

09/09/2003TTAB

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

Central Products Company and Intertape
Polymer Corporation,

Petitioner,

v.

3M Company,

Registrant.

Cancellation No. 92042254



08-29-2003

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

STIPULATED MOTION TO SUSPEND PROCEEDING PENDING CIVIL ACTION

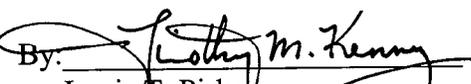
Pursuant to 37 C.F.R. § 2.117(a) and TBMP § 510.02, Registrant 3M Company and Petitioners Central Products Company and Intertape Polymer Corporation, by and through their undersigned counsel, hereby stipulate and move to suspend the captioned cancellation proceeding because the parties are engaged in a civil action which may be dispositive of the cancellation proceeding. The parties are engaged in Civil Action No. 03-2651 (JRT/FLN) filed by Registrant in the United States District Court for the District of Minnesota. A true and correct copy of Registrant's Complaint filed in that action on April 3, 2003, is attached hereto as Exhibit A.

Respectfully submitted,

DATED: 8/27/03

DATED: August 26, 2003

By: 
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ATTORNEYS FOR PETITIONERS

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UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA

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CLERK, U.S. DIST COURT
MINNEAPOLIS, MN

3M COMPANY,

Plaintiff,

v.

Civil Action No. _____

INTERTAPE POLYMER GROUP INC.,
IPG (U.S.) HOLDINGS INC., IPG (U.S.)
INC. and CENTRAL PRODUCTS
COMPANY,

Defendants.

**3M COMPANY'S COMPLAINT FOR TRADEMARK INFRINGEMENT, DILUTION
UNFAIR COMPETITION AND UNJUST ENRICHMENT**

Plaintiff 3M Company ("3M Company" or "3M"), appearing through its undersigned
counsel, states as follows:

PARTIES

1. 3M Company is a Delaware corporation having its principal place of business at
2501 Hudson Rd., St. Paul, Minnesota 55144.

2. On information and belief, Defendant Intertape Polymer Group Inc. ("Intertape")
is a Canadian corporation having a principal place of business at 110 E. Montee De Liesse,
Montreal PQ H4T 1N4, Quebec, Canada.

3. On information and belief, Defendants IPG (U.S.) Holdings Inc. ("IPG
Holdings"), IPG (U.S.) Inc. ("IPG"), and Central Products Company ("Central Products") are
Delaware corporations having a principal place of business at 3647 West Cortez Road,
Bradenton, Florida 34210.

4. On information and belief, Central Products is a subsidiary of IPG, which is a
subsidiary of IPG Holdings, which is a subsidiary of Intertape (collectively these parties will be



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referred to as "Defendants"). Intertape controls and directs the infringing acts of IPG Holdings, IPG, and Central Products.

NATURE OF THIS ACTION; JURISDICTION OF THE COURT

5. This is an action for trademark infringement, dilution, and unfair competition under the Trademark Act of 1946, as amended, 15 U.S.C. § 1051 *et seq.* ("Lanham Act"), for trademark dilution under the Minnesota Anti-Dilution Statute, Minn. Stat. Ann. § 333.285 and the dilution statutes of other states where Defendants are conducting their activities, and for trademark infringement, unfair competition and unjust enrichment under the common law of Minnesota and other states where Defendants are conducting their activities.

6. This Court has jurisdiction over the subject matter of this action under 15 U.S.C. § 1121 and 28 U.S.C. § 1331 and 1338 (a) and (b), and has supplemental jurisdiction under 28 U.S.C. § 1367(a) over 3M's claims under state law.

3M'S COLOR BLUE MARK

7. 3M Company introduced a premium quality UV-resistant painter's masking tape ("Painter's Tape"), blue in color, in 1987 ("3M Blue Tape").

8. 3M Blue Tape was a result of 3M Company's drive to create innovative and useful new products. It was a revolutionary product. As a result, 3M Blue Tape has been an extremely successful product in the marketplace.

9. 3M Company has continuously used the color blue in connection with 3M Blue Tape since its introduction in 1987.

10. The blue color of 3M Blue Tape is a protectable trademark ("Color Blue Mark") for Painter's Tape. This mark is owned by 3M Company.

11. As a result of the long use and promotion of the Color Blue Mark by 3M Company, that mark has become distinctive to designate 3M Company, to distinguish 3M

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Company and its products from the products of other businesses, and to distinguish the source or origin of 3M Blue Tape products. As a result of these efforts by 3M Company, the consuming public in Minnesota and elsewhere widely recognizes and associates the Color Blue Mark with 3M Company and its products.

