

ESTTA Tracking number: **ESTTA634534**

Filing date: **10/22/2014**

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	Henkel Corporation
Granted to Date of previous extension	10/22/2014
Address	One Henkel Way Rocky Hill, CT 06067 UNITED STATES

Attorney information	Amy Span Wergeles Henkel Corporation One Henkel Way Law Department - Trademarks Rocky Hill, CT 06067 UNITED STATES amy.wergeles@henkel.com, lizette.sayah@henkel.com
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Applicant Information

Application No	86181133	Publication date	06/24/2014
Opposition Filing Date	10/22/2014	Opposition Period Ends	10/22/2014
Applicant	Atotech Deutschland GmbH Erasmusstrasse 20 Berlin, 10553 GERMANY		

Goods/Services Affected by Opposition

Class 001. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Chemical preparations for surface treatment of metals, non-conductive substrates and semiconductor substrates, particularly for electroplating; metal plating chemical baths; metal plating chemical preparations; tempering and soldering preparations
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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.	1122125	Application Date	06/08/1978
Registration Date	07/17/1979	Foreign Priority Date	NONE
Word Mark	TEROTEX		

Design Mark	TEROTEX
Description of Mark	NONE
Goods/Services	Class 002. First use: First Use: 1977/10/26 First Use In Commerce: 1977/12/05 COATINGS TO PREVENT RUST AND PROVIDE CHIP RESISTANCE ON METAL SURFACES

Attachments	73173495#TMSN.png(bytes) Notice of Opposition TELOTECH.pdf(420635 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	//Amy Span Wergeles//
Name	Amy Span Wergeles
Date	10/22/2014

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

In the Matter of United States Trademark Application:

Applicant: Atotech Deutschland GmbH

Serial No.: 86/181133

Filed: January 31, 2014

Mark: TELOTECH

Henkel AG & Co. KGaA,	:	
Opposer	:	
v.	:	Opposition No. _____
Atotech Deutschland GmbH	:	
Applicant	:	

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

NOTICE OF OPPOSITION

Henkel AG & Co. KGaA (Henkel), of Henkelstrasse 67, Düsseldorf 40589, Germany, believes that it will be damaged by registration of the mark shown in the above-referenced application, which was published in the Official Gazette of June 24, 2014, and hereby opposes issuance of the registration.

As grounds for opposition, Henkel alleges as follows:

1. Henkel and its wholly-owned subsidiary and related company, Henkel Corporation (hereinafter, "Opposer") have used the trademark TEROTEX in Commerce since at least as early

as December 5, 1977, in association with coatings to prevent rust and chipping on metal (“Opposer’s Goods”).

2. Since at least as early as December 5, 1977, Opposer has engaged in the manufacture, distribution and sale of a line of coatings for metal in commerce, in conjunction with the TEROTEX trademark, and the mark has been in continuous use by Opposer since that time.

3. Opposer is the owner of United States Trademark Registration No. 1,122,125, which issued on July 17, 1979 for the trademark TEROTEX for “coatings to prevent rust and provide chip resistance on metal surfaces” in International Class 002. The mark was first used in commerce on December 5, 1977. A copy of the TESS database record for this Registration, as well the Assignment record for the Registration, is attached hereto as Exhibit A.

4. This registration is valid and incontestable.

5. Opposer has invested considerable effort and resources in advertising and promoting its mark TEROTEX and the goods sold under the mark, with the result that the relevant purchasing public has come to know, rely upon, and recognize the goods of Opposer by that mark. Opposer has established valuable goodwill in its mark TEROTEX and the mark has become well known to the relevant purchasing public.

6. Upon information and belief, Applicant is a German corporation with an address of Erasmusstrasse 20, Berlin, Germany 10553.

7. On January 31, 2014, Applicant filed application Serial No. 86/181133 for the mark TELOTECH under Section 1(b) for “Chemical preparations for surface treatment of metals, non-conductive substrates and semiconductor substrates, particularly for electroplating; metal plating chemical baths; metal plating chemical preparations; tempering and soldering preparations” in International Class 001 (“Applicant’s Goods”).

8. Application Serial No. 86/181133 was published for opposition in the USPTO Official Gazette of June 24, 2014. Opposer obtained extensions of time to oppose this application to October 22, 2014.

9. There is no issue as to priority. Opposer has priority based on its use and registration of the mark TEROTEX in the United States. Opposer used and registered the mark TEROTEX long before the Applicant's application date.

10. Applicant's proposed trademark TELOTECH is visually and phonetically very similar to Opposer's mark TEROTEX, and creates a commercial impression which is very similar to Opposer's mark.

11. The goods identified in Applicant's application are identical and/or virtually identical to the goods with which Opposer's mark TEROTEX is used and for which it is registered, and Applicant's Goods may be offered for sale to the same customers and through the same channels of trade.

12. Applicant's proposed trademark TELOTECH so resembles Opposer's trademark TEROTEX as to be likely, when applied to Applicant's Goods, to cause confusion or to cause mistake or to deceive within the meaning of 15 U.S.C. §1052(d), in view of Opposer's prior use, ownership and registration of its trademark TEROTEX.

13. Registration should therefore be refused under 15 U.S.C. §1052(d).

14. Registration of Applicant's proposed mark on the Principal Register would be inconsistent with Opposer's rights under the aforementioned registrations, and its common-law rights, and would be damaging to Opposer.

WHEREFORE, Opposer prays that its opposition be sustained and that the registration sought by Applicant in be refused.

Respectfully submitted,

By: 

Amy Span Wergeles
Attorney for Opposer
Henkel A.G. & Co. KGaA

Dated: 10/22/14

EXHIBIT A



United States Patent and Trademark Office

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TEROTEX

Word Mark	TEROTEX
Goods and Services	IC 002. US 016. G & S: COATINGS TO PREVENT RUST AND PROVIDE CHIP RESISTANCE ON METAL SURFACES. FIRST USE: 19771026. FIRST USE IN COMMERCE: 19771205
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	73173495
Filing Date	June 8, 1978
Current Basis	1A
Original Filing Basis	1A
Registration Number	1122125
Registration Date	July 17, 1979
Owner	(REGISTRANT) W.R. GRACE & CO. CORPORATION CONNECTICUT 62 WHITTEMORE AVE. CAMBRIDGE MASSACHUSETTS 02140 (LAST LISTED OWNER) HENKEL AG & CO. KGAA PARTNERSHIP LIMITED BY SHARES FED REP GERMANY HENKELSTRASSE 67 DUESSELDORF FED REP GERMANY 40589
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	Amy Span Wergeles
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20090815.

Renewal 2ND RENEWAL 20090815
Live/Dead Indicator LIVE

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing Notice of Opposition was served on:

Barbara Z. Morrissey, Esq.
Frommer Lawrence & Haug LLP
745 5th Avenue
New York, NY 10151-0099
United States

by first class mail, postage prepaid, this 22nd day of October, 2014.



Lizette E. Sayah