

09/09/2003 TTAB

TTAB

Attorney Docket DX-3 (#90545)

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

In the Matter of:
Application Serial No. 75/701,707
Mark: Drawing of a Marine Heat Exchanger
Published in the Official Gazette at Page TM 400 on May 9, 2000



09-08-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

DURAMAX MARINE, LLC)	
)	
)	
v.)	Opposition No. 119,899
)	
R.W. FERNSTRUM & COMPANY,)	
)	
Applicant,)	

Box TTAB – No Fee
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

09-08-2003
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U.S. PATENT & TRADEMARK OFFICE

**OPPOSER'S RESPONSE TO APPLICANT'S CROSS MOTION FOR
SUMMARY JUDGMENT**

I. Introduction

Opposer Duramax Marine, LLC ("Duramax Marine") filed a motion for Summary Judgment on June 27, 2003 on the grounds (1) that R. W. Fernstrum & Company ("Fernstrum") cannot obtain a registration on a realistic picture of a product that it sells, and (2) that Fernstrum is not entitled to change the basis of its application from § 2(e)(1) to § 2(f) of the Trademark Act because the survey used in the Amendment changing the basis of the application to § 2(f) (Ex. 9, p. 2, Bates No. 0076) did not show to those being surveyed the trademark which is the subject of the application being opposed. Fernstrum filed a response ("Applicant's Opposition to Opposer's Motion for Summary Judgment") to the foregoing motion of Duramax Marine, making various factual assertions, and arguing that Duramax Marine failed to present a *prima facie* case that Fernstrum failed to establish

acquired distinctiveness, alleging that Fernstrum has been using its mark for over 50 years and further stating that Fernstrum's registration of a mark showing its keel cooler in front of a globe established that its mark acquired a secondary meaning. Fernstrum also based its response on the factors set forth in *In re Morton-Norwich Products, Inc.*, 213 U.S.P.Q. 9 (C.C.P.A. 1982). Duramax Marine filed a Reply Brief on August 19, 2003 contesting the factual assertions made by Fernstrum, wherein it attacked the basis upon which Fernstrum had established its legal argument with respect to secondary meaning, as well as responding to the functionality arguments set forth in Fernstrum's memorandum. Fernstrum also filed a Cross Motion for Summary Judgment ("Cross Motion"), and it is in response to this Cross Motion that this response brief is directed.

II. Duramax Marine Does have Standing to Bring the Present Opposition.

A. Prior Determination of Standing in the Present Opposition.

The issue of whether opposer Duramax Marine has standing to pursue the present opposition was previously raised in the present opposition by the filing by Fernstrum of its "Memorandum in Support of Applicant's Motion for Judgment on the Pleadings and/or Summary Judgment" on September 13, 2000. Fernstrum made the following statement in the paragraph beginning on the lower part of page 10 of its earlier Memorandum:

While Duramax has pled sufficient facts to show its "standing" to oppose the subject application,...

Thus, whereas Fernstrum previously pleaded that Duramax Marine had sufficient standing to bring the opposition, Fernstrum is now reversing its position.

In the Board's decision rendered on April 26, 2001, with respect to the "Motion to Dismiss" set forth in Fernstrum's motion of September 13, 2000, the Board stated on page 6 of its decision that it was of the opinion that "...opposer has sufficiently alleged standing in this proceeding..." Fernstrum is thus also asking the Board to reverse its earlier

decision on standing. The facts and the law in the present case firmly support that Duramax Marine has standing to participate in the present opposition proceeding, as both Fernstrum and the Board have previously acknowledged.

B. The Requirements for Standing

The Court of Appeals for the Federal Circuit has set forth two bases for standing in *inter partes* cases in general, and in opposition proceedings in particular: (1) the "Real Interest" test for preventing "mere intermeddlers" who do not raise a real controversy from bringing oppositions or cancellation proceedings, and (2) a "Reasonable Belief of Damage" test. *Ritchie v. Simpsons*, 170 F. 3d 1092, 50 U.S.P.Q. 2d 1023, 1025, 1027 (Fed. Cir. 1999).

