

ESTTA Tracking number: **ESTTA683398**

Filing date: **07/13/2015**

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

Proceeding	91222214
Party	Defendant Nicolon Corporation
Correspondence Address	STACY R. STEWART CANTOR COLBURN LLP 1180 PEACHTREE ST NE STE 2050 ATLANTA, GA 30309-7525  TM-CT@cantorcolburn.com
Submission	Answer
Filer's Name	/Stacy R. Stewart/
Filer's e-mail	sstewart@cantorcolburn.com, TM-CT@cantorcolburn.com
Signature	/Stacy R. Stewart/
Date	07/13/2015
Attachments	7FA5221- Dandy Answers Final.pdf(81545 bytes ) EXHIBIT I - 76363902 - Hickenbottom Inc.pdf(26850 bytes ) EXHIBIT I - 73753809 - Hickenbottom Inc.pdf(28610 bytes ) EXHIBIT II - Hickenbottom Inc v. Dandy Products Inc Complaint.pdf(639038 bytes ) EXHIBIT III - 78078529 - NOTICE OF WITHDRAWAL OF APPLICATION - DANDY.pdf(24119 bytes )

**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**

By: /Stacy R. Stewart/  
Stacy R. Stewart, Esq.  
Jeffery B. Arnold, Esq.  
**Cantor Colburn LLP**  
1180 Peachtree Street  
Suite 2050  
Atlanta, Georgia 30309  
Phone: 404-607-9991  
Fax: 404-607-9981  
sstewart@cantorcolburn.com  
Attorneys for Nicolon Corporation

**CERTIFICATE OF SERVICE**

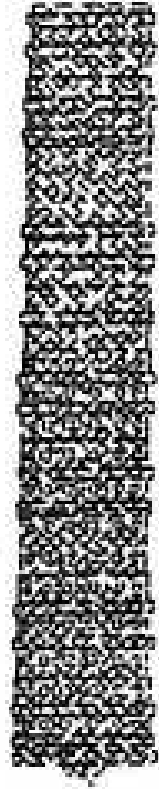
I, Stacy Raphael Stewart, counsel to Applicant Nicolon Corporation, in Opposition No. 91222214, certify that, on the 13th day of July, 2015, I served a copy of the **ANSWER AND AFFIRMATIVE DEFENSES**, via first class prepaid mail, upon:

Terry L. Clark  
Marta B. Allard  
**Bass, Berry & Sims PLC**  
1201 Pennsylvania Avenue NW  
Suite 300  
Washington, DC 20004

          /Stacy R. Stewart/            
Stacy R. Stewart, Esq.

Generated on: This page was generated by TSDR on 2015-07-13 22:13:30 EDT

Mark:



US Serial Number: 76363902

Application Filing Date: Jan. 25, 2002

US Registration Number: 2880664

Registration Date: Sep. 07, 2004

Register: Principal

Mark Type: Trademark

Status: The registration has been renewed.

Status Date: Oct. 23, 2013

Publication Date: Jun. 15, 2004

---

## Mark Information

---

Mark Literal Elements: None

Standard Character Claim: No

Mark Drawing Type: 2 - AN ILLUSTRATION DRAWING WITHOUT ANY WORDS(S)/ LETTER(S)/NUMBER(S)

Description of Mark: The mark consists of the color orange as applied to the entirety of the goods. The dotted outline of the goods is intended to show the position of the mark and is not intended to be a part of the mark.

Color(s) Claimed: Color is not claimed as a feature of the mark.

Lining and Stippling Statement: The drawing is lined for the color orange.

Acquired Distinctiveness Claim: In whole

Design Search Code(s): 14.01.01 - Couplings and joints, metal pipe; Tubing (hardware); Tubes (hardware); Pipes and fittings; Pipe couplings and joints  
15.01.25 - Robots, industrial; Pumps, air (motorized); Fulcrums; Door closers; Compactors, industrial and commercial; Trash compactors, industrial; Air pumps, motorized

---

## Related Properties Information

---

Claimed Ownership of US Registrations: 1563348, 1807524

---

# Goods and Services

**Note:** The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((..)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks \*..\* identify additional (new) wording in the goods/services.

