

ESTTA Tracking number: **ESTTA366176**

Filing date: **09/01/2010**

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	Construction Research & Technology GmbH LIMITED LIABILITY COMPANY
Granted to Date of previous extension	09/01/2010
Address	Dr.-Albert-Frank-Strasse 32 Trostberg, D-83308 GERMANY

Attorney information	D. Ari Sherwin Curatolo Sidoti Co., LPA 24500 Center Ridge Road Suite 280 Cleveland, OH 44145 UNITED STATES docket@patentandtm.com Phone:440.808.0011
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Applicant Information

Application No	77892389	Publication date	05/04/2010
Opposition Filing Date	09/01/2010	Opposition Period Ends	09/01/2010
Applicant	Res-Tek Inc. 110 Riverside Drive Cartersville, GA 30120 UNITED STATES		

Goods/Services Affected by Opposition

Class 019. All goods and services in the class are opposed, namely: urethane cement for refurbishing concrete flooring or for sealing concrete flooring
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Grounds for Opposition


Deceptiveness	Trademark Act section 2(a)
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.	1030416	Application Date	09/20/1974
Registration Date	01/20/1976	Foreign Priority Date	NONE

Word Mark	UCRETE
Design Mark	
Description of Mark	NONE
Goods/Services	Class 001. First use: CHEMICAL PRODUCTS-NAMELY, POLYMERS FOR USE IN THE MANUFACTURE OF POLYMERIC CONCRETE

U.S. Registration No.	3758701	Application Date	10/14/2008
Registration Date	03/09/2010	Foreign Priority Date	NONE

Word Mark	UCRETE
Design Mark	
Description of Mark	NONE
Goods/Services	Class 019. First use: First Use: 1982/12/00 First Use In Commerce: 1982/12/00 Polymeric concrete aggregate

Attachments	77592312#TMSN.jpeg (1 page)(bytes) CRXC3500a.pdf (8 pages)(665432 bytes) CRXC3500b.pdf (2 pages)(76693 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	/D. Ari Sherwin/
Name	D. Ari Sherwin
Date	09/01/2010

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

In the matter of Application Serial No. 77/892,389

Filed on December 14, 2009

For the mark PUR-CRETE

Published in the *Official Gazette* (Trademarks) on May 4, 2010

Construction Research &)	
Technology GmbH,)	
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)	
Opposer,)	Opposition No.: _____
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)	
v.)	
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Res-Tek Inc.,)	
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Applicant.)	
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**UNITED STATES PATENT AND TRADEMARK OFFICE
ATTN: TRADEMARK TRIAL AND APPEAL BOARD
P.O. BOX 1451
ALEXANDRIA, VA. 22313-1451**

NOTICE OF OPPOSITION

Construction Research & Technology GmbH (hereinafter referred to as "OPPOSER"), a limited liability company organized and existing under the laws of the country of Germany, having its principal place of business at Dr.-Albert-Frank Strasse 32, Trostberg, Germany D-83308, believes that it will be damaged by the registration of PUR-CRETE shown in Trademark Application Serial No. 77/892,389 and hereby opposes the same.

The grounds for opposition are as follows:

1. OPPOSER is a subsidiary of BASF SE, duly organized and existing under the laws of the European Union, having its principal place of business in Ludwigshafen, Germany.

2. OPPOSER was organized and functions as the legal owner of certain intellectual property rights of BASF SE and its subsidiaries.

3. OPPOSER owns United States Trademark Registration No. 1,030,416 for the mark UCRETE for chemical products-namely, polymers for use in the manufacture of polymeric concrete in International Class 019.

4. United States Trademark Registration No. 1,030,416 for the mark UCRETE was issued on January 20, 1976 and has achieved incontestable status.

5. OPPOSER also owns United States Trademark Registration No. 3,758,701 for the mark UCRETE for polymeric concrete aggregate in International Class 001.

6. United States Trademark Registration No. 3,758,701 for the trademark UCRETE was issued on March 9, 2010 and bears a date of first use in commerce of at least as early as December, 1982.

7. A true copy of each of United States Trademark Registration Nos. 1,030,416 and 3,758,701 are attached hereto as Exhibits 1 and 2, respectively.