12. As a result of 3M Company's long use and promotion of the Color Blue Mark in Minnesota and elsewhere, 3M Company has developed great and valuable goodwill and has acquired valuable common law rights in the Color Blue Mark.

13. The Color Blue Mark is famous in the painting and construction industries.

14. In accordance with federal law, 3M Company has registered the Color Blue Mark on the Principal Register of the United States Patent and Trademark Office. A copy of U.S. Registration No. 2,176,916 is attached hereto as Exhibit 1.

DEFENDANTS AND THEIR ACTIVITIES

15. Defendants are engaged in the business of manufacturing, marketing, distributing, and selling a variety of pressure sensitive tapes, including Painter's Tape ("Defendants' Goods"). Defendants' Goods are or have been sold under the names PG-90 SolaBlue and Pro-Mask Blue.

16. Defendants – or their predecessors-in-interest – selected a blue color strikingly similar to 3M's Color Blue Mark for use in connection with Defendants' Goods.

17. Defendants sell Defendants' Goods in commerce in competition with 3M Blue Tape.

18. Defendants use the color blue in the manufacturing, marketing and sale of Defendants' Goods.

19. Defendants' first sale of Defendants' Goods using the color blue commenced long after 3M Company's first use of its Color Blue Mark.

20. Defendants – or their predecessors-in-interest – adopted the color blue for use in

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connection with Defendants' Goods and introduced Defendants' Goods into the market with full knowledge of 3M Company's prior use of the color blue for directly competing products.

21. Defendants – or their predecessors-in-interest – did not ask for or obtain 3M Company's permission to use the color blue in connection with Defendants' Goods.

22. Defendants adopted the color blue and introduced Defendants' Goods in the color blue into the market in order to lead consumers to believe that there was some connection or affiliation between Defendants, or Defendants' Goods, and 3M Company or the 3M Blue Tape sold in connection with the Color Blue Mark.

23. Defendants are now selling Defendants' Goods in commerce in the United States, and in this District, in direct competition with the 3M Blue Tape. By using the color blue in this manner, Defendants are intentionally trading on 3M Company's immense goodwill in the Color Blue Mark.

24. Defendants have intentionally confused United States consumers as to the source or affiliation of Defendants' Goods.

**EFFECT OF DEFENDANTS' ACTIVITIES ON THE
CONSUMING PUBLIC AND/OR 3M COMPANY**

25. Defendants' unauthorized use of a color confusingly similar to the Color Blue Mark in the manner described above is likely to cause confusion, to cause mistake, and/or to deceive customers and potential customers of the parties, at least as to some affiliation, connection or association of Defendants with 3M Company, or as to the origin, sponsorship, or approval of Defendants' Goods by 3M Company.

26. Defendants' unauthorized use of a color confusingly similar to the Color Blue Mark in the manner described above falsely indicates to the purchasing public that Defendants' goods originate with 3M Company, or are affiliated, connected or associated with 3M Company,

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or are sponsored, endorsed, or approved by 3M Company, or are in some manner related to 3M Company and/or its products.

27. Defendants' unauthorized use of a color confusingly similar to the Color Blue Mark in the manner described above falsely designates the origin of Defendants' goods, and falsely and misleadingly describes and represents facts with respect to Defendants and Defendants' Goods.

28. Defendants' unauthorized use of a color confusingly similar to the Color Blue Mark in the manner described above enables them to trade on and receive the benefit of goodwill in that mark, which 3M Company has built up at great labor and expense over many years. Defendants' unauthorized use also enables them to gain acceptance for their own goods, not solely on their own merits, but on the reputation and goodwill of 3M Company and its Color Blue Mark.

29. Defendants' unauthorized use of a color confusingly similar to the Color Blue Mark in the manner described above causes dilution of the distinctive quality of 3M Company's famous Color Blue Mark.

30. Defendants' unauthorized use of a color confusingly similar to the Color Blue Mark in the manner described above began after that mark had become famous.

31. Defendants' use of a color confusingly similar to the Color Blue Mark in the manner described above unjustly enriches Defendants at 3M Company's expense.

32. Defendants' unauthorized use of a color confusingly similar to the Color Blue Mark in the manner described above removes from 3M Company the ability to control the nature and quality of products provided under that mark and places the valuable reputation and goodwill of 3M Company in the hands of Defendants, over whom 3M Company has no control.

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33. Defendants' activities have caused irreparable injury to 3M Company and, unless restrained by this Court, will continue to cause irreparable injury to 3M and to the public. There is no adequate remedy at law for this injury.