**For:** ENVIRONMENTAL EROSION CONTROL AND STORM WATER PRODUCTS, NAMELY, NON-METAL CONSTRUCTION DRAIN FILTER INLETS USED ON CONSTRUCTION SITES AND THE LIKE

**International Class(es):** 019 - Primary Class

**U.S Class(es):** 001, 012, 033, 050

**Class Status:** ACTIVE

**Basis:** 1(a)

**First Use:** Apr. 26, 1979

**Use in Commerce:** Oct. 27, 1979

## Basis Information (Case Level)

**Filed Use:** Yes

**Currently Use:** Yes

**Amended Use:** No

**Filed ITU:** No

**Currently ITU:** No

**Amended ITU:** No

**Filed 44D:** No

**Currently 44D:** No

**Amended 44D:** No

**Filed 44E:** No

**Currently 44E:** No

**Amended 44E:** No

**Filed 66A:** No

**Currently 66A:** No

**Filed No Basis:** No

**Currently No Basis:** No

## Current Owner(s) Information

**Owner Name:** Hickenbottom, Incorporated

**Owner Address:** 2074 Hemlock Avenue  
Fairfield, IOWA 52556  
UNITED STATES

**Legal Entity Type:** CORPORATION

**State or Country Where Organized:** IOWA

## Attorney/Correspondence Information

### Attorney of Record

**Attorney Name:** Wade Kerrigan

**Docket Number:** 59884.10001

**Attorney Primary Email Address:** [pto-kc@huschblackwell.com](mailto:pto-kc@huschblackwell.com)

**Attorney Email Authorized:** Yes

### Correspondent

**Correspondent Name/Address:** Wade Kerrigan  
Husch Blackwell LLP  
4801 Main Street, Suite 1000  
Kansas City, MISSOURI 64112  
UNITED STATES

**Phone:** 816-983-8000

**Fax:** 816-983-8080

**Correspondent e-mail:** [pto-kc@huschblackwell.com](mailto:pto-kc@huschblackwell.com)

**Correspondent e-mail Authorized:** Yes

### Domestic Representative - Not Found

## Prosecution History

Date	Description	Proceeding Number
Oct. 23, 2013	NOTICE OF ACCEPTANCE OF SEC. 8 & 9 - E-MAILED	
Oct. 23, 2013	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	68335
Oct. 23, 2013	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	68335
Oct. 17, 2013	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	68335
Oct. 22, 2013	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	68335
Oct. 17, 2013	TEAS SECTION 8 & 9 RECEIVED	
Feb. 10, 2011	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	75184
Feb. 10, 2011	SEC 7 REQUEST FILED	75184
Feb. 10, 2011	CERTIFICATE OF CORRECTION ISSUED	75184



Feb. 10, 2011	TEAS RESPONSE TO OFFICE ACTION-POST REG RECEIVED	
Sep. 24, 2010	POST REGISTRATION ACTION MAILED - SEC. 7	75184
Aug. 30, 2010	TEAS SECTION 8 & 15 RECEIVED	
Aug. 31, 2010	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	75184
Aug. 30, 2010	TEAS SECTION 7 REQUEST RECEIVED	
Sep. 07, 2004	REGISTERED-PRINCIPAL REGISTER	
Jun. 15, 2004	PUBLISHED FOR OPPOSITION	
May 26, 2004	NOTICE OF PUBLICATION	
Apr. 05, 2004	APPROVED FOR PUB - PRINCIPAL REGISTER	
Mar. 18, 2004	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Mar. 18, 2004	PAPER RECEIVED	
Jun. 18, 2003	CASE FILE IN TICRS	
Dec. 04, 2002	LETTER OF SUSPENSION MAILED	
Oct. 31, 2002	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Nov. 04, 2002	PAPER RECEIVED	
May 01, 2002	NON-FINAL ACTION MAILED	
Apr. 22, 2002	ASSIGNED TO EXAMINER	77304
Apr. 19, 2002	ASSIGNED TO EXAMINER	77304
Apr. 17, 2002	ASSIGNED TO EXAMINER	78065

