

Office Action Response
Mark: HARDIEBACKER
Ser. No. 88341552

Applicant submits these remarks in response to the Office Action dated May 3, 2019 in which the Examining Attorney initially refused Applicant's HARDIEBACKER mark on the grounds that the prefix HARDIE is primarily merely a surname and also requesting amendment to the identification of goods. In light of the comments set forth below and the amendments made with the response Applicant respectfully requests that the Examining Attorney withdraw the refusal and allow Applicant's application to proceed to publication.

Amendments to the Identification of Goods

Applicant amends the identification of goods as follows:

[no changes] Class 1: Waterproofing chemical compositions; waterproofing membranes in liquid chemical form for use in construction

[no changes] Class 6: Nails; screws of metal; waterproof nails and metal screws

Class 8: **Hand tools in the nature of** scoring knives; knives used for construction and building purposes, **namely, utility knives; knives used for construction and building purposes, namely, knives for cutting and marking fiber cement building materials;** hand-operated cutting tools; cement and backboard scoring knives

- The amendment to Class 8 includes the suggested amendments listed in the Office Action as well as items modeled off the ID manual.
- The ID Manual lists "scoring knife for veneer sheets" (008-330) as well as "blades for [indicate type of knives]" (008-191) as such, the proposed amendments above should be sufficiently definite. Furthermore, there are several registrations using the phrase *hand tools in the nature of scoring knives* including the following: 4583069, 4587373, 4961955, 3247068, 3095071. We additionally identified a registration that registered for "scoring knives" without further description: See. Reg. 3801287.
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Class 17: Caulking materials; waterproof sealants; sealants for buildings; **adhesive waterproof tape, other than stationery and not for medical or household purposes; waterproof duct tape and waterproof wallboard joint tape;** adhesive tape for industrial and commercial use

- The amendment to Class 17 matches the ID Manual Term ID 017-836 and incorporates the suggested amendments listed in the Office Action

[no changes] Class 19: Waterproofing membranes for roofing, floors and walls; waterproof membrane for use as a floor underlayment

I. Introduction:

The mark HARDIEBACKER, when viewed as a whole, is not considered or recognized by the consuming public as “primarily merely a surname”. As such, the mark should be registered on the Principal Register as inherently distinctive for all goods listed in the application.

However, should the Examining Attorney maintain the position that HARDIEBACKER is primarily merely a surname, Applicant introduces evidence that Applicant has acquired distinctiveness in the mark, specifically through prior registrations for the mark HARDIEBACKER, of the mark in the US for more than thirty years, as well as even longer use of the “HARDIE” prefix across Applicant’s portfolio of products both in the U.S. and globally. In light of the arguments set forth below, the public has come to identify the prefix HARDIE and the mark HARDIEBACKER in Applicant’s industry exclusively in connection with Applicant. Accordingly, Applicant respectfully requests that, in the alternative, the application be approved for registration on a claim of partial 2(f), based on Applicant’s recognition and reputation in the HARDIE and HARDIEBACKER marks.

In light of the arguments and evidence submitted herein, Applicant requests that the refusal against the application be withdrawn and that Applicant’s application be allowed to resume to allowance.

A. HARDIEBACKER is not primarily merely a surname and the mark is entitled to registration on the Principal Register as inherently distinctive.

Applicant respectfully maintains that its mark HARDIEBACKER is not recognized by the public as primarily merely a surname and that the mark is inherently distinctive.

The Examining Attorney suggests that consumers would break up the mark HARDIEBACKER, into the component parts, HARDIE and BACKER, and would consider the HARDIE prefix to be primarily merely a surname. Applicant respectfully disagrees. The mark HARDIEBACKER is presented as, spoken as, and flows as one continuous word without a phonetic break splitting up HARDIE and BACKER. The mark has the appearance, sound and commercial impression of a trademark. As such, consumers recognize the combined mark HARDIEBACKER as its own distinctive trademark and will not stop to split the mark into its component parts. Additionally, the HARDIE prefix brings to mind the durable nature and strength of Applicant’s building products giving it a primary significance other than that of a surname. Under T.M.E.P. §1211.01(a), where a trademark has non-surname significance, such that the primary significance of the term is not that of a surname, registration should be granted on the Principal Register without evidence of acquired distinctiveness. The Examining Attorney points out that the question is not whether the mark has surname significance, but rather, whether **in the context of an applicant’s goods**, the non-surname significance is the mark’s primary significance to the

purchasing public. Here, the commercial impression offered by the term “HARDIE” as denoting strength and durability is the dominant impression of the term given that the goods related to the field of building and construction.

Furthermore, the Examining Attorney argues the fact that Applicant was founded by an individual with the name James Hardie is evidence to support that consumers would break up the trademark into its component parts and view HARDIEBACKER as a surname. Applicant again, respectfully disagrees. The history of the Applicant’s company is relevant only to show how Applicant came up with its naming convention for its large family of marks. However, that does not take away from the fact that HARDIEBACKER, when looked at as a whole is inherently distinctive. The combined mark does not have the “look and feel” of a surname and the term HARDIE also creates a commercial impression that gives the mark non-surname significance. The T.T.A.B. has held that the fact that the mark shares the surname of someone associated with the applicant is not dispositive in a surname refusal. *In re Okamoto Corp.*, Serial No. 85739429 (February 6, 2015) [not precedential] (reversing the examining attorney’s surname refusal of the OKAMOTO mark, finding the mark is not primarily merely a surname, even where the President of the company has the OKAMOTO surname).

Furthermore, Applicant points out that many of Applicant’s registrations have issued as inherently distinctive, showing that Applicant’s HARDIE-containing marks are generally recognized by the public to be inherently distinctive.

- ASKHARDIE (and design) (Reg. 5117402) issued on January 10, 2017
- 100% HARDIE (Reg. 86916624) issued on November 15, 2016
- HARDIETRIM (Reg. 4891463) issued on January 26, 2016,
- HARDIELINK (Reg. 4030856) issued on September 27, 2011
- HARDIEZONE (Reg. 4019894) issued on August 30, 2011
- HARDIEWRAP (Reg. 3828781) issued on August 3, 2010
- HARDIEFLOOR (Reg. 3822393) issued on July 20, 2010

See Exhibit A for a copy of Applicant’s TSDR records for the above-referenced HARDIE marks.

Furthermore, HARDIE is not a common surname. The name does not even appear on the U.S. 2010 census list of the 1000 most common surnames and in fact appears in less than 0.0027% of the population. (In the Office Action, the Examining Attorney referenced 8485 Hardie surnames in the U.S. Even assuming that each of those listings is relevant and unique (many of which are duplicate entries for the same person), in a country of 320 million, that accounts for less than 0.0027% of the population or fewer than 1 in 37,000 people.) *See In re Suphachatwong Innovation Co., Ltd.*, Serial No. 86516441 (November 3, 2016) [not precedential] at pp. 8-9 (finding the surname VEASY to be very rare and therefore unlikely to be viewed as a surname, despite being similar to the more common surname VEASEY, and also finding that the examining attorney did not sufficiently prove that members of the public would view the name as a surname). *See attached as Exhibit B for a copy of the U.S. 2010 List of 1000 most frequent surnames in the U.S.*

In light of the response made herein, Applicant respectfully maintains that the HARDIEBACKER mark is inherently distinctive and should be approved for publication.

