

ESTTA Tracking number: **ESTTA205876**

Filing date: **04/18/2008**

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

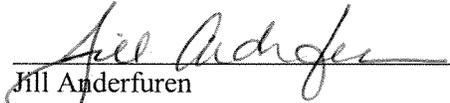
Proceeding	92049027
Party	Defendant Calumet Carton Co.
Correspondence Address	Calumet Carton Co. 16920 State Street South Holland, IL 60473 UNITED STATES
Submission	Motion to Suspend for Civil Action
Filer's Name	Jill Anderfuren
Filer's e-mail	janderfuren@marshallip.com
Signature	/ja/
Date	04/18/2008
Attachments	MOTION TO SUSPEND.pdf (25 pages)(1481735 bytes)

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

Box Packaging, Inc.)	
)	
Petitioner,)	Cancellation No. 92049027
)	
v.)	
)	
Calumet Carton Company,)	
)	
Registrant.)	

CERTIFICATE OF ELECTRONIC SUBMISSION

I hereby certify that this paper is being deposited electronically with the United States Patent and Trademark Office, on: April 18, 2008


Jill Anderfuren

Trademark Trial and Appeal Board
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

MOTION TO SUSPEND UNDER 37 CFR § 2.117(a) AND TBMP §510.02

Registrant, Calumet Carton Company, hereby moves to suspend pending the outcome of Civil Action No. 07 C 6389 in the United States District Court for the Northern District of Illinois, Eastern Division.

The civil action involves issues in common with this Cancellation Action. In support of this motion, attached herewith are copies of the following pleadings:

Exhibit 1) Original complaint

Exhibit 2) Answer and Counterclaim. The counterclaim includes allegations that the mark is generic and not entitled to federal registration, and the Defendant and Petitioner for Cancellation requests cancellation of the subject Registration No. 3,236,171.

Exhibit 3) Answer and Affirmative Defenses to Counterclaim

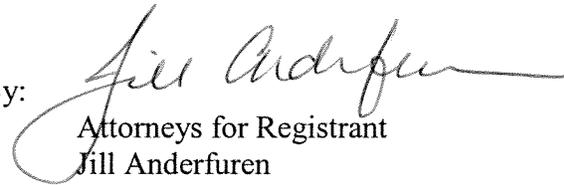
These pleading support suspension, as a final determination of the civil action will have a bearing on the issues before the Board.

Therefore, Registrant, Calumet Carton Company, requests suspension of this proceeding pending the determination of the pending civil action.

Respectfully submitted,

Dated: April 18, 2008

By:



Attorneys for Registrant
Jill Anderfuren
Richard M. LaBarge
Marshall, Gerstein & Borun LLP
6300 Sears Tower
233 South Wacker Drive
Chicago, IL 60606-6357
(312) 474-6300
Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a true and exact copy of the foregoing MOTION TO SUSPEND was mailed to the following person by first class mail, postage prepaid, and also sent by e-mail on April 18, 2008:

Mark V.B. Partridge
Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP
311 South Wacker Drive
Suite 500
Chicago, IL 60606

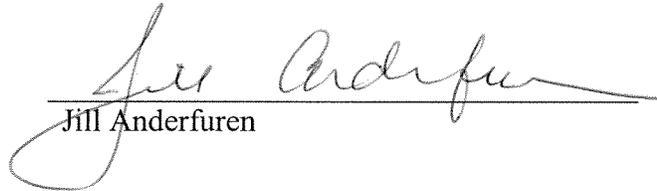

Jill Anderfuren

EXHIBIT 1

02127-25

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION**

07 C 6389

CALUMET CARTON COMPANY)	
)	
Plaintiff,)	
)	
v.)	No.
)	
B O X PACKAGING, INC.)	
)	
Defendant.)	

