

ESTTA Tracking number: **ESTTA613616**

Filing date: **07/02/2014**

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	Matthews Resources, Inc.
Granted to Date of previous extension	07/02/2014
Address	3411 Silverside Road 204 Weldin Building Wilmington, DE 19810 UNITED STATES
Attorney information	Joseph C. Guagliardo/Trevor L. Bannister Pepper Hamilton LLP 500 Grant Street Suite 5000 Pittsburgh, PA 15219-2507 UNITED STATES docketingpgh@pepperlaw.com, bannistert@pepperlaw.com, guagliardoj@pepperlaw.com, burtnerj@pepperlaw.com Phone:412-454-5000

Applicant Information

Application No	85363491	Publication date	03/04/2014
Opposition Filing Date	07/02/2014	Opposition Period Ends	07/02/2014
Applicant	Aiken, Bret 1807 Carnegie Ave. Santa Ana, CA 92705 UNITED STATES		

Goods/Services Affected by Opposition

Class 002. First Use: 1998/03/26 First Use In Commerce: 2010/06/09 All goods and services in the class are opposed, namely: Hand-applied sealer coatings for hard surfaces, namely, glass, granite, stone, porcelain, stainless steel and painted surfaces, for use in homes, hospitals, hotels, commercial buildings, and transportation
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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.	1785090	Application Date	04/22/1991
Registration Date	08/03/1993	Foreign Priority Date	NONE
Word Mark	DIAMOND SHIELD		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 002. First use: First Use: 1991/03/01 First Use In Commerce: 1991/03/01 coatings in the nature of a protective finish for bronze cemetery memorial products

Attachments	matwnotopp.pdf(110290 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	/Joseph C. Guagliardo, PA Bar member/
Name	Joseph C. Guagliardo
Date	07/02/2014

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

MATTHEWS RESOURCES, INC.

Opposer,

v.

BRET AIKEN

Applicant.

Opposition No. _____

Mark: DIAMOND SEAL SYSTEMS
FOREVER BRILLIANT

Application Ser. No.: 85/363,491

Published in *Official Gazette*: March 04, 2014

Filed: July 5, 2011

NOTICE OF OPPOSITION

Honorable Commissioner for Trademarks
P. O. Box 1451
Alexandria, VA 22313-1451

In the matter of Trademark Application Serial No. 85/363,491 for the mark DIAMOND SEAL SYSTEMS FOREVER BRILLIANT, filed July 11, 2011 and published for opposition in the *Official Gazette* of March 4, 2014.

Matthews Resources, Inc., a Delaware corporation having a place of business at 204 Weldin Building, 3411 Silverside Road, Wilmington, DE 19810 (“Opposer”), believes that it will be damaged by the registration of the mark shown in the above-identified application for the goods in International Class 2 identified therein and hereby opposes the same. The grounds for opposition are as follows:

1. Bret Aiken (“Applicant”) seeks to register “DIAMOND SEAL SYSTEMS FOREVER BRILLIANT” as a trademark for use in connection with a “hand-applied sealer coatings for hard surfaces, namely, glass, granite, stone, porcelain, stainless steel and painted surfaces, for use in homes, hospitals, hotels, commercial buildings, and transportation,” in International Class 2, as evidenced by the publication of said mark in the *Official Gazette* on March 4, 2014.

2. The application which is the subject of this opposition was filed on July 11, 2011 on the basis of use in commerce. Applicant claims a date of first use of March 26, 1998 and a date of first use in commerce of June 9, 2010.

3. Opposer, through its affiliate, Matthews International Corporation, is and has been engaged in the sale of memorialization products and protective coatings and finishes therefor.

4. Since at least as early as March 1991, Opposer, through its affiliate Matthews International Corporation, has used DIAMOND SHIELD as a mark for protective coatings and finishes for memorialization products.

5. The nature and extent of Opposer’s business and its use of DIAMOND SHIELD generally can be seen at its website, <http://www.matthewsid.com/products/cast-plaques/finishes>.

6. Opposer has taken steps to protect its DIAMOND SHIELD mark, including obtaining U.S. Trademark Registration No. 1,785,090 for the mark DIAMOND SHIELD for “coatings in the nature of a protective finish for bronze cemetery memorial products” in International Class 2 (“the ‘090 Registration”). The ‘090 Registration was filed on

April 22, 1991 on the basis of Opposer's use of the mark in commerce and was registered on August 3, 1993 and is now incontestable.

