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

Proceeding	91222214
Party	Defendant Nicolon Corporation
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<b>DANDY PRODUCTS, INC.</b>	)	
<b>Opposer,</b>	)	<b>Mark: COLOR ORANGE</b>
<b>v.</b>	)	
	)	<b>Serial No.: 86057945</b>
	)	
<b>NICOLON CORPORATION</b>	)	<b>Opposition No.: 91222214</b>
<b>Applicant.</b>	)	
_____	)	

**ANSWER AND AFFIRMATIVE DEFENSES**

Applicant, Nicolon Corporation (“Applicant”), through its attorneys, hereby answers the Notice of Opposition filed by Dandy Products, Inc. (“Opposer”) in the above-captioned proceeding as follows:

With respect to the allegations contained in the first unnumbered paragraph of the Notice of Opposition, Opposer cites a U.S. trademark application the record of which is the best evidence its contents; therefore, reference is hereby made to the same. Applicant is without knowledge or information sufficient to form a belief or sufficient to truthfully admit or deny whether Opposer “believes it will be damaged by the registration of Application Serial No. 86057945”, and therefore, Applicant denies this allegation, leaving Opposer to satisfy its burden of proof. All remaining allegations in the first unnumbered paragraph are denied.

For the sake of clarity, when Applicant references its “**Orange Woven Fabric**” it is speaking specifically to its orange woven geotextile/geosynthetic fabric used for “the purposes of drainage, stabilizing inclines, recultivation, plant support, absorption, filtration, separation, stabilization and reinforcement of the soil; geotextiles for use in connection with road construction, tunnel construction, waterway construction and public works construction; fabrics for use in civil engineering; erosion control fabric” which is the subject of its Application, Serial No. 86057945. Further, in Opposer’s Notice of Opposition, Opposer made reference to the August Response (as defined below) with respect to Applicant’s Fabric. Applicant makes clear that in the August Response, and in its Answers, Applicant’s Fabric is defined as “Applicant’s woven geotextile/geosynthetic fabric used for base course reinforcement and subgrade stabilization for road, runway

and railway construction; embankment stabilizations on soft foundations; reinforcement for mechanically stabilized earth structures; and liner support”.

With respect to the allegations of the numbered paragraphs of the Notice of Opposition, unless expressly admitted herein, each allegation in the Notice of Opposition is denied:

1. Applicant is without knowledge or information sufficient to form a belief or sufficient to truthfully admit or deny the allegations asserted in Paragraph 1, and therefore denies the allegations, leaving Opposer to satisfy its burden of proof.

2. Applicant is without knowledge or information sufficient to form a belief or sufficient to truthfully admit or deny the allegations asserted in Paragraph 2, and therefore denies the allegations, leaving Opposer to satisfy its burden of proof.

3. The allegations of Paragraph 3 are admitted.

4. The allegations of Paragraph 4 are admitted.

5. The allegations of Paragraph 5 are admitted.

6. The allegations of Paragraph 6 are admitted.

7. The allegations of Paragraph 7 are admitted.

8. While Applicant is not in a position to know what Dandy “believed”, Applicant admits that Dandy is in the best position to state what it believed. Applicant, therefore, admits that Dandy believed that an orange geosynthetic fabric would make its products easy to see on the job site. Applicant is without knowledge or information sufficient to form a belief or sufficient to truthfully admit or deny the allegations that an orange geosynthetic fabric would benefit Dandy by either making its products easy to see on a jobsite or making its products easily identifiable as Dandy products as asserted in Paragraph 8, and therefore denies the allegations, leaving Opposer to satisfy its burden of proof. The remaining allegations of Paragraph 8 are denied.

9. Applicant is without knowledge or information sufficient to form a belief or sufficient to truthfully admit or deny the allegations asserted in Paragraph 9, and therefore denies the allegations, leaving Opposer to satisfy its burden of proof.

10. Applicant admits that it did supply an orange geosynthetic fabric to Dandy as a part of the proposed manufacturing and distribution arrangement. The fabric Applicant manufactured and distributed for Dandy was neither designed for nor was it suited to use used as a woven geotextile/geosynthetic fabric used for “the purposes of drainage, stabilizing inclines, recultivation, plant support, absorption, filtration, separation, stabilization and reinforcement of the soil; geotextiles for use in connection with road construction, tunnel construction, waterway construction and public works construction; fabrics for use in civil engineering; erosion control fabric”. Applicant is without knowledge or information sufficient to form a belief or sufficient to truthfully admit or deny the remaining allegations asserted in Paragraph 10, and therefore denies the allegations, leaving Opposer to satisfy its burden of proof.

