

ESTTA Tracking number: **ESTTA549404**

Filing date: **07/19/2013**

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	TREMCO ILLBRUCK PRODUKTION GMBH
Granted to Date of previous extension	07/20/2013
Address	WERNER-HAEPF-STRASSE 1 BODENWOEHR, D92439 GERMANY

Attorney information	Scott Woldow Smith, Gambrell & Russell, LLP 1055 THOMAS JEFFERSON ST. NW, SUITE 400 WASHINGTON, DC 20007 UNITED STATES swoldow@sgrlaw.com Phone:202-263-4300
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### Applicant Information

Application No	85810871	Publication date	05/21/2013
Opposition Filing Date	07/19/2013	Opposition Period Ends	07/20/2013
Applicant	Pacific Tide Inc. 11242 Jade Heights San Antonio, TX 78249 UNITED STATES		

### Goods/Services Affected by Opposition

Class 001. All goods and services in the class are opposed, namely: Hydrocarbon Resins; Composite carbon epoxy resins
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### Grounds for Opposition

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

U.S. Registration No.	2850416	Application Date	02/20/2003
Registration Date	06/08/2004	Foreign Priority Date	NONE
Word Mark	PACTAN		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 001. First use: First Use: 1990/00/00 First Use In Commerce: 1997/05/00 Adhesives for general industrial use Class 017. First use: First Use: 1990/00/00 First Use In Commerce: 1997/05/00 Adhesive sealant and adhesive caulking compound for general use

Attachments	TRADEMARK 1.PDF(214304 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	/SW/
Name	Scott Woldow
Date	07/19/2013

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

In the Matter of Trademark Application Serial No. 85/810,871  
Published: May 21, 2013

Tremco illbruck Produktion GmbH	)	
	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. _____
	)	
Pacific Tide Inc.	)	
	)	
Applicant.	)	

**NOTICE OF OPPOSITION**

Commissioner for Trademarks  
**Box TTAB FEE**  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

In the matter of Pacific Tide Incorporated's trademark application for registration of the mark PACTAC, filed on December 27, 2012, application Serial No. 85/810,871, published in the Official Gazette on May 21, 2013, Tremco illbruck Produktion GmbH believes that it will be damaged by registration of the mark identified by trademark application Serial No. 85/810,871, and hereby opposes registration.

Tremco illbruck Produktion GmbH (hereinafter “OPPOSER” or “Tremco”), a Limited Liability Company of the Federal Republic of Germany, having offices located at Werner-Haepf-Strasse 1, Bodenwoehr, D-92439, Germany, believes that it will be damaged by registration of the PACTAC mark identified by Application Serial No. 85/810,871 and hereby opposes the same.

The grounds for opposition are as follows:

1. Opposer is now and has been engaged in the adhesive and sealant industries.
2. Opposer offers a variety of goods and services related to adhesives, sealants, compound membranes and impregnated and non-impregnated tapes.
3. Opposer offers a wide variety of products for use in various and diverse markets.
4. Opposer is the owner of United States Registration No. 2,850,416, for the mark PACTAN, which registered on June 8, 2004, and is currently registered in association with “adhesives for general industrial use,” in Class 1 and “adhesive sealant and adhesive caulking compound for general use,” in Class 17.
5. Opposer’s ownership of United States Trademark Registration No. 2,850,416, has been valid and continuous and has not been abandoned.
6. Opposer’s mark is symbolic of goodwill and consumer recognition.
7. On December 27, 2012, Applicant filed a United States trademark application for the mark PACTAC.
8. The aforesaid trademark application was assigned United States Application Serial No. 85/810,871.
9. United States Application Serial No. 85/810,871 was approved for publication in association with “hydrocarbon resins; composite carbon epoxy resins,” in Class 1.

10. Applicant's PACTAC mark, in connection with the identified resins is confusingly similar to Opposer's PACTAN mark, as set forth and protected by Opposer's trademark registration.

11. Purchasers of Applicant's goods, and Opposer's goods, are likely to be confused, mistaken or deceived as to the source of the goods. Applicant's PACTAC mark, in Class 1, in association with the resin products identified in the trademark application, is likely to cause confusion, mistake or deception when compared to Opposer's PACTAN mark and the goods identified in Class 1 and Class 17 of the corresponding trademark registration.

12. The PACTAC and PACTAN marks are highly similar in sound and appearance such that when used on highly similar goods cause a likelihood of confusion, mistake or deception.

13. Applicant's use and registration of the PACTAC mark, in association with the goods specified in the trademark application, will cause confusion in the trade resulting in damage and injury to Opposer.

14. The Opposer's goods and the Applicant's goods are likely to be used in the same industries by the same consumers.

15. The conditions surrounding the marketing of the goods set forth in Registration No. 2,850,416 and the goods set forth in trademark application Serial No. 85/810,871 are such that they are likely to be encountered by the same purchasers under the same or similar circumstances that could give rise to the mistaken belief that the goods originate from a common source.