The "Real Interest" test defines a legitimate opposer in various ways, such as one having a personal interest beyond that of the general public, *Ritchie v. Simpson supra*; a trade association, *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F. 2d 490, 2 U.S.P.Q. 2d 2021 (Fed. Cir. 1987); and two women representing all women, *Bromberg v. Carmel Self Service, Inc.*, 198 U.S.P.Q. 176 (TTAB 1978). Duramax Marine as a direct competitor of Fernstrum, clearly has met the "Real Interest" test, since a competitor clearly has an interest beyond that of the general public and has standing. *Books on Tape, Inc. v. Booktape Corp.*, 836 F. 2d 519, 5 U.S.P.Q. 2d 1301 (Fed. Cir. 1987)

With respect to the "Reasonable Belief of Damage" criteria, the court has said that a party has standing to oppose if it can demonstrate that it has a real interest in the proceeding. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F. 2d 1098, 92 U.S.P.Q. 24, 27 (CCPA 1976). Duramax Marine is hardly a gratuitous interloper and intermeddler willing to spend the time and money in undertaking expensive *inter partes* challenges. 3 *McCarthy on Trademarks and Unfair Competitors*, § 20:11 (4th ed. 2003)

One has standing to oppose where the mark is allegedly descriptive and the opposer has a sufficient interest in using the descriptive term in his business. *De Walt v. Magna Power Tool Corp.*, 289 F. 2d 656, 129 U.S.P.Q. 275 (CCPA 1961). An opposer need not be using the mark as a trademark or even considering doing so. 3 *McCarthy on Trademarks and Unfair Competition*, § 20:11 citing *Cummins Engine Co. v. Continental Motors Corp.*, 359 F. 2d 892, 149 U.S.P.Q. 559 (CCPA 1966). Damage is presumed if the mark is descriptive and the opposer has a sufficient interest to use the term in its business. Damage has been found on the basis that the existence of a registration makes it difficult for an opposer to use a term. *De Walt v. Magna Power Tool Corp. supra* 129 U.S.P.Q. at 280.

Duramax Marine has undoubtedly met the criteria set forth in both bases for establishing standing in an opposition proceeding. Therefore, Fernstrum's allegation that Duramax Marine lacks standing to bring this opposition is clearly without merit.

C. Duramax Marine has One-Piece Keel Coolers Manufactured and Sells Such Keel Coolers.

Duramax Marine has manufactured for itself and sells one-piece keel coolers which are directly competitive with the keel coolers sold by Fernstrum. All of the litigation which has occurred to date between Fernstrum and Duramax Marine, except for the present opposition, was brought by Fernstrum in an effort to curtail the sales by Duramax Marine of one-piece keel coolers. Fernstrum has also brought a suit against East Park Radiator & Battery Shop, Inc. (Ex. 11), and has brought a counterclaim against Donovan Marine, Inc. (Ex. 7), both in the Eastern District of Louisiana in cases also relating to keel coolers, in which Duramax Marine was in effect an unnamed party. The litigation in the federal court in New Orleans included as a main issue whether Fernstrum would be able to enforce its alleged trademark rights to the configuration of the coolant flow tubes extending between

the headers of its keel cooler. Fernstrum abandoned its application to register the three dimensional configuration of its keel coolers and settled that litigation as noted in various places in this opposition proceeding. Fernstrum also filed a lawsuit (Ex. 14) against Duramax Marine in the federal court in the Western District of Michigan alleging that an advertising slogan ("Best By Test") used by Duramax Marine was not true, and Fernstrum lost its motion for preliminary injunction in that case and subsequently withdrew the litigation. It then filed a complaint in the National Advertising Division of the Council of Better Business Bureaus ("NAD"), and the NAD dismissed that litigation (Ex. 16) when Duramax Marine explained that it had stopped using that advertisement, although the decision from the Western District of Michigan included in its decision commentary that Fernstrum was found not to be able to establish the falsity of the advertising claims of Duramax Marine. (Ex. 15, pp. 19-22)

