

11-06-2002

U.S. Patent & TMOrc/TM Mail Rcpt Dt. #73

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

DURO-LAST, INC. )  
 )  
Opposer, )  
v. )  
DURACASE, LLC )  
 )  
Applicant. )

**NOTICE OF OPPOSITION**

Opposition No. \_\_\_\_\_

Serial No. 76/369,176

Published: 9/17/02

(Page TM 535)

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Assistant Commissioner for Trademarks  
BOX TTAB FEE  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

November 6, 2002

Duro-Last, Inc. a corporation duly organized,  
incorporated, and existing under the laws of the State of  
Michigan and having a principal place of business at 525 Morley  
Drive, Saginaw, Michigan 48601, believes that it will be damaged  
by registration of the mark DURASHEET of application Serial No.  
76/369,176 in International Class 17 by the Applicant, and hereby  
opposes the same under the provisions of 15 U.S.C. Section 1063.

As grounds of opposition, Opposer alleges:

11/18/2002 KGIBBONS 00000024 76369176

01 FC:6402 300.00 OP

**CERTIFICATION 37 C.F.R. 1.8a and 1.10**

I hereby certify that, on the date shown below, this correspondence is being:

x deposited with the United States Postal Service, in an envelope addressed to the Assistant Commissioner for Trademarks,  
2900 Crystal Drive, Arlington, Virginia 22202-3513.

**37 C.F.R. 1.8a**

**37 C.F.R. 1.10**

with sufficient postage as first class mail.

x as "Express Mail Post Office to Addressee" Mailing Label  
No. EL670072513US (mandatory)

*Deborah A. Bohn*  
Signature

Date: November 6, 2002

Deborah A. Bohn

Duro-Last, Inc.

1. The application Serial No. 76/369,176 filed by Applicant was filed as an intent-to-use trademark application and its products are classified in International Class 17.

2. On information and belief, applicant made no use of the trademark prior to its filing date of February 11, 2002 and Applicant has not since used the trademark.

3. Continuously, and commencing long prior to Applicant's application filing date and up to the present date, Opposer has continuously used the trademark DURO-LAST on a wide variety of products in various fields including products registered in International Class 17.

4. Continuously, commencing long prior to Applicant's application filing date, and up to the present time, Opposer has used the mark DURO-LAST in commerce throughout the United States of America on and in association with its plastic sheet or membrane panels.

5. On information and belief, the PVC encased sheeting marketed by Opposer for many, many years is the same product, or substantially the same product, marketed, or proposed to be marketed, by Applicant.

6. Opposer, Duro-Last, Inc., is the owner of the following federal trademark registrations, and the marks registered thereby, for the products set forth therein:

<u>Reg. No.</u>	<u>Mark</u>	<u>Reg. Date</u>
1,292,285	DURO-LAST	August 28, 1984
1,798,975	DURO-LAST	October 19, 1993
2,278,503	DURO-FOLD	September 14, 1999

Duro-Last, Inc.		
2,386,473	DURO-CAULK	September 12, 2000
2,602,600	DURO-LAST	July 30, 2002

Copies of these U.S. registrations are attached hereto in the order listed, as Exhibits A-E.

7. Applicant's and Opposer's products may be or are referenced as PVC sheets from which other products are made or fabricated.

8. Since the initial use of its DURO-LAST trademark, Opposer has made a substantial investment in nationally advertising and promoting its sheet products under its DURO-LAST trademark and has extensively used, advertised, promoted, and offered such products to the public for many years through various channels of trade and commerce, with the result that Opposer's customers and potential customers, and the public in general, have come to know and recognize Opposer's trademark, and associate the same with Opposer and the products marketed by Opposer. Opposer has built up extensive goodwill and a very valuable reputation in connection with its marketing of plastic sheet products under the DURO-LAST trademark.

9. On information and belief, applicant's proposed mark, DURASHEET, is also to be used, or is used, in some of the same trades.

10. On information and belief, applicant's product or sheeting bearing the mark DURASHEET would be exhibited, or is exhibited at the same shows as Opposer's product and Applicant's customers would be, or are, parties involved in some of the same trades.

Duro-Last, Inc.

11. Applicant's proposed mark, DURASHEET, so closely resembles Opposer's mark DURO-LAST that, when applied to the products of Applicant, it is likely to cause confusion, or mistake, and will deceive purchasers, resulting in damage or detriment to Opposer.

