

ESTTA Tracking number: **ESTTA364852**

Filing date: **08/25/2010**

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	Nano-Tex, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	2220 Livingston Street Suite 201 Oakland, CA 94606 UNITED STATES		

Attorney information	Julia C. Archer Enns & Archer LLP 939 Burke Street Winston-Salem, NC 27101 UNITED STATES jarcher@ennsandarcher.com Phone:336-723-5180		
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**Applicant Information**

Application No	79019869	Publication date	07/27/2010
Opposition Filing Date	08/25/2010	Opposition Period Ends	08/26/2010
International Registration No.	0873906	International Registration Date	09/30/2005
Applicant	NANO-X GmbH Theodor-Heuss-Str. 11a Saarbrücken, 66130 GERMANY		

**Goods/Services Affected by Opposition**

Class 001. All goods and services in the class are opposed, namely: Industrial chemicals for use in the manufacture of surface coatings; unprocessed artificial resins
Class 042. All goods and services in the class are opposed, namely: Scientific and technological services and research and design relating thereto; industrial analysis and research services; all the aforesaid services exclusively for the fields of chemical product manufacture and use as well as the field of surface coating development and manufacture

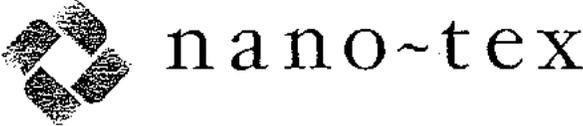
**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
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**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	3018347	Application Date	03/03/2004
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Registration Date	11/22/2005	Foreign Priority Date	NONE
Word Mark	NANOTEX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 001. First use: First Use: 2004/09/01 First Use In Commerce: 2004/09/01 chemicals for treatment of fibers, yarns, fabrics, synthetic materials, webs, or textile finished goods		

U.S. Registration No.	2926588	Application Date	05/13/2002
Registration Date	02/15/2005	Foreign Priority Date	NONE
Word Mark	NANO-TEX		
Design Mark			
Description of Mark	The marks consists in part of four rounded rectangles forming a diamond shape.		
Goods/Services	Class 001. First use: First Use: 2000/11/30 First Use In Commerce: 2000/11/30 chemicals for treatment of fibers, yarns, fabrics, webs, or textile finished goods to enhance performance and/or aesthetics		

U.S. Registration No.	2867197	Application Date	07/11/2001
Registration Date	07/27/2004	Foreign Priority Date	NONE
Word Mark	NANO-TEX		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 020. First use: First Use: 2001/11/10 First Use In Commerce: 2001/11/10 fabric sold as an integral component of furniture

U.S. Registration No.	3023951	Application Date	12/28/1999
Registration Date	12/06/2005	Foreign Priority Date	NONE

Word Mark	NANO-TEX
Design Mark	<b>NANO-TEX</b>

Description of Mark	NONE
Goods/Services	Class 024. First use: First Use: 2001/04/30 First Use In Commerce: 2001/04/30 Fabrics for use in the manufacture of clothing and furnishings for home, industrial, and commercial use; and upholstery fabrics for home, industrial and commercial use

U.S. Registration No.	3154437	Application Date	08/10/2001
Registration Date	10/10/2006	Foreign Priority Date	NONE

Word Mark	NANO-TEX
Design Mark	<b>NANO-TEX</b>

Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 2000/03/31 First Use In Commerce: 2000/03/31 Business marketing and consulting services Class 040. First use: First Use: 2000/10/31 First Use In Commerce: 2000/10/31 Treatment of fabric and similar materials Class 041. First use: First Use: 2000/10/31 First Use In Commerce: 2000/10/31

