ESTTA Tracking number: **ESTTA256733**

Filing date: **12/22/2008**

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	L'Isolante K-Flex S.R.L.
Granted to Date of previous extension	12/20/2008
Address	100 Nomaco Drive Youngsville, NC 27596 UNITED STATES

Attorney information	D. Blake Simpson Smith, Anderson, Blount, Dorsett, Mitchell & Jernigan, LLP P.O. Box 2611 Raleigh, NC 27602 UNITED STATES bsimpson@smithlaw.com

Applicant Information

Application No	79052851	Publication date	10/21/2008
Opposition Filing Date	12/22/2008	Opposition Period Ends	12/20/2008
International Registration No.	0961531	International Registration Date	03/13/2008
Applicant	Kieselmann GmbH Paul-Kieselmann-StraÃ#e 4-10 75438 Knittlingen GERMANY		

Goods/Services Affected by Opposition

Class 006. All goods and services in the class are opposed, namely: Metal valves not being parts of machines and parts and fittings therefor
Class 007. All goods and services in the class are opposed, namely: Metal valves being parts of machines and parts and fittings therefor
Class 017. All goods and services in the class are opposed, namely: Sealing and insulating materials; non-metal seals and sealing rings for use in valves, tanks and pipe connections

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	2330544	Application Date	05/14/1997
Registration Date	03/21/2000	Foreign Priority Date	NONE
Word Mark	K-FLEX		
Design Mark	K-FLEX		
Description of Mark	NONE		
Goods/Services	Class 017. First use: First Use: 1997/02/00 First Use In Commerce: 1997/02/00 foamed rubber sheets and tubes, namely, thermal insulation for water pipes, air pipes, air conditioning units, refrigeration units; extruded plastic in the form of bars, blocks, pellets, rods, sheets and tubes for use in manufacturing, building, industrial, and commercial uses		

Attachments	75292623#TMSN.gif (1 page)(bytes) Notice of Opposition to K-Flex Mark.pdf (7 pages)(303977 bytes)

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	/D. Blake Simpson/
Name	D. Blake Simpson
Date	12/22/2008

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

In the matter of Trademark Application Serial No. 79/052,851
Filed: March 13, 2008
Mark: K-FLEX
Published in the Official Gazette: October 21, 2008

L'ISOLANTE K-FLEX S.r.l.	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. _____
	)	
KIESELMANN GmbH	)	
	)	
Applicant.	)	

NOTICE OF OPPOSITION

L'Isolante K-Flex S.r.l. hereby states that it believes that it will be damaged by registration of the mark shown in Application Serial No. 79/052,851 in International Classes 006, 007 and 017 and therefore opposes same.

As grounds for opposition, it is alleged as follows:

1. Opposer, L'Isolante K-Flex Srl., is a corporation organized and existing under the laws of Italy which maintains its principal place of business at Via Don G. Locatelli, 35 20040 Roncello, Milan, Italy.

2. Since February 1997, Opposer has used and is now using the trademark K-FLEX in interstate commerce in the United States in connection with the manufacture, marketing, promotion, distribution and sale of foamed rubber sheets and tubes, namely, thermal insulation for water pipes, air pipes, air conditioning units, and refrigeration

units, and extruded plastic in the form of bars, blocks, pellets, rods, sheets and tubes for use in manufacturing, building, industrial and commercial uses.

3. By virtue of the popularity and quality of the goods offered for sale and sold in the United States by Opposer under its K-FLEX trademark, Opposer's extensive marketing and promotional efforts, and Opposer's substantial and exclusive use of its K-FLEX trademark in the United States in connection with its goods, Opposer's K-FLEX trademark has acquired great value as a way of identifying Opposer's goods and as a way of distinguishing such goods from those offered for sale and sold by others.

4. Opposer and its K-FLEX trademark have become well known among consumers in the United States, as persons know Opposer by its distinctive K-FLEX trademark, and they associate Opposer's K-FLEX trademark with Opposer and the goods offered for sale and sold by Opposer. As a result of Opposer's extensive use of its K-FLEX trademark in interstate commerce in the United States, consumers have come to recognize the K-FLEX trademark as signifying and identifying Opposer as the source of its goods. Opposer's K-FLEX trademark, therefore, is symbolic of extensive goodwill and consumer recognition built up by Opposer through its advertising and promotional efforts.

5. On March 21, 2000, the U.S. Patent and Trademark Office issued to Opposer U.S. Registration No. 2,330,544 for its trademark K-FLEX for use in connection with "foamed rubber sheets and tubes, namely, thermal insulation for water pipes, air pipes, air conditioning units, refrigeration units; extruded plastic in the form of bars, blocks, pellets, rods, sheets and tubes for use in manufacturing, building, industrial, and commercial uses" in International Class 017. This registration has achieved incontestable

status under 15 U.S.C. § 1065. Opposer also is the owner of extensive common law rights in its K-FLEX trademark.

6. Applicant, Kieselmann GmbH, has filed U.S. Application Serial No. 79/052,851 seeking to register "K-FLEX" as a trademark for use in connection with "metal valves not being parts of machines and parts and fittings therefor" (International Class 006); "metal valves being parts of machines and parts and fittings therefor" (International Class 007); and "sealing and insulating materials; non-metal seals and sealing rings for use in valves, tanks and pipe connections" (International Class 017). Upon information and belief, Applicant is a company with limited liability organized under the laws of the Federal Republic of Germany with a principal place of business at Paul-Kieselmann Straβe 4-10 75438, Knittlingen, Federal Republic of Germany.

