

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

Lucite International, Inc. )  
 )  
 Opposer, )  
 )  
 v. )  
 )  
 Metl-Span I., Ltd., MSGP, Inc. )  
 )  
 Applicant )  
 \_\_\_\_\_ )

Opposition No. 91162539  
Serial. No. 76/538,263

BOX TTAB – No Fee  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

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 U.S. PATENT & TRADEMARK OFFICE

**APPLICANT’S ANSWER TO NOTICE OF OPPOSITION**

Metl-Span I, Ltd. (“Applicant”), a limited partnership organized under the laws of the State of Texas, having a principal place of business at 1497 North Kealy, Lewisville, Denton County, Texas 75057, the owner of U.S. Application Serial No. 76/538,263 (“Applicant’s Mark”), for its Answer to Notice of Opposition filed by Lucite International, Inc. (“Opposer”), pleads and avers as follows:

1. Answering paragraph 1 of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained therein and accordingly denies the allegations.
  
2. Answering paragraph 2 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly denies the allegations.



11-19-2004

3. Answering paragraph 3 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly denies the allegations. Applicant does note that an attachment to the Notice of Opposition appears to be a printout from the U.S. Patent and Trademark Office T.A.R.R. database of trademark information relating to trademark registration 2,667,526 which cites the Opposer as the last listed owner of the registration.
4. Answering paragraph 4 of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained therein and accordingly denies the allegations.
5. Answering paragraph 5 of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained therein and accordingly denies the allegations.
6. Answering paragraph 6 of the Notice of Opposition, Applicant admits the allegations contained therein.
7. Answering paragraph 7 of the Notice of Opposition, Applicant denies the allegations contained therein.
8. Answering paragraph 8 of the Notice of Opposition, Applicant denies the allegations contained therein.
9. Answering paragraph 9 of the Notice of Opposition, Applicant denies the allegations contained therein.

10. Answering paragraph 10 of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained therein and accordingly denies the allegations.
11. Answering paragraph 11 of the Notice of Opposition, Applicant denies the allegations contained therein.

**AFFIRMATIVE DEFENSES**

12. Applicant affirmatively alleges that during examination of the present application, U.S. Trademark Application Serial No. 76/538,263, the Trademark Examining Attorney searched the Office records and found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d); specifically, the Examining Attorney did not cite the alleged U.S. trademark registration cited by Opposer in paragraph 3 of the Notice of Opposition.
13. Applicant affirmatively alleges that the mark listed by Opposer is not sufficiently similar to Applicant's mark as to cause a likelihood of confusion, mistake or deception. The mark cited by Opposer consists of one word "TUFECOAT." Applicant's mark consists of two words "TUFF COTE." When viewed side by side, the mark cited by Opposer and Applicant's mark are distinguishable based upon spelling, meaning and appearance.
14. Applicant affirmatively alleges that Applicant's goods and services advertised, offered, sold and/or distributed under the mark TUFF COTE are distinctly different and distinguishable from those goods identified by Opposer. Specifically, the mark cited by Opposer is not registered for goods and service relating to spray on material that simulates stucco. Furthermore, the goods cited by Opposer are alleged to be unprocessed

acrylic resins used as an architectural capping product. Opposer's products are sold to distributors who then sell to residential contractors and individuals in the home building trade. In contrast, Applicant's mark is not mass-marketed, but instead, is sold to installation panel contractors, architects, and specialty wall contractors. Consumers are not likely to mistake the marks as representing the same products nor be deceived into choosing Applicant's products over Opposer's. Based upon the different uses for the products, Applicant's mark and the mark cited by Opposer will travel in different channels of trade.

15. Applicant affirmatively alleges that Opposer has acquiesced to third party use of TUFCOAT for protective surfacing products as evidenced by the existence of the valid U.S. trademark registration for TUFCOAT, U.S. Registration No. 2,880,120, which was registered on August 31, 2004 in connection with "*water-based aliphatic exterior coating sold as a component part of loudspeakers.*" (See Exhibit A attached). Opposer has not contested or has failed in its contest of this third party mark and thus cannot assert that Applicant's mark is likely to confuse, mistake or deceive consumers in connection with the mark cited by Opposer.
16. Applicant affirmatively alleges that Opposer will not be damaged by the registration of Applicant's mark.
17. Applicant affirmatively alleges that to its knowledge there have been no incidents of actual confusion between Applicant's mark and the mark cited by Opposer.

