

ESTTA Tracking number: **ESTTA674511**

Filing date: **05/27/2015**

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	United States Mineral Products Company (d/b/a Isolatek International)
Granted to Date of previous extension	05/27/2015
Address	41 Furnace Street Stanhope, NJ 07874 UNITED STATES
Attorney information	Todd A. Denys Porzio, Bromberg & Newman, P.C. 29 Thanet Road, Suite 201 Princeton, NJ 08540 UNITED STATES tadenys@pbnlaw.com

Applicant Information

Application No	86386431	Publication date	01/27/2015
Opposition Filing Date	05/27/2015	Opposition Period Ends	05/27/2015
Applicant	KreteTek Industries 1000 N West Street Wilmington, DE 19801 UNITED STATES		

Goods/Services Affected by Opposition

Class 002. First Use: 2013/08/20 First Use In Commerce: 2013/08/20 All goods and services in the class are opposed, namely: Concrete moisture barrier coating; Concrete sealers in the form of a coating; Penetrating sealer coatings for use on Concrete; Sealer coatings for use in Concrete

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.	3944517	Application Date	05/18/2007
Registration Date	04/12/2011	Foreign Priority Date	NONE
Word Mark	ISOLATEK		

Design Mark	<h1>ISOLATEK</h1>
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Description of Mark	NONE
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Goods/Services	<p>Class 001. First use: First Use: 2010/06/30 First Use In Commerce: 2010/06/30 ADHESIVES FOR USE IN SOUND AND HEAT INSULATION, CONDENSATION CONTROL AND FIRE PROTECTION IN THE CONSTRUCTION INDUSTRY; SPRAY APPLIED FIRE PROOFING CHEMICALS; ACCELERANTS FOR USE WITH CEMENTITIOUS SLURRIES</p> <p>Class 002. First use: First Use: 2010/04/30 First Use In Commerce: 2010/04/30 SEALER COATINGS, INTUMESCENT PAINTS, INTUMESCENT COATINGS AND COATINGS ALL USED FOR CONDENSATION CONTROL AND FIRE PROTECTION IN THE CONSTRUCTION INDUSTRY</p> <p>Class 017. First use: First Use: 2010/04/30 First Use In Commerce: 2010/04/30 FIRE RESISTIVE BOARD, SPRAY APPLIED MINERAL WOOL AND NON-MINERAL WOOL PRODUCTS FOR USE AS SOUND AND HEAT INSULATION, CONDENSATION CONTROL AND FIRE RESISTANCE; SPRAY APPLIED HIGH TEMPERATURE INDUSTRIAL INSULATION; SEALANTS FOR BUILDINGS FOR USE IN SOUND AND HEAT INSULATION, CONDENSATION CONTROL AND FIRE RESISTANCE IN THE CONSTRUCTION INDUSTRY; SEALER COATINGS, INTUMESCENT PAINTS, INTUMESCENT COATINGS AND COATINGS ALL USED AS INSULATION FOR SOUND AND HEAT IN THE CONSTRUCTION INDUSTRY</p>
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U.S. Registration No.	3944753	Application Date	08/13/2008
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Registration Date	04/12/2011	Foreign Priority Date	NONE
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Word Mark	IS LATEK
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Design Mark	
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Description of Mark	The mark consists of "ISOLATEK" in which a globe is used to depict the letter "O".
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Goods/Services	<p>Class 001. First use: First Use: 2010/06/30 First Use In Commerce: 2010/06/30 ADHESIVES FOR USE IN SOUND AND HEAT INSULATION, CONDENSATION CONTROL AND FIRE PROTECTION IN THE CONSTRUCTION INDUSTRY; SPRAY APPLIED FIRE PROOFING CHEMICALS; ACCELERANTS FOR USE WITH CEMENTITIOUS SLURRIES</p> <p>Class 002. First use: First Use: 2010/04/30 First Use In Commerce: 2010/04/30 SEALER COATINGS, INTUMESCENT PAINTS, INTUMESCENT COATINGS AND COATINGS ALL USED FOR CONDENSATION CONTROL AND FIRE PROTECTION IN THE CONSTRUCTION INDUSTRY</p>
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U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	Isolatek International trade name		
Goods/Services	ADHESIVES FOR USE IN SOUND AND HEAT INSULATION, CONDENSATION CONTROL AND FIRE PROTECTION IN THE CONSTRUCTION INDUSTRY; SPRAY APPLIED FIRE PROOFING CHEMICALS; ACCELERANTS FOR USE WITH CEMENTITIOUS SLURRIES; SEALER COATINGS, INTUMESCENT PAINTS, INTUMESCENT COATINGS AND COATINGS ALL USED FOR CONDENSATION CONTROL AND FIRE PROTECTION IN THE CONSTRUCTION INDUSTRY; FIRE RESISTIVE BOARD, SPRAY APPLIED MINERAL WOOL AND NON-MINERAL WOOL PRODUCTS FOR USE AS SOUND AND HEAT INSULATION, CONDENSATION CONTROL AND FIRE RESISTANCE; SPRAY APPLIED HIGH TEMPERATURE INDUSTRIAL INSULATION; SEALANTS FOR BUILDINGS FOR USE IN SOUND AND HEAT INSULATION, CONDENSATION CONTROL AND FIRE RESISTANCE IN THE CONSTRUCTION INDUSTRY; SEALER COATINGS, INTUMESCENT PAINTS, INTUMESCENT COATINGS AND COATINGS ALL USED AS INSULATION FOR SOUND AND HEAT IN THE CONSTRUCTION INDUSTRY		