7. Opposer's DIAMOND SHIELD mark is inherently distinctive as applied to Opposer's coatings and finishes for memorialization products and has acquired commercial strength and distinctiveness by virtue of significant, continuous, and substantially exclusive use in commerce and by virtue of the recognition of the mark by the relevant public.

8. By virtue of Opposer's continuous use in commerce of its DIAMOND SHIELD mark, and its use in connection with its goods, and the nature and extent of such use, such goods have become favorably known to the relevant trade and public under such mark and identify the goods of Opposer.

9. Opposer has made continuous use of its DIAMOND SHIELD mark since long prior to the earliest date of first use that Applicant could claim in support of the application herein opposed, namely June 9, 2010, so priority is not an issue.

10. In the application herein opposed, there are no restrictions on the types of products nor the particular types of hard surface materials that may be used with the hand-applied sealer coatings, so it is presumed that Applicant's proposed hand-applied sealer may be used for all types of products, including memorial products, and all types of hard surface materials, including bronze and other materials used in making memorial products.

11. In the application herein opposed, there are no restrictions on the trade channels, so it must be presumed that Applicant's proposed hand-applied sealer coatings will travel through all trade channels appropriate for goods of that type, including to purchasers of memorial products and/or protective coatings and finishes for memorial products including, without limitation, those used in homes, hospitals, and commercial buildings.

12. The “DIAMOND SEAL” element of Applicant’s mark is the most dominant portion of Applicant’s mark and, as such, creates a commercial impression separate and apart from the other elements of Applicant’s mark such that the hand-applied coatings in the application herein opposed will simply be referred to by consumers as “diamond seal.”

13. The dominant portion of Applicant’s mark, namely DIAMOND SEAL, is nearly identical to and creates the same commercial impression as Opposer’s DIAMOND SHIELD mark.

14. Applicant’s mark and the dominant portion thereof as applied to the hand-applied coatings in the application herein opposed so resembles Opposer’s DIAMOND SHIELD trademark as used in connection with Opposer’s own protective coatings, that it is likely to cause confusion, mistake, and/or deception as to the source of goods or services or sponsorship or affiliation with Opposer.

15. Applicant’s use of the mark “DIAMOND SEAL SYSTEMS FOREVER BRILLIANT” in connection with hand-applied sealer coatings is likely to cause confusion, or cause mistake, or will deceive the public into believing that said products emanate from Opposer and/or are manufactured by Opposer and/or are approved or endorsed by Opposer.

16. If Applicant is permitted to register “DIAMOND SEAL SYSTEMS FOREVER BRILLIANT” as a mark for the hand-applied sealer coatings identified in its application, confusion of the relevant trade and public is likely to result, which will damage and injure Opposer.

17. Any defect, objection to, or fault found with Applicant’s hand-applied sealer sold under the proposed “DIAMOND SEAL SYSTEMS FOREVER BRILLIANT” mark

would reflect on and injure the reputation that Opposer has established for its goods and business.

18. If Applicant is granted a registration for the mark herein opposed for the goods in International Class 2, it would obtain thereby at least a prima facie exclusive right to use the mark for such goods as identified in the registration. Such registration would be a source of damage and injury to Opposer.

19. The Registration of the mark “DIAMOND SEAL SYSTEMS FOREVER BRILLIANT” by Applicant on the Principal or Supplemental Register of the United States Patent and Trademark Office would be inconsistent with Opposer’s rights, including those under U.S. Trademark Registration No. 1,785,090, and would damage Oppose.

WHEREFORE, Opposer prays that registration of the mark of Application Serial No. 85/363,491 be refused and that this opposition be sustained.

Respectfully submitted,

Date: July 2, 2014

By: /Joseph C. Guagliardo/
Joseph C. Guagliardo
Trevor L. Bannister
Sean P. McConnell
PEPPER HAMILTON, LLP
3000 Two Logan Square
Eighteenth and Arch Streets
Philadelphia, PA 19103
T – 215.981.4000
F – 215.981.4750
bannistt@pepperlaw.com
guagliaj@pepperlaw.com
mconnells@pepperlaw.com

Attorneys for Opposer

CERTIFICATE OF SERVICE

I, Joseph C. Guagliardo, hereby certify that on July 2, 2014, a true and correct copy of the foregoing Notice of Opposition was served via U.S. First Class Mail, postage prepaid, upon the following:

Bret Aiken
1807 Carnegie Avenue
Santa Ana, California 92705

Applicant

/Joseph C. Guagliardo/
Joseph C. Guagliardo