JUDGE DARRAH
MAGISTRATE JUDGE DENLOW

COMPLAINT

Plaintiff, CALUMET CARTON COMPANY, by its attorneys, LAWRENCE A. STEIN of HUCK BOUMA, PC, complains of defendant, B O X PACKAGING, INC., for trademark infringement, as follows:

1. Plaintiff is an Delaware corporation, authorized to conduct business in Illinois, with its principal place of business in South Holland, Illinois.
2. Defendant is an Illinois corporation with its principal place of business in Elgin, Illinois.
3. This action arises under the Trademark Act of 1946 (15 U.S.C. §§ 1051 *et seq.*)
4. This court has jurisdiction over the subject matter of this action pursuant to 15 U.S.C. § 1116(a).
5. Since approximately defendant has been continuously engaged, and is still engaged, in the business of selling packaging products under the trademark "StayFlats."
6. Plaintiff manufactures and sells packaging supplies throughout the United States.
7. Plaintiff is the owner of the trademark "StayFlats," which has been registered in the

United States Patent and Trademark Office under registration number 3,236,171.

8. An accurate copy of the registration certificate is attached as exhibit A.

9. The registration is in full force and effect, neither revoked nor canceled.

10. The trademark of plaintiff for “StayFlats” has been used continuously by the plaintiff since approximately 1986 in intrastate and interstate commerce.

11. Plaintiff has never abandoned any of its rights to the use of such trademark but, on the contrary, had diligently protected such rights.

12. Plaintiff has expended substantial resources in advertising its trademark “StayFlats” as identifying its unique packaging product.

13. As a result of the extensive advertising of plaintiff, and of the efforts expended and expenses incurred by the plaintiff, in improving its packaging increasing its sales throughout the United States, plaintiff, has built up a highly valuable reputation and good will and the public generally has come to recognize and know the trademark “StayFlats” as being identified with the plaintiff and its business.

14. Commencing in or around 2005, and continuing thereafter, defendant has marked a product not manufactured by the plaintiff as “StayFlats” that infringes on the trademark registration of the plaintiff.

15. An accurate copy of an example of the defendant’s infringement of the plaintiff’s Trademark for “StayFlats,” retrieved from the defendant’s website on November 9, 2007, just before filing this complaint is attached as exhibit B.

16. The defendant’s infringement of the plaintiff’s trademark for “StayFlats,” was in order to appropriate, and defendant has appropriated, the good will and reputation that plaintiff has

acquired for its “StayFlats” product and it has conveyed the false impression that the products of the defendant was manufactured by, or affiliated with, plaintiff.

17. The action of the defendants has been undertaken with the full knowledge of the rights of the plaintiff without any commercial necessity therefor, and with a fraudulent and unfair intent and purpose.

18. The marketing by the defendant of its products as “StayFlats” constitutes an infringement of the trademark of the plaintiff and an unfair trading on the good will and reputation of the plaintiff by use of its trademark.

19. Plaintiff has been damaged by the defendant’s acts, which have caused injury to the reputation of “StayFlats.”

20. Plaintiff has also lost profits as a result of the defendant’s acts in that members of the public have purchased the packaging products and supplies of the defendant in the belief that it was manufactured by plaintiff or that it was sponsored by plaintiff or that the defendant was affiliated with or sponsored by the plaintiff.

21. The damages suffered by plaintiff are irreparable and will continue unless the defendants are restrained by this court from the commission of the above described acts.

22. Plaintiff is without an adequate remedy at law, in that the continuing nature of the infringement and unfair competition will necessitate a multiplicity of suits to repair the injuries plaintiff will sustain unless the injunction sought in its complaint is granted.

23. On August 24, 2007, the plaintiff wrote to the defendant informing them of the plaintiff’s rights. However, the defendant continued to infringe on the plaintiff’s trademark thereafter, proving the intentionally wrongful conduct of the defendant.

