

ESTTA Tracking number: **ESTTA300629**

Filing date: **08/12/2009**

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	Nuplex Resins B.V.
Granted to Date of previous extension	08/12/2009
Address	Synthesebaan 1 Bergen op Zoom, 4612 RB NETHERLANDS ANTILLES
Attorney information	Thomas E. Zutic DLA Piper LLP (US) 500 8th Street, NW Washington, DC 20004 UNITED STATES Ann.Ford@dlapiper.com, Thomas.Zutic@dlapiper.com, John.Nading@dlapiper.com, David.Huff@dlapiper.com Phone:2027994141

Applicant Information

Application No	77633410	Publication date	04/14/2009
Opposition Filing Date	08/12/2009	Opposition Period Ends	08/12/2009
Applicant	Setac Corporation Suite E 5905 Johnston Street Lafayette, LA 70503 UNITED STATES		

Goods/Services Affected by Opposition

Class 001. First Use: 1981/08/01 First Use In Commerce: 1981/08/01
All goods and services in the class are opposed, namely: Chemical additives for oil well drilling fluid

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2401530	Application Date	04/19/1999
Registration Date	11/07/2000	Foreign Priority Date	NONE
Word Mark	SETAL		

Design Mark	SETAL
Description of Mark	NONE
Goods/Services	Class 001. First use: First Use: 1971/00/00 First Use In Commerce: 1996/01/00 UNPROCESSED ARTIFICIAL AND SYNTHETIC RESINS FOR MANUFACTURING USE IN THE COATINGS INDUSTRY

U.S. Registration No.	2332518	Application Date	04/19/1999
Registration Date	03/21/2000	Foreign Priority Date	NONE

Word Mark	SETAMINE
Design Mark	SETAMINE
Description of Mark	NONE
Goods/Services	Class 002. First use: First Use: 1971/00/00 First Use In Commerce: 1996/01/00 UNPROCESSED ARTIFICIAL AND SYNTHETIC RESINS FOR USE IN THE COATINGS INDUSTRY

Attachments	75686246#TMSN.gif (1 page)(bytes) 75686243#TMSN.gif (1 page)(bytes) SETAC - Opposition - US.pdf (7 pages)(1463608 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	/Thomas E. Zutic/
Name	Thomas E. Zutic
Date	08/12/2009

2. The Nuplex corporate family dates back to 1952. Nuplex, including through its predecessors-in-interest, has long-established rights in its “SETA” family of marks (hereinafter “‘SETA’ Marks), which include, but are not limited, to the following trademarks:

a. SETATAACK, which registered on June 12, 1984 and December 25, 1990 as Registration Nos. 1,281,151 and 1,628,859, respectively, but which registrations are no longer active;

b. SETAL, which registered on November 7, 2000 as Registration No. 2,401,530; and

c. SETAMINE, which registered on March 21, 2000 as Registration No. 2,332,518.

3. Nuplex uses its “SETA” Marks in connection with, among other things, a variety of chemicals, chemical preparations, water-borne resins for paint and coatings, and artificial resins for use as raw materials for general industrial use.

4. Furthermore, Nuplex, including through its predecessors-in-interest, has extensively and continuously used the “SETA” Marks worldwide, including but not limited to one or more in the United States, since, upon information and belief, at least as early as 1979.

5. Notwithstanding Nuplex’s rights to the “SETA” Marks prior to Applicant’s filing date of December 15, 2008, Applicant filed a use-based Application for registration of the SETAC Mark with a first use date of August 1, 1981.

6. Nuplex has spent a significant amount of money and expended a significant amount of resources in the marketing and sale of goods bearing the “SETA” Marks.

7. Upon information and belief, Nuplex had used one or more of its "SETA" Marks continuously on or in connection with its goods in interstate commerce prior to the filing date of Applicant's Application.

LIKELIHOOD OF CONFUSION – Lanham Act Section 2(d), 15 U.S.C. § 1052(d)

8. Nuplex repeats and realleges the allegations contained in Paragraphs 1 through 7 of this Notice of Opposition.

9. Applicant's Mark is confusingly similar to Nuplex's "SETA" Marks, and, upon information and belief, the respective goods of the parties are substantially related, and are, or would normally be, marketed within the same or similar channels of trade, and to the same class of consumers, with the result that Nuplex's consumers, the trade and the public in general, are likely to be confused, mistaken or deceived as to the origin and/or sponsorship of Applicant's goods under its SETAC Mark, and misled into believing that such goods are marketed by, or are in some way directly or indirectly associated with the goods offered by Nuplex, thus violating Nuplex's rights to its "SETA" Marks.

