

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

FAUX EFFECTS INTERNATIONAL, INC.

Opposer,

Serial No.: 76/405,281
Trademark: AQUA FAUX
International Class: 002

vs.

T.J. RONAN PAINT,

Applicant.


09-11-2003
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #22

NOTICE OF OPPOSITION

Opposer, Faux Effects International, Inc ("Faux Effects"), a Florida corporation with a business address of 3435 Aviation Blvd, Suite A-4, Vero Beach, Florida 32960, hereby opposes registration of the trademark AQUA FAUX that is the subject of application Serial No. 76/405,281, published in the Official Gazette on July 15, 2003 and states that Faux Effects will be damaged by registration of said application and opposes registration thereof. As grounds in support of its opposition, Faux Effects asserts as follows:

1. Faux Effects is a renowned provider of decorative paint products in the field of faux finishing. Specifically, Faux Effects provides paints and coatings to create decorative and faux finishes for walls, furniture and other surfaces. Faux Effects' products are used both by professional painters and "do-it-yourself" painters. Faux Effects has educated thousands of faux finishing professionals.

2. Faux Effects, for many years and prior to any date of first use upon which Applicant can rely, has adopted and continuously used the term AQUA in conjunction

with at least twenty-four (24) trademarks ("AQUA Family of Marks," as defined in more detail below) and has used the trademark FAUX EFFECTS® for its decorative finishing products. Faux Effects has used many of its AQUA trademarks since at least as early as 1993. Faux Effects has used its FAUX EFFECTS® trademark at least as early as June 26, 1991.

3. Faux Effects is the owner of numerous U.S. trademark registrations and applications. The registrations are valid, subsisting, unrevoked, and uncanceled. The following are certain of Faux Effects' registrations and applications relevant to this opposition proceeding:

<u>Trademark</u>	<u>Reg. /Serial No</u>	<u>Goods/Services</u>
1. FAUX EFFECTS®	2,330,478	Liquid chemical compositions used in the production of faux finishes on solid substrates.
2. AQUAGLAZE®	2,758,754	Decorative compositions and finishes, namely interior and exterior faux glazes and paints.
3. AQUACRACKLE	76/469,936	Decorative compositions and finishes, namely interior and exterior faux glazes and paints.
4. FAUX EFFECTS	76/469,939	Educational and instructional services in the field of decoration and applying decorative finishes.
5. AQUA FINISHING SOLUTIONS	76/469,940	Decorative compositions and finishes.
6. AQUA FINISHING SOLUTIONS	76/469,938	Educational and instructional services in the nature of courses and workshops in the

field of decoration and applying decorative finishes.

7. THE FAUX STORE	76/469,933	Wholesale and retail store services in the field of decorative services, decorative products, paints, and paint application products.
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A copy of each of the foregoing registration is attached hereto as Exhibits 1 thru 7.

4. In addition to the foregoing, Faux Effects also is using and has acquired trademark rights in each of the following trademarks: AQUABOND, AQUABOND METALLIC, AQUACOLOR, AQUACOLOR HI-LITE, AQUACOLOR METALLIC, AQUACRACKLE METALLIC, AQUACREME, AQUAEXTENDER, AQUA FINISHING PASTE, AQUA IRIDESCENT COLOR, AQUA PALETTE ART, AQUAGARD, AQUARUST, AQUASEAL, AQUASIZE, AQUASTONE, AQUATEX, AQUATHANE, AQUAVERDI, AQUAVERDI COLOR, AQUAWAX (collectively, the foregoing trademarks referred to in paragraph 3, and trademarks AQUAGLAZE, AQUACRACKLE, and AQUA FINISHING SOLUTIONS will be referred to as the "AQUA Family of Trademarks"). Additionally, Faux Effects also has used and is using each of the following trademarks: FAUX CRÈME and FAUX EFFECTS FINE FINISHING STUDIO.

5. Applicant has filed an intent-to-use application to register the trademark AQUA FAUX in International Class 002, for house paints; interior paints; exterior paints; varnishes; lacquers in the nature of coatings; paint enamels in the nature of house paint; paint sealers; wood stains; paint primers; glazes; shellac substitutes, namely for use as a

surface coating; metallic coatings in the nature of sign finishes, automobile and decorative finishes; pearlescent coatings in the nature of sign finishes, automobile and decorative finishes; tints and clear coatings in the nature of sign finishes and/or automobile finishings; marbled coatings, glazes and clears for decorative and faux finishes; coatings used by furniture and cabinet refinishers to create artistic effects and a variety of decorative applications; paints and coatings used by specialty painters and scenic artist for aging effects, faux finishes, marbling and glazing; coatings used to make tints, stains or glazes for wet-in-wet techniques to create artistic effects including but not limited to dirt, age, smoke damage and simulated marble and wood grain; paint solvents and additives. The application was assigned Serial No. 76/405,281.

6. The trademark application of AQUA FAUX is identical to and confusingly similar to Faux Effects' AQUA Family of Trademarks and its FAUX EFFECTS[®] trademark in appearance and connotation.