8. OPPOSER has licensed United States Trademark Registration Nos. 1,030,416 and 3,758,701 to BASF Corporation.

9. The Building Systems business of BASF Corporation uses the federally registered UCRETE mark in connection with the marketing and sale of urethane-based flooring systems in the commercial and residential building, construction, renovation and repair industries.

10. The use of the federally registered UCRETE mark on or in connection with the marketing and sale of goods in commerce by OPPOSER and its affiliates, and predecessors-in-interest, has been valid and continuous since the registration dates for the UCRETE registrations and have not been abandoned.

11. Upon information and belief, Res-Tek Inc. (hereinafter referred to as "APPLICANT"), is a corporation duly organized and existing under the laws of the State of Georgia, having a mailing address of 10 Riverside Drive, Cartersville, Georgia 30120.

12. APPLICANT has filed Trademark Application Serial No. 77/892,389 (hereafter referred to as the "Application") to register PUR-CRETE on the Principal Register of the United States Patent and Trademark Office for urethane cement for refurbishing concrete flooring or for sealing concrete flooring in International Class 019.

13. The Application was published for opposition in the *Official Gazette* (Trademarks) on May 4, 2010.

14. The Application was filed based on an intent to use on December 14, 2009 and no Allegation of Use has been filed to date.

15. OPPOSER'S registration of the UCRETE mark and the first use in commerce and registration of the UCRETE mark is well before APPLICANT'S filing date of the Application.

16. The "PUR-" prefix is the official designation for polyurethane according to the International Union of Pure and Applied Chemistry.

17. The prefix "U" of OPPOSER'S registered UCRETE mark suggests a urethane or polyurethane-based product.

18. The mark PUR-CRETE and OPPOSER'S federally registered UCRETE mark are substantially similar in appearance and spelling.

19. The sound and pronunciation of the mark PUR-CRETE and OPPOSER'S federally registered UCRETE mark are substantially similar.

20. The mark PUR-CRETE conveys a similar or virtually the same commercial impression and connotation as OPPOSER'S federally registered UCRETE mark, namely, a urethane concrete product.

21. The goods for which APPLICANT seeks to register the term PUR-CRETE are related to, substantially similar to, or of the same general nature as the goods recited in OPPOSER'S federal registrations for the UCRETE mark.

22. The goods of OPPOSER'S licensee are offered for sale and advertised at least through the internet.

23. Upon information and belief, APPLICANT'S goods are offered for sale and advertised through the internet, and therefore constitute similar trade channels.

24. OPPOSER'S licensee markets and sells OPPOSER'S goods to contractors and sub-contractors in the commercial and residential building, construction, renovation and repair industries.

25. Upon information and belief, APPLICANT'S goods are marketed and sold to contractors and sub-contractors in the commercial and residential building, construction, renovation and repair industries, and therefore are directed to the same general class of purchasers as OPPOSER'S goods.

26. OPPOSER has spent significant time, effort, and money extensively advertising, marketing and otherwise promoting its federally registered UCRETE mark to the purchasing public in connection with the sale of goods in interstate commerce throughout the United States.

27. By extensively advertising, marketing and promoting goods under the federally registered UCRETE mark, the purchasing public has come to recognize OPPOSER'S federally registered UCRETE mark as signifying OPPOSER and its affiliates as the source or origin of those goods.

28. By extensively advertising, marketing and promoting goods under the federally registered UCRETE mark, OPPOSER has developed exceedingly valuable goodwill and consumer recognition throughout the United States with respect to the trademark.

29. Upon information and belief, APPLICANT'S registration of the mark PUR-CRETE in connection with the goods recited in the Application is such that it will create or is likely to create confusion, deception, or mistake among purchasers as to the origin or source of APPLICANT'S goods.

30. Upon information and belief, APPLICANT'S registration of the mark PUR-CRETE is such that purchasers will be misled and deceived into mistakenly believing that APPLICANT'S goods are approved or sponsored by OPPOSER, which they are not.

31. Upon information and belief, APPLICANT'S registration of the mark PUR-CRETE is such that purchasers will be misled and deceived into mistakenly believing that APPLICANT or APPLICANT'S products are in some way affiliated, connected to, or associated with OPPOSER, which they are not.