Fernstrum states that Duramax Marine may not manufacture or promote keel coolers with rectangular headers on page 18 of its Cross Motion brief. That is correct; however, neither Duramax Marine nor East Park will be required to use the beveled header in the event that Fernstrum no longer uses a header configuration consisting of a vertical edge on the aft and fore end of the headers of its keel coolers pursuant to the settlement agreement in the New Orleans litigation. (Ex. 13, par. 11, p. 7)

More importantly, the keel cooler marketed by Duramax Marine (Ex. 35) is very similar to that marketed by Fernstrum (Ex. 24), since the beveled portion of the Duramax Marine keel cooler does not make it look that much different from the one-piece keel cooler of Fernstrum. Indeed, a view of the Duramax Marine keel cooler can be made in views from any of a number of a range of angles, and some of those views would look nearly identical to the keel cooler of Fernstrum. Just because Duramax Marine cannot

make keel coolers with rectangular headers does not mean that drawings of keel coolers of both parties cannot appear very similar to each other.

In addition, Sean Fernstrum, a Vice President of Fernstrum who testified on behalf of Fernstrum, stated that if he saw a lined drawing of the Duramax Marine keel cooler as shown in Ex. 35, without the two cross brackets and bolts that go across the coolant flow tubes, he would bring this to the attention of the other officers at Fernstrum with respect to whether an infringing situation had occurred. (Ex. 46, Fernstrum Deposition, p. 51-53, attached).

Fernstrum states the following on the paragraph beginning page 19 of its present Cross Motion brief:

On this record, there is no genuine issue of material fact regarding Duramax' lack of standing. Duramax is not in a position to either manufacture or advertise...a keel cooler with rectangular headers...Accordingly, Fernsturm's motion for summary judgment should be granted and the opposition should be dismissed.

The foregoing is not the case. Duramax Marine, as a direct competitor of Fernstrum, has standing because it has an interest in the outcome beyond that of the general public. 3 *McCarthy on Trademarks and Unfair Competition* §21:7, citing *Books on Tape, Inc. v. Booktape Corp.*, 836 F. 2d 519,5 U.S.P.Q. 2d 1301 (Fed. Cir. 1987). Standing to oppose is presumed when the mark sought to be registered is allegedly descriptive of the goods and the opposer is one who has a sufficient interest in using the descriptive term in his business. 3 *McCarthy supra*, §20:11, citing *DeWalt, Inc. v. Magna Power Tool Corp.*, 289 F. 2d 656, 129 U.S.P.Q. 275 (C.C.P.A. 1961); *Federal Glass Co. v. Corning Glass Works* 162 U.S.P.Q. 279 (T.T.A.B. 1969).

In the present situation, the mere existence of a registration of a picture of Fernstrum's keel cooler as shown in U.S. Serial No. 75/701,707 will make it more difficult for Duramax Marine to use a similar picture of its own product, since a registration by Fernstrum would be evidence of its right to the exclusive use of that term as a trademark, rather than as a descriptive term. 3 *McCarthy on Trademarks and Unfair Competition*, supra at § 20.11 The mere registration of a picture of its keel cooler by Fernstrum would give it the opportunity to harass Duramax Marine in its use of a picture of its own product, further establishing that Duramax Marine has standing in the present opposition. *Sunline, Inc. v. Confection Products Corp.*, 159 U.S.P.Q. 688, 689 (T.T.A.B. 1968).

It is respectfully submitted that both the facts and the law fully support the denial by the Board of Fernstrum's Motion for Summary Judgment.