In view of the foregoing, Applicant contends that this Opposition is groundless and baseless in fact; that Opposer has not shown that it has been, will be, or is likely to be, damaged

15001/01001

by the registration of Applicant's mark TUFF COTE, the subject of U.S. Trademark Application Serial No. 76/538,263.

Applicant prays that this Opposition be dismissed and that registration of U.S. Trademark Application Serial No. 76/471,682 be granted.

METL-SPAN I, LTD.

Date: November 18, 2004



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Attorneys For Applicant

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing Applicant's Answer to Notice of Opposition has been served upon the parties as indicated below this 18th day of November, 2004.

James R. Menker, Esq.  
Patrick J. Jennings, Esq.  
Pillsbury Winthrop, LLP  
P.O. Box 10500  
McLean, Virginia 22102

By U.S. Mail



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Charles S. Cotropia

**EXHIBIT A**



# UNITED STATES PATENT AND TRADEMARK OFFICE

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(*TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS*)

### Typed Drawing

<b>Word Mark</b>	TUFCOAT
<b>Goods and Services</b>	IC 009. US 021 023 026 036 038. G & S: water-based aliphatic exterior coating sold as a component part of loudspeakers. FIRST USE: 20030500. FIRST USE IN COMMERCE: 20030500
<b>Mark Drawing Code</b>	(1) TYPED DRAWING
<b>Serial Number</b>	76489509
<b>Filing Date</b>	February 14, 2003
<b>Current Filing Basis</b>	1A
<b>Original Filing Basis</b>	1B
<b>Published for Opposition</b>	September 30, 2003
<b>Registration Number</b>	2880120
<b>Registration Date</b>	August 31, 2004
<b>Owner</b>	(REGISTRANT) Community Light & Sound, Inc. CORPORATION PENNSYLVANIA 333 East 5th Street Chester PENNSYLVANIA 19013
<b>Attorney of Record</b>	JORDAN A. LAVINE
<b>Type of Mark Register</b>	TRADEMARK PRINCIPAL

**Live/Dead  
Indicator**      LIVE

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**Serial Number:** 76489509

**Registration Number:** 2880120

**Mark (words only):** TUFCOAT

**Standard Character claim:** No

**Current Status:** Registered.

**Date of Status:** 2004-08-31

**Filing Date:** 2003-02-14

**Transformed into a National Application:** No

**Registration Date:** 2004-08-31

**Register:** Principal

**Law Office Assigned:** LAW OFFICE 108

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**Current Location:** 900 -File Repository (Franconia)

**Date In Location:** 2004-09-09

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

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1. Community Light & Sound, Inc.

**Address:**

Community Light & Sound, Inc.  
333 East 5th Street  
Chester, PA 19013  
United States

**Legal Entity Type:** Corporation

**State or Country of Incorporation:** Pennsylvania

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**GOODS AND/OR SERVICES**

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**International Class:** 009

water-based aliphatic exterior coating sold as a component part of loudspeakers

**First Use Date:** 2003-05-00

**First Use in Commerce Date:** 2003-05-00

**Basis:** 1(a)

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**ADDITIONAL INFORMATION**

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(NOT AVAILABLE)

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**MADRID PROTOCOL INFORMATION**

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(NOT AVAILABLE)

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**PROSECUTION HISTORY**

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2004-08-31 - Registered - Principal Register

2004-06-08 - Allowed for Registration - Principal Register (SOU accepted)

2004-06-07 - Statement of use processing complete

2004-05-26 - Amendment to Use filed

2004-05-26 - PAPER RECEIVED

2003-12-23 - Notice of allowance - mailed

2003-09-30 - Published for opposition

2003-09-10 - Notice of publication

2003-08-06 - Approved for Pub - Principal Register (Initial exam)

2003-08-04 - Case file assigned to examining attorney

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**CORRESPONDENCE INFORMATION**

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**Correspondent**

JORDAN A. LAVINE (Attorney of record)

JORDAN A. LAVINE

AKIN GUMP STRAUSS HAUER & FELD, L.L.P.

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