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

Proceeding	91177064
Party	Plaintiff THE GLIDDEN COMPANY
Correspondence Address	KENNTH J. STACHEL THE GLIDDEN COMPANY 15885 WEST SPRAGUE ROAD STRONGSVILLE, OH 44136 UNITED STATES ken_stachel@ici.com
Submission	Motion to Suspend for Civil Action
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Date	08/21/2007
Attachments	RHINO GLUE Mtn Suspend312.pdf (5 pages)(18402 bytes) Rhino EXHIBIT A.pdf (10 pages)(34727 bytes)

VIA ELECTRONIC SYSTEM FOR
TRADEMARK TRIALS AND APPEALS (“ESTTA”)
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UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

_____)	
Opposition No. 91,177,064)	Serial No. 78/916,312
)	Filed: June 25, 2006
The Glidden Company)	
)	Published in the <i>Official Gazette</i>
Opposer,)	on January 2, 2007
)	
v.)	MARK: RHINO GLUE
)	
Jason Kinsella)	
)	
Applicant.)	
_____)	

MOTION TO SUSPEND OPPOSITION
AND MEMORANDUM IN SUPPORT

MOTION TO SUSPEND OPPOSITION

Pursuant to 37 C.F.R. § 2.117(a), The Glidden Company (“Glidden”) hereby respectfully requests that the above-captioned *inter partes* proceeding (the “Opposition”) be suspended until the termination of a civil action between the parties; The Glidden Company v. Jason Kinsella, Case No. 1:07cv01710, United States District Court, Northern District of Ohio, Eastern Division (the “Civil Action”); which may have a bearing on the Opposition. The reasons supporting this Motion are more fully set forth in the attached Memorandum in Support.

MEMORANDUM IN SUPPORT OF
MOTION TO SUSPEND OPPOSITION

I. PRELIMINARY STATEMENT

The Opposition arises from a dispute over registration of the trademark RHINO GLUE for use in connection with “adhesives for household purposes.” As shown below, the Opposition should be suspended pending the outcome of the Civil Action, which involves the same parties, trademarks, and claims as the Opposition.

II. FACTS

Applicant has filed to register a series of RHINO-element marks for adhesives, including RHINO GLUE, RHINOULTRA, RHINO ULTRA GLUE, RHINOMAX, RHINO MAX GLUE, and RHINO FIX GLUE. Glidden filed the present opposition proceeding on May 2, 2007, after the Trademark Office cited Applicant’s pending applications as grounds for suspending further prosecution of Glidden’s applications Serial Nos. 78/944,891 and 78/940,070 to register the marks RHINO ULTRA and RHINO ULTRA GLUE (and design).

Applicant answered the Opposition on June 1, 2007, asserting exclusive rights to all RHINO-element marks in connection with adhesives and alleging that Glidden’s use of its RHINO ULTRA and RHINO ULTRA GLUE (and design) marks is likely to cause consumer confusion with Applicant’s “rhino brand.” On June 8, 2007, Glidden initiated the Civil Action, seeking a declaratory judgment of non-infringement of Applicant’s RHINO-element marks, non-validity of Applicant’s RHINO ULTRA and RHINOULTRA marks, and that Glidden has superior rights to the RHINO ULTRA mark. A copy of the complaint is attached hereto (without exhibits) as Exhibit A. The complaint in the Civil Action was served via waiver method on July 3, 2007.

In the meantime, the parties have been discussing possible settlement of all outstanding issues regarding their uses of RHINO-element marks.

III. ARGUMENT

When the parties to a proceeding before the Board “are engaged in a civil action . . . which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action.” 37 C.F.R. § 2.117(a). “To the extent that a civil action in a Federal district court involves issues in common with those in a proceeding before the Board, the decision of the Federal district court is often binding upon the Board, while the decision of the Board is not binding upon the court.” Trademark Trial and Appeal Board Manual of Procedure § 510.02(a).

In this case, the Civil Action goes beyond the scope of the current Opposition to address Applicant’s claim to all RHINO-element marks and deal with Applicant’s accusations of infringement. As a result, the parties should be able to address all outstanding issues with respect to their respective uses of RHINO-element marks more completely and more efficiently in the Civil Action.