---

### Maintenance Filings or Post Registration Information

---

**Affidavit of Continued Use:** Section 8 - Accepted

**Affidavit of Incontestability:** Section 15 - Accepted

**Renewal Date:** Sep. 07, 2014

**Change in Registration:** Yes

**Correction made to Registration:** In the statement, column 1, line 1, "Hickenbottom, Inc", should be deleted and "Hickenbottom, Incorporated", should be inserted.

---

### TM Staff and Location Information

---

**TM Staff Information - None**

**File Location**

**Current Location:** GENERIC WEB UPDATE

**Date in Location:** Oct. 23, 2013



Filed 44E: No                      Currently 44E: No                      Amended 44E: No  
Filed 66A: No                      Currently 66A: No  
Filed No Basis: No                      Currently No Basis: No

## Current Owner(s) Information

**Owner Name:** HICKENBOTTOM, INCORPORATED  
**Owner Address:** 2074 Hemlock Avenue  
FAIRFIELD, IOWA 52556  
UNITED STATES  
**Legal Entity Type:** CORPORATION                      **State or Country Where Organized:** IOWA

## Attorney/Correspondence Information

### Attorney of Record

**Attorney Name:** Kris Kappel                      **Docket Number:** 59884.10019  
**Attorney Primary Email Address:** [pto-kc@huschblackwell.com](mailto:pto-kc@huschblackwell.com)                      **Attorney Email Authorized:** Yes

### Correspondent

**Correspondent Name/Address:** Kris Kappel  
Husch Blackwell Sanders LLP  
4801 Main Street, Suite 1000  
Kansas City, MISSOURI 64112  
UNITED STATES  
**Phone:** 816-983-8000                      **Fax:** 816-983-8080  
**Correspondent e-mail:** [pto-kc@huschblackwell.com](mailto:pto-kc@huschblackwell.com)                      **Correspondent e-mail Authorized:** Yes

### Domestic Representative - Not Found

## Prosecution History

Date	Description	Proceeding Number
Apr. 21, 2011	CERTIFICATE OF CORRECTION ISSUED	59136
Feb. 10, 2011	TEAS RESPONSE TO OFFICE ACTION-POST REG RECEIVED	
Sep. 21, 2010	POST REGISTRATION ACTION MAILED - SEC. 7	59136
Sep. 15, 2010	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	59136
Sep. 14, 2010	TEAS SECTION 7 REQUEST RECEIVED	
Nov. 12, 2009	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	76533
Nov. 12, 2009	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Nov. 09, 2009	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	76533
Nov. 02, 2009	TEAS SECTION 8 & 9 RECEIVED	
Nov. 24, 2008	CASE FILE IN TICRS	
May 06, 2005	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Dec. 17, 1995	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	
May 01, 1995	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	
Oct. 31, 1989	REGISTERED-PRINCIPAL REGISTER	
Aug. 08, 1989	PUBLISHED FOR OPPOSITION	
Jul. 09, 1989	NOTICE OF PUBLICATION	
Feb. 22, 1989	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Mar. 30, 1989	APPROVED FOR PUB - PRINCIPAL REGISTER	
Mar. 22, 1989	EXAMINERS AMENDMENT MAILED	
Mar. 21, 1989	ALLOWANCE/COUNT WITHDRAWN	
Feb. 06, 1989	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Sep. 26, 1988	UNRESPONSIVE/DUPLICATE PAPER RECEIVED	
Jan. 17, 1989	NON-FINAL ACTION MAILED	

## Maintenance Filings or Post Registration Information

**Affidavit of Continued Use:** Section 8 - Accepted

**Affidavit of Incontestability:** Section 15 - Accepted

**Renewal Filed:** Yes

**Renewal Date:** Oct. 31, 2009

**Change in Registration:** Yes

**Correction made to Registration:** In the statement, column 1, line 1, INC. should be deleted, and "INCORPORATED" should be inserted.