23. A copy of the letter of August 24, 2007 is attached as exhibit C.

24. Plaintiff demands trial by jury.

WHEREFORE, plaintiff, CALUMET CARTON COMPANY, demand preliminary and permanent injunctive relief against defendant, BOX PACKAGING, INC., prohibiting the continued violation of the trademark, requiring an accounting for damages, assessing damages in the amount of three times of the damages sustained, the reasonable and necessary attorney's fees incurred in preparing presenting and enforcing this action, and all other relief deemed appropriate under the circumstances.

Respectfully submitted,

HUCK BOUMA PC

/s/ Lawrence A. Stein

Lawrence A. Stein

Lawrence A. Stein
HUCK BOUMA PC
1755 South Naperville Road
Wheaton, Illinois 60187
Telephone (630) 221-1755
Facsimile (630) 221-1756

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Int. Cl.: 16

Prior U.S. Cls.: 2, 5, 22, 23, 29, 37, 38 and 50

United States Patent and Trademark Office

Reg. No. 3,236,171

Registered May 1, 2007

**TRADEMARK
PRINCIPAL REGISTER**

STAYFLATS

CALUMET CARTON CO. (DELAWARE COR-
PORATION)

16920 STATE STREET

SOUTH HOLLAND, IL 60473

FOR: RIGID ENVELOPES AND RIGID PAPER-
BOARD MAILING POUCHES, IN CLASS 16 (U.S.
CLS. 2, 5, 22, 23, 29, 37, 38 AND 50).

FIRST USE 4-9-1985; IN COMMERCE 4-9-1985.

THE MARK CONSISTS OF STANDARD CHAR-
ACTERS WITHOUT CLAIM TO ANY PARTICULAR
FONT, STYLE, SIZE, OR COLOR.

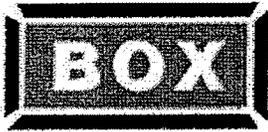
OWNER OF U.S. REG. NO. 1,570,925.

SEC. 2(F).

SER. NO. 78-738,869, FILED 10-24-2005.

JENNIFER VASQUEZ, EXAMINING ATTORNEY

EXHIBIT A



- [Home](#)
- [Products](#)
- [Place Order](#)
- [Open Orders](#)
- [Invoices](#)
- [Freight Estimator](#)
- [Price Lists](#)
- [Custom Quotes](#)
- [Shopping Cart Websites](#)
- [Web Products Link](#)
- [E-Mail Blast Program](#)
- [Catalogs](#)
- [Product Flyers](#)
- [Manage Users](#)
- [My Account](#)
- [Contact Us](#)

B O X Packaging, Inc.

[Products](#) > [Mailing Bags & Envelopes](#) > [Stay Flats Mailers](#)

Distributor Login

User ID:

Password:

Featured Vendors

CENTRAL
AUTHORIZED WHOLESALER

GP Georgia-Pacific
Authorized Wholesaler

Scaled Air
Authorized Wholesaler

Better Pack®
Authorized Wholesaler

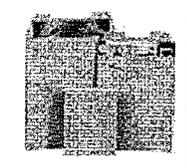
3M Authorized Wholesaler

REVOLUTION
AUTHORIZED WHOLESALER

MARSH
Authorized Wholesaler

AUTHORIZED INTERNATIONAL PAPER WHOLESALER

GOODWRAPPERS
AUTHORIZED WHOLESALER



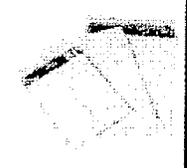
[Kraft Stay Flats Mailers](#)



[Kraft Stay Flats Mailers - Self Seal](#)



[White Stay Flats Mailers](#)



[White Stay Flats Mailers - Self Seal](#)



[Gusseted White Stay Flats Mailers](#)



[Side Loading White Stay Flats Mailers](#)

EXHIBIT B



P.O. BOX 405
16920 STATE STREET
SOUTH HOLLAND, IL 60473
TEL: 708-333-6521
FAX: 888-333-8540

FOLDING CARTONS AND STAYFLATS® MAILERS
DIGITAL, KRAFT AND MICRO-CORR™ PACKAGING

August 24, 2007

David Burbrink
B O X Packaging
2650 Galvin Drive
Elgin, IL 60123

Dear Dave,

I am sending this letter to you as a follow up to our conversation. We discussed the matter of Calumet Carton Company's trademarks, STAYFLATS® and STAYFLATS PLUS® Mailers, and the use of them on your company's website. I do not wish there to be any confusion that we at Calumet Carton consider this a very important matter to us, as it should be to you.

