

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

GEORGIA PACIFIC CORPORATION)
 and FORT JAMES OPERATING)
 COMPANY,)
)
 Opposers,)
)
 v.)
)
 SOLO CUP COMPANY,)
)
 Applicant.)
)



11-13-2003
U.S. Patent & TMO/TM Mail Rpt Dt. #22

Opposition No. 91157923

Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

APPLICANT'S ANSWER TO NOTICE OF OPPOSITION

Applicant, SOLO CUP COMPANY ("Applicant"), by and through its attorneys, hereby responds to Opposers', GEORGIA-PACIFIC CORPORATION and FORT JAMES OPERATING COMPANY ("Opposers"), Notice of Opposition of Applicant's Application Serial No. 76/357,255, as follows:

Georgia-Pacific Corporation, a Georgia corporation, and its subsidiary Fort James Operating Company, a Virginia corporation, both having a principal place of business at 133 Peachtree Street, Atlanta, Georgia 30303 (jointly "Opposers") believe that they will be damaged by registration of the mark in Application Serial No.. 76/357,255 and hereby oppose the same under the provisions of 15 U.S.C. §1063.

ANSWER

Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in the Preamble to the Notice of Opposition, and therefore denies the same.

As grounds for the opposition, Opposers assert that:

1. Opposers or their predecessors-in-interest have manufactured and sold plastic lids since at least as early as 1960.

ANSWER

Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 1 of the Notice of Opposition, and therefore denies the same.

2. Applicant owns a utility patent, U.S. Patent No. 4,589,569 ("Applicant's Utility Patent"), for an invention Applicant described in its patent as "Lid for Drinking Cup." Applicant filed the patent application (as a continuation-in-part of copending application Ser. No. 545,076, filed October 24, 1983 and now abandoned) on August 22, 1984, the patent issued on May 20, 1986, and it will expire by October 23, 2003. A copy of Applicant's U.S. Patent No. 4,589,569 is attached at Tab A.

ANSWER

Applicant admits the allegations of paragraph 2 of the Notice of Opposition.

3. On January 10, 2002, Applicant filed a federal trademark application, Application Serial No. 76/357,255 for a Miscellaneous Design product configuration mark for plastic cup lids in Class 20 ("Applicant's Trademark Application"), claiming a date of first use of 1984 (the same year Applicant filed Applicant's Utility Patent.) Applicant's Trademark Application describes the claimed mark as: "Configuration of Cup Lid."

ANSWER

Applicant admits the allegations of paragraph 3 of the Notice of Opposition.

4. On May 15, 2002, the PTO issued an Office Action refusing Applicant's Trademark Application on the grounds that the claimed mark was functional and, as a product configuration, not inherently distinctive.

ANSWER

Applicant admits the allegations of paragraph 4 of the Notice of Opposition.

5. On November 15, 2002, Applicant filed an Amendment and Response to Office Action, amending the application to seek registration under Section 2(f) of the

Lanham Act and arguing the claimed mark was not functional.

ANSWER

Applicant admits that it filed an Amendment and Response to Office Action, amending the application to seek registration under Section 2(f) of the Lanham Act, and arguing the claimed mark was not functional.

6. On May 21, 2003, the PTO issued a Notice of Publication and the application was published for opposition on June 10, 2003.

ANSWER

Applicant admits the allegations of paragraph 6 of the Notice of Opposition.

7. Applicant's claimed mark is functional.

ANSWER

Applicant denies the allegations of paragraph 7 of the Notice of Opposition.

8. Some of the utilitarian advantages of the features of Applicant's claimed mark are disclosed in the invention that is the subject of Applicant's soon-to-be-expiring Utility Patent.

ANSWER

Applicant denies the allegations of paragraph 8 of the Notice of Opposition.

9. Applicant's claimed mark is therefore functional as stated in the U.S. Supreme Court's decision in *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23 (2001).

ANSWER

Applicant denies the allegations of paragraph 9 of the Notice of Opposition.

10. Upon information and belief, there are a relatively limited number of alternative designs available for making plastic cup lids having the same functional attributes as Applicant's design.

ANSWER

Applicant is without knowledge or information sufficient to form a belief as to the truth

of the allegations of paragraph 10 of the Notice of Opposition, and therefore denies the same.

11. Upon information and belief, Applicant's design accomplishes various functions in a superior way, including the fact that the raised lid accommodates foam and toppings and the recess and side walls accommodate a user's lips and enable a user to drink from the cup through an opening comfortably and without spillage.