III. Equitable Estoppel

A. Duramax Marine Renews Its Opposition To Applicant Fernstrum's Motion for Summary Judgment.

As explained in opposer Duramax Marine's response dated October 13, 2000, to applicant Fernstrum's Motion for Summary Judgment, paragraph 15 of the Settlement and Mutual Release Agreement (Ex. 13) said that Fernstrum would abandon its Serial No. 75/382,850 for its functional configuration of the coolant flow tubes in its actual one-piece keel cooler, and included the following sentence:

Nothing herein shall preclude Fernstrum from seeking to register, in two-dimensional format, its trademark logo featuring its one-piece keel cooler as part of said design. (Emphasis added)

There was no statement made or suggested that Duramax Marine or any party to that Settlement and Mutual Release Agreement could not oppose such an application or petition to cancel any registration that would issue to Fernstrum on such application.

As explained in "Opposer's Reply Brief" dated August 19, 2003, at Section III(B) on page 3, Fernstrum, as well as the parties to that litigation and Duramax Marine were all represented by trademark counsel who knew that any published trademark application would be subject to an opposition. Fernstrum admitted that the Settlement Agreement had no language preventing the filing of an opposition to register its logo in two-dimensional form. (Ex. 42, Adm. 9)

Moreover, the language from paragraph 15 of the "Settlement and Mutual Release Agreement," (Ex. 13) quoted above, says that nothing shall preclude Fernstrum from filing a trademark application "as part of said design." The term "as part of said design" indicates that the drawing of Fernstrum's keel cooler would be a part of its trademark application, such as the trademark in Fernstrum's Reg. No. 2,357,354 (Ex. 20) showing Fernstrum's keel cooler in front of a globe. In the service mark application being opposed herein, Serial No. 75/701,707 shows only a drawing of Fernstrum's keel cooler. The keel cooler is not a part of the design, it is the entire design. Thus, even Fernstrum did not have the present service mark in mind when it prepared and executed the "Settlement and Mutual Release Agreement."

Thus, the facts upon which Fernstrum is basing its Motion for Summary Judgment simply do not exist. Fernstrum's Motion for Summary Judgment on this basis alone should be denied.

B. The Cases Cited by Fernstrum Do Not Support Its Request for Equitable Estoppel.

In the portion of its Cross Motion brief entitled "Controlling Authority" commencing on page 20, Fernstrum cites a number of cases; however, none of these cases have facts which would support their assertion that they are entitled to summary judgment. In *Wells Cargo, Inc. v. Wells Cargo, Inc.*, 606 F.2d 961, 203 U.S.P.Q. 564, 567 (C.C.P.A.

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1979), a first company had earlier applied to register the trademark WELLS CARGO and the opposer filed an opposition claiming prior use. The first company withdrew its application "with prejudice to its right to file a similar application in the Patent Office at a later date." The Opposer consented to the withdrawal "upon the condition that it is withdrawn with prejudice." The first opposition was dismissed. A second company, the successor-in-interest to the first company, filed another application for the same mark, and the original Opposer filed a second notice of opposition, and alleged that estoppel existed because the predecessor of the second company had filed a withdrawal with prejudice. The CCPA held that equitable estoppel was in effect because of the first company's withdrawing of its prior application with prejudice. In the present case, Fernstrum had abandoned its first application because its coolant flow tubes were functional, and made no agreement regarding any other trademark application it would file. Neither party who was an adversary of Fernsturm in the litigation in New Orleans nor Duramax Marine ever made any agreement, either expressly or by implication, not to oppose any two-dimensional application filed by Fernstrum.

