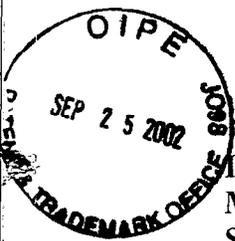


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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD



IN THE MATTER OF:
MARK:
SERIAL NO.
DATE OF PUBLICATION:

Miscellaneous Design
75/869,343
August 27, 2002

AMERICAN FLANGE &)
MANUFACTURING CO., INC.,)
)
Opposer,)
)
v.)
)
RIEKE CORPORATION,)
)
)
Applicant.)



09-25-2002
U.S. Patent & TMO/TM Mail Rcpt Dt. #61

Opposition No. _____

NOTICE OF OPPOSITION

In the matter of Application Serial No. 75-869,343 (the "Application") to register a "Miscellaneous Design" in International Class 6 by Rieke Corporation ("Applicant"), which was published in the August 27, 2002 Official Gazette, American Flange & Manufacturing Co., Inc. (hereinafter "Opposer"), a Delaware corporation having a principal place of business at 290 E. Fullerton Ave., Carol Stream, Illinois 60188, believes that it is and will be damaged by the registration of the mark shown in the Application and hereby opposes the Application on the following grounds under the provisions of Section 13 of the Trademark Act of July 5, 1946 (15 U.S.C. § 1063):

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TRADEMARK TRIAL AND
APPEAL BOARD

BACKGROUND FACTS

1. Applicant and Opposer are both in the business of manufacturing and marketing closures for containers, including flange and plug assemblies for use with steel drums. Such flange and plug assemblies are commonly understood in the steel

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drum industry as comprising three general constructions known as "Type I," "Type II" and "Type III" closures (Type III closures are not relevant to these proceedings), as defined by federal purchasing specification No. PPP-P-420B, a copy of which is attached hereto as Exhibit A. This specification has been effective at least between 1972 and 1994, and Type I and Type II closures are also the subject of the 1999 draft International Standards Organization (ISO) Specification ISO/DIS 15750-3 (Exhibit B), wherein Type I and Type II are referred to as Type A and Type B, respectively.

2. In a Type I closure, an internally-threaded, octagon-shaped flange is inserted in a drum wall around an opening, with a rubber gasket therebetween, forming a liquid-tight seal. A cup-shaped plug having an internal wrench-engaging insert is then screwed into the flange. A Type I plug has a circular head beneath which a narrow, ring-type gasket is positioned to seal against the surrounding flange. A copy of a page from Opposer's website demonstrating one of its Type I plugs is attached hereto as Exhibit C. (See also Exhibit B at Annex A.)

3. Type II closures are configured differently. Drums with which Type II closures are used are formed with a raised annular portion surrounding the drum opening. A Type II serrated-base flange is inserted in the drum wall creating an annular drum wall surface surrounding the flange opening. A Type II plug having an internal wrench-engaging insert is then screwed into the flange. The Type II plug has a wide, hexagonally-shaped head for gripping, beneath which a flat, washer-type gasket is positioned to seal directly against the surrounding drum wall. The federal specification PPP-P-420B provides that the head of a Type II plug must be hexagonal in shape (see Exhibit A at 5), and this construction is also shown in the ISO Specification (Exhibit B at

Annex B.3). The ISO Specification also shows that the central grip has a butterfly shape.

(Id.)

4. Although both Type I and Type II closures provide seals for drum containers, the two types of closures perform differently in certain applications. For example, a significant market segment in the steel drum industry is for recycled, or “reconditioned,” drums. Such drums are rendered fit for re-use by subjecting them to very high heat to burn away residues of previous contents, such as chemicals. This burning operation, however, also destroys the flange gaskets used in the above described closures. Because Type I closures rely on the use of flange gaskets to provide a tight seal against the drum wall, Type I closures function less well in this significant market segment than Type II closures, where the plug seals directly on the drum wall, unaffected by the reconditioning process.

