

ESTTA Tracking number: **ESTTA703568**

Filing date: **10/21/2015**

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	SONAX GmbH
Granted to Date of previous extension	11/04/2015
Address	MÃ¼nchener Strasse 75 Neuburg, 86633 GERMANY

Attorney information	Richard Lehv Fross Zelnick Lehrman & Zissu, P.C. 866 UN Plaza New York, NY 10017 UNITED STATES rlehv@fzlj.com, ehrlich-docket@fzlj.com Phone:2128135928
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Applicant Information

Application No	86475824	Publication date	07/07/2015
Opposition Filing Date	10/21/2015	Opposition Period Ends	11/04/2015
Applicant	SONAX (Beijing) International Trading Co., Ltd. 1007 Floor 9, Building 4, No. 53 Yard Beijing, CHINA		

Goods/Services Affected by Opposition

Class 017. First Use: 2014/11/01 First Use In Commerce: 2014/11/01 All goods and services in the class are opposed, namely: Tinted plastic film for use on windows,not for use on vehicles; Heat reflective plastic film to be applied to windows,not for use on vehicles; Thermoplastic and foamed plastic sections for use in the manufacture of windows, doors, facadeglazings, and partition walls for use as building materials for heat-insulatingapplications

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
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.	706463	Application Date	10/20/1959
Registration Date	11/01/1960	Foreign Priority	NONE

		Date	
Word Mark	SONAX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 0 First Use In Commerce: 0 Automobile Polishes		

U.S. Registration No.	3194299	Application Date	06/11/2004
Registration Date	01/02/2007	Foreign Priority Date	12/11/2003

Word Mark	SONAX		
Design Mark			

Description of Mark	NONE		
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Goods/Services	<p>Class 001. First use: First Use: 0 First Use In Commerce: 0 [Chemicals used in industry particularly additives for engine radiator liquids, namely, radiator additives to prevent rust;] antifreeze, namely, antifreezing compounds for cooling liquids and for water for windscreen washers; [leak sealant for cooling systems of motor vehicles; hydraulic brake fluids;] chemical additives for enhancing the performance of lubricating oils, greases, industrial oils and motor oils [; chemical motor oil additives; chemical additives for use with internal combustion engine fuels, particularly for gasoline and diesel fuel; chemical preservatives for use as corrosion inhibitors on automobile exhaust systems; chemical agents for impregnating, binding or coating of textiles, namely, impregnating agents for canopy tops, for tents and for garments]</p> <p>Class 004. First use: First Use: 0 First Use In Commerce: 0 Automotive lubricants [; industrial oils and greases, including oils for engines, gearings, compressors as well as hydraulic oils; contact oils and greases for improving the electrical contact between two conducting components; non-chemical additives for industrial oils as well as additives for fuels, in particular for petrol and diesel fuel; non-chemical additives for industrial grease, for industrial oils, for motor oils, for gear oils, for compressor oils and for hydraulic oils]</p>		
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U.S. Registration No.	3445334	Application Date	08/31/2004
Registration Date	06/10/2008	Foreign Priority Date	NONE

Word Mark	SONAX		
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Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 001. First use: First Use: 0 First Use In Commerce: 0 Antifreezes for radiators and for cleaning installations for motor car windscreens, de-icing compounds, namely, chemical preparations for melting snow and ice, window de-icing fluids, automobile lockde-icing fluids; impregnating materials, namely, waterproofing chemical compositions, stain repellents, and fabric protectants for motor car convertible tops, as well as for tents and clothing; waterproofing chemical composition preserving products for exhaust pipe parts</p> <p>Class 002. First use: First Use: 0 First Use In Commerce: 0 Protective agents for chrome, namely, coatings in the nature of a polishing paste to protect chrome parts from corrosion, rust preventatives in the nature of a coating and anti-corrosive preparations, namely, vehicle corrosion inhibiting preparations, protective agents for window surfaces and for vehicle bodies, namely, paint sealers, glass sealers, primers and clear coatings; protective coatings, namely, corrosion inhibitors and cavity sealers for use on rocker panels and for protection of vehicle body cavities</p> <p>Class 003. First use: First Use: 0 First Use In Commerce: 0 Automotive cleaning preparations, liquid products and pastes for cleaning and preserving lacquers, namely, automotive shampoo, vehicle polishes, automotive wax, silicon and wax removers, insect removing preparations; cleaning products for vehicle washing installations, namely, soaps and carnauba wax for applying to automobiles in automatic car washes; liquid and powdered substances for washing and pre-washing for steam jet apparatus and for high-pressure cleaning tools, namely, shampoos and soaps for washing automobiles, additives, namely, drying agent for promotion of water beading on vehicle finishes for use in commercial car washes; rust removing preparations for use in windscreen washing installations, tar removing products, namely, vehicle cleaning preparations for the removal of tar, cleaning products for plastic materials, namely, cleaners and sealers for use on rubber and plastic parts on automobile exteriors, cleaning solutions and emulsions for use on rubber and plastic parts in automobile interiors; glass cleaners for use on automobile windows, cleaning and care products for motors and engines, namely, degreasing and cleaning preparations for use on automobile engines and motors</p> <p>Class 021. First use: First Use: 0 First Use In Commerce: 0 Cleaning sponges for washing, cleaning sponges for removing insects; demisting rags, namely, cleaning wipes impregnated with a solution to prevent fogging on windows</p>