As a current customer, you are aware of the fact that Calumet Carton has been selling its STAYFLATS® brand of mailers nationwide for the past several decades. When people see the STAYFLATS® brand, they have an expectation that Calumet Carton will stand behind its product. We are proud of the reputation that we enjoy in the market as a manufacturer of quality mailing supplies, and in particular of the excellent reputation that we have developed for the STAYFLATS® brand mailer.

When we sell a STAYFLATS® mailer to a customer that resells the product, the retailer should be able to expect that they have a right to use our mark in their advertising. Of course, that right is not without limit. For example, the mark may only be used in connection with genuine STAYFLATS® mailers. Nor would we expect a retailer to use our mark in their promotions on a website or search engine listings to offer something other than genuine STAYFLATS® mailers.

In reviewing your website recently (copies of web pages enclosed), we noticed your use of the "Stayflats Mailers" mark, as well as the phrases "Stayflat mailers" or "Stay flat mailers" throughout the site. These uses would be permissible if they were used to sell genuine STAYFLATS® brand mailers. However, as we discussed, most of these items currently being bought from a different manufacturer and not Calumet Carton.

EXHIBIT C



P.O. BOX 405
16920 STATE STREET
SOUTH HOLLAND, IL 60473
TEL: 708-333-6521
FAX: 888-333-8540

FOLDING CARTONS AND STAYFLATS® MAILERS
DIGITAL, KRAFT AND MICRO-CORR™ PACKAGING

We find the use of the STAYFLATS® mark with a product that is not a genuine STAYFLATS® brand mailer to be very disappointing. Of course, if you were to sell only genuine STAYFLATS® brand mailers to your customers, there would be no problem.

We are respectfully requesting that all of BOX Packaging's promotional material, catalog, website and all other products use our trademarks only when referencing the products you actually purchase from us. Other products from a different manufacturer should not use Calumet Carton's intellectual property in any manner

I would appreciate a call back within the next 7 days to confirm receipt of our request and discuss plans to address our concerns.

Sincerely,

A handwritten signature in cursive script, appearing to read 'Doug Grever'.

Doug Grever
Sales Manager

EXHIBIT 2

RECEIVED

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

FEB 27 2008

MICHAEL W. DOBBINS
CLERK, U.S. DISTRICT COURT

CALUMET CARTON COMPANY,)	
)	Civil Action No 07 C 6389
Plaintiff,)	
)	Hon. John W. Darrah
v.)	
)	Magistrate Judge Morton Denlow
BOX PACKAGING, INC.,)	
)	
Defendant.)	

ANSWER AND COUNTERCLAIM

1. Plaintiff is an [sic] Delaware corporation, authorized to conduct business in Illinois, with its principal place of business in South Holland, Illinois.

ANSWER: Admitted.

2. Defendant is an Illinois corporation with its principal place of business in Elgin, Illinois.

ANSWER: Admitted

3. This is an action under the Trademark Act of 1946, (15 U.S.C. §§ 1051, et seq.)

ANSWER: Admitted

4. This court has jurisdiction over the subject matter of this action pursuant to 15 U.S.C. § 1116(a).

ANSWER: Admitted.

5. Since approximately defendant [sic] has been continuously engaged, and is still engaged, in the business of selling packaging products under the trademark "StayFlats."

ANSWER: Defendant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 5 of the Complaint and therefore denies those allegations.

6. Plaintiff manufactures and sells packaging supplies throughout the United States.

ANSWER: Defendant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 6 of the Complaint and therefore denies those allegations.

