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

Proceeding	92051039
Party	Defendant Professional Coatings, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In Re Trademark Registration No. 2,892,968
For the Mark PRO-COAT (std. Char.)
Issue Dated: October 12, 2004

SWIMC, INC.

Petitioner

v.

Cancellation No. 92051039

PROFESSIONAL COATINGS, INC.

Registrant and
Respondent

ANSWER TO PETITION FOR CANCELLATION

Registrant/Respondent, Professional Coatings, Inc., owner of all right , title and interest in and to Registration 2,892,968, through its counsel, hereby responds to the Petition for Cancellation filed by SWIMC, Inc. (Petitioner or Sherwin-Williams, as real party in interest) concerning Pro-Coat's Registration No. 2,892,968 for the mark PRO-COAT® in standard characters (the Registration).

1. Registrant admits that Sherwin-Williams Company is a manufacturer, retailer, wholesaler and distributor of paints, coatings and various related products, including, in particular, various paint coatings and related products for wood and other architectural surfaces, including as a retailer of certain of Registrant's PRO-COAT®

products. With respect to all other allegations contained in Paragraph 1, Registrant is without sufficient knowledge, information or belief to form an opinion as to the truth or falsity of those allegations and, therefore, on that basis, denies the same, leaving Petitioner to its proof.

2. In response to Paragraph 2, in a previous application for registration of the mark PRO KOTE, serial number 76/600,805, Petitioner alleges a date of first use in 1987. As a consequence, Registrant, and, perhaps Petitioner, are at least confused as to the actual date of first use, but in any event, Registrant is without sufficient knowledge, information or belief to form an opinion as to the truth or falsity of the allegations contained therein and, therefore, on that basis, denies the same, leaving Petitioner to its proof.

3. In response to the allegations contained in Paragraph 3, Professional Coatings, Inc., your Registrant, is the owner of all right, title and interest in and to United States Registration No. 2,892,968. With respect to all other allegations contained in Paragraph 3, it is admitted that there is some resemblance between Registrant's registered trademark and Petitioner's PRO KOTE, although the product sold under PRO KOTE is significantly different, both in market and content, from that of Respondent's registered trademark.

4. In response to Paragraph 4, it is admitted, except that it is important to note that Registrant's registered trademark will, as a matter of law, be incontestible on October 12, 2009.

5. In response to Paragraph 5, it is admitted that Registrant alleges a date of first use of January 1, 1989. With regard to all other allegations, Registrant is without sufficient knowledge, information or belief to form an opinion as to the truth or falsity of those allegations and, therefore, on that basis, denies the same, leaving Petitioner to its proof.

6. In response to Paragraph 6, it is denied that Petitioner's licensee has valuable good will established in Petitioner's PRO KOTE mark. As to the remaining allegations of Paragraph 6, Registrant is without sufficient knowledge, information or belief to form an opinion as to truth or falsity of those allegations and, therefore, on that basis, denies the same, leaving Petitioner to its proof.

7. In response to Paragraph 7, each, every and all of the allegations are denied. Registrant affirmatively asserts that there is no actual, or likelihood of, confusion as between the Registrant's registered trademark and Petitioner's PRO KOTE mark, and Petitioner has so admitted. In its response, filed August 3, 2005, to an office action mailed February 8, 2005, refusing registration under Section 2(d) - Likelihood of Confusion, application serial number 76/608,805, Petitioner asserts, in the last paragraph on page 2 of that response:

"The duPont factors also include the nature and extent of actual confusion and the length of time of concurrent use. Applicant has been using its mark since at least as early as 1987 through predecessors in interest. According to the

'698 registration, the registrant has allegedly been using its mark since January 1989. To Applicant's knowledge there has been no actual confusion in more than 16 years of concurrent use. . ." (Emphasis in original)

8. In response to Paragraph 8, each, every and all of the allegations are denied. Registrant affirmatively asserts that there has been no actual confusion, and there is no reasonable likelihood of confusion as between the Registrant's registered trademark and Petitioner's PRO KOTE mark. In its response, filed August 3, 2005, to an office action mailed February 8, 2005, refusing registration under Section 2(d) - Likelihood of Confusion, application serial number 76/608,805, Petitioner asserts, in the last paragraph on page 2 of that response:

"The duPont factors also include the nature and extent of actual confusion and the length of time of concurrent use. Applicant has been using its mark since at least as early as 1987 through predecessors in interest. According to the '698 registration, the registrant has allegedly ben using its mark since January 1989. To Applicant's knowledge there has been no actual confusion in more than 16 years of concurrent use. . ." (Emphasis in original)

9. In response to the allegations of Paragraph 9, it is admitted that Petitioner deems (announces) that it is, or will be, damaged. It is denied that Petitioner

can, or will be able to, evidence actual damage for the many reasons pointed out in the following Affirmative Defenses.

AFFIRMATIVE DEFENSES

As and for separate and distinct affirmative defenses to the Petition herein, Registrant avers the following:

FIRST AFFIRMATIVE DEFENSE:

Registrant alleges that the claim alleged in the Petition is barred by acquiescence. Petitioner has sat on its corporate hands, having knowledge of Respondent's usage, for more than 19 years until the mark was on the threshold of becoming incontestable. Accordingly, Petitioner should not now be heard to claim damage.

SECOND AFFIRMATIVE DEFENSE:

Petitioner has not been damaged and can not be damaged by Registrant's use of its mark when they have represented, in writing, to the Trademark Office, that they have co-existed for some 16 years without any actual confusion, and that condition attends today.

THIRD AFFIRMATIVE DEFENSE:

Petitioner's action is barred by their admitted laches, in failing and refusing to challenge Registrant's use of the registered mark until May of 2009.

WHEREFORE, Registrant, Professional Coatings, Inc., respectfully requests the Board to enter an order awarding the following relief:

1. That the Petition herein be dismissed with prejudice;
2. That the Petitioner take nothing by its Petition;
3. That Registrant be awarded its reasonable attorneys' fees and costs;

and

4. For such other and further relief as the Board may in its discretion deem appropriate.

Dated: August 18, 2009

Respectfully submitted,

/s/ Dennis B. Haase

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Attorney for Registrant/Respondent

CERTIFICATE OF SERVICE

A copy of the foregoing Answer to Petition for Cancellation was mailed by United States mail, postage prepaid to:

Deron A. Cook, Esq.
c/o The Sherwin-Williams Company
1100 Midland Building. - Legal Dept.
101 W. Prospect Avenue
Cleveland, Ohio 44115-1075

on August 18, 2009. A copy was also forwarded by email to Mr. Cook at deron.a.cook@sherwin.com.

/s/ Margaret Haase
Margaret Haase, RP®