

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

HANCOR, INC.)

Opposer,)

v.)

PRINSCO, INC.)

Applicant)

Opposition No. 91159298

Application Serial No. 76/510,143

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APPLICANT'S AMENDED ANSWER TO NOTICE OF OPPOSITION

Prinsco, Inc. ("Applicant"), a Minnesota corporation, located and doing business at 108 Highway 7 West, Prinsburg, Minnesota 56281, hereby answers the Official Notice of Opposition, No. 91159298 filed by Hancor, Inc. ("Opposer") against Applicant's allowed published application to register its trademark, ECOPIPE.

1. Answering paragraph 1 of Hancor's Notice of Opposition, Applicant is currently without sufficient knowledge or information to form a belief as to the truth of the facts related to the allegations contained therein, and therefore denies same.

2. Answering paragraph 2 of Hancor's Notice of Opposition, Applicant denies that Federal Registration No. 2,642,585 is for the mark ECOFIRST. Applicant is currently without sufficient knowledge or information to form a belief as to the truth of the facts related to the remainder of the allegations contained in this paragraph, and therefore denies same.

3. Answering paragraph 3 of said Notice of Opposition, Applicant is currently without sufficient knowledge or information to form a belief as to the truth of the facts related to the allegations contained therein, and therefore denies same.

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4. Answering paragraph 4 of said Notice of Opposition, Applicant is currently without sufficient knowledge or information to form a belief as to the truth of the facts related to the allegations contained therein, and therefore denies same.

5. Answering paragraph 5 of said Notice of Opposition, Applicant is currently without sufficient knowledge or information to form a belief as to the truth of the facts related to the allegations contained therein, and therefore denies same.

6. Answering paragraph 6 of said Notice of Opposition, Applicant admits the allegations of said paragraph.

7. Answering paragraph 7 of said Notice of Opposition, Applicant admits that it does compete directly with the Opposer, to a limited extent only, in the agriculture and commercial markets.

8. Answering paragraph 8 of said Notice of Opposition, Applicant admits that it does sell and distribute corrugated high-density polyethylene pipe of some sizes, and does manufacture pipe using recycled high-density polyethylene, but only in a limited variety and sizes. Applicant admits that Opposer sells and distributes corrugated high-density polyethylene pipe of some sizes. Applicant is without sufficient knowledge or information as to Opposer's current manufacturing capabilities and therefore denies that Opposer manufactures pipe of recycled high-density polyethylene.

9. Answering paragraph 9 of said Notice of Opposition, Applicant admits that it sells and distributes its products in the construction, building, agricultural, recreational, residential, and specialty markets. Applicant is currently without sufficient knowledge or information as to extent of distribution channels of the Opposer, and therefore denies the remainder of this paragraph.

10. Answering paragraph 10 of said Opposition, Applicant admits that it sells its products in some of the same geographical regions as Opposer, and advertises in some of the same publications and at some of the same trade shows. Applicant is without sufficient knowledge to form a belief as to whether "both companies" sell their products in all of the same geographical regions and advertise in all of the same publications and at all of the same trade shows, and accordingly denies the same.

11. Answering paragraph 11 of said Notice of Opposition, Applicant denies that Opposer provided it technology necessary to manufacture pipe from recycled high-density polyethylene, as well as Opposer's false implication that it provided Applicant any such technology gratuitously. Applicant admits, however, that it did receive certain technology from the Opposer, as partial consideration for settlement of Applicant's civil suit for patent infringement against Opposer, to improve upon technology it already possessed for manufacturing pipe from recycled high-density polyethylene, and that it uses said technology to make products it sells under its ECOPIPE mark.

12. Answering paragraph 12 of said Notice of Opposition, Applicant admits that Opposer is the owner of recently issued U.S. Trademark Registration No. 2,765,879 on the un-enforceable Supplemental Register. Applicant is without sufficient knowledge or information to form a belief as to the alleged use to which the Opposer may put the green band referred to therein, and therefore denies the use referred to in said paragraph 12.

13. Answering paragraph 13 of said Notice of Opposition, Applicant states that it initially made limited experimental use of a green shrink-wrap to protect its gasket. Unsatisfied, Applicant shifted to the use of a stronger white shrink-wrap, and continues such usage to date. Applicant denies paragraph 13 in all other respects, including Opposer's alleged speculative

expectations, as Applicant is without sufficient knowledge or information to form a belief as to the truth thereof.

14. Answering paragraph 14 of said Notice of Opposition, Applicant denies that its ECOPIPE mark is of an identical nature to any mark owned by the Opposer, and denies that its goods and services are of an identical nature to those of the Opposer, and denies that its ECOPIPE mark is likely to cause confusion, to cause mistake, or to deceive.

15. Answering paragraph 15 of said Notice of Opposition, Applicant admits that it intends to use the mark ECOPIPE on pipe manufactured from recycled high-density polyethylene pipe. Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegation that such pipe assists in preserving resources and landfill space, or is "ecologically friendly," and therefore denies the same.

16. Answering paragraph 16 of said Notice of Opposition, Applicant denies that its ECOPIPE mark is merely descriptive, irrespective of any use to which it may be put and irrespective of the Opposer's unwarranted presumptions with respect to its anticipated usage. Applicant reincorporates its answer from paragraph 15 above, and therefore denies that such pipe is "ecologically friendly."

AFFIRMATIVE DEFENSES

1. Applicant is the owner of Federal Registration No. 2,802,952 for the distinctive mark ECO-PIPE SUPREME covering recycled high-density polyethylene pipe, the application for which was filed on an intent-to-use basis on June 7, 2001, well prior to Opposer's date of alleged first usage of the word ECOFIRST and Design as claimed in Registration No. 2,642,585, or any alleged

use of the word ECOFIRST apart from any design element. Applicant's use of such mark has been valid in the ordinary course of trade without abandonment. As such, Opposer has had full, clear and unequivocal advance legal notice of Applicant's intent to adopt and use a trademark, the salient portion of which is virtually identical to ECOPIPE. Opposer is therefore estopped from now opposing Applicant's application to register ECOPIPE based on alleged priority of rights and likelihood of confusion.

2. Applicant's first usage of ECOPIPE in commerce antedates Opposer's date of alleged first usage of ECOFIRST and Design as claimed in Registration No. 2,642,585, or any alleged use of the word ECOFIRST apart from any design element, and such use by Applicant has been valid in the ordinary course of trade without abandonment. Accordingly, Opposer's opposition fails to state a claim upon which relief can be granted.

3. On information and belief, Opposer's only mark is comprised of a distinctive design element in combination with the term ECOFIRST as shown in Registration No. 2,642,585, not the word ECOFIRST used alone, as alleged by Hancor, and ECOPIPE clearly is not confusingly similar with Opposer's combination mark.

4. On information and belief, Opposer's alleged mark ECOFIRST is not entitled to protection under Federal, State, or common law, because Opposer has made no use of the mark ECOFIRST alone, as alleged by Opposer, and therefore has developed no goodwill or rights in and to the mark ECOFIRST, used alone as alleged by Opposer.

5. On information and belief, Opposer is not entitled to rely on its alleged trademark rights in the mark ECOFIRST in opposing Applicant's application to register the mark ECOPIPE because Applicant has developed prior and/or intervening rights over Opposer to use the mark ECOPIPE as a trademark on plastic drainage pipe made of recycled polyethylene.

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