7. Plaintiff is the owner of the trademark "StayFlats," which has been registered in the United States Patent and Trademark Office under registration number 3,236,171.

ANSWER: Defendant admits that a document purporting to be registration number 3,236,171 has been registered by plaintiff, but denies that Plaintiff owns an enforceable rights in the generic, common descriptive phrase "Stay Flats".

8. An accurate copy of the registration certificate is attached as exhibit A.

ANSWER: Defendant admits that a document purporting to be registration 3,236,171 is attached as exhibit A.

9. The registration is in full force and effect, neither revoked nor canceled.

ANSWER: Defendant admits that the registration exists on the Trademark Office registry, but denies that registration is valid or enforceable.

10. The trademark of plaintiff for "StayFlats" has been used continuously by the plaintiff since approximately 1986 in intrastate and interstate commerce.

ANSWER: Defendant denies that "Stay Flats" is an enforceable trademark. Defendant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations of Paragraph 10 of the Complaint and therefore denies the same.

11. Plaintiff has never abandoned any of its rights to the use of such trademark but, on the contrary, had diligently protected such rights.

ANSWER: Defendant denies that "Stay Flats" is an enforceable trademark. Defendant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations of Paragraph 11 of the Complaint and therefore denies the same.

12. Plaintiff has expended substantial resources in advertising its trademark "StayFlats" as identifying its unique packaging product.

ANSWER: Defendant denies that "Stay Flats" is an enforceable trademark. Defendant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations of Paragraph 13 of the Complaint and therefore denies the same.

13. As a result of the extensive advertising of plaintiff, and of the efforts expended and expenses incurred by the plaintiff, in improving its packaging increasing [sic] its sales throughout the United States, plaintiff, has built up a highly valuable reputation and good will and the public generally has come to recognize and know the trademark "StayFlats" as being identified with the plaintiff and its business.

ANSWER: Defendant denies that the public generally has come to recognize and know "StayFlats" as identified with plaintiff and its business, and denies that "Stay Flats" is an enforceable trademark. Defendant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations of Paragraph 13 of the Complaint and therefore denies the same.

14. Commencing in or around 2005, and continuing thereafter, defendant has marked a product not manufactured by the plaintiff as "StayFlats" as being identified with the plaintiff and its business.

ANSWER: Defendant admits that it has used the merely descriptive phrase "Stay Flats" in its ordinary descriptive sense to identify "Stay Flats" mailers that are not manufactured by Plaintiff since about 2005.

15. An accurate copy of an example of the defendant's infringement of the plaintiff's Trademark for "StayFlats," retrieved from the defendant's website on November 9, 2007, just before filing this complaint is attached as exhibit B.

ANSWER: Defendant denies that its use of the merely descriptive phrase "Stay Flats" is an infringement or that "Stay Flats" is an enforceable trademark. Defendant admits that exhibit B of the Complaint is an example of materials previously but no longer available on Defendant's website. Defendant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 15 of the Complaint and therefore denies the same.

16. The defendant's infringement of the plaintiff's trademark for "StayFlats," was in order to appropriate, and defendant has appropriated, the good will and reputation that plaintiff has acquired for its "StayFlats" product and it has conveyed the false impression that the products of the defendant was manufactured by, or affiliated with, plaintiff.

ANSWER: Defendant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 16 of the Complaint and therefore denies the same.

17. The action of the defendants has been undertaken with the full knowledge of the rights of the plaintiff without any commercial necessity therefor, [sic] and with a fraudulent and unfair intent and purpose.

ANSWER: Denied.

18. The marketing by the defendant of its product as "StayFlats" constitutes an infringement of the trademark of the plaintiff and an unfair trading on the good will and reputation of the plaintiff by use of its trademark.

ANSWER: Denied.

19. Plaintiff has been damaged by the defendant's acts, which have caused injury to the reputation of "StayFlats."

ANSWER: Denied.

