

ESTTA Tracking number: **ESTTA714696**

Filing date: **12/15/2015**

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	Durez Corporation		
Entity	Corporation	Citizenship	Delaware
Address	46820 Magellan Drive Suite C Novi, MI 48377 UNITED STATES		

Attorney information	Terence P. Ross Crowell & Moring LLP 1001 Pennsylvania Ave. NW Washington, DC 20004 UNITED STATES tross@crowell.com, amace@crowell.com Phone:202-624-2500		
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Registration Subject to Cancellation

Registration No	4731457	Registration date	05/05/2015
Registrant	Performance Sealing Inc. 1821 Langley Avenue Irvine, CA 92614 UNITED STATES		

Goods/Services Subject to Cancellation

Class 017. First Use: 2000/07/27 First Use In Commerce: 2000/07/27 All goods and services in the class are cancelled, namely: Sealing and insulating materials

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
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Related Proceedings	92062497
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Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	175374	Application Date	07/25/1922
Registration Date	11/06/1923	Foreign Priority Date	NONE
Word Mark	"DUREZ"		

Design Mark	“ D U R E Z ”
Description of Mark	NONE
Goods/Services	Class 017. First use: First Use: 1921/04/00 First Use In Commerce: 1921/04/00 Molding Compositions Containing Resinous Ingredients

U.S. Registration No.	662780	Application Date	05/15/1957
Registration Date	06/10/1958	Foreign Priority Date	NONE
Word Mark	DUREZ		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 002. First use: First Use: 1921/04/00 First Use In Commerce: 1921/04/00 PAINTS, VARNISHES, AND COATING LACQUERS		

U.S. Registration No.	790156	Application Date	05/06/1964
Registration Date	06/01/1965	Foreign Priority Date	NONE
Word Mark	DUREZ		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 001. First use: First Use: 1921/04/00 First Use In Commerce: 1942/12/00 INDUSTRIAL CHEMICALS-NAMELY, CHEMICALS USEFUL IN THE SYNTHETIC RESIN INDUSTRY, CURING AGENTS, RUBBER ACCELERATORS, PLASTICIZERS AND BINDERS SYNTHETIC RESINS, SYNTHETIC RESIN COMPOSITIONS-NAMELY, PLASTICS, MOLDING COMPOSITIONS, PHENOL-FORMALDEHYDE RESINS, FURFURYL ALCOHOL RESINS, POLYESTER RESINS, AND POLYURETHANE RESINS		

Attachments	71167353#TMSN.png(bytes) durez petition for cancellation of durez.pdf(205776 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 Overnight Courier on this date.

Signature	/Ann Mace/
Name	Ann Mace
Date	12/15/2015

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

DUREZ CORPORATION)	
)	
Petitioner,)	
)	Cancellation No.: _____
v.)	Reg. No.: 4,731,457
)	Mark: DUREZ
PERFORMANCE SEALING INC.)	
)	
Registrant.)	
)	

PETITION FOR CANCELLATION

Petitioner Durez Corporation, a corporation organized and existing under the laws of Delaware, located and doing business at 46820 Magellan Drive, Suite C, Novi, Michigan 48377, believes that it is or will be damaged by the continued registration of the mark identified above and hereby petitions to cancel Reg. No. 4,731,457. The grounds for cancellation are as follows:

1. Petitioner Durez Corporation is a corporation organized and existing under the laws of Delaware, located and doing business at 46820 Magellan Drive, Suite C, Novi, Michigan 48377.

2. Petitioner manufactures and supplies thermosetting resins and molding compounds, with a primary focus on phenolic based materials, but other chemistries are also employed based on specific market needs. Petitioner makes these compounds for customers in the automotive, electrical and industrial markets. The Petitioner's products include but are not limited to: adhesives, abrasives, specialty paper coatings, food packaging and general coating applications, composites for automotive, electrical, and aerospace, friction components such as brake linings and clutch plates, general impregnation and lamination, oil and gas downhole applications, foam, refractory, and tire manufacture.