12. Upon information and belief, Opposer's customers, potential customers, and the public in general, are likely to be confused, mistaken, or deceived as to the origin and sponsorship of Applicant's product marketed under Applicant's proposed mark DURASHEET, and are likely to be misled to believe that such goods emanate from, or in some way are directly or indirectly associated with, or sponsored by, Opposer, or are simply another product marketed by Opposer.

13. The sale by Opposer of its plastic sheet or membrane product for Applicant's product is no more than an expected and normal expansion of Opposer's business.

14. Applicant's latecomer use of the proposed mark DURASHEET would falsely suggest a connection with Opposer.

WHEREFORE, in view of the foregoing, the Opposer prays that the application be rejected.

Opposer hereby gives notice under rule 2.122(d) that in this opposition proceeding and any appeals relating thereto, it will rely on its registrations, which are annexed as exhibits to this Notice of Opposition, as evidence in support of this Notice of Opposition.

The fees required in Section 2.6(a)(17) are filed herewith in the sum of \$300.00, covering the filing fee for said

Duro-Last, Inc.  
Opposition required to be filed with the Notice of Opposition for the single international class involved. The Commissioner is hereby authorized to charge payment of any additional fees required, or credit any overpayment, to Deposit Account No. 12-0755.

Opposer filed a request for an extension of time to oppose until November 17, 2002, which was granted.

An original and copy of this Notice of Opposition are enclosed.

All correspondence should be addressed to John F. Learman and Andrew Grove, at Reising, Ethington, Learman & McCulloch, 5291 Colony Drive North, Saginaw, Michigan 48603.

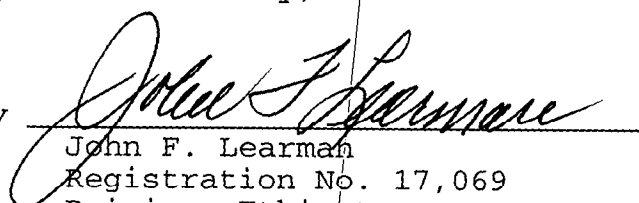
Respectfully submitted,

DURO-LAST, INC.

By their attorney,

Date: November 6, 2002

By



John F. Learman  
Registration No. 17,069  
Reising, Ethington,  
Learman & McCulloch, P.C.  
5291 Colony Drive North  
Saginaw, Michigan 48603  
(989) 799-5300

db  
enc

Int. Cl.: 19

EXHIBIT A

Prior U.S. Cl.: 12

Reg. No. 1,292,285

**United States Patent and Trademark Office**

Registered Aug. 28, 1984

**TRADEMARK**  
Principal Register

**DURO-LAST**

Duro-Last Roofing, Inc. (Michigan corporation)  
525 Morley Dr.  
Saginaw, Mich. 48601

For: POLYESTER-COATED CUSTOM FIT,  
FABRIC, ROOF COVERING SHEETS CUT TO  
THE INSTALLER'S SPECIFIED SIZE AND  
SOLD TO AUTHORIZED INSTALLERS TO  
HEAT WELD IN THE FIELD TO FASHION A  
ONE PIECE ROOF COVER, in CLASS 19 (U.S.  
Cl. 12).

First use Mar. 1981; in commerce Mar. 1981.

Ser. No. 376,481, filed Jul. 26, 1982.

R. G. COLE, Examining Attorney



EXHIBIT B

Int. Cls.: 1, 6, 7, 8, 9, 14, 16, 17, 18, 19, 20, 21, 25,  
37, 41 and 42

Prior U.S. Cls.: 2, 3, 5, 12, 13, 14, 23, 26, 27, 30,  
33, 39, 50, 100, 103 and 107

Reg. No. 1,798,975

United States Patent and Trademark Office Registered Oct. 19, 1993

TRADEMARK  
SERVICE MARK  
PRINCIPAL REGISTER

DURO-LAST

DURO-LAST, INC. (MICHIGAN CORPORATION)  
525 MORLEY DRIVE  
SAGINAW, MI 48601

FOR: MASTICS AND ADHESIVES FOR USE  
IN ROOFING, IN CLASS 1 (U.S. CL. 5).

FIRST USE 6-0-1983; IN COMMERCE  
6-0-1983.

FOR: METAL THREADED FASTENERS,  
METAL ANCHORS FOR SECURING MATERIAL  
TO CONCRETE, PLASTIC COATED  
METAL SHEETS FOR USE IN FABRICATING  
ROOFING, METAL BANDING, AND LICENSE  
PLATES, IN CLASS 6 (U.S. CLS. 14 AND 50).