20. Plaintiff has also lost profits as a result of the defendant's acts in that members of the public have purchased the packaging products and supplies of the defendant in the belief that it was manufactured by plaintiff or that it was sponsored by plaintiff or that the defendant was affiliated with or sponsored by the plaintiff.

ANSWER: Defendant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 20 of the Complaint and therefore denies the same.

21. The damages suffered by the plaintiff are irreparable and will continue unless the defendants are restrained by this court from the commission of the above described acts.

ANSWER: Defendant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 21 of the Complaint and therefore denies the same.

22. Plaintiff is without an adequate remedy at law, in that the continuing nature of the infringement and unfair competition will necessitate a multiplicity of suits to repair the injuries plaintiff will sustain unless the injunction sought in its complaint is granted.

ANSWER: Defendant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 22 of the Complaint and therefore denies the same.

23. On August 24, 2007, the plaintiff wrote to the defendant informing them of the plaintiff's rights. However, the defendant continued to infringe on the plaintiff's trademark thereafter, proving the intentionally wrongful conduct of the defendant.

ANSWER: Defendant admits that Plaintiff wrote to Defendant to assert its claim, but denies that Defendant has continued to engage in the allegedly infringing conduct or that Plaintiff owns an enforceable trademark in "StayFlats." Defendant denies the remaining allegations of Paragraph 23. Defendant avers that it has ceased use of "Stay Flats" in response to Plaintiff's objection.

23. A copy of the letter of August 24, 2007, is attached as Exhibit C.

ANSWER: Defendant admits that a copy of Plaintiff's letter of August 24, 2007, is attached as exhibit C.

24. Plaintiff demands trial by jury.

ANSWER: This Paragraph is not an allegation and no response is required.

AFFIRMATIVE DEFENSES

1. Plaintiff's alleged mark is widely used in the packaging industry as a common descriptive or generic term for mailers that stay flat; and therefore is not entitled to protection as a trademark.

2. Plaintiff's alleged mark merely describes the characteristics of stay flat mailers and lacks distinctiveness or secondary meaning as an indication of source; and therefore is not entitled to protection as a trademark.

3. Defendant used "Stay Flats" as a merely descriptive term to fairly describe mailers that stay flat, and not as a trademark; and therefore Defendant's use of "Stay Flats" constitutes fair use.

4. Defendant has been a customer of Plaintiff and other manufactures of packaging materials for many years and openly used "Stay Flats" to describe mailers from various manufacturers that stay flat for many years. On information and belief, Plaintiff had knowledge of such use but did not object for many years; and therefore Plaintiff's claims are barred by the doctrine of laches, acquiescence or waiver.

5. Plaintiff has failed to state a claim upon which relief can be granted.

COUNTERCLAIM

1. Defendant realleges the factual allegations of Paragraphs 1 through 4 of the Complaint and Answer as fully set forth here.

2. The alleged mark "StayFlats" is commonly used in the packaging material industry as a common descriptive or generic term for mailers that stay flat.

3. Plaintiff has commonly used the alleged mark "StayFlats" in its advertising materials as a common descriptive or generic term.

4. As a generic term, "StayFlats" is not entitled to federal registration as a trademark with the United States Patent and Trademark Office.

5. The alleged mark "StayFlats" is a merely descriptive term for mailers that stay flat and lacks distinctiveness or secondary meaning as an indication of source.

6. As a descriptive non-distinctive term, "StayFlats" is not entitled to federal registration as a trademark on the principal register of the United States Patent and Trademark Office.

7. Defendant is entitled to use "StayFlats" as a common descriptive or merely descriptive phrase for mailers that stay flat, and therefore believes that it has been and will be

damaged by the registration of "StayFlats" by Plaintiff on the principal register of the United States Patent and Trademark Office.