Attachments	77184637#TMSN.png(bytes) 77546282#TMSN.png(bytes) Notice_of_Opposition.PDF(302590 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	/todd a denys/
Name	Todd A. Denys
Date	05/27/2015

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

United States Mineral Products Company]	Opposition No.:	_____
(d/b/a Isolatek International),]	Application No.:	86/386,431
]	Mark:	ISO-TEK
Opposer,]	Filed:	September 5, 2014
v.]	Published for Opposition:	January 27, 2015
]		
]		
KreteTek Industries]		
]		
Applicant.]		
]		

NOTICE OF OPPOSITION

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Opposer, United States Mineral Products Company (d/b/a Isolatek International), a corporation of Delaware, with a business address of 41 Furnace Street, Stanhope, New Jersey 07874 (hereinafter referred to as “Opposer”), believes that it will be damaged by the registration of the trademark ISO-TEK for “Concrete moisture barrier coating; Concrete sealers in the form of a coating; Penetrating sealer coatings for use on Concrete; Sealer coatings for use in Concrete” in International Class 2 as set forth in United States Trademark Application Serial No. 86/386,431, filed September 5, 2014, published January 27, 2015, and hereby opposes said application.

As grounds for this opposition, it is alleged that:

1. Prior to August 20, 2013, the alleged date of first use of the trademark ISO-TEK by KreteTek Industries (hereinafter "Applicant") as set forth in United States Trademark Application Serial No. 86/386,431, Opposer established rights in the following United States trademark registrations:

Registration No.	Trademark	Status	Goods
3944517	ISOLATEK	Registered	<p>adhesives for use in sound and heat insulation, condensation control and fire protection in the construction industry; spray applied fire proofing chemicals; accelerants for use with cementitious slurries (International Class 1)</p> <p>sealer coatings, intumescent paints, intumescent coatings and coatings all used for condensation control and fire protection in the construction industry (International Class 2)</p> <p>fire resistive board, spray applied mineral wool and non-mineral wool products for use as sound and heat insulation, condensation control and fire resistance; spray applied high temperature industrial insulation; sealants for buildings for use in sound and heat insulation, condensation control and fire resistance in the construction industry; sealer coatings, intumescent paints, intumescent coatings and coatings all used as insulation for sound and heat in the construction industry (International Class 17)</p>
3944753		Registered	<p>adhesives for use in sound and heat insulation, condensation control and fire protection in the construction industry; spray applied fire proofing chemicals; accelerants for use with cementitious slurries (International Class 1)</p>

			<p>sealer coatings, intumescent paints, intumescent coatings and coatings all used for condensation control and fire protection in the construction industry (International Class 2)</p> <p>fire resistive board, spray applied mineral wool and non-mineral wool products for use as sound and heat insulation, condensation control and fire resistance; spray applied high temperature industrial insulation; sealants for buildings for use in sound and heat insulation, condensation control and fire resistance in the construction industry; sealer coatings, intumescent paints, intumescent coatings and coatings all used as insulation for sound and heat in the construction industry (International Class 17)</p>
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2. Prior to August 20, 2013, the alleged date of first use of the trademark ISO-TEK by KreteTek Industries (hereinafter “Applicant”) as set forth in United States Trademark Application Serial No. 86/386,431, Opposer established rights in the trade name “Isolatek International.” *See* Exhibit A attached hereto.

3. Opposer’s rights in Opposer’s “Isolatek International” trade name were first registered on August 9, 1995. *See* Exhibit A attached hereto.

4. Opposer’s rights in Opposer’s ISOLATEK trademarks were first registered in the United States on April 12, 2011 with a priority date of May 18, 2007.

5. Opposer’s rights in Opposer’s “Isolatek International” trade name are valid and in full force and effect. *See* Exhibit A attached hereto.