7. The goods that Applicant intends to use the trademark AQUA FAUX are identical and closely related to the goods on which Faux Effects uses its marks in commerce in the United States.

8. Faux Effects will be damaged by registration of application Serial No. 76/405,281 for the trademark AQUA FAUX.

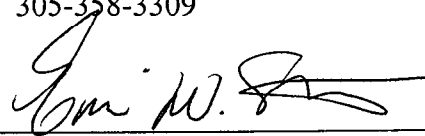
9. Applicant's trademark so resembles Faux Effects' previously adopted, used and registered AQUA Family of Trademarks and FAUX EFFECTS[®] trademark as to be likely, when applied to the goods set forth in Applicant's application, to cause confusion, mistake, or deception within the meaning of Section 2(d) of the Lanham Act, 15 U.S.C. section 1052(d).

WHEREFORE, Faux Effects respectfully requests that this opposition be sustained and that application Serial No 76/405,281 be refused registration.

Respectfully submitted,

FELDMAN GALE & WEBER, P.A.
Attorneys for Opposer, Faux Effects
International, Inc.
201 South Biscayne Boulevard
Miami Center – Suite 1920
Miami, Florida 33131
Tel: 305-358-5001
Fax: 305-358-3309

By: _____



James A. Gale/USPTO No.: 32,222
Henry S. Kaplan/USPTO No.: 25,346
Samuel A. Lewis/ FL Bar No.: 055360
Stephanie C. Alvarez/USPTO No.: 44,503
Erica W. Stump/FL Bar No.: 437632

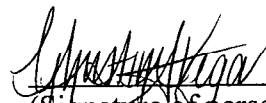
CERTIFICATE OF MAILING UNDER 37 C.F.R. 1.8

Date of Deposit: September 11, 2003

I HEREBY CERTIFY that the document named below is being deposited with the United States Postal Service, with sufficient pre-paid postage, in an envelope addressed to: Assistant Commissioner for Trademarks, Trademark Trial and Appeal Board, 2900 Crystal Drive, Arlington, VA 22202-3514.

Name of Document: **Notice of Opposition**


Christine A. Vega
(Type or print name of person mailing
paper)


(Signature of person mailing paper)

TTAB

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

In re: T.J. Ronan Paint Corp.
Application Serial No.: 76/405,281
Mark: AQUA FAUX
Filing Date: May 9, 2002
Publication Date: July 15, 2003


09-11-2003
U.S. Patent & TMOtc/TM Mail Rcpt Dt. #22

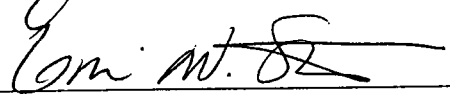
TRANSMITTAL SHEET

Commissioner for Trademarks
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Enclosed herewith is a **Notice of Opposition** and a check in the amount of \$300.00, payable to the Commissioner for Trademarks, along with a return receipt card, which I request you stamp and returned to the undersigned.

Respectfully submitted,

E-loan, Inc.

By: 
Erica W. Stump
Attorney for Applicant

Dated: September 11, 2003

FELDMAN GALE & WEBER, P.A.
Miami Center, 19th Floor
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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FAUX EFFECTS INTERNATIONAL, INC.

Opposer,

Serial No.: 76/405,281

Trademark: AQUA FAUX

International Class: 002

vs.

T.J. RONAN PAINT,

Applicant.

10-31-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #78

**RESPONSE TO REQUEST FOR EXPLANATION
OF RELATIONSHIP BETWEEN FAUX EFFECTS, INC. AND
FAUX EFFECTS INTERNATIONAL, INC.**

MP

Opposer, Faux Effects International, Inc. ("FEI") responds to the Board's Request for an Explanation of the Relationship between Faux Effects, Inc. and Faux Effects International, Inc. and asserts as follows:

1. Faux Effects, Inc. and FEI are, in fact, the same corporation which underwent a corporate name change. These corporate names refer to one, single corporation.
2. FEI filed a Notice of Opposition to Serial Number 76/405,281 for AQUA FAUX (the "Mark") on September 11, 2003 in its own name "Faux Effects International, Inc." Prior to the filing of the Notice of Opposition, FEI requested and obtained an extension of time to file a notice of opposition to the Mark. In the request for extension of time, FEI was identified by its old corporate name "Faux Effects, Inc."
3. By way of an amendment to its Articles of Incorporation on August 23, 2002, FEI changed its name from "Faux Effects, Inc." to "Faux Effects International, Inc." See Exhibit "A," Amendment to Articles of Incorporation. However, at the time undersigned

counsel filed the Request for Extension on behalf of FEI, undersigned counsel was not aware that FEI had formally changed its name from "Faux Effects, Inc." to "Faux Effects International, Inc." Undersigned counsel became aware of this change after the Request for Extension was filed, but before the Notice of Opposition was filed.

