

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

AS HOLDINGS, INC.,)	
)	
Opposer,)	
)	Opposition No. 91182064
-vs-)	
)	Serial No. 76/461,157
H&C MILCOR, INC., f/k/a/)	Mark: Miscellaneous Design
AQUATICO OF TEXAS, INC.,)	(Pipe Boot Product Design)
)	
Applicant.)	

NOTICE OF FILING

TO: Terence J. Linn, Esq.
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Grand Rapids, MI 49546

PLEASE TAKE NOTICE that on the 21st day of December, 2011, we filed with the United States Trademark Trial and Appeal Board, APPLICANT'S BRIEF AT FINAL HEARING, a copy of which is attached hereto.



Dillis V. Allen
Attorney for Applicant
Reg. No. 22,460

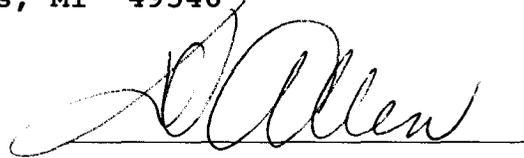


12-21-2011

CERTIFICATE OF SERVICE

This is to certify that on December 20, 2011, the foregoing Notice of Filing and APPLICANT'S BRIEF AT FINAL HEARING were sent via Federal Express to the Trademark Trial and Appeal Board, 600 Dulany Street, Room 37A, Alexandria, VA 22314, and a true and correct copy of same was sent via Federal Express on December 20, 2011, to Opposer's counsel as follows:

Terence J. Linn, Esq.
Gardner, Linn, Burkhardt, & Flory, LLP
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A handwritten signature in black ink, appearing to read "D. Allen", written over a horizontal line.

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APPLICANT'S BRIEF AT FINAL HEARING


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TraFFix Devices, Inc. v. Marketing Displays, Inc.,
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278 F.3d 1268, 61 USPQ2d 1422 (Fed.Cir. 2002) 35,42,44

DESCRIPTION OF THE RECORD

Taken from OPPOSER'S TRIAL BRIEF OPPOSER'S EXHIBITS

Opposer's 1		Second ReNotice of Deposition of Applicant Pursuant to Fed.R.Civ.P. 30(b)(6)
Opposer's 2		Applicant Portals Plus Product Catalog
Opposer's 3		Applicant Portals Plus Medium Pipe Boot Technical Product Information from Applicant's website. ALP00476
Opposer's 4		Applicant Portals Plus Medium Pipe Boot Technical Product Information from Applicant's website (Opposer's Exhibit 3), with hand drawn addition. ALP00476
Opposer's 5		Applicant's advertisement, including Portals Plus and Milcor logos, from Snips trade publication dated January 2008; Vol 77, No. 1
Opposer's 6		Applicant Portals Plus Installation Instructions from Applicant's website. ALP00479
Opposer's 7		Excerpts from websites for Milcor and Portals Plus, including Portals Plus and Milcor logos. ALP00458-462
Opposer's 8		Applicant Portals Plus Product Selection list from Applicant's website, including pipe boot information. ALP00463 – ALP00472
Opposer's 9		Applicant Portals Plus Pipe Flashings Technical Product Information from Applicant's website, including pipe boot information. ALP00473 – ALP00478
Opposer's 10		Applicant Portals Plus Adapter Rings Technical Product Information from website. ALP00480 – ALP00481
Opposer's 11		Drawing and description of Applicant's mark as alleged in response in application file at time of publication.
Opposer's 12		Applicant's expired U.S. Patent No. 4,211,423, Resech, entitled Roof Seal Device; ALP00209 – ALP00216
Opposer's 13		Applicant Portals Plus Installation Instructions for Pipe Boots
Opposer's 14		Hand drawn sketch of left side of hypothetical pipe boot by Attorney for Applicant, Dillis Allen, with hand drawn additions points A and B by Attorney for Opposer, Terence J. Linn
Opposer's 20		Color photograph of Opposer's black pipe boot with 13-inch base and stamp of "ALPHA SYSTEMS EPDM 1" on the base (Applicant's Physical Exhibit 2)
Opposer's 21		Color photograph of Opposer's black pipe boot with 13-inch base and stamp of "CUT ABOVE RIB" (Applicant's Physical Exhibit 2)
Opposer's 22		Color photograph of Opposer's white pipe boot with 13-inch base (Applicant's Physical Exhibit 1)

Opposer's 23		Color photograph Bridgestone/Firestone black pipe boot with 13-inch base and stamp "BFDP EPDM" on the bottom horizontal ring (Applicant's Physical Exhibit 4)
Opposer's 24		Color photograph of Opposer's black pipe boot with 9-inch base and stamp of "ALPHA SYSTEMS EPDM 2" (Applicant's Physical Exhibit 3)
Opposer's 25		Color photograph of Opposer's black pipe boot with 9-inch base and stamp of "cut above rib" (Applicant's Physical Exhibit 3)
Opposer's 26		Color photograph of Opposer's black pipe boot with 9-inch base and stamp of "CUT ABOVE RIB" (Applicant's Physical Exhibit 3)
Opposer's 27		Color photograph of Firestone/Bidgestone black pipe boot with 9-inch base and stamp of "FBPCO" on the base (Applicant's Physical Exhibit 5)
Opposer's 28		Color photograph of Firestone/Bidgestone black pipe boot with 9-inch base and "pipe flashing ½-1-1 ½-2 ½ epdm" on the base (Applicant's Physical Exhibit 5)
Opposer's 29		Print-out of GenFlex Roofing Systems website pages, 9 pages
Opposer's 30		Collection of first pages of U.S. Patents naming Michael J. Hubbard as an inventor
Opposer's 31		Firestone Technical information sheets for pipe boots and flashings, 5 pages
Opposer's 32		Bridgestone/Firestone black pipe boot with 13-inch base (Applicant's Physical Exhibit 4), shown with clamping band
Opposer's 33		Bridgestone/Firestone black pipe boot with 13-inch base (Applicant's Physical Exhibit 4), shown with clamping band
Opposer's 34		Color photograph of Opposer's black pipe boot with 13-inch base (Applicant's Physical Exhibit 2), shown with clamping band
Opposer's 35		Color photograph of Opposer's black pipe boot with 13-inch base (Applicant's Physical Exhibit 2), shown with clamping band
Opposer's 36		Color photograph of Opposer's black pipe boot with 9-inch base (Applicant's Physical Exhibit 3) show with clamping band
Opposer's 37		Color photograph of Opposer's black pipe boot with 13-inch base (Applicant's Physical Exhibit 2) and Opposer's black pipe boot with 9-inch base (Applicant's Physical Exhibit 3) shown side by side
Opposer's 38		Color photograph of Bridgestone/Firestone black pipe boot with 13-inch base (Applicant's Physical Exhibit 4), shown with clamping band

APPLICANT'S EXHIBITS

Applicant's 1 (Steimle)	Hand drawn sketch of left side of hypothetical pipe boot by Attorney for Applicant, Dillis V. Allen
Applicant's 1 (Kintzele)	White 13-inch base pipe boot with stamping on base of "Alpha Systems EPDM 1"
Applicant's 2	Black, 13-inch base pipe boot with stamping on base of "Alpha Systems EPDM 1"
Applicant's 3	Black, 9-inch base pipe boot with the stamping on base "Alpha Systems EPDM 2"
Applicant's 4	Black, 13-inch base pipe boot with stamping on the first frusto surface from bottom of "BFDP EPDM"
Applicant's 5	Black, 9-inch base pipe boot with the stamping of "BFPCO" and "PIPE FLASHING 1/2-1-1 1/2 2 1/2, EPDM"
Applicant's 6	1-color photograph of pipe boot stamped "PFDP EPDM" on bottom horizontal circumference
Applicant's 7	1 color photograph of pipe boot, 13-inch base depicting stamp on base "Alpha Systems, EPDM 1"
Applicant's 8	1 color photograph of white 13-inch base pipe boot
Applicant's 9	1-page, hand-drawn document depicting steps on pipe boot dated 11-12-08, Labeled "Exh A"
Applicant's 10	1-page document labeled as "Exh B", dated 11 (12 13) 08; hand-drawn diagram depicting steps of pipe boot
Applicant's 11	26-pages, documents marked "Confidential" from Maple Mold Technologies
Applicant's 12	52-pages, Portals Plus web-site print-outs
Applicant's 13	222-pages, United States Patents on various seals for roof vent pipes or similar articles
Applicant's 14	21-pages, purchasing specifications from Firestone Specialty Products to Alpha Systems
Applicant's 15	1-page, hand drawings of EPDM, TPO & PVC for GenFlex Mold Types by Mr. Hubbard

Applicant's 16	Excluded in Board's December 20, 2010 Decision
Applicant's 17	Photos of Pipe Boot Insert for BFPD(Ex 4)
Applicant's 18	Portals Plus Invoices to Firestone(2005,2006)
Applicant's 19	Portals Plus 1998 Catalog Sheet
Applicant's 20	Firestone Building Products Specification App.p.24*
Applicant's 21	Firestone Product Specifications App.p.27-32
Applicant's 22	Modified Defendant's Exhibit 9 Drawing

DEPOSITION TRANSCRIPTS

Opposer Submitted:

- Deposition I of Sean Steimle -
Public and Confidential Transcripts
- Deposition of Christopher Carl Kintzele -
Public and Confidential Transcripts
- Deposition of Michael John Hubbard -
Public and Confidential Transcripts

Applicant Submitted:

- Deposition of David Smith, Jr. -
Non-Confidential and Confidential Transcripts
- Deposition of David Smith, III
Non-Confidential and Confidential Transcripts
- Deposition of John Wayne Merryman -
Non-Confidential Transcript
- Deposition II of Sean Steimle -
Non-Confidential Transcript, minus certain sentences relating to the stricken portions of Exhibits 16, 20 and 21
- Deposition of Larry Devitt -
Non-Confidential Transcript minus certain sentences relating to the stricken portions of Exhibits 16, 20 and 21

*App.p. refers to Applicant's Appendix to its Opposition to Opposer's Motion to Strike Exhibits and Testimony for Improper Disclosure and Failure to Disclose

STATEMENT OF THE ISSUES

Applicant submits the following issues to the Board for consideration, whether:

1. The Opposer has improperly raised a new issue of acquired distinctiveness at final hearing, and if not, whether the Opposer has met its burden of proving acquired distinctiveness;

2. Applicant's pipe boot trademark is de facto functional and therefore registerable;

3. Opposer's misappropriation of Applicant's pipe boot without any attempt at redesign raises an inference of adequate competitive alternatives;

4. The Examiner's acceptance of Applicant's amended drawing and the record of its amended drawing features at the application filing date obviate the Opposer's objections to the amended drawing.

5. The Board's Decision of December 20, 2010 striking Applicant's Exhibits 16, 20 and 21, or parts thereof, should be revisited.

I. INTRODUCTION

Applicant's trademark is for the physical configuration of a pipe boot that encircles infrastructure pipes protruding upwardly from flat roofed commercial buildings, sealing the pipe at the roof juncture from the elements and foreign matter.

The physical configuration of the distinctive portions applicant claims as identifying its product from its competitors are a combination of surfaces including a lower frusto-conical surface 10, a semi-toroidal annular rib 11, a short frusto-conical wall 12 extending upwardly from the rib, a flat horizontal annular wall 13, and an inwardly adjacent frusto-conical wall 14.