6. The registrations for Opposer's ISOLATEK trademarks are valid and in full force and effect under United States trademark law..

7. Opposer has used Opposer's "Isolatek International" trade name with the goods outlined in the tables set forth above in United States commerce since at least as early as August, 1995.

8. Opposer has used Opposer's ISOLATEK trademarks with the goods outlined in the tables set forth above in United States commerce since at least as early as April 30, 2010.

9. Opposer's registered trademarks and registered trade name set forth above are hereby collectively referred to as "Opposer's ISOLATEK Marks."

10. Opposer is currently using Opposer's ISOLATEK Marks with the goods outlined in the tables set forth above in United States commerce.

11. Opposer has so used Opposer's Marks ISOLATEK Marks with the goods outlined in the tables set forth above in United States commerce such that the public has come to associate Opposer's ISOLATEK Marks with Opposer and as indicating that any product sold under a trademark incorporating "ISO" and "TEK" in the construction industry originates with Opposer. As a result, Opposer has created and is the owner of substantial goodwill in Opposer's ISOLATEK Marks.

12. In view of Opposer's registration and use of Opposer's ISOLATEK Marks, Opposer has built up substantial rights in Opposer's ISOLATEK Marks.

13. Applicant filed United States Trademark Application Serial No. 86/386,431 on September 5, 2014 seeking to register the mark ISO-TEK in connection with "Concrete moisture barrier coating; Concrete sealers in the form of a coating; Penetrating sealer coatings for use on Concrete; Sealer coatings for use in Concrete" in International Class 2¹.

14. United States Trademark Application Serial No. 86/386,431 was published in the *Official Gazette* on January 27, 2015.

15. Upon information and belief, Applicant allegedly first used the mark ISO-TEK with "Concrete moisture barrier coating; Concrete sealers in the form of a coating; Penetrating sealer coatings for use on Concrete; Sealer coatings for use in Concrete" in United States commerce on August 20, 2013.

16. The ISO-TEK trademark sought to be registered by Applicant is similar to Opposer's ISOLATEK Marks.

¹ Opposer notes that on May 14, 2015, KreteTek Industries filed a Post-Publication Amendment requesting that the identification of goods for United States Trademark Application Serial No. 86/386,431 be amended to read "Concrete moisture barrier coatings sold in bulk to sophisticated industrial and commercial customers which typically make their purchasing decisions in consultation with experts such as architects, engineers and materials scientists." For the sake of clarity, should that Post-Publication Amendment be granted, Opposer's allegations set forth herein remain unchanged.

17. Applicant's ISO-TEK trademark is confusingly and deceptively similar to Opposer's previously and duly registered and used in United States commerce Opposer's ISOLATEK Marks.

18. Applicant's ISO-TEK trademark has the appearance and commercial impression of being one of Opposer's ISOLATEK Marks or somehow affiliated with or sponsored by Opposer.

19. The goods identified in United States Trademark Application Serial No. 86/386,431 for the ISO-TEK trademark are so closely related to the goods offered by Opposer under Opposer's ISOLATEK Marks such that consumers are likely to believe that Applicant's goods originate with Opposer or vice versa.

20. Applicant has adopted a trademark so closely resembling Opposer's ISOLATEK Marks in connection with related goods that it would be viewed by any consumer as emanating from Opposer, either erroneously believing the ISO-TEK trademark to be an existing trademark of Opposer, or a new trademark of Opposer or that Applicant is somehow affiliated with or sponsored by Opposer.

21. Upon information and belief, Applicant's and Opposer's goods travel in common channels of trade.

22. Upon information and belief, the consumers for Applicant's goods are the same consumers of Opposer's goods.

23. Due to the confusing similarity between Applicant's ISO-TEK trademark and Opposer's ISOLATEK Marks, which were previously and duly registered and used in United States commerce, the related nature of the parties' goods as well as the overlapping of channels of trade and consumers who are likely to believe that Applicant's goods originate with Opposer or vice versa, the result will be a likelihood confusion in the marketplace and damage to Opposer. Moreover, registration of the ISO-TEK trademark by Applicant is likely to cause a belief by consumers that Applicant's goods are endorsed by, sponsored by or approved by Opposer, causing damage to Opposer.

24. Opposer will be further damaged by the registration of the ISO-TEK trademark by Applicant, because it will cause confusion and uncertainty in the industry and handicap and damage the legitimate present and future activities of Opposer, by placing Applicant in the position to raise doubts as to the rights of Opposer to use Opposer's ISOLATEK Marks in connection with its goods. As a result, Opposer will eventually be deprived of all distinctiveness in Opposer's ISOLATEK Marks since Applicant's use will blur Opposer's ISOLATEK Marks along with the goods identified with those marks, and the association with which said Opposer's ISOLATEK Marks have come to convey will be tarnished.