WHEREFORE, Defendant requests that this Court

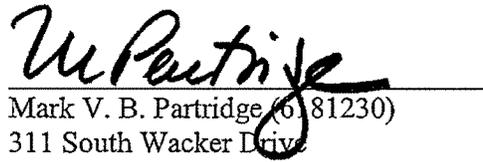
1. Grant judgment in Defendant's favor on all claims asserted by Plaintiff.
2. Order that Registration No. 3,236,171 be cancelled in accordance with 15 U.S.C. §§ 1052 (e) and (f); 1064; and 1119;
3. Award Defendant its reasonable costs and fees, including all attorney's fees incurred in the action in accordance with 15 U.S.C. § 1117; and
4. Grant such other relief as this Court deems just.

Dated: February 27, 2008

Respectfully submitted,

PATTISHALL, McAULIFFE, NEWBURY,
HILLIARD & GERALDSON LLP

By:



Mark V. B. Partridge (618) 81230)

311 South Wacker Drive

Suite 5000

Chicago, Illinois 60606

(312) 554-8000

(312) 554-8015 (facsimile)

Attorneys for Defendant Box Packaging, Inc.

EXHIBIT 3

02127-25

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION**

CALUMET CARTON COMPANY)	
)	
Plaintiff,)	
)	
v.)	No. 07 C 6389
)	
BOX PACKAGING, INC.)	
)	
Defendant.)	

ANSWER AND AFFIRMATIVE DEFENSES TO COUNTERCLAIM

Plaintiff, CALUMET CARTON COMPANY, by its attorney, Lawrence A. Stein of HUCK BOUMA PC, answers the counterclaim of the defendant, BOX PACKAGING, INC., as follows:

1. Defendant realleges the factual allegations of paragraphs 1 through 4 of the complaint and answer as fully set forth here.

ANSWER: Plaintiff admits that the defendant has realleged the factual allegations of paragraphs 1 through 4 of the complaint and answer and notes for the court that those allegations are admitted by the defendant.

2. The alleged mark "StayFlats" is commonly used in the packaging material industry as a common descriptive or generic term for mailers that stay flat.

ANSWER: Plaintiff denies the allegations of paragraph 2.

3. Plaintiff has commonly used the alleged mark "StayFlats" in its advertising materials as a common descriptive or generic term.

ANSWER: Plaintiff denies the allegations of paragraphs 3.

4. As a generic term, “StayFlats” is not entitled to federal registration as a trademark with the United States Patent and Trademark Office.

ANSWER: Plaintiff denies the allegations of paragraph 4.

5. The alleged mark “StayFlats” is a merely descriptive term for mailers that stay flat and lacks distinctiveness or secondary meaning as an indication of source.

ANSWER: Plaintiff denies the allegations of paragraph 5.

6. As a descriptive non-distinctive term, “StayFlats” is not entitled to federal registration as a trademark on the principal register of the United States Patent and Trademark Office.

ANSWER: Plaintiff denies the allegations of paragraph 6.

7. Defendant is entitled to use “StayFlats” as a common descriptive or merely descriptive phrase for mailers that stay flat, and therefore believes that it has been and will be damaged by the registration of “StayFlats” by plaintiff on the principal register of the United States Patent and Trademark Office.

ANSWER: Plaintiff denies the allegations of paragraph 7.

ANSWER AND AFFIRMATIVE DEFENSES

As their affirmative defenses to the plaintiff’s amended complaint, defendants state as follows:

1. Defendant has waived its right to, and is estopped from asserting its, claims for relief.
2. Defendant has failed to state a cause of action upon which relief can be granted.
3. Defendant’s claims are barred by limitations.
4. Defendant’s claims are barred by the doctrine of laches.

WHEREFORE, plaintiff, CALUMET CARTON COMPANY, requests judgment in its favor,

and for its costs, and for all other relief deemed appropriate under the circumstances.

Respectfully submitted,

HUCK BOUMA PC

/s/ Lawrence A. Stein

Lawrence A. Stein

Lawrence A. Stein
HUCK BOUMA PC
1755 South Naperville Road
Wheaton, Illinois 60187
Telephone (630) 221-1755
Facsimile (630) 221-1756