

ESTTA Tracking number: **ESTTA342208**

Filing date: **04/13/2010**

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 parties oppose registration of the indicated application.

Opposers Information

Name	Sutherlands West Texas, Inc.
Granted to Date of previous extension	04/14/2010
Address	5000 W 95th Street Suite 250 Overland Park, KS 66207 UNITED STATES

Name	Sutherland Centennial Lumber Co. LLC
Granted to Date of previous extension	04/14/2010
Address	5000 W 95th Street Suite 250 Overland Park, KS 66207 UNITED STATES

Name	Sutherland Building Materials Centers LP
Granted to Date of previous extension	04/14/2010
Address	5000 W 95th Street Suite 250 Overland Park, KS 66207 UNITED STATES

Attorney information	Sean T. Bradley ERICKSON, KERNELL, DERUSSEAU & KLEYPAS, LLC 800 W. 47th Street, Suite 401 Kansas City, MO 64112 UNITED STATES sbradley@kcpatentlaw.com Phone:816-753-6777
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Applicant Information

Application No	77784368	Publication date	12/15/2009
Opposition Filing Date	04/13/2010	Opposition Period Ends	04/14/2010
Applicant	Cimarron Lumber and Supply Company 4000 Main St. Kansas City, MO 64111 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 1936/12/31 First Use In Commerce: 1936/12/31 All goods and services in the class are opposed, namely: Retail lumber, building supply and home improvement store services

Grounds for Opposition

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Other	The application was not made by the owner of the mark as required under Trademark Act section 1 (15 USC 1051).

Attachments	632_003_Notice_of_Opposition.pdf (6 pages)(21535 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	/Sean T. Bradley/
Name	Sean T. Bradley
Date	04/13/2010

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

SUTHERLAND CENTENNIAL LUMBER)	
CO. LLC, SUTHERLAND BUILDING)	Opposition No. _____
MATERIALS CENTERS, LP, and)	Mark: SUTHERLAND LUMBER
SUTHERLANDS WEST TEXAS, INC.)	COMPANY
)	Filing Date: July 19, 2009
Opposers,)	Serial No.: 77784368
)	Publication Date: December 15, 2009
v.)	
)	
CIMARRON LUMBER AND SUPPLY)	
COMPANY)	
)	
_____ Applicant.)	

NOTICE OF OPPOSITION

Sutherland Centennial Lumber Co. LLC, a limited liability company organized and existing under the laws of the State of Missouri; Sutherland Building Materials Centers, LP, a limited partnership organized and existing under the laws of the State of Texas; and Sutherlands West Texas, Inc., a corporation organized and existing under the laws of the State of Texas, all with offices at 5000 W 95th Street, Suite 250, Overland Park, Kansas 66207 (collectively “Opposers”), believe that they will be damaged by registration of the service mark shown in U.S. Application Serial No. 77784336, published for opposition in the Official Gazette on December 15, 2009, and hereby oppose registration of the same.

As grounds for the opposition, it is respectfully alleged that:

1. Opposers Sutherland Centennial Lumber Company, LLC, Sutherland Building Materials Centers, LP and Sutherlands West Texas, Inc., and their predecessors, are part of a family of companies originally founded over 80 years ago by one Robert Sutherland.
2. Since the original founding of the Sutherland family of companies these

companies have operated lumber yards throughout the United States under the trade names “Sutherland Lumber Company”, “Sutherlands” or close variations thereof and have provided goods and services under the SUTHERLANDS and SUTHERLAND LUMBER COMPANY marks in a cooperative endeavor.

3. The various lumber yards referred to above are operated by various descendants of Robert Sutherland, including principals of both the Opposers and Applicant.

4. Until recently, Applicant provided certain services to Opposers including, but not limited to, wholesale purchasing and distribution of lumber and building supplies, certain tax, accounting, administrative and IT services, inventory calculation services and management and related services (hereinafter referred to as the “Management Services”).

5. Opposer Sutherland Centennial Lumber Company, LLC operates one lumber yard in Moberly, Missouri under the trade names “Sutherland Lumber Company” and “Sutherlands”, which provides goods and services under the marks SUTHERLANDS and SUTHERLAND LUMBER COMPANY .

6. Opposer Sutherland Centennial Lumber Company, LLC enjoys substantial goodwill and a good reputation in connection with the marks SUTHERLANDS and SUTHERLAND LUMBER COMPANY and claims ownership in said marks.