B. In the alternative, the term HARDIE in Applicant's mark has acquired distinctiveness.

Should the Examining Attorney maintain the Section 2(e)(4) refusal of Applicant's HARDIEBACKER mark, Applicant requests that the Examining Attorney consider the following evidence of acquired distinctiveness in the HARDIE mark. Firstly, Applicant presently owns two prior registrations for the HARDIEBACKER mark in connection with overlapping and highly related goods. Secondly, as demonstrated herein and in the entire record for this Application, the relevant customers and professionals in the building and construction industry have come to associate the term HARDIE *exclusively* with Applicant, James Hardie, such that any use of HARDIE in this industry automatically causes consumers to think of James Hardie. Accordingly, Applicant requests that the Examining Attorney approve the application for publication under a claim of partial 2(f).

i. Applicant owns two prior registrations for the HARDIEBACKER mark and has been using the HARDIEBACKER mark for over thirty years

Under TMEP Sections 1212.04 and 1212.05, applicants in 1B applications may submit evidence of prior registrations for the same mark or evidence of 5+ years of use of the mark, as prima facie evidence of acquired distinctiveness. Applicant owns two registrations for the mark HARDIEBACKER as shown in U.S. Registration Nos. 3550567 and 3705668 for goods and services in Classes 19 and 35 related to building and construction, which issued on December 23, 2008 and November 3, 2009, respectively. (See Exhibit A for TSDR records.) Furthermore, Applicant has been using the HARDIEBACKER mark in commerce in the U.S. since as early as 1987, becoming one of Applicant's most popular products.

The goods filed in the instant application are an extension of the HARDIEBACKER product line and have adopted the significant marketplace goodwill build in the current HARDIEBACKER products.

ii. The relevant consumers will recognize the HARDIE in HARDIEBACKER mark as a source identifier for James Hardie goods

a) The Legal Standard:

A claim of acquired distinctiveness may apply to a portion of a mark, including for marks comprised of a surname combined with generic wording. T.M.E.P. §§ 1212.02(f)(i) and 1212.02(f)(ii)(A). An intent-to-use applicant may assert a claim of acquired distinctiveness under §2(f) as to part of a mark prior to filing an acceptable allegation of use if the applicant has already used the relevant part of the mark in commerce on or in connection with the specified goods or services, or related goods or services. See: T.M.E.P. § 1212.09(b). In such a scenario, the applicant must establish acquired distinctiveness for the relevant portion of the mark and also show that the goods in the §1(b) application are identical to or related to the goods or services in connection with which the mark is distinctive. See: T.M.E.P. § 1212.09(b). Once the applicant establishes that it has acquired distinctiveness as to the relevant portion of the mark, the

examining attorney must withdraw any refusals related to the nondistinctive character of that part of the mark. See: T.M.E.P. § 1212.09(b).

When an applicant is claiming §2(f) in part as to only a portion of its mark, the mark in the claimed prior registration (and/or prior uses) will be considered the “legal equivalent” of the portion of the mark for which the applicant is claiming acquired distinctiveness, if it creates the same, continuing commercial impression such that the consumer would consider the two to be the same. See: T.M.E.P. § 1212.02(f)(ii)(B). The question of whether the goods are “sufficiently similar” can be established by looking at the relatedness of the applied-for goods with prior registrations. Where the relatedness of the goods is self-evident, the examining attorney may accept the 2(f) claim without additional evidence. T.M.E.P. §1212.04(c). **Additionally, “an applicant may, in the context of *ex parte* prosecution of an application that has been refused registration under Section 2(e)(1), present evidence of a family of marks to help prove acquired distinctiveness of a new member of that family under Section 2(f).” *In re LC Trademarks, Inc.*, Ser. No. 85890412 p11, (T.T.A.B. December 29, 2016) [precedential].**

Applicant respectfully submits that it has acquired distinctiveness in the HARDIE portion of its mark through significant use of the mark in the US and globally for decades in connection with a wide variety of products and services in the building and construction field. James Hardie’s products include, among many other things, metal fasteners (e.g. bolts, nails, nuts, rivets, screws and ballistic fasteners) in Class 6, knives, blades and hand tools in Class 8, caulking materials, sealants and tapes in Class 17, and non-metal building and construction materials in Class 19 including for roofing, flooring, and walls. James Hardie also owns registrations for many other products and services related to the building and construction industry including in Classes 2, 35, 37 and 42. Through James Hardie’s significant and substantial use of the HARDIE prefix and the significant goodwill it has developed in the mark, consumers will instantly recognize the use of the HARDIE prefix for goods in the building and construction industry, including goods in classes 1, 6, 8, 17 and 19, as relating to Applicant, James Hardie. Accordingly, Applicant respectfully submits that it has acquired distinctiveness as to the HARDIE portion of its HARDIEBACKER mark, and requests that Applicant’s HARDIEBACKER mark be approved for publication.

b) Introduction: The relevant public recognizes the term HARDIE and the HARDIE-prefix as used in Applicant’s family of marks, as being a source identifier for Applicant’s products.

Applicant, James Hardie, is a publicly traded global leader in the building and construction industry and gained its recognition as a manufacturer of fiber cement building materials, such as backer boards, panels, trim, fascia, and mouldings as well as related products and materials for the building and construction space including metal fasteners, paint, coatings, blades for power tools, moisture barriers, among many other goods and services. The company, through its predecessors, has been in operation for over 120 years under the James Hardie house brand and has established a reputation as a high-quality provider of products and services targeting the building and construction industry.

James Hardie is known worldwide, including in the U.S., by contractors, builders, architects, remodelers, and other building industry professionals under its house marks JAMES HARDIE®

and HARDIE®. Since at least as early as 1986, Applicant has also built a large family of HARDIE-Containing Marks using the HARDIE prefix, similar to the instant HARDIEBACKER mark. The HARDIE-Family of Marks (defined below), are used in connection with James Hardie's different lines of building and construction materials. Examples of the HARDIE-family of marks for goods include the following:

HARDIEPLANK®
HARDIEBACKER®
HARDIEPANEL®
HARDIESOFFIT®
HARDIETRIM®
HARDIEZONE®
HARDIEBLADE®
HARDIEWRAP®
HARDIESHINGLE®
HARDIENAIL®

among many others.

James Hardie also uses the HARDIE-Family of Marks in connection with various related services, such as HARDIELINK® which is a website for tracking and placing orders, ASKHARDIE® for customer support services, HARDIESTORE® for online store services, and HARDIEPANEL®, HARDIEBACKER®, HARDIEPLANK®, HARDIESHINGLE®, among several others, in connection with Class 35 cooperative advertising and marketing services it offers for its network of contractors. Other examples of the HARDIE-family of marks for services include the following:

HARDIEREWARDS®
100% HARDIE®
HARDIESOFFIT®
HARDIETRIM®,

among many others.

See Exhibit A for registration records for Applicant's HARDIE-Family of Marks. As detailed below, through more than three decades of use of its JAMES HARDIE®, HARDIE®, and HARDIE-Family of Marks in the U.S., as well as the company's widespread reach and recognition across the U.S., the term HARDIE has become synonymous with James Hardie in this industry, including in connection with the goods listed in the instant HARDIEBACKER application.

Through James Hardie's marketplace recognition in its HARDIE marks, customers have been educated to recognize that new members of the HARDIE-Family of Marks also come from James Hardie. Applicant's use of HARDIE in HARDIEBACKER, follows the identical naming convention as James Hardie's other HARDIE-Family of Marks, making this use the "legal equivalent" of Applicant's HARDIEBACKER registrations as well as its other registered HARDIE** marks under T.M.E.P. Section 1212.04(b). Additionally, the applied-for goods, being in classes 1, 6, 8, 17, and 19 are identical to or highly related to the goods covered in the existing HARDIE-Family of products for which Applicant is recognized (and for which it owns numerous U.S. registrations). See T.M.E.P. § 1212.04(c).