16. Applicant's goods bearing the PACTAC mark can be precursor components of the Registrant's goods designated in trademark Registration No. 2,850,416.

17. Upon information and belief, the PACTAN mark set forth in Registration No. 2,850,416 was applied for and used in the United States prior to any actual use or constructive use of the mark set forth in Application Serial No. 85/810,871.

18. Persons familiar with the Opposer's mark would be likely to confuse Applicant's goods as products made, sold, or sponsored by Opposer. Any such confusion in the trade would inevitably result in damage to the Opposer.

19. In addition to the harm identified in the preceding paragraphs, any defect, objection or fault found with Applicant's products marketed under the PACTAC mark would necessarily reflect badly upon and significantly injure the reputation which the Opposer has established for its goods.

20. Purchasers of these goods are likely to be confused or mistaken as to whether Applicant's products emanate from the Opposer or from a source connected with the Opposer.

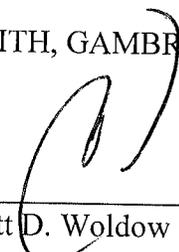
21. United States Patent and Trademark Office electronic database information showing the current status and title of United States Trademark Registration No. 2,850,416 is attached hereto as Exhibit A and is made part of the record.

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's mark, and prays that registration be denied.

Please charge Deposit Account No. 02-4300 for any additional fees that may be required.

Respectfully submitted,

SMITH, GAMBRELL & RUSSELL, LLP



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Scott D. Woldow

Attorney for Opposer

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Date: July 19<sup>th</sup>, 2013

# EXHIBIT A

**United States Patent and Trademark Office**

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**Trademarks > Trademark Electronic Search System (TESS)**

TESS was last updated on Thu Jul 18 03:12:28 EDT 2013

TESS HOME	NEW USER	STRUCTURED	FREE FORM	BROWSE DICT	SEARCH OG	BOTTOM	HELP	PREV LIST	CURR LIST
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 List At: \_\_\_\_\_ OR  to record: \_\_\_\_\_ **Record 1 out of 4**

TSDR	ASSIGN Status	TTAB Status
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*( Use the "Back" button of the Internet Browser to return to TESS)*
**Typed Drawing**

<b>Word Mark</b>	PACTAN
<b>Goods and Services</b>	IC 001. US 001 005 006 010 026 046. G & S: Adhesives for general industrial use. FIRST USE: 19900000. FIRST USE IN COMMERCE: 19970500  IC 017. US 001 005 012 013 035 050. G & S: Adhesive sealant and adhesive caulking compound for general use. FIRST USE: 19900000. FIRST USE IN COMMERCE: 19970500
<b>Mark Drawing Code</b>	(1) TYPED DRAWING
<b>Serial Number</b>	76494739
<b>Filing Date</b>	February 20, 2003
<b>Current Basis</b>	1A;44E
<b>Original Filing Basis</b>	1A;44E
<b>Published for Opposition</b>	March 16, 2004
<b>Registration Number</b>	2850416
<b>Registration Date</b>	June 8, 2004
<b>Owner</b>	(REGISTRANT) HeidelbergCement AG CORPORATION FED REP GERMANY Berliner Strasse 6 69120 Heidelberg FED REP GERMANY  (LAST LISTED OWNER) TREMCO ILLBRUCK PRODUKTION GMBH LIMITED LIABILITY COMPANY FED REP GERMANY WERNER-HAEPF-STRASSE 1 BODENWOEHR FED REP GERMANY D92439
<b>Assignment Recorded</b>	ASSIGNMENT RECORDED
<b>Attorney of Record</b>	Scott D. Woldow

Type of Mark      TRADEMARK  
Register            PRINCIPAL  
Affidavit Text     SECT 8 (6-YR).  
Live/Dead  
Indicator           LIVE

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## Current Owner(s) Information

**Owner Name:** TREMCO ILLBRUCK PRODUKTION GMBH  
**Owner Address:** WERNER-HAEPP-STRASSE 1  
BODENWOEHR D92439  
GERMANY  
**Legal Entity Type:** LIMITED LIABILITY COMPANY  
**State or Country Where Organized:** GERMANY

## Attorney/Correspondence Information

### Attorney of Record

**Attorney Name:** Scott D. Woldow  
**Attorney Primary Email Address:** [sdwoldow@sgrlaw.com](mailto:sdwoldow@sgrlaw.com)  
**Docket Number:** TBD  
**Attorney Email Authorized:** No

### Correspondent

**Correspondent Name/Address:** Scott D. Woldow  
SMITH, GAMBRELL & RUSSELL, LLP  
1055 Thomas Jefferson St., NW  
Suite 400  
WASHINGTON, DISTRICT OF COLUMBIA 20007  
UNITED STATES  
**Phone:** 202-973-2612  
**Fax:** 202-263-4312  
**Correspondent e-mail:** [sdwoldow@sgrlaw.com](mailto:sdwoldow@sgrlaw.com) [docketing@sgrlaw.com](mailto:docketing@sgrlaw.com)  
**Correspondent e-mail Authorized:** Yes