---

## TM Staff and Location Information

---

**TM Staff Information - None**  
**File Location**

**Current Location:** Not Found

**Date in Location:** Jun. 03, 2011

FILED  
SOUTHERN DISTRICT OF IOWA  
03 MAR -6 AM 8:15  
SOUTHERN DISTRICT OF IOWA

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF IOWA  
OTTUMWA DIVISION

Hickenbottom, Inc. ]  
Plaintiff, ]  
vs. ]  
Dandy Products, Inc. ]  
Defendant. ]

FILE NUMBER  
**4:03-CV-10123**  
VERIFIED COMPLAINT  
(JURY TRIAL DEMANDED)

Plaintiff, Hickenbottom, Inc., for its Verified Complaint against the Defendant above named, hereby states and alleges as follows:

THE PARTIES

1. Plaintiff, Hickenbottom, Inc. ("Hickenbottom") is an Iowa corporation with its principal place of business located at 2074 Hemlock Avenue, Fairfield, Iowa 52556. Plaintiff is in the business of servicing the soil and water management/conservation industry, and manufactures and sells water management and environmental erosion control products in the nature of non-metal drain filter inlet devices under its federally registered ORANGE COLOR trademark. Plaintiff's erosion control products are used in a variety of erosion control applications including, but not limited to, construction, stormwater, and agricultural dewatering projects.

2. On information and belief, Defendant, Dandy Products, Inc. ("Dandy Products") is an Ohio corporation with its principal place of business at 2011 Harrisburg Pike, Suite R, Grove City, Ohio 43123. Defendant, Dandy Products, is in the business of, among other things, selling environmental erosion control products in the nature of non-metal drain inlet protection devices that are used in stormwater systems and dewatering projects, and are colored orange.

Pleading # 1

JURISDICTION AND VENUE

3. This is an action for trademark infringement, false designation of origin, and unfair competition under 15 U.S.C. §§1114 and 1125(a), under Chapter 548 of the Iowa Code and under the common law.

4. This Court has jurisdiction over the subject matter of this action pursuant to 28 U.S.C. §1338 and supplemental jurisdiction under 28 U.S.C. §1367(a).

5. Venue in this district is proper pursuant to 28 U.S.C. §1391(b).

FACTS GIVING RISE TO VIOLATIONS OF LAW

6. On or about October, 1979, Plaintiff began selling in interstate commerce environmental erosion control products in the nature of non-metal drain filter inlet devices primarily used for erosion and sediment control in construction, stormwater, and agricultural dewatering applications. Since Plaintiff's inception, it has continuously marked its drain filter inlet products with a distinctive bright ORANGE COLOR trademark covering the exterior thereof. On September 26, 1988, Plaintiff filed with the United States Patent and Trademark Office (the "USPTO") an application to register its ORANGE COLOR trademark on the USPTO's Principal Register. On October 31, 1989, the USPTO registered the Plaintiff's ORANGE COLOR trademark on the Principal Register under Section 2(f) of the Lanham Act, 15 U.S.C. §1052(f), Registration No. 1,563,348, for "plastic drain inlet tubing for use out of doors in fields, ponds, catch basins, and the like" under international class 17. A copy of this registration is attached hereto as Exhibit A.

7. Plaintiff is also the owner of Iowa state Registration No. 8994, covering the ORANGE COLOR exterior of Plaintiff's drain filter inlet products, which was issued to Plaintiff on July 15, 1988.

8. In the more than twenty (20) years since the ORANGE COLOR trademark was first adopted and used by Plaintiff, Plaintiff has made extensive, continuous, and substantially exclusive use of such color mark in connection with the sale and/or use of its drain filter inlet products throughout the United States and in Canada, Europe, and Australia. Plaintiff's drain filter inlets bearing its distinctive ORANGE COLOR trademark are used in a variety of water management and erosion control applications, and are commonly sold to construction, stormwater, and agricultural drainage contractors, as well as drainage pipe manufacturers, and wholesale and retail dealers of environmental erosion control products.