10. In view of the similarity of the respective marks and the similar or related nature of the goods of the respective parties, Applicant's SETAC Mark so resembles Nuplex's "SETA" Marks, as to be likely to cause confusion and mistake, deceive the public, injure and damage Nuplex and the goodwill and reputation symbolized by Nuplex's "SETA" Marks, and raise a considerable risk of consumer confusion as to the affiliation of Nuplex and Applicant.

11. Likelihood of confusion in this case is enhanced by the fact that Applicant's alleged SETAC Mark and Nuplex's "SETA" Marks both incorporate the key component "SETA" and because the products identified by Applicant's alleged trademark are closely related to the products identified by Nuplex's "SETA" Marks.

12. Applicant is not affiliated or connected with nor is it licensed, endorsed or sponsored by Nuplex.

13. Applicant has never sought or obtained Nuplex's permission to use the SETAC Mark nor has Nuplex approved any of the goods offered or sold by Applicant under the SETAC Mark.

FRAUD

14. Nuplex repeats and realleges the allegations contained in Paragraphs 1 through 13 of this Notice of Opposition.

15. In Applicant's "use-based" application for the SETAC Mark, Applicant declared that: "he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods and/or services of such other person, to cause confusion, or to cause mistake, or to deceive and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true."

16. Upon information and belief, Applicant has made no use of its alleged SETAC Mark on products. Therefore, Applicant has made no use of its alleged SETAC Mark in commerce in connection with Applicant's Goods prior to the Application filing date.

17. Upon information and belief, the Application is *void ab initio* because Applicant was not using the SETAC Mark in commerce on any of Applicant's Goods at the time it filed the Application.

18. Upon information and belief, the specimen submitted by Applicant with its Application does not demonstrate use of the alleged mark in commerce for Applicant's Goods. Indeed, the alleged specimen of use also inappropriately contains the ® registration symbol.

19. Registration of Applicant's Application should be denied because approval was obtained by fraud.

If Applicant obtains such rights as conferred under the Principal Register of the Trademark Act of 1946, it will obtain at least a *prima facie* exclusive right to use its alleged trademark, and Nuplex will be subjected to great and irreparable damage, and Applicant will enjoy unlawful gain and advantage to which it is not entitled under the Trademark Act of 1946.

WHEREFORE, Nuplex believes and avers that it is being, and will continue to be, damaged by registration of the SETAC Mark, and respectfully requests that Application Serial No. 77/633,410 be rejected, that no registration be issued thereon to Applicant, and that the Opposition be sustained in favor of Nuplex.

Nuplex hereby appoints Ann K. Ford, a member of the Bar of the District of Columbia, Thomas E. Zutic, a member of the Bar of the District of Columbia, Ryan C. Compton, a member of the Bar of the District of Columbia, John M. Nading, a member of the Bar of Columbia, David M. Kramer, a member of the Bar of the State of Maryland, and all of the law firm of DLA Piper LLP (US) to transact all business in the USPTO in connection with the above opposition proceeding and hereby revokes all previous powers of attorney herein. Please address all correspondence to:

Ann K. Ford, Esq.
DLA Piper LLP (US)
500 8th Street NW
Washington, DC 20004
Ann.Ford@dlapiper.com

The filing fee for this opposition, in the amount of \$300.00, is hereby electronically transferred with the submission of the Notice of Opposition.

The undersigned, registered agent for Nuplex herein, states that he is authorized to prosecute this opposition, that he has read and signed the foregoing Notice of Opposition and knows the contents thereof, and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that willful false statements may jeopardize the validity of this opposition and any decision resulting therefrom.

Respectfully submitted,

DLA PIPER LLP (US)

By: /s/ Thomas E. Zutic
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*Attorneys for Opposer
Nuplex Resins B.V.*

Dated: August 12, 2009

CERTIFICATE OF SERVICE

I, Thomas E. Zutic, hereby certify that I have this 12th day of August, 2009, served a copy of the foregoing NOTICE OF OPPOSITION via First Class U.S. Mail, postage prepaid, and properly addressed to Applicant as follows:

Mr. Alan Cates
Setac Corporation
5905 Johnston Street, Building E
Lafayette, Louisiana 70503

/s/ Thomas E. Zutic
Thomas E. Zutic
Attorney for Opposer