

ESTTA Tracking number: **ESTTA274189**

Filing date: **03/25/2009**

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

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	Duramax Marine, LLC
Granted to Date of previous extension	04/11/2009
Address	17990 Great Lakes Parkway Hiram, OH 44234 UNITED STATES
Attorney information	D. Peter Hochberg D. Peter Hochberg Co., L.P.A. 1940 East 6th St. - 6th Floor Cleveland, OH 44114 UNITED STATES dphdocket@dpeterhochberg.com, smellino@dpeterhochberg.com Phone:216-771-3800

**Applicant Information**

Application No	77575106	Publication date	02/10/2009
Opposition Filing Date	03/25/2009	Opposition Period Ends	04/11/2009
Applicant	International Paper Company 6400 Poplar Avenue Memphis, TN 38197 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 016. First Use: 2006/01/01 First Use In Commerce: 2006/01/01  
All goods and services in the class are opposed, namely: paperboard packaging, namely, corrugated containers for shipping produce

**Grounds for Opposition**

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

**Mark Cited by Opposer as Basis for Opposition**

U.S. Registration No.	2352255	Application Date	05/15/1997
Registration Date	05/23/2000	Foreign Priority	NONE

		Date	
Word Mark	DURACOOLER		
Design Mark	<b>DURACOOLER</b>		
Description of Mark	NONE		
Goods/Services	Class 011. First use: First Use: 1999/06/01 First Use In Commerce: 1999/06/01 marine heat exchangers, namely, coolers for the engines and transmissions of ships and boats		

Attachments	75292161#TMSN.gif ( 1 page )( bytes ) DURACOOL pleadings.pdf ( 5 pages )(203119 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/D. Peter Hochberg/
Name	D. Peter Hochberg
Date	03/25/2009



many years been involved in the business of manufacturing and marketing bearings for industrial applications, such as rotating shaftings in pumps and down-hole drilling tools, industrial pumps, industrial applications, stators, hydroturbines, wicket gates and industrial rotating shaft apparatus, product lubricated bearings, and housings for bearings, and non-industrial applications, such as marine applications, including marine bearings, stave bearings, bushings, stern tube fillers, housings for bearings, cooling systems, such as keel coolers, sealing systems, including stuffing boxes, packing glands, shaft seal systems, stern castings, and fendering systems, including dock bumpers, tow knees, batterboard systems, wear pads, weatherstrip door gaskets, and marine heat exchangers, namely, coolers for the engines and transmissions of ships and boats.

2. Opposer has become widely known nationally and internationally as a marketer of bearings for industrial applications, such as rotating shaftings in pumps and down-hole drilling tools, industrial pumps, industrial applications, stators, hydroturbines, wicket gates and industrial rotating shaft apparatus, product lubricated bearings, and housings for bearings, and non-industrial applications, such as marine applications, including marine bearings, stave bearings, bushings, stern tube fillers, housings for bearings, cooling systems, such as keel coolers, sealing systems, including stuffing boxes, packing glands, shaft seal systems, stern castings, and fendering systems, including dock bumpers, tow knees, batterboard systems, wear pads, weatherstrip door gaskets, and marine heat exchangers, namely, coolers for the engines and transmissions of ships and boats, those goods having good quality, and Opposer has acquired a favorable reputation throughout large segments of the aforementioned industrial and non-industrial fields for its above-described goods sold and provided under, and in association with

the mark DURACOOLER (the "DURAMAX" mark).

3. Opposer is the owner of U.S. trademark Registration No. 2,352,255 registered May 23, 2000 for the mark "DURACOOLER" in International Class 11 as used in association with the goods of "marine heat exchangers, namely, coolers for the engines and transmissions of ships and boats." The registration was based on an application filed in the U.S. Patent and Trademark Office on May 15, 1997. The mark has been in use for the goods in International Class 11 since at least as early as June 1, 1999, and has been in use in commerce for the goods in International Class 11 since at least as early as June 1, 1999, both of which are dates prior to the filing date of Applicant's application and Applicant's alleged date of first use of its mark. Said trademark and registration therefor are valid and subsisting, and Opposer owns the DURACOOLER mark, the registration, and the goodwill of the business associated with such mark. Registration No. 2,352,255 for the mark "DURACOOLER" has a registration date which precedes the filing date of the Applicant's application and Applicant's alleged date of first use of its mark set forth in its application.