9. In the more than twenty (20) years since the ORANGE COLOR trademark was first adopted and used by the Plaintiff, Plaintiff has spent substantial amounts of time and money promoting and advertising the ORANGE COLOR trademark in connection with its drain filter inlet products through, among other things, printed brochures, catalogs, trade journal advertisements, trade shows, and national and international erosion control conventions. Most printed advertisements since Plaintiff's inception in 1979 have touted the use of the ORANGE COLOR trademark to identify the Plaintiff's drain filter inlets with statements such as "LOOK FOR THE BRIGHT ORANGE TOP" or "LOOK FOR THE BRIGHT ORANGE INLET-HICKENBOTTOM'S TRADEMARK."

10. As a result of Plaintiff's long-term, extensive, continuous and substantially exclusive use of its ORANGE COLOR trademark in connection with its erosion control drain filter-inlet products, and as a result of Plaintiff's extensive promotion and advertising of its ORANGE COLOR trademark in connection with such goods, the color orange has become associated in the minds of the consuming public with environmental erosion control drain filter inlet products originating from the Plaintiff.

11. The validity of Plaintiff's registered trademark for the color orange, and Plaintiff's exclusive right to use its ORANGE COLOR trademark in commerce in connection with its environmental erosion control drain filter inlets, are incontestable pursuant to 15 U.S.C. §§1065 and 1115(b), as the required affidavits of continuous use have been filed with the Commissioner of Patents and Trademarks.

12. At a date unknown to Plaintiff, but long subsequent to Plaintiff's initial adoption, use and registration of its ORANGE COLOR trademark, Defendant Dandy Products began selling in interstate commerce environmental erosion control products in the nature of drain inlet protection devices which bear a bright orange color and may be used in a variety of construction, stormwater, and agricultural applications to filter sediment and debris, and control silt and sediment flow through drain inlets.

13. On information and belief, Defendant's drain inlet protection devices can be used, and are used, in the same or similar dewatering applications as Plaintiff's drain filter inlet devices, and may be used in direct association with Plaintiff's drain filter inlets.

14. On information and belief, Plaintiff and Defendant service the same water management and erosion control industry, advertise in the same channels of trade, and oftentimes advertise through the same media sources. Defendant adopted and began use of the color orange to mark its environmental erosion control products without the permission or authority of the Plaintiff, and now prominently advertises the color orange in association with such products. Copies of Defendant's representative advertisements are attached hereto as Exhibits B and C.

15. On August 9, 2001, Defendant Dandy Products filed with the USPTO an application to register the color orange as its trademark under international class 19 for its erosion control products. Such application currently stands rejected by the USPTO based on a holding of



likelihood of confusion with the Plaintiff's ORANGE COLOR trademark covered under its prior existing federal Registration No. 1,563,348.

16. On January 25, 2002, Plaintiff also filed an application with the USPTO to register its ORANGE COLOR trademark on the Principal Register for environmental erosion control and stormwater products, namely, non-metal construction drain filter inlets used on constructions sites and the like, under international class 19. All statutory requirements for registration of Plaintiff's ORANGE COLOR trademark under international class 19 have been met, except that prosecution has been suspended pending disposition of Defendant's earlier application to register the color orange under the same class. Plaintiff's right of exclusive use and right to register its ORANGE COLOR trademark is therefore being damaged by the continued existence of Defendant's application to register the color orange for its erosion control products.

17. Defendant's unauthorized use and application to register the color orange in connection with erosion control products in the nature of inlet protection devices is likely to cause mistake, confusion and deception among members of the public as to the source of origin of the parties' respective goods and as to whether Defendant's goods are approved by or otherwise associated with Plaintiff.

