

ESTTA Tracking number: **ESTTA429601**

Filing date: **09/09/2011**

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	SWIMC, Inc.
Granted to Date of previous extension	09/11/2011
Address	850 Library Avenue Suite 204-H Newark, DE 19711 UNITED STATES

Attorney information	Deron A. Cook, Reg. No. 52,767 The Sherwin-Williams Company 101 W. Prospect Ave. 1100 Midland Bldg. - Legal Dept. Cleveland, OH 44115-1075 UNITED STATES legal_ip@sherwin.com Phone:2165663047
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Applicant Information

Application No	85083225	Publication date	03/15/2011
Opposition Filing Date	09/09/2011	Opposition Period Ends	09/11/2011
Applicant	True Value Company 8600 West Bryn Mawr Avenue Chicago, IL 606313505 UNITED STATES		

Goods/Services Affected by Opposition

Class 002. All goods and services in the class are opposed, namely: Paint
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	1955591	Application Date	01/13/1994
Registration Date	02/13/1996	Foreign Priority Date	NONE
Word Mark	PLATINUM		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 002. First use: First Use: 1994/05/17 First Use In Commerce: 1994/05/17 clear and pigmented coatings in the nature of interior and exterior paint
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Attachments	easy clare platinum opposition.PDF (9 pages)(184898 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	/DAC/
Name	Deron A. Cook, Reg. No. 52,767
Date	09/09/2011

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

*In the matter of Trademark Application Serial No. 85083225
Filed July 13, 2010
For the Mark EASY CARE PLATINUM
Published in the Official Gazette on March 15, 2011*

SWIMC, Inc.)	
	Opposer,)
)	Opposition No. _____
vs.)	
)	
True Value Company)	
	Applicant.)

BOX TTAB FEE
Commissioner for Trademarks
PO Box 1451
Arlington, VA 22313-1451

NOTICE OF OPPOSITION

SWIMC, Inc., a corporation organized and doing business under the laws of the State of Delaware, having a place of business at 850 Library Avenue, Suite 204H, Newark, Delaware 19711-7174 (“Opposer”), believes it will be damaged by grant of a registration to True Value Company, located at 8600 West Bryn Mawr Avenue, Chicago, Illinois (“Applicant”), based on Application Serial No. 85/083225 for the mark "EASY CARE PLATINUM" filed July 13, 2010 for "paint" in International Class 2. Opposer hereby gives notice of its intention to oppose the registration of the aforementioned mark. As grounds for this Opposition, Opposer respectfully alleges the following:

1. Opposer is the owner of U.S. Trademark Registration No. 1,955,591 for the mark PLATINUM for “clear and pigmented coatings in the nature of interior and exterior paint” (“Opposer’s Registration”).

2. Opposer’s Registration issued February 13, 1996 and is valid, subsisting, enforceable and incontestable. A copy of the TARR report for the Opposer’s Registration is attached as Exhibit A.

3. Opposer’s licensee, The Sherwin-Williams Company, is a leading manufacturer, retailer, wholesaler and distributor of paint and coating products, including, without limitation, architectural paints.

4. Opposer’s PLATINUM mark has been used continuously in interstate commerce by and through Opposer’s licensee from a date prior in time to the July 13, 2010 filing date of Applicant’s trademark application for EASY CARE PLATINUM.

5. As a result of the use, promotion and advertising of Opposer’s PLATINUM mark and products bearing its PLATINUM mark, Opposer’s PLATINUM mark has acquired significant goodwill.

6. The similarity of Applicant’s EASY CARE PLATINUM mark to Opposer’s PLATINUM mark is evident from comparison of the marks; and the goods described in

Applicant's trademark application are related to the goods bearing Opposer's PLATINUM mark and may be encountered by the same class of consumers in similar channels of trade.

7. Applicant's mark so resembles Opposer's mark that its use is likely to deceive consumers or cause confusion or mistake in the minds of consumers by leading consumers to believe that Applicant's goods are endorsed, approved, associated with, or sponsored by Opposer or that Applicant utilizes Opposer's goods, all to the injury of consumers and to Opposer and its goodwill in the PLATINUM mark.