Since the HARDIE portion of the mark in HARDIEBACKER is “legally identical” to the HARDIE mark which has acquired a great deal of distinctiveness and recognition, and since the HARDIEBACKER goods are identical to or highly related to the goods and services registered in the HARDIE-Family of Marks, Applicant respectfully submits that its claim of acquired distinctiveness in the HARDIE portion of its mark as well as the HARDIEBACKER mark as a whole is proper. *See cf. J & J Snack Foods Corp. v. McDonald’s Corp.*, 932 F.2d 1460, 1463 (Fed. Cir. 1991) (finding that the Opposer, who owned registrations for a large number of MC + generic food name marks, had established a family of marks and built sufficient rights in the “MC” prefix to stop a third party from registering a MC + generic food name mark, such as McPretzel).

c) **James Hardie history and status of the company as a global leader in the building and construction industry.**


James Hardie was initially launched in Australia over 120 years ago in 1888. Over the years, the company has expanded to become a world leader in the manufacture of fiber cement construction products including siding, panels, backer board, trim, soffits, and flooring, among other products used in connection with building products such as metal fasteners and parts, paints, primers, building flashing, blades and knives, tape, downloadable apps, etc. James Hardie also offers a variety related services to its customers including support services, sales and marketing services, online retail store services, SAAS services, among many other industry-specialized services directed towards contractors, builders, and architects, among others. All of these products and services are offered under the HARDIE and JAMES HARDIE house marks, as well as under various product- and service-level marks incorporating the HARDIE** naming convention. James Hardie’s products and services target a number of markets, including single and multi-family residential construction, manufactured housing, commercial construction and industrial construction and remodeling.

James Hardie was first publicly traded in Australia in 1951 and today enjoys sales and operations in numerous countries globally. Today the company is publicly traded on the Australian Stock Exchange and the New York Stock Exchange. Its major markets include the U.S., Canada, Australia, New Zealand, Philippines and parts of Europe. James Hardie products are also sold in China, Mongolia, Hong Kong, India, Israel, the UAE, Singapore, Korea, Taiwan, Vietnam, among other countries. In its most recent 2018 fiscal year, James Hardie enjoyed overall growth from 2017 and reported over USD \$2 Billion in global net sales. The company currently has 5000 employees globally, invests US\$20 million annually in R&D, and has seen annual growth in net sales each year since at least 2012. By certain measures, James Hardie is the largest manufacturer of fiber cement products and systems for internal and external building construction applications in the U.S., Australia, New Zealand and the Philippines.

As of 2019, James Hardie has 9 manufacturing facilities in the U.S., and has been installed in over 8 million homes in North America. The company also invests heavily in its employees and corporate culture, including in its sustainability and conservation practices, environmental management policies, workplace safety initiatives and social responsibility goals.

d) The James Hardie Family of HARDIE-Marks and prior registrations.

Virtually all of Applicant's products and services are branded and advertised under the JAMES HARDIE and HARDIE house marks, for which Applicant owns several US registrations:

- HARDIE® Reg. No. 2274743 for Class 19
- JAMESHARDIE® Reg. No. 5089776 for Classes 2, 6, 7, 17, 19, 35, 37, 42
- JAMES HARDIE® Reg. No. 2252291 for Class 19
-  **JamesHardie**® Reg. No. 5276524 for Classes 18 and 25

In addition to being its house marks, Applicant has built an entire family of HARDIE-containing marks for its product- and service-level brands. These marks are also customer-facing brands, and are the brands that customers often times reference for the products and services that they purchase and use.

Each member of the family follows the same naming convention using the HARDIE-prefix with a descriptive or suggestive descriptor that helps identify the product or service. Each mark also shares the same stylization. Together, these marks have created a strong family that has built awareness in the HARDIE brand and prefix as an indicator of source of James Hardie products and services. James Hardie owns over 200 global registrations for its HARDIE-Family of Marks including 36 registrations in the U.S.

The first brands under the family of HARDIE marks launched in the U.S. more than 30 years ago, in at least as early as 1986. The HARDIEBACKER mark was part of that initial launch making its introduction in U.S. commerce in at least as early as 1987. Since then, the HARDIE brands have continued to build into a suite of products and services. In addition to the marks JAMES HARDIE and HARDIE, Applicant owns registrations for the following marks, each representing one of James Hardie's various products or related services:

- HARDIEBACKER®
- HARDIETRIM®
- HARDIESOFFIT®
- HARDIEPLANK®
- HARDIEPANEL®
- HARDIESHINGLE®
- HARDIEBLADE®
- HARDIEWRAP®
- HARDIEZONE®
- HARDIELINK®
- HARDIESTORE®
- HARDIENAIL®
- HARDIEREWARDS®

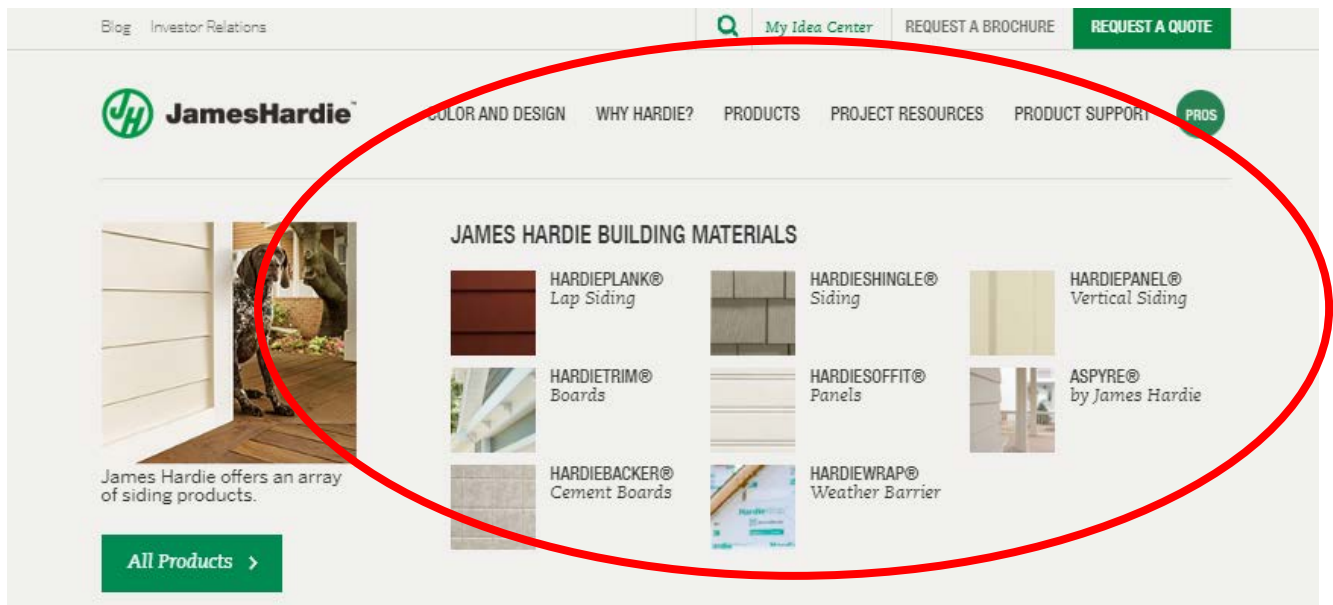
("HARDIE-Family of Marks"). See Exhibit A.

