

**EXHIBIT**

*PTAB*



06-25-2003

U.S. Patent & TMO/TM Mail Rpt Dt. #73

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO: COMMISSIONER FOR TRADEMARKS, 2900 CRYSTAL DRIVE, ARLINGTON, VA 22202-3514, ON THE DATE INDICATED BELOW.

By Deborah C. Cowger  
Deborah C. Cowger  
Date JUNE 23, 2003

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

In the matter of trademark application Serial No. 76/441,251  
Filed August 19, 2002  
For the mark: FRE  
Published in the Official Gazette on February 25, 2003.

CHAMPION FIBERGLASS, INC.,

Opposer,

v.

FRE COMPOSITES, INC.

Applicant.

Opposition No. \_\_\_\_\_

06-25-2003  
10:00 AM  
PTAB

**NOTICE OF OPPOSITION**

Champion Fiberglass Inc.  
6400 Spring Stuebner Road  
Spring, Texas 77389  
a Texas Corporation

The above-identified Opposer believes that it will be damaged by registration of the mark shown in the above-identified application, and hereby opposes the same. The grounds for opposition are as follows:

1. The above-identified Applicant seeks to register "FRE" as a trademark for reinforced fiberglass conduits, fittings and adapters for carrying electrical and telecommunications cables underwater, underground and above ground; reinforced fiberglass

carriers for cables and light fixtures in the nature of cable trays and poles (U.S. Application Serial No. 76/441,251) (hereinafter, the '251 Application) as evidenced by the publication of said trademark in the Official Gazette of February 25, 2003.

2. Opposer is, and has been for many years, engaged in the manufacture of conduits, fittings, adapters and cable trays composed of composite materials, such as fiberglass reinforced epoxy (FRE), for the electrical and mechanical markets. Opposer has built a large and profitable business in connection therewith.

3. Opposer's conduits, fittings, adapters and cable trays (hereinafter, "Opposer's Goods") are marketed and sold to diverse industries in competition with Applicant.

**FRE IS GENERIC OF GOODS COMPOSED OF  
FIBERGLASS REINFORCED EPOXY**

4. The "FRE" designation that is the subject of Applicant's application is generic and, therefore, is incapable of functioning as a trademark for reinforced fiberglass conduits, fittings and adapters for carrying electrical and telecommunication cable underwater, underground and above ground; reinforced fiberglass carriers for cables and light fixtures in the nature of cable trays and poles (hereinafter, "Applicant's Goods") composed of fiberglass reinforced epoxy (FRE).

5. Pursuant to the Lanham Act § 2(e), the designation "FRE" is known in the industry as a generic term for the composition "fiberglass reinforced epoxy". Generic terms are common names that the relevant purchasing public understands primarily as describing the genus of goods being sold. They are by definition incapable of indicating a particular source of the goods, and cannot be registered as trademarks; doing so "would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are." *In re Merrill*

*Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 1559, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987).

6. The determination of whether a mark is generic is made according to a two part inquiry: “First, what is the genus of the goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?” *H. Marvin Gin Corp. v. International Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir. 1986).

7. An abbreviation of a generic term which still conveys to the buyer the original generic connotation of the abbreviated name, is still “generic.” *In re General Aniline & Films Corp.*, 136 USPQ 306 (T.T.A.B. 1962) (the term “PVP” was held to be the recognizable abbreviation of the generic term “polyvinylpyrrolidone”); *Exxon Corp. v. Motorgas Oil & Refinery Corp.*, 219 USPQ 440, 443-445 (T.T.A.B. 1983) (MOGAS was held a nonregisterable generic acronym for motor gasoline); *El Paso Prods. Co. v. C. P. Hall Co.*, 180 USPQ 409 (T.T.A.B. 1973) (“DMG” was held to be a recognized abbreviation for the drug name dymethyl glutarate).

8. Evidence in the form of competitor’s use and Applicant’s own use of the term FRE may be used to prove genericness. *McCarthy on Trademarks and Unfair Competition* § 12.13 (4<sup>th</sup> Ed. 2003). Attached Exhibits 1 through 9 show use of FRE in the industry as a generic term. As shown in attached Exhibits 10, 11 and 12, Applicant admits FRE is generic when it uses “fiberglass reinforced epoxy” before and/or after the term FRE. *See, In re Gould Paper Corp.*, 835 F.2d 1017, 1019, 5 USPQ2d 1110, 1112 (Fed. Cir. 1987) (“Gould’s own submissions provided the most damaging evidence [that the word is generic]”). *Lawfinder’s*

*Assoc., Inc. v. Legal Research Center*, 65 F.Supp.2d 427 (N.D. Tex. 1998), *aff'd*, 193 F.3d 317 (5<sup>th</sup> Cir. 1999) (“[Plaintiff’s] own words provide some indication that the mark is generic”).

**FRE IS MERELY DESCRIPTIVE OF GOODS COMPOSED OF  
FIBERGLASS REINFORCED EPOXY**

9. Alternatively, the “FRE” designation that is the subject of Applicant’s application is merely descriptive of Applicant’s Goods, and is incapable of functioning as a trademark for the recited goods.

10. Opposer and, on information and belief, third parties, have and continue to use, the descriptive phrase “FRE” in connection with its conduits fittings, adapters and cable trays.

