

ESTTA Tracking number: **ESTTA234473**

Filing date: **09/03/2008**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	W. R. Grace & Co.-Conn.
Granted to Date of previous extension	09/03/2008
Address	7500 Grace Drive Columbia, MD 21044 UNITED STATES
Attorney information	John P. Rynkiewicz Kaye Scholer LLP 901 Fifteenth Street, N.W. Suite 700 Washington, DC 20005 UNITED STATES jrynkiewicz@kayescholer.com, kimberly.sauter@grace.com Phone:2026823500

Applicant Information

Application No	77350635	Publication date	05/06/2008
Opposition Filing Date	09/03/2008	Opposition Period Ends	09/03/2008
Applicant	Grace Biotech Corporation No. 44-3, Polowen, Polo Tsun Hukou Hsiang, TAIWAN		

Goods/Services Affected by Opposition

Class 001. All goods and services in the class are opposed, namely: UNPROCESSED DECOMPOSABLE STARCH RESINS, EPOXY RESINS, LOW GLOSS THERMOPLASTIC RESINS, PHENOLIC RESINS, POLYESTER RESINS, POLYETHYLENE RESIN, POLYPROPYLENE RESINS, SYNTHETIC RESINS, UNPROCESSED ARTIFICIAL RESINS, UNPROCESSED SYNTHETIC RESINS

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	733284	Application Date	08/31/1961
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Registration Date	06/26/1962	Foreign Priority Date	NONE
Word Mark	GRACE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U016 (International Class 019). First use: First Use: 1960/06/03 First Use In Commerce: 1960/08/12 Water Repellents and Barrier Coatings for Use on Masonry		

U.S. Registration No.	1437819	Application Date	02/18/1986
Registration Date	04/28/1987	Foreign Priority Date	NONE
Word Mark	GRACE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1985/07/00 First Use In Commerce: 1985/10/00 COMPUTER PROGRAMS		

U.S. Registration No.	1607468	Application Date	11/16/1989
Registration Date	07/24/1990	Foreign Priority Date	NONE
Word Mark	GRACE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 017. First use: First Use: 1989/08/12 First Use In Commerce: 1989/08/12 PLASTICS FOR INDUSTRIAL/COMMERCIAL PACKAGING USE		

U.S. Registration No.	1758304	Application Date	06/11/1992
Registration Date	03/16/1993	Foreign Priority Date	NONE
Word Mark	GRACE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1950/00/00 First Use In Commerce: 1950/00/00 printed chemical dosage guides, paper or cardboard uncalibrated rulers containing printed matter; paper charts, paper graphs, brochures and pamphlets pertaining to chemicals, health care, [restaurants, chocolate and cocoa,] construction products, [animal breeding services,] energy, shipping and food service; magazines and newsletters pertaining to personal health, diet and lifestyle; annual corporate reports; pens, pencils, stationery-type portfolios, clipboards and note pads		

U.S. Registration No.	1751126	Application Date	06/11/1992
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Registration Date	02/09/1993	Foreign Priority Date	NONE
Word Mark	GRACE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1960/00/00 First Use In Commerce: 1960/00/00 measuring tapes, slide rules; computer programs for use in the chemical, construction, water treatment and petroleum fields; hand-held data logger to interface with computer programs for use with monitoring and managing water treatment systems; protective clothing; concrete temperature gauge; dipstick gauge for measuring liquid nitrogen; and laboratory apparatus used for metering and measuring in scientific research, in the fields of ultrafiltration, pharmaceuticals, biotechnology, specialty chemicals and chromatography		