FIRST USE 6-0-1983; IN COMMERCE  
6-0-1983.

FOR: ELECTRIC SCREW GUNS, HAND  
HELD HOT AIR GUN TOOLS FOR SURFACE  
MELTING PLASTIC MATERIALS TO RENDER  
THEM ADHERABLE, HOT AIR SEAM  
WELDER MACHINES FOR SURFACE HEAT-  
ING AND THEN PRESSURE WELDING  
TAPPED PLASTIC SHEET MATERIALS TO-  
GETHER, HAND-PROPELLED ROLLERS FOR  
PRESSING HEATED ROOFING MEMBRANE  
MATERIALS TOGETHER AND ADHERING  
THEM; AND HAMMER DRILLS, IN CLASS 7  
(U.S. CL. 23).

FIRST USE 6-0-1983; IN COMMERCE  
6-0-1983.

FOR: MANUALLY-OPERATED TOOLS;  
NAMELY, PUNCHES, TACK CLAWS, SCREW  
DRIVERS, BANDING TOOLS, HAMMERS,  
SCISSORS, UTILITY KNIVES FOR CUTTING

MEMBRANES, CHISELS, NAIL PULLERS, MA-  
SONRY BITS, SCREW DRIVER TIPS, BAT-  
TERY OPERATED RAZORS, PRYING TOOLS,  
SHEET METAL TENSIONERS, DUCK-BILLED  
LOCKING PLIERS AND FASTENER APPLY-  
ING TOOLS FOR SECURING FASTENERS FOR  
ROOFING MATERIALS SUCH AS MEM-  
BRANES, IN CLASS 8 (U.S. CL. 23).

FIRST USE 6-0-1983; IN COMMERCE  
6-0-1983.

FOR: FASTENER PULL TESTERS FOR USE  
IN MEASURING THE FORCE REQUIRED TO  
PULL FASTENERS FROM A ROOFING DECK,  
IN CLASS 9 (U.S. CL. 26).

FIRST USE 6-0-1983; IN COMMERCE  
6-0-1983.

FOR: WATCHES, IN CLASS 14 (U.S. CL. 27).  
FIRST USE 2-0-1983; IN COMMERCE  
2-0-1983.

FOR: PROMOTIONAL ITEMS; NAMELY,  
PENS AND STATIONERY TYPE PORTFOLIOS  
, IN CLASS 16 (U.S. CL. 3).

FIRST USE 2-0-1983; IN COMMERCE  
2-0-1983.

FOR: ROOFING MATERIALS; NAMELY,  
SEALANTS, SELF-LEVELING FILLERS;  
NAMELY, SILICONE, BUILDING INSULA-  
TION, AND PLASTIC PIPE STACKS, IN CLASS  
17 (U.S. CL. 12).

FIRST USE 6-0-1983; IN COMMERCE  
6-0-1983.

FOR: DUFFLE BAGS, IN CLASS 18 (U.S. CL.  
3).

FIRST USE 2-0-1983; IN COMMERCE 2-0-1983.

FOR: ROOFING ACCESSORIES; NAMELY, NON-ELECTRIC, STATIONARY VENTS, RIGID FACIA STRIPS, RIGID AND FLEXIBLE CORNERS, SCUPPERS, DRAINS, DRAIN CLAMPING EXPANSION RINGS, DRIP EDGE COVERING, DRAIN LEAF GRATES, GRAVEL STOPS, FLASHINGS, ROOFING MEMBRANE SHEETING, UNDERLAYMENT; NAMELY, FIBER-GLASS MAT AND PLASTIC FILM, TERMINATION BARS, AND ROOF MEMBRANE STRESS DISTRIBUTION PLATES, MOISTURE ABSORBERS IN THE NATURE OF GRANULATED BENTONITE CLAY SOLD IN BAGS, IN CLASS 19 (U.S. CL. 12).

FIRST USE 1-0-1981; IN COMMERCE 1-0-1981.

FOR: PLASTIC FASTENERS FOR USE IN SECURING PLASTIC MEMBRANE AND INSULATION TO ROOFING DECKS, IN CLASS 20 (U.S. CL. 13).

FIRST USE 6-0-1983; IN COMMERCE 6-0-1983.