Turning next to *Roux Laboratories, Inc. v. La Cade Products Company*, 558 F. 2d 33, 194 U.S.P.Q 542, 544 (C.C.P.A. 1977), the defendant filed an application to register the trademark ULTRA MINK (with a disclaimer on the work MINK apart from the mark as shown), and it was opposed both based on prior use of the trademark WHITE MINX, and on a Supplemental Registration of WHITE MINX. The Opposer, through cross-examination, withdrew and abandoned its cause of action based on likelihood of confusion and left only the issue of descriptiveness as the basis for the opposition. During the cross-examination, the Opposer, through its testimony, restricted the opposition to the issue of whether the term "ultra" was merely descriptive, and the Board held that the Opposer had

abandoned the cause of action based on confusion. The CCPA affirmed the Board. In the present situation, Duramax Marine never withdrew its right to oppose the service mark of Fernstrum in any respect, and as stated throughout this opposition it did not do so in the settlement agreement; this is clear from a reading of the "Settlement and Mutual Release Agreement" (Ex. 13), from Fernstrum's admission that the Agreement did not preclude an opposition (Ex. 42, Adm. 9), and not from some misinterpretation of Paragraph 15 of the Agreement (Ex. 13) since Fernstrum was represented by its trademark lawyer who prepared the settlement agreement.

With respect to *MWS Wire Industries, Inc. v. California Fine Wire Co., Inc.* 797 F. 2d 799, 230 U.S.P.Q. 873, 875 (9th Cir. 1986), the plaintiff had a registration for the mark MULTIFILAR, and accused the defendant of infringing its registration. The two parties signed a settlement agreement in which the defendant acknowledged the validity of the trademark and said it would not use any confusingly similar trademark in the future. Subsequently, the plaintiff sued the defendant for trademark infringement, and the defendant convinced the District Court that the trademark registration was invalid. The Ninth Circuit Court of Appeals reversed and remanded the decision since it said that the settlement agreement, if valid, precluded the District Court from considering the validity of the trademark registration. While the Circuit Court said that there was an "overriding public interest in settling and quieting litigation," that case differed from the present opposition in that there was no provision in the present settlement agreement made to preclude the present opposition. In *Beer Nuts, Inc. v. King Nut Co.*, 477 F. 2d 326, 177 U.S.P.Q. 609, 610-11 (6th Cir. 1973), *cert. denied*, 414 U.S. 858 (1973), King Nut Co. had entered into a settlement agreement with the predecessor of Beer Nuts, Inc. and stipulated that the predecessor owned the mark BEER NUTS and that the latter trademark was valid.

In a subsequent trademark infringement case, the Court of Appeals for 6th Circuit affirmed summary judgment that King Nut Co. was estopped from contesting the mark's validity due to the settlement agreement. This is distinguishable from the present case since Duramax Marine never agreed that the two dimensional picture by Fernstrum of its keel coolers was a valid trademark. In *Danskin, Inc. v. Dan River, Inc.*, 182 U.S.P.Q. 370 (CCPA 1974), Danskin sued Dan River in response to Dan River's oppositions against two of Danskin's applications. Following a detailed settlement agreement, the suit and one opposition were dismissed. Danskin agreed to abandon or sign to Dan River the mark involved in the other opposition and to refrain from opposing any Dan River applications for registration of a "Dan" mark. When Danskin opposed an application of Dan River for DANSHEER, Dan River moved for summary judgment asserting equitable estoppel against Danskin. Unlike the latter case, Duramax Marine never agreed not to oppose any applications for registration of a mark of Fernstrum, and cannot be estopped from opposing Fernstrum's present application to register a picture of its keel cooler.

Finally, *MarCon Ltd. v. Avon Products, Inc.* 4 U.S.P.Q. 2d 1474 (T.T.A.B. 1987), is also distinguishable. MarCon had opposed the application of Avon to register AVON SILKEN SOAP. Avon was estopped from pursuing the opposition because of a settlement agreement relating to the use of trademarks bearing the word SILK. The agreement in effect precluded the opposer from contesting or interfering in any way with Avon's use or registration of any trademark including the word SILK. The Agreement further gave the applicant an irrevocable license to use the trademark SILK in connection with the relevant goods. This differs from the present facts in that Duramax Marine never agreed not to contest or interfere with Fernstrum's use or registration of the mark in question, and there was certainly no license involved.

The cases cited by Fernstrum do not support its position that Duramax Marine is estopped from commencing and proceeding in this opposition proceeding.

