

09/02/2003TTAB

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

In the Matter of Application Serial No. 76/441,251
Published in the Official Gazette of February 25, 2003 at TM 163
in International Class 9



08-21-2003

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

_____)
Champion Fiberglass, Inc.,)
)
	Opposer,)
)
	v.)
)
FRE Composites, Inc. ,)
)
	Applicant.)
_____)

Opposition No.: 91156994

BOX TTAB
NO FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Applicant's Answer to Notice of Opposition

Applicant, FRE Composites, Inc. ("Applicant"), for its Answer to the Notice of Opposition, which Champion Fiberglass, Inc. ("Opposer") filed against the application for registration of Applicant's trademark FRE, Serial No. 76/441,251, filed August 19, 2002 and published in the Official Gazette on February 25, 2003, states as follows:

1. Applicant admits paragraph 1 of the Notice of Opposition.
2. Applicant admits paragraph 2 of the Notice of Opposition, provided that Applicant does not have sufficient knowledge or information to admit or deny the allegations contained therein regarding the size or profitability of Opposer's business and therefore denies the same.

09/02/2002TAP

3. Answering paragraph 3 of the Notice of Opposition, Applicant admits that Opposer is a competitor of Applicant; Applicant does not have sufficient knowledge or information to admit or deny the remaining allegations contained in such paragraph 3 and therefore denies the same.

4. Applicant denies paragraph 4 of the Notice of Opposition.

5. Answering paragraph 5 of the Notice of Opposition, Applicant denies that its mark FRE is generic and affirmatively alleges that its mark is distinctive. To the extent paragraph 5 of the Notice of Opposition purports to state a legal standard, Applicant denies that such legal standard is applicable in this case.

6. Answering paragraph 6 of the Notice of Opposition, to the extent paragraph 6 of the Notice of Opposition purports to state a legal standard, Applicant denies that such legal standard is applicable in this case.

7. Answering paragraph 7 of the Notice of Opposition, to the extent paragraph 7 of the Notice of Opposition purports to state a legal standard, Applicant denies that such legal standard is applicable in this case.

8. Answering paragraph 8 of the Notice of Opposition, Applicant denies that its mark FRE is generic and affirmatively alleges that its mark is distinctive. Further, Applicant denies that the referenced exhibits indicate that Applicant's FRE trademark is generic, or that Applicant has in any way admitted that its FRE trademark is generic. Applicant affirmatively states that the referenced exhibits speak for themselves. To the extent paragraph 8 of the Notice of Opposition purports to state a legal standard, Applicant denies that such legal standard is applicable in this case.

9. Applicant denies paragraph 9 of the Notice of Opposition.

09/02/2002TAB

10. Answering paragraph 10 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to admit or deny the allegations contained therein and therefore denies the same.

11. Applicant denies paragraph 11 of the Notice of Opposition, including Opposer's characterization of Exhibits 1 through 12, and affirmatively states that the referenced exhibits speak for themselves.

12. Answering paragraph 12 of the Notice of Opposition, Applicant admits that its goods and goods sold by Opposer are similar or related and that Applicant and Opposer are in competition in the United States for the sale of their respective goods. Applicant does not have sufficient knowledge or information to admit or deny the remaining allegations contained in such paragraph 12 and therefore denies the same.

13. Answering paragraph 13 of the Notice of Opposition, Applicant admits that its goods and goods sold by Opposer are similar or related and that Applicant and Opposer are in competition in the United States for the sale of their respective goods. Applicant does not have sufficient knowledge or information to admit or deny the remaining allegations contained in such paragraph 13 and therefore denies the same.

14. Answering paragraph 14 of the Notice of Opposition, Applicant admits use of the ® symbol with its FRE trademark as shown on Applicant's website which is published from Applicant's home office in Quebec, Canada. Applicant affirmatively alleges that use of the ® symbol is based on and authorized by Applicant's registration of its FRE trademark in Canada where Applicant's home office is located, and therefore denies that use of the ® symbol is improper or intended to deceive or mislead the public or the U.S. Patent and Trademark Office

007092700031TAB

("USPTO"). Applicant further affirmatively states that the referenced exhibits speak for themselves.

15. Answering paragraph 15 of the Notice of Opposition, Applicant acknowledges receipt of the referenced written communications. Applicant admits use of the ® symbol with its FRE trademark as shown on Applicant's website which is published from Applicant's home office in Quebec, Canada. Applicant affirmatively alleges that use of the ® symbol is based on and authorized by Applicant's registration of its FRE trademark in Canada where Applicant's home office is located, and therefore denies that use of the ® symbol is improper or intended to deceive or mislead the public or the USPTO.

16. Answering paragraph 16 of the Notice of Opposition, Applicant admits use of the ® symbol with its FRE trademark on materials emanating from Applicant's home office in Canada, affirmatively alleges that use of that symbol is based on and authorized by Applicant's registration of its FRE trademark in Canada where Applicant's home office is located, and therefore denies that use of the ® symbol is improper or intended to deceive or mislead the public or the USPTO.

17. Answering paragraph 17 of the Notice of Opposition, Applicant acknowledges receipt of communications from Opposer, affirmatively alleges that to the best of its knowledge its use of the FRE trademark predates and is therefore superior to any such alleged third party uses, and therefore denies that it had any obligation to inform the USPTO of such alleged third party uses.