Also, each of these marks share the same stylization convention, helping reinforce with consumers that these are part of a family of marks and emphasizing the HARDIE** prefix. See, for example, the following marks:

HardieBacker® HardiePlank® HardieShingle®
HardiePanel® HardieTrim® HardieSoffit®
HardieBlade® HardieStore® HardieRewards®


Applicant attaches as Exhibit C product images, installation and instructional materials for the HARDIE-Family of products showing the unitary stylization for the marks.

The HARDIE-Family of Marks are also branded and advertised together and appear consistently on Applicant’s website, product advertisements, labels, packaging, installation instructions, point of sale displays, etc. Examples of such use from the James Hardie webpages and installation pages shown below – which also highlight the use of the HARDIEBACKER mark:




[PRODUCT SPECS](#) -
 [INSTALL & TECH DOCS](#) -
 [EXPLORE](#) -
 [PRO SUPPORT](#)
[SHORTCUTS](#)


Siding Products




- HardiePlank® Lap Siding**
- HardieShingle® Siding**
- HardiePanel® Vertical Siding**
- HardieTrim® Boards & Mouldings**
- HardieSoffit® Panels**

Collections



Aspyre®
By James Hardie 










Also By James Hardie



- HardieBacker® Cement Boards**
- HardieWrap® Weather Barriers**

Browse by Product

Get all the documentation you need for a specific product in one convenient place.

	Traditional Siding HardiePlank® Lap Siding		Collections Reveal® Panel System
	Traditional Siding HardieShingle® Panels		Collections Artisan® Lap Siding
	Traditional Siding HardieTrim® Boards & Mouldings		Traditional Siding HardiePanel® Vertical Siding
	Also By James Hardie HardieBacker® Boards		Traditional Siding HardieSoffit® Pre-Cut Panels
	Also By James Hardie HardieWrap® Weather Barrier		

HARDIEBACKER® CEMENT BOARD PRODUCTS

The products you'll see below are readily available for zip code 92130. Not your zip code? [Update it now.](#)



HARDIEBACKER® CEMENT BOARD

1/4 IN. CEMENT BOARD

This light, simple-to-cut, no-mesh board features our exclusive EZ Grid® recessed fastener pattern, making installation even easier.



HARDIEBACKER® CEMENT BOARD

500 CEMENT BOARD

HardieBacker 500 cement board is resistant to damage from moisture. Its smooth surface allows for finishing with paint, wallpaper or texture.



HardieBacker®
Cement Board

Installation Guide

**MADE BETTER.
INSTALLS BETTER.
PERFORMS BETTER.**



HARDIEPLANK® LAP SIDING PRODUCTS

The products you'll see below are readily available for zip code 92130. Not your zip code? [Update it now.](#)



HARDIEPLANK® LAP SIDING **SELECT CEDARMILL®**

Our natural cedar look has a soft texture that mimics wood.

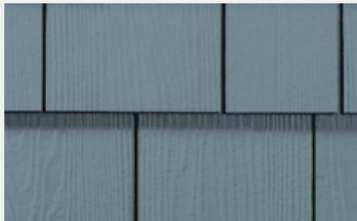


THE STATEMENT COLLECTION™

Classic shades—engineered with long-lasting ColorPlus® Technology—will make a statement that resonates for generations. The tried and true colors of James Hardie's Statement Collection™ products were designed for every home. They're our most popular hues. And they are readily available in your region.

HARDIESHINGLE® SIDING PRODUCTS

The products you'll see below are readily available for zip code 92130. Not your zip code? [Update it now.](#)



HARDIESHINGLE® SIDING **STRAIGHT EDGE PANEL**

A clean-lined shingle can soften contemporary-looking designs or add refinement to rustic styles. Make your selection from our Statement Collection products or Dream Collection products.



HARDIEPANEL® VERTICAL SIDING PRODUCTS

The products you'll see below are readily available for zip code 92130. Not your zip code? [Update it now.](#)



HARDIEPANEL® VERTICAL SIDING **SELECT CEDARMILL®**

Our natural cedar look has a soft texture that mimics wood.



HARDIEPANEL® VERTICAL SIDING **SMOOTH**

You can't go wrong with this sleek, modern siding. Find the perfect color in our Statement Collection products or Dream Collection products. Or get it primed for paint.



HardieWrap® Weather Barriers

[Download the Product Catalog >](#)



HardiePlank® Lap Siding

EFFECTIVE APRIL 2018

IMPORTANT: FAILURE TO FOLLOW JAMES HARDIE WRITTEN INSTALLATION INSTRUCTIONS AND COMPLY WITH APPLICABLE BUILDING CODES MAY VIOLATE LOCAL LAWS, AFFECT BUILDING ENVELOPE PERFORMANCE AND MAY AFFECT WARRANTY COVERAGE. FAILURE TO COMPLY WITH ALL HEALTH AND SAFETY REGULATIONS WHEN CUTTING AND INSTALLING THIS PRODUCT MAY RESULT IN PERSONAL INJURY. BEFORE INSTALLATION, CONFIRM YOU ARE USING THE CORRECT HARDIEZONE® PRODUCT INSTRUCTIONS BY VISITING HARDIEZONE.COM OR CALL 1-866-942-7343 (866-9-HARDIE)

STORAGE & HANDLING:

Store flat and keep dry and covered prior to installation. Installing siding wet or saturated may result in shrinkage at butt joints. Carry planks on

CUTTING INSTRUCTIONS

OUTDOORS

1. Position cutting station so that airflow blows dust away from the user and others near the cutting area.
2. Cut using one of the following methods:
 - a. Best: Circular saw equipped with a HardieBlade® saw blade and attached vacuum dust collection system. Shears

INDOORS

- DO NOT grind or cut with a power saw indoors. Cut using shears (manual, pneumatic or electric) or the score and snap method, not recommended for products thicker than 7/16 in.
- DO NOT dry sweep dust; use wet dust suppression or vacuum to collect dust.



HardieSoffit® Panels

EFFECTIVE APRIL 2018

IMPORTANT: FAILURE TO FOLLOW JAMES HARDIE WRITTEN INSTALLATION INSTRUCTIONS AND COMPLY WITH APPLICABLE BUILDING CODES MAY VIOLATE LOCAL LAWS, AFFECT BUILDING ENVELOPE PERFORMANCE AND MAY AFFECT WARRANTY COVERAGE. FAILURE TO COMPLY WITH ALL HEALTH AND SAFETY REGULATIONS WHEN CUTTING AND INSTALLING THIS PRODUCT MAY RESULT IN PERSONAL INJURY. BEFORE INSTALLATION, CONFIRM YOU ARE USING THE CORRECT HARDIEZONE® PRODUCT INSTRUCTIONS BY VISITING HARDIEZONE.COM OR CALL 1-866-942-7343 (866-9-HARDIE)

STORAGE & HANDLING:

Store flat and keep dry and covered prior to installation. Installing siding wet or saturated may result in shrinkage at butt joints. Carry planks on edge. Protect edges and corners from breakage. James Hardie is not responsible for damage caused by improper storage and handling of the

CUTTING INSTRUCTIONS

OUTDOORS

1. Position cutting station so that airflow blows dust away from the user and others near the cutting area.
2. Cut using one of the following methods:
 - a. Best: Circular saw equipped with a HardieBlade® saw blade and attached vacuum dust collection system. Shears (manual, pneumatic or electric) may also be used, not recommended for products thicker than 7/16 in.
 - b. Better: Circular saw equipped with a dust collection feature (e.g. Roar® saw) and a HardieBlade saw blade.
 - c. Good: Circular saw equipped with a HardieBlade saw blade.

