

Exhibits

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application filed by :
JOHNS MANVILLE INTERNATIONAL, INC. :
Serial No. 76/001,050 :
Filed: March 14, 2000 :
Mark: TEXTRA :
Published: 31 December 2002 :
_____ :

BOX TTAB FEE
Asst. Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

RECEIVED
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NOTICE OF OPPOSITION

ROOS INTERNATIONAL, LTD., a corporation organized and existing under the laws of the State of Arizona, believes that it will be damaged by registration of the mark shown in Serial No. 76/001,050 in Class 027 and hereby opposes the same.

As grounds of opposition, it is alleged that:

1. The Applicant seeks to register the mark TEXTRA as a trademark for wall coverings, namely, glass fiber texture wall coverings in International Class 027, based on alleged first use and first use in commerce dates as of February 16, 2000, as listed in an application filed March 14, 2000, as is evidenced by the publication of said mark in the Official Gazette in the December 31, 2002 issue.

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2. The Opposer has since April 1996 used the word mark TEXTURGLAS for wall coverings, namely, fiberglass wall coverings and wall borders, and the like. Opposer is submitting herewith as part hereof and marked Exhibit 1, Registration No. 2,272,407 issued August 24, 1999 covering this mark.

3. Opposer was the exclusive distributor of some of this Applicant's products for ten years from 1992 to 2002, and Applicant was aware of Opposer's use of the TEXTURGLAS mark for fiberglass, or glass textile wall coverings.

4. At a joint sales meeting held by Opposer in August 1999 concerning Applicant's products for which Opposer was the exclusive distributor, Applicant made a surprise announcement of its impending release of EXTRA Glass Textile Wallcovering products. At the time of this meeting, Applicant was fully aware of Opposer's use of the TEXTURGLAS[®] mark for fiberglass, or glass textile wall coverings.

5. As proof of use of the TEXTURGLAS[®] mark through the years, Opposer is submitting herewith as part hereof and marked as Exhibits 2 and 3, respectively, copies of a first and second brochures introducing and advertising the TEXTURGLAS products (the first one naming Opposer's then exclusive United States distributor, Thybony Wallcoverings, as contact point, and the latter initially doing the same, but re-used with cover-up stickers by the Opposer as well) in circulation of the thousands since 1996. Further, Opposer secured domain name

www.texturglas.com on May 16, 2000 (and as evidenced by a WHOis report from Verisign (formerly known as Network Solutions, made a part hereof and marked as Exhibit 4), and the brochure at Exhibit 3, before depleted, was made available to all for review, analysis, saving and printing in Adobe Acrobat® PDF format, using freely available Adobe Acrobat® Reader, or Adobe Acrobat®, or with any other then available PDF format file-handling program, and from May 16, 2000 until about September 2002, when this brochure was replaced with a later one, this file received no less than Five Thousand Eight Hundred (5,800) hits at *www.texturglas.com*.

6. As additional proof of use of the TEXTURGLAS® mark through the years, a label that Opposer has attached to all clear wrappers of header rolls of the TEXTURGLAS goods sold here-to-date, currently numbering two thousand, and currently in reprinting in a quantity of five thousand, is made a part hereof and marked as Exhibit 5.

7. A third TEXTURGLAS brochure was printed in excess of Thirty-Five Thousand (35,000) in September 2002, with Thirty Thousand (30,000) copies going into immediate national circulation and distribution, in the Sweets Catalog File, printed and distributed by THE MCGRAW-HILL COMPANIES, sent to all Sweets Catalog File subscribers. This was also concurrently advertised in Sweets Product News, while another concurrent Product Announcement was featured in ten regional magazines from Dodge Construction Publications, both publications of

THE MCGRAW-HILL COMPANIES; these ten regional magazines, being, namely, New York Construction News; Midwest Construction; Louisiana Contractor; Texas Construction; Southeast Construction; Colorado; Intermountain Construction; Southwest Contractor; Northwest Construction; and California Construction Link; supported the advertising promoting the TEXTURGLAS products and the TEXTURGLAS brochure, and resulting in hundreds of additional brochure and information requests, but with Opposer having just Five Thousand (5,000) then-remaining copies, those are virtually depleted now. Since October 4, 2002, a replacement of this brochure, with all ™ notices changed to the ® symbol, has been available to all for review, analysis, saving and printing in Adobe Acrobat® PDF format at Opposer's www.texturglas.com website at the TEXTURGLAS® link, or obtained directly at www.roosinternational.com/pdf/texturglas_brochure.pdf, and it is also in printing now. A copy of the Dodge Construction Publications confirmation of both the regional magazine and the Sweets Product News advertisements is made a part hereof, and is marked as Exhibit 6. A copy of the September 2002 TEXTURGLAS brochure is made a part hereof, and is marked as Exhibit 7, while its replacement, which is web-available now, and on information and belief, will be in distribution in the thousands to sales representatives, distributors, and customers by the time this is being sent to the Applicant by the Trademark Trial and Appeal Board, is made a part hereof, and is marked as Exhibit 8 (as prints from the web-based version). Meanwhile, until the new brochure is printed, many of Opposer's sales representatives, distributors, and customers have been directed to the website at