COUNT I: FEDERAL TRADEMARK INFRINGEMENT

34. 3M Company repeats the allegations above as if fully set forth herein.

35. The acts of Defendants complained of herein constitute infringement of 3M Company's federally registered Color Blue Mark in violation of 15 U.S.C. § 1114(1).

36. Defendants' infringement has been willful and in bad faith making this an exceptional case within the meaning of 15 U.S.C. § 1117(a).

COUNT II: FEDERAL UNFAIR COMPETITION

37. 3M Company repeats the allegations above as if fully set forth herein.

38. The acts of Defendants complained of herein constitute trademark infringement and unfair competition in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

39. Defendants' infringement and unfair competition have been willful and in bad faith, making this an exceptional case under 15 U.S.C. § 1117.

COUNT III: FEDERAL DILUTION

40. 3M Company repeats the allegations above as if fully set forth herein.

41. The acts of Defendants complained of herein cause dilution of the distinctive quality of 3M's Color Blue Mark, in violation of the Federal Trademark Dilution Act, 15 U.S.C. § 1125(c).

42. Defendants have willfully traded on 3M Company's reputation and caused dilution of 3M Company's famous Color Blue Mark.

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COUNT IV: COMMON LAW TRADEMARK INFRINGEMENT

43. 3M Company repeats the allegations above as if fully set forth herein.

44. The acts of Defendants complained of herein constitute trademark infringement in violation of the common law of Minnesota and other states where Defendants are conducting their activities.

COUNT V: DILUTION UNDER STATE LAW

45. 3M Company repeats the allegations above as if fully set forth herein.

46. The acts of Defendants complained of herein constitute dilution of 3M Company's Color Blue Mark in violation of the Minnesota Anti-Dilution Statute, Minn. Stat. Ann. § 333.285, and the dilution statutes of other states where Defendants are conducting their activities.

COUNT VI: UNJUST ENRICHMENT

47. 3M Company repeats the allegations above as if fully set forth herein.

48. The acts of Defendants complained of herein constitute unjust enrichment of Defendants at 3M Company's expense.

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PRAYER

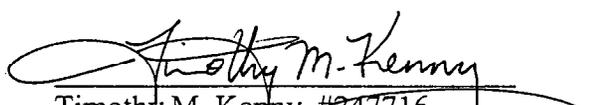
WHEREFORE, 3M Company prays that:

- (a) Defendants, their officers, agents, servants, employees, attorneys, and all those persons in active concert or participation with them, be permanently enjoined and restrained from using in connection with Defendants' Goods, the Color Blue Mark, or any other color that is confusingly similar to 3M Company's Color Blue Mark or that dilutes the distinctive quality thereof;
- (b) Defendants, their officers, agents, servants, employees, attorneys, and all those persons in active concert or participation with Defendants, be required to deliver to the Court for destruction, or show proof of destruction of, any and all products, labels, signs, prints, packages, wrappers, receptacles, marketing materials and advertisements in Defendants' possession or control which use or depict the Color Blue Mark, or any color that is confusingly similar to 3M Company's Color Blue Mark or that dilutes the distinctive quality thereof;
- (c) Defendants be ordered to file with this Court and to serve upon 3M Company, within thirty (30) days after the entry and service on Defendants of an injunction, a report in writing and under oath setting forth in detail the manner and form in which Defendants have complied with the injunction;
- (d) 3M Company recover all damages it has sustained as a result of Defendants' activities and that said damages be trebled;
- (e) An accounting be directed to determine Defendants' profits resulting from its activities and that such profits be paid over to 3M Company, increased as the Court finds to be just under the circumstances of this case;
- (f) 3M Company recover its reasonable attorney fees;

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- (g) 3M Company recover its costs of this action and prejudgment and post-judgment interest; and
- (h) 3M Company recover such other relief as the Court may deem appropriate.

Dated: April 3, 2003.


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August 27, 2003

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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BOX TTAB – NO FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

Sir:

Transmitted herewith are the following paper(s):

- Stipulated Motion To Suspend Proceeding Pending Civil Action, including Exhibit A (Registrant's Complaint filed in that action on April 3, 2003).

Respectfully submitted,

By: *Jessica Sachs*
 Jessica S. Sachs, Esq.
 (937) 443-6857

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Cancellation No. 92042254

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited in the United States Postal Service as first class mail in the envelope addressed to: **BOX TTAB-NO FEE**, Commissioner for Trademarks, Arlington, Virginia 22202-3514, on

8/27/03

(Date of Deposit)

Jessica Sachs
Attorney