11. The allegations of Paragraph 11 are admitted.

12. The allegations of Paragraph 12 are admitted.

13. Applicant is without knowledge or information sufficient to form a belief or sufficient to truthfully admit or deny the allegations asserted in Paragraph 13, and therefore denies the allegations, leaving Opposer to satisfy its burden of proof.

14. The allegations of Paragraph 14 are admitted.

15. Paragraph 15 states a legal conclusion requiring no response. To the extent a response is required, the allegations of Paragraph 15 are denied.

16. Applicant admits that **Exhibit A** is an example of a marketing piece for the Dandy POP™ and Dandy Dewatering Bag™ products. To the extent Paragraph 16 is requiring the admission or denial of a legal conclusion, Applicant is without knowledge or information sufficient to form a belief or sufficient to truthfully admit or deny the allegations that “[t]he color orange is a trademark of Dandy Products, Inc.” as well as the statements and contents of Exhibit A, as asserted in Paragraph 16, and therefore denies the allegations, leaving Opposer to satisfy its burden of proof. In addition, Applicant is without knowledge or information sufficient to form a belief or sufficient to truthfully admit or deny that the marketing piece was distributed as early as June 2002, as asserted in Paragraph 16, and therefore

denies the allegations, leaving Opposer to satisfy its burden of proof. The remaining allegations of Paragraph 16 are denied.

17. Applicant admits that **Exhibit B** is an example of a marketing piece for the Dandy Curb Inlet Protection product. To the extent Paragraph 16 is requiring the admission or denial of a legal conclusion, Applicant is without knowledge or information sufficient to form a belief or sufficient to truthfully admit or deny the allegations that “[t]he color orange is a trademark of Dandy Products, Inc.” as well as the statements and content of Exhibit B, as asserted in Paragraph 17, and therefore denies the allegations, leaving Opposer to satisfy its burden of proof. In addition, Applicant is without knowledge or information sufficient to form a belief or sufficient to truthfully admit or deny that the marketing piece was distributed as early as June 2005, as asserted in Paragraph 17, and therefore denies the allegations, leaving Opposer to satisfy its burden of proof. The remaining allegations of Paragraph 17 are denied.

18. Applicant admits that **Exhibit C** is an example of a marketing piece for the Dandy Curb Inlet Protection products. To the extent Paragraph 16 is requiring the admission or denial of a legal conclusion, Applicant is without knowledge or information sufficient to form a belief or sufficient to truthfully admit or deny the allegations that “[t]he color orange geotextile is a trademark of Dandy Products, Inc.” as well as the statements and contents of Exhibit C, as asserted in Paragraph 18, and therefore denies the allegations, leaving Opposer to satisfy its burden of proof. In addition, Applicant is without knowledge or information sufficient to form a belief or sufficient to truthfully admit or deny that the marketing piece was distributed as early as June 2006, as asserted in Paragraph 18, and therefore denies the allegations, leaving Opposer to satisfy its burden of proof. The remaining allegations of Paragraph 18 are denied.

19. Applicant admits that there are nine short videos on Opposer’s website featuring Dandy's orange-colored storm water management, inlet protection and sediment control products. Applicant is without knowledge or information sufficient to form a belief or sufficient to truthfully admit or deny the allegations that the videos were uploaded on October 22, 2009, and that they are true copies of the

videos allegedly uploaded on October 22, 2009, as asserted in Paragraph 19, and therefore denies the allegations, leaving Opposer to satisfy its burden of proof. Except as admitted, all remaining allegations in Paragraph 19 are denied.

20. Applicant is without knowledge or information sufficient to form a belief or sufficient to truthfully admit or deny the allegations asserted in Paragraph 20, and therefore denies the allegations, leaving Opposer to satisfy its burden of proof.

21. To the extent Opposer is referencing Applicant's Orange Woven Fabric, the allegations of Paragraph 21 are denied. Applicant is without knowledge or information sufficient to form a belief or sufficient to truthfully admit or deny the remaining allegations of Paragraph 21, and therefore denies the allegations, leaving Opposer to satisfy its burden of proof.

