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EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85802574

MARK: REPEL A TEX ADVANCED MATTRESS



CORRESPONDENT ADDRESS:

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THE TRADEMARK COMPANY

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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Perry Textiles Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the examining attorney's final refusal to register the mark REPEL-A-TEX ADVANCED MATTRESS PROTECTION TECHNOLOGY WITH ODOR ELIMINATOR (with design), for the goods "Stain repellents for bedding," in International Class 1. The examining attorney has refused registration on the Principal Register because applicant's mark is confusingly similar with Registration

Number 0398382 for the mark REPEL-O-TEX (in standard character format) for the goods, "Preparation for Rendering Textiles, Fabrics, and Textile and Other Materials, Exclusive of Lithographic and Planographic Printing Plates and Other Lithographic and Planographic Materials, Water, Stain, and Perspiration Resistant," in International Class 1. 15 U.S.C. §1052(d); 37 C.F.R. §2.64(a).

Accordingly, it is respectfully requested that the refusal based on likelihood of confusion under Trademark Act Section 2(d) be affirmed.

I. FACTS

On December 17, 2012, Perry Textiles Inc., DBA Soft-Tex Manufacturing, filed U.S. Trademark Application Serial No. 85/802574, seeking registration of the proposed mark, REPEL-A-TEX ADVANCED MATTRESS PROTECTION TECHNOLOGY WITH ODOR ELIMINATOR (with design) for "Stain repellents for bedding," and provided a disclaimer of the terms ADVANCED MATTRESS PROTECTION TECHNOLOGY WITH ODOR ELIMINATOR. On March 30, 2013, the examining attorney issued an office action refusing registration of the mark under Trademark Act Section 2(d).

On September 30, 2013, applicant responded to the Office Action and presented arguments in an effort to overcome the refusal under Section 2(d) of the Trademark Act.

On October 22, 2013, the examining attorney made final the refusal under Section 2(d) of the Trademark Act.

On April 16, 2014, applicant filed a request for reconsideration of the final office action however, the request was denied the request on May 15, 2014 and the application was abandoned for failure to respond or for late response on December 11, 2014.

On January 2, 2015, applicant simultaneously petitioned to revive the application, its request for reconsideration and filed its Brief in support of Registration of Serial Number 85/802574.

On January 27, 2015, the petition was granted, and on February 24, 2015, the examining attorney denied the request for reconsideration.

II. THE MARKS OF APPLICANT AND REGISTRANT ARE HIGHLY SIMILAR IN DOMINANT PORTION AND THE GOODS ARE SIMILAR OR CLOSELY RELATED SUCH THAT THERE EXISTS A LIKELIHOOD OF CONFUSION, UNDER SECTION 2(d) OF THE TRADEMARK ACT

The Board should affirm the likelihood of confusion refusal because the marks are highly similar in part and the goods are closely related in nature and purpose. The Court in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973), listed the principal factors to be considered in determining whether there is a likelihood of confusion under Section 2(d) of the Trademark Act. Any one of the factors listed may be dominant in any given case, depending upon the evidence of record. In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods, and similarity of trade channels of the goods.

Any doubt as to the issue of likelihood of confusion must be resolved in favor of the registrant and against the applicant who has a legal duty to select a mark that is dissimilar to trademarks already being used. See *In re Hyper Shoppes (OHIO), Inc.*, 837 F.2d 463 (Fed. Cir. 1988).

A. The marks are similar because the dominant portion of the applicant's mark is highly similar to the registrant's mark and thus is confusingly similar.

The marks must be compared for similarities in sound, appearance, meaning, or connotation. *E.I. du Pont de Nemours*, 476 F.2d 1357. Similarity in any one of these elements is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755 (TTAB 1977). The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. Instead, the

issue is whether the marks create the same overall impression. *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). Thus, the primary focus is on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *Chemetron Corp. v. Morris Coupling and Clamp Co.*, 203 USPQ 537 (TTAB 1979). When an applicant's mark is compared to the registered mark, "the points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 40 (D.C. Cir.), *cert. denied*, 351 U.S. 973 (1956).

