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

Proceeding.	92060608
Applicant	Defendant Elmer's Products, Inc.
Other Party	Plaintiff DAP Products, Inc.
Have the parties held their discovery conference as required under Trademark Rules 2.120(a)(1) and (a)(2)?	No

### **Motion for Suspension in View of Civil Proceeding With Consent**

The parties are engaged in a civil action which may have a bearing on this proceeding. Accordingly, Elmer's Products, Inc. hereby requests suspension of this proceeding pending a final determination of the civil action. Trademark Rule 2.117.

Elmer's Products, Inc. has secured the express consent of all other parties to this proceeding for the suspension and resetting of dates requested herein.

Elmer's Products, Inc. has provided an e-mail address herewith for itself and for the opposing party so that any order on this motion may be issued electronically by the Board.

### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Facsimile or email (by agreement only) on this date.

Respectfully submitted,  
/Brian P. Gregg/  
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01/30/2015

**IN THE UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF OHIO  
EASTERN DIVISION**

ELMER'S PRODUCTS, INC.	:	
	:	
Plaintiff	:	Case No. 2:14-CV-1988
	:	
v.	:	
	:	
DAP PRODUCTS INC.	:	
	:	
Defendant.	:	

**DEFENDANT DAP PRODUCTS INC.'S ANSWER, AFFIRMATIVE DEFENSES, AND  
COUNTERCLAIM**

Defendant DAP Product Inc. ("DAP"), by and through its undersigned counsel, submits its Answer, Affirmative Defenses, and Counterclaim to the Complaint and states as follows:

**THE PARTIES**

1. DAP is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 1 of the Complaint and therefore DAP denies same.
2. DAP admits that the allegations contained in Paragraph 2 of the Complaint.

**JURISDICTION AND VENUE**

3. Paragraph 3 states legal conclusions to which no response is required; and, to the extent any response is required, DAP denies the allegations contained within said paragraph.
4. Paragraph 4 states legal conclusions to which no response is required; and, to the extent any response is required, DAP denies the allegations within said paragraph.
5. Paragraph 5 states legal conclusions to which no response is required; and, to the extent any response is required, DAP denies the allegations contained within said paragraph.

6. DAP admits that it conducts business in Ohio. The remainder of Paragraph 6 states legal conclusions to which no response is required; and, to the extent any response is required, DAP denies the allegations contained within said paragraph.

**FACTUAL ALLEGATIONS COMMON TO ALL COUNTS**

7. DAP admits the allegations set forth in Paragraph 7 of the Complaint.

8. DAP is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 8 and therefore denies same.

9. DAP is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 9 and therefore denies same.

10. Paragraph 10 states a legal conclusion to which no response is required; and, to the extent any response is required, DAP denies the allegations contained within said paragraph.

11. DAP is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 11 and therefore denies same.

12. DAP is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 12 and therefore denies same.

13. DAP is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 13 and therefore denies same.

14. DAP is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 14 and therefore denies same.

15. DAP is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 15 and therefore denies same.

16. DAP is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 16 and therefore denies same.

17. DAP admits that Elmer's did not and has not authorized DAP to use any trademarks that contain the "carpenter's" element but denies that such authorization is required.

**DAP's Use of CARPENTER'S**

18. DAP admits that it is engaged in the manufacture and distribution of wood glue and wood filler, among many other products.

19. DAP admits that it uses the term, "Carpenter's" in association with its wood glue and wood filler products. DAP admits that Exhibit C contains photographs of DAP products.

20. DAP denies that it uses CARPENTER'S to identify the source of its products and admits that it began referring to some of its products as "Carpenter's" after the alleged dates of first use by Elmer's. DAP denies that it began referring to its wood glue products as "Carpenter's" after the filing dates of each of Elmer's applications to register CARPENTER'S and admits that it began referring to its wood filler products as "Carpenter's" after the filing dates of each of Elmer's applications to register CARPENTER'S.

21. DAP admits that the terms CARPENTER'S and "Carpenter's" are phonetically identical.

22. DAP denies that it has CARPENTER'S branded products and admits that DAP and Elmer's distribute some of their products through the same channels of trade.

23. DAP admits that both Elmer's and DAP use the term "carpenter's" on packaging for some of their products. DAP denies that these uses are as trademarks.

