

ESTTA Tracking number: **ESTTA692145**

Filing date: **08/27/2015**

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	Clariant Corporation
Granted to Date of previous extension	08/29/2015
Address	1600 West Hill Street Louisville, KY 40210 UNITED STATES
Correspondence information	Sean M. Sullivan Lee Sullivan Shea & Smith LLP 224 N Desplaines St Ste 250 Chicago, IL 60661 UNITED STATES sullivan@ls3ip.com, smith@ls3ip.com Phone:312-754-9602

Applicant Information

Application No	86569259	Publication date	06/30/2015
Opposition Filing Date	08/27/2015	Opposition Period Ends	08/29/2015
Applicant	Multisorb Technologies, Inc. 325 Harlem Road Buffalo, NY 14224 UNITED STATES		

Goods/Services Affected by Opposition

Class 001. First Use: 1996/00/00 First Use In Commerce: 1996/00/00
All goods and services in the class are opposed, namely: Desiccants

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	1369682	Application Date	02/14/1985
Registration Date	11/12/1985	Foreign Priority Date	NONE
Word Mark	DESI PAK		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 001. First use: First Use: 1983/12/13 First Use In Commerce: 1983/12/13 PREPACKAGED DESICCANTS FOR USE IN CLOSED PACKAGES FOR MACHINE PARTS, ELECTRONICCOMPONENTS, SURGICAL INSTRUMENTS AND SUPPLIES, TOOLS, PHARMACEUTICALS, FOOD ANDFILM

Attachments	Notice of Opposition (FINAL 8.27.2015).pdf(96773 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	/Sean M. Sullivan/
Name	Sean M. Sullivan
Date	08/27/2015

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

CLARIANT CORPORATION)	
)	
)	
Opposer,)	Opposition No.
)	
v.)	Application Serial No. 86/569,259
)	
MULTISORB TECHNOLOGIES, INC.)	
)	
Applicant.)	
)	

NOTICE OF OPPOSITION

Opposer Clariant Corporation (“Clariant”), a New York corporation with a business address at 1600 West Hill Street, Louisville, Kentucky 40210, believes it will be damaged by registration of the mark DESIPAX shown in Application Serial No. 86/569,259, and hereby opposes the same pursuant to 15 U.S.C. § 1063. The grounds for opposition are as follows:

1. Upon information and belief, Applicant Multisorb Technologies, Inc. (“Applicant”) is a New York corporation with business address at 325 Harlem Road, Buffalo, New York 14224.
2. On March 19, 2015, Applicant filed Application Serial No. 86/569,259 for the mark DESIPAX (“Applicant’s DESIPAX Mark”) in International Class 001 for use in connection with “desiccants” (“Applicant’s Goods”).
3. Application Serial No. 86/569,259 was published in the Official Gazette on June 30, 2015, and the time within which to file a notice of opposition was set to expire on July 30, 2015. On July 27, 2015, Clariant filed, and was granted, a 30 Day Request for Extension of

Time to Oppose Application Serial No. 86/569,259. Thus, this Notice of Opposition is timely filed.

4. Clariant is the owner of U.S. Registration No. 1369682, which registered on November 12, 1985 for the mark DESI PAK (the “DESI PAK Mark”) in International Class 001 for use in connection with “prepackaged desiccants for use in closed packages for machine parts, electronic components, surgical instruments and supplies, tools, pharmaceuticals, food and film” (“Clariant’s Goods”). Clariant’s DESI PAK Mark is registered on the Principal Register.

5. Clariant’s DESI PAK Mark is incontestable under 15 U.S.C. § 1065. Consequently, the registration of Clariant’s DESI PAK Mark is conclusive evidence of the validity of the registered mark and of the registration of the mark, of Clariant’s ownership of the mark, and of Clariant’s exclusive right to use the registered mark in commerce under 15 U.S.C. §1115.