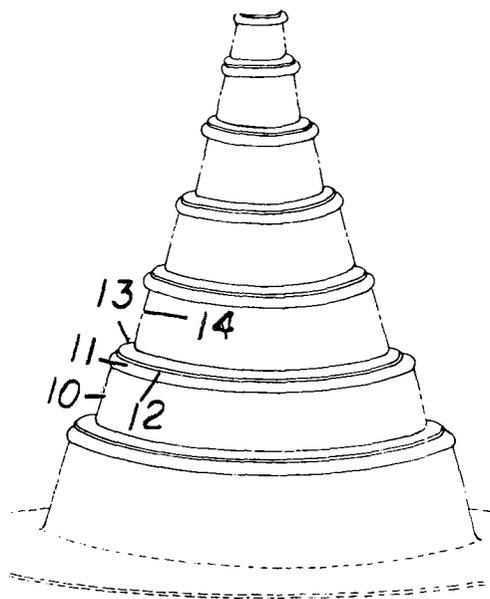


FIG. 1

The original engineering drawing of the same boot in a 13 inch version is dated April 23, 1982, cosigned by Ronald Resech, the then President of Portals Plus¹, and Portals Plus has made that boot continuously and successfully since that date --- without any competitor copying the unique combination of surfaces claimed as applicant's trademark. That is, no copying except AS Holdings, who is not a competitor and never made or sold any pipe boots prior to the filing of this Opposition.

Applicant's Serial No. 76/461,157 was filed with the affidavit of Ronald Resech, along with sales records, trade show participation, brochures, catalogues, sales summaries, and sales activity for a seven year period, claiming continuous and exclusive use of the mark during that period under 37 CFR 2.41(a) and (b).

1. Portals Plus was acquired by Hart & Cooley, Inc. of Grand Rapids, Michigan, which formed H&C Milcor, Inc. for a very limited corporate purpose.

Now the Opposer claims for the first time in its brief that the Resech Affidavit is "suspect", and also that other evidence by Applicant in Serial No. 76/461,157 under 37 CFR 2.41 is not evidence of acquired distinctiveness under Section 2(f).

Let's put this issue to rest at the onset of these proceedings. Opposer's Statement of Issues in its Brief includes "Whether the mark lacks distinctiveness" without the adjunct that Applicant's mark "is a functional configuration" contained in the Opposer's Notice of Opposition. Opposer never notified Applicant of its intent to pursue acquired distinctiveness alone without functionality. Opposer opted not to take the deposition of Ronald Resech whose Affidavit it attacks, never questioned any of Portals Plus witnesses on advertising, continuous use, exclusive use or any other indicia of acquired distinctiveness. During the Steimle deposition 1, Applicant's counsel asked Opposer's counsel why he wanted to ask the witness questions about Portals Plus sales and he answered "I don't know".

If Opposer desired to add acquired distinctiveness to the issues in this case, it should have filed a Motion under FRCP 15. Therefore, Applicant here moves, or asks the Board sua sponte, to strike issues 2 and 3 from Opposer's "Statement of Issues" and to strike all facts and arguments relating thereto.

It is well settled that acquired distinctiveness, even if properly pleaded, is presumed from the 37 CFR 2.41 filings when accepted by the Examiner and that this prima facie case showing shifts the burden to the Opposer to rebut this showing by the introduction of its own evidence. Therefore, even if the Board accepts this new acquired distinctiveness issue, Opposer's arguments fail because they are not supported by one iota of rebuttal evidence.

Opposer also argues that the Resech affidavit and its supporting evidence are not in fact evidence at all because they are only in the file history citing an abundance of cases. However,

all these cases were reversed by the Federal Court in 2009, in *Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352(Fed.Cir.2009).

AS Holdings is just short of a thief in the misappropriation of Portals Plus pipe boot, a practice the Opposer has admitted doing with other company products as well. Opposer started this process by buying a 13 inch pipe boot from Firestone, claiming repeatedly it did not know at that time, or even today, it was made by Portals Plus for Firestone bearing the Portals Plus mold insert BFDP.

Instead of redesigning the Firestone boot to its own specifications, Opposer sent only the Firestone pipe boot to Maple Mold, in Michigan to make a multiple cavity mold for Opposer using the Firestone pipe boot as a master, which Maple Mold did and delivered the completed tool to AS Holdings. The question is why didn't AS Holdings redesign the Firestone tool using its own ingenuity. AS Holdings had no engineering department, in fact it had not one employee who was a graduate engineer of any type. And they never hired any outside engineering consultants, perhaps for the same reason it had no engineering department.

Opposer says it "was and is not aware that the Firestone pipe boot is a design of(Opposer, sic)" applicant. That is simply preposterous. Applicant's employees have testified they made the subject Firestone pipe boot. Applicant's employees testified they drafted the Firestone specification in evidence, and in fact that specification has a Portals Plus logo in the upper left corner of page 1 of the specification. Opposer's own witness even testified that all pipe boot dimensions in the Portals Plus specification sheet were identical to those in the Firestone specification sheet. And while the supporting Exhibit was excluded by the Board, Opposer's counsel has seen the pipe boot mold insert "BFDP" that transforms the Portals Plus molding tool to the Firestone molding tool when Portals Plus manufactured an

order from Firestone. There is no doubt in this case that the Firestone boots, one of which is the Applicant's Exhibit 4, were made by Portals Plus.

The Opposer could have taken the testimony of Firestone employees on this issue, but chose not to.

A critical issue in this case is whether there is a patent covering, disclosing, or claiming the five featured surfaces of this trademark.

The reason why the issue is so important is because our Supreme Court in *TraFFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001(2001) told us that competitive alternatives need not be considered when an existing patent, expired or unexpired, covers the feature sought to be trademarked.

Buoyed by the *TraFFix* case, Opposer maintains boldly --- but falsely --- that the Raymond Resech, Portals Plus, U.S. Patent No. 4,211,423, not only discloses these five surfaces, but also "claims" them. Both are false.

The Resech '423 patent discloses a pipe boot having a rigid bottom piece including wall 51 and cylindrical wall 55. An upper softer piece 18 fits over the rigid lower piece 51 and is clamped at 30. The upper piece is vertically split so it wraps around the pipe, not stretched over the top of the pipe as Applicant's boot does.

The vertical steps in Resech are cylindrical, not frusto-conical, there is no short frusto-conical wall in Resech. There is no semi-toroidal annular ring below the short wall -- and in short not two of the five Portals Plus surfaces are shown in the Resech patent.

The claims in Resech are limited to "a pair of complementary base sections" and a "rigid skirt" inside the base. In short, there are no features claimed either singly or in combination that compare to any of Applicant's five surfaces.

Opposer's reliance on the Resech patent only underscores the weakness and futility of AS Holding's Opposition.

It is true that some of Applicant's marketing materials refer to the rib as a cutting guide and reinforcing element -- and it admittedly has those general functions. But that is only one of Judge Rich's criteria, and the facts show that the rib was not originally designed for those purposes and that the softness of the rubber from which the pipe boot is made -- Shore A 60 -- make it a very poor knife guide because a knife will easily plunge into the rib when the installer is trying to cut above the rib, all while holding the pipe boot in one hand without the help of any fixed holding device.

Furthermore, Opposer's own witness testified that installers frequently don't use the rib as a cutting guide anyway, because the diameter of the pipe to be cut is less than the inside of the pipe boot at the rib, necessitating a cut further up the boot from the rib but below the next rib up.

One of Opposer's witnesses drew a sketch of a pipe boot during his testimony strikingly similar to the subject Portals Plus pipe boot --- claiming that GenFlex manufactured that boot. However, GenFlex was purchased by Firestone and in all probability it was a pipe boot made for Firestone by Portals Plus. Opposer never produced any hard evidence of the supposed GenFlex pipe boot so it appears to be a dead issue.

In cases where there are no patents disclosing the functions of the design,, the *Morton-Norwich* requirement for examining competitive alternatives does come into play. Such is the case here. During the examination of several of Opposer's employees and two of Portals Plus employees, a sketch was developed, in part by Applicant's counsel, to exemplify possible constructions that might be competitive alternatives to Applicant's pipe boot (App.Exh.9, Fig. 7 below).

In Fig. 7 below(p.25), the walls 10, 11, 12, 13, 14, 15, 16, and 17 with the ribs 22, are all intended to represent the five surfaces of Firestone's and Applicant's subject boot. The cross-hatched surfaces 11, 18, 19, 20 and ribs 21, 22, and 23 are

intended to depict an alternative construction wherein horizontal steps 12, 14, and 16 are eliminated and replaced with the frusto-conical walls 18, 19, 20.

Applicant's witnesses testified the alternate constructions 18, 19 and 20 would be less costly because less material would be needed. Witnesses for Applicant also testified that the semi-toroidal rib 23 could be replaced by a square rib at 22 or a triangular rib at 21.

The Opposer says that the angled frusto surfaces 11, 18, 19 and 20 in Fig. 7(App.Exh.9) would increase the overall height of the boot. Incorrect. As seen in Fig. 7, the new cross hatched boot has the same height as the dotted Portals Plus Firestone boot.

Opposer's witness, Michael Hubbard, said that the increased angle of surface 18, compared to Portals Plus surface 13 would cause buckling, making the boot leak under the clamp. Firstly, Mr. Hubbard is only a chemist and does nothing at AS Holdings other than design adhesives. He never designed a pipe boot and AS Holdings never made pipe boots other than this misappropriation.

Furthermore, as Mr. Devitt testified, an architectural engineering graduate from the University of Illinois and an experienced trainer of other employees in the installation of pipe boots -- the installer cuts the boot at 1/2" narrower than the pipe diameter and then stretches it over the pipe so a large vertical area of the boot, where one places the clamp, is stretched to a pure cylindrical portion with no ripple --- and that would apply to the Applicant's Exhibit 9 alternate design as well.

There is no functional magic to the semi-toroidal cross section of Applicant's ribs 11. Why couldn't they be rectangular, square or even triangular as depicted at 22 and 21 in Fig. 7 (App.Exh.9)? Mr. Devitt testified there would be no more difficulty in releasing the pipe boot from its mold with the sharper

edged shapes than with the semi toroidal shape. Opposer's chemist, Mr. Hubbard, with no pipe boot design experience, or any mold design experience, testified otherwise.

The distinctiveness of Applicant's mark, and customer recognition is exemplified not only by the presence of the combination of the five surfaces but also the relative size and location of these surfaces. For example, the rib 11 could be displaced downwardly 1/2 inch, the short wall 15 could be tripled in height, and the horizontal wall 13 width could be cut in half. Various combinations of these modified relative surface sizes produce a markedly different appearance as shown in the sketch in Fig. 10 below. And none of these modifications detracts from the useability of Applicant's pipe boot -- but they do change the appearance of the pipe boot, without detracting from the quality or economics of the product. Opposer was, in short, too cheap to make any design changes to Applicant's boot, even these simple ones.

The Opposer recites about dozens of illusory facts and overruled legal conclusions in its Brief, and the minutia one is its complaint that Applicant changed the drawing. But the Examiner approved and accepted the amended drawing and that should end the matter, not only with Opposer but with the Board. The original draftsman admittedly failed to include all the details of the boot even though he drew it from a Portals Plus 13" physical pipe boot. However, what was added was already in the record. Exhibit L, the 1982 original engineering drawing, was filed with the original application and clearly shows all of the features and dimensions of the final application drawing. Furthermore, Exhibit N-1 to N-9 also filed with the original application and Ronald Resech's affidavit, is a Portals Plus brochure that shows each and every feature of the finally accepted drawing. So exactly what rule was broken, or how was the public harmed by the Examiner's acceptance of the amended drawing? If the Examiner

had finally opposed such amendments, they would have been added without objection in a refiled application. The Opposer should better focus on its stronger points.