7. Applicant's proposed "K-FLEX" trademark is identical or substantially similar to Opposer's registered K-FLEX trademark. Applicant's proposed "K-FLEX" trademark and Opposer's registered K-FLEX trademark are spelled the same. They are also the same or substantially similar in appearance and sound.

8. Upon information and belief, some or all of the goods in connection with which Applicant proposes to use its "K-FLEX" trademark are identical or substantially related to the goods that Opposer offers for sale and sells under Opposer's registered K-FLEX trademark.

9. Upon information and belief, the goods in connection with which Applicant proposes to use its "K-FLEX" trademark will be (or are likely to be) marketed, promoted, distributed, offered for sale and sold in the same or similar channels of trade as

the goods that Opposer markets, promotes, distributes, offers for sale and sells under Opposer's registered K-FLEX trademark.

10. Upon information and belief, the goods in connection with which Applicant proposes to use its "K-FLEX" trademark in the United States will be (or are likely to be) marketed, promoted, offered for sale and sold to the same or similar classes of purchasers as Opposer markets, promotes, offers for sale and sells goods under Opposer's registered K-FLEX trademark.

11. Upon information and belief, the goods in connection with which Applicant proposes to use its "K-FLEX" trademark in the United States will be (or are likely to be) offered for sale and sold in close proximity with Opposer's goods offered for sale and sold under Opposer's registered K-FLEX trademark.

12. There is no issue as to priority. As alleged above, Opposer has used its K-FLEX trademark in interstate commerce in the United States in connection with foamed rubber sheets and tubes, namely, thermal insulation for water pipes, air pipes, air conditioning units, and refrigeration units and extruded plastic in the form of bars, blocks, pellets, rods, sheets and tubes for use in manufacturing, building, industrial and commercial uses since February 1997, more than 10 years prior to Applicant's asserted priority date of October 2007.

13. Applicant's proposed "K-FLEX" trademark is likely, when used in connection with the goods identified in U.S. Application Serial No. 79/052,851, to cause confusion or mistake or to deceive purchasers, resulting in damage and detriment to Opposer and its reputation.

14. In view of Opposer's prior and substantial use of its K-FLEX trademark in connection with its goods, as alleged above, Opposer's promotional and marketing efforts directed to the same or similar channels of trade and classes of customers to which Applicant intends to advertise, market, distribute, offer for sale and sell the goods identified in U.S. Application Serial No. 79.052,851, Applicant's proposed use of "K-FLEX," as applied for, falsely suggests a connection with Opposser within the meaning of 15 U.S.C.§ 1052(a) and/or so resembles Opposer's registered K-FLEX trademark as to be likely to cause confusion, mistake and/or deception within the meaning of 15 U.S.C. § 1052(d) as to the affiliation, connection or association of Applicant with Opposer, or as to the origin, sponsorship, or approval of Applicant's goods with Opposer. Any such confusion in the trade inevitably will result in loss of sales by Opposer, causing damage to Opposer within the meaning of 15 U.S.C. § 1063(a). Moreover, any defect, objection or fault found with Applicant's goods marketed under its proposed "K-FLEX" trademark, as applied for, would reflect upon and injure the reputation which Opposer has established for the goods it offers for sale and sells under its registered K-FLEX trademark, also causing damage to Opposer within the meaning of 15 U.S.C. § 1063(a).

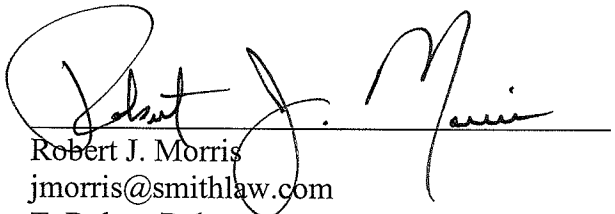
15. Opposer also will be damaged by the registration of Applicant's proposed "K-FLEX" mark within the meaning of 15 U.S.C. § 1063(a) because such registration would support and assist Applicant in the confusing and misleading use of its proposcd "K-FLEX" trademark mark and in infringing Opposer's rights in its registered K-FLEX trademark, and because such registration would give Applicant color of right in and to its proposed "K-FLEX" trademark in violation of the prior and superior rights of Opposer.

16. Further, use of Applicant's proposed "K-FLEX" trademark, as applied for, is false and misleading and likely to cause confusion with Opposer's registered K-FLEX trademark and is therefore in violation of 15 U.S.C. § 1125(a), causing damage to Opposer within the meaning of 15 U.S.C. §1063(a).

17. Opposer believes, and therefore states, that it will be damaged by registration of the "K-FLEX" trademark that is the subject of U.S. Application Serial No. 79/052,851 and requests that registration be refused.

WHEREFORE, Opposer, L'Isolante K-Flex S.r.l., requests that its opposition be sustained, that U.S. Application Serial No. 79/052,851 be rejected, and that registration of the trademark set forth therein for the goods identified in International Classes 006, 007 and 017 be refused.

This the 22nd day of December, 2008.



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Attorneys for Opposer
L'Isolante K-Flex S.r.l.

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Notice of Opposition was served on counsel of record for Applicant, Kieselmann GmbH, by depositing a copy hereof in the United States mail, first-class postage prepaid, addressed as follows:

Mark D. Roth
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This the 22nd day of December, 2008.

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