The applicant's mark is highly similar in dominant portion and highly similar in appearance, meaning, connotation and commercial impression to the registered mark. The applicant seeks to register the mark REPEL-A-TEX ADVANCED MATTRESS PROTECTION TECHNOLOGY WITH ODOR ELIMINATOR (with design). The registered mark is REPEL-O-TEX (RN 0398382) in standard character format.

A standard character or typed mark means that the mark may be displayed in any lettering style. 37 C.F.R. §2.52(a). The rights associated with a mark in typed or standard character form reside in the wording itself, and the applicant is free to adopt any style of lettering, including lettering identical to that used by the registrants. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991). The registrant's mark is in standard character format, and as such, the mark may be used in a variety of stylized ways in the marketplace. Even though applicant's mark contains additional design elements, and although marks must be compared in their entirety, the word portion generally may be the dominant and most significant feature of a mark because consumers will request the goods and/or services using the wording. See *In re Viterra Inc.*, 671 F.3d 1358, 1362, 1366, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012); *In re Davia*, 110 USPQ2d 1810, 1813 (TTAB 2014). For this reason, greater weight is often given to the word portion of marks when determining whether marks are confusingly similar. Joel Gott Wines,

LLC v. Rehoboth Von Gott, Inc., 107 USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)); TMEP §1207.01(c)(ii).

1. Applicant's Dominant Feature of the Mark and Registrant's Mark are Similar in Overall Impression and Meaning

The likelihood of confusion refusal should also be affirmed because the dominant portion of the marks are comprised of highly similar wording. The law is clear that marks may still be confusingly similar notwithstanding the addition, deletion or subtraction of letters or words. *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988). "It is not necessary for similarity to go only to the eye or the ear for there to be infringement. The use of a designation which causes confusion because it conveys the same idea, or stimulates the same mental reaction, or has the same meaning is enjoined on the same basis as where the similarity goes to the eye or the ear." *Standard Oil Co. v. Standard Oil Co.*, 116 USPQ 176, 182 (10th Cir. 1958). The dominant portion of applicant's mark and the registrant's mark are similar in appearance and sound because they are comprised in part of the same wording, specifically REPEL and TEX and have a similar construct, specifically, REPEL-A-TEX versus REPEL-O-TEX.

The commercial impression of the marks is also similar because the terms ADVANCED MATTRESS PROTECTION TECHNOLOGY WITH ODOR ELIMINATOR in applicant's mark are descriptive and do not distinguish the overall meaning of the mark. The term REPEL refers to the ability to "to drive or force back; hold or ward off." The term TEX is an abbreviation for the term TEXTILE which is defined as "having to do with weaving or with woven fabrics."¹ When used together, the terms REPEL and TEX give the impression that the goods possess the feature that allows it to repel, block, prevent, or minimize stains from adhering to textiles such as bedding. The terms REPEL and TEX are suggestive of the purpose of the goods. The additional wording in the applied-for mark "ADVANCED MATTRESS

¹ The Examining Attorney requests that the Board take judicial notice of the attached dictionary definitions for the words "repel" and "textile" from Collins' Online Dictionary. The Board may take judicial notice of dictionary definitions. TBMP §1208.04.

PROTECTION TECHNOLOGY WITH ODOR ELIMINATOR,” is not the dominant part of the mark because it is descriptive matter that merely informs the consumer of two specific features of the goods, that it contains specific technology designed to provide a high level of protection to mattresses, and to eliminate odors from mattresses and fabrics. Since ADVANCED MATTRESS PROTECTION TECHNOLOGY WITH ODOR ELIMINATOR is highly descriptive for the goods, and has been disclaimed as such the wording REPEL-A-TEX is the dominant portion of the mark.