22. The allegations of Paragraph 22 are denied.

23. The allegations of Paragraph 23 are denied.

24. Applicant admits that it stated to the USPTO that "Applicant is the first, and has been since as early as May 2010, the only user of the color orange for woven textiles/geosynthetic fabrics for, among other things, for [sic] base course reinforcement and subgrade stabilization for road, runway and railway construction; embankment stabilizations on soft foundations; reinforcement for mechanically stabilized earth structures; and liner support." While Opposer seeks to reference Applicant's August 20, 2014 Response to the Office Action (the "August Response") out of context, Applicant wishes to clarify that it stated to the Examiner as follows, in Footnote 1:

Recently, one infringer has entered the marketplace using the color orange for woven geotextile/geosynthetic fabrics but Applicant has taken affirmative action against this company. Further [sic], unauthorized users of Applicant's mark does not impair the distinctiveness of the Applicant's Mark. See TMEP § 1212.05(b) (use of mark by Applicant need only be *substantially* exclusive – "this makes allowances for use of others which may be inconsequential or infringing.") (emphasis added).

Applicant also stated in its Affidavit of Lee Bryan at 11 as follows:

TenCate is the sole manufacturer of orange woven geosynthetic fabrics. In 2013, Willacoochee Industrial Fabrics, Inc. ("Willacoochee") began copying TenCate's use of orange colored yarns in woven geosynthetic fabrics. TenCate objected to Willacoochee's use of the color orange in its woven geosynthetic fabric,

and demanded that Willacoochee cease and desist its use of TenCate's orange trademark.

The remaining allegations of Paragraph 24 are denied.

25. Applicant admits that in its August Response it stated as follows: "[t]he color orange is not commonly used in the industry on woven geotextile/geosynthetic fabrics." The remaining allegations of Paragraph 25 are denied.

26. Applicant admits that in its August Response it stated as follows: "Applicant's use of the color orange in connection its [sic] Fabric is original, unique and unusual in the geotextile/geosynthetic materials industry." The remaining allegations of Paragraph 26 are denied.

27. Applicant admits that in its August Response it stated as follows: "[its] Mark does in fact serve as a source indicator and is a registrable trademark." The remaining allegations of Paragraph 27 are denied.

28. Applicant admits that in its August Response it stated as follows: "Applicant selected the color orange in connection with its Fabric not to ornament or make its product aesthetically pleasing, but rather to distinguish its goods from competitors, and to indicate Applicant as the Fabric's source." The remaining allegations of Paragraph 28 are denied.

29. Applicant admits that in its August Response it stated as follows: "Applicant first adopted the color orange in connection with the Fabric as early as May 2010." The remaining allegations of Paragraph 29 are denied.

30. Applicant admits that in its August Response it stated as follows: "there are no other competitors using the color orange or any other color (other than Carbon Black) in connection with products similar to Applicant's Fabric." The remaining allegations of Paragraph 30 are denied.

#### **COUNT I FUNCTIONALITY AND LACK OF DISTINCTIVENESS**

31. Paragraph 31 does not contain any allegations of fact requiring a response. To the extent that a response is required, Applicant denies that its Mark is functional and lacks of distinctiveness.

32. Paragraph 32 states a legal conclusion requiring no response. To an extent a response is required, Opposer should be well aware that, pursuant to TMEP § 1202.05, "color marks are **never**

inherently distinctive, and **cannot be registered on the Principal Register without a showing of acquired distinctiveness** under §2(f) of the Trademark Act”. (emphasis added). Accordingly, Applicant admits that its COLOR ORANGE Mark has not become inherently distinctive, but rather through Applicant’s continuous and notorious use of its COLOR ORANGE Mark, its Mark has acquired secondary meaning in the relevant consuming public. The remaining allegations of Paragraph 32 are denied

33. To the extent Opposer is referencing Applicant’s Orange Woven Fabric, the allegations of Paragraph 33 are denied. Paragraph 33 states a legal conclusion requiring no response. To the extent a response is required, Applicant admits that through its continuous and notorious use of its ORANGE COLOR Mark, the Mark has acquired secondary meaning in the relevant consuming public. The remaining allegations of Paragraph 33 are denied.