Accordingly, the Opposition should be suspended in this instance to avoid expending the Board’s resources.

IV. CONCLUSION

For the foregoing reasons, Glidden requests that its Motion to Suspend the Opposition be granted and that the Opposition be suspended for all purposes until the termination of the Civil Action.

Respectfully submitted,

/Christina J. Moser/

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Dated: August 20, 2007

Attorneys for The Glidden Company

CERTIFICATE OF FILING AND OF SERVICE

The undersigned hereby certifies that a true copy of the foregoing MOTION TO SUSPEND OPPOSITION AND MEMORANDUM IN SUPPORT is being filed electronically with United States Patent and Trademark Office and being served by First-Class U.S. Mail, postage prepaid, on this 20th day of August 2007, to the following:

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/Christina J. Moser/

Christina J. Moser

EXHIBIT A

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF OHIO
EASTERN DIVISION

The Glidden Company, a Delaware
corporation,

Plaintiff,

vs.

Jason Kinsella, an individual,

Defendant.

CASE NO. _____

JUDGE

COMPLAINT FOR DECLARATORY
RELIEF

Plaintiff The Glidden Company (“Glidden”), for its complaint against defendant Jason Kinsella (“Kinsella”), alleges as follows:

JURISDICTION AND VENUE

1. This is an action for declaratory relief under 28 U.S.C. §§ 2201-2202.
2. This Court has subject matter jurisdiction pursuant to 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331, 1338, and 1367. There is a substantial, immediate, and actual controversy between the parties as to their legal interests. Kinsella has created a real and reasonable apprehension that Glidden will be a party to litigation based on a course of conduct, including in the State of Ohio, that has brought Glidden into adversarial conflict with Kinsella.

3. Venue is proper in this district pursuant to 28 U.S.C. § 1391(b) and (c), as a substantial part of the events or omissions giving rise to Glidden's claim against Kinsella occurred in and a substantial part of property that is the subject of the action is situated in this district, and Kinsella is subject to the personal jurisdiction of this Court.

PARTIES

4. Glidden is a Delaware corporation with its principal place of business at 15885 West Sprague Road, Strongsville, Ohio 44136.

5. Upon information and belief, Kinsella is an individual with his residence and/or principal place of business at 63 Via Pico Plaza, San Clemente, California 92672 who conducts business nationwide, including the State of Ohio.

GLIDDEN'S BUSINESS AND RHINO ULTRA MARK

6. Glidden has for many years engaged in the manufacture, distribution, and sale of paints, adhesives, coatings, sealants, and other materials used in the fields of construction, remodeling, and repair.

7. In early 2006, Glidden launched a new product under its LIQUID NAILS family of multi-purpose adhesive, sealant, and caulking products, named RHINO ULTRA. Glidden's RHINO ULTRA brand glue is a powerful adhesive, used to attach or adhere to a wide variety of materials, such as wood, composite, siding, crown molding, wainscoting, stone, brick, masonry, concrete, pavers, rock, ceramic, fabric, vinyl, metal, plastic, drywall, ceiling tiles, MDF, cork, laminate, particleboard, and foam.

8. Glidden's RHINO ULTRA product is a moisture-curing polyurethane adhesive that may take twenty to forty minutes to set. Because the adhesive will expand, the parts being joined must be clamped together for a period of time following application. Due to its composition, the product is an amber brown. Glidden sells the product in a clear bottle having a

bright red nozzle and cap. The RHINO ULTRA logo features a face-on view of a charging rhinoceros and incorporates the colors red, grey, bronze, black, and white.

9. Currently, RHINO ULTRA brand glue is available through a variety of retailers, including ACE Hardware Stores, Do It Best Hardware Stores, HSN.com, Magic Mart, Meijer, True Value Hardware Stores, Walgreen's, and Wal-Mart. As a result of Glidden's widespread promotion and advertising of its RHINO ULTRA brand glue, its continuous use of its RHINO ULTRA mark, and by the association with Glidden's LIQUID NAILS family of multi-purpose adhesive, sealant, and caulking products, the RHINO ULTRA mark has acquired brand recognition and a valuable reputation. The RHINO ULTRA mark has become widely and favorably known to the public throughout the United States and has become recognized by consumers, the trade, and the public at large.