7. Opposer Sutherland Building Materials Centers, LP operates various lumber yards in Benbrook, Texas; Alexandria, Louisiana and Nevada, Missouri under the trade names “Sutherland Lumber Company” and “Sutherlands”, which provide goods and services under the marks SUTHERLANDS and SUTHERLAND LUMBER COMPANY.

8. Opposer Sutherland Building Materials Centers, LP enjoys substantial goodwill and a good reputation in connection with the marks SUTHERLANDS and

SUTHERLAND LUMBER COMPANY and claims ownership in said marks.

9. Opposer Sutherlands West Texas, Inc. operates various lumber yards in Amarillo, Texas and Lubbock, Texas under the trade name “Sutherland Lumber Company” and “Sutherlands”, which provide goods and services under the marks SUTHERLANDS and SUTHERLAND LUMBER COMPANY.

10. Opposer Sutherlands West Texas, Inc. enjoys substantial goodwill and a good reputation in connection with the marks SUTHERLANDS and SUTHERLAND LUMBER COMPANY and claims ownership in said marks.

11. Opposers have a co-ownership interest in the marks SUTHERLANDS and SUTHERLAND LUMBER COMPANY.

12. The goodwill and good reputation enjoyed by the Opposers will be jeopardized by registration of the mark SUTHERLAND LUMBER COMPANY by Applicant.

13. Upon information and belief, Applicant knowingly failed to disclose the true and complete ownership of the mark SUTHERLAND LUMBER COMPANY as required under the Trademark Act § 1(a).

14. As a fiduciary of Opposers, Applicant had a duty to protect Opposers’ ownership interests in the marks SUTHERLANDS and SUTHERLAND LUMBER COMPANY and to include Opposers as owners/applicants in the present application.

15. Upon information and belief, the Applicant has not provided the services specified in the application under the mark SUTHERLAND LUMBER COMPANY.

16. Upon information and belief, the Applicant does not control the nature and quality of the services specified in the application under the mark SUTHERLAND LUMBER COMPANY, nor the use of the mark itself.

17. Due to the defect in ownership present in the application, registration of the mark SUTHERLAND LUMBER COMPANY by Applicant will likely cause the public to be confused, deceived and mistaken.

WHEREFORE, Opposers believe that they will be damaged by registration of the mark SUTHERLAND LUMBER COMPANY by Applicant and request that the consolidated opposition be sustained and said registration be denied.

Opposers Sutherland Centennial Lumber Company, LLC, Sutherland Building Materials Centers, LP and Sutherlands West Texas, Inc., hereby appoint the following attorneys at Erickson, Kernell, Derousseau & Kleypas, LLC, with full power of substitution and revocation, to prosecute this Opposition and to transact all business in the Patent and Trademark Office connected therewith: Sean T. Bradley, Kent R. Erickson, Dan Chase, James J. Kernell, Ginnie Derousseau, Mark L. Kleypas, Michael Yakimo, Jr. and Tamatane Aga.

Please direct all communications in conjunction with this matter to the following attorney for Opposer:

Sean T. Bradley
Erickson, Kernell, Derousseau & Kleypas, LLC
800 West 47th Street, Suite 401
Kansas City, Missouri 64112
Phone: (816) 753-6777
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The statutory filing fee of \$900.00 for this consolidated Notice of Opposition is submitted herewith. The Commissioner is hereby authorized to charge any additional amount required, or credit any overpayment to Deposit Account No. 50-2790.

Respectfully submitted,

/Sean T. Bradley/
Sean T. Bradley, Reg. No. 46,572

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Attorneys for Opposers
Sutherland Centennial Lumber Company, LLC
Sutherland Building Materials Centers, LP
Sutherlands West Texas, Inc.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Notice of Opposition has been served upon the Applicant by mailing a copy of same by U.S. First Class Mail, postage prepaid, to Applicant Attorney of Record and Correspondent Lawrence A. Swain, Polsinelli Shughart PC, 6201 College Blvd., Suite 500, Overland Park, KS 66211-2435, and to Applicant Cimarron Lumber and Supply Company, 4000 Main Street, Kansas City, Missouri 64111 this 13th day of April, 2010.

/Sean T. Bradley/
Sean T. Bradley, Reg. No. 46,572