FOR: COFFEE MUGS, IN CLASS 21 (U.S. CLS. 2, 30 AND 33).

FIRST USE 2-0-1983; IN COMMERCE 2-0-1983.

FOR: CLOTHING; NAMELY, SHIRTS, PANTS, JACKETS, SWEATSUITS, GYM SHORTS, CAPS, AND APRONS, IN CLASS 25 (U.S. CL. 39).

FIRST USE 2-0-1983; IN COMMERCE 2-0-1983.

FOR: REPAIRING AND MAINTAINING ROOFING SYSTEMS, IN CLASS 37 (U.S. CL. 103).

FIRST USE 2-0-1981; IN COMMERCE 2-0-1981.

FOR: EDUCATION SERVICES; NAMELY, PRODUCING SEMINARS FOR ARCHITECTS, ENGINEERS, BUILDING OWNERS, DEALERS AND PROSPECTIVE DEALERS, AND PROVIDING RELATED INSTRUCTIONAL LITERATURE, IN CLASS 41 (U.S. CL. 107).

FIRST USE 1-0-1983; IN COMMERCE 1-0-1983.

FOR: INSPECTING AND TESTING ROOFING SYSTEMS FOR OTHERS, IN CLASS 42 (U.S. CL. 100).

FIRST USE 2-0-1981; IN COMMERCE 2-0-1981.

OWNER OF U.S. REG. NO. 1,292,285.

SER. NO. 74-132,374, FILED 1-22-1991.

LORI SCHULMAN, EXAMINING ATTORNEY



EXHIBIT C

Int. Cl.: 17

Prior U.S. Cls.: 1, 5, 12, 13, 35, and 50

Reg. No. 2,278,503

**United States Patent and Trademark Office**

Registered Sep. 14, 1999

**TRADEMARK  
PRINCIPAL REGISTER**

**DURO-FOLD**

DURO-LAST, INC. (MICHIGAN CORPORATION)  
525 MORLEY DRIVE  
SAGINAW, MI 48601

FOR: ROOF DECK INSULATION BOARDS,  
NAMELY, SUBSTANTIALLY RIGID FOAM  
BOARDS CONNECTED BY FOLDABLE MATERIAL  
SO AS TO BE SHIPPABLE IN FOLDED

CONDITION, IN CLASS 17 (U.S. CLS. 1, 5, 12, 13,  
35 AND 50).

FIRST USE 3-19-1999; IN COMMERCE  
3-19-1999.

SN 75-444,956, FILED 3-5-1998.

JASON TURNER, EXAMINING ATTORNEY

EXHIBIT D

Int. Cl.: 17

Prior U.S. Cls.: 1, 5, 12, 13, 35, and 50

Reg. No. 2,386,473

United States Patent and Trademark Office

Registered Sep. 12, 2000

**TRADEMARK  
PRINCIPAL REGISTER**

**DURO-CAULK**

DURO-LAST, INC. (MICHIGAN CORPORATION)  
525 MORLEY DRIVE  
SAGINAW, MI 48601

FIRST USE 6-9-1999; IN COMMERCE 6-9-1999.  
OWNER OF U.S. REG. NOS. 1,292,285 AND  
1,798,795.

FOR: CAULKING FOR PARTICULAR USE WITH  
ROOFING SYSTEMS, IN CLASS 17 (U.S. CLS. 1, 5,  
12, 13, 35 AND 50).

SN 75-627,130, FILED 1-26-1999.

ELIZABETH HUGHITT, EXAMINING ATTORNEY

EXHIBIT E

Int. Cl.: 35

Prior U.S. Cls.: 100, 101, and 102

**United States Patent and Trademark Office**

**Reg. No. 2,602,600**

Registered July 30, 2002

**SERVICE MARK  
PRINCIPAL REGISTER**

**DURO-LAST**

DURO-LAST, INC. (MICHIGAN CORPORATION)  
525 MORLEY DRIVE  
SAGINAW, MI 48601

AND PRINTING SERVICES, IN CLASS 35 (U.S. CLS.  
100, 101 AND 102).

FIRST USE 10-0-2000; IN COMMERCE 1-0-2001.

FOR: ADVERTISING SPECIALTY SERVICES,  
NAMELY CREATING ADVERTISING FOR OTH-  
ERS THROUGH CUSTOMIZED SILK SCREENING

SN 76-193,536, FILED 1-15-2001.

BRIAN NEVILLE, EXAMINING ATTORNEY