

ESTTA Tracking number: **ESTTA146400**

Filing date: **06/18/2007**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	James Hardie International Finance, B.V.
Granted to Date of previous extension	06/18/2007
Address	Unit 04-07, Atrium Building Strawinskylaan 3077 Amsterdam, 1077 ZX NETHERLANDS
Party who filed Extension of time to oppose	James Hardie International Finance, B.V.
Relationship to party who filed Extension of time to oppose	Opposer moved from "Name" field to "Company" field to correctly reflect nature of Opposer.

Attorney information	Lisa Shereen Zamaludin/Thomas C. Wright GARDERE WYNNE SEWELL LLP 3000 Thanksgiving Tower 1601 Elm Street Dallas, TX 75201 UNITED STATES twright@gardere.com, lzamaludin@gardere.com Phone:214 999 4914
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Applicant Information

Application No	77061128	Publication date	04/17/2007
Opposition Filing Date	06/18/2007	Opposition Period Ends	06/18/2007
Applicant	CertainTeed Corporation 750 E. Swedesford Road Valley Forge, PA 194820101 UNITED STATES		

Goods/Services Affected by Opposition

Class 019. All goods and services in the class are opposed, namely: Non-metal building materials, namely, siding

Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2962179	Application Date	09/02/2003
Registration Date	06/14/2005	Foreign Priority Date	NONE
Word Mark	COLORPLUS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 019. First use: First Use: 2001/03/00 First Use In Commerce: 2001/03/00 ENGINEERED CEMENT COMPOSITES FOR BUILDING AND CONSTRUCTION; FIBER-REINFORCED CEMENT COMPOSITES, NAMELY, CLADDING, SIDING, TRIM, PANELS AND BOARDS FOR INTERIOR AND EXTERIOR APPLICATION FOR BUILDING AND CONSTRUCTION		

U.S. Registration No.	2825715	Application Date	07/27/2001
Registration Date	03/23/2004	Foreign Priority Date	NONE
Word Mark	COLORPLUS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 002. First use: First Use: 2001/03/00 First Use In Commerce: 2001/03/00 PAINTS, COATINGS AND STAINS FOR FIBER-CEMENT BUILDING PRODUCTS, NAMELY, A PROPRIETARY EXTERIOR PAINTS, COATINGS IN THE NATURE OF EXTERIOR COATINGS AND EXTERIOR STAINS FOR FIBER-CEMENT BUILDING PRODUCTS; A FINISH COATING SYSTEM FOR FIBER-CEMENT BUILDING PRODUCTS AND FIBER-CEMENT BUILDING PRODUCTS HAVING PRE-APPLIED FINISH COAT COMPRISED OF EXTERIOR PAINT AND STAIN COATINGS FOR FIBER-CEMENT BUILDING PRODUCTS		

Attachments	76291365#TMSN.gif (1 page)(bytes) Notice of Opposition.pdf (8 pages)(124375 bytes)
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Signature	/lsz tcw/
Name	Lisa Shereen Zamaludin/Thomas C. Wright
Date	06/18/2007

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

JAMES HARDIE INTERNATIONAL FINANCE, B.V.

OPPOSER,

OPPOSITION NO. _____

VS.

CERTAINTEED CORPORATION.,

APPLICANT.

APPLICATION SERIAL NO.
77/061,128

NOTICE OF OPPOSITION

Commissioner for Trademarks
BOX TTAB FEE
P.O. Box 1451
Alexandria, VA 22313-1451

Sir:

This matter relates to an application for trademark registration, Serial No. 77/061,128, filed December 11, 2006 by CertainTeed Corporation ("Applicant") for registration of the mark "COLORMAX" ("Opposed Mark") in connection with goods in class 19, described as "nonmetallic building materials, namely, siding." For the reasons set forth below, James Hardie International Finance, B.V. ("Opposer") believes that it would be damaged by the registration of the Opposed Mark, and hereby opposes such registration.

The grounds for the opposition are as follows:

Commencing in at least March, 2001, which upon information and belief is long prior to any date upon which Applicant may rely, and continuing without interruption to the present time, Opposer, and its predecessors in interest, have used and promoted the mark COLORPLUS (the

“Opposer’s Mark”) in connection with a wide variety of goods and services including, *inter alia*: engineered cement composites for building and construction; fiber-reinforced cement composites, namely, cladding, siding, trim, panels and boards for interior and exterior application for building and construction and paints, coatings and stains for fiber-cement building products, namely, a proprietary exterior paints, coatings in the nature of exterior coatings and exterior stains for fiber-cement building products; a finish coating system for fiber-cement building products and fiber-cement building products having pre-applied finish coat comprised of exterior paint and stain coatings for fiber-cement building products. Indeed, Opposer is the owner of all right, title and interest in and to United States Registration Nos. 2,825,715 (Class 2) and 2,962,179 (Class 19) of its COLORPLUS mark (the “Registrations”). Registration 2,825,715 was assigned to Opposer on February 26, 2004 by James Hardie Research Pty Limited. Copies of the Registrations are attached hereto as Exhibit A, and a copy of the Trademark Assignment Abstract of Title is attached as Exhibit B.

Opposer's has extensively used and promoted COLORPLUS in the United States in connection with the goods and services set forth in the Registrations, and COLORPLUS has thus come to indicate to the relevant trade and consumers, goods and services having their source of origin in, or connected with, the Opposer.

