

ESTTA Tracking number: **ESTTA289739**

Filing date: **06/15/2009**

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	Haywood Holdings, Inc.		
Entity	Corporation	Citizenship	Alabama
Address	274 Wehapa Lakes Circle Leeds, AL 35094 UNITED STATES		

Attorney information	Howard P. Walthall, Jr. Burr & Forman LLP 420 North 20th Street Suite 3400 Birmingham, AL 35203 UNITED STATES hpwaltha@burr.com, ivincent@burr.com, pkustos@burr.com Phone:205-458-5462
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Registration Subject to Cancellation

Registration No	3213620	Registration date	02/27/2007
International Registration No.	NONE	International Registration Date	NONE
Registrant	Fraunhofer-Gesellschaft zur FÃ¶rderung der angewandten Forschung e.V. HansastraÃ#e 27c 80686 MÃ¼nchen, GERMANY		


Goods/Services Subject to Cancellation

Class 006. All goods and services in the class are cancelled, namely: Products and components made of common metals and their alloys, namely gratings and partition wall panels
Class 007. All goods and services in the class are cancelled, namely: Machines for the processing of plastics; machines for the coating of work pieces; machines for the lacquering of work pieces, in particular lacquering booths; machines for the manufacture of plastics, in particular adhesive and foamed plastics; machines for the joining of components, in particular to stick together components; structural components of the above-named machines; housings being parts for machines; engines and motors not for land vehicles
Class 040. All goods and services in the class are cancelled, namely: Material treating, namely application of protective coating and lacquering of surfaces, and the stripping of lacquer finishes and stripping of coating finishes with corrosives

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.	77567975	Application Date	09/11/2008
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	PERMA-CLEAN II		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 002. First use: First Use: 1972/12/00 First Use In Commerce: 1972/12/00 protective coating for use in protecting steel, iron and concrete from water, waterborne chemicals and other corrosive environments		

Attachments	77567975#TMSN.jpeg (1 page)(bytes) PERMACLEAN PLAS - Petition to Cancel.PDF (5 pages)(171884 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	/india e vincent/
Name	India E. Vincent, Esq.
Date	06/15/2009

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

Haywood Holdings, Inc.,)	
)	
Petitioner,)	
)	
v.)	Cancellation No. _____
)	
Fraunhofer-Gesellschaft zur Förderung der)	Mark: PERMACLEAN PLAS
angewandten Forschung e.V.,)	
)	Reg. No. 3,213,620
Registrant.)	

PETITION TO CANCEL

Haywood Holdings, Inc. (“Petitioner”), an Alabama corporation, having its principal place of business at 274 Wehapa Lakes Circle, Leeds, Alabama 35094, believes it is being damaged by the continued use and registration of the PERMACLEAN PLAS mark identified in U.S. Trademark Registration No. 3,213,620 (“Registrant's Mark”), owned by Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung e.V. (“Registrant”), and pursuant to 15 U.S.C. § 1064 hereby petitions to cancel the same.

As grounds for its Petition to Cancel, Petitioner alleges that:

1. Petitioner through its predecessors and authorized licensees, has been manufacturing and selling protective coatings for use in protecting steel, iron and concrete from water, waterborne chemicals and other corrosive environments under the marks PERMA-CLEAN and PERMA-CLEAN II (collectively “Petitioner's Mark”) since at least as early as December 1972.

2. Petitioner filed Application Serial No. 77/567,975 for registration of PERMA-CLEAN II on September 11, 2008. Petitioner has received from the United

States Patent and Trademark Office (“USPTO”) an Office Action for Application Serial No. 77/567,975 refusing the registration of Petitioner's Mark based on a likelihood of confusion with Registrant's Mark.

3. Upon information and belief, Registrant is a German corporation which has an address at HansasträÙe 27c 80686 München, Germany.

