

ESTTA Tracking number: **ESTTA566659**

Filing date: **10/23/2013**

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	E. I. DU PONT DE NEMOURS AND COMPANY
Granted to Date of previous extension	10/23/2013
Address	1007 MARKET STREET WILMINGTON, DE 19898 UNITED STATES
Attorney information	WILLIAM H. BREWSTER KILPATRICK TOWNSEND & STOCKTON 1100 PEACHTREE ST., STE 2800 ATLANTA, GA 30309 UNITED STATES bbrewster@ktslaw.com, japratt@ktslaw.com, kteilhaber@ktslaw.com, tadmin@ktslaw.com

Applicant Information

Application No	79125101	Publication date	06/25/2013
Opposition Filing Date	10/23/2013	Opposition Period Ends	10/23/2013
International Registration No.	1147412	International Registration Date	12/18/2012
Applicant	Zhejiang Fluorine Chemical,; New Material Co., Ltd. No. 5, Weiyi Road Hangzhou Gulf shangyu, Industrial Zone Zhejiang, CHINA		

Goods/Services Affected by Opposition

Class 001. All goods and services in the class are opposed, namely: Stain-preventing chemicals for use on fabrics; refrigerants, namely, refrigerant gas for use in industrial cooling systems; plastics, unprocessed; artificial resins, unprocessed; fire extinguishing compositions; fireproofing preparations; leather-dressing chemicals, namely, tanning agents for use in the manufacture of leather; adhesives for industrial purposes

Grounds for Opposition

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.	418698	Application Date	02/10/1945
Registration Date	01/08/1946	Foreign Priority Date	NONE
Word Mark	TEFLON		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U001 (International Class 017). First use: First Use: 1944/10/09 First Use In Commerce: 1944/10/09 SYNTHETIC RESINOUS FLUORINE-CONTAINING POLYMERS IN THE FORM OF MOLDING AND EXTRUDING COMPOSITIONS, FABRICATED SHAPES- NAMELY, SHEETS, [RODS] TUBES, TAPE AND FILAMENTS [-SOLUTIONS,] AND EMULSIONS		

U.S. Registration No.	559331	Application Date	03/09/1951
Registration Date	05/27/1952	Foreign Priority Date	NONE
Word Mark	TEFLON		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U016 (International Class 002). First use: First Use: 1948/01/30 First Use In Commerce: 1948/01/30 POLYTETRAFLUOROETHYLENE COATINGS IN THE NATURE OF PAINTS AND VARNISHES		

U.S. Registration No.	623605	Application Date	07/02/1954
Registration Date	03/20/1956	Foreign Priority Date	NONE
Word Mark	TEFLON		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U043 (International Class 023). First use: First Use: 1953/10/02 First Use In Commerce: 1953/10/02 FIBERS AND FILAMENTS IN THE NATURE OF THREADS AND YARNS ADAPTED TO BE USED IN MAKING FABRICS		

U.S. Registration No.	676166	Application Date	04/18/1958
Registration Date	03/31/1959	Foreign Priority Date	NONE
Word Mark	TEFLON		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U001 (International Class 001). First use: First Use: 1958/03/14 First Use In Commerce: 1958/03/14		

	FILMS OR SHEETS MADE FROM POLYMERS OF FLUORINATED HYDROCARBONS FOR USE IN PACKAGING APPLICATIONS, IN ELECTRICAL AND NON-ELECTRICAL INSULATION, AS PROTECTIVE LINERS FOR CONTAINERS AND EQUIPMENT, IN TAPES, IN MACHINERY PARTS, IN COVERING, COATING, AND PACKING SUBSTANCES, IN HOSE AND PIPING, AND FOR GENERAL USE IN THE INDUSTRIAL ARTS		
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U.S. Registration No.	827105	Application Date	11/02/1966
Registration Date	04/11/1967	Foreign Priority Date	NONE
Word Mark	TEFLON		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U016 (International Class 002). First use: First Use: 1965/05/27 First Use In Commerce: 1965/05/27 COATINGS IN THE NATURE OF PAINT, BASED ON FLUORINE-CONTAINING RESINS		

U.S. Registration No.	1111147	Application Date	06/15/1978
Registration Date	01/16/1979	Foreign Priority Date	NONE
Word Mark	TEFLON		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 001. First use: First Use: 1978/04/05 First Use In Commerce: 1978/04/05 CHEMICAL COMPOUND IN THE NATURE OF A TEXTILE FINISH WITH OIL, WATER, AND STAIN REPELLENT CHARACTERISTICS		