Attachments	79008138#TMSN.png(bytes) 79006240#TMSN.png(bytes) F1798383.PDF(284319 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	/Richard Lehv/
Name	Richard Lehv
Date	10/21/2015

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

Opposer's Ref: SONX USA TC 1505922

In the Matter of Application Serial No. 86475824
Mark: SONAX
Filed: December 9, 2014
Published in the *Official Gazette*: July 7, 2015

SONAX GmbH,

Opposer,

-against-

SONAX (Beijing) International Trading Co., Ltd,

Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

Opposer, SONAX GmbH, a limited liability company organized and existing under the laws of Germany, whose address is Münchener Strasse 75, 86633 Neuburg, Federal Republic of Germany, believes it will be damaged by the registration of the mark shown in Application Serial No. 86475824, and opposes that application under the provisions of 15 U.S.C. § 1063.

As grounds for its opposition, Opposer, by its attorneys, Fross Zelnick Lehrman & Zissu, P.C., alleges as follows:

FACTS COMMON TO ALL CLAIMS FOR RELIEF

1. Founded in Germany in 1950, SONAX GmbH (“Sonax”) is the leading manufacturer and seller of automotive cleaning and polishing products in Germany and one of the leading brands worldwide. The SONAX brand is sold in 100 countries around the world. In

the United States, SONAX products are sold in numerous retailers throughout the country and on the company's own website at www.sonaxusa.com.

2. Opposer is the owner of the trademark SONAX for automotive cleaning and polishing products and related products; it has used the SONAX mark in commerce since long prior to any date on which Applicant may rely.

3. Sonax products typically bear the following red SONAX logo:



4. Opposer has registered the SONAX mark and logo in the United States Patent and Trademark Office. Opposer is the owner of the following United States Registrations:

- a. No. 706,463, for SONAX, issued on November 1, 1960 for automotive polishes in International Class 4;
- b. No. 3,194,299, for SONAX, issued on January 2, 2007 for
 - i. antifreeze, namely, antifreezing compounds for cooling liquids and for water for windscreen washers; and chemical additives for enhancing the performance of lubricating oils, greases, industrial oils and motor oils in International Class 1, and
 - ii. automotive lubricants in International Class 4;
- c. No. 3,445,334, for the SONAX logo, issued on March 25, 2008, for
 - i. Antifreezes for radiators and for cleaning installations for motor car windscreens, de-icing compounds, namely, chemical preparations for melting snow and ice, window de-icing fluids, automobile lock de-icing fluids; impregnating materials, namely, waterproofing chemical compositions, stain repellents, and fabric protectants for motor car

convertible tops, as well as for tents and clothing; waterproofing chemical composition preserving products for exhaust pipe parts in International Class 1;