18. By letter dated March 9, 2002, Plaintiff placed Defendant on notice of Plaintiff's long-term extensive and continuous use and rights in and to the color orange with respect to its environmental erosion control drain filter inlet products, and of its federal registration covering the same. By subsequent letter dated June 28, 2002, Plaintiff again advised Defendant's counsel of its rights in and to the color orange, and notified the Defendant of its infringement of such rights. Defendant, Dandy Products, has not responded to Plaintiff's letter of June 28, 2002; nor has it

discontinued use of the color orange on erosion control products in the nature of drain inlet protection devices.

19. On information and belief, Defendant's conduct and continued unauthorized use of the color orange in connection with erosion control products in the nature of drain inlet protection devices has been willful and intentional with reckless disregard for the Plaintiff's rights in the color orange.

20. Defendant's conduct has subjected and will continue to subject Plaintiff to irreparable injury for which Plaintiff has no adequate remedy at law.

COUNT ONE

FEDERAL TRADEMARK INFRINGEMENT

21. Plaintiff incorporates by reference the allegations of paragraphs 1-20 above.

22. Defendant's conduct constitutes trademark infringement in violation of Section 32(1) of the Lanham Act, 15 U.S.C. §1114(1).

COUNT TWO

FALSE DESIGNATION OF ORIGIN

23. Plaintiff incorporates by reference the allegations of paragraphs 1-22 above.

24. Defendant's conduct constitutes false designation of origin in violation of Section 43(a) of the Lanham Act, 15 U.S.C. §1125(a).

COUNT THREE

STATE TRADEMARK INFRINGEMENT

25. Plaintiff incorporates by reference the allegations of paragraphs 1-24 above.

26. Defendant's conduct constitutes state trademark infringement in violation of Iowa Code Section 548.112.

COUNT FOUR

INJURY TO BUSINESS REPUTATION

27. Plaintiff incorporates by reference the allegations of paragraphs 1-26 above.

28. Plaintiff's long-term extensive, continuous and substantially exclusive use of its ORANGE COLOR trademark in the state of Iowa has caused such mark to attain the status of a famous mark in such state pursuant to Iowa Code §548.113.

29. Defendant's conduct has caused and is continuing to cause dilution of Plaintiff's ORANGE COLOR trademark in the state of Iowa, and constitutes injury to the Plaintiff's business reputation in violation of Iowa Code §548.113.

COUNT FIVE

UNFAIR COMPETITION

30. Plaintiff incorporates by reference the allegations of paragraphs 1-29 above.

31. Defendant's conduct constitutes unfair competition in violation of the common law.

WHEREFORE, Plaintiff prays for judgment against Defendant as follows:

A. That the Court issue preliminary and permanent injunctions enjoining Defendant, along with its agents, servants, and employees, and those acting by, under, or in concert with any of them, from using the color orange, or any other color or mark confusingly similar to the color orange, in any manner, or in any form, in connection with the manufacturing, use or sale of environmental erosion control products in the nature of drain inlet or drain inlet protection devices used in dewatering applications;

B. That the Court order Defendant to withdraw its federal application Serial No. 78/078,529 for registration of the color orange;

C. That the Court order Defendant to account for and pay over to the Plaintiff all gains, profits and advantages derived from its infringement and other unlawful acts;

D. That the Court award to the Plaintiff compensatory damages consistent with the Plaintiff's proof; and

E. That the Court award such other and further relief as the Court may deem just and equitable.

Dated: 2/24/03

Johnson, Hester, Walter  
& Breckenridge, L.L.P

By RE Breckenridge  
Robert E. Breckenridge, Reg. No. WP0014200  
111 West Second Street  
P.O. Box 716  
Ottumwa, Iowa 52501  
Telephone: 641/684-5481

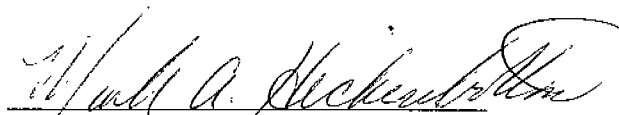
Schroeder & Siegfried, P.A.