4. Registrant's Mark is registered for:

products and components made of common metals and their alloys, namely gratings and partition wall panels in International Class 006;

machines for the processing of plastics; machines for the coating of work pieces; machines for the lacquering of work pieces, in particular lacquering booths; machines for the manufacture of plastics, in particular adhesive and foamed plastics; machines for the joining of components, in particular to stick together components; structural components of the above-named machines; housings being parts for machines; engines and motors not for land vehicles in International Class 007; and

material treating, namely application of protective coating and lacquering of surfaces, and the stripping of lacquer finishes and stripping of coating finishes with corrosives in International Class 040.

5. The registration for Registrant's Mark (based on Registrant's § 66(a) application) indicates a filing date of August 19, 2005, and a priority date of February 19, 2005 (the “Priority Date”).

6. Upon information and belief, Registrant had not made any actual or constructive use of Registrant's Mark prior to the Priority Date.

7. Upon information and belief, neither Registrant nor any predecessor or related company of Registrant has any basis for claiming rights in Registrant's Mark in connection with the identified goods and services prior to the Priority Date.

8. Petitioner's continuous use of Petitioner's Mark in interstate commerce since at least as early as December 1972 on or in connection with its protective coating

product as described above in Paragraph 1, pre-dates the Priority Date of Registrant's Mark by more than thirty years.

9. Petitioner has sold significant quantities of the product marketed under Petitioner's Mark since 1972, and has invested significant amounts of time and money advertising and promoting the goods under Petitioner's Mark throughout the United States.

10. By virtue of Petitioner's sales and marketing efforts, Petitioner's Mark has become well-known in connection with the high quality product marketed and sold by Petitioner under Petitioner's Mark, and Petitioner has created significant and valuable goodwill symbolized by Petitioner's Mark.

11. The types of goods and services listed in Registrant's registration are related to the goods associated with Petitioner's Mark, and the goods and services could be marketed and sold to the same or similar class of purchasers.

12. While Petitioner believes that appropriate safeguards may be able to alleviate any potential confusion, to date, Registrant has not agreed to such safeguards, or to limit its registration of or use of the Registrant's Mark accordingly.

13. The appearance and sound of Registrant's Mark are very similar to Petitioner's Mark as Registrant's Mark appropriates the key portion of Petitioner's Mark, namely "Perma-Clean."

14. Given the similarities in appearance and sound of the marks and the similarities in the goods and services, Registrant's use and registration of Registrant's Mark in conjunction with the goods and services is, without proper safeguards, likely to cause confusion, to cause mistake, or to deceive persons by creating the erroneous

impression that Registrant's Mark originates from or comes from the same source as Petitioner's Mark, or is endorsed by, sponsored by, or connected in some with Petitioner, and thus absent appropriate restrictions Registrant's registration of Registrant's Mark, damages and will continue to damage Petitioner.

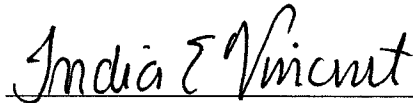
15. The Examining Attorney's refusal to register Petitioner's Mark is further evidence of the damage Registrant's registration is causing Petitioner.

WHEREFORE, Petitioner respectfully requests that Registration No. 3,213,620 for the mark PERMACLEAN PLAS be cancelled.

This filing fee of \$900.00 is submitted herewith. Please charge any underpayment or credit any overpayment to Deposit Account No. 500376.

Dated this 15th day of June 2009

Respectfully Submitted,



Howard P. Walthall, Jr., Esq.

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Justin H. Kelly, Esq.

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Attorneys for Petitioner, Haywood Holdings, Inc.

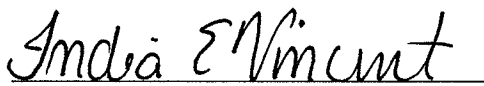
CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Petition to Cancel was mailed to Registrant on June 15, 2009 by first class mail, postage prepaid, to the address listed by Registrant on his registration as follows:

Dr. Dirk Ostermann
Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung e.V.
Hansastraße 27c
80686 München
Germany

A copy of the Motion was also sent on the above mentioned date to Registrant via email at dirk.ostermann@zv.fraunhofer.de.

Respectfully Submitted,


India E. Vincent, Esq.