Finally, the Board erred when it excluded certain Applicant's Exhibits in its December 20, 2010 Decision and its reconsideration Decision of August 24, 2011. These Decisions exclude documents showing shipments and specifications from Portals Plus to Firestone and a mold insert with the caption "BFDP" used by Portals Plus to make the Firestone pipe boot.

Mr. Pologeorgis excluded these Exhibits for failure of Applicant to produce them in response to a document request for "third party use" documents -- interpreting the request to include, not competitors of Portals Plus, but customers. That request would require hundreds of thousands of Portals Plus documents if completely responded to. Applicant did produce sample customer invoices and objected to the request as overly broad. Opposer, in response, filed no motion to compel. This issue needs to be revisited by the Board.

For the above and below reasons, Applicant requests (1) that the issue of distinctiveness be limited to functionality and that Opposer's facts and arguments relating thereto be stricken; (2) that Applicant's trademark, a Pipe Boot, be found de facto functional and not de jure functional; (3) that Applicant's final drawing be accepted as filed, and (4) that the Board's December 10, 2010 Decision striking portions of Applicant's Exhibits 16, 20 and 21 be withdrawn and those Exhibits considered in these Briefs at Final Hearing.

II. FACTS

A. THE DEVELOPMENT, HISTORY, AND PROSECUTION OF APPLICANT'S PHYSICAL TRADEMARK

Fig. 1 above is applicant's physical trademark as depicted in the drawings filed on March 2, 2007 and accepted by the Examiner as evidenced

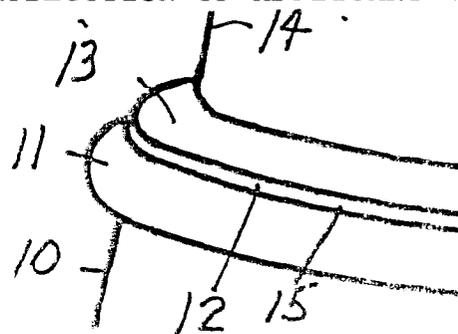


FIG. 2

by the Publication Notice. Fig. 2 is a sketch filed in Applicant's Amendment filed on March 2, 2007.

In that amendment, the distinctive portions of applicant's trademark were described by counsel as follows. "The distinctiveness of the present mark is evidenced by a combination of shapes illustrated in Fig. 3; that is: (a) the frusto-conical surface 10; (b) the arcuate ring 11; (c) the annular nearly vertical surface 12; (d) the horizontal annular surface 13, and (e) the frusto-conical outer surface of 14. Thus, it is a combination of all five of these shapes that defines the present design and trademark."

The Affidavit of Ronald Resech, then President of Portals Plus, was filed with the original application on October 18, 2002, claiming exclusive and continuous use for the prima facie period set forth in 37 CFR 2.41(a) and (b). Many exhibits were attached to and described in the Resech Affidavit as follows:

"The pipe flashing products and other products manufactured by Portals Plus, Inc. are shown and described in the attached brochure identified as Exhibit A.

Exhibit B shows the sales records per unit sold for the last seven years ranging from 42,970 units in 1995 to 336,830 units in 2001.

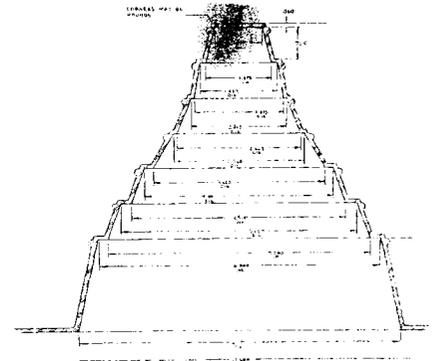
A chart entitled "Trademark of Pipe Boot Section 2 and 8", Exhibit C, shows advertising costs from 1997 to 2001 ranging from \$15,606 in 1997, to \$10,342 in 2001; Catalog and Literature Costs from 1997 to 2001, beginning with \$10,715 in 1997, to \$34,514 in 2001, down from \$44,862 in the year 2000, and Trade Show Costs for the past six years beginning with \$21,157 in 1996 to \$23,521 in 2001.

Trade Directory Advertisements are exemplified by Exhibits D through K including a Wholesale Distributor, G. W. Berkheimer Co., Inc.; Great Lakes Regional Roofing Trade Show Exhibit Directory 2002; NERCA 2000 Membership Directory and Resource Guide; a

1999 Tool and Fastener Hand Guide by Dynamic Fastener, and others all containing advertisements for the Portals Plus Pipe Boot during the last five years.

An original production drawing is exemplified by Exhibit L entitled "SPNI #116 Roof Seal" drawn by S. Gordon, an employee of Portals Plus, Inc., and checked by myself as indicated in the lower right-hand title box. Note that this drawing was made on April 25, 1982, and dated that date, and this product has been manufactured continuously by Portals Plus since that date in April, 1982."

Exhibit L is a 1982 engineering drawing cosigned by Ronald Resech and attached to his Affidavit. No competitors, save the Opposer has copied these five surfaces since that 1982 inception. (F.H.²Exh.L, F.H.Exh.O to T).



"Group Exhibit M is a compilation of 21 Invoices representing sales of the Pipe Boot to a majority of the states in the United States demonstrating that this product is sold throughout the United States. The invoices in Group 1 are but a small fraction of the total invoices on this product by Portals Plus, and these are merely representative of the various states in which sales have occurred as opposed to total volume.

Exhibit N1 to N9 are actual brochures of the Pipe Boot for 1992, 1993, 1994, 1996, 1997, 2000, 2001, and 2002 respectively, showing the extent and longevity of the advertising for this product.

Literature for the competitors manufacturing Pipe Boots are illustrated in Exhibits O to T including, for example, Cone-Jack Products, Inc. of Eugene, Oregon; Firestone Quickseam Tape Systems; Duro-Last, Inc. Accessories and Pipe Flashings; Carlisle

2. F.H. refers to "File History".

Corporation of Carlisle, Pennsylvania "Sure-Seal and Brite-Ply EPDM Molding Pipe Flashings; Johns Manville UltraGard EPDM Peel and Stick Pipe Flashing; and Seaman Corporation FTR Pre-Molding Flashing."

The Examiner accepted the file history evidence of exclusive use and continuous use when he passed the application Serial No. 76/461,157 to publication on December 5, 2007.

B. FACTS RELATING TO THE NEW ISSUE OF ACQUIRED DISTINCTIVENESS RAISED BY THE OPPOSER

In Opposer's Notice of Opposition, the following Counts are set forth:

"COUNT I

70. The alleged mark of Applicant's Application is a functional configuration of the goods that is not distinctive, has not acquired secondary meaning or acquired distinctiveness, and does not operate as a trademark.

COUNT II

74. The alleged mark of Applicant's Application is a configuration that is functional and is a configuration of a design feature that is functional and serves a utilitarian purpose of purposes.

COUNT III

78. Applicant and/or Applicant's predecessor in interest materially altered the mark sought to be registered in Applicant's Application after the original filing thereof.

COUNT IV

83. In Applicant's Application and during the course of prosecution of Applicant's Application, Applicant, Applicant's predecessor in interest and/or their counsel affirmatively misrepresented to the Examining Trademark Attorney and the Patent and Trademark Office that the mark sought to be registered by Applicant is not functional --- etc."

Now in Opposer's Brief at Final Hearing, the following issues are set forth:

"STATEMENT OF THE ISSUES

1. Whether the mark for which registration is sought is functional and therefore unregistrable.
2. Whether the mark for which registration is sought lacks distinctiveness and is therefore unregistrable.

3. Whether Applicant has proven that the mark for which registration is sought has acquired secondary meaning or acquired distinctiveness under Section 2(f) of the Trademark Act.

4. Whether Applicant improperly amended the application during prosecution to add subject matter sought to be registered as all or part of the mark and therefore registration should be denied."

Now Opposer's Brief issues 2 and 3: Whether the mark for which registration is sought lacks distinctiveness and is therefore unregistrable; and Whether Applicant has proven that the mark for which registration is sought has acquired secondary meaning or acquired distinctiveness under Section 2(f) of the Trademark Act, exclude the functionality requirement of Counts I and II.

The result is that Opposer has attempted to significantly broaden the scope of the Opposition to include acquired distinctiveness.

FRCP Rule 15 sets forth:

"Rule 15. Amended and Supplemental Pleadings

(a) Amendments Before Trial

(2) Other Amendments

In all other cases, a party may amend its pleading only with the opposing party's written consent or the court's leave. The court should freely give leave when justice so requires.

(b) Amendments During and After Trial

(2) For Issues Tried by Consent

When an issue not raised by the pleadings is tried by the parties' express or implied consent, it must be treated in all respects as if raised in the pleadings."

Opposer presented no evidence or testimony at trial on the issue of acquired distinctiveness -- none. There was one colloquy, however, at the Sean Steimle's 30(b)(6) deposition(Steimle I, p.72,73) relating to Portals Plus sales records.³

"MR. ALLEN: Why would we use the sales information?

MR. LINN: I don't know.

3. Applicant waives any confidentiality associated with this testimony

MR. ALLEN: What's the relevance of it?
MR. LINN: The only reason I would want to look at them if you want to use them."

Thus, the only testimony or evidence introduced by the Opposer on the issue of acquired distinctiveness are Portals Plus sales that Applicant's counsel conceded would be used by Opposer only if Applicant used them for some purpose.

Opposer chose not to take the deposition of Ronald Resech who was in the geographic vicinity of Applicant's offices and manufacturing plants during the trial of this case.

Furthermore, Opposer filed no motion under FRCP 15 to add this new issue to this case.

C. THE FIRESTONE PIPE BOOT WAS MADE BY PORTALS PLUS AND OPPOSER COPIED IT TO MAKE ITS TOOLING

Applicant's Exhibit 6 (Fig. 4) is a photo of the mold insert legend "BFDP" and "EPDM" of the Firestone physical pipe boot Applicant Exhibit 4. The "BF" stands for Bridgestone Firestone, and the EPDM represents the thermosetting rubber from which the Pipe Boot was made (Kintzele, p.11).



AS HOLDINGS vs. H&C MILC
Opposition No. 9118,067
Serial No. 78451,157
Delt. No. 6

FIG. 4, AE 6

Opposer purchased this same Firestone Pipe Boot from Firestone in 2007.

AS Holdings sent the Firestone Pipe Boot to Maple Mold in Auburn Hills, Michigan to have the Firestone Pipe Boot copied, which it did and shipped the completed tool to AS Holdings in March of 2007 (Kintzele, p.22). Mr. Kintzele testified that Maple Mold made the AS tooling by measurements from the Firestone sample (Kintzele, p.28). AS had no engineering department at that time (Kintzele, p.28). And AS Holdings never considered farming out design projects to consulting firms even on other

projects(Kintzele,p.29) and it was common practice for AS Holdings, instead of designing its own products, to send competitors' part samples to Maple Mold for replication(Kintzele,p.29).

"Q So you -- it's a common practice for you to send parts made by other manufacturers to your tool-maker to design that part?

Or replicate it?

A Correct

Q Common-practice, is it?

A Yes."

In short, AS Holdings did zero engineering on its new products(Kintzele,p.30).