	<p>Educational services, namely conducting on-site demonstrations, trials, training and workshops in the field of handling and use of industrial chemicals and equipment for fabrics and similar materials</p> <p>Class 042. First use: First Use: 2000/12/31 First Use In Commerce: 2000/12/31</p> <p>Intellectual property services, namely intellectual property licensing and product development</p>
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Attachments	<p>76579413#TMSN.gif ( 1 page )( bytes )</p> <p>76406410#TMSN.gif ( 1 page )( bytes )</p> <p>76283558#TMSN.gif ( 1 page )( bytes )</p> <p>75882693#TMSN.gif ( 1 page )( bytes )</p> <p>76298759#TMSN.gif ( 1 page )( bytes )</p> <p>NANO-X Notice of Opposition.pdf ( 8 pages )(238241 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	/jarcher/
Name	Julia C. Archer
Date	08/25/2010



as the field of surface coating development and manufacture” in International Class 42; among other goods in International Classes 2 and 4 that are not the subject of this notice of opposition. The Application is a request for extension of protection pursuant to the Madrid Protocol and has a priority date of March 30, 2005. The Application was published in the *Official Gazette* on July 27, 2010.

2. Opposer is a leading fabric innovation company providing textile enhancements to the apparel and interior furnishings markets. Founded in 1998, Opposer was the first company to apply nanotechnology to the textile industry. Since introducing its first product in 2000, Opposer has licensed over 175 textile mills worldwide to use its treatments in fabrics sold by over 100 leading apparel and interior furnishing brands in the United States and around the world. Over the years, Opposer has continued to innovate, conduct research, and develop new chemical treatments and enhancements for textiles.
3. Opposer has used the mark NANO-TEX, both alone and in combination with other wording and designs (hereafter collectively “NANO-TEX”), in connection with chemicals for the treatment of fibers, yarns, fabrics, and textile finished goods since at least as early as November 30, 2000. Opposer offers a variety of chemical treatments that give the textiles various desirable characteristics, such as making them more resistant to spills and stains, or more resistant to static, or more resistant to odors, or quicker drying. Since at least as early as April 30, 2001, Opposer has

licensed the NANO-TEX mark to numerous textile mills and textile processors, who use the mark to indicate that the fabrics they offer in connection with the NANO-TEX brand have been treated with the NANO-TEX chemicals and possess the qualities associated with those treatments. Opposer has also licensed the NANO-TEX mark to numerous brand owners, wholesalers and retailers in the United States and around the world who use the NANO-TEX mark in connection with various types of clothing, furnishings and household items, in order to communicate to consumers that the products have the characteristics associated with Opposer's chemical treatments.

4. Through extensive use and advertising by Opposer and its licensees, Opposer's NANO-TEX mark has come to be recognized by relevant consumers both in the textile industry and in the public generally to indicate the source of high quality chemical treatments for textiles, resulting in textiles, clothing items and furnishings with desirable characteristics, such as stain resistance, moisture wicking, static resistance, odor elimination and more. Opposer has developed significant goodwill in the NANO-TEX mark in connection with chemical treatments for textiles and relevant consumers have come to recognize the NANO-TEX mark as an indicator of Opposer as the origin of those goods. Opposer has also developed significant goodwill in the NANO-TEX mark in connection with scientific innovation, research, development and design in the field of chemical textile treatments.

5. Opposer owns several active registrations in the United States for the NANO-TEX mark, including:

- U.S. Reg. No. 3018347 for the mark NANOTEX & Design, filed on March 3, 2004, and registered on November 22, 2005, for “chemicals for treatment of fibers, yarns, fabrics, synthetic materials, webs, or textile finished goods” in International Class 1;
- U.S. Reg. No. 2926588 for the mark NANO-TEX & Design, filed on May 13, 2002, and registered on February 15, 2005, for “chemicals for treatment of fibers, yarns, fabrics, webs, or textile finished goods to enhance performance and/or aesthetics” in International Class 1;
- U.S. Reg. No. 2867197 for the mark NANO-TEX, filed on July 11, 2001, and registered on July 27, 2004, for “fabric sold as an integral component of furniture” in International Class 20;
- U.S. Reg. No. 3023951 for the mark NANO-TEX, filed on December 28, 1999, and registered December 6, 2005, for “fabrics for use in the manufacture of clothing and furnishings for home, industrial, and commercial use; and upholstery fabrics for home, industrial and commercial use” in International Class 24;
- U.S. Reg. No. 3154437 for the mark NANO-TEX, filed on August 10, 2001, and registered October 10, 2006, for “business marketing and consulting services” in International Class 35; “treatment of fabric and similar materials” in International Class 40;

