

ESTTA Tracking number: **ESTTA33909**

Filing date: **05/25/2005**

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

Proceeding	78159585
Applicant	Ted Lansing Corporation
Correspondence Address	Robin C. Vance McGuireWoods LLP One James Center 901 E. Cary Street Richmond, VA 23219 UNITED STATES rvance@mcguirewoods.com, jpeyton@mcguirewoods.com
Submission	Applicants Request for Remand and Amendment
Attachments	585RequestforRemandConsent.pdf (2 pages) GliddenConsentAgreement.pdf (3 pages)
Filer's Name	Robin C. Vance
Filer's e-mail	rvance@mcguirewoods.com
Signature	/Robin C. Vance/
Date	05/25/2005

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

REQUEST FOR REMAND

Mark: WINDJAMMER

Serial Number: 78/159,585

Filing Date: August 30, 2002

Applicant: Ted Lansing Corporation
8501 Sanford Drive
Richmond, VA 23228

Applicant's Attorney: Robin C. Vance
McGuireWoods LLP
One James Center
901 East Cary Street
Richmond, Virginia 23219
Direct Dial: 804.775.1071
Direct Fax: 804.698.2007
E-Mail: rvance@mcguirewoods.com

Applicant filed the present application to register the mark WINDJAMMER (the "Mark") for "building materials, namely decking boards; non-metal vinyl siding and installation components therefor, namely J-channels, outside corner posts, inside corner posts, starter strips and utility trim; nonmetal soffits; non-metal fencing; and non-metal gates," in International Class 19 (as amended by way of a Response to Office Action filed August 27, 2003). An Office Action was issued in connection with the application on February 28, 2003, and a Final Refusal was issued thereafter, on February 10, 2004. The Examining Attorney has refused registration of Applicant's Mark under Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d), asserting that Applicant's Mark is likely to be confused with the registered mark WIND JAMMER (United States Registration Number 2,563,508) (the "Cited Mark").

Applicant timely appealed to the Trademark Trial and Appeal Board the decision of the Trademark Examining Attorney refusing registration, dated February 10, 2004. Applicant's Notice of Appeal was received by the Trademark Trial and Appeal Board on August 10, 2004. Applicant has been diligently negotiating a consent agreement with the owner of the Cited Mark that may prove helpful in resolving the subject proceeding. The parties have executed a

final agreement with respect to these matters (the "Consent Agreement"), which Consent Agreement Applicant submits herewith.

Pursuant to the Consent Agreement, Applicant has agreed not to use or seek formal protection for the Mark in connection with caulking, which good served as the basis for the Examining Attorney's previous Office Action and Final Refusal. Accordingly, Applicant hereby requests the Trademark Trial and Appeal Board to remand the subject application for the Mark for the Examining Attorney's consideration of the attached Consent Agreement. See Trademark Trial and Appeal Board Manual of Procedure §§1205.01 and 1209.04 (2004) (providing that the Trademark Trial and Appeal Board should grant an applicant's Request to Remand if such would obviate a ground for refusal) [hereinafter, TBMP]. Applicant asserts that the Consent Agreement will resolve the present objection.

Consequently, pursuant to TBMP §1205.01, Applicant has filed this Request for Remand with the Trademark Trial and Appeal Board, with the understanding that, if granted, the subject appeal proceedings will be suspended and the matter will be remanded to the Examining Attorney for consideration. Applicant respectfully requests that the Examining Attorney consider the attached Consent Agreement, withdraw the previously issued Final Refusal and approve the application for publication.

Respectfully submitted,

Ted Lansing Corporation

By: Robin C. Vance
Robin C. Vance

Counsel to Applicant

Robin C. Vance
McGuireWoods LLP
One James Center
901 East Cary Street
Richmond, Virginia 23219
Direct Dial: 804.775.1071
Direct Fax: 804.698.2007
E-Mail: rvance@mcguirewoods.com

CONSENT TO REGISTRATION AND USE OF TRADEMARKS

THIS CONSENT TO REGISTRATION AND USE OF TRADEMARKS (the "Agreement") is made as of the 11th day of May, 2005 (the "Effective Date") between Ted Lansing Corporation, a Virginia corporation with its principal place of business at 8501 Sanford Drive, Richmond, VA 23228 ("TLC"), and The Glidden Company, a Delaware corporation with its principal place of business at 15885 West Sprague Road, Strongsville, Ohio 44136 ("Glidden").