U.S. Registration No.	1813264	Application Date	06/12/1992
Registration Date	12/28/1993	Foreign Priority Date	NONE
Word Mark	GRACE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 001. First use: First Use: 1954/00/00 First Use In Commerce: 1954/00/00 [chemicals for use in water purification and as scale inhibitors and anti-corrosives for industrial, municipal and boiler water treatment; plastic chemicals and polymers for use in industrial and commercial film packaging; scale and corrosion inhibiting preparations for use as additives to boiler water and cooling water]; chemical additives and admixtures for concrete, cement, waterproofing, fireproofing and insulation for use in the construction field; silicas used in a wide variety of industries; dessicants for use as humidity buffers for electronics and a wide variety of general industrial products; silica gel adsorbents used as dessicants for pharmaceutical containers and the like; fluid-cracking catalysts used in the petroleum field;[fertilizers for agricultural and horticultural uses;] hydrogenation catalysts for use in the chemical process industry; catalysts for the control of gaseous pollutant emissions in vehicles and in stationary industrial power plant systems; [chemical additives for the removal of iron deposits in various heating and cooling industrial systems;] cell growth enhancing preparation for use in a laboratory/medical setting; chemicals; namely, metal tolerance and hydrogen selectivity additive for use in the manufacturing of gasoline;[water treatment chemicals in the pulp and paper industries; namely, chemicals for the control of bacterial and fungal slime; oxygen scavenger chemicals for use in industrial, municipal and waste water treatment]; chemical adsorbents for specialized refrigerant dehydration and filtration; chemicals for use in the manufacture of pharmaceuticals; and iron chelates for agricultural purposes]		

U.S. Registration No.	2090423	Application Date	09/05/1995
Registration Date	08/26/1997	Foreign Priority Date	NONE
Word Mark	GRACE		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 039. First use: First Use: 1985/00/00 First Use In Commerce: 1985/00/00 travel information services; travel booking agency services; travel agency services, namely, making reservations and bookings for transportation Class 042. First use: First Use: 1985/00/00 First Use In Commerce: 1985/00/00 travel agency services, namely, making reservations and bookings for temporary lodging

U.S. Registration No.	2090421	Application Date	09/05/1995
Registration Date	08/26/1997	Foreign Priority Date	NONE
Word Mark	GRACE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1959/00/00 First Use In Commerce: 1959/00/00 research services and technical consultation services in the fields of chemicals, biomedicine, water treatment, catalysts, construction products, packaging and film wrap, specialty polymers, bottle, can and container sealants and closures, catalytic converters and biopesticides; chemical laboratory services; chemical analysis services; medical research services; construction products' chemistry, additives and performance analysis services; packaging design services for others; non-religious charitable services, namely, providing food, clothing, community outreach services in the nature of counseling on the subject of education and community awareness services; and food preparation services; vocational guidance services and career counseling for elementary, junior high school and high school students		

U.S. Registration No.	2090422	Application Date	09/05/1995
Registration Date	08/26/1997	Foreign Priority Date	NONE
Word Mark	GRACE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1986/00/00 First Use In Commerce: 1986/00/00 educational services, namely, conducting seminars, conferences and workshops in the field of science, chemicals, the environment and community health and safety; education demonstrations in the field of science; educational services, namely, science workshops for teachers at the elementary and secondary levels; educational services, namely, high school student mentor program and science fair services in the fields of science and industry offered at the secondary level; educational and recreational programs for at-risk youth and low-income developments, namely, classes, conferences and workshops in the fields of personal responsibility, community emergency, business, science and industry		

U.S. Registration No.	1995531	Application Date	09/05/1995
Registration Date	08/20/1996	Foreign Priority Date	NONE

Word Mark	GRACE
Design Mark	
Description of Mark	NONE
Goods/Services	Class 028. First use: First Use: 1977/00/00 First Use In Commerce: 1977/00/00 Christmas tree ornaments, golf balls, golf tees, golf divot repair tool for golfers, tennis balls, toy trucks

U.S. Registration No.	2206302	Application Date	09/05/1995
Registration Date	12/01/1998	Foreign Priority Date	NONE
Word Mark	GRACE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1989/00/00 First Use In Commerce: 1959/00/00 credit union services; non-religious charitable fundraising and non-religious philanthropic services concerning monetary donations; financial investment in the field of stock dividends; underwriting insurance for pre-paid health care and for pre-paid pharmacy prescriptions; installment loans		

U.S. Registration No.	1995539	Application Date	09/05/1995
Registration Date	08/20/1996	Foreign Priority Date	NONE
Word Mark	GRACE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 1976/00/00 First Use In Commerce: 1976/00/00 tote bags, all-purpose sports bags, golf umbrellas, umbrellas, leather briefcase-type portfolios, suitcases, garment bags for travel, travel bags, credit and business card cases		

U.S. Registration No.	1998235	Application Date	09/05/1995
Registration Date	09/03/1996	Foreign Priority Date	NONE
Word Mark	GRACE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 006. First use: First Use: 1976/00/00 First Use In Commerce: 1976/00/00 [money clips (metal),] metal key rings, [metal storage drums] Class 021. First use: First Use: 1976/00/00 First Use In Commerce: 1976/00/00 coffee and beverage cups and mugs; thermal insulated containers for beverages		

