

ESTTA Tracking number: **ESTTA47703**

Filing date: **10/06/2005**

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

Proceeding	92043900
Party	Defendant DIE GEM CO., INC., THE DIE GEM CO., INC., THE P.O. BOX 8033 MAPLE VALLEY STATION AKRON, OH 44320
Correspondence Address	THE DIE GEM CO., INC. P.O. BOX 8033, MAPLE VALLEY STATION AKRON, OH 44320
Submission	Letter in Answer to changes in Confidential Agreement
Filer's Name	James R Adams
Filer's e-mail	JRA@die-gem.com
Signature	/James R Adams/
Date	10/06/2005
Attachments	OCT0605 LtrDecliningINTERN .pdf (6 pages) USPTO NoteAccer&Ren0003.pdf (1 page)

1. Omnova Solution Inc. Representative has said they would have no way of using any information to gain an advantage over The Die-Gem Co., Inc.

Omnova Solutions Inc. does not know what is in the Confidential Information and therefore is not in the position to make that judgment.

2. Omnova Solution Inc. Representative has said they are not competitors.

The Die-Gem Co., Inc. is literally surrounded by facilities of Omnova Solution Inc. in Akron Ohio.

- a. The Die-Gem Co., Inc. and Omnova Solutions Inc. are just like Goodyear and Goodrich they are confused by all and no one but the employees know the difference and this would be true of PEEL & STICK. The public just knows they came from that company in Akron, Ohio.

- b. The Die-Gem Co., Inc. sells in the same markets and each potential customer has a finite budget for repairs and new structures. Omnova Solution Inc. continues to dilute the mark PEEL N STICK and does not care that it is diluting The Die-Gem Co., Inc valuable asset.
- c. The United States Patent and Trademark Office believes that Omnova Solution Inc. is competing with The Die-Gem Co., Inc. and that The Die-Gem Co., Inc. is currently using the mark PEEL N STICK and has future use of the mark and plans to continue to use the mark.
 1. The application(S) of Omnova Solution Inc. for the mark PEEL & STICK has been denied twice by The United States Patent and Trademark Office. The USPTO specific reason given was that the mark PEEL & STICK will be used in the same markets as the mark PEEL N STICK and therefore will be confusing to the customer base.
 2. The Die-Gem Co., Inc. did apply for a 10 year extension (March 22, 2005) of the mark PEEL N STICK and USPTO Renewal Department has

granted an extension through (June 9, 2015) See attachment.

3. The mark PEEL N STICK was registered on the PRINCIPAL REGISTER, BECAME INCONTESTABLE IN 1992, and continues to have that status.

3. Mr. Mermelstein, in your letter of July 30, 2005 you note that the exhibits were designated confidential.

Please note that the petitioner Omnova Solution Inc. was given the same CD provided to the TTAB. That CD contained the 19 page Answer, Motion to Dismiss and four classes of exhibits.

- a. There were 44 exhibits in the 1st class of exhibit.
- b. There were 24 exhibits in the 2nd class of exhibit.
- c. There were 17 exhibits in the 3rd class of exhibit.
- d. There were 12 exhibits in the 4th class of exhibit.

This is prima facie evidence of the use, continued use and depth of penetration of the mark PEEL N STICK in the market in this part of the answer.

The part of the answer marked confidential as noted in the 19 page non-confidential section contains a control list, some product specifications, R & D since 1995 and The Die-Gem Co., Inc. plan for action. There is fundamental information in this section marked confidential that any company even the petitioner Omnova Solution Inc. would not want known.

However there will be no doubt in the Board's conclusion after reviewing the Answer in its entirety as has already been concluded by the USPTO in accepting the proof and extending the PRINCIPAL REGISTER of the mark PEEL N STICK.

Sincerely

James R Adams
President
The Die-Gem Co., Inc.

Encl: USPTO **NOTICE OF ACCEPTANCE AND RENEWAL**
Registration No: 1384270 Serial No: 73/420918

Email response JRA@die-gem.com

330-784-7400 Fax 7542

I certify that on the 6th day of October 2005 this letter to Mr. Mermelstein was served by Internet and addressed to the representative of Omnova Solutions Inc.

Mr. Michael C Whitticar
Jagtiani + Guttag
10363-A Democracy Lane
Fairfax, Va. 22030

At

iplaw@jagtiani.com
Web site [www. Jagtiani.com](http://www.Jagtiani.com)

And by

I certify that on the 6th day of October 2005 this letter to Mr. Mermelstein was served by US Mail addressed to the representative of Omnova Solutions Inc. addressed and postage prepaid to the correspondent of record for Petitioner:

Mr. Michael C Whitticar
Jagtiani + Guttag
10363-A Democracy Lane
Fairfax, Va. 22030

James R Adams JRA@die-gem.com
President 330 784-7400



REGISTRATION NO: 1384270 SERIAL NO: 73/420918 MAILING DATE: 06/09/2005
REGISTRATION DATE: 02/25/1986
MARK: PEEL N STICK
REGISTRATION OWNER: DIE GEM CO., INC., THE

CORRESPONDENCE ADDRESS:

THE DIE GEM CO., INC.
P.O. BOX 8033
MAPLE VALLEY STATION
AKRON, OH 44320

NOTICE OF ACCEPTANCE

15 U.S.C. Sec. 1058(a)(3)

THE COMBINED AFFIDAVIT AND RENEWAL APPLICATION FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 8 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1058.

ACCORDINGLY, THE SECTION 8 AFFIDAVIT IS ACCEPTED.

NOTICE OF RENEWAL

15 U.S.C. Sec. 1059(a)

THE COMBINED AFFIDAVIT AND RENEWAL APPLICATION FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 9 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1059.

ACCORDINGLY, THE REGISTRATION IS RENEWED.

THE REGISTRATION WILL REMAIN IN FORCE FOR CLASS(ES):
017.

CONLEY, JOYCE MARIE
PARALEGAL SPECIALIST
POST-REGISTRATION DIVISION
571-272-9500

PLEASE SEE THE REVERSE SIDE OF THIS NOTICE FOR INFORMATION CONCERNING REQUIREMENTS FOR MAINTAINING THIS REGISTRATION

ORIGINAL