"Q So, in this particular case, of sending the Firestone production samples to Maple Mold, AS Holdings did zero Engineering on this product?

A That's a true statement."

And AS Holdings never did any tests on the samples it ran from the Maple Mold tools for safety, reliability, or specification compliance(Kintzele,p.30).

"Q Did you run any tests that you are aware of on those prototype samples of Exhibits 1 and 2?

A I'm not aware of any testing."

And, the short of it is that AS Holdings did not want to spend any of its own money on the Firestone project (Kintzele,p.32).

"Q Why didn't you design your own pipe boot?

A My understanding is that the pipe boot that we are Purchasing from Firestone has the qualities that are deemed, I guess, 'acceptable' by roofing contractors.

Q Do you mean because they are initially successful?

A Yes

Or, they work in commercial applications that we were hoping to sell them to.

Q Without spending any Engineering money?

A Yes."

Not only did AS Holdings have no Engineering Department, it did not have a single graduate engineer anywhere in its organization(Kintzele,p.40).

There is substantial other evidence in the record to demonstrate the Firestone Pipe Boot of Applicant's Exhibit 4 was made by Portals Plus. For example, in the Board's Decision of December 20, 2010, striking portions of Applicant's Exhibit 20, the Board denied the Motion to Strike with respect to page 2 of that Exhibit (Appendix p.24 of Applicant, H&C Milcor's Opposition to Opposer's Motion to Strike Exhibits and Testimony for Improper Disclosure and Failure to Disclose.

This Firestone specification was sent to Portals Plus by Firestone (Devitt, p.7) and it is entitled "Firestone Building Products Company EPDM Pipe Boot" with a picture of a pipe boot that looks like the Firestone Pipe Boot of Applicant's Exhibit 4, with dimensions the exact same as the dimensions in the Portals Plus catalog.



Firestone

Building Products Company

EPDM Pipe Boot

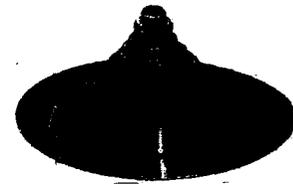


FIG. 5

Firestone Spec AE 20, p.2

But note, in the upper left corner of Exhibit 20 in the headline is the logo of Portals Plus surrounded by a square line. How did this logo get there if it wasn't generated by Portals Plus? Mr. Larry Devitt, Marketing Manager and University of Illinois Architecture graduate, explained this Exhibit at Devitt, p.7:

"Q Can you identify those documents?

A Yes. --- this particular page that has a drawing of a pipe boot and along again with some dimensions and whatnot and a little bit of description with Firestone's name on it and the Portals Plus logo.

Q Who generated that document?

A Portals Plus did. Portals Plus generated it and sent it to at that time the purchasing agent at Firestone to give him an idea, a concept, of what it is that he is going to be buying."

Also, there are invoices in the record showing many shipments of pipe boots from Portals Plus to Firestone, just a few years prior to the AS Holdings purchase of the Firestone boot. Sean Steimle, a Vice President of Hart & Cooley and General Manager of a renamed Portals Plus (Commercial Products Group of Hart & Cooley) authenticated Applicant's Exhibit 18, 16 Invoices of shipments from Portals Plus from Portals Plus to Firestone Building Products Co.

Furthermore, the Opposer's own employee, Michael Hubbard, a chemist, confirmed that the pipe boot dimensions in the Firestone catalog were exactly the same as those in the Portals Plus catalog (Hubbard, p.34):

"Q I want you to read them off, or you can tell me whether are identical, whether the dimensions of the Portals Plus pipe boot are -- in that catalog are identical to the thousandths of an inch in the Firestone pipe boot in Exhibit 14?

THE WITNESS: Those are identical."

Opposer's statement in its brief that it doesn't know "to this day" who made the Firestone pipe boot, opens the door to an Exhibit excluded by the Board in its December 20, 2010 decision. Excluded Applicant Exhibit 16, which is a mold insert with the legend "BFDP EPDM" in reverse, to the admitted Applicant's Exhibit 6 photo of the markings on the Firestone pipe boot and in Applicant's Exhibit 4. Applicant does not raise this for the Exhibits evidentiary value, but only to show the state of mind of the Opposer.

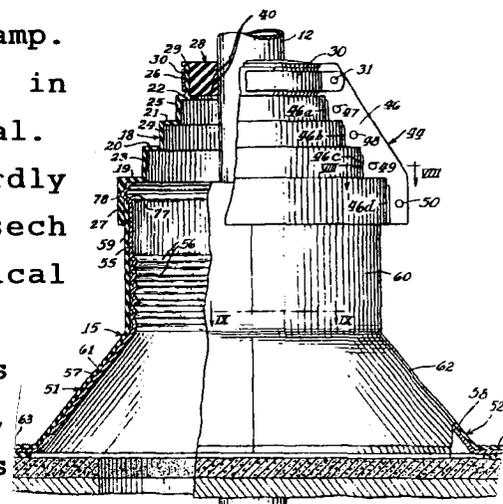
**D. THE FACTS ON THE RESECH, U.S. PATENT NO. 4,211,423
ASSIGNED TO PORTALS PLUS**

Opposer argues that the Resech '423 patent discloses and "claims" the five surface combination touted as proprietary and distinctive by Applicant, namely: (a) the frusto-conical surface 10; (b) the arcuate ring 11; (c) the annular nearly vertical surface 12; (d) the horizontal annular surface 13, and (e) the frusto-conical surface 14.

Opposer's statement that the Resech patent discloses and claims these surfaces is simply not true.

The Resech "Roof Seal Device" is a stepped pipe boot, but there the similarity stops. Resech shows a two piece pipe boot including a lower rigid section 15 and a vertically split, not continuous, upper soft section 18, that is wrapped around the lower section 15 and the pipe and the split upper section is held together with a clamp. There are no frusto-conical surfaces in Resech, instead surfaces 23 are cylindrical.

There are no semi-toroidal outwardly projecting ribs disclosed in the Resech patent. There are no short frusto-conical surfaces above the ribs as defined in the above distinctive combination of surfaces or walls. Note also in Resech, Fig. 6, that the upper boot section 18 has radial flanges protruding along the split line not found in the trademark boot.



Resech Patent, FIG. 6

Claim 1 in Resech reads as follows:

"1. In a device for providing a weather-tight seal around an object projecting upwardly therefrom, a pair of complementary base sections adapted to be joined together along a generally vertical plane in approximate alignment with said object and together providing an upstanding generally tubular portion for surrounding the object and a peripheral flange portion extending outwardly from the lower end of said tubular portion for engaging the upper surface of roofing material about said object; seal means secured to the upper end of said tubular portion for sealing engagement with said object, each of said complementary base sections including a supporting part of a molded, strong and substantially rigid plastic material and a skirt part of a flexible elastomeric material on said support part, each of said skirt parts having edge portions arranged for overlapping interfitting engagement with edge portions of the skirt part of the other section, said skirt parts having peripheral edge portions together providing a downwardly facing surface adapted to engage an annular portion of the upper surface of roofing material about said object,

and an adhesive material for sealing and bonding said downwardly facing surface of said skirt parts to said upper surface of said roofing material."

There is nothing in that Claim that responds to the Applicant's trademark pipe boot.

E. APPLICANT'S BROCHURE STATEMENTS

It is true that Portals Plus brochures beginning about 1996 attribute a cutting guide and a reinforcing function to the rib 11, and in later materials a clamp stopping function to ribs.

Firstly, it is important to note that these statements were not made prior to 1996, while the original engineering drawings and sales began in 1982(see F.H.Exhibit L). In response to Opposer's document requests, Applicant could find no documents in the 1980s attributing any function whatsoever to the rib 11.

Larry Devitt testified the functional statements in Portals Plus catalogs were simply marketing tools(Devitt,p.18), but the stronger evidence of quasi-functionality is the fact that the entire pipe boot is constructed of an extremely soft Shore A 60 durometer material -- the softness of a firm sponge -- and could hardly be characterized as a well designed knife cutting guide.

Mr. Steimle also testified as to the effectiveness of the rib 11 as a cutting guide(Steimle II,p.14):

"Q I am going to ask you whether in your experience with pipe boots that that semi-toroidal rib is an effective cutting guide?

THE WITNESS:(MR. STEIMLE): No. It is a decorative marketing piece. It is a soft rubber. I believe it is 60 Shore A and the -- if you are using a knife to cut the pipe boot, you can walk yourself right through the semi-toroidal bead indicated in our cutting line, which would not be a guide. It is a marketing function and decorative.

BY MR. ALLEN:

Q And when you position the clamp on the pipe boot, does the semi-toroidal ring act as a stop to keep the clamp from slipping off the pipe boot?

(MR. STEIMLE): No, it doesn't. Actually, where you put the clamp could vary on the pipe boot. You actually want to cut it below the rib line so that you can

stretch the material up and clamp the pipe boot against the pipe. So the clamp actually does not sit against the semi-toroidal bead around the pipe boot."

Mr. Hubbard also agreed that the rib 11 could easily be impaled with a cutting knife(Hubbard,p.139):

"Q MR. ALLEN: "Now let's assume that it's a Shore A-40.

A Okay.

Q Which is a very soft material?

A I agree.

Q And, you take a knife and go in there to cut.

Wouldn't you cut into the rib just as easily as the little short wall above? If we had Shore A-40?

A Possibly"

The effectiveness of the rib as an adequate reinforcing element is also open to question even though Applicant admits there is a marginal reinforcement provided circumferentially by the rib 11.

Firstly, the cut line for a particular pipe size may well be below the rib instead of above the rib(See Steimle II,p.15).

And Opposer's Mr. Hubbard agreed that cutting must be made in a variety of locations to accommodate pipe size (Hubbard, p.131-132).

"Q And, in terms of these flat horizontal annular surfaces, 13, do they provide any benefit or function to the pipe?

A The top step here?

Q Yes.

A Yeah.

Sometimes they can actually be an interesting thing to cut along that line and then pull it down. You actually get a --.

I've actually done that where you can cut along where you have a pipe that not quite the diameter of this one.

MR. DILLIS V. ALLEN: Cut inside the step.

THE WITNESS: Inside the step only if the diameter is little bit smaller than the ring."

And while the Portal Plus catalogs call rib 11 a cutting guide, it is not an effective one because it is made of a soft material, Shore A 60 durometer, into which a knife could easily

plunge. If one were to engineer a well designed cutting guide, a rigid ring could be insert molded into the pipe boot under rib 11.

With respect to the rib 11 acting as a stop, Larry Devitt, who has designed, installed and taught pipe boot installation at Portals Plus since 1996 (Devitt, p.9,12) doesn't even believe the clamp is necessary much less a stop for the clamp (Devitt, p.14,15,17).

"Our pipe boot when we look at it right here on the table in front of me, we can see that each one of these steps has a slight angle to it. Once that boot is installed, that angled surface that is contacting the pipe is actually going to be vertical. It is going to be 90 degrees. So sometimes it's tough to pull it down.

So we slide that down the pipe. Again, the side is now becoming vertical because it's being stretched. So the penetration is being sealed because the rubber is tight up against the pipe.

Then I take the clamp I had in the box and I position that. I really don't need it again because remember this pipe boot is sealed 100 percent against it because it's stretched. But I put a clamp around it as a belt and suspenders type of thing. Tighten it with a screwdriver. And essentially I am done.

Q Is the rib necessary to keep the clamp after it's installed from slipping off?