6. Clariant also has extensive common law rights in its DESI PAK Mark.

7. Since at least as early as December 13, 1983, Clariant, its predecessors, and their affiliated and related entities, and/or distributors, have continuously used, and continue to use, Clariant’s DESI PAK Mark in interstate commerce in the United States in connection with Clariant’s Goods.

8. In association with the use of its DESI PAK Mark in the United States, Clariant has invested significant amounts of money and resources in the marketing, promotion, and sale of prepackaged desiccants bearing Clariant’s DESI PAK Mark, and Clariant has had substantial sales of such products.

9. By virtue of, among other things, Clariant’s extensive use of, and investment in, its DESI PAK Mark in the United States in connection with Clariant’s Goods, Clariant’s DESI

PAK Mark has come to identify products originating exclusively from, or otherwise associated with, Clariant and are distinctive of Clariant's Goods.

10. Likewise, as a result of Clariant's extensive use of, and investment in, its DESI PAK Mark in the United States in connection with Clariant's Goods, Clariant has built up highly valuable goodwill in its DESI PAK Mark and such goodwill has become closely identified and associated with Clariant.

11. Clariant's extensive use of its DESI PAK Mark in the United States, its significant investment in the marketing, promotion, and sale of prepackaged desiccants bearing its DESI PAK Mark, and Clariant's substantial sales of prepackaged desiccants bearing its DESI PAK Mark, have made Clariant's DESI PAK Mark famous in the United States.

**COUNT I
LIKELIHOOD OF CONFUSION**

12. Clariant repeats and realleges each and every allegation stated in Paragraphs 1 through 11 above as if fully set forth herein.

13. Clariant first used its DESI PAK Mark in the United States before Application Serial No. 86/569,259 for Applicant's DESIPAX Mark was filed on March 19, 2015, and before Applicant's alleged first use date of 00/00/1996.

14. Clariant's Goods are reasonably encompassed within the scope of, and are closely related to, Applicant's Goods – they are both desiccants.

15. Clariant's Goods and Applicant's Goods also travel in the same channels of trade and are offered to similar types of consumers.

16. Applicant's DESIPAX Mark so resembles Clariant's DESI PAK Mark that it is likely to cause confusion, mistake, or deceive consumers regarding the source, sponsorship or affiliation of the parties' respective goods, and both Clariant and consumers would be injured by

the registration of Applicant's DESIPAX Mark.

17. Accordingly, Application Serial No. 86/569,259 for Applicant's DESIPAX Mark should be refused registration pursuant to 15 U.S.C. § 1052(d).

**COUNT II
LIKELIHOOD OF DILUTION**

18. Clariant repeats and realleges each and every allegation stated in Paragraphs 1 through 17 above as if fully set forth herein.

19. Clariant's DESI PAK Mark is famous in the United States.

20. Clariant's DESI PAK Mark became famous in the United States before Application Serial No. 86/569,259 for Applicant's DESIPAX Mark was filed on March 19, 2015, and before Applicant's alleged first use date of 00/00/1996.

21. Applicant's DESIPAX Mark so resembles Clariant's DESI PAK Mark that it is likely to impair the distinctiveness of Clariant's DESI PAK Mark.

22. Accordingly, Application Serial No. 86/569,259 for Applicant's DESIPAX Mark should be refused registration pursuant to 15 U.S.C. §§ 1063(a) and 1125(c), because it is likely to dilute the distinctiveness of Clariant's famous DESI PAK Mark.

WHEREFORE, Plaintiff requests that the Board SUSTAIN its opposition against Application Serial No. 86/569,259.

Date: August 27, 2015

Respectfully submitted,

/Sean M. Sullivan Reg. No. 40,191/

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Attorneys for Opposer Clariant Corporation

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing NOTICE OF OPPOSITION was served on the Attorney of Record for Application Serial No. 86/569,259 by mailing said copy on August 27, 2015, via First Class Mail, postage prepaid, to:

Rhett V. Barney
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Date: August 27, 2015

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