By Brian F. Schroeder  
Brian F. Schroeder, Reg. No. 0183143  
222 South Ninth Street, Suite 2870  
Minneapolis, Minnesota 55402  
Telephone: 612/339-0120

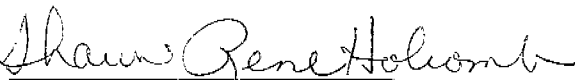
VERIFICATION

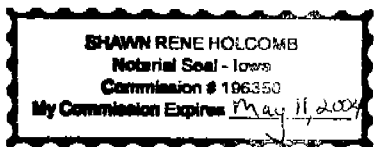
STATE OF IOWA            ]  
  ]  
COUNTY OF Jefferson ]

I, Mark A. Hickenbottom, am President of Hickenbottom, Inc. I hereby acknowledge that I have read the foregoing Verified Complaint and that the facts stated therein are true to the best of my knowledge, information and belief.

  
Mark A. Hickenbottom

Subscribed and sworn to before me this 6<sup>th</sup> day of February, 2003.

  
Notary Public



Int. Cl.: 17

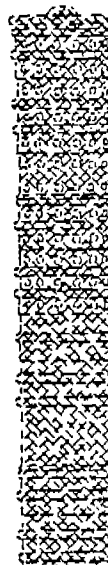
Prior U.S. Cl.: 35

**United States Patent and Trademark Office**

Reg. No. 1,563,348

Registered Oct. 31, 1989

**TRADEMARK  
PRINCIPAL REGISTER**



HICKENBOTTOM, INC. (IOWA CORPORATION)  
BOX 161  
RURAL ROUTE 2  
FAIRFIELD, IA 52556

FOR: PLASTIC DRAIN INLET TUBING FOR  
USE OUT OF DOORS IN FIELDS, PONDS,  
CATCHBASINS, AND THE LIKE, IN CLASS 17  
(U.S. CL. 35).

FIRST USE 4-26-1979; IN COMMERCE  
10-27-1979.

THE DRAWING IS LINED FOR THE COLOR  
ORANGE.

THE MARK CONSISTS OF THE COLOR  
ORANGE APPLIED TO THE EXTERIOR SUR-  
FACE OF THE GOODS. THE SHAPE OF THE  
GOODS IS SHOWN IN DOTTED LINES, BUT  
NO CLAIM IS MADE TO THE SHAPE.

SEC. 2(F).

SER. NO. 753,809, FILED 9-26-1988.