C. Duramax Marine did not Expressly or Implicitly Agree that Fernstrum Could Register Its Mark.

Fernstrum quotes at Section III(B)(3) on page 21 of its Cross Motion brief, a paragraph from Duramax Marine's "Brief in Support of Motion for Summary Judgment," stating that the settlement agreement said Fernstrum could file a new trademark application, and that there was nothing in the agreement precluding an opposition by Duramax Marine thereto. Fernstrum states that Duramax Marine, as an "afterthought," now wishes to oppose the application. That is not the situation that occurred when the settlement agreement was entered; Duramax Marine has always contemplated filing an opposition if Fernstrum applied simply to register a picture of its keel cooler. As noted earlier, Paragraph 15 of the Settlement Agreement included the provision that nothing in the settlement agreement would preclude Fernstrum from seeking to register, in two dimensional design format, its trademark logo featuring its one-piece keel cooler "as part of said design." The term "part of" means that the picture of Fernstrum's keel cooler would be part of its trademark logo and not constitute the entire logo. Further, and as noted several times herein, there was nothing precluding the filing of an opposition against a trademark (or service mark) application of Fernstrum. This was well understood since the settlement agreement was negotiated by a number of trademark attorneys.

Moreover, Paragraph 18 of the "Settlement and Mutual Release Agreement" (Ex. 13) recites in its relevant portion the following:

18. Fernstrum stipulates and agrees that in the event Duramax or East Park files a trademark application(s)... which includes the two dimensional design of their beveled one-piece keel cooler, Fernstrum will not oppose or otherwise contest said application and

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Fernstrum will not file a petition or other proceeding to cancel any registration issuing from said trademark application. (Emphasis added)

In this same settlement agreement, Fernstrum agreed not to oppose or petition to cancel a trademark application of Duramax Marine or East Park, yet now wants the omission of that term to be ignored in the portion of the settlement agreement which it is trying to apply against Duramax Marine. This further emphasizes the mischievous behavior which Fernstrum has demonstrated throughout this opposition proceeding as well as other proceedings against its competitors.

D. Fernstrum Did Not Rely on the Agreement Between the Parties to the Earlier Litigation in Which It Attempted to Enforce Its Alleged Trademark on the Coolant Flow Tubes in Its Keel Cooler.

For the first time in this opposition proceeding, Fernstrum is now alleging under Section III(B)(4) (second occurrence) on page 22 of its Cross Motion brief, that Duramax Marine has implicitly said it would not oppose Fernstrum's present mark because of Paragraph 17 of the "Settlement and Mutual Release Agreement" (Ex. 13). Paragraph 17 states that Duramax Marine would not take any action against Fernstrum arising in any way from the facts and/or claims asserted or arising in any way from the facts asserted in the litigation in the Eastern District of Louisiana. The two dimensional picture of the Fernstrum's keel cooler was not an issue in that litigation, and of course Fernstrum's application to register the latter logo was not involved therein. Fernstrum alleges that it agreed to withdraw its previously filed trademark application for the three dimensional configuration of its one-piece keel cooler (although, in fact, the application was for the configuration of the coolant flow tubes having a rectangular cross section which extend between the headers, and not the entire one-piece keel cooler). Fernstrum further says that it had the "reasonable understanding that it would not be precluded from seeking to

register, in two dimension design format, its trademark logo featuring the one-piece keel cooler." This is a misstatement of what occurred.

As noted previously in the proceedings relating to Duramax Marine's Motion for Summary Judgment, Fernstrum withdrew its earlier application in response to the suggestion of District Judge Lemmon, who had advised Fernstrum to attempt to settle the litigation after it had put on its case. This was not a trade off as Fernstrum suggests, but rather a way for Fernstrum to get out of the litigation with as little damage to itself as possible.