18. Answering paragraph 18 of the Notice of Opposition, Applicant admits that it was granted U.S. Registration No. 1,886,041 and that Registration No. 1,886,041 was canceled by the USPTO on April 6, 2002. Applicant affirmatively alleges that its failure to file a declaration of

09/02/2009 11:09

continuing use pursuant to Lanham Act Section 8 was due to inadvertence or mistake and not due to lack of use of the FRE mark in commerce in the United States.

19. Applicant denies paragraph 19 of the Notice of Opposition.

20. Applicant denies paragraph 20 of the Notice of Opposition.

21. Answering paragraph 21 of the Notice of Opposition, Applicant states that the legal effect of a registration granted for its FRE trademark will be as provided in applicable law, and to the extent the allegations in paragraph 21 of the Notice of Opposition are contrary to applicable law, Applicant denies. Applicant affirmatively alleges that it has superior rights to use the FRE trademark based on long-standing use of the mark. Applicant denies that Opposer or others in the relevant trade are entitled to use the term FRE for the goods described in Applicant's application.

22. Answering paragraph 22 of the Notice of Opposition, Applicant states that the legal effect of a registration granted for its FRE trademark will be as provided in applicable law, and to the extent the allegations in paragraph 22 of the Notice of Opposition are contrary to applicable law, Applicant denies. Applicant affirmatively alleges that it has superior rights to use of the FRE trademark based on long-standing use of the mark, and denies that Opposer or Opposer's customers would be damaged or injured due to registration of Applicant's FRE trademark.

23. Except as expressly admitted, qualified or otherwise answered above, Applicant denies each and every allegation in the Notice of Opposition.

Affirmative Defenses

24. Applicant affirmatively alleges that Opposer has failed to allege grounds sufficient to establish its standing to maintain the present opposition.

00/00/0000TTTAA

- 25. Applicant affirmatively alleges that Opposer's claims are barred by laches, acquiescence, waiver and/or estoppel.
- 26. Applicant affirmatively alleges that Opposer's Notice of Opposition fails to state a claim for which relief can be granted.
- 27. Applicant affirmatively alleges that the FRE mark is not generic.
- 28. Applicant affirmatively alleges that the FRE mark is not merely descriptive of Applicant's goods.
- 29. In the alternative, Applicant affirmatively alleges that the FRE mark has acquired distinctiveness or secondary meaning.
- 30. Applicant affirmatively alleges that as a result of its continuous substantial usage of its mark FRE, this mark is a valuable asset of Applicant and carries considerable goodwill and customer acceptance of Applicant's goods sold under the mark. Such goodwill and substantial usage have made the mark distinctive to Applicant.

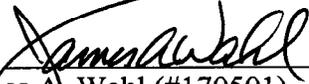
In view of the foregoing, Applicant contends that this opposition is groundless and baseless in fact; that Opposer has not shown where in it will be, or is likely to be, damaged by the registration of Applicant's trademark; the Applicant's trademark is manifestly distinct from any marks of the Opposer or any designation of the Opposer and Applicant prays that this Opposition be dismissed and that Applicant be granted registration of its trademark.

09/09/2003TTAB

Dated: August 19, 2003

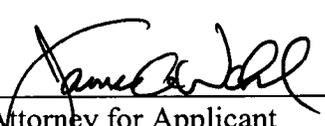
Respectfully submitted,

MACKALL, CROUNSE & MOORE, PLC

By: 
James A. Wahl (#170501)
Tim A. Staum (#190470)
Attorneys for Applicant
1400 AT&T Tower
901 Marquette Avenue
Minneapolis, MN 55402
(612) 305-1400

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513, Attention BOX TTAB, NO FEE, on August 19, 2003.


Attorney for Applicant

Certificate of Service

I hereby certify that a copy of the foregoing APPLICANT'S ANSWER TO NOTICE OF OPPOSITION was mailed first-class mail, postage prepaid, to Richard D. Fladung, Esq., Akin Gump Strauss Hauer & Feld LLP, 711 Louisiana Street, Suite 1900, Houston, TX 77002, attorneys for Opposer, on August 19, 2003.


Attorney for Applicant

JAW/jaw#671249v2

TTAB

00110000700700

Law Offices
1400 AT&T Tower
901 Marquette Avenue
Minneapolis, MN 55402-2859
Telephone: (612) 305-1400
Facsimile: (612) 305-1414

MACKALL
CROUNSE
& MOORE
P L C

James A. Wahl
Attorney at Law
612-305-1486
jaw@mcmlaw.com



August 19, 2003

08-21-2003

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

Box TTAB
NO FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Re: Opposition No. 91156994
Applicant's Answer to Notice of Opposition
United States Trademark Application No. 76/441,251
Applicant: FRE Composites, Inc.
Mark: **FRE**
Opposer: Champion Fiberglass, Inc.

Our File: 088100-12

Dear Sir/Madam:

Enclosed for filing are the following:

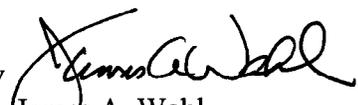
1. Applicant's Answer to Notice of Opposition
2. Certificate of Mailing
3. Certificate of Service upon Opposer's Attorney

08 SEP -3 PM 9:32
James A. Wahl

If you have any questions or comments concerning the enclosed Answer, please direct them to my attention at the address set forth above.

Respectfully submitted,

MACKALL, CROUNSE & MOORE, PLC

By 
James A. Wahl

Enclosures