

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TTAB

Lucite International, Inc.,)	
)	
Opposer,)	
)	
v.)	
)	Ser. No. 76/538,263
Metl-Span I, Ltd., MSGP, Inc.)	
)	
Applicant.)	
)	
Our Ref. No. 81904/000003)	

NOTICE OF OPPOSITION

Box TTAB FEE
 Commissioner for Trademarks
 2900 Crystal Drive
 Arlington, Virginia 22202-3514

10/14/2004 ZCLIFT01 00000104 033975 76538263
 01 FC:6402 300.00 DA

Sir:

Opposer Lucite International, Inc. ("Opposer"), a Missouri corporation having its principal place of business at 7275 Goodlett Farms Parkway, Cordova, Tennessee 38018, believes that it will be damaged by the registration of the mark TUFF COTE, set forth in Application Serial No. 76/538,263, for use on or in connection with a "fiber reinforced polymer material that is spray applied and oven cured to create a stucco-like appearance." Consequently, Opposer wishes to oppose Metl-Span I, Ltd., MSGP, Inc.,'s ("Applicant") registration of the TUFF COTE mark, which the United States Patent and Trademark Office ("USPTO") published for opposition on April 6, 2004.

As grounds for the opposition, Opposer alleges that:

1. Opposer is a global leader in the design, development, and manufacture of acrylic-based products. Opposer and its affiliated corporations employ two thousand people at



sixteen manufacturing sites and thirty-five sales offices around the world. Opposer serves and supports customers in more than one hundred different countries, and has revenues over \$1 billion.

2. Opposer owns and is using the TUFCOAT[®] mark in commerce, and has been doing so since December 31, 1996.

3. On December 31, 2002, the Opposer registered the TUFCOAT[®] mark on the Principal Register, for use in connection with “unprocessed acrylic resins, namely, capping resins for use as a protective layer over substances such as polymers, wood-based products,” with the USPTO. *See* Reg. No. 2,667,526. Opposer owns this registration. Attached please find additional information from the USPTO’s T.A.R.R. database regarding Opposer’s TUFCOAT[®] registration.

4. Opposer’s TUFCOAT[®] brand unprocessed acrylic resins are now the construction industry’s leading architectural capping product, with sales growing eight times in the last five years. Because Opposer’s TUFCOAT[®] brand unprocessed acrylic resins are extruded over a traditional substrate material, such as PVC, they impart exceptional durability and performance characteristics to siding, including ultraviolet weathering resistance. As a result, Opposer’s customers can offer a wide range of color options that will not fade or change color over time.

5. Opposer has widely and extensively sold, advertised, and promoted goods bearing the TUFCOAT[®] mark in interstate commerce. Opposer has also used the TUFCOAT[®] mark to identify and distinguish its goods from the goods of its competitors. Consequently, consumers have come to know and recognize the TUFCOAT[®] mark as the source of high quality, unprocessed acrylic resins.

6. On August 19, 2003, Applicant filed an intent-to-use application to register the mark TUFF COTE, for use on “fiber reinforced polymer material that is spray applied and oven

cured to create a stucco-like appearance,” with the USPTO. *See* Serial No. 76/538,263.

Attached please find additional information from the USPTO’s T.A.R.R. database regarding Applicant’s TUFF COTE mark.

7. Applicant’s TUFF COTE mark so resembles Opposer’s TUFACOAT[®] mark as to be likely, when used on or in connection with Applicant’s goods, to cause confusion, to cause mistake, and to deceive.

8. Applicant’s goods are closely related to Opposer’s goods.

9. Applicant’s goods move in the same channels of trade and appeal to the same consumers as Opposer’s goods.

10. Opposer began using the TUFACOAT[®] mark more than six and a half years after Applicant filed an intent-to-use application to register the TUFF COTE mark. Upon information and belief, Opposer began using its mark prior to any actual use or constructive use of the mark set forth in Serial No. 76/538,263.

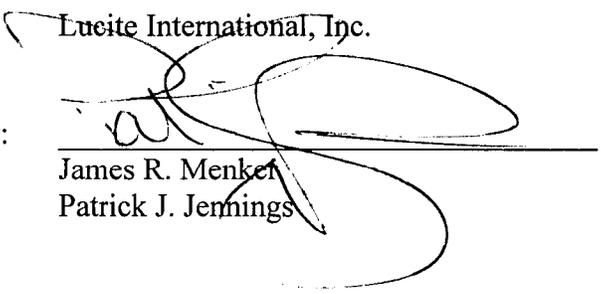
11. Opposer is likely to be damaged by the registration of Applicant’s TUFF COTE mark.