24. DAP admits that both Elmer's and DAP's products can be purchased by the same consumers. DAP denies any inference that the use of "carpenter's" by either party is as a trademark.

25. Paragraph 25 contains legal conclusions to which no response is required. To the extent that Paragraph 25 contains statements or inferences of fact, they are denied.

26. Paragraph 26 states legal conclusions to which no response is required. To the extent that Paragraph 26 contains statements or inferences of fact, they are denied.

27. DAP denies the allegations contained in Paragraph 27 of the Complaint.

28. DAP admits that Elmer's has requested that DAP cease all use of the term "carpenter's" but denies that Elmer's has exclusive rights to use the term and that DAP's use violates Elmer's rights.

29. DAP admits that it continues to use the term "carpenter's" but denies that its use is as a trademark.

### **COUNT I**

30. DAP incorporates by reference as if fully set forth herein its responses to Paragraph 1 through 29, inclusive, of the Complaint.

31. Paragraph 31 contains legal conclusions to which no response is required; and, to the extent any response is required, DAP denies the allegations contained within said paragraph.

32. Paragraph 32 contains legal conclusions to which no response is required. To the extent that Paragraph 32 is construed to contain facts or inferences, they are denied.

33. Paragraph 33 contains legal conclusions to which no response is required. To the extent that Paragraph 33 is construed to contain facts or inferences, they are denied.

34. DAP denies that it has infringed on Elmer's trademark rights. DAP is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 34 and therefore denies same.

35. Paragraph 35 contains legal conclusions to which no response is required; and, to the extent any response is required, DAP denies the allegations contained within said paragraph.

**COUNT II**

36. DAP incorporates by reference as if fully set forth herein its responses to Paragraph 1 through 35, inclusive, of the Complaint.

37. Paragraph 37 contains legal conclusions to which no response is required. To the extent that Paragraph 37 is construed to contain allegations, they are denied.

38. Paragraph 38 contains legal conclusions to which no response is required. To the extent that Paragraph 38 is construed to contain allegations, they are denied.

39. Paragraph 39 contains legal conclusions to which no response is required. To the extent that Paragraph 39 is construed to contain allegations, they are denied.

40. DAP denies that it has falsely designated the origin of its products and unfairly competed. DAP is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 40 and therefore denies same.

41. Paragraph 41 contains a legal conclusion to which no response is required; and, to the extent any response is required, DAP denies the allegations contained within said paragraph.

**COUNT III**

42. DAP incorporates by reference as if fully set forth herein its responses to Paragraph 1 through 41, inclusive, of the Complaint.

43. DAP denies the allegations contained in Paragraph 43 of the Complaint.

44. Paragraph 44 contains legal conclusions to which no response is required. To the extent that Paragraph 44 is construed to contain allegations, they are denied.

45. Paragraph 45 contains legal conclusions to which no response is required; and, to the extent any response is required, DAP denies the allegations contained within said paragraph.

46. DAP denies the allegations contained in Paragraph 46 of the Complaint.

47. Paragraph 47 contains a legal conclusion to which no response is required; and, to the extent any response is required, DAP denies the allegations contained within said paragraph.

#### **COUNT IV**

48. DAP incorporates by reference as if fully set forth herein its responses to Paragraph 1 through 47, inclusive, of the Complaint.

49. Paragraph 49 contains legal conclusions to which no response is required; and, to the extent any response is required, DAP denies the allegations contained within said paragraph.

50. Paragraph 50 contains legal conclusions to which no response is required; and, to the extent any response is required, DAP denies the allegations contained within said paragraph.

51. Paragraph 51 contains legal conclusions to which no response is required. To the extent that Paragraph 51 is construed to contain allegations, they are denied.

#### **COUNT V**

52. DAP incorporates by reference as if fully set forth herein its responses to Paragraph 1 through 51, inclusive, of the Complaint.

53. Paragraph 53 contains legal conclusions to which no response is required. To the extent that Paragraph 53 is construed to contain allegations, they are denied.

54. Paragraph 54 contains legal conclusions to which no response is required; and, to the extent any response is required, DAP denies the allegations contained within said paragraph.

55. Paragraph 55 contains legal conclusions to which no response is required; and, to the extent any response is required, DAP denies the allegations contained within said paragraph.

56. DAP denies the allegations contained in Paragraph 56 of the Complaint.

57. Paragraph 57 contains legal conclusions to which no response is required; and, to the extent any response is required, DAP denies the allegations contained within said paragraph.