WHEREFORE, United States Mineral Products Company (d/b/a Isolatek International) requests that registration of United States Trademark Application Serial No. 86/386,431 be denied, and this opposition be sustained.

Respectfully Submitted,

United States Mineral Products Company
(d/b/a Isolatek International)

Dated: 05/27/2015

BY: /todd a denys/
Todd A. Denys, Esq.
Porzio Bromberg & Newman P.C.
29 Thanet Road, Suite 201
Princeton, New Jersey 08540-3674
Tel: (609) 924-8555
Fax: (609) 924-3036
tadenys@pbnlaw.com
Attorney for Opposer

CERTIFICATE OF FILING

I hereby certify that this Notice of Opposition (with Exhibit A) is being filed with the United States Patent and Trademark Office via the Trademark Trial and Appeal Board's Electronic System for Trademark Trials and Appeals [ESTTA] on-line filing process.

05/27/2015
(Date of Deposit)

/todd a denys/
(Signature)

05/27/2015
(Date of Signature)

EXHIBIT A

FILED

SEP 16 1998

ANA

REGISTRATION OF ALTERNATE NAME
(For Use by Domestic Profit and Foreign Corporations)
(Profit and Nonprofit Corporations)

James A. DiEugenio, Jr.
State Treasurer

Check Appropriate Statute:

Title 14A:2-2.1 (2) New Jersey Business Corporation Act

Title 15A:2-2-3 (b) New Jersey Nonprofit Corporation Act

Mail to: Secretary of State, CN-308, Trenton, NJ 08625

Pursuant to the provisions of the appropriate Statute, checked above, of the New Jersey Statutes, the undersigned corporation hereby applies for the registration of an Alternate Name in New Jersey for a period of five (5) years, and for that purpose submits the following application:

1. Name of Corporation: United States Mineral Products Company
2. Corporation Number: 0100636150
3. Set Forth state of Original Incorporation: Delaware
4. Date of Incorporation: June 30, 1995

Date of Authorization (Foreign): August 9, 1995

5. Alternate Name to be Used: Isolatek International
6. The Character or Nature of the Particular Business/Activity to be Conducted using the Alternate Name is: Manufacture and sale of spray-applied fire-resistive products

7. The Corporation Intends to Use the Alternate Name in this State. Yes

8. The Corporation has not previously used the Alternate Name in this State in violation of this Statute, or, if it has, the month and year in which it commenced such use is: August 1995

Signature: *Russell D. Smith*

Name:

(Print Above Name)

RUSSELL D. SMITH
VICE PRESIDENT OF OPERATIONS

Title:

(Must be Ch. of Bd. Pres. or Vice Pres.)

Date:

S 476813
J 909652
J 909654

0100636150

NEW JERSEY DEPARTMENT OF THE TREASURY
DIVISION OF REVENUE AND ENTERPRISE SERVICES

UNITED STATES MINERAL PRODUCTS COMPANY

0100636150

I, the Treasurer of the State of New Jersey, do hereby certify that the above-name did on 9th day of August, 2013 file and record in the department a Certificate of Renewal of Alternate Name.

1. BUSINESS NAME:

UNITED STATES MINERAL PRODUCTS COMPANY

2. BUSINESS ID.:

0100636150

3. ALTERNATE NAME:

ISOLATEK INTERNATIONAL

4. ALTERNATE NAME IS VALID UNTIL:

September 16, 2018

5. ACTIVITY TO BE CONDUCTED USING ALTERNATE NAME:

Business intend to use the name in New Jersey.



*IN TESTIMONY WHEREOF, I have
hereunto set my hand and affixed my
Official Seal at Trenton, this
9th day of August, 2013*

A handwritten signature in black ink, appearing to read "Andrew P. Sidamon-Eristoff".

Andrew P Sidamon-Eristoff
State Treasurer

Certification # 129229283

Verify this certificate at

https://www1.state.nj.us/TYTR_StandingCert/JSP/Verify_Cert.jsp

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and complete copy of the foregoing Notice of Opposition (with Exhibit A) was served, on this 27th day of May, 2015, via First Class Mail, postage prepaid, addressed as follows:

Timothy H. Hiebert
Samuels & Hiebert LLC
Two International Place, 23rd Floor
Boston, MASSACHUSETTS 02110-4104

Dated: 05/27/2015

BY: /todd a denys/
Todd A. Denys, Esq.
Porzio Bromberg & Newman P.C.
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Princeton, New Jersey 08540-3674
Tel: (609) 924-8555
Fax: (609) 924-3036
tadenys@pbnlaw.com
Attorney for Opposer