

ESTTA Tracking number: **ESTTA675964**

Filing date: **06/03/2015**

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	Lumite, Inc.
Granted to Date of previous extension	06/03/2015
Address	1515 North County Line Road Alto, GA 30510 UNITED STATES
Correspondence information	Jacquelyne Regan Attorney Gardner Groff Greenwald & Villanueva, PC 2018 Powers Ferry Road, Suite 800 Atlanta, GA 30339 UNITED STATES litigation@gardnergroff.com Phone:770-984-2300

Applicant Information

Application No	86057945	Publication date	02/03/2015
Opposition Filing Date	06/03/2015	Opposition Period Ends	06/03/2015
Applicant	Nicolon Corporation 365 South Holland Drive Pendergrass, GA 30567 UNITED STATES		

Goods/Services Affected by Opposition

Class 019. First Use: 2010/03/30 First Use In Commerce: 2010/05/20 All goods and services in the class are opposed, namely: Geosynthetics, namely, geotextiles for the purposes of drainage, stabilizing inclines, recultivation, plant support, absorption, filtration, separation, stabilization and reinforcement of the soil; geotextiles for use in connection with road construction, tunnel construction, waterway construction and public works construction; fabrics for use in civil engineering; erosion control fabric

Grounds for Opposition

The mark is merely descriptive	Trademark Act section 2(e)(1)
The mark comprises matter that, as a whole, is functional	Trademark Act section 2(e)(5)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

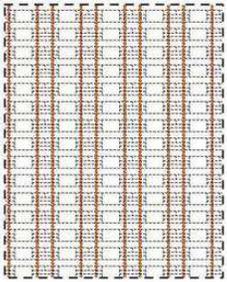
Attachments	Notice of Opposition to Nicolon '945 Application.pdf(306348 bytes)
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Certificate of Service

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	/Jacquelynn Regan/
Name	Jacquelynn Regan
Date	06/03/2015

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

LUMITE, INC.,)
)
 Opposer,) Opposition No. _____
) Application Serial No. 86/057,945
v.) Filing Date: September 6, 2013
) Publication Date: February 3, 2015
NICOLON CORPORATION,) Mark: 
)
)
 Applicant.)
_____)

NOTICE OF OPPOSITION

LUMITE, INC. (“Opposer”), a corporation duly organized and existing under the laws of Georgia, with a principal place of business at 1515 N. County Line Road, Alto, Georgia 30510, believes that it will be damaged by the issuance of registration in Class 19 for the design mark underlying Application Serial No. 86/057,945 filed by Nicolon Corporation (“Applicant”), a corporation organized and existing under the laws of Georgia, with a mailing address of 365 S. Holland Drive, Pendergrass, Georgia 30567, and hereby opposes registration of the mark.

As grounds for its opposition, Opposer, by and through its attorneys, alleges as follows:

1. Opposer, a competitor of Applicant, is the manufacturer of Lumite Performance Products, a widely-recognized line of innovative geosynthetic textiles that grew out of the original Lumite® synthetic mosquito netting first created by an engineer with Johnson & Johnson for the U.S. Armed Forces in 1943. Lumite Performance Products expanded into horticultural and agricultural products after the Korean War, and in recent years, added a range of fabrics that consistently provide barriers that suppress sun, heat, wind, erosion and intrusion of unwanted elements.

2. Geosynthetics, such as those produced by Opposer, are found in freeways, airports, retaining structures, reservoirs, along canals, dams, slope protection, and numerous coastal engineering configurations. These fabrics are used to armor levees and sand dunes to protect upland coastal area from storm surges. When placed in sloped steps, the geosynthetics reduce scour and help prevent shore erosion. Geo-material is used as matting to stabilize channel flows and also allow planting on steep slopes further securing anti-erosion measures.

3. Since 2004, Opposer has sold geotextiles in competition with Applicant. Opposer has previously sold geotextile fabric incorporating the color orange since at least as early as 2009, and intends to sell orange-colored geotextile fabric again in the near future. Opposer manufactures and sells custom geotextile fabrics that incorporate threads of a high-contrast color, such as orange, to customers who request the geotextile incorporate an eye-catching color to aid in the visibility of the geotextile after installation.

4. The color orange is widely used in a range of construction, horticultural and agricultural products, as it has high visibility and contrasts with the browns, greens and blacks of the natural landscape in which such products are typically used.