58. Defendant denies each and every allegation contained within Plaintiff's Complaint not specifically admitted to be true herein.

**FIRST AFFIRMATIVE DEFENSE**

59. The Complaint and each and every cause of action alleged therein fails to state facts sufficient to constitute a claim upon which relief can be granted.

**SECOND AFFIRMATIVE DEFENSE**

60. The Complaint is barred by the doctrine of laches.

**THIRD AFFIRMATIVE DEFENSE**

61. The Complaint is barred by the doctrine of estoppel.

**FOURTH AFFIRMATIVE DEFENSE**

62. Plaintiff's damages, if any, were proximately caused by its own acts or omissions, barring any recovery against Defendant.

**FIFTH AFFIRMATIVE DEFENSE**

63. DAP has the right to use the term "carpenter's" to describe its products because the term is merely descriptive as used in connection with those products.

**SIXTH AFFIRMATIVE DEFENSE**

64. DAP has the right to use the term "carpenter's" to describe its products because the term is generic as used in connection with those products.

**WHEREFORE**, Defendant demands that Plaintiff's Complaint be dismissed; that it be awarded its attorney fees, costs, and expenses incurred in the defense of this action, and for all and any relief, whether legal or equitable that this Court deems just and proper.

**DEFENDANT DAP PRODUCTS, INC.'S COUNTERCLAIM**

Defendant DAP Products, Inc. (“DAP”), for its counterclaim against Plaintiff Elmer’s Products, Inc. (“Elmer’s), states the following:

1. DAP is a leading marketer of patch and repair products. Among DAP’s products are adhesives and fillers for construction, floor covering, industrial, and specialty use (“Products”).

2. DAP’s Products are used by professional contractors and do-it-yourselfers working in the construction, home repair, and remodeling industries.

3. DAP’s Products are sold in thousands of retail outlets throughout the United States and on the Internet.

4. Since at least as early as 1985, DAP adopted and has continuously used the term “Carpenter’s” in connection with its wood glue products. For example, DAP identifies one of its wood glue products as DAP® WELDWOOD® Carpenter’s Wood Glue.

5. Since at least as early as 2013, DAP adopted and has continuously used the term “Carpenter’s” in connection with its wood filler products. For example, DAP identifies one of its wood filler products as DAP® PLASTIC WOOD® Latex Carpenter’s Wood Filler.

6. Elmer’s asserts that it is the owner of three (3) registered trademarks: CARPENTER’S WOOD GLUE, U.S. Reg. No. 2460720; CARPENTER’S, U.S. Reg. No. 3249287, and CARPENTER’S, U.S. Reg. No. 3253431, for wood glue, wood putty, and wood filler (“Registrations”). DAP has filed petitions in the United States Patent and Trademark Office Trademark Trial and Appeal Board to cancel the Registrations.

7. Elmer’s averred in its applications that the term “carpenter’s” had acquired distinctiveness by virtue of its substantially exclusive use of the term to identify its wood glue

and wood putty products for more than five (5) years prior to the filings of its applications. In fact, third-parties, including DAP, used the term “carpenter’s” to identify the same products in the same channels of trade for more than five (5) years prior to the filing of Elmer’s trademark applications.

8. Elmer’s knew or should have know that its use of the term “carpenter’s” was not exclusive for the five (5) years prior to the filings of its applications.

9. Since the Registrations were issued, third-parties, including DAP have continued to use the term “carpenter’s” in connection with wood, filler, and putty products.

10. Upon information and belief, there has been no actual consumer confusion as to the source of the various “carpenter’s” products. Consumers are accustomed to seeing the common reference to “carpenter’s” in connection with these products and do not associate the term with the sources of the products.

11. Upon information and belief, Elmer’s has not taken action to enforce its alleged right to exclusive use of its CARPENTER’S trademarks. By permitting third-parties to use the term “carpenter’s” to identify wood glue, putty and filler, any acquired distinctiveness in the trademarks has been eroded.

#### **First Counterclaim**

12. The term “carpenter’s” in the trademark CARPENTER’S WOOD GLUE, U.S. Reg. No. 2460720, is merely descriptive because it describes an ingredient, quality, characteristic, function, feature, purpose, use, or user of the wood glue products that are the subject of the registration, and said term has not acquired distinctiveness.