U.S. Registration No.	1592650	Application Date	07/31/1989
Registration Date	04/24/1990	Foreign Priority Date	NONE
Word Mark	TEFLON		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 001. First use: First Use: 1989/06/28 First Use In Commerce: 1989/06/28 FLUORINE-CONTAINING POLYMERS IN RESIN AND DISPERSION FORM FOR USE AS ADDITIVES IN INKS, PLASTICS, LUBRICANTS, COATING, AND OTHER HOST MATERIALS WHERE ATTRIBUTES SUCH AS LUBRICITY, FRICTION REDUCTION, NONSTICK, AND TEMPERATURE AND CHEMICAL RESISTANCE ARE DESIRED		

U.S. Registration No.	2601355	Application Date	11/19/1997
Registration Date	07/30/2002	Foreign Priority Date	NONE
Word Mark	TEFLON		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 012. First use: First Use: 2002/02/18 First Use In Commerce: 2002/02/18 Windshield wiper blades

U.S. Registration No.	3206677	Application Date	09/07/2004
Registration Date	02/06/2007	Foreign Priority Date	NONE
Word Mark	TEFLON		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 2003/12/31 First Use In Commerce: 2003/12/31 CLEANING PREPARATIONS, SHAMPOOS, WAX AND POLISH FOR AUTOMOBILES		

U.S. Registration No.	3590266	Application Date	04/18/2008
Registration Date	03/17/2009	Foreign Priority Date	NONE
Word Mark	TEFLON		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 004. First use: First Use: 2004/02/01 First Use In Commerce: 2004/02/01 INDUSTRIAL LUBRICANTS, GREASES, AND OILS		

Attachments	2013.10.23 Notice of Opposition (DuPont).pdf(119433 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	/William H. Brewster/
Name	WILLIAM H. BREWSTER
Date	10/23/2013

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

E.I. DU PONT DE NEMOURS AND COMPANY, a Delaware corporation)	
)	
Opposer,)	In the matter of Application
)	Serial No. 79/125,101
v.)	Mark: ZHEFLON (Stylized/Design)
)	
)	Opposition No. _____
ZHEJIANG FLUORINE CHEMICAL, NEW MATERIAL CO., LTD., a China limited company)	
)	
Applicant.)	

NOTICE OF OPPOSITION

E.I. du Pont de Nemours and Company (“Opposer” or “DuPont”), a Delaware corporation with corporate headquarters at 1007 Market Street, Wilmington, Delaware 19898, believes that it will be damaged by the issuance of a federal trademark registration for the mark ZHEFLON (Stylized/Design) (Serial No. 79/125,101) for “[s]tain-preventing chemicals for use on fabrics; refrigerants, namely, refrigerant gas for use in industrial cooling systems; plastics, unprocessed; artificial resins, unprocessed; fire extinguishing compositions; fireproofing preparations; leather-dressing chemicals, namely, tanning agents for use in the manufacture of leather; adhesives for industrial purposes” in International Class 1, and opposes the same.

As grounds for its opposition, DuPont alleges as follows, with knowledge concerning its own acts, and on information and belief as to all other matters:

1. DuPont has used the TEFLON[®] trademark since at least as early as 1944, and is the owner of at least ten registrations on the Principal Register for trademarks comprised of or incorporating the TEFLON[®] mark, including the following:

TRADEMARK	REG. NO.	REG. DATE	GOODS/SERVICES
TEFLON	418,698	January 8, 1946	Class 17: Synthetic resinous fluorine-containing polymers in the form of molding and extruding compositions, fabricated shapes – namely, sheets, tubes, tape and filaments, and emulsions
TEFLON	559,331	May 27, 1952	Class 2: Polytetrafluoroethylene coatings in the nature of paints and varnishes
TEFLON	623,605	March 20, 1956	Class 23: Fibers and filaments in the nature of threads and yarns adapted to be used in making fabrics
TEFLON	676,166	March 31, 1959	Class 1: Films or sheets made from polymers of fluorinated hydrocarbons for use in packaging applications, in electrical and non-electrical insulation, as protective liners for containers and equipment, in tapes, in machinery parts, in covering, coating, and packing substances, in hose and piping, and for general use in the industrial arts
TEFLON	827,105	April 11, 1967	Class 2: Coatings in the nature of paint, based on fluorine-containing resins
TEFLON	1,111,147	January 16, 1979	Class 1: Chemical compound in the nature of a textile finish with oil, water, and stain repellent characteristics
TEFLON	1,592,650	April 24, 1990	Class 1: Fluorine-containing polymers in resin and dispersion form for use as additives in inks, plastics, lubricants, coating, and other host materials where attributes such as lubricity, friction reduction, nonstick, and temperature and chemical resistance are desired
TEFLON	2,601,355	July 30, 2002	Class 12: Windshield wiper blades
TEFLON	3,206,677	February 6, 2007	Class 3: Cleaning preparations, shampoos, wax and polish for automobiles
TEFLON	3,590,266	March 17, 2009	Class 4: Industrial lubricants, greases, and oils

2. The ten above-identified registrations are valid and in full force and effect. All of the registrations issued before Applicant filed the application that is the subject of this Notice of Opposition, before the issuance of the International Registration on which the subject Application is based, and before any other priority date of Applicant.