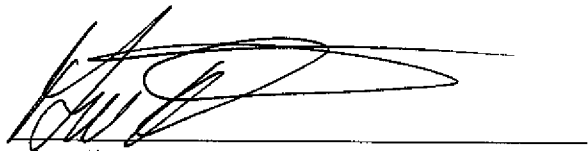
Upon information and belief, and according to the records of the United States Patent and Trademark Office, Applicant is the owner of Application Serial No. 77/061,128 and of the Opposed Mark.

The mark sought to be registered by Applicant in Application Serial No. 77/061,128 consists of a mark that so resembles Opposer's Mark, identified above and previously used and registered by Opposer, as to be likely, when applied to the products and/or services of Applicant,

to cause confusion, to cause mistake or to deceive, thereby to Opposer's damage. Moreover, Opposer's use of its "COLORPLUS" mark has priority over the Opposed Mark.

WHEREFORE, Opposer prays that Applicant be required to answer this Notice of Opposition, that the mark made the subject of Application Serial No. 77/061,128 be refused registration, and that Opposer be awarded such other and further relief as may be deemed to be just and proper.

Respectfully submitted,



Lisa Shereen Zamaludin
Thomas C. Wright
GARDERE WYNNE SEWELL LLP
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Dallas, Texas 75201
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Fax: 214-999-3554

ATTORNEYS FOR OPPOSER

EXHIBIT A

Int. Cl.: 2

Prior U.S. Cls.: 6, 11, and 16

United States Patent and Trademark Office

Reg. No. 2,825,715

Registered Mar. 23, 2004

**TRADEMARK
PRINCIPAL REGISTER**

COLORPLUS

JAMES HARDIE RESEARCH PTY LIMITED
(AUSTRALIA CORPORATION)
RESEARCH AND PRODUCT DEVELOPMENT
BUILDING
10 COLQUHOUN STREET ROSEHILL
NEW SOUTH WALES, AUSTRALIA 2142

FOR: PAINTS, COATINGS AND STAINS FOR
FIBER-CEMENT BUILDING PRODUCTS, NAME-
LY, A PROPRIETARY EXTERIOR PAINTS, COAT-
INGS IN THE NATURE OF EXTERIOR COATINGS
AND EXTERIOR STAINS FOR FIBER-CEMENT
BUILDING PRODUCTS; A FINISH COATING SYS-

TEM FOR FIBER-CEMENT BUILDING PRODUCTS
AND FIBER-CEMENT BUILDING PRODUCTS
HAVING PRE-APPLIED FINISH COAT COMPRISED
OF EXTERIOR PAINT AND STAIN COATINGS FOR
FIBER-CEMENT BUILDING PRODUCTS, IN CLASS
2 (U.S. CLS. 6, 11 AND 16).

FIRST USE 3-0-2001; IN COMMERCE 3-0-2001.

SN 76-291,365, FILED 7-27-2001.

BRIDGETT SMITH, EXAMINING ATTORNEY

Int. Cl.: 19

Prior U.S. Cls.: 1, 12, 33 and 50

United States Patent and Trademark Office

Reg. No. 2,962,179

Registered June 14, 2005

**TRADEMARK
PRINCIPAL REGISTER**

COLORPLUS

JAMES HARDIE INTERNATIONAL FINANCE,
B.V. (NETHERLANDS CORPORATION)
UNIT 04-07, ATRIUM BUILDING
STRAWINSKYLAAN 3077, 1077 ZX
AMSTERDAM, NETHERLANDS

FOR: ENGINEERED CEMENT COMPOSITES
FOR BUILDING AND CONSTRUCTION; FIBER-
REINFORCED CEMENT COMPOSITES, NAMELY,
CLADDING, SIDING, TRIM, PANELS AND
BOARDS FOR INTERIOR AND EXTERIOR APPLI-

CATION FOR BUILDING AND CONSTRUCTION,
IN CLASS 19 (U.S. CLS. 1, 12, 33 AND 50).

FIRST USE 3-0-2001; IN COMMERCE 3-0-2001.

OWNER OF U.S. REG. NO. 2,825,715.

SER. NO. 78-295,094, FILED 9-2-2003.

BRIDGETT SMITH, EXAMINING ATTORNEY

EXHIBIT B



United States Patent and Trademark Office

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Assignments on the Web > Trademark Query

Trademark Assignment Abstract of Title

Total Assignments: 1

Serial #: [76291365](#)

Filing Dt: 07/27/2001

Reg #: [2825715](#)

Reg. Dt: 03/23/2004

Registrant: JAMES HARDIE RESEARCH PTY LIMITED

Mark: COLORPLUS

Assignment: 1

Reel/Frame: [2833/0910](#)

Received: 04/23/2004

Recorded: 04/23/2004

Pages: 11

Conveyance: ASSIGNS THE ENTIRE INTEREST

Assignor: [JAMES HARDIE RESEARCH PTY LTD](#)

Exec Dt: 02/26/2004

Entity Type: CORPORATION

Citizenship: AUSTRALIA

Entity Type: CORPORATION

Citizenship: NETHERLANDS

Assignee: [JAMES HARDIE INTERNATIONAL FINANCE, B.V.](#)

UNIT 04-07, ATRIUM BUILDING STRAWINSKYLAAN 3077, 1077 ZX
AMSTERDAM, NETHERLANDS

Correspondent: ANDREW H. SIMPSON

2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

Search Results as of: 06/18/2007 11:50 AM
If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350, v.2.0.1
Web interface last modified: April 20, 2007 v.2.0.1

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