5. The “Miscellaneous Design” that Applicant is seeking to register for a “metal closure fitting for drum containers” in International Class 6 (the “Proposed Mark”) includes at least two design features in which Applicant is specifically asserting trademark protection, including the butterfly-shaped grip situated in the center of the plug, and the above-discussed overall hexagonal shape of the plug, namely, the hexagonal shape of the head extending from the body of Applicant’s plug.

6. Opposer at one time had registered the configuration of its Type I closures with the PTO. Opposer’s earlier two registrations, however, are no longer in force. One registration expired in 1985, and the other was cancelled at least as early as January 2001. See Exhibit D (Trademark Status Reports from PTO website).

7. Applicant is not the only entity that has marketed Type II plugs having hexagonal heads. For example, a company called Allen-Stevens marketed and distributed such plugs in the 1970s and 1980s. A company called Contech Ltd. in Louisiana also marketed and distributed such plugs during the 1980s and 1990s. Upon information and belief, Applicant paid Contech to cease its marketing and distribution of these plugs. Currently, a company called Rahil International imports, markets and distributes these plugs, and has done so for several years. These facts are commonly known in the steel drum industry.

8. In responding to an Office Action dated May 11, 2000 rejecting the Proposed Mark on grounds of functionality, Applicant's agent stated that, to the best of Applicant's knowledge, "the actual configuration is not, and has not been, the subject of a utility or design patent." (See Exhibit E, Response dated November 10, 2000, at 3.) As support, Applicant attached and cited to a number of patents it owned dating largely from the 1920s and 1930s. However, several of these patents disclosed hexagonal heads and claimed polygonal wrench heads as useful features. For example, U.S. Patent No. 1,838,285, entitled "Bung for Containers" and owned by Applicant, is attached hereto as Exhibit F. The patent shows a bung, or closure, for a container, with a hexagonal shaped head 2 having an upstanding rim 3 for forming a wrench head. The polygonal wrench head shape was claimed as recited at page 2 of the specification.

9. Applicant's agent claimed in the November 10, 2000 response that the "hexagonal sides are by no means a requirement" for its closures. (Exhibit E at 5.) This statement was misleading because it failed to point out that the federal purchasing specification no. PPP-P-420B required hexagonal heads, that the draft ISO Specification

showed hexagonal heads, and that the steel drum industry also accepts hexagonal head plugs as a standard.

10. Applicant's agent claimed in the November 10, 2000 response that its use of the Proposed Mark has been exclusive over many years. (Exhibit E at 4.) This statement omitted the material fact that Allen-Stevens, Contech and Rahil had for a period of several years marketed plugs having hexagonal heads and that, upon information and belief, Applicant paid Contech to cease marketing such plugs.

11. Applicant's agent in the November 10, 2000 response also stated that the "Tri-Sure" closure produced by Opposer is "equally feasible" with Applicant's closure. (Exhibit E at 3.) This statement omitted the material fact that the Tri-Sure closure is not "equally feasible" as Applicant's closure in reconditioning applications, wherein there is a functional advantage in having the plug seal directly on the drum body.

12. Applicant's agent stated in the November 10, 2000 response that Opposer owned registrations for its "Type I" closures. (Exhibit E at 3.) This statement was misleading, in that at least one of the registrations in question had expired at that time, a fact of which, upon information and belief, Applicant was aware.

13. Later, in a Response dated April 15, 2002 to a Final Office Action dated April 2, 2002, Applicant's agent submitted a number of affidavits from customers of Applicant in the steel drum industry. (See Exhibit G.) These affidavits all stated that Applicant had been the only company over the previous ten years selling closures having both a hexagonally shaped head and a butterfly, or "dog-bone," shaped grip. However, the affidavits all omitted the material fact, well known in the steel drum industry, that Allen-Stevens, Contech and Rahil were currently selling or had previously sold closures

having hexagonally shaped heads. Upon information and belief, Applicant and/or one or more of the individuals executing these affidavits were aware of this material fact at the time the affidavits were executed and submitted.