3. Pursuant to Sections 8 and 15 of the Lanham Act, nine of the ten registrations listed above are incontestable, including the following: Registration Nos. 418,698; 559,331; 623,605; 676,166; 827,105; 1,111,147; 1,592,650; 2,601,355; and 3,206,677.

4. DuPont is internationally known for the development, manufacture, sale, and distribution of innovative products and ingredients. In the late 1930's, DuPont discovered a method to polymerize tetrafluoroethylene to form a fluoropolymer compound known as polytetrafluoroethylene ("PTFE"). PTFE is both slippery and chemically inert making it ideal for use in a wide variety of different products.

5. In approximately 1944, DuPont coined the fanciful trademark TEFLON[®] for use in connection with PTFE and products containing PTFE.

6. The TEFLON[®] mark is used in connection with industrial additives, coatings, films and resins. The versatility of TEFLON[®] allows for almost unlimited application, including with a wide variety goods.

7. The TEFLON[®] mark has been used by DuPont in connection with a wide array of products containing other fluorine-based polymer derivatives that prevent sticking or provide other properties, such as insulation, heat and chemical resistance, friction reduction, and providing anti-corrosive, anti-stain or water repellency attributes. The products sold using the TEFLON[®] mark range from apparel to wiper blades, and include not only cookware and bakeware, but also home and garden products (including exterior and interior paint, and surface protector offerings for the protection of tile, glass, and stone); composite parts for electric and electronics equipment; insulation for wire, cable, tubing, hoses, and gaskets for multiple industries; fabric protectors for home textiles and bedding; greases, lubricants, and oils; friction-resistant sports and recreational equipment (including tennis rackets); medical devices and

equipment; light bulbs; ink; personal care products (i.e., hair straighteners, hair curlers, men's razors, and eyeglasses); building and construction materials (including the coating on the Statue of Liberty); and insulation and coatings in musical instruments and equipment (guitar strings, guitar picks, harmonicas, audio speakers, wire, cables, and lubricants for piano keys).

8. DuPont's TEFLON[®] fluoropolymer products have been a tremendous commercial success. Since 1944, DuPont has generated billions of dollars in revenue from the sale of TEFLON[®] products and the licensing of the TEFLON[®] mark.

9. DuPont and its licensees have spent tens of millions of dollars in advertising and promotion of the TEFLON[®] mark, and products sold under the TEFLON[®] mark.

10. Over the course of almost seventy years, the TEFLON[®] mark has achieved an extraordinary level of fame and consumer recognition as a source identifier for DuPont's fluoropolymers. The TEFLON[®] mark has come to identify high quality and dependable products originating exclusively from DuPont and its licensees.

11. DuPont's TEFLON[®] mark is famous under the Lanham Act, 15 U.S.C. § 1125 *et seq.*, because "it is widely recognized by the general consuming public as a designation of source of the goods or services of the mark's owners." Over 40 years ago, in *In re Miller*, 441 F.2d 689, 690 (C.C.P.A. 1971), the court referred to DuPont's goods as "well known under the trademark 'Teflon.'" DuPont's TEFLON[®] mark was famous long before Applicant filed the subject application for ZHEFLON (Stylized/Design) or obtained an International Registration.

12. Notwithstanding DuPont's prior rights, and after the TEFLON[®] mark became famous, on February 14, 2013, applicant Zhejiang Fluorine Chemical, New Material Co., Ltd. ("Applicant") filed Application Serial No. 79/125,101 to register the mark ZHEFLON (Stylized/Design) ("Applicant's Mark") for "[s]tain-preventing chemicals for use on fabrics;

refrigerants, namely, refrigerant gas for use in industrial cooling systems; plastics, unprocessed; artificial resins, unprocessed; fire extinguishing compositions; fireproofing preparations; leather-dressing chemicals, namely, tanning agents for use in the manufacture of leather; adhesives for industrial purposes” in International Class 1 (the “Opposed Goods”). The application for Applicant’s Mark is based on Section 66(a) of the Lanham Act and International Registration 1,147,412 dated December 18, 2012.