INDOORS

- DO NOT grind or cut with a power saw indoors. Cut using shears (manual, pneumatic or electric) or the score and snap method, not recommended for products thicker than 7/16 in.
- DO NOT dry sweep dust; use wet dust suppression or vacuum to collect dust.
 - For maximum dust reduction, James Hardie recommends using the "Best" cutting practices. Always follow the equipment manufacturer's instructions for proper operation.
 - For best performance when cutting with a circular saw, James Hardie recommends using HardieBlade® saw blades.



HardieShingle® Siding

SINGLE FAMILY INSTALLATION REQUIREMENTS

EFFECTIVE APRIL 2018

IMPORTANT: FAILURE TO FOLLOW JAMES HARDIE WRITTEN INSTALLATION INSTRUCTIONS AND COMPLY WITH APPLICABLE BUILDING CODES MAY VIOLATE LOCAL LAWS, AFFECT BUILDING ENVELOPE PERFORMANCE AND MAY AFFECT WARRANTY COVERAGE. FAILURE TO COMPLY WITH ALL HEALTH AND SAFETY REGULATIONS WHEN CUTTING AND INSTALLING THIS PRODUCT MAY RESULT IN PERSONAL INJURY. BEFORE INSTALLATION, CONFIRM YOU ARE USING THE CORRECT HARDIEZONE® PRODUCT INSTRUCTIONS BY VISITING HARDIEZONE.COM OR CALL 1-866-942-7343 (866-9-HARDIE)

STORAGE & HANDLING:

Store flat and keep dry and covered prior to installation. Installing siding wet or saturated may result in shrinkage at butt joints. Carry planks on

CUTTING INSTRUCTIONS

OUTDOORS


1. Position cutting station so that airflow blows dust away from the user and others near the cutting area.
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 - a. Best: Circular saw equipped with a HardieBlade® saw blade and attached vacuum dust collection system. Shears

INDOORS

- DO NOT grind or cut with a power saw indoors. Cut using shears (manual, pneumatic or electric) or the score and snap method, not recommended for products thicker than 7/16 in.
- DO NOT dry sweep dust; use wet dust suppression or vacuum to collect dust.

The HARDIE-Family of Marks has also been promoted through the 100% HARDIE® promotional program, which is similar to a “look for” advertising campaign and commitment program. The 100% HARDIE® campaign was established to encourage construction and provide extra protections for projects that utilize all James Hardie building materials. The promotion would encourage consumers to look for the HARDIE brand (e.g. HardiePlank, HardieTrim, HardieBacker, etc.) to make a 100% HARDIE® built home. See, for example, the archived webpages shown below:

THE 100% HARDIE HOME




Top to bottom, our products are defined by uncompromising performance, authentic aesthetics and unrivaled design options.

A 100% HARDIE exterior features America's #1 brand of siding and the only trim with the character to stand beside it.

There's no substitute for authentic James Hardie siding and trim. Select from our full collection of products to design your home's exterior.

[Request a Quote](#)



In addition to its Class 19 building and construction materials, James Hardie also provides various metal hardware products under its JAMESHARDIE and HARDIE** brands including metal fasteners, namely, bolts, nails, nuts, rivets, screws, and ballistic fasteners, (see: U.S. Registration 5089776 for JAMESHARDIE and U.S. Registration 5728168 for HARDIENAIL covering Class 6 goods) as well as related products such as blades for power tools and saws in Class 7 (see: U.S. Registration 5089776 for JAMESHARDIE, and U.S. Registration Nos. 3661216 and 3643927 for HARDIEBLADE), hand tools in Class 8, weather barriers and tape in Class 17 (see: U.S. Registration 3828781 for HARDIEWRAP, and U.S. Registration 5089776 for JAMESHARDIE) all of which are used with its building and construction materials.





In the sections that follow, Applicant provides more details and evidence showing the widespread presence and recognition James Hardie and its HARDIE-Family of Marks have gained in the building and construction industry. Through this use, the relevant public has come to recognize the use of the HARDIE prefix in the building and construction industry as signaling that the named products or services come from James Hardie.

Accordingly, even when a new product or service that follows the same HARDIE-naming convention is introduced to the market, customers will already recognize the mark as a source identifier for James Hardie products (even before the product has launched in commerce). For example, the expansion of the HARDIEBACKER mark which has already garnered a strong reputation for goods that are related to the building and construction industry, will instantly be recognized by consumers as a James Hardie product.

e) **Further Evidence Showing that James Hardie Has Acquired Distinctiveness in the HARDIE Mark**

James Hardie’s product reach and promotional activities.

James Hardie’s advertising, marketing and promotional expenditures for the James Hardie brand and the HARDIE-Family of Products well exceed USD \$1 million annually. Advertising and promotional efforts include magazine ads, television ads, billboards, in-store advertisements and displays, trade shows, online promotion, sweepstakes, and the like. A small sample of James Hardie’s advertising and promotional efforts for its house mark and family of brands is described below.

In-Store Presence:

James Hardie products, including the HARDIEBACKER mark, are widely distributed in the U.S. in thousands of brick and mortar stores including major retail stores such as The Home Depot and Lowes. In fact, James Hardie products are available in every Lowes and The Home Depot store in the U.S., and also appear at the stores of other large-scale dealers such as Boise, Weyco, ABC Supply, Norandex, Lansing Building Products, BFS-ProBuild, among others.

In addition to being sold in nationally famous stores, James Hardie products are offered prime in-store display space, such as being placed at the beginning of the aisles, close to the registers, and near the front entrance. James Hardie is also provided a large promotional space at these stores, giving its name and its products a strong presence. See for example, the following in-store displays that show the use and promotion of various products in the HARDIE-Family.

The Home Depot:



(HardieBaker® displayed)



(HardieBacker® displayed)

Lowes:



(HardiePanel® displayed)



(HardiePlank® displayed)



(HardieZone® displayed)



(HARDIESOFFIT®, HARDIESHINGLE®, and HARDIEPLANK® displayed)







(numerous of the HARDIE-Family of Marks displayed)


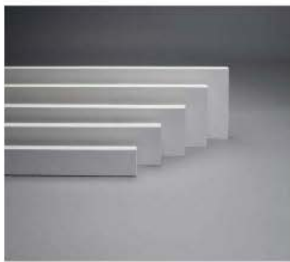


Online Retailers:

The James Hardie marks and products are also available on major retail websites including those of The Home Depot and Lowes.