3. Petitioner owns several valid, incontestable trademark registrations for DUREZ (collectively, the “DUREZ Marks”), including:

Mark	Classes of Goods	Reg. No.	Registration Date	Exhibit #
DUREZ	International Class 17: Molding compositions containing resinous ingredients.	175,374	11/6/1923	A
DUREZ	International Class 2: Paints, varnishes, and coating lacquers.	662,780	6/10/1958	B
DUREZ	International Class 1: Synthetic resins, synthetic resin compositions – namely, plastics, molding compositions, phenol-formaldehyde resins, furfuryl alcohol resins, polyester resins, and polyurethane resins. Industrial chemicals – namely, chemicals useful in the synthetic resin industry, curing agents, rubber accelerators, plasticizers and binders.	790,156	6/1/1965	C

Printouts from the U.S. Patent and Trademark Office Database for the foregoing registrations, displaying the current status and title of such registrations, are attached as Exhibits A – C.

4. Since at least as early as 1921, Petitioner or its predecessors in interest have used and continue to use the DUREZ Marks in connection with the goods shown in Petitioner’s registrations. Over this time, Petitioner has built extensive and valuable goodwill in connection with the DUREZ Marks.

5. On May 5, 2015, Performance Sealing Inc. received Reg. No. 4,731,457 from the United States Patent and Trademark Office for the mark DUREZ (the “Performance DUREZ Registration”). That registration covers “sealing and insulating materials” in International Class 17. A printout from the U.S. Patent and Trademark Office Database showing the status of the Performance DUREZ Registration is attached as Exhibit D.

6. On information and belief, because Petitioner has used the DUREZ Marks in commerce since at least as early as 1921 and has continuously used the DUREZ Marks since that date, Petitioner has priority of use.

7. Petitioner also has priority because each of Petitioner's Registrations described in Paragraph 3 was filed prior to the registration date for the Performance DUREZ Registration.

8. The goods in the Performance DUREZ Registration are similar or closely related to the goods sold and offered by Petitioner under the DUREZ Marks, including as set out above in Paragraphs 3 and 5.

9. On information and belief, the goods contained in the Performance DUREZ Registration are intended to be offered to the same or similar customers as the goods sold and offered by Petitioner under the DUREZ Marks.

10. On information and belief, the goods contained in the Performance DUREZ Registration are offered through the same or similar channels of trade as the goods sold and offered by Petitioner under the DUREZ Marks.

11. Registrant's DUREZ mark is identical to Petitioner's DUREZ Marks. And, on information and belief, Registrant's DUREZ mark so resembles Petitioner's DUREZ Marks as to be likely, when used in connection with the goods listed in Registrant's 4,731,457 Registration, to cause confusion, mistake, or to deceive, with Petitioner's DUREZ Marks.

PRAYER FOR RELIEF

WHEREFORE, for the foregoing reasons and other reasons the Board may deem sufficient, Petitioner respectfully requests that this Petition for Cancellation be granted and that Registration No. 4,731,457 be cancelled.

This Petition for Cancellation is submitted electronically. The required filing fee for this Petition is submitted simultaneously herewith via credit card payment.

Respectfully submitted,

December 15, 2015

/s Terence P. Ross
Terence P. Ross
Ann Mace
Attorneys for Petitioner

CROWELL & MORING LLP
1001 Pennsylvania Ave, N.W.
Washington, DC 20044-4300
Telephone No.: (202) 624-2500
Facsimile No.: (202) 628-8844

CERTIFICATE OF SERVICE

I hereby certify that the undersigned caused to be served on Registrant's attorney a true copy of the PETITION FOR CANCELLATION, this 15th day of December, 2015, by sending same via overnight courier, to:

Joseph A. Mandour
Mandour & Associates, APC
16870 West Bernardo Drive, Suite 400
San Diego, CA 92127
jmandour@mandourlaw.com

/s Ann Mace
Ann Mace



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“ D U R E Z ”