WHEREFORE, Opposer requests that the USPTO refuse registration of Applicant’s TUFF COTE mark.

Respectfully submitted,

Lucite International, Inc.

By:


James R. Menkel
Patrick J. Jennings

Opposer’s Attorneys
Pillsbury Winthrop LLP
P.O. Box 10500
McLean, Virginia 22102
(703) 905-2000



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Ser. No. 76/538,263

AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT

Commissioner for Trademarks
 2900 Crystal Drive
 Arlington, Virginia 22202-3514

Sir:

The following Trademark Processing Fees are due in connection with this document:

Fee Code 377, Notice of Opposition, in the amount of \$300.00.

Please charge these fees to Deposit Account No. 03-3975, 81904/000003.

Filed by Patrick J. Jennings on October 4, 2004.

Respectfully submitted,

Lucite International, Inc.

By:



James R. Menker
 Patrick J. Jennings



Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2004-10-04 12:39:51 ET

Serial Number: 75679005 Assignment Information

Registration Number: 2667526 Assignment Information

Mark (words only): TUFCOAT

Standard Character claim: No

Current Status: Registered.

Date of Status: 2002-12-31

Filing Date: 1999-04-12

Transformed into a National Application: No

Registration Date: 2002-12-31

Register: Principal

Law Office Assigned: LAW OFFICE 106

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -File Repository (Franconia)

Date In Location: 2003-08-28

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. LUCITE INTERNATIONAL, INC.

Address:

LUCITE INTERNATIONAL, INC.

7275 Goodlett Farms Parkway

Cordova, TN 38018

United States

Legal Entity Type: Corporation

State or Country of Incorporation: Missouri

GOODS AND/OR SERVICES

International Class: 001

UNPROCESSED ACRYLIC RESINS, NAMELY, CAPPING RESINS FOR USE AS A PROTECTIVE

LAYER OVER SUBSTANCES SUCH AS POLYMERS, WOOD-BASED PRODUCTS

First Use Date: 1996-12-31

First Use in Commerce Date: 1996-12-31

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2003-06-19 - Section 7 correction issued

2003-04-28 - Section 7 amendment filed

2003-04-28 - PAPER RECEIVED

2002-12-31 - Registered - Principal Register

2002-10-08 - Published for opposition

2002-09-18 - Notice of publication

2002-06-27 - Approved for Pub - Principal Register (Initial exam)

2002-05-08 - Communication received from applicant

2002-02-19 - Non-final action mailed

2000-04-27 - Letter of suspension mailed

2000-02-29 - Communication received from applicant

1999-08-30 - Non-final action mailed

1999-08-20 - Case file assigned to examining attorney

1999-08-16 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent

PAUL W KRUSE (Attorney of record)

PAUL W KRUSE
PILLSBURY WINTHROP LLP
1600 TYSONS BLVD
MCLEAN VA 22102

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2004-10-04 13:10:55 ET

Serial Number: 76538263

Registration Number: (NOT AVAILABLE)

Mark (words only): TUFF COTE

Standard Character claim: No

Current Status: A request for an extension of time to file an opposition has been filed at the Trademark Trial and Appeal Board.

Date of Status: 2004-04-29

Filing Date: 2003-08-19

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 112

Attorney Assigned:
MASTERSON ARETHA C Employee Location

Current Location: 657 -Pre-Publication Final Review

Date In Location: 2004-09-20

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Metl-Span I, Ltd.

Composed Of:
MSGP, Inc., a Nevada corporation

Address:
Metl-Span I, Ltd.
1497 North Kealy
Lewisville, TX 75057
United States

Legal Entity Type: Limited Partnership
State or Country Where Organized: Texas

GOODS AND/OR SERVICES

International Class: 019

fiber reinforced polymer material that is spray applied and oven cured to create a stucco-like appearance

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

Basis: 1(b)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2004-09-08 - Case File in TICRS

2004-04-29 - Extension of time to oppose - Filed

2004-04-06 - Published for opposition

2004-03-17 - Notice of publication

2004-01-12 - Approved for Pub - Principal Register (Initial exam)

2004-01-12 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent

Charles S. Cotropia (Attorney of record)

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