www.roosinternational.com/pdf/texturglas_brochure.pdf to view, read, print, and/or save the new brochure, and from the October 4, 2002 posting until current to the date below, this new brochure itself has received at least Nine Hundred Sixty (960) hits.

8. As additional proof of use of the mark through the years, Opposer is submitting herewith as part hereof and marked as Exhibit 9, TEXTURGLAS catalogs in a red binder marked TEXTURGLAS™, first printed at a quantity of Two Thousand Eight Hundred Fifty (2,850) in July 1996 (this specimen naming Opposer's then exclusive United States distributor, Thybony Wallcoverings, as contact point). Yet, since these catalogs were quickly depleted, and since they were expensive, Opposer, through the years has compiled several "alternate catalogs" from its assortment of TEXTURGLAS® product brochures, information flyers and sheets, product samples, information about related products, including two TEXTURGLAS catalogs using the brochure in Exhibit 3 as their covers (with the over-stickered replacement of contact information from Thybony Wallcoverings to Opposer), and others, using the TEXTURGLAS brochure in Exhibit 7 as the cover of several different variants of catalogs, all distributed in the many thousands by the Opposer across the United States, all made a part hereof and attached as Exhibits 10, 11, 12 and 13.

9. Also showing proof of use of the mark through the years, Opposer attaches hereto as part hereof and marked as Exhibits 14, 15, and 16, a

TEXTURGLAS™ Estimating Guideline, the TEXTURGLAS™ Mold and Mildew Protection flyer, and the 1 July 1998 and 10 November 1999 TEXTURGLAS™ Mold and Mildew Protection instruction sheets (all reprinted, copied and distributed across the United States in the several thousands).

10. Lastly, showing proof of use of the mark through the years, Opposer attaches hereto as part hereof and marked as Exhibits 17, 18, 19, 20, 21, and 22, TEXTURGLAS™ Distributor Price sheets for calendar years 2002, 2001, 1999, 1998, 1997 and 1996 (note, the 1997 price sheet uses Opposer's then-known also-known-as name, Tasso).

11. There is no issue as to priority. Applicant's actual dates of first use are subsequent to Opposer's April 1996 first use and first use in commerce dates.

12. Opposer has developed an exceedingly valuable goodwill in respect to the mark with its goods as shown by the aforesaid brochures, catalogs, and flyers, as well as direct use of the mark on packaging for the goods.

13. By virtue of its efforts, and the expenditure of considerable sums for promotional activities, and by virtue of the excellence of its service and products, the Opposer has gained for its above-identified mark, a most valuable reputation.

14. By virtue of its application, Applicant proposes registration of the word TEXTRA for its goods, glass fiber textile wall coverings.

15. Yet, in all of Applicant's brochures, and throughout Applicant's internet website for TEXTRA products, Applicant uses the mark TEXTRA, followed by the words "Glass Textile Wallcoverings"; thus "TEXTRA™ Glass Textile Wallcoverings"; and this is its dominant style of use of the mark. See Exhibits 23 and 24 comprising Applicant's brochures and prints of Applicant's internet website at <http://www.jm.com/textra/index.html>.

16. The trademark proposed for registration by the Applicant, as used by the Applicant, is audibly identical to Opposer's. Phonetically, the marks as used by the Applicant, are virtually indistinguishable: TEX'-TUR-GLAS versus TEX'-TRA-GLAS. The effective identicalness is dramatically demonstrated if one rapidly repeats these terms a few times.

17. The trademark proposed for registration by the Applicant, as used by the Applicant, raises the substantially identical sound and image engendered by the Opposer's word mark TEXTURGLAS with its wall coverings, thus "TEXTURGLAS Wall Coverings" and "TEXTRA Glass Textile Wallcoverings".

