

Exhibit

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

 ZELCO INDUSTRIES, INC.,)
)
 Petitioner,)
)
 v.)
)
 DIAMOND BRANDS INCORPORATED,)
)
 Respondent.)

Cancellation No. 20,485



06-26-2002

U.S. Patent & TMO/TM Mail Rcpt. Dt.

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TRADEMARK TRIAL AND
APPEAL BOARD

**MOTION TO AMEND PETITION FOR CANCELLATION PURSUANT
TO RULES 15(a) AND 15(b) F.R.CIV.P. AND FOR
SUMMARY JUDGMENT PURSUANT TO RULE 56 F.R.CIV.P.**

Petitioner, Zelco Industries, Inc. ("Zelco"), based upon the accompanying Declaration of Robert B.G. Horowitz dated April 17, 1998 and exhibits thereto, pursuant to Rules 15(a) and 15(b) of the Federal Rules of Civil Procedure, moves to amend its Petition for Cancellation as per Exhibit 1 hereto to include a count of descriptiveness as a ground for cancellation of Respondent's U.S. Registration No. 1,662,173 for the mark SUPERMATCH, and, pursuant to Rule 56 of the Federal Rules of Civil Procedure, for summary judgment on its count of descriptiveness and for cancellation of Respondent's registration. Alternatively, and in the event that its Motions to Amend and for Summary Judgment are denied, Petitioner requests that its rebuttal testimony period be reset, and that the same commence after the Board's ruling on this motion.

This motion is being brought at the present time because it has just come to light that respondent's goods are in fact matches which are large in size. This was admitted by John Young, Respondent's vice-president of sales and marketing, at his testimony

deposition, March 3, 1998. There was no way Petitioner could have known this information prior to Mr. Young's deposition. Respondent had never referred to its goods as "matches"; rather, in its registration, they were identified as "firestarting briquettes for use with barbecue grills, wood stoves or fireplaces." Additionally, nothing in the documents produced by Respondent during discovery indicated that its goods are, in fact, matches. The issue of descriptiveness was tried at Mr. Young's deposition upon Respondent's implied consent.

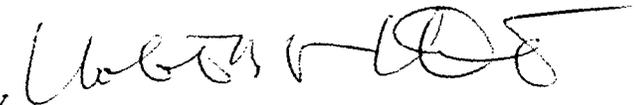
Respondent will not be prejudiced by the grant of this relief, notwithstanding the fact that this motion is made after the close of the parties' testimony-in-chief periods. Nevertheless, should the Board deem it necessary, Petitioner has no objection to Respondent taking additional discovery and testimony, provided such discovery and testimony is limited to the issue of the descriptiveness of Respondent's mark.

In view of the above, Petitioner respectfully requests the grant of any and all relief set forth in this motion.

Respectfully Submitted,

COOPER & DUNHAM LLP

By



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Dated: April 17, 1998

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

ZELCO INDUSTRIES, INC.,)
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) Petitioner,)
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) v.) Cancellation No.: 20,485
)
) DIAMOND BRANDS INCORPORATED,)
)
) Respondent.)
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PETITION FOR CANCELLATION

IN THE MATTER of the registration DIAMOND BRANDS INCORPORATED (hereinafter referred to as "Respondent") for the trademark SUPERMATCH in Classes 4 and 34 for "firestarting briquettes for use with barbeque grills, wood, stoves or fireplaces", Registration No. 1,662,173 issued October 29, 1991, ZELCO INDUSTRIES, INC., (hereinafter referred to as "Petitioner"), a corporation of New York, which has its principal place of business at 630 South Columbus Avenue, Mount Vernon, New York 10551-4445, believes that it will be damaged by continuance of said trademark registration and hereby petitions for cancellation of said registration.

The grounds for cancellation are as follows:

FACTS COMMON TO ALL GROUNDS FOR CANCELLATION

1. Petitioner for many years has been engaged in the advertising, promotion and sale of various products.

2. Since at least as early as January 1, 1980 and long prior to any date on which Respondent herein is entitled to rely, Petitioner has continuously sold, promoted and advertised in interstate commerce and foreign commerce regulatable by Congress lighters for barbecues, fireplaces, gas ovens, wood stoves and other products which require a long-reaching flame source, in connection with the trademark SUPERMATCH.