**FAIR USE**

11. Applicant is not entitled to registration of a descriptive term which will interfere with Opposer’s right to use. Opposer has used the term as a descriptive designation. Opposer has now provided, through attached Exhibits 1 through 12, information from which the Board can conclude that Applicant can not meet its ultimate burden of showing any secondary meaning for the term FRE.

12. Opposer’s Goods and Applicant’s Goods are substantially related. Opposer and Applicant are in direct competition in the United States for the sale of these goods.

13. The conduits, fittings, adapters and cable trays would be sold to the same and overlapping classes of purchasers through the same and similar channels of trade. Opposer’s customers are likely to be the same as Applicant’s customers.

**FRAUD IN IMPROPER USE OF  
FEDERALLY PROTECTED SYMBOL ®**

14. Referring to attached Exhibits 10 through 12 which were printed from Applicant’s website on May 29, 2003, from a computer located in Houston, Texas, improper uses of the federal registration symbol, ®, are shown, that are deliberate and intended to deceive or mislead

the public or the Office. *See Copelands' Enter., Inc. v. CNV, Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991); *Wells Fargo & Co. v. Lundeen & Assocs.*, 20 USPQ2d 1156 (T.T.A.B. 1991).

15. In written communications dated July 22, 2002, and October 10, 2002, Opposer advised Applicant's counsel of the fact that their U.S. Registration No. 1,886,041 was cancelled but Applicant continues to use the federally protected symbol ®.

16. Applicant has submitted specimens in the present application that include the use of the federally protected symbol ®. However, Applicant did not notify the U.S. Trademark Office that it had been informed that its U.S. Federal Trademark Registration was cancelled and that it could no longer use this federally protected symbol ® in the United States.

**FRAUD IN FAILURE TO  
INFORM USPTO OF THIRD PARTY USE**

17. Additionally, in letters dated before August 19, 2002 (Application's filing date), and on October 10, 2002, Opposer informed Applicant of the third party uses of the term FRE as shown in Exhibits 1 through 9, yet Applicant did not advise the U.S. Trademark Office of these third party uses. Therefore, Applicant knew of a number of other users of the trademark before and during the pendency of its application.

**FRAUD IN FAILURE TO INFORM USPTO  
THAT IT HAD IMPROPERLY ASSERTED ITS  
TRADEMARK WAS FEDERALLY REGISTERED**

18. The USPTO issued a Certificate of Registration for the term FRE to Applicant on March 28, 1995 (U.S. Registration No. 1,886,041) (the '041 Registration). The '041 Registration was subsequently canceled on April 6, 2002, for Applicant's failure to demonstrate use of the term in commerce. *See Lanham Act § 8.*

19. After Applicant's '041 Registration was cancelled, Applicant improperly asserted its trademark was registered to Opposer in a written correspondence which constitutes fraud. *Aromatique, Inc. v. Gold Seal, Inc.*, 28 F.3d 863, 877 (8<sup>th</sup> Cir. 1994). Applicant's failure to inform the USPTO that it had improperly asserted its trademark was federally registered after its mark was cancelled constitutes fraud on the PTO. *Id.* at 878.

**FRAUD IN "NO USE" BY APPLICANT  
OF "FRE" WITH CABLE TRAYS**

20. On information and belief, Applicant has not used "FRE" with all of Applicant's Goods. In particular, Applicant has not used "FRE" with cable trays in the United States for at least the last three (3) years.

21. If Applicant is granted a registration for the alleged mark herein opposed, it would obtain thereby at least a *prima facie* exclusive right to use "FRE" for reinforced fiberglass conduits, fittings and adapters for carrying electrical and telecommunications cables underwater, underground and above-ground; reinforced fiberglass carriers for cables and light fixtures in the nature of cable trays and poles. Such registration would be a source of damage and injury to Opposer and others in the relevant trade who use and wish to continue to use and are entitled to use such generic/descriptive wording and wording substantially similar to the term FRE in connection with conduits, fittings, adapters, cable trays, struts and poles.

22. If Applicant is granted a registration for the designation "FRE" herein opposed, it would obtain thereby at least any *prima facie* exclusive right to use such designation. Such registration would be a source of damage and injury to Opposer and Opposer's customers.

WHEREFORE, Opposer prays that registration of the alleged mark of the '251 Application be refused and that this opposition be sustained.

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In the alternative, if the Board finds that the Applicant's mark is registrable for Applicant's Goods that are not composed of fiberglass reinforced epoxy, Opposer prays that the application of the '251 Application be amended to exclude Applicant's Goods that are composed of fiberglass reinforced epoxy, only for those Goods that Applicant used "FRE" thereon.

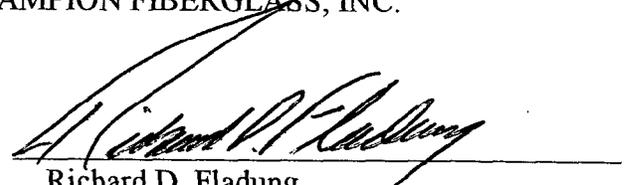
A duplicate copy of this Notice of Opposition is enclosed herewith.

A check in the amount of \$300.00 is enclosed. Any additional fees in connection with this opposition will be charged to Deposit Account No. 16-2435 and any overpayment may be credited to this account.

Respectfully submitted,

CHAMPION FIBERGLASS, INC.

By:



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Date: June 23, 2003