

07/22/2003TTAB

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Attorney

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

In the Matter of Registration No. 2,176,916
Registration Date: July 28, 1998



07-09-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

INTERTAPE POLYMER GROUP INC.,]
]]
Petitioner,]]
]]
v.]]
]]
3M COMPANY,]]
]]
Registrant.]]

Cancellation No. _____

BOX TTAB – FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

PETITION FOR CANCELLATION

Intertape Polymer Group Inc., a corporation organized and existing under the laws of Canada, with its principal place of business at 110 E. Montee De Liesse, Montreal, Canada H4T 1N4, believes that it is being damaged by Registration No. 2,176,916, owned by 3M Company (“Registrant”), a Delaware corporation having its principal place of business at 2501 Hudson Road, St. Paul, Minnesota 55144, and hereby petitions to cancel such registration.

As grounds for cancellation, it is alleged as follows:

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1. Intertape Polymer Group or its predecessors-in-interest (collectively "Petitioner") has adopted and used various shades of the color blue in connection with premium-quality masking tape since at least as early as 1990.

2. Registration No. 2,176,916 was issued to Registrant's predecessor-in-interest on July 28, 1998 on the Principal Register under Section 2(f) of the Lanham Act. Registrant is the owner of Registration No. 2,176,916 as shown by the Assignment Records of the U.S. Patent and Trademark Office ("Office") at Trademark Reel 2502, Frame 0547.

3. Registration No. 2,176,916, now sought to be cancelled, is for the trademark MISCELLANEOUS DESIGN, registered for use on premium-quality masking tape in Class 17. The description of the mark as originally registered read, in part: "The mark consists of the single color blue as applied to the entirety of the goods." The lining statement for the mark as originally registered read: "The drawing is lined for blue and color is claimed as a feature of the mark." On January 16, 2003, Registrant filed a post-registration request to narrow the description of the mark to read, in part: "The mark consists of a particular shade of the color blue, sometimes referred to as medium blue, applied to the entire surface of the goods."

4. Registration No. 2,176,916 is not "incontestable" under Section 15 of the Lanham Act.

5. Upon information and belief, Registrant's Section 2(f) claim of acquired distinctiveness was improperly accepted because the Office based its finding of acquired distinctiveness upon false and misleading information provided by Registrant. At the time Registrant filed the application which issued as Registration No. 2,176,916, Petitioner and numerous third parties were selling commercially significant amounts of blue premium-quality masking tape and Registrant was clearly aware this. Nevertheless, Registrant made several false and misleading statements regarding the substantial exclusivity of its use of blue premium-quality masking tape in support of its claim of acquired distinctiveness. Specifically, Registrant misled the Office by making statements that it had "substantially exclusive and continuous use of

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the mark on the goods in interstate commerce for at least nine years before the date on which the claim of distinctiveness is made” and that it “continues to produce nearly all of the goods in the market which use any form of blue on the goods themselves.” Had the Office known the true facts – that the color blue had been used by numerous parties for commercially significant amounts of premium-quality masking tape for several years prior to Registrant’s claim of acquired distinctiveness – the application would have been rejected. Thus, Registrant did not meet the standards for acquired distinctiveness under Section 2(f). Accordingly, Registration No. 2,176,916 is invalid and should be cancelled.

6. Upon information and belief, Registration No. 2,176,916 was fraudulently obtained because Registrant, in its application to register the color blue for premium-quality masking tape, intentionally made misrepresentations to the Office concerning material facts. Contrary to Registrant’s allegations and claims set forth in its application, Registrant’s use of the color blue for premium-quality masking tape was *not* substantially exclusive at the time of filing of the application and, indeed, is still not substantially exclusive. Registrant was aware that numerous companies, including Petitioner, were using the color blue for commercially significant amounts of premium-quality masking tape prior to and at the time Registrant filed its application for its blue premium-quality masking tape. Nevertheless, Registrant intentionally and falsely stated in its application that it “continues to produce nearly all of the goods in the market which use any form of blue on the goods themselves” and intentionally misled the Office by stating that “[c]ompetitors offer the goods in colors other than blue.” Had Registrant not intentionally provided the Office with false and misleading information regarding the acquired distinctiveness of the color blue on premium-quality masking tape and its substantially exclusive use of the color blue, Registration No. 2,176,916 would not have been granted. Thus, Registrant obtained its registration by fraud. Accordingly, Registration No. 2,176,916 is invalid and should be cancelled.

7. Registration No. 2,176,916 should be cancelled on the basis that the mark had not acquired secondary meaning during prosecution of the application and, indeed, still has not acquired distinctiveness. Upon information and belief, numerous parties, including Petitioner,

were selling commercially significant amounts of blue premium-quality masking tape, both prior to the time Registrant filed its application for its blue premium-quality masking tape and during the time relied upon by Registrant to support its Section 2(f) claim of acquired distinctiveness. Upon information and belief, Petitioner asserts that the color blue for masking tape is viewed by consumers as designating a *type* of masking tape (premium-quality), rather than the *source* (in the trademark sense) of a particular masking tape. In light of numerous companies' uses of commercially significant amounts of blue masking tape, Registrant did not and cannot prove its substantially exclusive use of blue in connection with premium-quality masking tape.

8. Registrant's mark is a generic "grade designation" when used in connection with Registrant's premium-quality masking tape. Registrant sells premium-quality masking tapes in several colors including blue, white, green and beige. Registrant's product brochures advertise this variety of colors. Upon information and belief, Registrant's blue masking tapes are intended to be used for painted surfaces and glass, and for faux and decorative painting; its white masking tape is intended to be used for delicate surfaces; its green masking tape is intended to be used for hard-to-stick surfaces; and, of its two beige masking tapes, one is intended to be used for trim and woodwork and the other for general purposes. Inasmuch as Registrant's color blue functions merely as part of a color-coding system to identify its various *types* of masking tapes and not to identify and distinguish the *source* of Registrant's masking tape, Registration No. 2,176,916 should be cancelled.

9. If Registrant is permitted to maintain Registration No. 2,176,916, such registration would continue to be a source of damage and injury to Petitioner and others in the tape industry who use the color blue to indicate a *type* of masking tape, requiring Petitioner and others to abandon their use and change their promotional and advertising tactics, all to the great expense and detriment of Petitioner and others in the trade.

10. Furthermore, if Registrant is permitted to maintain Registration No. 2,176,916, such registration may be deemed "incontestable" after five years from its date of registration and Petitioner and others in the trade would be additionally damaged.

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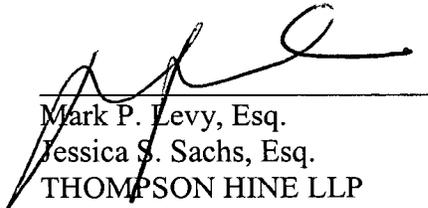
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WHEREFORE, Petitioner deems that it is being damaged by the continued existence of Registration No. 2,176,916, and thus petitions for cancellation thereof.

A duplicate copy of this Petition for Cancellation and the fee required in § 2.6(a)(16) are enclosed herewith.

Respectfully submitted,

Date: 7/7/03



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