

# ReedSmith

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November 8, 2004

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Re: Notice of Opposition  
Mark: SMARTSHIM  
Applicant: Fibertech Polymers, Inc.  
Serial No.: 78/300,356  
Filed: September 15, 2003  
Atty. Docket No. 04-40101-US-OP  
Our Ref.: 878622.20011

Dear Sir:

Enclosed for filing in connection with the above-referenced Notice of Opposition are the following documents:

1. Three copies of the Notice of Opposition;
2. Check in the amount of \$300.00; and
3. Return Receipt Postcard.

### CERTIFICATE OF MAILING (37 CFR 2.197)

I hereby certify that this paper, and the papers and/or fees referred to herein as transmitted, submitted or enclosed, are being deposited on the date shown below with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

Name Dolores Springfield Signature *Dolores Springfield* Date of Deposit November 8, 2004



11-10-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #66

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Commissioner for Trademarks  
November 8, 2004  
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Kindly acknowledge receipt of these documents by returning the enclosed self-addressed, stamped post card to me.

The Commissioner is hereby authorized to charge any additional fees required in connection with this filing to Account No. 18-0586.

Sincerely yours,

REED SMITH LLP

A handwritten signature in cursive script, appearing to read 'C.H. Pierce', written in black ink.

Carl H. Pierce

Enclosures

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

FURMANITE INTERNATIONAL LIMITED

Opposer,

Opposition No:

v.

Application Serial No: 78/300,356

FIBERTECH POLYMERS, INC.



Applicant.

11-10-2004

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #66

**NOTICE OF OPPOSITION**

FURMANITE INTERNATIONAL LIMITED, having its place of business at Furman House, Shap Road, Kendal, Cumbria. LA 9 6RU, United Kingdom ("Opposer"), believes that it has been, is currently being and/or will be damaged by the registration of the mark SMARTSHIM ("Applicant's Mark") shown in Class 20 for "Shims made of polymer and cellulose materials" and hereby opposes the same.

As grounds for opposition, it is alleged that:

1. On information and belief, on September 15, 2003, Applicant FiberTech Polymers, Inc. filed an application, Serial No. 78/300,356 ("Applicant's Application") for registration upon the Principal Register for the mark "SMARTSHIM" as a trademark in Class 20 in connection with "shims made of polymer and cellulose materials" ("Applicant's Goods"), based upon Section 1(b) of the Lanham Act, 15 U.S.C. §1051(b), and that Applicant's Application was published for opposition in the Official Gazette in the May 11, 2004 issue.

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2. Pursuant to 37 C.F.R. 2.102(c), Opposer has filed for and received successive extensions for time to file this Notice of Opposition. The current extension granted by the Trademark Trial and Appeal Board expired November 7, 2004. The present Notice of Opposition is filed on November 8, 2004, and accordingly is timely filed pursuant to 37 C.F.R. §2.196.

3. Opposer FURMANITE INTERNATIONAL LIMITED is the owner of United States Trademark Application Serial No. 78/282,842<sup>1</sup>, filed on August 4, 2003, for the mark "SMARTSHIM" for services in classes 37 and 42 ("Opposer's Application"). Opposer's Application further claims priority to United Kingdom Trademark No. 2,322,712 filed in the United Kingdom on February 4, 2003.

4. Opposer's services include engineering and design services for both on-shore and off-shore constructions, and include the use of shims made utilizing polymers to dampen motions of such structures. The subject shims are the subject of United States Patent Publication No. 20030119390, titled Damping of Conductor Tubes, and filed on June 7, 2002.

5. Based upon the foregoing and upon information and belief, pursuant to Section 7(c) of the Trademark Act of 1946, as amended, 15 U.S.C. § 1057(c), Opposer has priority over Applicant for the use of Opposer's SMARTSHIM mark in connection with Opposer's Services. Opposer's U.S. filing date for Opposer's Application of August 4, 2003 has priority over Applicant's U.S. filing date of September 15, 2003. Opposer's Application further has a priority date of February 4, 2003, pursuant to Section 44(d) of the Lanham Act, as

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<sup>1</sup> An Office Action for Opposer's application issued on February 13, 2004. On August 13, 2004, a Response to the Office Action was mailed by Opposer to the Trademark Office. The Trademark Office erroneously marked the Application as abandoned on September 10, 2004. A Petition to Revive was filed on October 26, 2004, and accordingly while the application is presently in an abandoned status, Opposer expects revival of the application in the immediate future and in no way concedes to the abandoned status.

amended, 15 U.S.C. § 1126(d), and accordingly has further priority over Applicant's U.S. filing date of September 15, 2003.

6. Opposer believes that a likelihood of confusion exists between Opposer's SMARTSHIM mark and the applied for mark by virtue of the breadth of Applicant's recitation of goods.

7. By virtue of its efforts, the expenditure of considerable sums for marketing and promotional activities, and by virtue of the excellence of Opposer's Services, Opposer has gained for Opposer's SMARTSHIM mark a most valuable reputation and exceedingly valuable goodwill.

8. If Applicant's Application to register the term "SMARTSHIM" is allowed, such a registration would be a source of serious and irreparable damage and injury to Opposer.

**WHEREFORE**, Opposer prays that this Opposition be sustained and that application Serial No. 78/300,356 be rejected, and registration of the mark therein set forth be refused.

Respectfully submitted,



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