, Registrant American Sports filed an application, serial No. 78/253,774, with the U.S. Patent and Trademark Office to register "X-1" in connection with the following goods, namely "bicycles and structural parts thereof".

5. Registrant American Sports' Registration No. 2,861,672 was registered on July 6, 2004.

6. Petitioner Speedplay, through the use of its trademark "X/1", from a time prior to Registrant American Sports' filing of its application to register the mark "X-1", and by virtue of the quality of the Petitioner Speedplay's goods, has built up a valuable goodwill and reputation in connection with its mark "X/1".

7. Registrant American Sports' mark "X-1" is similar in appearance, sound, connotation, and commercial impression to Petitioner Speedplay's mark "X/1".

8. Registrant American Sports and Petitioner Speedplay's respective goods under their respective marks are related in that they both involve bicycling products, are distributed and sold through the same or similar channels of trade, and are marketed to the same or similar customers and end users.

9. Petitioner Speedplay believes that it will be damaged by the continued registration of Registrant American Sports' mark "X-1" and petitions to cancel Registration No. 2,861,672 because Registrant American Sports' registration and use of its mark "X-1" in connection with the goods set forth in Registration No. 2,861,672 is likely to cause confusion, to cause mistake, and to deceive customers, potential customers and others, thereby injuring Petitioner Speedplay and the consuming public and jeopardizing the valuable goodwill and reputation Petitioner Speedplay has built up in connection with its mark "X/1".

10. Accordingly, for each and every reason stated above, Petitioner Speedplay believes that it will be damaged by the continued registration of Registrant American Sports' "X-1" mark and Registration No. 2,861,672.

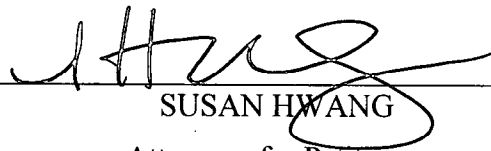
WHEREFORE, Petitioner Speedplay prays that this petition for cancellation (submitted in duplicate, with the appropriate fee under 37 C.F.R. § 2.6(a)(17)) be sustained and that the registration of Registrant American Sports' "X-1" mark in Registration No. 2,861,672 be cancelled.

July 27, 2005

Respectfully submitted,

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

By: _____



SUSAN HWANG

Attorneys for Petitioner
SPEEDPLAY, INC.

333 South Hope Street, 48th Floor
Los Angeles, California 90071
Telephone: (213) 620-1780
Facsimile: (213) 620-1398

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this PETITION FOR CANCELLATION is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451, on July 27, 2005.

By 
MARIA LUCIANO

****Please place on Upper Right Corner****
****of Response to Office Action ONLY.****

Examining Attorney: CARROLL, DORITT L.

Serial Number: 76/557543

IN THE UNITED STATES PATENT



In re Application of

Speedplay, Inc.

Serial No. 76/557,543

Filed: November 6, 2003

For: X/1

) Examining Attorney: Doritt Carroll

) Law Office: 116

)
) CERTIFICATE OF MAILING: RESPONSE TO OFFICE ACTION
) AND REQUEST FOR SUSPENSION OF APPLICATION

) I hereby certify that this correspondence 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,
) Alexandria, VA 22313-1451 on July 27, 2005.

) Signature: Maria Luciano
) Maria Luciano

RESPONSE TO OFFICE ACTION AND
REQUEST FOR SUSPENSION OF APPLICATION

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

Dear Sir:

Applicant submits the following remarks and evidence in response to the Office Action mailed on January 27, 2005.

REMARKS

The Examining Attorney withdrew her refusal to register Applicant's mark based on U.S. Registration No. 2,484,353 under 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), , but has now initially refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that there is a likelihood of confusion between Applicant's mark and newly registered U.S. Registration No. 2,861,672 (X-1) owned by American Sports Design Company. The Examining Attorney has also continued her refusal to register Applicant's mark on the ground that Applicant's mark allegedly merely represents a model, style or grade designation and would not be perceived as a trademark for the goods



identified in the application, under Trademark Act Sections 1, 2 and 45, 15 U.S.C. § § 1051, 1052 and 1127.

APPLICANT REQUESTS SUSPENSION OF ITS APPLICATION

Applicant files herewith a Petition for Cancellation under Section 14 of the Trademark Act, 15 U.S.C. § 1064 in the Trademark Trial and Appeal Board against U.S. Registration No. 2,861,672 (X-1). The requisite filing fee under 37 C.F.R. § 2.6(a)(16) is enclosed. Applicant respectfully requests that the Examining Attorney suspend further examination of Applicant's application pending the disposition of the cancellation proceeding.