5. The color orange is commonly used for high-visibility applications, such as hunting vests and traffic cones.

6. The color orange is used in roadwork construction as a warning color.

7. Commonly-observed examples of use of the color orange on construction sites include orange geotextile safety fencing and orange geotextile silt fencing for erosion prevention.

8. Due to its widely-recognized use in construction, horticultural and agricultural applications, the color orange is a natural choice for customers who seek a contrasting color to be interwoven into geotextile materials for such applications.

9. Light visible to the human eye falls within a wavelength range of about 400-700 nanometers (nm).

10. Orange light has a wavelength of about 590 nm.

11. The color orange contrasts visibly with dark soils.

12. Use of the color orange as applied to geosynthetic materials used in construction works is often functional.

13. The functionality of the color orange in construction settings stems from its high visibility. The orange color in such geotextiles serves as a visual cue to those encountering them.

14. The color orange has been used in geotextiles to create a “high visibility signal barrier for future excavations[.]” *See* Feb. 20, 2014 Office Action at 2 and webpage cited (<http://www.sigmahellas.gr/index.php?lang=2&thecatid=4&thesubcatid=428&thesubsubcatid=434>).

15. The use of the color orange in geotextiles to create a high-visibility signal barrier is functional.

16. Opposer has received and fulfilled orders for such orange-colored geotextiles, including orders for orange-colored woven monofilament fabric in 2009 for its customer, Dandy Products, Inc., a Delaware corporation (“Dandy”).

17. Opposer’s use of orange for geotextiles, even in 2009, was not the first of its kind, as other manufacturers of woven and non-woven geotextiles have regularly provided orange-colored geosynthetic materials for use in construction, agricultural and horticultural applications for more than a decade.

18. Notwithstanding the prior use of Opposer and other manufacturers in the industry, on September 6, 2013, Applicant filed Application Serial No. 86/057,945 (“the ‘945

Application”) to register the color orange as applied to woven geosynthetic material used in construction works, as follows:

Alleged Mark:	
Serial No.:	86/057,945
Mark Drawing Type:	2 – An illustration drawing without any words(s)/letter(s)
Description of the Mark:	The mark consists of the color orange as applied to one or more yarns or threads woven into the body of geosynthetic or geotextile fabric of indefinite length and width producing a radiant orange surface when light strikes the fabric and the matter shown in broken lines is not part of the mark and serves only to show the position or placement of the mark.
Color Drawing:	Yes
Color(s) Claimed	The color(s) orange is/are claimed as a feature of the mark.
Goods and Services:	Geosynthetics, namely, geotextiles for the purposes of drainage, stabilizing inclines, recultivation, plant support, absorption, filtration, separation, stabilization and reinforcement of the soil; geotextiles for use with road construction, tunnel construction, waterway construction and public works construction; fabrics for use in civil engineering; erosion control fabric
Filed:	September 6, 2013
Filing Basis:	1(a) use as early as March 30, 2010 and use in commerce as early as May 20, 2010
Alleged Distinctiveness:	2(f) acquired distinctiveness based on use in commerce as early as May 2010

19. Applicant claims that its first use of the mark “as March 30, 2010 and use in commerce as early as May 20, 2010” – a full year after Opposer commercially used the color orange for the very same type of goods claimed by Applicant.

20. The '945 Application takes into account the high visibility of the color orange, stating that: "The mark consists of the color orange as applied to one or more yarns or threads woven into the body of geosynthetic or geotextile fabric ... producing a radiant orange surface when light strikes the fabric[.]"

21. Applicant is a wholly-owned subsidiary of Royal Ten Cate (USA) Inc., a Delaware corporation ("Ten Cate").

22. Applicant manufactures, markets and sells a variety of geotextile products under the brand name Mirafi®.

23. The website of Ten Cate (www.tencate.com) describes Applicant's Mirafi® geotextiles as follows: "The use of this orange delineation fabric allows for safe excavations where utilities or other sensitive structures may be buried. The highly visible orange nonwoven geotextile serves as a warning to construction workers when the excavation reaches a buried structure."

24. The Ten Cate Website further describes Applicant's Mirafi® geotextiles as follows: "TenCate Mirafi® Delineation Nonwoven Geotextiles specifically designed for visual barrier, soil separation and drainage."

25. In marketing materials, Applicant and/or its parent company Ten Cate claims that "the color ORANGE used in connection with geosynthetic or textile products are registered and/or unregistered trademarks of Nicolon Corporation."