Although the marks are compared in their entireties under a Section 2(d) analysis, one feature of a mark may be recognized as more significant in creating a commercial impression. It is well established that “in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties.” *In re National Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985). For instance, “[t]hat a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark.” *Id.* Accordingly, there is nothing improper in giving less weight to the highly descriptive and disclaimed terms ADVANCED MATTRESS PROTECTION TECHNOLOGY WITH ODOR ELIMINATOR and more weight to the term(s) REPEL-A-TEX as the dominant term in the applicant’s mark, when consideration is given to the similarity of the marks in their entireties.

For a composite mark containing both words and a design, the word portion may be more likely to be impressed upon a purchaser’s memory and to be used when requesting the goods and/or services. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin’s Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)); TMEP §1207.01(c)(ii); see *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708

F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir. 1983)). Thus, although such marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. *In re Viterro Inc.*, 671 F.3d at 1366, 101 USPQ2d at 1911 (Fed. Cir. 2012) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)). Although applicant's mark contains design elements in addition to the wording REPEL-A-TEX ADVANCED MATTRESS PROTECTION TECHNOLOGY WITH ODOR ELIMINATOR, the wording REPEL-A-TEX is featured in larger type-setting and contains three separate and distinct colors making it clearly the dominant feature of applicant's mark.

The dominant feature of the applicant's mark (REPEL-A-TEX) and registrant's mark (REPEL-O-TEX) are essentially phonetic equivalents and thus sound similar. Similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv). Slight differences in the sound of similar marks will not avoid a likelihood of confusion. *In re Energy Telecomm. & Elec. Ass'n*, 222 USPQ 350, 351 (TTAB 1983); see *In re Viterro Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012).

**2. The Dominant Portion of the Applicant's Mark Is the Wording REPEL-A-TEX
Rendering it Confusingly Similar in Appearance and Sound to the Registered Mark
REPEL-O-TEX**

In order to distinguish itself from the registered marks, the applied-for mark must also contain some other non-descriptive wording like the registered marks. See *In re Mighty Leaf Tea*, 601 F.3d 1342 (Fed. Cir. 2010); *In re Optica Int'l*, 196 USPQ 775, 778 (TTAB 1977). Aside from the highly descriptive terms ADVANCED MATTRESS PROTECTION TECHNOLOGY WITH ODOR ELIMINATOR, there is no other wording in the applied-for mark to distinguish it from the registered mark. See *In re Chatam Int'l Inc.*, 380 F.3d

1340, 1343 (Fed. Cir. 2004) (“Viewed in their entirety with non-dominant features appropriately discounted, the marks [GASPAR’S ALE for beer and ale and JOSE GASPAR GOLD for tequila] become nearly identical.”).

There is no correct pronunciation of a mark because it is impossible to predict how the public will pronounce a particular mark. See *Embarcadero Techs., Inc. v. RStudio, Inc.*, 105 USPQ2d 1825, 1835 (TTAB 2013) (quoting *In re Viterro Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012); *In re The Belgrade Shoe Co.*, 411 F.2d 1352, 1353, 162 USPQ 227, 227 (C.C.P.A. 1969)); TMEP §1207.01(b)(iv). The marks in question could clearly be pronounced the same; such similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv). It is likely that a consumer would pronounce the terms REPEL-A-TEX and REPEL-O-TEX the same.

3. Evidence of Dilution is Unpersuasive

Applicant has submitted printouts of third-party registrations for marks containing the wording TEX and TECH to support the argument that this wording is weak, diluted, or so widely used that it should not be afforded a broad scope of protection. The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks in use in the marketplace in connection with similar goods and/or services. See *Nat’l Cable Television Ass’n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973).