APPLICANT'S MARK FUNCTIONS AS A TRADEMARK IN ADDITION TO USE AS A MODEL DESIGNATION

The Examining Attorney has continued her refusal to register Applicant's mark on the ground that Applicant's mark allegedly merely represents a model, style or grade designation and would not be perceived as a trademark for the recited goods, namely, "bicycle parts and accessories, namely, pedals", under Trademark Act Sections 1, 2 and 45, 15 U.S.C. § § 1051, 1052 and 1127.

Applicant respectfully continues to disagree with the Examining Attorney's grounds for refusal to register and requests reconsideration in light of the following remarks.

Applicant's mark X/1 is not merely used as a model, style or grade designation but serves to also identify the source of the goods.

According to the Trademark Manual of Examining Procedure ("TMEP") § 1202.10, "[s]ubject matter used **solely** as a model, style or grade designation within a product line does not function as a trademark" (citing *In re Dana Corp.*, 12 USPQ2d 1748 (TTAB 1989) (emphasis added). However, model designations can, through use and promotion, be perceived as marks indicating origin in addition to functioning as model designations. *In re Petersen Mfg. Co., Inc.*, 229 USPQ 466, 468 (TTAB 1986) (letter-number combinations found registrable for locking hand tools, the Board stating, "[T]here is no question that such model designations can,

through use and promotion, be perceived as marks indicating origin in addition to functioning as model designations.’).

In the instant case, Applicant’s X/1 mark serves as a trademark in addition to use as a model designation. Attached hereto as Exhibit 1 is a substitute specimen of use and a signed declaration under 37 C.F.R. § 2.20 verifying that the substitute specimen was in use in commerce at least as early as the application filing date. As the substitute specimen clearly shows, Applicant’s mark is used as a trademark on Applicant’s packaging for its product. In addition, attached as Exhibit 2 are declarations from consumers indicating that they recognize X/1 as a trademark of Applicant.

Applicant believes that the relevant consumers associate Applicant as the particular source for goods bearing Applicant’s X/1 mark. As discussed above, such an association is sufficient to establish that the proposed mark is registrable as a trademark. Applicant’s consistent and repetitive use of the mark in connection with Applicant’s goods in the marketplace for more than 13 years establishes the trademark capability of the mark, and not just as a model or grade designation.

Accordingly, based on the above arguments and supporting evidence, Applicant respectfully requests that the Examining Attorney reconsider her refusal to register under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. § § 1051, 1052 and 1127.

APPLICANT CLAIMS STANDARD CHARACTER FORMAT

Applicant notes that the PTO’s web site database incorrectly indicates Applicant’s mark drawing code as “words, letters, and/or numbers in stylized form”. Applicant respectfully states that Applicant filed for its mark as a standard character mark, not in stylized form. For the record, Applicant hereby submits the following statement:

“The mark is presented in standard character format without claim to any particular font style, size or color.”

Applicant respectfully requests that the application be corrected accordingly.

CONCLUSION

Applicant believes that a suspension of application proceedings is appropriate pending the disposition of the cancellation proceeding and respectfully requests the Examining Attorney to order the same. Should the Examining Attorney require further information, Applicant respectfully requests that the Examining Attorney contact the undersigned.

July 27, 2005

Respectfully submitted,

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

By


SUSAN HWANG

Attorneys for Applicant
SPEEDPLAY, INC.

333 S. Hope Street, 48th Floor
Los Angeles, California 90071
Telephone: (213) 620-1780
Facsimile: (213) 620-1398

Exhibit 1

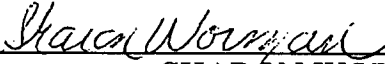
Applicant: Speedplay, Inc.
Mark: X/1
Serial No.: 76/557,543
Filed: November 6, 2003

DECLARATION UNDER 37 C.F.R. § 2.20

I, Sharon Worman, do hereby declare that:

1. The undersigned is authorized by the Applicant to execute this declaration.
2. The substitute specimen attached hereto was in use in commerce at least as early as the application filing date.
3. The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that the facts set forth in this application are true; all statements made of her own knowledge are true; and all statements made on information and belief are believed to be true.

Date: July 27, 2005



SHARON WORMAN
President
Speedplay, Inc.

DESIGNED AND MANUFACTURED
IN THE UNITED STATES



SPEEDPLAY®

SPEEDPLAY INC. IS A CREATIVE DESIGN
COMPANY DEDICATED TO PRODUCING
FUNCTIONAL, HIGH QUALITY INNOVATIONS
TO ENHANCE CYCLING PERFORMANCE,
EFFICIENCY, SAFETY AND COMFORT.