26. Opposer is timely filing this Notice of Opposition, as Opposer filed for and was granted an extension of time to oppose the '945 Application to June 3, 2015.

27. Applicant first filed the '945 Application on September 6, 2013. In an Office Action dated February 20, 2014, the Examiner refused registration on the basis that "[c]olor

marks are never inherently distinctive and can only be registered on the Supplemental Register or on the Principal Register with sufficient proof of acquired distinctiveness.” The Examiner went on to explain why it was improper to claim exclusive use of the color orange in geotextiles:

The applied-for mark fails to function as a trademark because **it consists solely of a color used on the goods**. Purchasers do not perceive color, including Applicant’s color orange, as identifying a source or origin for goods, but rather as a feature of the goods. **See attached excerpted webpages . . . showing the color orange, among other available colors, specifically used on geotextiles for its high visibility in construction and environmental settings**. Therefore, because the mark consists solely of a color applied to the goods, **the mark is not inherently distinctive** and registration is refused pursuant to Sections 1, 2 and 45 of the Trademark Act.

February 20, 2014 Office Action at 2.

28. The ‘945 Application claims use of orange threads to produce “a radiant orange surface when light strikes the fabric[.]”

29. It is clear from the prosecution history and initial application that Applicant filed the ‘945 Application in an attempt to claim exclusive use of the color orange in geotextiles for its “high visibility in construction and environmental settings”.

30. Applicant’s true motivation for claiming exclusive use of the color orange in geotextiles is apparent from the Ten Cate Website, which touts the high visibility of the color orange in geotextiles: “The highly visible orange nonwoven geotextile serves as a warning to construction workers when the excavation reaches a buried structure.”

31. Nevertheless, in its August 20, 2014 Response to Office Action, Applicant claimed that “**Applicant’s Fabric does not serve as a warning to construction workers when the excavation reaches a buried or utility structure.**” Aug. 20, 2014 Response to Office Action at 3 (underlined emphasis in the original; bolded emphasis added).

32. Recognizing that its original motivations were insufficient to justify its claim to exclusive use of the color orange in geotextiles, Applicant responded to the Office Action and claimed a facial reason for its use of the color orange: “Applicant has used the color orange deeply rooted in its corporate history, identity, and branding.” *See* Aug. 20, 2014 Response to Office Action at 3. Applicant suggested that its use of the color orange stems from the historical use of orange as symbolic for the Netherlands. *Id.* Based on that purported reason for “claiming” the color orange, Applicant then argued that its proposed “Mark has acquired distinctiveness as a source identifier under Section 2(f) of the Trademark Act.” *Id.*

33. Although Applicant argued in the prosecution history that the color orange serves as a source identifier for its woven geosynthetic fabric, Applicant actually sells woven geosynthetic fabric in colors other than orange.

34. Applicant sells geosynthetic fabric that is black in color (with no contrasting interwoven threads).

35. Applicant sells woven geosynthetic fabric that features blue threads woven into the body of the geosynthetic fabric.

36. Applicant further argued in its August 20, 2014 Response to Office Action that “Applicant’s Mark is not functional.” *Id.* That conclusion appears to be based on Applicant’s position that its use of the color “orange is no more economical with respect to the manufacture of Applicant’s Fabric, and [therefore] provides no competitive advantage to applicant.”

37. In drawing its conclusion that “Applicant’s Mark is not functional,” Applicant willfully ignores the fact that the functionality of its claimed mark stems not from any cost advantage in manufacturing geotextiles, but rather, from the color’s high contrast, visibility and use as a visual cue to those encountering it in construction applications.

38. Applicant's claim of distinctiveness as a source identifier is misplaced and fails to overcome the fact that Applicant's use of the color orange in geotextiles is functional.

39. Even if Applicant's purported reason for choosing the color orange was somehow linked to its claimed historical roots in the Netherlands, that reason does not change the fact that the color orange, *as used in Applicant's products*, is wholly functional.

40. Applicant's trademark application makes claim to the entire orange spectrum, as its description of the mark provides that "[t]he color(s) orange is/are claimed as a feature of the mark." *See* the '945 Application.

41. Applicant fails to specify a particular pantone number or to otherwise restrict its application to a particular shade of orange. As a result, Applicant's proposed mark spans the entire spectrum of the color orange.