A No. No. The clamp -- again, the clamp number one, is not necessary. But number two, no, it doesn't have to keep the clamp in place. For example, this last step is designed for six inches down here at the bottle bottom. I mean, you have a huge space here. You can put the clamp anywhere. The clamp can go on top of the rib even. It doesn't matter. That rim is nothing but decoration. It helps to separate us from other manufacturers."

The function of rib 11 as a stop, as with the other advertised functions of reinforcement and a cutting guide -- can be characterized as desirable features, but certainly not as functional necessities. In the 25 years of Portals Plus' manufacture of this pipe boot, it is telling that no competitor has adopted an extended ring as a cutting guide and a clamp stop (F.H.Exh.0-T), even though some have adopted rings for reinforcement.

F. THE GENFLEX PIPE BOOTS

Mr. Hubbard testified that he worked for GenFlex as a chemist and that they made and sold pipe boots. He sketched two of these as Applicant's Exhibit 15, one of which appears similar to the Portals Plus design. Opposer has produced no hard evidence of either of these two sketches and in the GenFlex catalogs (Opposer Exhibit 29), no similar pipe boots can be found.

Further, Mr. Hubbard testified that GenFlex was previously acquired by Firestone (Hubbard, p.8) and that GenFlex purchased pipe boots from Portals Plus (Hubbard, p.87) and that the GenFlex boot was "very similar to Firestone's (Hubbard, p.37), so one could conclude that the GenFlex pipe boots were also made by Portals Plus.

G. THE BACKGROUNDS OF MR. DEVITT AND MR. HUBBARD

Inasmuch as the technical inquiries of both parties are largely cornerstoned in the testimony of Larry Devitt for the Applicant, and Michael Hubbard for the Opposer, a brief review of each of their backgrounds is believed helpful.

Mr. Devitt is a man of about 65 who graduated from the University of Illinois with a degree in Architecture. He spent his entire working life in roofing (Devitt, p.9):

"A Gosh, that is actually pretty compact. Because in 19-- beginning in 1996 I started with Portals Plus. So that takes us back thirteen years. Prior to that where was I? I was with a wholesale distributor in the Chicago area. A national distributor in the Chicago area. I have been in roofing in one form or another. Whether it is contracting, roofing consulting, investigating failed roofs, designing new roofs, since about 1980."

Mr. Devitt described his experience as follows: (Devitt, p.10)

"A Well, certainly during that time frame one thing that I learned in roofing -- I started out with a company investigating roofs. Problems on roofs. How to repair roofs. How to keep roofs in good shape. During that time, I learned that problems on roofs occur in general at the details. Statistics from the National Roofing Contractors Association show that 80 percent of

the time a problem on a roof is going to be at the detail. In other words, it's not going to be out in the middle where there's nothing around. Very seldom does it leak there.

So pipe boots become an important part of the details because there are projections through the roof on virtually every roof. So it's important that the pipe boots be durable, be flexible. Because even though we don't know it when we're looking at the commercial industrial roof, that roof is moving. Moving all the time. From the heat of the sun. From the cold weather. From the roof membrane itself. Aging. It shrinks. And when it does that it pulls on every component that it is attached to.

Therefore, a pipe boot -- as the roof shrinks and it shrinks towards the center of the roof, any pipe boot that you put on it is going to be stretched generally horizontally away from that penetration and being pulled.

So you need flexibility. You need weather-ability. There is extremes of weather. Roofs can be 140 degrees in the summer and 40 degrees below zero in the winter. In addition, there are ultraviolet rays really affect the performance of anything that you put on the roof. To degradation from the ultraviolet rays of the sun is horrible.

So all of those factors play into the design of a good pipe boot or the product that it is even."

After joining Portals Plus in 1996, Mr. Devitt trained Portals Plus employees and others in the proper installation of pipe boots (Devitt, p.12,13).

Mr. Hubbard is a man of 48 years with a degree in chemistry and was hired by AS Holdings about two years prior to his testimony as a "Senior Development Chemist" (Hubbard, p.8), after leaving GenFlex. He never designed a pipe boot in his life (Hubbard, p.16):

"A I don't have much history at all in designing pipe boots."

Q So, you never designed a pipe boot?

A I've never designed a pipe boot."

His sole responsibility at AS Holdings was to "develop new products in adhesive and sealants and some plastics" (Hubbard,p.17). He stated he was not a structural engineer (Hubbard, p.18). Mr. Hubbard did not inspect or even see the two tools used to make the "Alpha Systems" pipe boots (Hubbard,p.20).

H. THE PRESENCE OF ADEQUATE COMPETITIVE ALTERNATIVES TO THE PORTALS PLUS PIPE BOOT

1. APPLICANT'S EXHIBIT 9 ALTERNATIVES

The most compelling fact supporting the presence of equally functional alternative pipe boots is the 25 year period prior to this Opposition, during which no competitor copied and marketed a pipe boot having the combination of five surfaces -- save this Opposer. That could be for two reasons: (a) a competitor's respect for the Portals Plus trade dress, or (b) a competitor's realization that the Portals Plus features were not functionally necessary in the marketplace. Or possibly a combination of the two.

Fig. 7 is Applicant's Exhibit 9, and is a sketch made by Applicant to illustrate several alternative designs. Many of the witnesses commented on these alternatives with Applicant's witnesses on one side and Opposer's witnesses on the other.

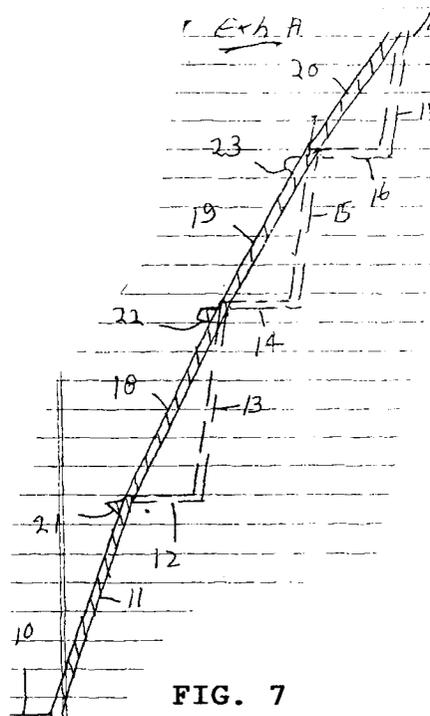
The sketch is intended to show the Firestone boot in dotted and full lines including frusto-conical wall 11, horizontal annular wall 12, frusto-conical wall 13, horizontal annular wall 14, frusto-conical wall 15, annular rib 23(offset), horizontal annular wall 16, and frusto-conical wall 17.

Applicant has suggested an alternative, where instead of the horizontal annular walls 12, 14, and 16, and the frusto-conical walls 13, 15, and 17 --- that these walls be replaced by frusto-conical walls 18, 19 and 20.

The stated purpose of the first alternative pipe boot is to eliminate two of the walls Applicant claims in the proprietary combination of five surfaces --- and replace those with a single

frusto-conical wall that reduces pipe boot material requirement (shortest distance between two points) without increasing overall pipe boot height.

While Opposer argues in its brief that Applicant's first alternative in Fig. 7 would increase the height and cost of the pipe boot -- those statements are incorrect simply by looking at Fig. 7, where the Firestone pipe boot and the first alternative end at the top of the page at exactly the same height. Opposer's Mr. Hubbard agreed and supported this conclusion (Hubbard, p.4).



"Q --- so that you can achieve the step configuration of the same height without increasing it up another foot?
A Mm-mm."

The principle objection Opposer has to Applicant's first alternative in Fig. 7, is that the frusto-conical surfaces 18, 19, and 20 allegedly would "pucker" under a clamp and leak, although Mr. Hubbard himself characterized his own opinion as a "guess" (Hubbard, p.42).

Mr. Devitt testified as he did above, that first alternative wall 18 (Applicant Exhibit 9) would not buckle because of its angle, since after the pipe boot is properly cut at a smaller diameter than the pipe, the upper portion of the boot is contiguous with the pipe and therefore a straight cylinder (Devitt, p.25):

"THE WITNESS (Mr. Devitt): Okay. In this example then I would be cutting it at approximately .22 on your sketch. And, once again, I would be stretching the rubber out so it's vertical against that wall. Therefore, no. There is no buckling because I have stretched the rubber."

Also depicted in Fig. 7(AE 9) are second and third applicant's proposed alternative pipe boots, one with a square or rectangular rib 22, or a triangular rib 21, all substituted for the semi-toroidal rib 11 in the Portals Plus design.

Opposer has not questioned the functional efficacy of the square rib or the triangular rib, but Mr. Hubbard "guesses" again that those profiles would be difficult to release from the mold. Please bear in mind that Mr. Hubbard has never designed a pipe boot or a mold.

Mr. Devitt, however, maintains these proposed rib shapes would not pose a problem coming out of the mold(Devitt,p.19,20).

"Q There's been some testimony in this case by a Mr. Hubbard, an employee of AS Holdings, that if you change the shape of the semi-toroidal rib to some other shape, that it would be difficult or impossible to get the pipe boot out of the mold.

A. No

No. To go to a rectangle or I think you said a pyramid, no. That would not create at(sic) problem because as we can see here this pipe boot is very flexible.

When it comes out of the tool, it's even more flexible because in the molding of these products, these are what is called compression molding. Now in the molding of these pipe boots a slug, if you will, essentially a hunk of rubber, when the tool is opened is placed into each cavity. The tool is lowered. Now the tool is steam heated. So that the tool is hot. It essentially melts the rubber. The rubber fills all the spaces in the tool and that heat also and the pressure of the tool also vulcanizes. Much like a tire. So it will always have this shape.

This is what we call cured EPDM as opposed to uncured. Uncured EPDM can be stretched and stretched and stretched until ultimately it will break. But it will never snap back because it's uncured. You can make it any shape you want.

This is cured. When you stretch this, it's much like a rubber band in analogy, in that it will snap back. I can stretch it and it will snap back.

Again, this is very warm because that tool is heated. It(sic) still relatively soft. So that when you take it out -- and, of course, this tape makes it more stiff but you can bend it. You can just pull it right out of those cuts in the tool.

So, no, the shape has little impact on whether you can get it out of the tool or not.

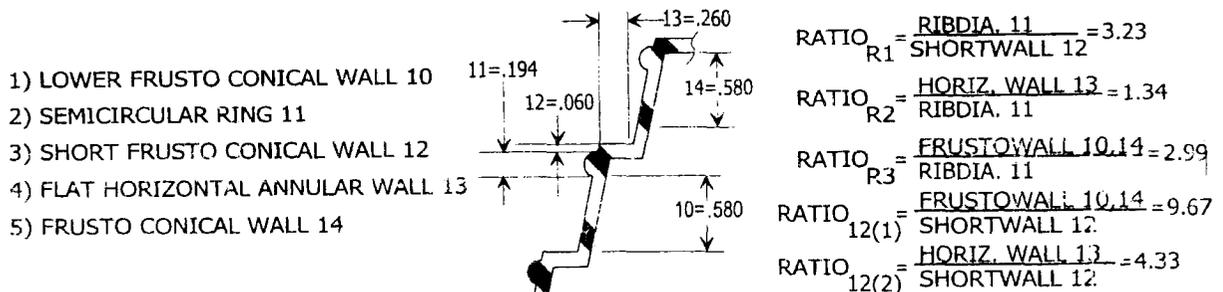
Q. Mr. Devitt, do you know what the durometer and elongation of this material is?