4. Notwithstanding Opposer's prior rights in and to said marks, Applicant, on September 21, 2008, filed an application for registration of the trademark "DURACOOL" in International Class 16 for "paperboard packaging, namely, corrugated containers for shipping produce." Said application was given Serial No. 77/575,106 and the mark was published for Opposition in the *Official Gazette* on February 10, 2009 at page TM 655, International Class 16 and is an application based on use in commerce alleging a date of first use of January 1, 2006 and a date of first use in commerce of January 1, 2006.

5. The goods for which Applicant seeks to register its "DURACOOL" term are

identical to, substantially similar to, of the same general type of or could be used in connection with the goods sold in connection with the goods of Opposer under its "DURACOOOL" mark.

6. Since prior to January 1, 2006, the alleged date of first use and the alleged date of first use in commerce of the Applicant's mark set forth in the Applicant's application, Opposer has become extensively associated with sales of marine heat exchangers, namely, coolers for the engines and transmissions of ships and boats. The aforementioned applications of the Opposer could reasonably employ the use of "paperboard packaging" for the transport of said goods of the Opposer's or for accessories and/or parts therefor. Opposer's customers include purchasers of goods for industrial and non-industrial applications and are likely to include the same people before whom Applicant is using or intending to use the alleged "DURACOOOL" trademark. Applicant's customers or prospective customers are very possibly customers of Opposer, and would unwittingly believe that Opposer was directly or indirectly involved with the goods provided by Applicant. Users of Opposer's products are likely to believe, to be confused or deceived into thinking that Applicant's goods originate with, or in some way are associated with, connected with, sponsored, endorsed or authorized by Opposer. By reason of the identical identity, appearance and sound, or the nearly identical identity, appearance and sound, of Applicant's alleged mark "DURACOOOL" and Opposer's "DURACOOOLER" mark and the likely overlapping of the class of customers and channels of trade, Applicant's alleged mark, when applied to its goods is likely to cause confusion or mistake, or to deceive, all to the injury or threatened injury of Opposer.

7. Opposer has developed an exceedingly valuable amount of goodwill with respect to the "DURACOOOLER" mark. By virtue of its efforts, and the expenditure of considerable

sums of promotional activities and by virtue of the excellence of its products, Opposer has gained for its "DURACOOLER" mark a most valuable reputation.

8. If Applicant is permitted to register "DURACOOL" as specified in the application herein opposed, confusion in the trade resulting in damage and injury to Opposer would be caused and would result by reason of the perception of a relationship between goods bearing the alleged mark and name "DURACOOL" of Applicant and Opposer's goods bearing the "DURACOOLER" mark. In this respect, consumers may have the impression that the goods of Opposer bearing the "DURACOOLER" mark and the goods of the Applicant having the alleged "DURACOOL" mark are being marketed, endorsed, approved or sponsored by Opposer. Persons familiar with the "DURACOOLER" mark of Opposer would likely buy Applicant's goods as goods marketed, endorsed, approved or sponsored by Opposer. Any such confusion in the trade inevitably would result in dilution of the goodwill created by Opposer. Furthermore, any defect, objection or fault found with Applicant's goods marketed under the alleged "DURACOOL" mark would unnecessarily reflect upon and seriously injure the reputation which Opposer has established with respect to its goods and services associated with its "DURACOOLER" mark.

9. Based upon the foregoing, the registration of the mark depicted in Application Serial No. 77/575,106 filed on September 21, 2008 on the Principal Register of the United States Patent and Trademark Office would cause injury and damage to Opposer.

WHEREFORE, Opposer requests that registration of Applicant's alleged mark "DURACOOL," Application Serial No. 77/575,106, in International Class 16, be denied and this opposition be sustained.