U.S. Registration No.	2203422	Application Date	09/05/1995
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Registration Date	11/17/1998	Foreign Priority Date	NONE
Word Mark	GRACE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1959/00/00 First Use In Commerce: 1959/00/00 pens, pencils, note paper, stationery-type portfolios; newsletters pertaining to travel; credit cards for pre-paid health insurance and credit cards for pre-paid pharmacy goods and services; brochures, pamphlets and booklets pertaining to chemicals, construction products, water treatment, container closures and sealants, packaging and plastic film wrap, and healthcare		

U.S. Registration No.	1910938	Application Date	12/23/1993
Registration Date	08/15/1995	Foreign Priority Date	NONE
Word Mark	GRACE DAVISON		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 001. First use: First Use: 1991/11/00 First Use In Commerce: 1991/11/00 chemicals, namely silicas for general industrial use; desiccants for use as humidity buffers for electronics, insulated glass, windows, artwork, cosmetics, pharmaceuticals, refrigerants, chromatography, petrochemical and refining industry and foods products, silica gel adsorbents used as desiccants for pharmaceutical containers; fluid-cracking catalysts used in the petroleum field; polyolefins used in the petroleum industry and in polyethylene processing; hydrogenation catalysts for use in the chemical process industry; catalysts for the control of gaseous pollutant emissions in vehicles and in stationary industrial power plant systems; metal tolerance and hydrogen selectivity additive for use in the manufacturing of gasoline; chemicals for use in the manufacture of pharmaceuticals and toothpastes; chemical polishing powders, rare earth chemicals for general industrial use; chemical catalysts for emission control; molecular sieves for use in fluid cracking catalysts; silica used in the food and beverage industries and in edible oil refining, ethanol production, and in the manufacture of polyethylene resins, plastic containers and films, paints and coatings		

U.S. Registration No.	1535850	Application Date	10/13/1987
Registration Date	04/18/1989	Foreign Priority Date	NONE
Word Mark	GRACE SPECIALTY CHEMICALS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1987/06/24 First Use In Commerce: 1987/06/24 PROVIDING RESEARCH INFORMATION AND CONSULTING SERVICES TO THE CHEMICAL INDUSTRY REGARDING CATALYSTS		

U.S. Application No.	77488630	Application Date	06/02/2008
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Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	GRACE CONSTRUCTION PRODUCTS		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 001. First use: First Use: 1971/07/30 First Use In Commerce: 1972/02/16 Chemicals for use in industry and science; chemicals fo ruse in or on cement, concrete, mortar, masonry, shotcrete, or other cementitious compositions or their manufacture; dispersants and water-reducing additives for use in cement, concrete, mortar, masonry, shotcrete, or other cementitious compositions or their manufacture; fireproofing compositions; adhesives and mastic compositions for use in industry</p> <p>Class 002. First use: First Use: 1994/04/15 First Use In Commerce: 1994/04/15 Anti-corrosive preparations; additives for paints and primers; oils for use in or on cement, concrete, mortar, masonry, shotcrete, or other cementitious compositions; coatings, paints and primers; fireproof paints; pigments and colorants</p> <p>Class 017. First use: First Use: 1983/10/06 First Use In Commerce: 1983/10/06 Waterproofing membranes and vapor barriers; adhesive tapes used in the construction industry for flashing, waterproofing protection; packing, stopping and insulating materials; sealants for construction joints; sealing compounds; moisture barrier materials, namely, waterproofing membrane strips and adhesive tapes</p> <p>Class 019. First use: First Use: 1960/01/00 First Use In Commerce: 1960/01/00 Non-metallic building materials; materials for use in building and civil engineering, construction and repair; bituminous coatings for roofing; roof flashing, window and door flashings; cementitious fireproofing materials for application to steel floors and beams, concrete surfaces and other construction materials; building materials, natural and artificial stone, cement, lime, mortar, plaster and gravel; pipes of earthenware or cement; road-making materials; asphalt, pitch and bitumen; portable buildings; stone monuments</p> <p>Class 022. First use: First Use: 2002/01/09 First Use In Commerce: 2002/01/09 Polymeric fibers for use in the further manufacture of reinforced concrete, mortar and masonry</p>		

