

ESTTA Tracking number: **ESTTA597584**

Filing date: **04/09/2014**

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	Duraframe, LLC		
Entity	Corporation	Citizenship	New York
Address	610 Salt Road Webster, NY 14580 UNITED STATES		

Attorney information	Katherine H. McGuire, Esq. Woods Oviatt Gilman LLP 2 State Street 700 Crossroads Building Rochester, NY 14614 UNITED STATES trademarks@woodsoviatt.com Phone:585-987-2800		
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Registration Subject to Cancellation

Registration No	2215593	Registration date	12/29/1998
Registrant	Radius Track Corporation Suite G Coon Rapids, MN 55433 MONGOLIA		

Goods/Services Subject to Cancellation

Class 006. First Use: 1997/01/15 First Use In Commerce: 1997/01/15 All goods and services in the class are cancelled, namely: curved wall and ceiling frame member made of metal

Grounds for Cancellation

Genericness	Trademark Act section 23
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Attachments	petitiontocancel.pdf(216077 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Katherine H. McGuire/
Name	Katherine H. McGuire, Esq.
Date	04/09/2014

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

In the matter of U.S. Trademark Registration No. 2,215,593
For the mark: RADIUS TRACK
Date registered on Supplemental Register: December 29, 1998

DURAFRAME, LLC

Petitioner,

Cancellation No.:

v.

RADIUS TRACK CORPORATION,

Registrant.

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

PETITION TO CANCEL

1. Duraframe, LLC ("Petitioner"), is a New York Limited Liability Company having a principal place of business at 610 Salt Road, Webster, NY 14580.
2. To the best of Petitioner's knowledge, the name and address of the Registrant is Radius Track Corporation having a business address at 9320 Evergreen Boulevard Northwest, Suite G, Minneapolis, MN 55433.
3. Petitioner believes that it will be damaged by Trademark Registration No. 2,215,593 ("the '593 Registration") for the mark Radius Track ("the Mark"), and hereby petitions to cancel the same. Petitioner's statement of standing and the grounds for cancellation are as follows:

I. PETITIONER HAS STANDING

4. Petitioner received a letter dated March 21, 2014 from the law office of Haugen Law Firm LLP stating that the firm represents Radius Track Corporation and that:

Our client's Radius Track trademark is also improperly and without authorization used in the duraframesolutions.com website. A printout from a product description page from the duraframesolutions.com website improperly using the RADIUS TRACK trademark in a generic sense is attached hereto as Exhibit C. . .

In view of the above, we demand that FrameCo and Duraframe immediately cease its use of the RADIUS TRACK trademark, as set forth above, including by immediately and permanently removing all instances of the RADIUS TRACK mark and all confusingly similar words or phrases from all text, meta tags, title tags, meta data, and/or source code of the framecoframing.com and duraframesolutions.com websites.

5. By virtue of receiving the above-referenced trademark cease and desist letter from Registrant, Petitioner has standing to bring the instant petition.

II. REGISTRANT'S MARK IS GENERIC

6. Petitioner repeats and realleges the allegations of paragraphs "1" through "5" as if more fully set forth herein.
7. Registrant's mark RADIUS TRACK lists the following goods classified in IC006 in the '593 Registration: "Curved wall and ceiling frame member made of metal."
8. The above-mentioned cease and desist letter claims that Petitioner herein is using the mark "in a generic sense".
9. The '593 Registration is based on Serial Number 75315627 filed on June 17, 1997. A first office action ("the Action") was issued on March 13, 1998. The Action cited two grounds of rejection: 1) mark being used solely as a trade name, and not as a trademark; and 2) the mark being merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1).

10. In discussing the rejection based on descriptiveness, the examiner cited U.S. Patent Nos. 4,095,641 (“the ‘641 patent”) and 5,655,345 (“the ‘345 patent”) and underlined the words “radius track” and “radius track member” therein, respectively.

11. In the ‘641 patent, the words “radius track” are used in the following passage:

“Tracks 112 are installed in conventional manner after first being cut to the proper length. It must, of course, be ensured that the cable drums 120 clear the ceiling but any radius track will work with the fitting of the present invention.” (See Col. 6, Lns. 1-5).

12. In the ‘345 patent, the words “radius track member” is use in the following passage and references the part labeled “40” in the drawing Fig. 6 which is reproduced below:

As can best be seen by reference to FIG. 6, each of the tier base support units (10) comprises a plurality of generally rigid tie members (20) connected to one or more generally flexible track members (40) (41); wherein, in the preferred embodiment of the invention the tie members (20) are connected to both of the track members (40) (41); and, in an alternate version of the invention the tie members (20) are only connected to the inside radius track member (40). (See Col. 2, Lns. 32-39).

