

ESTTA Tracking number: **ESTTA287138**

Filing date: **06/02/2009**

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

## Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

### Petitioner Information

Name	SWIMC, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	300 Delaware Avenue Suite 522 Wilmington, DE 198011607 UNITED STATES		

Attorney information	Deron A. Cook, Reg. No. 52,767 c/o The Sherwin-Williams Company 101 W. Prospect Avenue 1100 Midland Bldg. - Legal Dept. Cleveland, OH 441151075 UNITED STATES legal_ip@sherwin.com Phone:2165663047		
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### Registration Subject to Cancellation

Registration No	2892968	Registration date	10/12/2004
Registrant	Professional Coatings, Inc. 27010 Highway 107 Cabot, AR 72023 UNITED STATES		

### Goods/Services Subject to Cancellation

Class 002. First Use: 1989/01/01 First Use In Commerce: 1989/01/01 All goods and services in the class are cancelled, namely: Sealer coatings for use on wood; wood varnishes; wood lacquers in the nature of a coating; coatings in the nature of adhesion promoters for other wood coatings
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### Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
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### Mark Cited by Petitioner as Basis for Cancellation

U.S. Application No.	77726150	Application Date	04/30/2009
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	PRO KOTE		

Design Mark	<b>PRO KOTE</b>
Description of Mark	NONE
Goods/Services	Class 002. First use: First Use: 1984/05/22 First Use In Commerce: 1987/11/04 Paints

Attachments	77726150#TMSN.jpeg ( 1 page )( bytes ) 9438 cancellation.PDF ( 6 pages )(126203 bytes )
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Deron A. Cook/
Name	Deron A. Cook, Reg. No. 52,767
Date	06/02/2009

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

*In the matter of Trademark Application Registration No. 2892968  
Registered October 12, 2004  
For the Mark PRO-COAT*

**SWIMC, Inc.** )  
 )  
 ) Petitioner, )  
 ) v. ) **Cancellation No.** \_\_\_\_\_ )  
 ) )  
 ) **PROFESSIONAL COATINGS, INC.** )  
 ) )  
 ) Registrant. )

BOX TTAB FEE  
Commissioner for Trademarks  
PO Box 1451  
Arlington, VA 22313-1451

**PETITION FOR CANCELLATION**

Petitioner, SWIMC, Inc., a corporation organized and existing under the laws of the State of Delaware and having its principal office and place of business at 300 Delaware Avenue, Suite 522, Wilmington, Delaware 19801-1607, believes that it is being or that it will be damaged by United States Trademark Registration Number 2892968 and hereby petitions to cancel the same. As grounds therefore, Petitioner respectfully alleges the following:

1. Petitioner's Licensee, The Sherwin-Williams Company, is a leading manufacturer, retailer, wholesaler and distributor of paints, coatings, and various related products, including, in particular, various paints, coatings and related products for wood and other architectural surfaces and has built up a large and profitable business in connection therewith.

2. Petitioner and/or its predecessors in interest have adopted and continuously used the trademark PRO KOTE since at least as early as May 22, 1984 to the present in connection with the sale of architectural paints in International Class 002.
3. Upon information and belief, Registrant, Professional Coatings, Inc., is the owner of U.S. Trademark Registration No. 2892968, for the trademark PRO-COAT for “sealer coatings for use on wood; wood varnishes; wood lacquers in the nature of a coating; coatings in the nature of adhesion promoters for other wood coatings” in International Class 002. Registrant’s PRO-COAT mark closely resembles Petitioner’s PRO KOTE mark and the goods specified in the 2892968 Registration are closely related, and in some instances almost identical, to those of Petitioner.
4. Based upon information and belief, U.S. Trademark Registration No. 2892968 is not incontestable.
5. Based upon information and belief, Petitioner and/or its predecessors in interest have used the PRO KOTE mark since at least four years prior to Registrant’s alleged January 1, 1989 first use date for its PRO-COAT mark.
6. Petitioner’s Licensee has expended considerable effort and expense in promoting Petitioner’s PRO KOTE trademark and the goods sold under such mark, with the result that the purchasing public has come to know, rely upon, and recognize the products of Petitioner’s Licensee by such mark. Petitioner’s Licensee has valuable goodwill established in Petitioner’s PRO KOTE mark.
7. If Registrant is permitted to retain U.S. Trademark Registration No. 2892968, and thereby the *prima facie* exclusive right to use the PRO-COAT mark in commerce on goods similar to those sold by Petitioner’s Licensee, confusion in the trade is likely to result from the concurrent use of Petitioner’s mark and that of Registrant all to the detriment of Petitioner and Petitioner’s Licensee, who has expended

considerable money and effort in promoting Petitioner's PRO KOTE trademark.

8. If Registrant is permitted to retain U.S. Trademark Registration No. 2892968, confusion will be placed on Petitioner and its Licensee's title in and to Petitioner's PRO KOTE trademark and on its right to enjoy the free and exclusive use thereof in connection with the sale of its goods, all to the injury of Petitioner.
9. Petitioner deems that it is or will be damaged by U.S. Trademark Registration No. 2892968, and petitions for cancellation thereof as it relates to goods in International Class 002.

The undersigned, acting on behalf of the Petitioner, hereby appoints Deron A. Cook, Reg. No. 52,767 and Robert E. McDonald, Reg. No. 29,193 and Vivien Y. Tsang, Reg. No. 40,209 and Arthi K. Tirey, Reg. No. 50,960 and Eryn Ace Fuhrer, Reg. No. 44,491, whose addresses are:

The Sherwin-Williams Company  
101 W. Prospect Avenue  
1100 Midland Bldg. – Legal Dept.  
Cleveland, Ohio 44115-1075

its attorneys in the matter of the above-identified cancellation to prosecution said Cancellation, to transact all business with the Patent and Trademark Office and the United States Courts connected with this Cancellation and to sign its name to all papers which may hereafter be filed in connection with the Cancellation and to receive the official communications relating to the same.

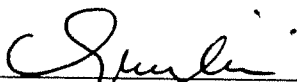
All correspondence in connection with this matter should be mailed to:

Deron A. Cook, Esq.  
c/o The Sherwin-Williams Company  
101 W. Prospect Avenue  
1100 Midland Bldg. – Legal Dept.  
Cleveland, Ohio 44115-1075

Dated in Newark, Delaware, this 26<sup>th</sup> day of May, 2009.

Respectfully submitted,


SWIMC, INC.

By   
Donald J. Paglisi, President

**VERIFICATION**

State of Delaware            )  
  ) ss.  
County of New Castle        )

Donald J. Puglisi, being duly sworn, deposes and says that he is President of the Petitioner, SWIMC, Inc., in the foregoing Petition for Cancellation, and that he has read and signed the same and knows the contents thereof and that the same is true of his own knowledge except as to matters herein alleged on information and belief, and as to those matters he believes them to be true.

By   
Donald J. Puglisi, President

Subscribed to and sworn to be fore me this 26<sup>th</sup> day of May, 2009.

  
NOTARY PUBLIC

GREGORY F. LAVELLE  
NOTARY PUBLIC  
STATE OF DELAWARE  
My Commission Expires July 24, 2011

**CERTIFICATE OF SERVICE**

Copies of the foregoing Petitioner's Petition to Cancel were mailed by United States Mail, postage prepaid to:

Joe D. Calhoun, Esq.  
Calhoun Law Firm  
PO Box 251504  
Little Rock, AR 72225

Attorney for Registrant on this 2<sup>nd</sup> day of June, 2009.



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Deron A. Cook