GLIDDEN'S RHINO ULTRA APPLICATIONS

10. At the time Glidden adopted the RHINO ULTRA mark, it was the first and exclusive user of that mark in connection with adhesives. Other marks containing the term "rhino" as a component are used by several other entities in the adhesive, sealant, and caulking market, which co-exist in the marketplace.

11. Glidden filed a pending U.S. Trademark Application No. 78940070 ("the '070 application") for the RHINO ULTRA design and word mark in Class 16 for use in connection with "all purpose household glue." The '070 application was filed on July 28, 2006 and is based on the first use of the mark in interstate commerce on February 24, 2006. A copy of TARR results for the pending '070 application is attached hereto as Exhibit A.

12. Glidden also filed a pending U.S. Trademark Application No. 78944891 ("the '891 application") for the RHINO ULTRA word mark in Class 01 for use in connection with "polyurethane glue for woodworking." The '891 application was filed on August 4, 2006 and is

based on the first use of the mark in interstate commerce on February 24, 2006. A copy of the TARR results for the pending '891 application is attached hereto as Exhibit B.

KINSELLA'S INVALID TRADEMARK APPLICATIONS

13. After learning of Glidden's prior use of the mark RHINO ULTRA, Kinsella filed a series of trademark applications claiming an intent to use RHINO ULTRA GLUE in Class 01 for "adhesives for general industrial use," filed on July 24, 2006 (Serial No. 78935602), RHINOULTRA in Class 16 for "adhesives for household purposes," filed on July 29, 2006 (Serial No. 7890587), and RHINOULTRA in Class 01 for "adhesives for general industrial use," filed on July 30, 2006 (Serial No. 78940651) (collectively, the "ULTRA applications"). Copies of the TARR results for these applications are attached hereto as Exhibits C-E.

14. Glidden opposed registration of Kinsella's intent to use applications for the RHINO GLUE and RHINOULTRA marks on May 2, 2007 (Serial Nos. 91177064, 91177963, and 91177061) ("the Glidden Oppositions") based on Glidden's actual use date of February 24, 2006.

15. Upon information and belief, Kinsella does not and never has used the marks claimed in the ULTRA applications and does not and never has used the term "ultra" in a trademark manner in connection with goods and services, despite claiming, in its answers to the Glidden Oppositions, a first use date for the RHINOULTRA mark of November 6, 2005.

16. Over the past year, following Glidden's adoption of the RHINO ULTRA mark, Kinsella has filed a flurry of other "rhino" component marks on an intent-to-use basis, including RHINO GLUE in Class 16 for "adhesives for household purposes, filed June 25, 2006, RHINO FIX GLUE in Class 01 for "adhesives for general industrial use," filed on July 26, 2006, RHINOMAX in Class 01 for "adhesives for general industrial use," filed on July 29, 2006,

RHINO MAX GLUE in Class 01 for “adhesives for general industrial use,” filed March 10, 2007. Copies of the TARR results for these applications are attached hereto as Exhibits F-I.

KINSELLA’S INFRINGEMENT ALLEGATIONS

17. Kinsella’s RHINO GLUE product is a cyanoacrylate-based adhesive and is colorless, sets instantly without expanding or foaming, and does not require clamping. It is sold in clear bottles with tan labels featuring a simplified, black and white side-facing rhinoceros silhouette logo.

18. After Glidden first used its RHINO ULTRA mark in interstate commerce, Kinsella emailed Glidden on July 21, 2006 that “we might have a trademark infringement on our adhesive trademark.” Upon information and belief, Kinsella claims exclusive right to use the term “rhino” in connection with adhesives.

19. Kinsella refused Glidden’s attempts to discuss the matter. Until recently, Kinsella took no further action following his 2006 email.

20. Notwithstanding the pending Glidden Oppositions, on May 23, 2007, Glidden received a five-page letter dated May 21, 2007 from Kinsella’s attorney, accusing Glidden of trademark infringement and demanding that Glidden immediately cease all use of “‘Rhino Ultra Glue,’ ‘rhino ultra’ and any other marks using the word ‘rhino’ for adhesives.” A copy of this letter is attached hereto as Exhibit J. The May 21, 2007 letter further demanded that Glidden “preserve all evidence of infringement, including all sales records, emails, letters and inquiries received from customers or prospective customers regarding the ‘Rhino Ultra Glue’ and ‘rhino ultra’ adhesives.” Kinsella demanded a response within ten days.