ANSWER

Applicant denies the allegations of paragraph 11 of the Notice of Opposition.

12. Upon information and belief, the design of Applicant's claimed mark results from a comparatively simple or inexpensive method of manufacture.

ANSWER

Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 12 of the Notice of Opposition, and therefore denies the same.

13. The alleged mark in Applicant's Trademark Application is not inherently distinctive.

ANSWER

Applicant denies the allegation of paragraph 13 of the Notice of Opposition.

14. Applicant's Trademark Application should not be registered because the mark had not acquired secondary meaning at the time the application was filed and has not acquired distinctiveness since then.

ANSWER

Applicant denies the allegations of paragraph 14 of the Notice of Opposition.

15. Upon information and belief, numerous third parties and Opposer were selling commercially significant amounts of similar plastic cup lids, both prior to the time Applicant's Trademark Application was filed and during the time period relied upon Applicant to support its Section 2(f) claim. In light of numerous companies' use of commercially significant amounts of similar plastic cup lids, Applicant did not and cannot prove its substantially exclusive use of its claimed mark in connection with plastic cup lids.

ANSWER

Applicant denies the allegations of paragraph 15 of the Notice of Opposition.

16. Upon information and belief, Applicant's claim of acquired distinctiveness was improperly accepted because the PTO based its finding of acquired distinctiveness upon false and misleading information provided by Applicant. At the time Applicant filed the application, Opposers and numerous third parties were selling commercially significant amounts of similar plastic cup lids and Applicant was clearly aware of that fact. Nevertheless, Applicant alleged the substantial exclusivity of its use of plastic cup lids in support of its claim of acquired distinctiveness. Applicant did not meet the standards for acquired distinctiveness under Section 2(f) and therefore Applicant's Trademark Application is invalid and should not be registered.

ANSWER

Applicant denies the allegations of paragraph 16 of the Notice of Opposition.

17. Upon information and belief, Applicant's claimed mark designates a type of product (plastic cup lids), rather than identify the source of the particular product. Consequently, because Applicant's plastic cup lid functions merely to identify the type of product and not to identify and distinguish the source of Applicant's goods, Applicant's alleged mark should not be registered.

ANSWER

Applicant denies the allegations of paragraph 17 of the Notice of Opposition.

18. If Applicant's Trademark Application is permitted to be issued as a registration, such registration would damage Opposers and other third parties who manufacture, distribute, or market similar plastic cup lids to indicate a type of product, thus hindering competition.

ANSWER

Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 18 of the Notice of Opposition, and therefore denies the same.

19. Registration of Applicant's alleged mark would be a further source of damage to Opposer because it would confer upon Applicant various statutory presumptions to which it is not entitled.

ANSWER

Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 19 of the Notice of Opposition, and therefore denies the same.

All allegations that are not specifically admitted are hereby denied.

AFFIRMATIVE DEFENSES

1. Applicant's Cup Lid mark is not functional, and is thus registrable.
2. Applicant's Cup Lid mark has acquired secondary meaning and is thus an indicator of the source of Applicant's goods.
2. Applicant further alleges that Opposer's Notice of Opposition fails to state a claim upon which relief can be granted and therefore should be dismissed pursuant to Federal Rule of Civil Procedure 12(b)(6).

WHEREFORE, Applicant, Solo Cup Company, prays that Opposer's opposition to registration of its Cup Lid mark be dismissed.

Respectfully submitted,

SOLO CUP COMPANY

Date: 11/10/03

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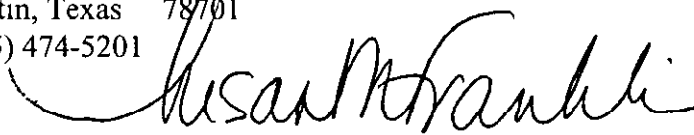
Attorneys for Applicant

(185746)

CERTIFICATE OF SERVICE

I certify and declare under penalty of perjury under the laws of the United States of America that a copy of the foregoing APPLICANT'S ANSWER TO NOTICE OF OPPOSITION was sent via first-class mail, postage prepaid, on November 10, 2003, addressed to:

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Susan M. Frankli

CERTIFICATE OF MAILING BY U.S. FIRST-CLASS MAIL

I certify that this correspondence is being deposited with the United States Postal Service as first-class mail, postage prepaid, addressed to: COMMISSIONER FOR TRADEMARKS, 2900 Crystal Drive, Arlington, Virginia 22202-3514, MAIL STOP TTAB, on November 10, 2003.


Susan M. Frankli