- ii. Protective agents for chrome, namely, coatings in the nature of a polishing paste to protect chrome parts from corrosion, rust preventatives in the nature of a coating and anti-corrosive preparations, namely, vehicle corrosion inhibiting preparations, protective agents for window surfaces and for vehicle bodies, namely, paint sealers, glass sealers, primers and clear coatings; protective coatings, namely, corrosion inhibitors and cavity sealers for use on rocker panels and for protection of vehicle body cavities in International Class 2;
- iii. Automotive cleaning preparations, liquid products and pastes for cleaning and preserving lacquers, namely, automotive shampoo, vehicle polishes, automotive wax, silicon and wax removers, insect removing preparations; cleaning products for vehicle washing installations, namely, soaps and carnauba wax for applying to automobiles in automatic car washes; liquid and powdered substances for washing and pre-washing for steam jet apparatus and for high-pressure cleaning tools, namely, shampoos and soaps for washing automobiles, additives, namely, drying agent for promotion of water beading on vehicle finishes for use in commercial car washes; rust removing preparations for use in windscreen washing installations, tar removing products, namely, vehicle cleaning preparations for the removal of tar, cleaning products for plastic materials, namely,

cleaners and sealers for use on rubber and plastic parts on automobile exteriors, cleaning solutions and emulsions for use on rubber and plastic parts in automobile interiors; glass cleaners for use on automobile windows, cleaning and care products for motors and engines, namely, degreasing and cleaning preparations for use on automobile engines and motors in International Class 3; and

- iv. Cleaning sponges for washing, cleaning sponges for removing insects; demisting rags, namely, cleaning wipes impregnated with a solution to prevent fogging on windows in International Class 21.

5. As a result of the foregoing, Opposer is the owner of statutory and common law rights in the SONAX mark and the SONAX logo, along with the trade name Sonax, in connection with, *inter alia*, automotive products in the United States.

6. As a result of the use by Opposer of the SONAX mark, the SONAX mark is famous and became famous in the United States long prior to the filing date of Applicant's trademark application.

7. Applicant, SONAX (Beijing) International Trading Co., Ltd, filed Application Serial No. 86475824 for the mark SONAX on December 9, 2014. Originally, the goods Applicant listed in the application were "Latex for industrial use; Non-metal sealing rings for use as connection seals; Rubber material for recapping tires; Tinted plastic film for use on windows; Heat reflective plastic film to be applied to windows; Radiant heat resistant film to be applied to automotive and marine parts; Rubber sleeves for protecting parts of machinery; Waterproof sealants; Soundproofing materials; Thermoplastic and foamed plastic sections for use in the manufacture of windows, doors, facade glazings, and partition walls for use as

building materials for heat-insulating applications” in International Class 17. The Examiner refused registration based on likelihood of confusion with Opposer’s mark, shown in Opposer’s Registrations. To overcome this objection, Applicant deleted certain goods and references to automotive uses. Then, on June 4, 2015, the Examiner issued an Examiner’s Amendment revising the identification of the goods further, so that, as published, it reads, “Tinted plastic film for use on windows, not for use on vehicles; Heat reflective plastic film to be applied to windows, not for use on vehicles; Thermoplastic and foamed plastic sections for use in the manufacture of windows, doors, facade glazings, and partition walls for use as building materials for heat-insulating applications.”

8. The mark in Application Serial No. 86475824 was published for opposition in the Trademark Official Gazette of July 7, 2015. Following publication, Opposer requested, and was granted, a ninety-day extension of time to oppose.

9. Applicant has a website, www.sonax-china.com. This website uses a logo that is virtually identical to Opposer’s famous SONAX logo:



10. In August, 2015, Opposer learned that Applicant had signed up as an exhibitor at the November 2015 Specialty Equipment Market Association (“SEMA”) automotive show in

Las Vegas, Nevada. Applicant registered as a “first time exhibitor” at the SEMA show, under the category “Restyling and Car Care Accessories,” the exact same category as Opposer.

11. Opposer also learned in August, 2015 that Applicant had changed its website, www.sonax-china.com, and is now offering on its website “Auto Film” (presumably some kind of plastic film to cover the glass or paint on the car). Here is a screenshot of the Applicant website showing an advertisement for “Auto Film”:



12. Obviously, if Applicant appears as an exhibitor at the SEMA show, offering “Auto Film” under the SONAX mark, using a red logo that is virtually identical to Opposer’s logo, this will cause massive confusion. Visitors to the show will believe that Opposer and Applicant are one and the same, or are German and Chinese branches of the same company, or are otherwise connected or affiliated, when that is not the case.