A. Yes. The pipe boots are purchased with a durometer -- and, of course, because every batch is slightly different in composition but the durometer is between 60 and 70 and the elongation is 300 to 350 percent."

2. APPLICANT'S OTHER ALTERNATIVES

It is not just the presence of the combination of the five surfaces that identify the distinctiveness of Applicant's pipe boot, but also the relative size and position of these surfaces. For example, the short wall 11 is only about 1/3 the diameter of the rib 11. The ratio of the height of frusto wall 10 to the diameter of rib 11 is about 3 to 1. And the ratio of the height of the frusto wall 10 to the height of the short wall 12 to about 9 1/2 to 1. As can be visualized, if these ratios are markedly changed, the appearance of the pipe boot would also be significantly changed -- yielding a fourth competitive alternative. At the same time, these significant ratio changes will not affect the marginal functions of these five surfaces.

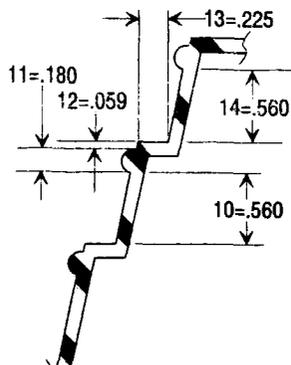
Fig. 8 is a drawing of the actual Firestone pipe boot (AE 4) already in the record, with measurements for the heights of the frusto walls 10, 14, the rib 11, short frusto wall 12, and horizontal wall 13, added from direct measurement from the physical exhibit. Opposer cannot complain about the addition of these measurements -- because they are what they are. Opposer is free to check these measurements against the actual physical exhibits.



Firestone Boot FIG. 8 from AE 4

What is important to note is the ratios of the five surfaces; namely, $R_1 = 3.23$, $R_2 = 1.34$, $R_3 = 2.99$, $R_{12(1)} = 9.67$, and $R_{12(a)} = 4.33$.

- 1) LOWER FRUSTO CONICAL WALL 10
- 2) SEMICIRCULAR RING 11
- 3) SHORT FRUSTO CONICAL WALL 12
- 4) FLAT HORIZONTAL ANNULAR WALL 13
- 5) FRUSTO CONICAL WALL 14



$$\begin{aligned} \text{RATIO}_{R1} &= \frac{\text{RIB DIA. 11}}{\text{SHORTWALL 12}} = 3.05 \\ \text{RATIO}_{R2} &= \frac{\text{HORIZ. WALL 13}}{\text{RIBDIA. 11}} = 1.25 \\ \text{RATIO}_{R3} &= \frac{\text{FRUSTOWALL 10,14}}{\text{RIBDIA. 11}} = 3.11 \\ \text{RATIO}_{12(1)} &= \frac{\text{FRUSTOWALL 10,14}}{\text{SHORTWALL 12}} = 9.50 \\ \text{RATIO}_{12(2)} &= \frac{\text{HORIZ. WALL 13}}{\text{SHORTWALL 12}} = 3.81 \end{aligned}$$

AS Boot FIG. 9 from AE 2

Fig. 9 is a similar drawing to Fig. 8, except it is a drawing of the AS Holdings (or Alpha Systems) pipe boot of Applicant's Exhibit 2, with dimensional heights measured in the same way. Note that while the actual measurements of the five surfaces in the Alpha Systems' boot are each slightly smaller than the corresponding Firestone boot dimensions --- these differences are most likely due to the fact that Maple Mold measured the Firestone pipe boot to make the tool, and parts made from such a tool would have a shrinkage factor depending upon the molding material used.

In any event, the resulting surface ratios are substantially the same as the Firestone pipe boot --- namely, in the Alpha Systems boot: $R_1 = 3.05$, $R_2 = 1.25$, $R_3 = 3.11$, $R_{12(1)} = 9.5$ and $R_{12(2)} = 3.81$.

Now, as noted above, if these ratios are markedly changed, the resulting pipe boot has an obvious appearance difference.

Fig. 10 is a sketch of an alternative pipe boot, with significantly different surface ratios than the Firestone pipe boot with surface ratios of $R_1 = .73$, $R_2 = .78$, $R_3 = 1.17$, $R_{12(1)} = .85$, and $R_{12(2)} = .57$.

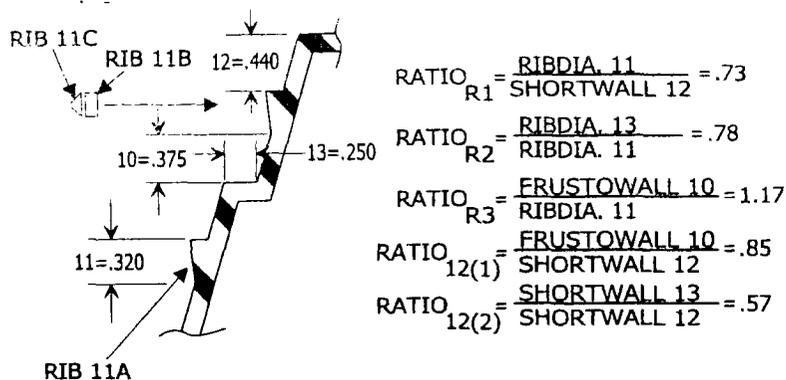


FIG. 10

Fig. 10 is not presented to the Board as evidence in this case, but is only a demonstrative Exhibit to aid in the visualization of modifying the surface ratios from those in the Portals Plus and Firestone pipe boot.

I. THE FACTS RELATIVE TO APPLICANT'S SUBMISSION OF A NEW DRAWING

The pipe boot as originally filed with the application contained the stepped frusto conical walls and the flat horizontal annular walls therebetween, but had no apparent semi-toroidal ribs.

On December 4, 2003, applicant submitted a substitute drawing including the semi-toroidal ribs -- some 14 months after the October 18, 2002 filing date.

The specimens filed with the original application were Portals Plus' original brochures clearly showing the semi-toroidal ribs.

Also filed with the original application was the engineering drawing dated April 25, 1982, attached as Exhibit L to the Ronald Resch affidavit -- and this drawing clearly shows the ribs 11 as well as the spatial relation of the ribs 11, the frusto conical surfaces 10, 14, and the short frusto walls 12.

The examiner never made an objection to the fact that the substituted drawings were modified, and he impliedly accepted them when he noticed the publication of the mark on December 5, 2007.

III. APPLICANT'S ARGUMENT

A. APPLICANT MOVES FOR AN ORDER STRIKING OPPOSER'S RADICAL NEW ISSUE

Applicant moves this Board to, or asks the Board to sua sponte, issue an Order barring Opposer's new issues of acquired distinctiveness.

The only Counts in Opposer's Notice of Opposition that use some form of the word distinctive are the following:

"COUNT I

70. The alleged mark of Applicant's Application is a functional configuration of the goods that is not distinctive, has not acquired secondary meaning or acquired distinctiveness, and does not operate as a trademark."

The new issues raised without warning, notice, or even inking and for the first time in Opposer's brief read as follows:

"2. Whether the mark for which registration is sought lacks distinctiveness and is therefore unregistrable." and "3." Whether Applicant has proven that the mark for which registration is sought has acquired secondary meaning or acquired distinctiveness under Section 2(f) of the Trademark Act."

Rule 15, above p. 13, requires "express or implied consent" to any new issues.

There is no doubt Opposer has intentionally broadened the functionality investigation to include distinctiveness of Applicant's mark totally aside from the functionality issue. Opposer spends dozens of pages in its Brief belittling the file history Affidavit of Portals Plus' then President, Ronald Resech, and belittling Applicant's failure to produce evidence at trial relating to the Section 2(f) issue -- but the bottom line is that Opposer presented absolutely no evidence at trial relating to the 2(f) question and did not even cross examine any of Plaintiff's witnesses on the question.

When Mr. Linn was asked by Applicant's counsel why he was asking Applicant's Vice President about sales, he answered "I don't know." There was simply no consent either actual, implied, or otherwise by Applicant, to the addition of this new issue.

When the Examiner accepted Applicant's Section 2(f) evidence of distinctiveness, the burden of proof shifts from the Applicant to the Opposer. Since Opposer has offered no evidence on the issue, it has not sustained that burden.

This Board considered a similar question under FRCP 15, in *Key West Fragrance v. The Mennen Company*, 216 USPQ 168, 169 (TTAB 1982), where the Respondent attempted to amend its answer under Rule 15 to add an unclean hands issue.

In denying the motion to amend, the Board held:

"The most important question to be resolved in deciding a motion under Rule 15(b) is whether the issues sought to be added were tried by express or implied consent and whether the non-moving party would be prejudiced by the amendment, i.e., whether he has a fair opportunity to defend against the issues.

Whether or not consent can be implied depends upon two things, i.e., (1) there was no objection to the introduction of evidence on the unpleaded issue, and (2) the non-objecting party was fairly apprised that the evidence went to the unpleaded issue. See: *Midland v. United States*, 9 FR Serv 2d. 15 b.1, Case 1; 338 F.2d 254 (CA 3 1964).

That is, merely offering one's interpretation of responses to questions involving collateral matters asked during cross-examination falls far short of 'trying' the issues. It is true that no objections were made as to the scope of the cross examination. However, it is abundantly clear from the questions asked on redirect (which had nothing whatever to do with these matters) that petitioner had no inkling of respondent's intention to raise these subjects as defenses to the petition, if indeed that had been respondent's plan at that time.

It is apparent from the foregoing that the affirmative defenses were neither expressly nor impliedly tried by the parties. Moreover, Rule 15(b) does not permit amendments to include collateral issues which may find some incidental support in the record. See: *Monod v. Futura, Inc.*, 13 FR Serv 2d 260, 415 F2d 1170 (10th Cir. 1969)."

In *Color Key Corporation v. Color 1 Associates, Inc.*, 219 USPQ 936,941(TTAB 1983), the Board followed *Key West* one year later denying a motion to add uncontrolled licensing as a new issue at 941:

"The relevant evidentiary development on this issue consists of a series of ten questions on cross-examination by opposer's counsel(Nicholson deposition, pp.61-65) in which inquiry was made as to the training and supervision received by applicant's licensee associates. We do not believe that the context or nature of such questions fairly put applicant on notice that a charge of naked licensing was being asserted.

This line of mild inquiry, without a pleaded claim, would hardly operate, we believe, to put applicant on notice that it needed to defend against a technical abandonment claim."

In this case, AS Holdings did nothing to apprise Portals Plus of its new acquired distinctiveness issue.

For the above reasons, Applicant asks this Court to strike the new issues in Opposer's Brief, and to strike all allegations and arguments in Opposer's Brief relating thereto.

B. OPPOSER HAS PATHETICALLY ATTEMPTED AND FAILED TO MEET ITS BURDEN OF PROOF ON THE ACQUIRED DISTINCTIVENESS ISSUE

Opposer's Brief spends more time criticizing Applicant's evidence of distinctiveness, than it does on what Applicant thought was the principal issue in this case -- functionality.

But the Opposer has made two legal quicksand errors in degrading Applicant's Section 2(f) evidence.

Opposer's first error is to assume that the Affidavit of Ronald Resch and its exhibits filed with the original application -- are not evidence at all -- and since Applicant introduced no additional evidence at trial -- then Opposer must necessarily prevail in defeating the distinctiveness of Applicant's mark.

This first error, both legally and philosophically, is underpinned upon weak case law that says file history evidence is not evidence in an interparty trial.