Recitals of the Parties

A. In various forms, TLC represents that it has used, and continues to use and desires to federally register with the United States Patent and Trademark Office ("PTO") the trademarks WINDJAMMER and WINDJAMMER BY TED LANSING CORPORATION and DESIGN, identified in the U.S. trademark applications identified by Serial Nos. 78/159,585 for the goods of building materials, namely decking boards; non-metal vinyl siding and installation components therefor, namely J-channels, outside corner posts, inside corner posts, starter strips and utility trim; nonmetal soffits; non-metal fencing; and non-metal gates; 78/975,163 for the goods of building materials; namely non-metal windows, non-metal patio doors; and non-metal rails; and 78/975,174 (collectively, the "TLC Marks").

B. Glidden owns, uses and/or has registered with the PTO the trademark WIND JAMMER (Reg. No. 2,563,508) in connection with sealants for elastomeric weather stripping and otherwise sealing doors, windows, and other openings or voids in residential and commercial buildings (the "Glidden Mark").

NOW, THEREFORE, in consideration of the following mutual covenants, the receipt and sufficiency of which are hereby acknowledged, the parties agree as follows:

1. Consent to Registration. Subject to the following two conditions of (a) and (b):
 - (a) the amendment referenced in Paragraph 2 below is accepted and entered by the PTO to become a part of any registration granted for the TLC Marks; and
 - b) as long as TLC complies with the terms of this Agreement; Glidden hereby consents to the registration at the PTO by TLC of the TLC Marks,
2. Obligations of TLC.
 - (a) TLC agrees to file an amendment ("Amendment") in its pending United States Application Serial No. 78/975,174 within fifteen (15) days from the Effective Date of this agreement seeking to amend the identification of goods listed therein to delete any reference to "caulking".

- (b) TLC further agrees to forward a copy of the Amendment as filed to Glidden.
- (c) TLC hereby agrees to cease use of the TLC Marks in connection with caulking and TLC agrees not to adopt or use any word or design having, including or incorporating the word "Windjammer" in any form for the goods of caulks, caulking, and/or sealants and in any divided trademark applications for the TLC Marks. Notwithstanding the foregoing, the parties agree that TLC may have four 4 months from the Effective Date of this Agreement to exhaust its current inventory of caulking bearing the TLC Marks without violation of this Agreement.
- (d) TLC hereby consents to, and agrees that it will not directly or indirectly take any action to expand the use or registration of the TLC Mark to any caulks, caulking, and/or sealants that are marketed in the same channels.
- (e) TLC agrees that it will not petition to cancel the registration for the Glidden Mark or otherwise challenge the Glidden Mark based on any of TLC's prior common law rights in the TLC Marks. TLC expressly recognizes that Glidden's use and ownership of the Glidden Mark in conjunction with advertising, marketing, offers for sale, and sales of goods as referenced in Paragraph B above does not and shall not infringe any rights held by TLC, including any rights in the TLC Marks, and is not likely to cause confusion or to cause mistake or to deceive the public as to the source, affiliation, connection, or sponsorship of said goods of Glidden with those of TLC.

3. Obligations of the Parties.

- (a) Although the parties know of no actual confusion to date, in the event any confusion arises in the future between the Glidden Mark and the TLC Marks, Glidden and TLC agree to cooperate and find ways to eliminate and minimize that confusion.
- (b) The provisions of this Agreement shall remain in effect until such time that either party abandons (as that term is defined in 15 U.S.C. Section 1127) all of its marks that are the subject of this Agreement.

4. General Provisions

a. Entire Agreement. This document constitutes the entire understanding of the parties with respect to the matters set forth herein and supersedes all prior written and oral understandings between the parties with respect hereto.

b. Further Assurances. The parties agree to cooperate with one another by entering into agreements or providing assistance in the future to further the intent of this Agreement.

c. Notices. All notices shall be in writing and shall be deemed given as follows: (i) if delivered by hand or transmitted by telecopier, on the date of delivery or transmission; (ii) if sent by certified or registered mail, on the fifth business day after the day of sending. Notices shall be sent to the parties at the addresses set forth above (or such other address as may be designated by notice hereunder).

d. Successors. This Agreement shall inure to the benefit and be binding upon the parties and their successors and assigns.

e. Counterparts. This Agreement may be executed in one or more counterparts, each of which shall be deemed an original, but all of which together will constitute one and the same instrument.

IN WITNESS WHEREOF, the parties have caused their duly authorized officers to execute this Agreement as of the date first above written.

THE GLIDDEN COMPANY

By: Cathryn M Fischer
Name: Cathryn M Fischer
Title: V.P. Marketing

TED LANSING CORPORATION

By: Lynn K. Whyte
Name: Lynn K. Whyte
Title: V.P., Administration