13. Elmer’s knew or should have known that its use of the terms “carpenter’s wood glue” was not substantially exclusive for the five (5) years prior to filing its application and had

not otherwise acquired distinctiveness or secondary meaning as to source prior to the application filing date of August 3, 1998.

14. Registration 2460720 for CARPENTER'S WOOD GLUE was granted contrary to the requirements of 15 U.S.C. §1052(e)(1) and therefore must be canceled.

**Second Counterclaim**

15. The term "carpenter's" in the trademark CARPENTER'S, U.S. Reg. No. 3249287, is merely descriptive because it describes an ingredient, quality, characteristic, function, feature, purpose, use, or user of the wood putty products that are the subject of the registration, and said term has not acquired distinctiveness.

16. Elmer's knew or should have known that its use of the terms "carpenter's" was not substantially exclusive for the five (5) years prior to filing its application and had not otherwise acquired distinctiveness or secondary meaning as to source prior to the application filing date of May 19, 2006.

17. Registration 3249287 for CARPENTER'S was granted contrary to the requirements of 15 U.S.C. §1052(e)(1) and therefore must be canceled.

**Third Counterclaim**

18. The term "carpenter's" in the trademark CARPENTER'S, U.S. Reg. No. 3253431, is merely descriptive because it describes an ingredient, quality, characteristic, function, feature, purpose, use, or user of the wood glue products that are the subject of the registration, and said term has not acquired distinctiveness.

19. Elmer's knew or should have known that its use of the terms "carpenter's" was not substantially exclusive for the five (5) years prior to filing its application and had not

otherwise acquired distinctiveness or secondary meaning as to source prior to the application filing date of May 19, 2006.

20. Registration 3253431 for CARPENTER'S was granted contrary to the requirements of 15 U.S.C. §1052(e)(1) and therefore must be canceled.

**WHEREFORE**, DAP requests that the registrations recited in DAP's Counterclaim be canceled.

Respectfully submitted,

*/s/ James E. Arnold*

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*Counsel for Defendant DAP Products, Inc.*

**CERTIFICATE OF SERVICE**

I hereby certify that on December 29, 2014, *Defendant's Answer and Counterclaim to Plaintiff's Complaint* was electronically filed using the Court's CM/ECF system, which will electronically serve it upon the parties that have entered an appearance in this matter.

*/s/ James E. Arnold* \_\_\_\_\_  
James E. Arnold

FILED  
JOHN P. HEHMAN  
CLERK

IN THE UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF OHIO  
EASTERN DIVISION

2014 OCT 20 AM 10:05

U.S. DISTRICT COURT  
SOUTHERN DIST. OHIO  
EAST. DIV. COLUMBUS

ELMER'S PRODUCTS, INC.,  
460 Polaris Parkway  
Suite 500  
Westerville, Ohio 43082

Case No. **2:14CV1988**

JUDGE

**JUDGE MARBLEY**

Plaintiff,

vs.

**MAGISTRATE JUDGE ABEL**

DAP PRODUCTS INC.,  
2400 Boston Street, Suite 200  
Baltimore, Maryland 21224

Jury Trial Demanded

Defendant.

**COMPLAINT WITH DEMAND FOR JURY TRIAL**

Plaintiff, Elmer's Products, Inc., hereby files this Complaint against Defendant DAP Products Inc. In support thereof, Plaintiff avers the following:

**THE PARTIES**

1. Plaintiff Elmer's Products, Inc. ("Elmer's") is a corporation organized and existing under the laws of the State of Delaware, having a principal place of business at 460 Polaris Parkway, Suite 500, Westerville, Ohio 43082.
2. Defendant DAP Products Inc. ("DAP"), upon information and belief, is a corporation organized and existing under the laws of the State of Delaware, having a principal place of business at 2400 Boston Street, Suite 200, Baltimore, Maryland 21224.

**JURISDICTION AND VENUE**

3. This action arises under the provisions of the Trademark Act of 1946, 15 U.S.C. §§ 1051 through 1141, particularly 15 U.S.C. §§ 1114(1), 1125(a)(1)(A) and 1125(a)(1)(B).
4. This action is also brought for common law trademark infringement and unfair competition.
5. This Court has jurisdiction over the subject matter of this action pursuant to 15 U.S.C. § 1121(a), 28 U.S.C. § 1338(a), and 28 U.S.C. § 1331 for claims arising out of violations of 15 U.S.C. § 1125, and pursuant to 28 U.S.C. § 1338(b) and § 1367 for related claims arising under the common law.
6. Venue is proper under 28 U.S.C. § 1391(b) and (c) because a substantial part of the events giving rise to the claims occurred in this judicial district, and because DAP does business, and thus resides, within this judicial district.