34. Applicant is without knowledge or information sufficient to form a belief or sufficient to truthfully admit or deny the allegations asserted in Paragraph 34, and therefore denies the allegations, leaving Opposer to satisfy its burden of proof.

35. Paragraph 35 states a legal conclusion requiring no response. To the extent that a response is required, Applicant is without knowledge or information sufficient to form a belief or sufficient to truthfully admit or deny the allegations asserted in Paragraph 35, and therefore denies the allegations, leaving Opposer to satisfy its burden of proof. The remaining allegations of Paragraph 35 are denied

36. Paragraph 36 states a legal conclusion requiring no response. To the extent a response is required, the allegations in Paragraph 36 are denied.

#### **COUNT II-LIKELIHOOD OF CONFUSION**

37. Paragraph 37 does not contain any allegations of fact requiring a response. To the extent that a response is required, Applicant denies that its Mark is likely to cause confusion with any alleged orange trademark Dandy allegedly owns.

38. Applicant is without knowledge or information sufficient to form a belief or sufficient to truthfully admit or deny the allegations asserted in Paragraph 38, and therefore denies the allegations, leaving Opposer to satisfy its burden of proof.

39. Applicant admits that it produced marketing pieces for Dandy. To the extent Paragraph 16 is requiring the admission or denial of a legal conclusion, Applicant is without knowledge or information sufficient to form a belief or sufficient to truthfully admit or deny the allegations that “[t]he color orange geotextile is a trademark of Dandy Products, Inc.” as well as the statements and contents of the “several marketing pieces”, as asserted in Paragraph 39, and therefore denies the allegations, leaving Opposer to satisfy its burden of proof. The remaining allegations of Paragraph 39 are denied.

40. Paragraph 40 states a legal conclusion requiring no response. To the extent a response is required, Applicant avers, based on Dandy’s own admissions in Paragraph 8, that Dandy’s use of the color orange is functional and for this reason, Dandy’s alleged orange mark cannot function as a trademark and is not entitled to protection. In addition, Applicant is without knowledge or information sufficient to form a belief or sufficient to truthfully admit or deny the allegations that “Oranged-colored geosynthetic fabric has become distinctive of Dandy’s products in commerce”, as asserted in Paragraph 40, and therefore denies the allegations, leaving Opposer to satisfy its burden of proof.

41. Paragraph 41 states a legal conclusion requiring no response. To the extent a response is required, Applicant avers, based on Dandy’s own admissions in Paragraph 8, that Dandy’s use of the color orange is functional and for this reason, Dandy’s alleged orange mark cannot function as a trademark and is not entitled to protection. In addition, Applicant is without knowledge or information sufficient to form a belief or sufficient to truthfully admit or deny the allegations that “Dandy owns the trademark to orange-colored geosynthetic fabric used in connection with drainage, stabilizing inclines, recultivation, plant support, absorption, filtration, separation, stabilization and reinforcement of the soil, road construction, tunnel construction, waterway construction, public works construction, civil engineering, and erosion control applications,” as asserted in Paragraph 41, and therefore denies the allegations, leaving Opposer to satisfy its burden of proof. The remaining allegations of Paragraph 41 are denied.

42. Based in Dandy's own admissions in Paragraph 8, Dandy's use of the color orange in connection with its products does not function as a trademark and is not entitled to protection. For a trademark to be abandoned there must be some tenable right to use and enforce the mark. In this case, Applicant avers that Dandy does not own an orange color trademark, and therefore, has no trademark rights to abandon. The allegations in Paragraph 42 are denied.

43. Paragraph 43 states a legal conclusion requiring no response. To the extent a response is required, the allegations of Paragraph 43 are denied.

44. Paragraph 44 states a legal conclusion requiring no response. To the extent a response is required, the allegations of Paragraph 44 are denied.

### **COUNT III - INEQUITABLE CONDUCT**

45. Paragraph 45 does not contain any allegations of fact requiring a response. To the extent that a response is required, Applicant denies knowingly making misrepresentations to the U.S. Patent and Trademark Office during the prosecution of the Application.

46. The allegations of Paragraph 46 are denied.

47. The allegations of Paragraph 47 are denied.

48. Paragraph 48 states a legal conclusion requiring no response. To the extent a response is required, the allegations of Paragraph 48 are denied.