This argument and the supporting evidence are unpersuasive. Evidence of weakness or dilution consisting solely of third-party registrations, such as those submitted by applicant in this case, is generally entitled to little weight in determining the strength of a mark, because such registrations do

not establish that the registered marks identified therein are in actual use in the marketplace or that consumers are accustomed to seeing them. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009); *Richardson-Vicks Inc. v. Franklin Mint Corp.*, 216 USPQ 989, 992 (TTAB 1982). Because the applied-for mark contains highly similar wording as the registered mark but no other distinguishing wording, it does not create a distinct commercial impression from the registered mark. Accordingly, even though the dominant feature of the applied-for mark and the registered mark are not word-for-word copies of one another, they are confusingly similar.

B. The goods are closely related because they overlap due to their nature and purpose.

The likelihood of confusion refusal should also be affirmed because the goods are related. It is well settled that the issue of likelihood of confusion between marks must be determined on the basis of the goods as they are identified in the application and the registration. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Accordingly, without limitations or restrictions as to their channels of trade or classes of purchasers, the goods must be deemed to be promoted in the same channels of trade and directed to the same purchasers. *Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910 (TTAB 2000).

1. Applicant's and registrant's goods are closely related and serve the same purpose and function

Here, the applicant's "Stain repellents for bedding," are closely related to the registrant's "Preparation for Rendering Textiles, Fabrics, and Textile and Other Materials, Exclusive of Lithographic and Planographic Printing Plates and Other Lithographic and Planographic Materials, Water, Stain, and Perspiration Resistant." The applicant's use of the stain repellent on bedding are likely to be included in registrant's stain repellent preparations used on textiles. Both the applicant's and the registrant's goods

are virtually identical stain treatments for fabrics and textiles, which include bedding. Neither identification limits the channels of trade or class of purchasers of the identified goods. Thus, it is presumed that these goods travel in the same channels of trade and are available to the same consumers.

The final Office Action included online articles depicting single sources that provide stain repellent or stain resistant preparations for fabrics, such as apparel and home textiles. For example, the excerpt from BASF The Chemical Company demonstrates that they provide “Ecological and high performance fluorocarbon finishing systems,” for “apparel,” “home textiles,” and “bed linen.” (Please see page 4-6 from final office action dated October 22, 2013). The excerpt from The University of Missouri (p. 18-20) describes the treatment of cotton with the chemical Teflon®, also known as Polytetrafluoroethylene, used on a wide range of textiles such as denim and backpacks to render them stain-resistant.

The denial of the Request for Reconsideration included web page evidence from The Home Depot (p. 3-7), which depicts “protector spray,” used on various textiles such as carpet and fabrics, provided by a single source. This market evidence tends to show that stain repellents are used on a wide range of fabrics and textiles, including bedding, and are closely related goods.

2. Applicant’s Goods and Registrant’s Goods Overlap in Function

Applicant argues that “...the average purchaser or member of the respective goods offered under the cited mark would also exercise a high level of sophistication in choosing the cited mark’s goods as apart from the goods of the Applicant’s mark, therefore minimizing any likelihood of confusion.” (Please see p. 14 of Applicant’s Brief). This assertion is supported by an employee of the applicant, Mr. Robert O’Connell. However, the goods are relatively common goods, can be purchased through common entities, and specialized knowledge is not needed to purchase these goods. The fact

that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); see, e.g., *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d. 1317, 1325, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011).

Applicant has submitted new information regarding purported third-party usage of the applied-for mark (Please see page 12 of Applicant's Brief). The examining attorney objects to the submission of this evidence and asks the Board to reject it and the accompanying argument. This submission is untimely because the evidentiary record should be complete prior to the filing of an *ex parte* appeal to the Board. 37 C.F.R. §2.142(d). See TBMP §1207.01; *In re Trans Continental Records Inc.*, 62 USPQ2d 1541 (TTAB 2002). Even if it were determined this third-party usage is both a registered mark and confusing, it is no defense to register yet another confusingly similar mark. *AMF Inc. v. American Leisure Products, Inc.*, 177 USPQ 268, 269 (C.C.P.A. 1973).