13. Accordingly, Opposer objected to the organizers of the SEMA show, and Opposer has been advised that Applicant will not be permitted to exhibit at the SEMA show.

14. Sonax has opposed various trademarks filed by SBI for the mark SONAX in China.

15. Applicant is aware of Opposer and is intentionally trying to copy Opposer's mark and products. Indeed, Applicant's name was originally USA Shounoukete Int'l. It changed the name to SONAX (Beijing) International Trading Co., Ltd. Its adoption of a logo that is virtually identical to Opposer's logo was not the result of an innocent coincidence. Nor was its decision to start selling auto products and to register as an exhibitor at the SEMA show.

16. Applicant's SONAX mark incorporates Opposer's SONAX mark in its entirety and is confusingly similar to Opposer's SONAX mark. The parties' marks create the identical commercial impression and are confusingly similar in meaning, appearance and sound.

17. Not only are the marks confusingly similar, but also the parties' goods are closely related. Applicant admits that it intends to use the mark SONAX on and in connection plastic film. This is closely related to Opposer's cleaning and polishing products, used on automobiles and sold under its SONAX name and mark, and in particular Opposer's "protective agents for window surfaces and for vehicle bodies, namely, paint sealers, glass sealers, primers and clear coatings." (See Registration No. 3,445,334, above.) Products used for cleaning, polishing and coating automotive windows are closely related to films used on automobile windows and could easily come from the same source, especially when sold under the exact same name, mark and logo. Although the Examiner's Amendment added the words "not for use on vehicles" to Applicant's identification of its goods, no such limitation appears on Applicant's website. On the contrary, Applicant's website and Applicant's intent to exhibit at the SEMA

show clearly demonstrate that it does offer products “for use on vehicles.” Moreover, consumers would not be aware of the exclusionary language in the application.

18. Applicant applied to register the mark SONAX with full knowledge of Opposer's rights to the well-known SONAX name, mark and logo, and with full knowledge of Opposer's existing federal trademark registrations for the SONAX mark. Further, under 15 U.S.C. § 1072, the registration of Opposer's mark constituted constructive notice of Opposer's claim of ownership of the mark SONAX.

19. Applicant's application and the presumption of exclusivity that would come from a registration to Applicant of the SONAX mark are inconsistent with the prior rights of Opposer in the well-known SONAX name, mark and logo, and the rights of Opposer flowing from its own federal trademark registrations.

COUNT I

20. Any use of the mark SONAX on or in connection with the goods identified in Application Serial No. 86475824 is likely to cause confusion or mistake or to deceive the public into the belief that the goods offered under the mark SONAX come from or are otherwise authorized or sponsored by, or connected or associated with, Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

COUNT II

21. The mark sought to be registered in Application Serial No. 86475824 consists of matter, namely the term SONAX, that may falsely suggest a connection with Opposer, in violation of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), in that (1) the mark is the same as Opposer's name; (2) the mark would be recognized as such, in that it points uniquely and unmistakably to Opposer; (3) the entity named in the mark, namely, Opposer, is not

connected with Applicant or Applicant's goods; and (4) the fame or reputation of Opposer is such that, when the mark is used with Applicant's goods, a connection with Opposer would be presumed.

COUNT III

22. Use of the mark Applicant seeks to register is likely to cause dilution of Opposer's famous and distinctive mark, in that the similarity of the marks is likely to create an association with Opposer's mark, impairing the distinctiveness of Opposer's mark, in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

23. By reason of the foregoing, Opposer will be damaged by the registration of the mark SONAX to Applicant.

WHEREFORE, Opposer respectfully requests that this opposition be sustained and that the registration of the mark in Application Serial No. 86475824 be denied.

Dated: New York, New York
October 21, 2015

Respectfully submitted,

FROSS ZELNICK LEHRMAN
& ZISSU, P.C.

By: /Richard Lehv/
Richard Lehv
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Attorneys for Opposer, SONAX GmbH

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing notice of opposition is being served on October 21, 2015, by first class mail, postage prepaid, on the attorney for applicant at the following address:

Alex Patel
Patel & Almeida, P.C.
16830 Ventura Boulevard, Suite 360
Encino, California 91436-1711

/Richard Lehv/
Richard Lehv
Attorney for Opposer