U.S. Application No.	77488633	Application Date	06/02/2008
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	GRACE CONSTRUCTION PRODUCTS		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 037. First use: First Use: 1969/00/00 First Use In Commerce: 1969/00/00 Providing advice to architectural contractors or tradesmen in the building, construction and/or repair industry</p> <p>Class 041. First use: First Use: 1969/00/00 First Use In Commerce: 1969/00/00 Educational services, namely, conducting seminars, conferences and workshops in the field of science, business, technology, chemicals, the environment and community health and safety; education demonstrations in the field of science; educational services - namely, high school student mentor programs and science fair services in the fields of science and industry offered</p>		

	<p>at the secondary level</p> <p>Class 042. First use: First Use: 1969/00/00 First Use In Commerce: 1969/00/00</p> <p>Research, development, testing, formulation and consultancy services; research services and technical consultation services in the field of chemicals, construction products; chemical analysis services; construction products' chemistry, additives and performance analysis services; vocational guidance and career counseling for elementary, junior and high school students; community outreach services in the nature of counseling on the subject of education and community awareness</p>
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Attachments	<p>77488630#TMSN.jpeg (1 page)(bytes)</p> <p>77488633#TMSN.jpeg (1 page)(bytes)</p> <p>GraceOpp-GraceBio.pdf (7 pages)(208885 bytes)</p>
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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	/john p rynkiewicz/
Name	John P. Rynkiewicz
Date	09/03/2008

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

W. R. GRACE & CO.-CONN.)	
)	
Opposer)	
)	
v.)	Opposition No. _____
)	
GRACE BIOTECH CORPORATION)	
)	
)	
Applicant.)	

NOTICE OF OPPOSITION

W. R. Grace & Co.-Conn., a corporation organized under the laws of the state of Connecticut, located at 7500 Grace Drive, Columbia, Maryland 21044 (“GRACE”), believes that it will be damaged by the registration of the mark “GraceBio” (& Design) which is the subject of Application Serial No. 77350635 and hereby opposes the registration of said mark.

As grounds for Opposition, it is alleged that:

1. Opposer, GRACE, a diversified company founded in 1854, is, among other things, a leading global specialty chemicals company whose stock is publicly traded on the New York Stock Exchange.

2. For many years and since long prior to the filing date of the Applicant’s application, Opposer has used the mark GRACE, alone and in conjunction with other terms, including but not limited to GRACE CONSTRUCTION PRODUCTS, GRACE DAVISON, GRACE DAREX, GRACE PACKAGING, GRACE COCOA, GRACE TRANSPORTATION SERVICES, GRACE SPECIALTY CHEMICALS and GRACE HEALTHCARE to identify a wide range of goods and services, including those related to the goods of the Applicant.

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3. Opposer is a world-class solutions provider of catalyst systems and catalyst supports to the polyolefins industry for a variety of polyethylene and polypropylene process technologies and its catalysts are used in manufacturing one-third of the world's catalytically produced polyethylene.

4. Opposer produces formulated resins used in the container, construction and packaging fields.

5. Opposer is a provider of material-based value-added solutions for the Life Sciences and Biotechnology industries.

6. Opposer is a leading provider of specialty catalysts, adsorbents and analytical tools to the petrochemical, chemical and pharmaceutical industries, with materials science expertise applied to improving the manufacture of bio-renewable fuels and chemicals.

7. Opposer's "Biofuel Technologies Group" is an innovator, manufacturer and marketer of specialty materials and analytical tools for enhanced biodiesel and bioethanol production. Opposer uses, has used or plans to use such names as "Grace BioRenewables," "Grace BioFuels" and "Biofuel Technologies Group" in this business segment.

8. Other than the opposed Applicant's pending application for "GraceBio' (& Design) there are no other active Class 1 chemical applications or registrations for or comprising "GRACE" in the records of the USPTO.

9. Opposer is the owner of the following United States Principal Register Registration

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Nos. and pending applications for or comprising the mark GRACE.