- (a) TheHomeDepot.com showing HARDIEBACKER® HARDIEPLANK® HARDIETRIM® HARDIEPANEL® HARDIESOFFTIT® HARDIEBLADE® products for purchase with certain products being labeled as a “**best seller**”:

Sort By: **Best Match**


<p><input type="checkbox"/> Compare</p>  <p>Best Seller James Hardie HardiePlank HZ10 5/16 in. x 8.25 in. x 144 in. Fiber Cement Select Cedarmill Lap Siding Model# 215518 ★★★★★ (224) BULK PRICE \$7⁴⁸ Buy 50 or more \$6.73</p> <p>✓ Next-day delivery Set your store to see local availability</p> <p>Add to Cart</p>	<p><input type="checkbox"/> Compare</p>  <p>James Hardie HardieBacker 3 ft. x 5 ft. x 1/4 in. Cement Backerboard Model# 220022 ★★★★★ (549) BULK PRICE \$8⁹⁸ Buy 30 or more \$8.08</p> <p>✓ Next-day delivery Set your store to see local availability</p> <p>Add to Cart</p>	<p><input type="checkbox"/> Compare</p>  <p>James Hardie HardiePanel HZ10 5/16 in. x 48 in. x 96 in. Fiber Cement Sierra 8 Panel Siding Model# 9000523 ★★★★★ (108) \$37⁷³</p> <p>✓ Next-day delivery Set your store to see local availability</p> <p>Add to Cart</p>	<p><input type="checkbox"/> Compare</p>  <p>Best Seller James Hardie HardieBacker 3 ft. x 5 ft. x 0.42 in. Cement Backerboard Model# 220023 ★★★★★ (511) BULK PRICE \$10⁹⁸ Buy 30 or more \$9.88</p> <p>✓ Next-day delivery Set your store to see local availability</p> <p>Add to Cart</p> <p>Feedback</p>
--	---	---	--

<p><input type="checkbox"/> Compare</p>  <p>James Hardie HardiePlank HZ10 5/16 in. x 8.25 in. x 144 in. Fiber Cement Beaded Smooth Lap Siding Model# 215608 ★★★★★ (21) \$9²¹</p> <p>✓ Next-day delivery Set your store to see local availability</p>	<p><input type="checkbox"/> Compare</p>  <p>James Hardie HardieTrim HZ10 .75 in. x 3.5 in. x 144 in. Fiber Cement Smooth Primed Trim Board Model# 216662 ★★★★★ (12) \$11⁷⁶</p> <p>✓ Next-day delivery Set your store to see local availability</p>	<p><input type="checkbox"/> Compare</p>  <p>New James Hardie HardiePanel HZ10 5/16 in. x 48 in. x 96 in. Fiber Cement Sierra 8 Panel Siding Model# 9003080 ★★★★★ (1) \$37⁷³</p> <p>✓ Next-day delivery Set your store to see local availability</p>	<p><input type="checkbox"/> Compare</p>  <p>James Hardie HardiePlank HZ10 5/16 in. x 8.25 in. x 144 in. Fiber Cement Smooth Lap Siding Model# 215615 ★★★★★ (1) \$10³⁵</p> <p>✓ Next-day delivery Set your store to see local availability</p> <p>Feedback</p>
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<p>James Hardie HardiSoffit 24 in. x 96 in. White Cement-Fiber Vented Smooth Primed Soffit Model# 9016072 ★★★★★ (1) \$28³²</p> <p>✓ Next-day delivery Set your store to see local availability</p> <p>Add to Cart</p>	<p>James Hardie HardieTrim HZ10 1 in. x 3.5 in. x 12 ft. Gray Fiber Cement Smooth Trim Board Model# 216642 ★★★★★ (1) \$12³³</p> <p>✓ Next-day delivery Set your store to see local availability</p> <p>Add to Cart</p>	<p>James Hardie HZ10 12 ft. White Composite Smooth Primed Vented Soffit Model# 9016084 ★★★★★ (2) \$32²</p> <p>✓ Next-day delivery Set your store to see local availability</p> <p>Add to Cart</p>	<p>James Hardie 5/16 in. x 8.25 in. x 12 ft. Hardiplank HZ10 Smooth Primed Siding Model# 215605 \$10³⁵</p> <p>✓ Schedule delivery Set your store to see local availability</p> <p>Add to Cart</p>
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Feedback

Compare



More Options Available

Diablo 7-1/4 in. x 4-Teeth Polycrystalline Diamond (PCD) Tipped James Hardie/Fiber Cement Saw Blade
Model# D0704DH
★★★★★ (206)
\$44⁹⁷

✓ Free delivery with \$45 order
Set your store to see local availability

Add to Cart

(b) Lowes.com showing HARDIEPLANK® HARDIEPANEL® HARDIETRIM® and HARDIEBACKER® for sale:

Compare



James Hardie 0.42-in x 36-in x 60-in **HardieBacker** Fiber Cement Backer...

★★★★☆ (241)

\$14.47

Compare



James Hardie 3.5-in x 144-in **HardieTrim** Primed Smooth Fiber Cement Trim

★★★★★ (2)

\$14.25

Compare



James Hardie 0.25-in x 36-in x 60-in **HardieBacker** Fiber Cement Backer...

★★★★☆ (304)

\$11.47

Sort by: **Featured**



Compare



James Hardie 8.25-in x 144-in-HZ10 **HardiePlank** Smooth Fiber Cement L...

★★★★★ (8)

\$9.80

Compare



James Hardie 8.25-in x 144-in HZ10 **HardiePlank** Cedarmill Fiber Cement...

★★★★☆ (96)

\$9.57

Compare



James Hardie 48-in x 96-in HZ10 **HardiePanel** Smooth Fiber Cement...

★★★★★ (18)

\$41.48

Compare



James Hardie 48-in x 96-in-HZ10 **HardiePanel** Sierra 8 Fiber Cement...

★★★★☆ (61)

\$39.98

(c) Paslode.com advertising the HARDIENAIL® fasteners

<https://www.paslode.com/products/fasteners/hardienail-studless-siding-fastener>

The screenshot shows the top navigation bar of the Paslode website with categories: FRAMING SYSTEMS, FINISH SYSTEMS, EXTERIOR SYSTEMS, and SERVICE & SUPPORT. Below the navigation is a 'NEW' badge and the product title: 'HardieNail™ - Studless Siding Fastener with tetraGRIP™ Fastening Technology'. A descriptive paragraph states: 'The HardieNail Siding Fastener is a 304 Stainless Steel 1-1/8" x .117" fastener. The shorter fastener prevents unintended damage to Electrical, Plumbing and HVAC lines hidden behind sheathing. It also features a large .300" Head for maximum holding power.' A bulleted list highlights four key features: 1. Why It Works Better - The revolutionary tetraGRIP™ technology barbed helix design of the HardieNail™ Studless Siding Fastener drives as fast as a nail and has the holding power of a screw. 2. Rotation Bonds Nail to Wood - Mechanically bonds with the wood fibers for superior holding power. 3. Strong Non-Destructive Wood Interaction - Efficient rotation helps eliminate wood destruction common in standard ring shank nails. 4. Superior Withdrawal Resistance - The barbed helix-to-wood engagement creates a high load capacity and does not require a nail-to-stud interaction. Below the list is a 'WHERE TO BUY' button. To the right of the text is a close-up image of the fastener being driven into a wooden stud, with three small circles below it indicating a carousel of images.

The screenshot shows a detailed product description for the 'HARDIENAIL™ STUDLESS FASTENING SYSTEM FEATURING PASLODE TETRAGRIP™ FASTENING TECHNOLOGY'. On the left is a green box with the 'HardieNail Studless Siding Fasteners' logo and 'FEATURING PASLODE tetraGRIP™ FASTENING TECHNOLOGY' below it. The main text describes the system as a new innovative method for quickly and securely installing James Hardie fiber cement siding. It states that the HardieNail features Paslode's patented tetraGRIP™ fastening technology, which allows siding installers to fasten directly to OSB sheathing. Fastening to a stud is not required. With the HardieNail fastener, HardiePlank siding can be installed 20% faster on average. This fastener simplifies the installation process and saves time by eliminating the time needed to locate and mark studs, and to measure and cut planks to land on studs. The text further explains that the HardieNail tetraGRIP™ Siding Fastening System is a technological breakthrough for James Hardie fiber cement siding installers. With its dedicated pneumatic coil nailer, the tetraGRIP™ Siding Fastening System drives as fast as a nail and has the holding power of a screw. Fast, secure installation without fastening to studs. A final bullet point notes: '* Average reduction in HardiePlank Siding installation time compared to using standard nails and pneumatic nailing. Complicated architecture, experience or site conditions can impact efficiency, creating some limitations to average install reduction time.'