Fernstrum asserts that it agreed to withdraw its previously filed application with the understanding that it would not be precluded from seeking to register in two dimensional form its trademark logo featuring the one-piece keel cooler. However, in the settlement agreement, it said that nothing would preclude Fernstrum from registering its trademark logo as part of its design, and not as the entire design. The present application may have been an afterthought of Fernstrum, rather than the opposite as it alleges.

Fernstrum states in the paragraph at the bottom of page 22 of its Cross Motion brief, that Duramax Marine entered into the "Settlement and Mutual Release Agreement" with full and actual knowledge that Fernstrum was actually using its logo as a service mark in connection with the custom manufacture of keel coolers. Although Duramax Marine did know that Fernstrum was using its picture of its keel cooler with its advertisements for many years, it did not understand that it was used as a service mark in connection with such custom manufacture.

Fernstrum also says that Duramax Marine knew that Fernstrum would be filing a new application for its logo once it abandoned the earlier application for a three dimensional configuration. As explained earlier, Fernstrum did not abandon its application

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to register the three dimensional configuration of the coolant flow tubes in exchange for filing the present application, but rather abandoned it as a result of statements made by District Judge Lemmon in the District Court in New Orleans. Furthermore, Fernstrum never indicated that it was going to file a new application on the two dimensional drawing of its keel cooler, since it said in the Settlement Agreement that the drawing of the keel cooler would be part of Fernstrum's trademark logo featuring its one-piece keel cooler. (Ex. 13, Par. 15) Duramax Marine did not know that Fernstrum would file an application to register a mark consisting exclusively of a picture of its keel cooler.

Fernstrum goes on to state in the latter paragraph at the base of page 22 of its Cross Motion brief that the very crux of the Agreement was to finally resolve the trademark and trade dress rights in Fernstrum's trademark logo. That was not the crux of the Agreement. As explained above, the crux insofar as Fernstrum was concerned was to get it out of the litigation in the District Court in New Orleans. Fernstrum is trying to change the issue in these proceedings to give to it what it feels are its "just trademark rights." The law simply will not permit an applicant to register a picture of the very product it sells, and Fernstrum's argument to the contrary should not stand. The first full sentence on page 23 of its Cross Motion brief has a statement that Fernstrum would receive no consideration for the abandonment of its prior application. The consideration which Fernstrum received was to be released from the litigation which could have been devastating to Fernstrum had it been required to pay attorney's fees, for example, and had nothing to do with the present application.

IV. Conclusion

In concluding its Cross Motion brief, Fernstrum argues that Duramax Marine induced Fernstrum to settle the trade dress civil litigation by agreeing that Fernstrum could file the application to register the mark which is the subject of the present opposition. Fernstrum goes on to say that it cannot understand how Duramax Marine could possibly be damaged by the mark sought to be registered, since they have different configurations of their headers. Fernstrum is misstating the entire situation. The keel coolers of Fernstrum and Duramax Marine are very similar in appearance, and pictures of their respective goods could also be very similar. Without rehashing the disputes between the two parties to this opposition, Duramax Marine wishes to point out that Fernstrum has been the instigator in every litigation against its competitors on trademark grounds except for the present opposition. Fernstrum has been unsuccessful in each of its lawsuits to curtail the manufacture and sale of one-piece keel coolers of Donovan Marine, East Park Battery and Radiator Shop and Duramax Marine. Fernstrum is now trying to register a realistic picture of its keel cooler. In an effort to move the basis of its application to § 2(f) of the Trademark Act, it filed a misleading survey purporting to establish the existence of acquired distinctiveness or secondary meaning of its mark, when those who participated in the survey were not even shown the mark that is the subject of the present opposition. Duramax Marine strongly believes that its Motion for Summary Judgment should be granted. The Cross Motion for Summary Judgment filed by Fernstrum should be denied

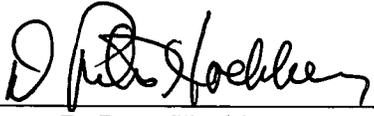
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since neither the facts nor the law support its case, and the facts themselves set forth by Fernstrum are certainly not conclusive.