4. Based on the foregoing, FEI was misidentified through mistake. Trademark Rule 2.102(b) provides, in relevant part:

Any opposition filed during an extension of time should be in the name of the person to whom the extension was granted, but an opposition may be accepted if the person in whose name the extension was requested was *misidentified through mistake* or if the opposition is filed in the name of a person in privity with the person who requested and was granted the extension of time. (Emphasis added).

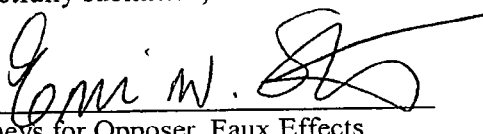
37 CFR 2.102(b). "Misidentified through mistake," means mistake in the form of the potential opposer's name or its entity type, not the naming of a different existing legal entity that is not in privity with the party that should have been named. *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ 2d 1075 (TTAB 1993); TMBP 206.03 (A request for ... an opposition, filed in a different name will not be rejected on the ground if it is shown to the satisfaction of the Board that the party in whose name the extension was requested was misidentified through mistake). FEI respectfully suggests that the opposition must go forward pursuant to Trademark Rule 2.102(b) because FEI was merely misidentified through mistake in the request for extension as "Faux Effects, Inc."

5. As previously stated, undersigned counsel became aware that FEI changed its name from "Faux Effects, Inc." to "Faux Effects International, Inc." after the Request for Extension was filed, but before the Notice of Opposition was filed. In fact, as soon as undersigned counsel became aware of the name change, name change notices were filed with the PTO for all of Opposer's registrations and pending applications.

6. Since "Faux Effects, Inc." and FEI are names referring to the same legal entity which was merely misidentified through mistake, FEI respectfully suggests there is no basis for precluding FEI from proceeding with the opposition filed.

WHEREFORE, Faux Effects respectfully requests that this opposition be sustained and that application Serial No 76/405,281 be refused registration.

Respectfully submitted,

By: 

Attorneys for Opposer, Faux Effects
International, Inc.

James A. Gale/USPTO No.: 32,222

Henry S. Kaplan/USPTO No.: 25,346

Samuel A. Lewis/ FL Bar No.: 055360

Stephanie C. Alvarez/USPTO No.: 44,503

Erica W. Stump/FL Bar No.: 437632

Dated: October 31, 2003

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Tel.: (305) 358-5001
Fax: (305) 358-3309

AMENDMENT TO ARTICLES OF INCORPORATION

OF

FAUX EFFECTS INC.

FILED

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COUNTY OF ST. LUCIE
ALLAHASSEE, FLOR.

The undersigned Directors of FAUX EFFECTS INC., hereby amend the Articles of Incorporation for said corporation, as follows:

AMENDMENT #1

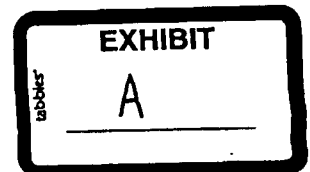
"The name of the corporation shall be: FAUX EFFECTS INTERNATIONAL, INC."

The above amendment was adopted at a meeting of all of the directors and all of the shareholders of the corporation on May 30, 2002. There is only one class of shareholders for this corporation, and the number of votes cast for the amendment by the class was sufficient for approval.

IN WITNESS WHEREOF, the undersigned has executed this Amendment to the Articles of Incorporation this 28 day of August, 2002.


RAYMOND SANDOR
President and Treasurer


JANE KOEHLER
Vice President and Secretary



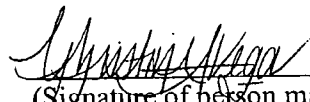
CERTIFICATE OF MAILING UNDER 37 C.F.R. 1.8

Date of Deposit: October 31, 2003

I HEREBY CERTIFY that the document named below is being deposited with the United States Postal Service, with sufficient pre-paid postage, in an envelope addressed to: Commissioner for Trademarks, Trademark Trial and Appeal Board, 2900 Crystal Drive, Arlington, VA 22202-3514.

Name of Document: **Response to Request for an Explanation of Relationship between Faux Effects, Inc. and Faux Effects International, Inc.**

Christine A. Vega
(Type or print name of person mailing paper)


(Signature of person mailing paper)

T T AB

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FAUX EFFECTS INTERNATIONAL, INC.

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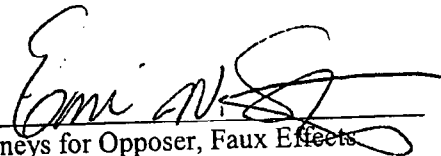
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10-31-2003

U.S. Patent & TMO/TM Mail Rpt Dt. #78

Enclosed herewith is a **Response to Request for Explanation of Relationship between Faux Effects, Inc. and Faux Effects International, Inc.** Also enclosed is a return receipt card, which we request you stamp and return to the undersigned.

Respectfully submitted,

By: 
Attorneys for Opposer, Faux Effects
International, Inc.

James A. Gale/USPTO No.: 32,222
Henry S. Kaplan/USPTO No.: 25,346
Samuel A. Lewis/ FL Bar No.: 055360
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