Trade Shows:

James Hardie also has a significant presence at major U.S. trade shows in the building and construction industry, such as the International Builders Show (IBS) which has over 60,000 registered attendees each year; Surfaces which hosts approximately 700 businesses; and the Minneapolis H&G show which hosts approximately 96,000 people. James Hardie attends approximately 30 annual trade shows and another 200 of the smaller home and garden shows. Photographs from some of James Hardie's trade show displays are shown below:



(HardieBacker® displayed)



(HardieWrap® displayed)



(**HardieShingle**® and **HardiePlank**® displayed)

Television Advertisements:

James Hardie has had numerous television commercial spots, such as on HGTV and DIY Network. James Hardie was also featured on a one-hour special for the television series DIY Network Blog Cabin. Following are sample screenshots from the television spots:



(**HardieBacker**® displayed)





(HardieWrap® displayed)



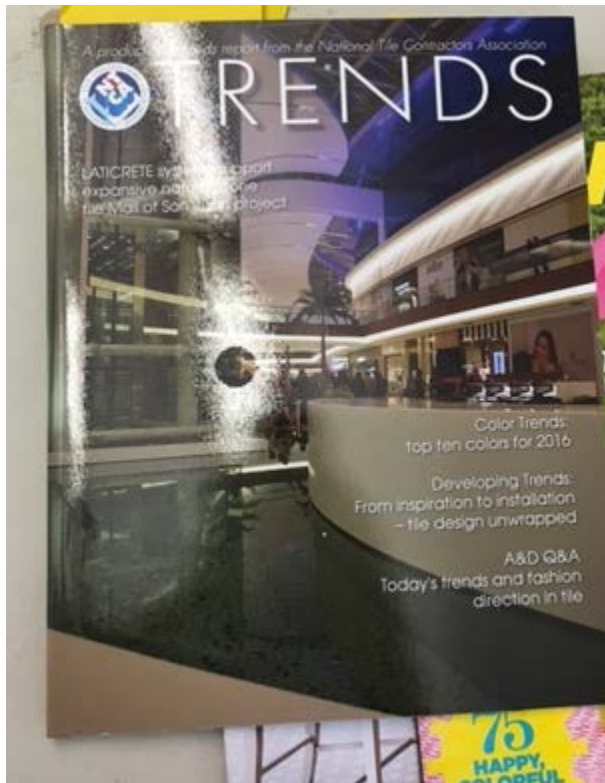
Radio Broadcast:

James Hardie has also been featured on the Angie's List radio and podcast show in the form of an interview with the James Hardie senior marketing manager. The show is available through AngiesList.com and Apple iTunes.

Magazine Advertisements:

James Hardie has a long list of magazine partners including HGTV, Southern Living, Sunset, Traditional Home, Trends, Builder, Coastal Living, among many more. Sample magazine advertisements are shown below:





(HardieBacker® displayed)



Sample Billboard:

The following billboard is with one of James Hardie’s partner contractors, advertising the James Hardie® and 100% HARDIE® marks:



Online Advertisements:

James Hardie also advertises online through various mediums including advertising on partner websites, promoting its products and services via social media avenues such as its YouTube channel, Facebook page, Twitter page, Houzz, LinkedIn, Pinterest and by promotion through its own numerous websites.

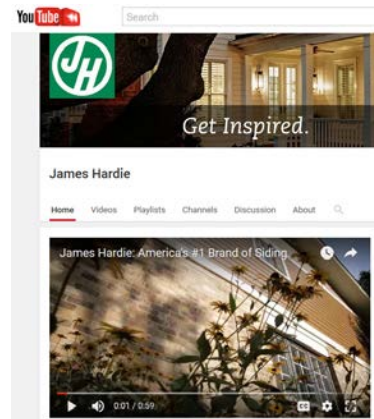
Facebook:



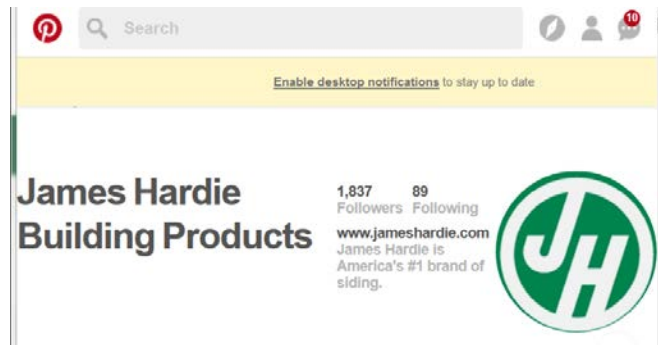
Twitter:



YouTube:



Pinterest:



Co-Branding with Licensed Partners:

James Hardie has extensive cobranding partnerships with dealers, distributors, and contractors. Additionally, James Hardie works with members from its “Contractor Alliance Program” program which constitutes a network of 3000 contractors that sell, install and promote James Hardie products, but that also receive a wide range of business support, marketing, and business development services from James Hardie. The program is marketed under the HardieAlliance.com website:

We've got your siding, your trim
AND YOUR BACK.

Give your homes instant curb appeal and lasting character with the endless design possibilities and uncompromising performance of James Hardie® siding and trim.

Join our Contractor Alliance™ Program and discover how we can help strengthen your business.

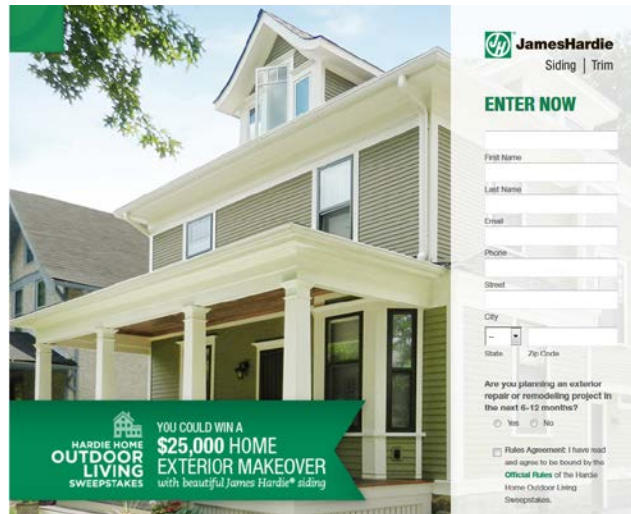
Visit HardieAlliance.com

JamesHardie
Siding | Trim

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Sweepstakes:

James Hardie has also promoted its brands through sweepstakes with a grand prize of a \$25,000 home makeover. (See: <http://www.jameshardiesweepstakes.com/>.)



Awards and Recognition:

James Hardie enjoys a significant reputation for its quality products and services that it provides to its customers. As such, it has received numerous accolades from the industry, such as the following listed below. Some of the recognitions are of individual products in the HARDIE-Family, whereas others recognize the company as a whole.