Respectfully submitted,

Date: August 29, 2003

DPH/kh
Att.: Exhibits

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

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Applicant,)

Opposition No. 119,899

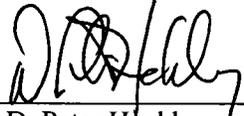
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CERTIFICATE OF SERVICE

I hereby certify that the foregoing Opposer's Response to Applicant's Cross Motion for Summary Judgment, and any document noted as being enclosed or attached, was served via first class U.S. mail, postage prepaid, on the date noted below to:

Samuel D. Littlepage, Esq.
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Washington, DC 20036-3506

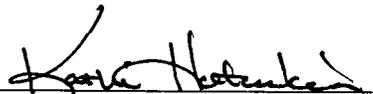
Date: August 29, 2003

By: 
D. Peter Hochberg

CERTIFICATE OF MAILING

I hereby certify that the foregoing Opposer's Response to Applicant's Cross Motion for Summary Judgment, and any document noted as being enclosed or attached, was filed via Express Mail (No. EV203147513US), postage prepaid, on the date noted below to: Box TTAB – No Fee -, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513

August 29, 2003
Date


Kathi Hotchkiss

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



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Opposer,

v

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R.W. FERNSTRUM & COMPANY,

Applicant

DEPOSITION OF R.W. FERNSTRUM AND COMPANY

VIA SEAN FERNSTRUM

DAY TWO OF TESTIMONY

Taken by the Opposer on the 16th day of April, 2003 at

the office of Jonathan P. Barstow, 104 Sixth Ave.,

Menominee, Michigan at 9:09 a.m.

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03/09/2003TTAB

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1 two. I can't speak--on a hypothetical situation about a
2 hypothetical individual viewing this hypothetical drawing
3 in this hypothetical case.

4 BY MR. HOCHBERG:

5 Q But that--of course, that would be the case in--in any
6 infringement situation. I mean you don't know--you don't
7 know what goes through the mind of--of the--of a potential
8 buyer would you?

9 MR. BERGSMAN: Objection, form of the question.

10 MR. HOCHBERG: You're shaking your head but you
11 have to answer.

12 THE WITNESS: I--I--I--I don't know what goes
13 through the mind of--of a customer at an--at any given
14 time.

15 MR. HOCHBERG: Let's go off the record.

16 (Off the record at 10:29 a.m - Back on the record at
17 10:31 a.m.)

18 MR. HOCHBERG: We'll mark this page number 1098
19 as another Exhibit. It'll be Exhibit 24.

20 BY MR. HOCHBERG:

21 Q I'm gonna show you Exhibit 24, and ask if you could
22 identify that product?

23 A It appears to be a competitors Keel Cooler.

24 Q And, do you know which competitor that would be?

25 A No.

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1 Q Which--which--who are the possibility--which are the
2 possible competitors?

3 A Duramax and East Park Radiator.

4 Q Now, if you saw a picture like that in a trade journal, as
5 a promotional piece of material, would you consider that
6 as possibly being an infringing situation, if you were
7 enable to get a registration on your present Mark?

8 MR. BERGSMAN: Excuse me. I just want to
9 clarify. Are you saying that it's a photograph?

10 MR. HOCHBERG: I'm not saying anything. I'm
11 asking him to identify it.

12 MR. BERGSMAN: Do you know what that is?

13 THE WITNESS: It appears to be a photograph of a
14 competitors Keel Cooler. If I saw this--this, what
15 appears to be a photograph, and used for advertising
16 purposes, no, I would not believe that it would infringe.

17 BY MR. HOCHBERG:

18 Q Now, suppose it were modified to, say to remove those two
19 cross brackets between the two nozzles that have an--I
20 think they each have a single bolt extending further--

21 A Two bolts.

22 Q Two bolts.

23 A Two bolts on each..

24 Q Okay. Suppose they were removed. Would that--would that
25 change your opinion?