13. The application to register Applicant’s Mark was first published for opposition in the *Official Gazette* dated June 25, 2013. Opposer timely filed and was granted an extension of time to oppose this application and is allowed until October 23, 2013 to file a Notice of Opposition.

14. There is no issue as to priority. DuPont began using its TEFLON[®] mark in commerce at least as early as 1944, well prior to Applicant’s filing of an application.

15. On information and belief, Applicant has not used Applicant’s Mark in commerce.

16. “TEFLON” is a coined or invented term. DuPont owns ten registrations that consist of or include the TEFLON[®] mark. No other mark on the Principal Register includes “TEFLON.”

17. DuPont’s TEFLON[®] mark is both conceptually and commercially strong. In *E.I. DuPont de Nemours & Co. v. Yoshida Int’l, Inc.*, 383 F. Supp. 502, 522 (E.D.N.Y. 1975), the court found that the TEFLON[®] mark is “a strong trademark deserving of broad protection from infringement.”

18. Applicant’s Mark is highly similar to DuPont’s TEFLON[®] mark in appearance, sound, and commercial impression.

19. The Opposed Goods are identical, very similar, overlapping and/or related to the goods on which Opposer uses its mark.

20. Applicant's Mark so resembles DuPont's TEFLON[®] mark as to be likely to cause confusion, mistake and/or to deceive consumers concerning an affiliation, connection, association, or sponsorship with the source of goods and services sold under DuPont's TEFLON[®] mark, in violation of 15 U.S.C. § 1052(d), with consequent injury to DuPont and the public.

21. If Applicant is permitted to register the mark ZHEFLON (Stylized/Design) in connection with the Opposed Goods, the resulting likelihood of confusion would cause damage and injury to DuPont. Furthermore, any defect, objection, or fault found with the Opposed Goods and Services marketed under Applicant's Mark would reflect upon and injure the reputation that DuPont has established for its goods.

22. Registration of Applicant's ZHEFLON (Stylized/Design) mark is likely to cause dilution of the distinctiveness of DuPont's famous TEFLON[®] mark by eroding consumers' exclusive identification of DuPont's TEFLON[®] mark with DuPont, and otherwise lessening the capacity of DuPont's TEFLON[®] mark to identify and distinguish the goods of DuPont, in violation of Section 43(C)(1) of the Lanham Act, 15 U.S.C. § 1125(c)(1).

23. Applicant's Mark is likely to cause dilution by blurring of DuPont's famous TEFLON[®] mark based on a number of relevant considerations, including, without limitation:

- (a) There is a high degree of similarity between the parties' marks in appearance, sound, and commercial impression;
- (b) DuPont's TEFLON[®] mark is inherently distinctive and has also acquired distinctiveness due to extensive use and promotion;
- (c) DuPont has substantially and exclusively used DuPont's TEFLON[®] mark for decades;

(d) DuPont's TEFLON[®] mark is widely recognized by the general consuming public; and

(e) On information and belief, by seeking to register and use Applicant's Mark, Applicant intends to create an association with DuPont and DuPont's TEFLON[®] mark.

24. If a registration is granted for Applicant's Mark for the Opposed Goods, that registration would be a source of damage and injury to DuPont.

25. The fee in the amount of \$300.00 for an opposition in one class is filed with this Notice of Opposition.

26. The Commissioner is authorized to debit the deposit account of Kilpatrick Townsend & Stockton LLP (Deposit Account No. 20-1430) for any deficiency in the required amount.

WHEREFORE, Opposer requests that this opposition be sustained, and that the registration of Application Serial No. 79/125,101 be denied.

Dated: October 23, 2013

Respectfully submitted,

**KILPATRICK TOWNSEND &
STOCKTON LLP**

By: /William H. Brewster/
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*Attorneys for Opposer
E.I. du Pont de Nemours and Company*

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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)	Opposition No. _____
ZHEJIANG FLUORINE CHEMICAL, NEW MATERIAL CO., LTD., a China limited company)	
)	
Applicant.)	

CERTIFICATE OF TRANSMITTAL

I hereby certify that a true copy of the foregoing **NOTICE OF OPPOSITION** is being filed electronically with the TTAB via ESTTA on this day, October 23, 2013.

/Jessica A. Pratt/
Jessica A. Pratt

CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing **NOTICE OF OPPOSITION** has been served on Applicant by depositing said copy with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to:

John Alumit
ALUMIT IP
135 S Jackson St Ste. 200
Glendale, CA 91205

DATED: October 23, 2013

/Jessica A. Pratt/
Jessica A. Pratt