- 2019 James Hardie earns 2019 David Weekly Homes’ Prestigious “**Partner of Choice**” Award
- James Hardie recognized as a “**brand leader**” in Builder Magazine from 2006-2016



- HardiePlank® is James Hardie’s best-selling product as well as the **most popular brand** of siding in America according to Hanley Wood’s 2015 Builder Brand Use report.
- James Hardie siding ranked #1 by Angie’s List members for **industry leading quality, durability and curb appeal.**
- HardiePlank® lap siding named “**Best Building Products** Made in America” by This Old House.



- HardieBacker® awarded the **most preferred brand** of backer board for floor and tile installation contractors according to Clear Seas Research.
- In May 2013 HardiePlank® received the **Good Housekeeping Seal.**



- James Hardie receives **Partners of Choice** award from David Weekley Homes for the 10th year.
- Readers' Choice 2016 Award for the "**Greenest Siding Brand**" for 5 straight years.



- **Exclusive siding partner** with Southern Living Inspired Communities.



- HardiePlank® recognized in Money magazine as a **great value**.

- Selected for the Better Homes and Gardens Innovation Home in 2015.
- February 18, 2017 Article in The Post and the Courier recognizing James Hardie as follows: "James Hardie was a pioneer in using cement to manufacture tough-as-nails siding and other durable exterior cladding materials for the residential and commercial building trades. HardiePlank is among its best-known consumer brands." (See attached Exhibit D.
- Recognition by the following magazines, trade publications and media:



Community Partnerships:

James Hardie also contributes to the community through partnerships with organizations such as the Travis Mills foundation, donating siding to help build retreat centers for veterans:



James Hardie also participated in building bicycles donated to the Boys and Girls Club of Miami Dade:

JAMES HARDIE GIVES BACK BY BUILDING BICYCLES



James Hardie is proud to support organizations that help build strong communities. On Thursday, Nov. 8, 2018, attendees of our SIDE Master Academy in Miami assembled bicycles that will be donated to the Boys & Girls Club of Miami-Dade.

[Read more...](#)

and volunteered in community efforts to repair and rehabilitate homes in Illinois before the onset of winter:

JAMES HARDIE TEAM MEMBERS HELP REPAIR HOUSES BEFORE WINTER



James Hardie team members participated in a community effort to repair and rehabilitate homes in the greater Peru, Illinois area.

[Read more...](#)

James Hardie also participates in restoration projects, joining with Northern American Mission Board in 2018 to restore the First Baptist Church Sutherland Springs after the 2017 mass shootings at the Texas-based church:

JAMES HARDIE TO ASSIST IN REBUILD OF FIRST BAPTIST CHURCH SUTHERLAND SPRINGS

Company encourages additional donations to support Texas community after last year's tragic event

CHICAGO (October 29, 2018) – James Hardie Building Products, the world leader in fiber cement siding, is working with the North American Mission Board (NAMB) and other partners to restore the First Baptist Church Sutherland Springs following the horrific mass shooting in November 2017.

James Hardie is donating siding and trim to the Sutherland Springs rebuild, which includes a new worship center and education building. Rebuild efforts led by the NAMB – which is part of the Southern Baptist Convention and is based in the Atlanta area – began in May 2018 and will continue through spring 2019.

The advertising, marketing and promotional programs featured above are just a small fraction of the recognition that the James Hardie company and its HARDIE-Family of Marks have in the marketplace. There is no doubt that James Hardie has built a significant reputation as a key leader in the building and construction industry centered around its HARDIE brand and family.

Consumer Survey showing recognition of the HARDIE brand and prefix as a source identifier.

Applicant conducted a carefully built anonymous survey of the relevant market of professionals in the building and construction industry. The list of relevant members of the building and construction industry was purchased from an independent source not connected to James Hardie. The survey was sent anonymously and was careful to not reveal the James Hardie brand anywhere when asking questions about the association that consumers made with the term HARDIE. The name of the survey, email address, and body of the survey did not make any reference to the James Hardie brand. The James Hardie name was not revealed until the last question in the survey at which point participants could not go back to change their answers to past questions and could not re-take the survey. The results of the survey showed that consumers recognize the HARDIE prefix and HARDIE mark exclusively in connection with James Hardie.

Out of 10 survey participants, when asked the question: “If you see the term HARDIE in connection with building and construction products would you associate that term with (a) one company (b) more than one company or (c) no company” 9 out of the 10 participants said “one company” showing that the consumers see HARDIE as capable of serving as a source-identifier. When asked, “What company or companies do you associate with the term HARDIE?” 7 out of the 10 respondents provided the following answers, and the remaining 3 skipped the question: 1. James Hardie Siding, 2. James Hardi Co. 3. James Hardie 4. James Hardie 5. Hardie Board 6. Hardie Siding and trim 7. Harris board. The first 6 responses directly named James Hardie. The 7th respondent answered “Harris board” which is not an actual brand of backer boards, seeming to suggest that the respondent may have mistyped the term “Hardie” referring to the James Hardie boards, also commonly known and referred to in the industry as “HardiBoard.”

The survey then asked questions to see whether customers would associate new members of the HARDIE-Family, specifically relating to the marks HARDIENAIL and HARDIEPAINT which had not yet launched in commerce as of the date of the survey, and HARDIESTORE which only recently launched in commerce as of the date of the survey.

- When asked “If you saw the term HARDIENAIL in connection with products or services related to building and construction would you associate that term with (a) one company (b) more than one company or (c) no company” 6 of the respondents answered “one company”. The remaining four respondents skipped the question. When asked: “What company or companies do you associate with HARDIEDNAIL?” the five responses received were: 1) JAMES HARDIE 2) James Gardi Co. 3) JamesHardie 4) James Hardie and 5) Hardie. The remaining five respondents skipped the question.
- When asked “If you saw the term HardiePaint in connection with products or services related to building and construction would you associate that term with (a) one company (b) more than one company or (c) no company?” 5 respondents answered “one company”, one respondent answered “no company” and the remaining four respondents

skipped the question. When asked: “What company or companies do you associate with HardiePaint?” the five responses received were: 1) James Hardie Siding 2) James Hardi Co. 3) James Hardie 4) Hardie and 5) Hardie Siding. The remaining five respondents skipped the question.

- When asked “What company or companies do you associate with the term HardieStore?,” only one respondent answered; the response was: James Hardi Co.

The final question of the survey asked: “Can you identify the brand name of any products sold by James Hardie?” Four respondents answered this question, providing the following answers: 1. Hardie Cement Board Siding & Trim 2. Yes 3. Hardieboard hardieplank 4. Hardie Board. As a reminder, this was the only time in the survey where the James Hardie name was revealed. The survey was designed so that respondents could not go back to change their prior answers or retake the survey from the same device.

The answers provided by the ten random survey participants show that there is brand recognition in the HARDIE mark and in the Hardie-Family of Marks and strongly support a showing that Applicant has acquired distinctiveness in the prefix HARDIE in connection with the building and construction industry.

II. Conclusion

Applicant respectfully requests that the Examining Attorney consider the evidence and arguments submitted herein and approve Applicant’s mark for publication. Applicant believes that the application should proceed to registration as inherently distinctive. However, if the Examining Attorney still believes that the HARDIEBACKER is not inherently distinctive with respect to the applied-for goods, then Applicant requests that the Examining Attorney approve the application on a claim of 2(f) in part based on the recognition and reputation Applicant has built in the HARDIE mark.

Should there be any further questions, or should the Examining Attorney require any additional information, the Examining Attorney is encouraged to contact the Applicant’s attorney.