**FACTUAL ALLEGATIONS COMMON TO ALL COUNTS**

**Elmer's Use of CARPENTER'S**

7. Elmer's is engaged in the business of manufacturing and selling adhesives, wood filler and related products at physical and online retailers throughout the United States.
8. Elmer's introduced its first consumer glue in 1947 and has continuously been using the trademark CARPENTER'S in commerce with wood glue since July 1, 1975 and with wood filler since January 31, 1980. Photographs of Elmer's CARPENTER'S glue and filler are attached as Exhibit A.
9. Elmer's has protected its CARPENTER'S trademark through federal trademark registrations consisting of:
  - CARPENTER'S WOOD GLUE - Reg. No. 2,460,720 - for wood glue for bonding, repairing and for construction and industrial purposes in

International Class 1, with a date of first use of July 1, 1975, and for wood glue for household use in International Class 16, with a date of first use of July 1, 1975, and

- CARPENTER'S - Reg. No. 3,249,287 - for preparations for concealing holes, imperfections and blemishes in wood and similar materials, namely, wood putty in International Class 2, with a date of first use of January 31, 1980; and,
- CARPENTER'S - Reg. No. 3,253,431 - for wood glue for bonding, repairing and for construction and industrial purposes in International Class 1, with a date of first use of July 1, 1975, and for wood glue and wood glue pens for household use in International Class 16, with a date of first use of July 1, 1975.

Collectively the "CARPENTER'S" Trademarks. True and correct copies of printouts from the United States Patent and Trademark Office (USPTO) Trademark Electronic Search System (TESS) are attached as Exhibit B.

10. In addition to its registrations, Elmer's enjoys common law rights in the CARPENTER'S Trademarks.
11. At considerable expense, Elmer's has extensively used and promoted the CARPENTER'S Trademarks.
12. Elmer's has used the CARPENTER'S Trademarks continuously in interstate commerce for the promotion, marketing and sale of adhesives and wood fillers since their respective dates of first use.
13. Through those efforts, Elmer's has acquired significant goodwill in and created substantial public recognition of the CARPENTER'S Trademarks.
14. Products bearing the CARPENTER'S Trademarks are extremely well-known and, as a result of extensive sales and advertising, have come to mean, and are identified with, Elmer's only.

15. Products bearing the CARPENTER'S Trademarks are sold throughout the United States in a wide variety of retail channels, including large home improvement stores, craft supply stores, small independent retailers, and online retailers. Products bearing the CARPENTER'S Trademarks are recognized by the purchasing public nationwide and are immediately identified by the purchasing public with Elmer's and its high-quality goods.
16. Since its first use of the CARPENTER'S Trademark, Elmer's has invested millions of dollars in advertising of products that bear its CARPENTER'S Trademarks. Elmer's has engaged in creative advertising campaigns to promote its CARPENTER'S Trademarks. Products that bear Elmer's CARPENTER'S Trademarks have generated substantial sales revenue.
17. Elmer's did not, and has not, authorized DAP to use any trademarks that contain the "carpenter's" element.

**DAP's Use of CARPENTER'S**

18. On information and belief, DAP is engaged in the manufacture and distribution of wood glue and wood filler.
19. DAP distributes its wood glue and wood filler under the CARPENTER'S mark. Photographs of DAP's product bearing the CARPENTER'S mark are attached as Exhibit C.
20. Upon information and belief, DAP began using its CARPENTER'S mark in commerce after the dates of first use of each of Elmer's CARPENTER'S Trademarks and after the filing dates of each of Elmer's applications to register the CARPENTER'S Trademarks.

