

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

BFS DIVERSIFIED PRODUCTS, LLC

Opposer,

v.

KIMBERTON ENTERPRISES, INC.

Applicant.

Opposition No. _____

Application No. 76/513,202

03/30/2004 SWILSON1 00000028 76513202

01 FC:6402

300.00 OP

NOTICE OF OPPOSITION

This is in the matter of an application for registration of the expression "RUBBERKOTE" for "elastomeric roof coating system, namely elastomeric exterior coating primer, elastomeric base coat and elastomeric top coat," Serial No. 76/513,202, filed April 20, 21, 2003 by Kimberton Enterprises, Inc., 336 Cold Stream Road, Kimberton, Pennsylvania 19442 (hereinafter "Applicant"), and published for opposition in the Official Gazette of December 2, 2003.

Void date: 03/30/2004 SWILSON1
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BFS Diversified Products, LLC, a Delaware limited liability company, having a business address at 525 Congressional Boulevard, Carmel, Indiana 46032, (hereinafter Opposer) believes that it would be damaged by registration as sought in the foregoing application and hereby opposes the same.

The grounds for the opposition are as follows:

1. By the application herein opposed, Applicant seeks to register "RUBBERKOTE" as a trademark for "elastomeric roof coating system, namely elastomeric exterior coating primer, elastomeric base coat and elastomeric top coat," basing such application for United States federal registration on an asserted use of the mark since April 2000 and use of the mark in commerce since May 2000.

2. Opposer, by and through its predecessors-in-interest, is the owner of all right, title and interest in and to various RUBBERGARD marks for goods and services in the field of roofing, including roofing membrane systems consisting of a rubber membrane, sealer and adhesive sold as a unit; rubber roofing membranes; and roofing services. As used herein, "Opposer's goods," "Opposer's services," and "Opposers' business," as well as expressions to a similar effect, mean the goods, the services and the business of BFS Diversified Products, LLC.

3. Opposer is the owner of U.S. Trademark Registration No. 1,642,092, registered April 23, 1991, for the mark RUBBERGARD (& Design) for rubber roofing membranes and roofing membrane systems, which registration is still in full force and effect. Opposer is also the owner of U.S. Service mark Registration No. 1,282,786, registered June 19, 1984, for the mark RUBBERGARD for roofing services.

4. The term RUBBERGARD was adopted as a mark by Opposer's predecessor at least as early as 1980 in connection with roofing membranes systems and rubber roofing membranes and at least as early as 1984 in connection with roofing services. The RUBBERGARD mark has been used continuously since then to the present in connection with the

advertising, promotion, sale and offering of Opposer's goods and services in interstate commerce; and is still in such use by Opposer.

5. Opposer is the market leader in the field of rubber roofing membranes and related roofing services. The RUBBERGARD marks are of significant value to Opposer as identifications of source in connection with the promotion, sale, rendering and offering such goods and services of Opposer and its affiliates, as well as in the conducting and identifying of the businesses of Opposer and its affiliates; and such marks distinguish such goods, such services and such businesses from those of others.

6. Opposer has been using the RUBBERGARD marks in connection with its goods, services, and business since prior to any date on which Applicant may rely on in this proceeding, and in particular, has been using such names and marks long prior to either the filing date of the application herin opposes or the dates of first use identified therein.

7. The RUBBERGARD mark for Opposer's goods and services, on the one hand, and the RUBBERKOTE mark as sought to be registered by Applicant for Applicant's goods, on the other hand, are similar in sound, spelling and appearance. Thus, the mark sought to be registered by Applicant so resembles Opposer's mark as to be likely to cause confusion, or to cause mistake, or to deceive.

8. Applicant's goods and Opposers' goods and services are closely related and are typically offered and provided to the same classes of purchasers through the same channels of trade. Specifically, the roof coating products identified by the Applicant's designation

RUBBERKOTE are used to coat the precise kinds of roofing membranes products offered by Opposer under its RUBBERGARD mark.

9. Applicant's RUBBERKOTE mark the creates the false impression that Applicant's roof coating system has been specifically approved or endorsed by Opposer for use with Opposer's market-leading roofing membranes, roofing membrane systems and roofing services, or that Applicant's goods are otherwise sponsored by or legitimately associated or connected with Opposer's goods, Opposer's services and Opposer's business.

10. Through use and promotion by Opposer and its affiliates of Opposer's RUBBERGARD mark for Opposer's goods, services and businesses, purchasers and prospective purchasers of such goods and services and/or of goods and services of the same general kind, as well as customers and prospective customers of such businesses, associate such marks with the goods, services and business of Opposer.

11. Purchasers and prospective purchasers familiar with Opposer's goods, services and businesses identified by the RUBBERGARD mark are likely to be misled into believing, contrary to fact, that Applicant's goods sold under the mark opposed herein emanate from or are in some way sponsored by Opposer or its affiliates, all to Opposer irreparable damage through loss and/or dilution of their good will as symbolized by Opposer's mark.

12. Granting of a registration as sought by Applicant through the Application herein opposed would inhibit Opposer in its free use of its RUBBERGARD mark in selling its products, promoting its services, and conducting its businesses, which would work manifest damage upon Opposer. Finally, such registration would constitute prima facie evidence of an exclusive right to

use the designation "RUBBRKOTE" for the goods designated in the application herein opposed and for all confusingly similar uses, thereby enabling Applicant to occupy a position in the trade which would further compound confusion on the part of the purchasing public, all to the damage of Opposer.

13. In view of extensive promotion and use thereof for almost a quarter of a century and in view of the widespread renown and recognition thereby developed, Opposer's RUBBERGARD mark has long been famous. Opposer's mark has been famous since long before any date on which Applicant may rely for priority purposes in this proceeding. Applicant's RUBBERKOTE mark, which is the subject of the application opposed herein, causes and will cause dilution of the distinctive quality of Opposer's famous RUBBERGARD mark, all to the further damage of Opposer.

14. The application opposed herein was filed on April 21, 2003, which was subsequent to January 16, 1996, the effective date of the federal anti-dilution statute reflected in Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c). Accordingly, the application herein opposed is subject to being opposed on the ground that the mark sought to be registered dilutes the distinctive quality of Opposer's famous mark.

15. For at least the above reasons, registration of Applicant's Serial No. 76/513,202 is herein opposed on the grounds that Applicant's proposed RUBBERKOTE mark so resembles Opposer's RUBBERGARD mark as to be likely to cause confusion, to cause mistake, or to deceive under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), and under state statutory and common law.

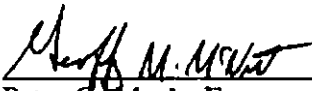
16. Additionally, registration of Applicant's RUBBERKOTE mark is opposed on the grounds that it will dilute the distinctive quality of Opposer's RUBBERGARD mark under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), and under state anti-dilution statutes.

WHEREFORE, Opposer requests that this opposition be sustained and the subject application Serial No. 76/513,202 to register the mark RUBBEROTE be refused registration.

A check in the amount of \$300.00 is attached to cover the statutory filing fee.

Respectfully submitted this 25 day of March, 2004,

BFS Diversified Products, LLC

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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Atty. Ref. No.: 016756/0229

BFS DIVERSIFIED PRODUCTS, LLC

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TRANSMITTAL LETTER

The Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Madam:

Please find attached hereto the following items:

1. Notice of Opposition (in duplicate)
2. Check (\$300.00) Covering Filing Fee

Please charge any additional fees due to Deposit Account No. 19-0741. A duplicate of this letter is attached for this purpose.

Respectfully submitted,

March 25, 2004

By: 

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Counsel for Opposers

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