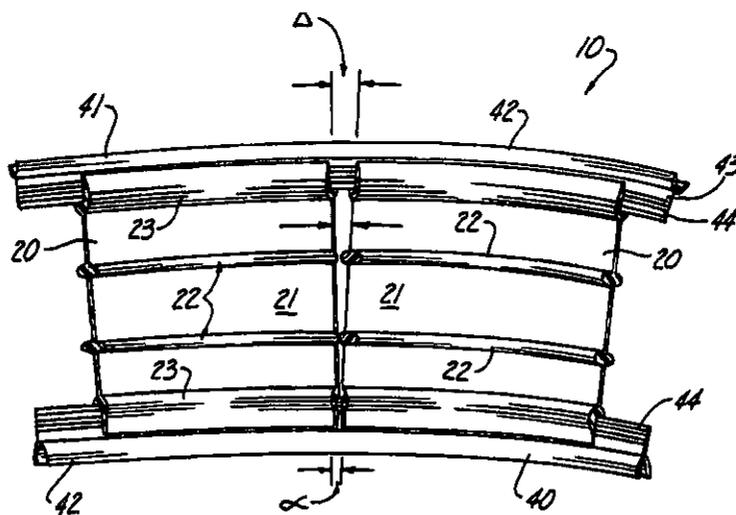


Fig. 6

13. There is a two-part test used to determine whether a designation is generic: (1) What is the genus of goods or services at issue? and (2) Does the relevant public understand the designation primarily to refer to that genus of goods or services? (See TMEP 1209.01).

14. The genus of goods at issue is metal members which are shaped to include a radius of curvature and to which other items attach or connect.

15. As the above cited patents reveal, this type of member is referred to as "radius track".

The words "radius track" are thus not merely describing a characteristic or quality of the goods, rather, they together constitute the actual name others use to name the goods at issue and hence the words "radius track" are generic.

16. In addition to Petitioner and the above cited patents, others in the relevant public commonly refer to the above genus of goods as "radius track" in a non-trademark sense as exemplified in the following:

<http://www.hopkinsre.com/remodel/dome.htm>: "Framing the Inner Circle for the ledge with radius track and short metal Studs I cut. Each one has 4 screws... TEDIOUS! (See the PVC in center, This is homeade Bullnose cap, since the Drywall supply does not manufacture 8" round bullnose cap.)"

http://www.jlconline.com/walls-and-ceilings/two-simple-curved-walls_2.aspx: For the curved wall plates, we used a product called Flex-C Trac (Flex-Ability Concepts; P.O. Box 7145, Edmond, OK 73083; 405/302-0611; www.flexc.com). This is a lightweight, flexible metal channel that comes in 10-foot lengths that join together easily for longer walls. We snapped two sections of Flex-C Trac together, curved the track to correspond to the radius we had drawn on the subfloor, then cut the track to length.

III. THE APPLICATION ON WHICH THE '593 REGISTRATION IS BASED WAS EFFECTIVELY ABANDONED AND SHOULD NOT HAVE PROCEEDED TO REGISTRATION

17. Petitioner repeats and realleges the allegations of paragraphs "1" through "16" as if more fully set forth herein.

18. Registration No. 2,215,593 is based on Serial Number 75315627 filed on June 17, 1997. A first office action ("the Action") was issued on March 13, 1998 citing two grounds of rejection: 1) mark being used solely as a trade name, and not as a trademark; and 2) the mark

being merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1). The front page of the Action included the following statement:

**A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED
WITHIN SIX MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO
AVOID ABANDONMENT**

(emphasis in original).

19. Thus, a proper response must have been filed by September 13, 1998 in order to avoid abandonment.
20. While the Applicant filed a response on September 10, 1998, it was not a complete response.
21. Applicant's response filed on September 10, 1998 failed to address the merely descriptive rejection under Trademark Act 2(e)(1).
22. The statute regarding improper responses to trademark office actions is as follows:

37 C.F.R. §2.65

(a) If an applicant fails to respond, *or to respond completely*, within six months after the date an action is issued, *the application shall be deemed abandoned* unless the refusal or requirement is expressly limited to only certain goods and/or services. If the refusal or requirement is expressly limited to only certain goods and/or services, the application will be abandoned only as to those particular goods and/or services. A timely petition to the Director pursuant to §§2.63(b) and 2.146 or notice of appeal to the Trademark Trial and Appeal Board pursuant to §2.142, if appropriate, is a response that avoids abandonment of an application. (Emphasis added).