3. Petitioner has had substantial sales of its product bearing the trademark SUPERMATCH and has spent substantial money in advertising and promoting its SUPERMATCH trademark throughout the United States.

4. By virtue of the sale, promotion and advertisement of Petitioner's goods bearing the trademark SUPERMATCH, said mark has come to represent a great and valuable goodwill to Petitioner.

AS AND FOR A FIRST GROUND FOR CANCELLATION

5. Use by Respondent of the SUPERMATCH trademark for which it has obtained registration which is the subject of this proceeding, for the good set forth therein, is likely to cause confusion, mistakes or deception as to the source of origin, sponsorship or approval of Respondent's product in that purchasers or others are likely to believe that Respondent's product is Petitioner's product or is in some way legitimately connected with, licensed by, or approved by Respondent. Such likelihood of confusion is manifest in view of the identity of the SUPERMATCH marks and the closely related and complementary nature of the parties' goods sold under said mark.

6. Use by Respondent of the registered SUPERMATCH trademark for which cancellation is sought is without Petitioner's consent or permission.

7. On October 28, 1991, Petitioner filed application Serial No. 74/216032 for registration of its SUPERMATCH trademark for "lighters for barbecues, fireplaces, gas ovens, wood stoves and other products which require a long-reaching flame source". In an Office Action dated January 31, 1992, Respondent's registration for SUPERMATCH was cited against said application on grounds of confusing similarity under Section 2(d) of the Trademark Act of 1946. A true, accurate and correct copy of said Office Action is annexed as Exhibit 1. Petitioner will not be able to register its SUPERMATCH trademark unless said registration is cancelled.

AS AND FOR A SECOND GROUND FOR CANCELLATION

8. Petitioner repeats and realleges paragraphs 1 through 7 as though fully set forth herein.

9. On March 3, 1998, John Young, Respondent's vice-president of sales and marketing gave a testimony deposition for Respondent.

10. At the deposition, during his direct testimony, Mr. Young testified in pp. 18-19 as follows:

Q. Your SUPERMATCH Fire Starter, how would you compare that to a match?

A. Well, it is a match, just in a little bit different form. In fact, as we designed the product, we tried to make it look as much like a match as possible. It originally was about four-and-a-half inches long. It think it is a little longer than that now. Probably about six inches long, five or six inches long. We cut the board, designed it as a match, and then put the same compound on the tip or head

of it that we do put on all of our safety matches, so that people can have the same convenience as they have with our normal wooden matches. It just burns for 12 minutes.

Q. It is essentially a big match?

A. Right.

11. Mr. Young testified as follows in pp. 90-92 of his testimony transcript during cross-examination:

Q. Does "Super" in the context of Diamond Brands' SUPERMATCH trademark mean jumbo sized?

A. It is in the context - now you are asking for my self-interpretation. The message we are trying to deliver is that it delivers a match and much more. A match that burns for 12 minutes. A match that has got super heat to it and it is super big.

Q. Diamond Brands' SUPERMATCH product has a rigid body, does it not?

A. Yes.

Q. And the body, I believe you testified, was made of compressed sawdust and paraffin wax; is that correct?

A. Yes.

Q. I believe you also testified that the body is tipped with a combustible mixture?

A. Yes.

Q. The combustible mixture is colored red, like a kitchen match; is that correct?

A. Yes.

Q. The combustible mixture in the tip bursts into flame through friction; isn't that correct?

A. That's correct.

Q. And the tip, when ignited, ignites the material of the body of the match; is that

correct?

A. Yes.

Q. And SUPERMATCH is struck like a kitchen match?

A. Yes, it is.

12. Respondent's SUPERMATCH trademark merely describes the goods upon which it is used, namely, "super matches".

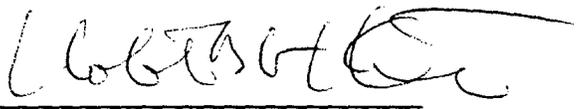
13. Pursuant to Section 2(e)(1) of the Trademark Act, Respondent's mark should not have been registered on the Principal Register and should, therefore, be cancelled.

WHEREFORE, Petitioner believes that it will be damaged by the continuance of said registration and prays that it be cancelled.

Please address all correspondence to Robert B.G. Horowitz, Cooper & Dunham LLP, 1185 Avenue of the Americas, New York, N.Y. 10036.

Respectfully submitted,

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Dated: New York, N.Y.
April 17, 1998