However, these cases have been reversed in toto in the *Cold War* case, *infra*.

The second major error of Opposer in attempting to argue a lack of distinctiveness, is its failure to assume its correctly shifted burden of proof in establishing a lack of distinctiveness.

It is axiomatic in established case law that most certainly was found by Opposer's counsel's vast legal research sources, that (1) when the examiner accepts the Applicant's evidence of Section 2(f) distinctiveness, then the Applicant has made a prima facie case of distinctiveness and (2) after that prima facie finding, the burden of proof on the issue of distinctiveness shifts to the Opposer.

Opposer has offered not one scintilla of evidence on the issue of the distinctiveness of Applicant's mark and therefore must fail in this argument.

The Federal Circuit had an opportunity in 2009 to review the issue of file history documents being evidence in an interparty trademark case in *The Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352,1359 (Fed.Cir.2009). The Board had relied on several cases cited by the Opposer on page 41 of its Brief to the effect that evidence submitted during the file history prosecution is not probative evidence in an interparty case in spite of the contrary dictates of 37 CFR 2.122(b). In overruling the *British Seagull* case and similar others of the Board, Circuit Judge Moore reversed saying at 1357:

"This statement conflicts with the plain language of the regulation. Indeed, the Board in *British Seagull* did not discuss the language of 37 CFR Section 2.122(b) at all; it cited instead to two other Board cases, neither of which discussed the regulatory language and neither of which was factually on point. Because *British Seagull* is contrary to the plain language of 37 CFR Section 2.122(b), we expressly overrule that decision to the extent it is inconsistent with our decision today.

In the case at hand, the Board acknowledged that the applicant had submitted evidence of acquired distinctiveness during prosecution. However, the Board decided that it could not consider this evidence because the Cold War Museum did not resubmit the evidence in the cancellation. This was error."

The *Cold War* decision is the law of this case as well.

The *Cold War* case also places the burden on the Opposer to establish distinctiveness where the examiner has accepted the Section 2(f) showing by Applicant(at 1358):

"Because Air Museum failed to even argue the issue of acquired distinctiveness in its petition for cancellation, it failed to rebut the registration's presumption of validity. Therefore, the Board erred as a matter of law in concluding that Air Museum(Petitioner) had established a prima facie case that the mark had not acquired distinctiveness.

Given Air Museum's failure to rebut the registration's presumption of validity, the Board also erred as a matter of law in shifting the 'burden' to the Cold War Museum(Registrant) to prove that the mark had acquired distinctiveness.

Initially, the party seeking cancellation also bears the 'burden to establish a prima facie case' that the registration is invalid.

To satisfy this initial burden, the party seeking cancellation must 'present sufficient evidence of argument on which the board could reasonable conclude' that the party has overcome the record evidence of acquired distinctiveness -- which includes everything submitted by the applicant during prosecution. (emphasis added)

Air Museum failed to present any evidence or argument of lack of distinctiveness, and therefore the Board erred in finding that any 'burden' was shifted to the Cold War Museum(Registrant)."

Quite clearly, here, the Opposer has totally failed to overcome the presumption of distinctiveness established by the record.

C. PORTALS PLUS' TRADEMARK MAY BE DE FACTO FUNCTIONAL BUT CERTAINLY NOT DE JURE

1. The 29 year old standard for determining physical trademark functionality is *In re Morton-Norwich Products, Inc.*, 213 USPQ 9(CCPA 1982).

The classic four criteria for determining whether a physical mark is de facto or de jure functional was fashioned by Judge Rich in the *Morton-Norwich* CCPA decision in 1982 as summarized as follows by the Federal Circuit in 2002 in *Valu Engineering Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422,1426 (Fed.Cir.2002) as follows at 1426:

"To determine whether a particular product design is de jure functional, we have applied the 'Morton-Norwich factors': (1) the existence of a utility patent disclosing the utilitarian advantages of the design; (2) advertising materials in which the originator of the design touts the design's utilitarian advantages; (3) the availability to competitors of functionally equivalent designs; and (4) facts indicating that the design results in a comparatively simple or cheap method of manufacturing the product. *Morton-Norwich*"

The physical article in *Morton-Norwich* was a plastic detergent bottle, Fig. 11, having a container portion for holding liquid detergent, a handle portion for user grasping, a rectangular housing cap portion with a simple straight pivotal trigger the user depresses to dispense detergent, and a single nozzle from which

the detergent is sprayed. There are no solely decorative features in the *Morton-Norwich* detergent bottle and yet the Court found it only de facto functional and not de jure functional.

The Opposer here repeatedly refers to Applicant's pipe boot as "entirely" functional. But that is not the *Morton-Norwich* test -- the test is instead an analysis of



FIG. 11

the four *Morton-Norwich* criteria -- which pass the present pipe boot as de facto functional and registerable.

2. AS HOLDINGS IS AN OPPORTUNIST AND JUST SHORT OF
A THIEF

AS Holdings is a large manufacturer of injection molded products. It is principally located in Elkhardt, Indiana on dozens of acres with many buildings housing giant injection molding machines, many several stories high and over 100 feet in length. Opposer is a privately held company, mostly owned by its President, David Smith, Jr., so its annual sales are not publicly available. But a financial business appraiser viewing its physical assets would certainly estimate its annual sales in the hundreds of millions of dollars.

What a surprise to learn that a company of that size has no engineering department, none. Not even one engineer anywhere on its vast staff -- only two chemists to select the appropriate molding materials to see that their products conform to the customer's specifications.

No engineering department and thus no adjunct draftsmen or drafting tables, no engineering instruments, no mechanics lab to test parts and prototypes. The funds not appropriated for research and development instead probably went home as bonuses for the executive-owners.

But with no engineering department how does AS Holdings design new products. It goes through the procedure it did with the Firestone pipe boot. It takes competitors' parts purchased in the marketplace and sends them to Maple Mold in Auburn, Hills, Michigan, for coping and then tooling made from the copied dimensions. This way AS Holdings doesn't have to hire an outside engineering consultant, doesn't need any engineering drawings, doesn't have to make and test prototypes that other companies this size routinely do. These are but some of the many ways AS Holdings saved money pirating competitors and Portals Plus products.

But why, aside from the vast cost savings, did the Opposer pirate the Portals Plus design. It didn't adopt the Portals Plus design for its functional features -- these were marginal. It copied the Portals Plus design because of the goodwill Portal Plus developed at great expense and 25 years of continuous sales. They copied Portals Plus design because it had a known and existing market for the pirated boot. Why take a chance on the industry burying, or not liking, a new design the Opposer might come up with?

Opposer has not, but should now explain why, with the exception of the Opposer, no competitor has copied the combination of Portals Plus' five surfaces. Possibly Opposer will try in its reply brief.

The Opposer had a myriad of options it could have adopted other than the Portals Plus design. Firstly, it could have chosen any of the pipe boot designs in the some 28 patents relied on in Opposer's Brief. No, that wouldn't work for AS Holdings because it would require the services of an outside engineering firm to make drawings and prototypes and prototype testing.

Opposer also could have adopted the step design in the expired Resech '463 patent, with its cylindrical sides and horizontal steps. But that would require outside engineering also.

And did the Opposer do a patent search to determine whether adopting the Portals Plus design would create any infringement problems. Apparently it did, and no doubt received an opinion there was no infringement problem, because it went ahead and gave Maple Mold a lot of money to make multiple cavity molds.

Opposer should have and apparently did not, conduct a trademark infringement search in the Opposer's 2007 tooling time frame, because if it did, it would have found the Portals Plus pending application, U.S. Serial No. 76/461,157. Poor research or just more cost savings?

And, if the Opposer had opted for an outside design firm, that firm may have designed one or more of the prior art or applicant's competitive alternatives shown in Figs. 7 and 10 above. But again, that would have hurt the AS Holdings cash flow.

3. OPPOSER FALSELY ASSERTS THE RESECH '423 PATENT
DISCLOSES AND CLAIMS THE PORTALS PLUS PIPE BOOT

Opposer's misguided errors in attempting to convince this Board that the Resech patent discloses or claims the combination of five surfaces is so obvious, Opposer's patent counsel should be embarrassed.

The Resech patent discloses a pipe boot with straight, not frusto-conical side surfaces. The Resech boot has no semi-toroidal ribs near the top, or anywhere, on its cylindrical side walls. The claims in the Resech patent are limited to a two-piece pipe boot with a rigid bottom section and a split clam-shelled top section.

How can a competent patent attorney, which Opposer's counsel certainly is, say that the Resech patent discloses and claims or covers the Portals Plus trademark pipe boot?

Note, that the Resech '423 patent issued on July 8, 1980, and the earliest engineering drawing of the Portals Plus pipe boot is April of 1982, suggesting they were independent designs.

Obviously, the Opposer's counsel is attempting to take this case into the ambit of the *TraFFix* case where the existence of a patent covering the two spring supports for an outdoor sign, and the successful infringement suit on that patent against a competitor, were critical in the Court's determination the *TraFFix* sign was de jure functional.

But that is not the case here and thus Applicant has successfully met its burden of satisfying the "patented" prong of the four *Morton-Norwich* criteria.

4. THE FUNCTIONAL FEATURES OF PORTALS' PLUS PIPE BOOT ARE DESIRABLE, BUT NOT COMPETITIVELY NECESSARY

The Portals Plus catalog functions beginning in the mid 90s and later with the clamp stop function, raise a time issue with respect to the derivation of the reinforcing, cutting guide and clamp stop features of the rib 11. The cutting guide and reinforcing functions of the rib 11 appeared for the first time in Portals Plus catalogs in the 1996 time frame and the clamp stop function at a later date. Portals Plus' original engineering drawing is dated April of 1982, and Portals Plus began marketing and selling their pipe boot almost immediately thereafter. Opposer's requests for production requested all advertising materials and other materials relating to the functions of the product --- but after investigation, Applicant could find no documents in the 1980s time frame to indicate any written function whatsoever attributable to the rib 11. This may suggest and support Applicant's testimony and contention that the attributes and function of the rib 11 may have been an after thought, for marketing purposes.

Applicant does not deny the rib 11 inherently has a reinforcing function because it is heavier than the adjacent frusto-conical wall. But the semi-toroidal shape of the rib does not contribute to its reinforcing function. The rib could be square or triangular and still perform exactly the same reinforcement.

And Applicant does not deny, that in some cases, the rib 11 acts as a cutting guide even though a poor one. Opposer's Mr. Hubbard testified that he cut the boot at a line between the inside of the horizontal wall 13 and the next frusto surface 14, if the size of the pipe dictated that diameter, to achieve a snug boot fit on the pipe. Mr. Steimle testified that the boot cut was made frequently below the rib, again if the pipe diameter dictated that diameter.

And most compelling is the durometer or hardness of the rib 11 is the same as the rest of the pipe boot, in the range of Shore A 50 to 60 -- making the rib as soft as a firm sponge or a flexible computer mouse pad. The testimony of both sides is that the rib could be easily misdirected into the rib by the installer instead of the upper edge of the rib. If an engineer were to design the rib as a good cutting guide, he would insert mold a rigid part in the rib.

Thus, the rib as a cutting guide is only marginally effective, and the primary purpose appears merely to add distinctiveness to Applicant's pipe boot. Thus rib 11 is de facto functional and not de jure.