The evidence of record shows that the goods are closely related because applicant's and registrant's goods are stain repellent preparations used on various textiles, such as bedding. Therefore, they serve the same purpose and function, namely, to provide the goods with protection and the ability to repel stains. Thus, because the goods perform essentially the same function and flow in similar channels of trade, the goods are legally related for purposes of supporting a finding of likelihood of confusion.

III. CONCLUSION

Because the marks are highly similar in dominant portion and the goods are closely related, consumers encountering the applicant's mark and the registered marks in the marketplace are likely to

mistakenly believe that the goods emanate from a common source. For the foregoing reasons, the refusal to register under Section 2(d) of the Trademark Act should, therefore, be affirmed.

Respectfully submitted,

/Anne C. Gustason/

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Word Frequency ●●●●●

repel (rɪˈpel ⓘ)

Definitions

transitive verb

Word forms: **re·pel·led**, **re·pel·ling**

1. to drive or force back; hold or ward off ⇒ *to repel an attack*
2. to refuse to accept, agree to, or submit to; reject ⇒ *to repel advances*
3. to refuse to accept (a person); spurn ⇒ *to repel a suitor*
4.
 - a. to cause distaste or dislike in; disgust ⇒ *the odor repelled him*
 - b. to cause (insects, etc.) to react by staying away
- 5.

zulily *shop for SUN!*

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The Language

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- b. to fail to mix with or adhere to ⇒ *water repels oil*
- intransitive verb**
6. to drive off, or offer an opposing force to, something
7. to cause distaste, dislike, or aversion

Derived Forms

re peller *noun*

► **Word Origin**

ME *repellen* < L *repellere*, to drive back < *re-*, back + *pellere*, to drive; see [pulse](#)!

► **Synonyms**

[View thesaurus entry](#)

= [disgust](#), gross out, [nauseate](#), [offend](#), [revolt](#), [sicken](#)

The Language

BY MURIEL FALKER
Gaynor

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How often do you use "LOL" when you are
talking?

- ☐ Every day
☐ Occasionally
☐ Never
☐ I don't know what this means

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► **Translations for 'repel'**

American English: [repel](#) When an army repels an attack, they successfully fight and drive back soldiers from another army who have attacked them. *repelled, repelling, repels* They have fifty thousand troops along the border ready to repel any attack.

Brazilian Portuguese: [repelir](#)

European Spanish: [repugnar](#)

German: [zurückschlagen](#)

Japanese: 撃退する

Portuguese: [repelir](#)

Chinese: 击退/擊退

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Spanish: [repugnar](#)

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Example Sentences Including 'repel'

As they moved to repel the assault from one front, Erik and his ten men raced into

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SERPENTWAR SAGA (1994)
Depending on the spin, electrons either attract or repel metals.
WIRE.U (2004)
Iraqi security forces repelled two assaults before American troops arrived to help repel a third.
USA TODAY (2004)
No, the best thing to do about TV shows that repel you is to not watch them.
NEW YORK POST (2002)
Achieving fusion is difficult because any two hydrogen atoms have the same electrical charge and thus repel each other.
Evan I. Schwartz THE LAST LONE INVENTOR (2002)

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textile ('teks,tʌɪ ; 'tekstɪl)

Definitions

adjective

1. having to do with weaving or with woven fabrics
2. that has been or can be woven => *textile material*
3. noun
3. a fabric made by weaving, knitting, etc.; cloth
4. raw material suitable for this, as cotton, wool, nylon, etc.

Word Origin

L *textilis* < *textus*: see [text](#)

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AMERICAN ENGLISH

American English: [textile](#) Textiles are types of woven cloth....textiles for the home. *textiles*

Arabic: [نسيج](#)

Chinese: [纺织品](#)

Czech: [textil](#)

Dutch: [textiel](#)

Brazilian Portuguese: [tecido](#)

Croatian: [tekstil](#)

Danish: [tekstil](#)

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☐ Occasionally
☐ Never
☐ I don't know what this means

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