21. DAP's CARPENTER'S mark is identical to Elmer's CARPENTER'S Trademark, Reg. Nos. 3,253,431 and 3,249,287, and substantially identical to Elmer's CARPENTER'S WOOD GLUE mark, Reg. No. 2,460,720.
22. DAP and Elmer's distribute their respective CARPENTER'S branded products nationwide through the same channels of trade, namely, large home improvement stores, craft supply stores, small independent retailers, and online retailers, including some of the same retailers, such as Menards and Amazon.
23. Elmer's and DAP use their respective marks on adhesives and wood filler.
24. Elmer's and DAP's CARPENTER'S branded adhesives can be purchased by the same consumers.
25. DAP's use of its CARPENTER'S mark is virtually identical to Elmer's use of its CARPENTER'S Trademarks, namely, as a brand name on the packaging of its wood glue and wood filler, and is likely to cause confusion, to cause mistake and to deceive consumers.
26. Elmer's CARPENTER'S Trademarks have priority over DAP's use of its CARPENTER'S mark through both an earlier date of first use and date of application for registration.
27. Because the parties' marks—as well as their respective goods and customer bases, channels of trade and even individual retailers—are virtually identical, consumers inevitably will be confused if DAP is permitted to continue using the CARPENTER'S mark. It is extremely likely that consumers will mistakenly believe that DAP is affiliated with Elmer's, or that Elmer's is the source or origin of DAP's wood glue and wood filler, or that DAP is a seller or distributor of Elmer's wood glue and wood filler.

28. Elmer's has notified DAP that its acts are violating Elmer's rights and has requested that DAP discontinue all use of the CARPENTER'S mark.
29. DAP continues to use the CARPENTERS mark.

**COUNT I**

**Section 32 of the Lanham Act:  
Infringement of Federally Registered Trademarks**

30. Paragraphs 1 through 29, above, are incorporated herein by reference as though set forth in full.
31. This is a claim for the infringement of trademarks registered in the USPTO, pursuant to Section 32(1) of the Lanham Act, 15 U.S.C. § 1114(1)(a), as amended.
32. The identical mark CARPENTER'S, used by DAP, is confusingly similar to Elmer's federally registered CARPENTER'S Trademarks, and infringes Elmer's CARPENTER'S Trademarks.
33. DAP's unauthorized use of the CARPENTER'S mark is likely to cause confusion, to cause mistake and to deceive the public as to the approval, sponsorship, license, source or origin of DAP's products.
34. Elmer's has been injured, and continues to be injured, and to suffer damages and harm by DAP's infringement of Elmer's trademark rights.
35. Elmer's has no adequate remedy at law.

**COUNT II**

**Section 43 of the Lanham Act:  
False Designation of Origin**

36. Paragraphs 1 through 29, above, are incorporated herein by reference as though set forth in full.

37. DAP's use of a trademark that is identical to Elmer's trademark is likely to cause confusion, to cause mistake and to deceive the public as to the origin, sponsorship or approval of DAP's goods, and the public is likely to mistakenly believe that DAP's goods are approved by, or licensed by, or affiliated with or in some other way legitimately connected with Elmer's.
38. DAP, by these actions, has engaged and continues to engage in false designation of origin and unfair competition in violation of 15 U.S.C. § 1125(a)(1)(A).
39. DAP's acts of false designation of origin and unfair competition will inevitably cause confusion and mistake as to the origin, sponsorship or approval of DAP's goods, entitling Elmer's to any and all available remedies under 15 U.S.C. §§ 1116, 1117 and 1125, including injunctive relief.
40. Elmer's has been injured, and continues to be injured, and to suffer damages and harm from DAP's false designation of origin and unfair competition.
41. Elmer's has no adequate remedy at law.

### **COUNT III**

#### **Section 43 of the Lanham Act: False Representation**

42. Paragraphs 1 through 29, above, are incorporated herein by reference as though set forth in full.
43. DAP's advertisement of its products under a trademark that is identical to Elmer's trademark misrepresents the nature, characteristics, and qualities of its products and is likely to cause the public to confuse the nature, characteristics, and qualities of its products with those of Elmer's products.

44. DAP, by these actions, has and continues to engage in false representation and unfair competition in violation of 15 U.S.C. § 1125(a)(1)(B).
45. Elmer's is entitled to any and all available remedies under 15 U.S.C. §§ 1116, 1117 and 1125, including injunctive relief.
46. Elmer's has been injured, and continues to be injured, and to suffer damages and harm from DAP's acts of false representation and unfair competition.
47. Elmer's has no adequate remedy at law.