“educational services, namely conducting on-site demonstrations, trials, training and workshops in the field of handling and use of industrial chemicals and equipment for fabrics and similar materials” in International Class 41; and “intellectual property services, namely intellectual property licensing and product development” in International Class 42.

Each of the above registrations is valid, subsisting and uncancelled.

Opposer’s registrations of the NANO-TEX mark are prima facie evidence of Opposer's exclusive right to use the mark in commerce on the goods and services specified in the registrations.

6. The NANO-X mark Applicant seeks to register so resembles Opposer’s NANO-TEX mark as to be likely to cause confusion among consumers when used in connection with identical and closely related goods and services. Applicant’s NANO-X mark is extremely similar to Opposer’s NANO-TEX mark in overall appearance, sound and commercial impression. Applicant’s omission of the “T” sound in the middle of the mark is the only difference, which is not sufficient for consumers to distinguish between the marks.
  
7. The goods and services in International Classes 1 and 42 with which Applicant proposes to use the NANO-X mark are identical and closely related to the goods and services with which Opposer has established rights in the NANO-TEX mark. On information and belief, based upon a review of Applicant’s website, Applicant offers chemicals for use in the

surface coating of textiles, along with other surfaces. Therefore, the industrial chemicals for use in the manufacture of surface coatings listed in Class 1 in Applicant's NANO-X application are identical to the chemical treatments in Class 1 for which Opposer has prior rights in the NANO-TEX mark. The scientific, technological, research and design services for the fields of chemical product manufacture and surface coating development and manufacture are also identical to the scientific, research and development services with which Opposer has established prior rights in the NANO-TEX mark.

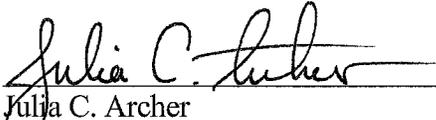
8. The similarity of Applicant's mark NANO-X to Opposer's NANO-TEX mark in overall appearance, sound, and commercial impression, combined with the fact that the goods and services listed in the NANO-X application in Classes 1 and 42 are identical to or very closely related to the goods and services with which Opposer has established prior rights in the NANO-TEX mark, creates a substantial likelihood that relevant consumers would be confused into believing that the goods and services bearing Applicant's NANO-X mark emanate from or are otherwise associated with or licensed by Opposer, thereby causing damage to Opposer.

WHEREFORE, Opposer prays that the goods and services listed in International Classes 1 and 42 in Application Serial No. 79019869 be rejected, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Opposer.

This Notice of Opposition is being filed through the ESTTA system and the fee in the amount of \$600 is being charged to Deposit Account No. 501779.

Respectfully submitted,

Date: Aug. 25, 2010

  
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Julia C. Archer  
Attorney for Opposer

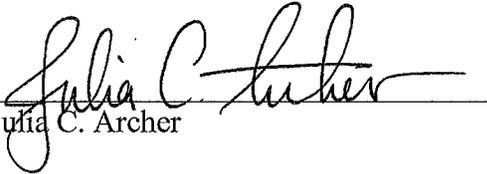
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**CERTIFICATE OF SERVICE**

I hereby certify that on this date I served the foregoing NOTICE OF  
OPPOSITION upon counsel of record by depositing a copy thereof in the United States  
mail, postage prepaid and addressed to:

Aimee L. Kaplan  
Stewart J. Bellus  
Collard & Roe, P.C.  
1077 Northern Blvd.  
Roslyn, NY 11576

This the 25<sup>th</sup> day of August, 2010.

  
Julia C. Archer

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