

ESTTA Tracking number: **ESTTA25042**

Filing date: **02/03/2005**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

| | | | |
|----------------|--|--------------------|--------|
| Name | ADL Insulflex, Inc. | | |
| Entity | Corporation | Citizenship | Canada |
| Address | 8783 Dale Road Cobourg, Ont K9A 4J9 CANADA | | |

| | | | |
|-----------------------------|--|--|--|
| Attorney information | Mark N. Mutterperl Fulbright & Jaworski L.L.P. 666 Fifth Avenue New York, NY 10103 UNITED STATES mmutterperl@fulbright.com Phone:212-318-3183 | | |
|-----------------------------|--|--|--|

Registration Subject to Cancellation

| | | | |
|---|---|--------------------------|------------|
| Registration No | 2836133 | Registration date | 04/27/2004 |
| Registrant | Davlyn Manufacturing Co., Inc. 85 Mennonite Church Road P.O. Box 49 Spring City, PA 19475 UNITED STATES | | |
| Goods/Services Subject to Cancellation | Class 017. First Use: 20030315, First Use In Commerce: 20030315 Goods/Services: silicone rubber coated sleeving for general industrial applications, namely, for the protection of electrical wiring and hydraulic hoses | | |

| | |
|--------------------|---|
| Attachments | Petition to Cancel-ADL v Davlyn.pdf (4 pages) |
|--------------------|---|

| | |
|------------------|----------------------|
| Signature | /Mark N. Mutterperl/ |
|------------------|----------------------|

| | |
|-------------|--------------------|
| Name | Mark N. Mutterperl |
|-------------|--------------------|

| | |
|-------------|------------|
| Date | 02/03/2005 |
|-------------|------------|

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

In the matter of Registration No.: 2,836,133
By Davlyn Manufacturing Co., Inc. for: FIRESLEEVE.COM
Registered: April 27, 2004

ADL Insulflex, Inc.,

Petitioner,

v.

Davlyn Manufacturing Co., Inc.,

Respondent.

Cancellation No. _____

PETITION TO CANCEL

ADL Insulflex, Inc. (“Petitioner”), a Canadian corporation having its principal place of business at 8783 Dale Road, Cobourg, Ontario, Canada K9A 4J9, believes that it is and will continue to be damaged by the existence of the registration for “FIRESLEEVE.COM” captioned above and hereby petitions to cancel the same under the provisions of 15 U.S.C. § 1064. As grounds for cancellation, Petitioner asserts the following:

1. Petitioner manufactures and distributes throughout the United States and elsewhere high-performance, non-asbestos, industrial heat-protection materials and products, including heat resistant sleeves (also commonly referred to and known as “firesleeves”), sealants, high temperature tapes and fire blankets.

2. Davlyn Manufacturing Co., Inc., (“Respondent”), a Pennsylvania corporation having a place of business at 85 Mennonite Church Road, P.O. Box 49, Spring City Pennsylvania 19475, obtained a United States trademark registration for “FIRESLEEVE.COM”

to identify “silicone rubber coated sleeving for general industrial applications, namely, for the protection of electrical wiring and hydraulic hoses” in International Class 17, U.S. Trademark Registration No. 2,836,133 (the “Registration”). The U.S. Patent and Trademark Office (“PTO”) issued the Registration on April 27, 2004.

3. As stated in the PTO’s *Trademark Manual of Examining Procedure* § 1209.03(m) (“TMEP”), the top level Internet domain name (“TLD”) “.com” functions to indicate an address on the World Wide Web and therefore serves no source-indicating function. As also noted in the TMEP, the TLD “.com” signifies to the public that the user of the domain name constitutes a commercial entity. *TMEP* § 1209.03(m). Consequently, the “.COM” portion of “FIRESLEEVE.COM” serves no source-identifying function and its addition to an otherwise unregistrable term cannot render the term registrable. *Id.*

4. “Firesleeve” (“fire-sleeve”) is recognized among the relevant consumers and in the relevant trade or industry as referring to silicone rubber coated sleeving.

5. The term “firesleeve” is a generic name for the goods set forth in the Registration, as well as other silicone rubber coated sleeves.

6. Alternatively, the term “firesleeve” is merely descriptive or deceptively misdescriptive of the goods set forth in the Registration.

7. The term “firesleeve” has not become distinctive in commerce of the goods set forth in the Registration or any other goods offered or sold by Respondent.

8. On information and belief, numerous third parties in the relevant trade or industry use the term “firesleeve” to refer to silicone rubber coated sleeving.

9. In Respondent's promotional materials, Respondent uses the term "firesleeve" in a generic and/or descriptive manner to refer to Respondent's silicone rubber coated sleeving products.

10. Petitioner is engaged in the manufacture and distribution of goods that are identical and related to the goods set forth in the Registration.

11. Petitioner has a present and prospective right to use the term "firesleeve" generically and/or descriptively in connection with the manufacture and distribution of its products and in connection with its other business activities.

12. Petitioner has been and continues to be damaged by continued registration of "FIRESLEEVE.COM" because it provides Respondent with *prima facie* evidence of the exclusive right to use "FIRESLEEVE.COM" in connection with Respondent's goods, which is inconsistent with Petitioner's right and the rights of other to use the term "firesleeve" in a generic and/or descriptive manner in connection with their goods and/or services.

WHEREFORE, Petitioner prays that U.S. Trademark Registration No. 2,836,133 be cancelled, and that this Petition to Cancel be sustained.

This Petition to Cancel is being filed electronically, along with the filing fee required by 37 C.F.R. § 2.6(a)(17). The Commissioner is authorized to draw on the Deposit Account of Fulbright & Jaworski L.L.P., Account No. 50-0624/10412242/MNM, if there is any problem with the processing of the electronically submitted fee.

Respectfully submitted,

Date: February 3, 2005



Mark N. Mutterperl
Patrick J. Gallagher
FULBRIGHT & JAWORSKI L.L.P.
666 Fifth Avenue, 31st Floor
New York, New York 10103-3198
Telephone: (212) 318-3000
Facsimile: (212) 318-3400

ATTORNEYS FOR PETITIONER