(b) When action by the applicant filed within the six-month response period is a bona fide attempt to advance the examination of the application *and is substantially a complete response to the examiner's action*, but consideration of some matter or compliance with some requirement has been inadvertently omitted, opportunity to explain and supply the omission may be given before the question of abandonment is considered.

Under 15 U.S.C. §1062(b) and 37 C.F.R. §2.65(a), an applicant must respond completely to each issue raised in the examining attorney's Office action to avoid abandonment. A response is incomplete if it: (1) does not address one or more of the requirements or refusals made in the Office action; (2) is unsigned; (3) is signed by an unauthorized person; or (4) is a response to a final action that does not overcome all refusals or satisfy all requirements, when the response period has expired, and the applicant has

not timely filed a notice of appeal. See TMEP §715.03(a).

23. Having failed to address a major basis for rejection, Applicant's response filed on September 10, 1998 was incomplete and was not a substantially complete response.
24. Having failed to comply with 37 C.F.R. §2.65 statutory requirements regarding a proper response, the application was effectively abandoned one day after the 6 month due date for response, i.e., the application was effectively abandoned on September 14, 1998.
25. A telephone interview between examiner and Applicant's attorney was held on October 16, 1998 wherein authorization was given to the examiner to amend the application to the Supplemental Register which resulted in the passage of the application to registration.
26. The date of the amendment to the Supplemental Register was after the response due date of September 13, 1998.
27. Since the application was already effectively abandoned as of September 14, 1998, prosecution was closed and the amendment to the Supplemental Register more than one month later was improper and the resultant registration is void.

IV. AT BEST, THE MARK IS MERELY DESCRIPTIVE OF THE GOODS

28. Petitioner repeats and realleges the allegations of paragraphs "1" through "25" as if more fully set forth herein.
29. The following is a paragraph copied from petitioner's website duraframesolutions.com:

Curv-Trak is the answer in *radius track* for the drywall framing industry. The Curv-Trak design consultancy team can offer innovative solutions to your needs on site, from curved steel stud and track to assembling whole soffit frames. With the expertise and ability to curve sections from 2-1/2" 25 ga to 8" 12ga in track, stud, angle and framing our team has the solutions for the most complex curved surfaces.
30. The paragraph reproduced in section 26 above shows Petitioner use of the words "radius track" in a manner which indicates the goods which it sells, namely, metal members which have a radius

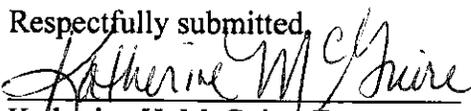
of curvature.

31. The '593 Registration is on the Supplemental Register by virtue of the examiner having found the Mark to be merely descriptive of the goods to which they relate.
32. Registrant tacitly acknowledges the merely descriptive nature of the Mark as the Registrant has, as of the time of filing of the instant petition, failed to submit an application to the USPTO seeking to place the Mark on the Principal Register.
33. Should Registrant's attempts to obtain and enforce exclusive rights to use the words "radius track", Petitioner and others would be prevented from using the descriptive term "radius track" to describe the goods which they sell and which would thereby give Registrant an unfair competitive advantage in the marketplace.

By reason of the foregoing, Petitioner would be damaged by the continued registration of RADIUS TRACK to Registrant.

WHEREFORE, it is respectfully requested that this Petition to Cancel be granted and that the Registration No. 2,215,593 be canceled, and for such other and further relief as is deemed just and proper.

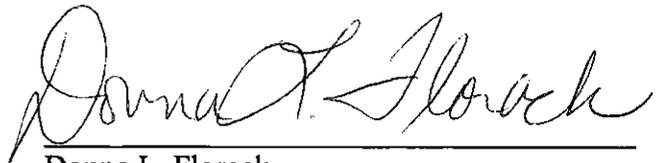
Dated: Rochester, New York
April 9, 2014

Respectfully submitted,

Katherine H. McGuire, Esq.
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Certificate of Service

I hereby certify that a true and complete copy of the foregoing Petition to Cancel in regard to Registration No. 2,215,593 has been served on the Registrant, Radius Track Corporation, by mailing said copy on April 9, 2014 via First Class Mail, postage prepaid, to:

Mark J. Burns
Haugen Law Firm PLLP
121 S. Eighth Street
1130 TCF Tower
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