Finally, the afterthought of rib 11 acting as a stop for the clamp. Firstly, there are many instances noted above where the clamp doesn't even go below rib 11. Further, Mr. Devitt, an expert in pipe boot installation training says the rib doesn't ever act as a stop as a practical matter, because the upper part of the boot, during installation, is stretched over the pipe so the clamping area on the boot, is perfectly cylindrical -- and not frusto-conical -- so there is no tendency for the clamp to ride vertically upwardly.

So while Applicant accedes to the catalog functions of the rib 11, these functions do not appear to be the primary functions of the rib, nor are they functional necessities to pipe boots in the marketplace. Thus, the rib 11 is de facto functional rather than de jure.

5. THERE IS A BEVY OF COMPETITIVE ALTERNATIVES AVAILABLE TO THE COMPETITION

The most compelling fact that there exist functionally adequate alternatives to the Portals Plus pipe boot, is that not one, none, of Portals Plus' competitors in Portal Plus' 25 years of manufacture and sale prior to the filing of the application,

has copied Applicant's distinctive five surface combination. Opposer does not qualify as a competitor because it has never made or sold a pipe boot.

The reticence of Portals Plus' competitors to use the five surface combination could also be due in part to their respect for the goodwill Portals Plus has developed over these years, in addition to the lack of functional necessity.

There are literally dozens of adequate and quality pipe boot designs the Opposer could have adopted.

The 28 patents cited in Opposer's Brief after a thorough search of the pipe boot art, all show pipe boot designs that are either expired or do not present infringement problems. Opposer cited these patents. Why doesn't the Opposer explain why each of these pipe boot designs would not be competitive in the industry?

Next, the claims in the Resech '423 patent have expired, so why aren't the pipe boot designs shown in that patent competitive alternatives? True, the side walls in the Resech boot are cylindrical rather than frusto-conical -- but what functional difference would that make? The total height of the Resech pipe boot would be no greater than the Portals Plus pipe boot simply by increasing the width of the horizontal annular flat surfaces.

Without acting as the Opposer's engineering department, which one can't be the missing department, Applicant has proposed and left open for Opposer's cross-examination at trial, four alternative designs that achieve all of the marginal functions of the Portals Plus pipe boot, but without adopting the distinctive five surface combination.

The first is depicted in Fig. 7 above where the horizontal annular surfaces and the adjacent frusto-conical surfaces are replaced by a single diagonal wall. This design drastically reduces the boot material requirement without increasing the height of the boot.

Mr. Hubbard says this design would cause the boot to wrinkle under the clamp. Mr. Hubbard never designed a rubber product -- did not even know what the hardness of the Firestone pipe boot was -- and admitted his theory was "just a guess".

Applicant's proposed other alternatives such as forming rib 11 with a square or triangular cross section. Mr. Devitt testified there would be no problem releasing these shapes from the mold not only because the material was very soft (Shore A, 50 to 60), but also because the pipe boot is hot and even softer as it is released from the mold.

And a further alternative is proposed by Applicant. The ratios of vertical heights of Applicant's five surfaces to one another contribute to the distinctiveness of Applicant's trademark and present still another option of modifying these ratios sufficiently to markedly change the appearance of the fourth alternative compared to the appearance of the Portals Plus trademark boot. By comparing Fig. 8, the dimensioned and ratioed pipe boot to the Fig. 10 sketch with altered ratios, one can visualize that the appearance of the boot can be changed without changing the shapes or angles of the surfaces, only the relative dimensions of the surfaces. Applicant wonders whether the Opposer ever considered this avenue.

Judge Rich's decision in the landmark CCPA case in *Morton-Norwich* is a beacon in this case for analyzing the functionality of Applicant's pipe boot. *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 USPQ 9 (CCPA 1982).

The Federal Court in 2002 summarized Judge Rich's four tests in *Valu Engineering Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422 (Fed.Cir.2002) as follows USPQ2d at 1426 (p.36 above) including (1) patent disclosure; (2) advertising; (3) alternative designs; and (4) simple method of manufacture.

But Judge Rich went way beyond those four criteria and approached the "essentialness" of the functions issue, which is relevant to this case, when he referred to the wholly functional design of the detergent container depicted in Fig. 11 above and at USPQ 1338,1339.

"This broad statement('a dish is a dish' by Gertrude Stein) of the 'law', that the design of an article 'having utility' cannot be a trademark, is incorrect and inconsistent with later pronouncements.(insert added)

No doubt, by definition, a dish always functions as a dish and has its utility, but it is the appearance of the dish which is important in a case such as this, as will become clear.

In the case at bar, for example, we cannot say that it means that the subject *design* is 'functional' merely because a hollow body, a handhold, and a pump sprayer are 'essential to its use'. What this phrase must mean is not that the generic parts of the article or package are essential, but, as noted above, that the particular *design* of the whole assembly of those parts must be essential."

These findings are wholly inconsistent with Opposer's belief that Applicant's mark is not registrable because it is "entirely" functional. That is nothing but a Gertrude Stein conclusion.

The Supreme Court in 2001 in the *TraFFix* case put a scare in the law of functionality when it ruled in some cases the existence of alternative designs is irrelevant when the mark is found to be de jure functional. *TraFFix Devices, Inc. v. Marketing Displays, Inc.*, 532 US 23, 58 USPQ2d 1001(2001). But the *TraFFix* Court alleviated those fears when the decision either on its face or by later determination limited its finding of de jure functionality to cases where patents disclosed and claimed the mark, and there were no competitive alternatives anyway.

The mark in that case was a dual spring design for supporting outdoor signs in high winds without falling over(See Fig. 11 from the Sarkisian, U.S. patents '696 and '482 owned by MDI). These patents contained very broad claims to just the two springs

and MDI successfully sued Winn-Proof on these patents. The infringement rationale in those applied to the *TraFFix* products alleged to infringe the MDI trademark at issue there.

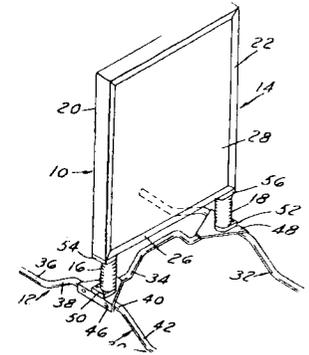


FIG. 12

The only competitive alternative was the same two spring design with a cover so one could not see the design, an alternative the *TraFFix* Court rejected.

The Court emphasized that the expired patent was critical in its decision at USPQ2d 1005 ---.

"The principal question in this case is the effect of an expired patent on a claim of trade dress infringement. A prior patent, we conclude, has vital significance in resolving the trade dress claim.

In light of this past ruling -- a ruling procured at MDI's own insistence -- it must be concluded the products here at issue would have been covered by the claims of the expired patents."

So the Court's holding at 1007:

"Because the dual-spring design is functional, it is unnecessary for competitors to explore designs to hide the springs, say by using a box or framework to cover them ---"

is obviously limited to covered patent situations -- not the case here.

The Federal Circuit, one year after *TraFFix*, analyzed its holding and found it did not modify *Morton-Norwich*, or the other prior case law on functionality. *Valu Engineering v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422,1427(Fed.Cir.2002). The Court noted at p.1427:

"But that does not mean that the availability of alternative designs cannot be a legitimate source of evidence to determine whether a feature is functional in the first place."

D. APPLICANT'S SUBMISSION OF A REVISED TRADEMARK DRAWING
WAS SUPPORTED BY OTHER ORIGINAL FILINGS

The draftsman that made the drawing filed with the application had an actual Portals Plus 13" pipe boot as a guide in preparing the drawing. Why he missed the rib 11, and why the attorney reviewing the filing documents did not catch the error no one knows.

But the error was discovered within a year after filing and Applicant filed a new drawing showing the ribs. Opposer is attempting to characterize Applicant's conduct as deceiving -- but why. The examiner accepted the revised drawings with the rib addition, and after other drawing objections accepted the final revised drawing filed on March 2, 2007.

It is difficult to determine why the Opposer is spending so many brief pages on this issue.

The Opposer is attempting to trump up a new matter analogy objection commonly found in patent prosecution, but trademark law has no counterpart to this counsel's knowledge, and Opposer cites no case law to support its position.

But even if this patent analogy had some validity, the Examiner had complete evidence of the rib configuration on the filing date of the application. Exhibit L(Fig. 3 above) attached to Resech's affidavit filed with the original application was a complete engineering drawing of the subject pipe boot and supported every feature shown in all of the revised drawings. Also, the brochures, also submitted with the original application, Exhibit N1-N9, each contain photos of Portals Plus' 13" pipe boot which is the subject of this trademark, clearly showing the ribs and their locations relative to the four other unique surfaces.

The Examiner accepted the revised drawings and that should finally end this matter.

Even if the revised drawings were somehow fatally defective, Applicant could have remedied the problem by filing a new application. Does the Opposer desire this result and the repetition of five years of prosecution and the repetition of this lengthy four year Opposition -- some nine years of delay?

That does not seem to be the correct resolution of this issue -- which is simply minutia and best discarded by the Board.

E. APPLICANT ASKS THE BOARD TO WITHDRAW ITS DECEMBER 20, 2010 DECISION EXCLUDING CERTAIN OF APPLICANT'S EXHIBITS

The Board, in its Decision of December 20, 2010, and its Reconsideration Decision of August 24, 2011, excluded from evidence Applicant's Exhibit 16, and portions of Exhibits 19 and 20. Only App. pgs. 23 and 25 were excluded from Exhibit 20 and only App. pgs. 26 and 33 to 36 were excluded from Exhibit 21. The Applicant's page numbers refer to pages in Applicant's Appendix to Applicant's Opposition to Opposer's Motion to Strike Exhibits and Testimony for Improper Disclosure and Failure to Disclose.

The Board excluded Exhibit 16 and portions of Exhibits 20 and 21, based on the belief those documents should have been produced by applicant in response to an Opposer's Request for Production that reads: "All documents and things referring or relating to third-party use of the Applicant's Mark." (Req. No. 21).

The Board's decision was based upon Mr. Pologeorgis' interpretation of "third party users" to include all of Portals Plus' customers for 25 years, rather than a more limited interpretation -- unauthorized third party users.

In any event, a production to this request, as interpreted by the Board attorney, would have required the production of all Portals Plus' sales invoices for 25 years -- some 100,000 documents.

In response to the Request for Production, Applicant produced several exemplary invoices with the objection: "Subject to classification under the Protective Order and the August 31, 2007 changes to 37 CFR 2.116(g), and the overbroad nature of the request, these documents will be produced." (emphasis added)

Opposer never complained about this incomplete production either informally or in a request for production.

Is that a sufficient reason to exclude Exhibits 16, 20, and 21 or parts thereof -- which were introduced not to show third party users of the mark -- but solely to show that the Firestone pipe boot in evidence was manufactured by Portals Plus and sold to Firestone.

Applicant asks the Board to revise its December 20, 2010 decision excluding these Applicant's exhibits, withdraw the decision, admit these exhibits into evidence -- and consider them at final hearing for what they are worth including the related trial testimony of Messrs. Steimle and Devitt.

IV. CONCLUSION

Applicant asks the Board to (a) strike the new issue of acquired distinctiveness raised by Opposer for the first time in its principle brief at final hearing; (b) find the Opposer guilty of flagrant misconduct by not making any effort to find competitive alternatives to pirating Portals Plus' pipe boot; (b) find the Portals Plus pipe boot at issue here merely de facto functional and not de jure functional and thus registerable; (d) deny Opposer's objections to Applicant's revised drawings; and (e) withdraw its decision of December 20, 2010 excluding certain Applicant's Exhibits -- and finally to deny this Opposition in its entirety.


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