Word Mark "DUREZ"
Goods and Services IC 017. US 001. G & S: Molding Compositions Containing Resinous Ingredients. FIRST USE: 19210400. FIRST USE IN COMMERCE: 19210400
Mark Drawing Code (5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM
Serial Number 71167353
Filing Date July 25, 1922
Current Basis 1A
Original Filing Basis 1A
Registration Number 0175374
Registration Date November 6, 1923
Owner (REGISTRANT) Industrial Molded Materials Company CORPORATION NEW JERSEY North Tonawanda NEW YORK
(LAST LISTED OWNER) DUREZ CORPORATION CORPORATION DELAWARE 46820 MAGELLAN DRIVE SUITE C NOVI MICHIGAN 48377
Assignment Recorded ASSIGNMENT RECORDED
Attorney of Record Nicole B. Emmons
Type of Mark TRADEMARK
Register PRINCIPAL
Affidavit Text SECTION 8(10-YR) 20131104.
Renewal 4TH RENEWAL 20131104
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Typed Drawing

Word Mark DUREZ
Goods and Services IC 002. US 016. G & S: PAINTS, VARNISHES, AND COATING LACQUERS. FIRST USE: 19210400. FIRST USE IN COMMERCE: 19210400
Mark Drawing Code (1) TYPED DRAWING
Serial Number 72030087
Filing Date May 15, 1957
Current Basis 1A
Original Filing Basis 1A
Registration Number 0662780
Registration Date June 10, 1958
Owner (REGISTRANT) HOOKER ELECTROCHEMICAL COMPANY CORPORATION NEW YORK BUFFALO AVE. NIAGARA FALLS NEW YORK
(LAST LISTED OWNER) DUREZ CORPORATION CORPORATION DELAWARE 46820 MAGELLAN DRIVE SUITE C NOVI MICHIGAN 48377
Assignment Recorded ASSIGNMENT RECORDED
Attorney of Record S. Roxanne Edwards
Prior Registrations 0175374;0366314;0393110
Type of Mark TRADEMARK
Register PRINCIPAL
Affidavit Text SECT 15. SECTION 8(10-YR) 20080804.
Renewal 3RD RENEWAL 20080804
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Typed Drawing

Word Mark DUREZ

Goods and Services IC 001. US 001. G & S: SYNTHETIC RESINS, SYNTHETIC RESIN COMPOSITIONS-NAMELY, PLASTICS, MOLDING COMPOSITIONS, PHENOL-FORMALDEHYDE RESINS, FURFURYL ALCOHOL RESINS, POLYESTER RESINS, AND POLYURETHANE RESINS. FIRST USE: 19210400. FIRST USE IN COMMERCE: 19421200

IC 001. US 006. G & S: INDUSTRIAL CHEMICALS-NAMELY, CHEMICALS USEFUL IN THE SYNTHETIC RESIN INDUSTRY, CURING AGENTS, RUBBER ACCELERATORS, PLASTICIZERS AND BINDERS. FIRST USE: 19210400. FIRST USE IN COMMERCE: 19421200

Mark Drawing Code (1) TYPED DRAWING

Serial Number 72192823

Filing Date May 6, 1964

Current Basis 1A

Original Filing Basis 1A

Registration Number 0790156

Registration Date June 1, 1965

Owner (REGISTRANT) HOOKER CHEMICAL CORPORATION CORPORATION NEW YORK BUFFALO AVE. AT 47TH STREET NIAGARA FALLS NEW YORK

(LAST LISTED OWNER) DUREZ CORPORATION CORPORATION DELAWARE 46820 MAGELLAN DRIVE SUITE C NOVI MICHIGAN 48377

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record Justin P. Welch

Prior Registrations 0175374;0662780;0682916

Type of Mark TRADEMARK

Register PRINCIPAL

Affidavit Text SECT 15. SECTION 8(10-YR) 20150318.

Renewal 3RD RENEWAL 20150318

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Durez

Word Mark DUREZ

Goods and Services IC 017. US 001 005 012 013 035 050. G & S: Sealing and insulating materials. FIRST USE: 20000727. FIRST USE IN COMMERCE: 20000727

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 86403172

Filing Date September 23, 2014

Current Basis 1A

Original Filing Basis 1A

Published for Opposition February 17, 2015

Registration Number **4731457**

Registration Date May 5, 2015

Owner (REGISTRANT) Performance Sealing Inc. CORPORATION DELAWARE 1821 Langley Avenue Irvine CALIFORNIA 92614

Attorney of Record Joseph A. Mandour

Type of Mark TRADEMARK

Register PRINCIPAL

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