### Domestic Representative

**Domestic Representative Name:** Scott D. Woldow  
**Phone:** 202-263-4300  
**Fax:** 202-263-4329  
**Domestic Representative e-mail:** [sdwoldow@sgrlaw.com](mailto:sdwoldow@sgrlaw.com)  
**Domestic Representative e-mail Authorized:** No

## Prosecution History

Date	Description	Proceeding Number
May 30, 2013	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Jun. 09, 2010	REGISTERED - SEC. 8 (6-YR) ACCEPTED	71378
Jun. 09, 2010	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	71378
Jun. 09, 2010	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Jun. 07, 2010	TEAS SECTION 8 RECEIVED	
Jan. 10, 2007	ATTORNEY REVOKED AND/OR APPOINTED	
Jan. 10, 2007	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Jun. 08, 2004	REGISTERED-PRINCIPAL REGISTER	
Mar. 16, 2004	PUBLISHED FOR OPPOSITION	
Feb. 25, 2004	NOTICE OF PUBLICATION	
Dec. 08, 2003	APPROVED FOR PUB - PRINCIPAL REGISTER	
Nov. 05, 2003	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Nov. 05, 2003	PAPER RECEIVED	
Jul. 24, 2003	UNRESPONSIVE/DUPLICATE PAPER RECEIVED	
Aug. 20, 2003	CASE FILE IN TICRS	
Jul. 24, 2003	PAPER RECEIVED	
Jul. 30, 2003	NON-FINAL ACTION MAILED	
Jul. 29, 2003	ASSIGNED TO EXAMINER	59228
Apr. 09, 2003	PAPER RECEIVED	

## Maintenance Filings or Post Registration Information

**Affidavit of Continued Use:** Section 8 - Accepted

## TM Staff and Location Information

TM Staff Information - None  
File Location

Current Location: TMO LAW OFFICE 110

Date in Location: Jun. 09, 2010

### Assignment Abstract Of Title Information

#### Summary

Total Assignments: 3

Registrant: HeidelbergCement AG

#### Assignment 1 of 3

Conveyance: ASSIGNS THE ENTIRE INTEREST

Reel/Frame: 3052/0684

Pages: 7

Date Recorded: Mar. 24, 2005

Supporting Documents: [assignment-tm-3052-0684.pdf](#)

#### Assignor

Name: HEIDELBERGCEMENT AG

Execution Date: Mar. 09, 2004

Legal Entity Type: CORPORATION

State or Country Where Organized: GERMANY

#### Assignee

Name: COMPAKT TECHNOLOGY GMBH

Legal Entity Type: CORPORATION

State or Country Where Organized: GERMANY

Address: GRUNSTRASSE 5  
40212  
DUSSELDORF, GERMANY HRB 49374

#### Correspondent

Correspondent Name: NORM J. RICH

Correspondent Address: 3000 K STREET NW  
SUITE 500  
WASHINGTON, DC 20007-5143

#### Domestic Representative - Not Found

#### Assignment 2 of 3

Conveyance: CHANGE OF NAME

Reel/Frame: 3052/0738

Pages: 3

Date Recorded: Mar. 24, 2005

Supporting Documents: [assignment-tm-3052-0738.pdf](#)

#### Assignor

Name: COMPAKT TECHNOLOGY GMBH

Execution Date: Apr. 14, 2004

Legal Entity Type: CORPORATION

State or Country Where Organized: GERMANY

#### Assignee

Name: COMPACT TECHNOLOGY GMBH

Legal Entity Type: CORPORATION

State or Country Where Organized: GERMANY

Address: TRAUNRING 65  
TRAUNREUT, GERMANY D-83301

#### Correspondent

Correspondent Name: NORM J. RICH

Correspondent Address: 3000 K STREET NW  
SUITE 500  
WASHINGTON, DC 20007-5143

#### Domestic Representative - Not Found

#### Assignment 3 of 3

Conveyance: MERGER EFFECTIVE 02182010

Reel/Frame: 4218/0018

Pages: 8

Date Recorded: Jun. 04, 2010

Supporting Documents: [assignment-tm-4218-0018.pdf](#)

#### Assignor

Name: COMPACT TECHNOLOGY GMBH

Execution Date: Feb. 18, 2010

Legal Entity Type: CORPORATION

State or Country Where Organized: GERMANY

**Assignee**

Name: TREMCO ILLBRUCK PRODUKTION GMBH

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: GERMANY

Address: WERNER-HAEPF-STRASSE 1  
BODENWOEHR, GERMANY 92439

**Correspondent**

Correspondent Name: SCOTT D. WOLDOW

Correspondent Address: 1130 CONNECTICUT AVENUE, NW  
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WASHINGTON, DC 20036

**Domestic Representative**

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# EXHIBIT A