<u>Trademark</u>	<u>Registration/ Application Number</u>
GRACE	733,284
GRACE	1,437,819
GRACE	1,607,468
GRACE	1,758,304
GRACE	1,751,126
GRACE	1,813,264
GRACE	2,090,423
GRACE	2,090,421
GRACE	2,090,422
GRACE	1,995,531
GRACE	2,206,302
GRACE	1,995,539
GRACE	1,998,235
GRACE	2,203,422
GRACE DAVISON	1,910,938
GRACE SPECIALTY CHEMICALS	1,535,850
GRACE CONSTRUCTION PRODUCTS	77488630
GRACE CONSTRUCTION PRODUCTS	77488633

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10. Opposer is the owner of the domain name registrations for <<www.Grace.com>> and <<www.GraceBioFuels.com>>.

11. As a result of the long use, promotion and advertising under the GRACE mark by Opposer, the federally registered and common law used mark GRACE has become a valuable asset of Opposer serving as a symbol for Opposer and its goods and services and of Opposer's goodwill which is associated with those goods and services, including widespread recognition in the investment and financial community.

12. Applicant's "GraceBio" (& Design) mark is highly similar to the GRACE mark and name adopted and used by Opposer through the years.

13. Applicant's literal portion "GraceBio" in the applied-for mark is the dominant portion and the design portion does not alter the overall commercial impression of the mark.

14. Despite Opposer's long prior common law and statutory rights in the mark GRACE, Applicant, with at least constructive notice of Opposer's federal registrations, and long after Opposer established rights in and to the mark GRACE, filed an application for the registration of the mark "GraceBio" (& Design) for goods described as "unprocessed decomposable starch resins, epoxy resins, low gloss thermoplastic resins, phenolic resins, polyester resins, polyethylene resin, polypropylene resins, synthetic resins, unprocessed artificial resins, unprocessed synthetic resins" in Class 1.

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15. Applicant's goods, as described in its application opposed herein, are sufficiently related to those goods and services offered and rendered by Opposer under the GRACE trademark.

16. Opposer believes and therefore alleges that use and registration of the mark covered by Application Serial No. 77350635 will damage Opposer, for the reasons among others:

- a. that customers and purchasers of the respective goods and services would be confused, mistaken, or deceived as to the source and origin of Applicant's goods rendered under the "GraceBio" & (Design) mark; and
- b. that customers and purchasers of the respective goods and services will assume, contrary to fact, that Applicant's goods are associated with, sponsored by, approved by, or otherwise related to or affiliated with Opposer.

17. Applicant's asserted mark "GraceBio" (& Design) so resembles Opposer's previously used and registered mark GRACE and variations thereof as to be likely, when applied to the goods set forth in Applicant's application, to cause confusion, mistake or deception within the meaning of 15 U.S.C. Section 1052(d).

18. Applicant's asserted mark "GraceBio" (& Design) so resembles Opposer's previously used and registered mark GRACE and variations thereof as to be likely, when applied to the goods set forth in Applicant's application, to falsely suggest a connection with the Opposer within the meaning of 15 U.S.C. Section 1052(a).

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19. Applicant's asserted mark "GraceBio" (& Design) is likely to dilute the distinctive quality of Opposer's famous, distinctive and federally-registered GRACE mark within the meaning of 15 U.S.C. Section 1125(c)(1).

WHEREFORE, Opposer respectfully prays that this Opposition be sustained and that registration to Applicant be refused.

The United States Patent and Trademark Office and the Trademark Trial and Appeal Board are hereby authorized to charge any fees necessitated by this Notice of Opposition to the Deposit Account of Opposer's attorneys, Kaye Scholer LLP, Deposit Account No. 11-0228.

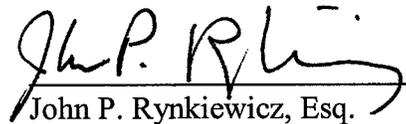
Respectfully submitted,

W. R. GRACE & CO.-CONN.

Date:

Sept. 3, 2008

By:



John P. Rynkiewicz, Esq.

Thomas A. Smart, Esq.

Kaye Scholer LLP

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Washington, DC 20005

Tel: (202) 682-3671

Attorneys for Opposer

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing NOTICE OF OPPOSITION was served on the Applicant by postage paid First Class U.S. Mail on the date set forth below, in an envelope addressed to:

GARY J. NELSON, ESQ.
CHRISTIE, PARKER & HALE, LLP
PO BOX 7068
PASADENA, CA 91109-7068

Sept 3, 2008
Date


John P. Rynkiewicz