32. The federally registered UCRETE mark is distinctive, famous, and well known for the goods of OPPOSER and its affiliates, and has been so before Applicant's filing date of the Application.

33. Upon information and belief, the registration of the mark PUR-CRETE work to OPPOSER'S disadvantage in that the goodwill attached to OPPOSER'S federally registered UCRETE mark will likely be extended to APPLICANT without OPPOSER'S knowledge or consent, thereby benefiting APPLICANT rather than OPPOSER.

34. Upon information and belief, APPLICANT'S registration of the mark PUR-CRETE will interfere with, or is likely to interfere with, or embarrass OPPOSER, in its business reputation and the reputation of the goods for which it uses the federally registered UCRETE mark.

35. Upon information and belief, APPLICANT'S registration and use of PUR-CRETE is likely to cause dilution of OPPOSER'S federally registered UCRETE mark.

WHEREFORE, OPPOSER believes that registration of application Trademark Application Serial No. 77/892,389 for the mark PUR-CRETE will damage OPPOSER, and pray that registration of Trademark Application Serial No. 77/892,389 in International Class 019 be refused.

CORRESPONDENCE ADDRESS

Please direct all correspondence in connection with this Opposition to:

D. Ari Sherwin, Esq.
Curatolo Sidoti Co., LPA
24500 Center Ridge Road, Suite 280
Cleveland, Ohio 44145

Applicant has appointed Joseph G. Curatolo, Salvatore A. Sidoti, Peter R. Detorre, D. Ari Sherwin, and Vince A. Cortese of Curatolo Sidoti Co., LPA, all members of the bar of the State of Ohio, to transact all business in the United States Patent & Trademark Office in connection with the present Opposition.

Respectfully submitted,

Date: September 1, 2010

/D. Ari Sherwin/
Salvatore A. Sidoti, Esq.
D. Ari Sherwin, Esq.
Curatolo Sidoti Co., LPA
24500 Center Ridge Road, Suite 280
Cleveland, Ohio 44145
T: 440.808.0011
F: 440.808.0657
Attorneys for Opposer

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **NOTICE OF OPPOSITION** has been served upon the Applicant's Attorney on this 1st day of September, 2010 by depositing the same in the United States First Class Mail, postage pre-paid, in an envelope addressed as follows:

Sumner C. Rosenberg, Esq.
Ballard Spahr LLP
999 Peachtree Street – Suite 1000
Atlanta, GA 30309-4471



D. Ari Sherwin

Int. Cl.: 1

Prior U.S. Cl.: 6

United States Patent Office

Reg. No. 1,030,416
Registered Jan. 20, 1976

TRADEMARK
Principal Register

UCRETE

Imperial Chemical Industries Limited (British limited
liability company)
Imperial Chemical House
Millbank, London SW1P 3JF, England

For: CHEMICAL PRODUCTS—NAMELY, POL-
YMERS FOR USE IN THE MANUFACTURE OF
POLYMERIC CONCRETE—in CLASS 1 (U.S. CL. 6).
Owner of British Reg. No. 992,229, dated May 17,
1972.

Ser. No. 32,609, filed Sept. 20, 1974.

D. SHALLANT, Examiner

United States of America

United States Patent and Trademark Office

UCRETE

Reg. No. 3,758,701 CONSTRUCTION RESEARCH & TECHNOLOGY GMBH (FED REP GERMANY LIMITED
Registered Mar. 9, 2010 LIABILITY COMPANY)

DR.-ALBERT-FRANK-STRASSE 32
TROSTBERG, FED REP GERMANY D-83308

Int. Cl.: 19

FOR: POLYMERIC CONCRETE AGGREGATE, IN CLASS 19 (U.S. CLS. 1, 12, 33 AND 50).

TRADEMARK
PRINCIPAL REGISTER

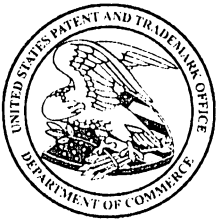
FIRST USE 12-0-1982; IN COMMERCE 12-0-1982.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NO. 1,030,416.

SN 77-592,312, FILED 10-14-2008.

ALYSSA STEEL, EXAMINING ATTORNEY



David J. Kappas

Director of the United States Patent and Trademark Office