MICHAEL A. SZOKE, EXAMINING ATTOR-  
NEY

# Need BMP's That You Can Count On? For Over 7 Years, Cities and Municipalities Have Been Counting On Dandy Products

## EXHIBIT B

**Coming Soon**  
Dandy Bag® II: New and improved under the grate containment combined with a filter top.

**DANDY BALE BAG™**

**DANDY BAG®**

**DANDY DEWATERING BAG™**

**TRUE DAM®**

**DANDY POP™**

**DANDY PIRE SOCK™**

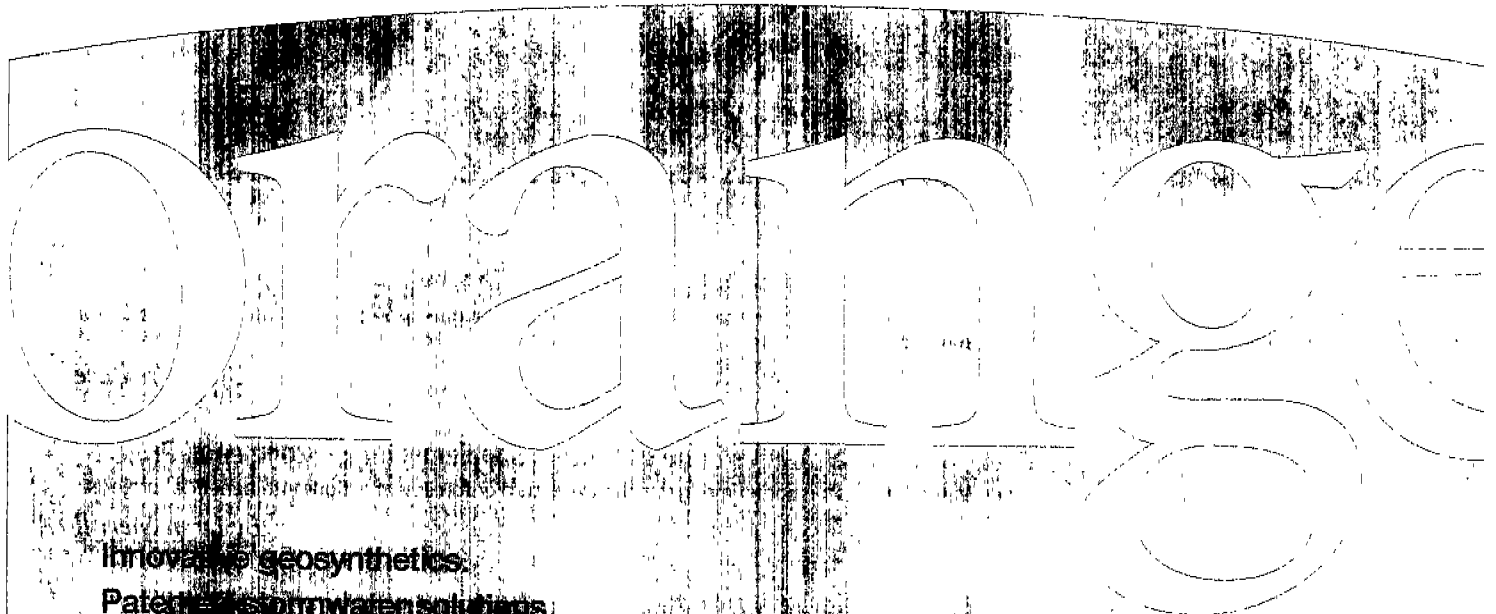
**.dp.**

**MIRAFLEX**  
Geosynthetics

# Dandy Products and Ten Cate Nicolon

Visit our booth!  
IECA  
Feb 25 - Mar 1, 2002  
Dandy #403  
Mirafi #307

present...



Innovative geosynthetics.  
Patented software solutions.

Two technologies come together to offer you a superior product in sediment control.

And to kick off our partnership, we're rolling out the orange carpet. Dandy Products and Ten Cate Nicolon present our line of stormwater and inlet protection products created with a highly recognizable orange geosynthetic.

Coupled with expert technical support and a worldwide distribution network, you'll soon be seeing these products in a city near you.



Ten Cate Nicolon



**EXHIBIT C**

**Sediment Control Solutions for All Stormwater Systems & Dewatering Projects**

Dandy Products, Inc.  
2001 Mansburg Pike, Suite R  
Cape City, TN 37041  
615-675-2284 Fax: 615-675-2004

Ten Cate Nicolon  
265 South Holland Drive  
Bendergrass, GA 30567  
770-626-6000 Fax: 770-626-6001





Attorney Docket No. 98530-200002/US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	DANDY PRODUCTS, INC.	)	
		)	
Serial No.	78/078,529	)	TM Law Office: 112
		)	
Filed:	August 9, 2001	)	TM Attorney: Jennifer M.B. Krisp
		)	
Mark:	Color Orange	)	
		)	

**EXPRESS WITHDRAWAL OF APPLICATION**

Hon. Commissioner of Patents & Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

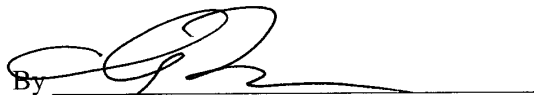
February 9, 2004

Sir:

Pursuant to 37 C.F.R. § 2.68, Applicant, Dandy Products, Inc. hereby expressly withdraws its U.S. Trademark Application Serial No. 78/078,529 to register the above-identified mark.

Respectfully submitted,

HARNESS, DICKEY & PIERCE, P.L.C.

By   
Terry L. Clark, Reg. No. 32,644

P.O. Box 8910  
Reston, VA 20195  
703/668-8000

Attorney for Dandy Products, Inc.

TLC:ewd



02-09-2004