42. Contrary to Applicant's statements to the U.S. Patent and Trademark Office ("USPTO"), Orange-colored geotextiles have not become inherently distinctive or associated with Applicant's goods in commerce.

43. Even if the color orange has become inherently distinctive and associated with Applicant and/or Ten Cate, which Opposer disputes, application for the color orange "*as applied to one or more yarns or threads woven into the body of geosynthetic or geotextile fabric*" is wholly improper, given the functionality of the color orange as used in such geotextiles.

44. The use of the color orange for geotextiles serves a functional purpose.

45. Moreover, other companies have sold geotextile products incorporating the color orange before Applicant's claimed first use date.

46. The color orange is currently and has previously been used in woven geosynthetic fabrics for its functionality: that is, to serve as an "orange warning barrier" and "to be clearly

seen as a contamination warning layer” thereby assuring “that adequate warning is put into place to protect anyone carrying out future excavations.” See February 20, 2014 Office Action at 2 and attached excerpted webpages referenced therein (<http://www.usfabricsinc.com/products/orange-warning-barrier-contamination-barrier>; <http://www.sigmahellas.gr/index.php?lang=2&thecatid=4&thesubcatid=428&thesubsubcatid=434>).

47. Applicant knew at the time it filed the ‘945 Application that use of the orange color in geotextiles served a functional purpose, and that the color orange in geotextiles is non-distinctive, both because the relevant market does not view the color orange as an indication of source and because Applicant uses the color orange to serve as a visual cue to those encountering it in construction settings.

48. At the time Applicant filed the ‘945 Application, it was fully aware that it was using the same or a similar orange color in geotextiles and in the same manner as its competitors. Nevertheless, Applicant knowingly made material misrepresentations with the intent to deceive the USPTO during the prosecution of its Application, and in particular, in its August 20, 2014 Response to Office Action.

49. The examining attorney relied upon Applicant’s misrepresentations in determining that Applicant’s proposed mark “appears to be entitled to registration.”

50. The examining attorney relied upon Applicant’s misrepresentations in approving Applicant’s proposed mark for publication in the *Official Gazette*.

51. Applicant knowingly misrepresented to USPTO that “Applicant is the first, and has been since as early as May 2010, the only user of the color orange for woven textiles/geosynthetic fabrics for, among other things, for base course reinforcement and subgrade stabilization for road, runway and railway construction; embankment stabilizations on soft

foundations; reinforcement for mechanically stabilized earth structures; and liner support.” *See* Aug. 20, 2014 Response to Office Action at 3.

52. Applicant knowingly misrepresented to USPTO that “the high visibility created by the light striking the orange threads has ‘nothing to do with the performance’ of the fabric when used as a base course reinforcement and subgrade stabilization for road, runway and railway construction; embankment stabilizations on soft foundations; reinforcement for mechanically stabilized earth structures; and liner support.” *See Id.* at 4.

53. Applicant knowingly misrepresented to the USPTO that “[t]he color orange is not commonly used in the industry on woven geotextile/geosynthetic fabrics.” *See Id.*

54. Applicant knowingly misrepresented to the USPTO that “Applicant’s use of the color orange in connection its [sic] Fabric is original, unique and unusual in the geotextile/geosynthetic materials industry.” *See Id.*

55. Applicant knowingly misrepresented to the USPTO that “the Mark does in fact serve as a source indicator and is a registrable trademark.” *See Id.* at 4.

56. Applicant knowingly misrepresented to the USPTO that “The color orange as used in TenCate’s woven geosynthetic fabric is non-functional and is an arbitrary use of color.” *See* Declaration of Lee Bryan, Aug. 20, 2014 Response to Office Action.

57. Applicant knowingly misrepresented to the USPTO that “TenCate is the sole manufacturer of orange woven geosynthetic fabrics.” *See* Declaration of Lee Bryan, Aug. 20, 2014 Response to Office Action.

58. Applicant knowingly misrepresented to the USPTO that “Applicant selected the color orange in connection with its Fabric not to ornament or make its product aesthetically

pleasing, but rather to distinguish its goods from competitors, and to indicate Applicant as the Fabric's source." *See Id.* at 4.

59. Applicant knowingly misrepresented to the USPTO that "Applicant first adopted the color orange in connection with the Fabric as early as May 2010." *See Id.* at 4.