18. The trademark proposed for registration by the Applicant, as used by the Applicant, when applied to goods that are virtually the same as and to goods

similar to those sold by the Opposer, as, e.g., fiberglass wall coverings (also known as glass textile wall coverings), so nearly resembles the Opposer's mark when sounded out as to be likely to be confused therewith and mistaken therefor. The Applicant's mark as used, when sounded out, is deceptively similar to Opposer's mark so as to cause confusion and lead to deception as to the origin of Applicant's goods bearing the Applicant's mark.

19. Even if Applicant were to change its advertising and its use of the TEXTRA mark, consumers, dealers, and resellers of wall covering will see and remember the TEXTRA products as Glass Textile Wallcoverings and associate the mark with the goods, thus conjuring up or remembering TEXTRA Glass Textile Wallcoverings. These memories and impressions will eventually fade leaving consumers, sales representatives, dealers, and resellers of wall covering with TEXTRAGlass wall coverings and TEXTURGLAS wall coverings.

20. On information and belief, starting at the joint sales meeting in August of 1999, referenced above, and continuing to the present hereof, Applicant appears to have targeted a campaign to mimic Opposer's TEXTURGLAS registered mark as identically as possible with virtually identical, or at least very similar goods, with full knowledge of Opposer's TEXTURGLAS registered mark with its goods. From its surprise announcement of its impending release of TEXTRA Glass Textile Wallcovering products, Applicant has already cost Opposer valuable long-term sales representative and distributor relationships. Additionally,

Applicant is currently soliciting Opposer's current and former sales representatives, distributors, and customers with its TEXTRA Glass Textile Wallcovering products.

21. Moreover, since Applicant has begun marketing its TEXTRA Glass Textile Wallcovering products, Opposer has been receiving communications from various trade representatives and customers, wondering how Opposer is related to TEXTRA Glass Textile Wallcovering products, wondering how TEXTRA Glass Textile Wallcovering products are related to TEXTURGLAS wall coverings, or wondering if TEXTURGLAS wall coverings is being replaced with TEXTRA Glass Textile Wallcovering products.

22. If the Applicant is permitted to use and register its mark for its goods, as specified in the application herein opposed and the facts herein presented, confusion in trade resulting in damage and injury to the Opposer would be caused and would result by reason of the similarity between the Applicant's TEXTRA mark in TEXTRA™ Glass Textile Wallcoverings and the Opposer's TEXTURGLAS mark in TEXTURGLAS® Wall Coverings. Persons familiar with Opposer's mark and its use would be likely to buy Applicant's goods as and for products made and sold by the Opposer. Any such confusion in trade inevitably would result in loss of sales to the Opposer. Furthermore, any defect, objection or fault found with Applicant's products marketed under its mark would necessarily reflect upon and seriously

injure the reputation which the Opposer has established for its services and products merchandised under its marks.

23. If the Applicant is granted the registration herein opposed, it would thereby obtain at least a prima-facie exclusive right to the use of its mark. Such registration would be a source of damage and injury to the Opposer.

WHEREFORE, the Opposer prays that the application Serial No. 76/001,050 be rejected, and that the mark therein sought for the goods therein specified in International Class 027 be denied and refused.

A duplicate copy of this Notice of Opposition and the fee required by 37 CFR §2.6(a)(17) are enclosed herewith.

Respectfully submitted this 2nd day of January, 2003,

ROOS INTERNATIONAL, LTD., Opposer

By



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EXHIBIT 1

TTAB FEE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application filed by
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U.S. Patent & TMO/c/TM Mail Rcpt. Dt. #57



01-06-2003

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CERTIFICATE OF MAILING

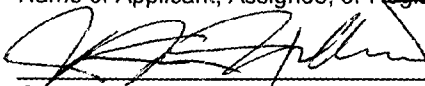
Assistant Commissioner for Trademarks
Box TTAB FEE
2900 Crystal Drive
Arlington, VA 22202-3515

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Dear Sir:

I hereby certify that this correspondence, consisting of a NOTICE OF OPPOSITION with Exhibits 1 through 24 in duplicate, Check for \$300.00, and postcard are being deposited in the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Trademarks, BOX TTAB FEE, 2900 Crystal Drive, Arlington, VA 22202-3513, on 2 January 2003.

Jordan M. Meschkow, Registration No. 31,043
Name of Applicant, Assignee, or Registered Representative




Signature

2 January 2003
Date

2 January 2003

Respectfully submitted,

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