21. The May 21, 2007 letter was the first communication from Kinsella since his July 21, 2006 email. Since Kinsella had rejected Glidden’s overtures the previous year and taken no

further action, Glidden continued to advertise and sell RHINO ULTRA glue product in good faith belief that it had superior rights to the mark.

22. Due to the intervening holidays, Glidden wrote Kinsella, stating that it would provide a complete response by June 15th. In response, Glidden received another letter from Kinsella's attorney, on or about June 1, 2007, this time claiming that "[e]very day Glidden continues advertising and using the 'Rhino Ultra Glue' mark increases the injury and damage to Mr. Kinsella. In addition to the demand to cease and desist, Mr. Kinsella will also require compensation for these injuries and damage." A copy of this letter is attached as Exhibit K. The June 1, 2007 letter then detailed explicit instructions to Glidden on preserving electronic data pursuant to Fed. R. Civ. Proc. 16 and demanded a telephone call with Glidden by June 8th, specifically to discuss Glidden's "electronic document maintenance structure and retention policies."

23. Based on the strong allegations made in Kinsella's cease and desist letters, his refusal to give Glidden additional time to respond to the substance of his complaints, his expressed urgency to resolve this matter, and his demand to preserve electronic data pursuant to Fed. R. Civ. Proc. 16, Kinsella has caused Glidden to be in reasonable apprehension of being imminently sued for alleged infringement.

CLAIM I
DECLARATION OF NON-INFRINGEMENT

24. Glidden repeats and incorporates herein by reference the allegations in paragraphs 1-23.

25. Glidden is currently using the RHINO ULTRA mark under its famous LIQUID NAILS house brand and intends to continue to do so.

26. Based on the foregoing allegations, there exists between the parties a controversy of sufficient immediacy and reality to warrant declaratory relief.

27. Glidden seeks a declaratory judgment pursuant to 28 U.S.C. §§ 2201-2202 that its use of the term RHINO ULTRA under its famous LIQUID NAILS house brand in connection with “all purpose household glue” and “polyurethane glue for woodworking” and is non-infringing.

CLAIM II
DECLARATION OF NON-VALIDITY

28. Glidden repeats and incorporates herein by reference the allegations in paragraphs 1-27.

29. Glidden is currently using the RHINO ULTRA mark and intends to continue to do so.

30. Based on the foregoing allegations, there exists between the parties a controversy of sufficient immediacy and reality to warrant declaratory relief.

31. Glidden seeks a declaratory judgment pursuant to 28 U.S.C. §§ 2201-2202 that Kinsella has no common law trademark rights in RHINO ULTRA GLUE or RHINOULTRA.

CLAIM III
DECLARATION OF SUPERIOR RIGHTS

32. Glidden repeats and incorporates herein by reference the allegations in paragraphs 1-31.

33. Glidden is currently using the RHINO ULTRA mark and intends to continue to do so.

34. Based on the foregoing allegations, there exists between the parties a controversy of sufficient immediacy and reality to warrant declaratory relief.

35. Glidden seeks a declaratory judgment pursuant to 28 U.S.C. §§ 2201-2202 that its right to use the term RHINO ULTRA in connection with “all purpose household glue” and “polyurethane glue for woodworking” is superior to Kinsella’s.

PRAYER FOR RELIEF

WHEREFORE, Glidden prays for relief as follows:

1. That this Court adjudge, decree and declare that
 - a) Glidden’s use of the RHINO ULTRA mark does not violate the Lanham Act, 15 U.S.C. § 1125;
 - b) Kinsella has no common law trademark rights in RHINO ULTRA GLUE or RHINOULTRA; and
 - c) Glidden has superior rights to the RHINO ULTRA mark;
2. That this Court enter judgment in favor of Glidden for its costs and reasonable attorneys’ fees to the extent permitted by law; and
3. That Glidden be awarded such further relief as this Court may deem proper and just.

Dated: June 8, 2007

Respectfully submitted,

/s/ Christina J. Moser

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