14. Opposer may wish to market and distribute competing Type II plugs for drum containers. The shape of Opposer's plugs, namely, the hexagonal shape of the head of the plugs, would be dictated by the same utilitarian requirements for closure fittings for drum containers that are manufactured and sold by Applicant and others.

15. Opposer will be damaged if Applicant is granted a registration of Application Serial No. 75-869,343.

COUNT I

16. Opposer hereby incorporates by reference paragraphs 1-15 of this Notice as if fully set forth herein.

17. The hexagonal head of Applicant's closure serves at least three functional purposes. First, in reconditioning applications, the presence of an enlarged plug head is dictated by the functional consideration that the plug head and underlying gasket are designed to overlie the body of a drum and to provide a seal against the drum body when the plug is tightened into the drum. This sealing arrangement provides distinct functional advantages in certain applications over other closures that do not provide this contact. Second, as indicated in the patent owned by Applicant, the hexagonal shape of the head is dictated by the functional consideration that the shape provides a wrench head configuration that can be tightened against or loosened from the drum with a wrench. Third, the hexagonal flange has served to bring Applicant's plugs

into compliance with specifications PPP-P-420B and ISO/DIS 15750-3, as well as long-accepted steel drum industry practice. In addition, the butterfly-shaped grip is shown in ISO draft specification ISO/DIS 15750-3.

18. As a result of the foregoing, Applicant's Proposed Mark does not serve as a trademark, but rather is a functional configuration. The Proposed Mark comprises design features of the identified goods, including, but not limited to, the hexagonal head, which serve a primarily utilitarian or functional purpose. The Proposed Mark is therefore dictated by the function of the goods.

COUNT II

19. Opposer hereby incorporates by reference paragraphs 1-18 of this Notice as if fully set forth herein.

20. Even if the Proposed Mark is determined to not be essentially utilitarian in nature and therefore unregistrable as a functional mark, the Proposed Mark has not acquired secondary meaning and Applicant has not shown that the Proposed Mark is recognized by consumers as an indicator of source, as evidenced by the fact that other entities, including Allen-Stevens, Contech and Rahil have also sold Type II plugs during the period of Applicant's asserted exclusive use.

COUNT III

21. Opposer hereby incorporates by reference paragraphs 1-20 of this Notice as if fully set forth herein.

22. In the course of applying for and achieving publication of its Proposed Mark before the United States Patent and Trademark Office ("PTO"), Applicant, itself and/or through its agent, has made a number of misrepresentations

and/or omissions of facts, including one or more of the statements set forth in paragraphs 8-13 above, that a reasonable Examining Attorney would have considered material in determining whether or not to allow the application to proceed to publication. Upon information and belief, one or more of these material facts were misrepresented or omitted with the intent to deceive the Trademark Office into approving the Proposed Mark for publication. Any one of these misstatements or omissions is sufficient to establish fraud in the attempted procurement of the Proposed Mark, whereby registration should be denied under 15 U.S.C. § 1064(3).

WHEREFORE, Opposer prays that this Opposition be sustained and that application Serial No. 75/869,343 for Miscellaneous Design be refused registration.

The filing fee of \$300.00 as provided in Sections 13 and 31 of the Trademark Act of 1946, and in 37 C.F.R. § 2.6(a)(17), is enclosed. Please charge any deficiency to Deposit Account 22-0585. This Notice is being filed in triplicate.

Please recognize Cory M. Amron, William H. Oldach III and Jean-Marc Brun, members of the Bar of the District of Columbia, all with the firm of Vorys, Sater, Seymour, and Pease, LLP, as Opposer's attorneys to prosecute this Notice of Opposition and to transact all business in the Patent and Trademark Office in connection herewith. Please address all communications to: Cory M. Amron, Esq., Vorys, Sater, Seymour and Pease LLP, 1828 L Street, NW, 11th Floor, Washington, DC 20036; Telephone (202) 467-8810; Facsimile (202) 467-8900, e-mail: cmamron@vssp.com. Please address correspondence to the said Cory M. Amron.

Respectfully submitted,

Date: 9/25/02

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