Specimen: Packaging
Mark: X/1
Serial No. 76/557,543
Applicant: Speedplay, Inc.

Exhibit 2

FROM :

FAX NO. :4142286768

Jul. 26 2005 09:06AM P1

I, PHILIP GOSKIN, do hereby declare that:

I am an independent sales representative.

I consider myself a bicyclist and may purchase bicycling products from time to time.

I consider the alpha-numeric designation X/1 to be exclusive of bicycle pedals manufactured and sold by Speedplay, Inc. When I see X/1, I associate X/1 as indicating that Speedplay, Inc. is the source of the bicycle pedal. Therefore, I consider X/1 to be a trademark of Speedplay, Inc. and not merely a model designation for a bicycle pedal.

I declare that all statements made herein of my own knowledge are true; that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Sections 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application and any registration resulting therefrom.

Dated: July 25, 20005

Philip P Goskin

Timothy Burks, do hereby declare that:

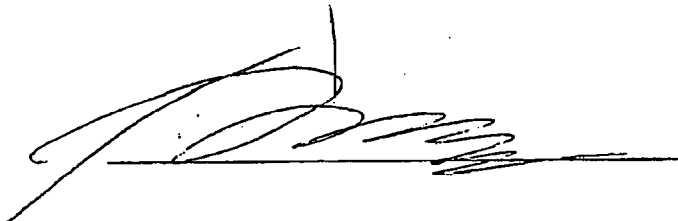
I am an independent sales representative.

I consider myself a bicyclist and may purchase bicycling products from time to time.

I consider the alpha-numeric designation X/1 to be exclusive of bicycle pedals manufactured and sold by Speedplay, Inc. When I see X/1, I associate X/1 as indicating that Speedplay, Inc. is the source of the bicycle pedal. Therefore, I consider X/1 to be a trademark of Speedplay, Inc. and not merely a model designation for a bicycle pedal.

I declare that all statements made herein of my own knowledge are true; that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Sections 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application and any registration resulting therefrom.

Dated: July 27, 2005



I, THOMAS ADAMS, do hereby declare that:


I am an independent sales representative.

I consider myself a bicyclist and may purchase bicycling products from time to time.

I consider the alpha-numeric designation X/1 to be exclusive of bicycle pedals manufactured and sold by Speedplay, Inc. When I see X/1, I associate X/1 as indicating that Speedplay, Inc. is the source of the bicycle pedal. Therefore, I consider X/1 to be a trademark of Speedplay, Inc. and not merely a model designation for a bicycle pedal.

I declare that all statements made herein of my own knowledge are true; that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Sections 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application and any registration resulting therefrom.

Dated: July 26, 2005



I, Paul Gallagher, do hereby declare that:

I am an independent sales representative.

I consider myself a bicyclist and may purchase bicycling products from time to time.

I consider the alpha-numeric designation X/1 to be exclusive of bicycle pedals manufactured and sold by Speedplay, Inc. When I see X/1, I associate X/1 as indicating that Speedplay, Inc. is the source of the bicycle pedal. Therefore, I consider X/1 to be a trademark of Speedplay, Inc. and not merely a model designation for a bicycle pedal.

I declare that all statements made herein of my own knowledge are true; that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Sections 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application and any registration resulting therefrom.

Dated: July 26, 2005

Paul Gallagher

I, Rich Delgado, do hereby declare that:

I am an independent sales representative.

I consider myself a bicyclist and may purchase bicycling products from time to time.

I consider the alpha-numeric designation X/1 to be exclusive of bicycle pedals manufactured and sold by Speedplay, Inc. When I see X/1, I associate X/1 as indicating that Speedplay, Inc. is the source of the bicycle pedal. Therefore, I consider X/1 to be a trademark of Speedplay, Inc. and not merely a model designation for a bicycle pedal.

I declare that all statements made herein of my own knowledge are true; that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Sections 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application and any registration resulting therefrom.

Dated: July 27, 2005

I, Tom Delaney, do hereby declare that:

I am an independent sales representative.

I consider myself a bicyclist and I purchase bicycling products from time to time.

I consider the alpha-numeric designation X/1 to be exclusive of bicycle pedals manufactured and sold by Speedplay, Inc. When I see X/1, I associate X/1 as indicating that Speedplay, Inc. is the source of the bicycle pedal. Therefore, I consider X/1 to be a trademark of Speedplay, Inc. and not merely a model designation for a bicycle pedal.

I declare that all statements made herein of my own knowledge are true; that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Sections 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application and any registration resulting therefrom.

Dated: July 27, 2005

Signed: Tom Delaney