#### **COUNT IV**

##### **Common Law Trademark Infringement and Unfair Competition**

48. Paragraphs 1 through 29, above, are incorporated herein by reference as though set forth in full.
49. This claim is for trademark infringement and unfair competition in violation of the common law of the State of Ohio.
50. DAP's use of its CARPENTER'S mark, as described above, constitutes common law trademark infringement, passing off and unfair competition in violation of Ohio common law.
51. DAP's acts described above have caused injury and damages to Elmer's, and have caused irreparable injury to Elmer's goodwill and reputation and, unless enjoined, will cause further irreparable injury, whereby Elmer's has no adequate remedy at law.

#### **COUNT V**

##### **Ohio Revised Code Section 4165 Deceptive Trade Practices**

52. Paragraphs 1 through 29, above, are incorporated herein by reference as though set forth in full.

53. DAP's use of a trademark that is identical to Elmer's trademark is likely to cause confusion, to cause mistake and to deceive the public as to the origin, sponsorship or approval of DAP's goods, and the public is likely to mistakenly believe that DAP's goods are approved by, or licensed by, or affiliated with or in some other way legitimately connected with Elmer's.
54. DAP, by these actions, has and continues to engage in deceptive trade practices in violation of Ohio Rev. Code Ann. § 4165.2.
55. Elmer's is entitled to any and all available remedies under Ohio Rev. Code Ann § 4165.3, including injunctive relief.
56. Elmer's has been injured, and continues to be injured, and to suffer damages and harm from DAP's deceptive trade practices.
57. Elmer's has no adequate remedy at law.

**Prayer For Relief**

**WHEREFORE**, Elmer's respectfully demands judgment in its favor and against DAP and requests:

- I. That an injunction be issued permanently enjoining DAP, its agents, servants and employees, and all persons acting in concert therewith, from:
  1. Directly or indirectly using the CARPENTER'S trademark or any mark, word, or name similar to Elmer's CARPENTER'S Trademarks which are likely to cause confusion, mistake or to deceive;
  2. Using any logo, trademark, or trade name which may be calculated to falsely represent or which has the effect of falsely representing that the products and

services of DAP or of third parties are sponsored by, authorized by or in any way associated with Elmer's;

3. Infringing the CARPENTER'S Trademarks;
4. Otherwise unfairly competing with Elmer's; and,
5. Falsely representing that DAP is connected with Elmer's or sponsored by or associated with Elmer's, or engaging in any act which is likely to falsely cause the public to believe that DAP is associated with Elmer's.

- II. That this Court, pursuant to the power granted it under 15 U.S.C. § 1118, order that all signs, labels, prints, packages, wrappers, receptacles, brochures, advertisements, and printed and electronic materials of any kind in the possession of DAP bearing the mark CARPENTER'S and all plates, molds, matrices and other means of making the same, shall be delivered up and destroyed.
- III. That DAP be ordered to remove all reference to the CARPENTER'S mark from any website associated with DAP or within DAP's control.
- IV. That DAP be required to file with this Court and serve upon Elmer's within thirty (30) days after the injunction is issued, a report in writing and under oath, setting forth in detail the manner and form in which DAP has complied with the injunction.
- V. That DAP be required to account to Elmer's for and pay to Elmer's all of DAP's profits and the actual damages suffered by Elmer's as a result of DAP's acts of infringement and unfair competition.
- VI. That DAP be required to pay to Elmer's such damages as Elmer's has sustained as a consequence of DAP's acts of false designation of origin, false representation, deceptive and unfair competition and trademark infringement pursuant to § 35 of the Lanham Act,

including three times the amount found as actual damages by the trier of fact to properly compensate Plaintiffs for their damages pursuant to 15 U.S.C. § 1117(a), and for DAP's deceptive trade practices pursuant to Ohio Rev. Code Ann. § 4165.03, together with prejudgment interest.

VII. That DAP be required to pay Elmer's all costs, disbursements and attorneys' fees of this action pursuant to 15 U.S.C. § 1117 and Ohio Rev. Code Ann. § 4165.03.

VIII. That the Court award Elmer's all other additional relief as it may deem just and proper under the circumstances.

**JURY TRIAL DEMAND**

Plaintiff Elmer's Products, Inc. hereby demands and requests trial by jury of all issues raised that are triable by jury.

ELMER'S PRODUCTS, INC.

By its attorneys,



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Date: October 20, 2014