60. Applicant knowingly misrepresented to the USPTO that "No, there are no other competitors using the color orange or any other color (other than Carbon Black) in connection with products similar to Applicant's Fabric." *See Id.* at 6.

61. A filing fee has been submitted electronically.

COUNT I – NON-DISTINCTIVENESS

62. Opposer incorporates by reference paragraphs 1–61 as if fully set forth herein.

63. The proposed mark in the '945 Application does not function as a trademark, is non-distinctive and has not acquired secondary meaning or distinctiveness.

64. The proposed mark in the '945 Application is not a trademark and falls short of the requirements of the Trademark Act, including Sections 1, 2, and 45, 15 U.S.C. §§ 1051, 1052, and 1127.

65. Entities other than Applicant manufacture, market, and sell geotextiles of the same or similar orange color that Applicant seeks to register in the '945 Application.

66. Applicant markets, advertises and promotes its orange geotextiles as serving as a warning signal to those who encounter it.

67. Opposer will be damaged by registration of the proposed mark. Granting Applicant the exclusive right to use the color orange to identify geotextiles for use in construction applications will give Applicant a substantial non-reputational advantage over Opposer and other competitors who could be precluded from accurately describing, marketing

and promoting the color and purpose of competing orange-colored geotextiles. Allowing the registration of Applicant's proposed mark would effectively prevent Opposer and other competitors from profitably competing with Applicant in the marketplace.

68. Furthermore, Opposer will be damaged because, if successful, Applicant's registration of the proposed mark will confuse or mislead the public as to whether Opposer has the exclusive right to use the color orange in geotextiles.

69. Allowing Applicant to register its proposed mark would empower Applicant to take enforcement measures against Opposer and others for their legal use of the functional, non-distinctive orange color in geotextiles.

70. In light of the non-distinctiveness of Applicant's proposed mark, the '945 Application should be refused registration.

COUNT II - FUNCTIONALITY

71. Opposer incorporates by reference paragraphs 1 – 61 as if fully set forth herein.

72. Applicant's proposed mark is functional in that it is used in geotextiles to serve as a warning signal to those encountering it.

73. The color orange is used in geotextiles for construction, horticultural and agricultural applications for its visibility and functionality as a visual cue.

74. The color orange, as used in geotextiles, is not inherently distinctive.

75. In the minds of the relevant public, the color orange has not become inherently distinctive or associated with Applicant's goods.

76. The mark proposed in the '945 Application fails to fulfill the requirements of the Trademark Act, including Section 2(E)(5), 15 U.S.C. § 1052(E)(5), due to its functionality.

77. Opposer will be damaged by registration of the proposed mark. Granting Applicant the exclusive right to use the color orange to identify geotextiles for use in construction applications will give Applicant a substantial non-reputational advantage over Opposer and other competitors who could be precluded from accurately describing, marketing and promoting the color and purpose of competing orange-colored geotextiles. Allowing the registration of Applicant's proposed mark would effectively prevent Opposer and other competitors from profitably competing with Applicant in the marketplace.

78. Furthermore, Opposer will be damaged because, if successful, Applicant's registration of the proposed mark will confuse or mislead the public as to whether Opposer has the exclusive right to use the color orange in geotextiles.

79. Allowing Applicant to register its proposed mark would empower Applicant to take enforcement measures against Opposer and others for their legal use of the functional, non-distinctive orange color in geotextiles.

80. In light of the non-distinctiveness of Applicant's proposed mark, the '945 Application should be refused registration.

COUNT III – INEQUITABLE CONDUCT

81. Opposer incorporates by reference paragraphs 1–61 as if fully set forth herein.

82. In Applicant's August 20, 2014 Response to Office Action, Applicant knowingly made material misrepresentations with the intent to deceive the USPTO.

83. The Examiner relied upon Applicant's misrepresentations in determining that Applicant's proposed mark "appears to be entitled to registration."

84. The Examiner relied upon Applicant's misrepresentations in approving the proposed mark for publication in the *Official Gazette*.

85. In light of the foregoing inequitable conduct, Applicant's proposed mark should be refused registration.

WHEREFORE, Opposer respectfully requests that this Notice of Opposition be sustained, the registration of Application Serial No. 86/057,945 be rejected, and the registration of the trademark therein sought, for the goods therein specified, be denied and refused.

Respectfully submitted this 3rd day of June, 2015.

/s/ Jacquelynne Regan
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