### **OPPOSER'S REQUEST FOR RELIEF**

Opposer's Request for Relief does not state any factual allegations, and therefore, no response is required. Applicant denies that Opposer is entitled to any such relief.

### **AFFIRMATIVE DEFENSES**

Applicant asserts that the following affirmative defenses bar Opposer's requested relief in its Notice of Opposition.

### **FIRST AFFIRMATIVE DEFENSE**

Opposer's claims alleged in the Notice of Opposition fail to state a claim upon which relief can be granted.

### **SECOND AFFIRMATIVE DEFENSE**

Opposer's claims alleged in the Notice of Opposition lack merit and are insufficient to support refusing the registration of the Application.

### **THIRD AFFIRMATIVE DEFENSE**

Opposer's claims alleged in the Notice of Opposition fail to state short and plain statements of grounds for the Opposition, and therefore, Applicant does not have proper notice of the actual asserted grounds for this Opposition.

### **FOURTH AFFIRMATIVE DEFENSE**

Opposer will not suffer any damages by U.S. registration and use by Applicant of the opposed Mark.

### **FIFTH AFFIRMATIVE DEFENSE**

Opposer's claims are barred because a third-party, Hickenbottom, Incorporated, has priority to use its U.S. registered COLOR ORANGE trademarks, namely: Reg. No. 1563348, covering plastic drain inlet tubing for use out of doors in fields, ponds, catchbasins, and the like, in Class 17, granted on October 31, 1989; and Reg. No. 2880664, covering "environmental erosion control and storm water products, namely, non-metal construction drain filter inlets used on construction sites and the like," in Class 19, granted on September 7, 2004. (Copies of Hickenbottom's registrations are attached hereto as **Exhibit I**). Dandy is well aware that Hickenbottom filed a Letter of Protest in opposition of its application to register the COLOR ORANGE, Serial No. 78078529, covering "environmental erosion control products, namely, environmental remediation bags and rolls and filters made of erosion control fabric use in inlet protection," and subsequently filed a trademark infringement lawsuit against Dandy in the Southern District of Iowa, United States District Court, Ottumwa Division. On February 9, 2004, Dandy expressly withdrew its application to register the COLOR ORANGE mark. (A copy of the Hickenbottom v. Dandy Complaint is attached hereto as **Exhibit II**; a Copy of Dandy's Express Withdrawal of Application is attached hereto as **Exhibit III**).

#### **SIXTH AFFIRMATIVE DEFENSE**

Opposer does not own an Orange trademark since by its own allegations in Paragraph 8 of its Opposition, it “believed that orange geosynthetic fabric would benefit Dandy by making its product easy to see on the job site and easily identifiable as Dandy[‘s] products”. This is a clear admission that its use of the color orange is functional. Accordingly, by its own admission, Dandy’s use of the color orange in connection with its storm water management, inlet protection and sediment control products is functional; and therefore, cannot function as a trademark, and is not entitled to protection.

#### **SEVENTH AFFIRMATIVE DEFENSE**

Applicant applied for its Mark in good faith.

#### **EIGHTH AFFIRMATIVE DEFENSE**

Applicant reserves its right to amend its answer to the “Notice of Opposition” and its affirmative defenses, assert such additional affirmative defenses as it deems appropriate and such counterclaims as may be permitted that may now exist or in the future are available based upon discovery and further factual investigation in this proceeding.

**WHEREFORE**, Applicant Nicolon Corporation respectfully requests that the Trademark Trial and Appeal Board dismiss the above-captioned Notice of Opposition in its entirety, that United State Trademark Application Serial No. 86057945, for ORANGE COLOR be allowed for registration, and that the Board grant Applicant Nicolon Corporation such other and further relief as it deems just and appropriate.

Dated: July 13, 2015

Respectfully submitted,  
**Nicolon Corporation**

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**CERTIFICATE OF SERVICE**

I, Stacy Raphael Stewart, counsel to Applicant Nicolon Corporation, in Opposition No. 91222214, certify that, on the 13th day of July, 2015, I served a copy of the **ANSWER AND AFFIRMATIVE DEFENSES**, via first class prepaid mail, upon:

Terry L. Clark  
Marta B. Allard  
**Bass, Berry & Sims PLC**  
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          /Stacy R. Stewart/            
Stacy R. Stewart, Esq.