8. Opposer will be injured by registration of Applicant's mark because Applicant's mark, when used in connection with Applicant's goods, is likely to:

- a. cause confusion or mistake in the minds of consumers or to deceive consumers as to an association between Applicant and Opposer and the goods provided by each;
- b. falsely suggest a connection or association with Opposer and/or products bearing Opposer's mark;
- c. damage Opposer's valuable goodwill in its PLATINUM trademark; and
- d. threaten Opposer's rights to expand the scope and use of its trademark to related, analogous or equivalent goods or services and to undermine and injure Opposer's rights in its mark.

9. Applicant is not now, and was not at the time of filing the application, or at any other time entitled to the registration of the mark disclosed for the goods specified therein.

NOW THEREFORE, for these reasons and other reasons, Opposer believes that it would be materially damaged if Applicant's mark was registered and, therefore, prays that registration of the mark EASY CARE PLATINUM be refused and that this Opposition be sustained.

The fee in the amount of \$300.00 should be charged to Deposit Account No. 19-2025, as well as any additional fees, and any overpayments should be credited to the same Deposit Account No. 19-2025.

All correspondence in connection with this matter should be mailed to:

Deron A. Cook, Esq.
c/o The Sherwin-Williams Company
101 W. Prospect Avenue
1100 Midland Bldg. - Legal Dept.
Cleveland, OH 44115-1075
phone: (216) 566-3047
fax: (216) 515-4400
email: legal_ip@sherwin.com

Dated: September 09, 2011.

Respectfully submitted,

SWIMC, INC.

By / DAC / .
Deron A. Cook
Reg. No. 52,767
Attorney for Opposer

Enclosure: Copy of TARR Report of Reg. No. 1,955,591

EXHIBIT A

Exhibit A to SWIMC, Inc.'s Notice of Opposition to
Trademark Application Serial No. 85083225

atest Status Info

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2011-09-09 12:18:44 ET

Serial Number: 74479108 Assignment Information Trademark Document Retrieval

Registration Number: 1955591

Mark (words only): PLATINUM

Standard Character claim: No

Current Status: The registration has been renewed.

Date of Status: 2006-07-11

Filing Date: 1994-01-13

Transformed into a National Application: No

Registration Date: 1996-02-13

Register: Principal

Law Office Assigned: LAW OFFICE 104

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 40S -Scanning On Demand

Date In Location: 2006-08-16

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. SWIMC, INC.

Address:
SWIMC, INC.
PO Box 657
Newark, DE 197150657
United States

Legal Entity Type: Corporation
State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

International Class: 002
Class Status: Active
clear and pigmented coatings in the nature of interior and exterior paint

Basis: 1(a)

First Use Date: 1994-05-17

First Use in Commerce Date: 1994-05-17

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2009-11-12 - Applicant/Correspondence Changes (Non-Responsive) Entered

2009-11-12 - TEAS Change Of Owner Address Received

2006-08-16 - Case File In TICRS

2006-07-11 - First renewal 10 year

2006-07-11 - Section 8 (10-year) accepted/ Section 9 granted

2006-07-11 - Assigned To Paralegal

2006-01-06 - Combined Section 8 (10-year)/Section 9 filed

2006-01-06 - TEAS Section 8 & 9 Received

2001-05-24 - Section 8 (6-year) accepted & Section 15 acknowledged

2001-02-27 - Section 8 (6-year) and Section 15 Filed

1996-02-13 - Registered - Principal Register

1995-11-21 - Published for opposition

1995-10-20 - Notice of publication

1995-09-10 - Approved for Pub - Principal Register (Initial exam)

1995-09-05 - Ex parte appeal - Instituted

1995-06-27 - Unresponsive/Duplicate Paper Received

1995-04-07 - Unresponsive/Duplicate Paper Received

atest Status Info

1995-02-24 - Final refusal mailed

1995-01-09 - Communication received from applicant

1994-11-03 - Amendment to Use approved

1994-08-16 - Unresponsive/Duplicate Paper Received

1994-09-27 - Amendment To Use Processing Complete

1994-08-16 - Use Amendment Filed

1994-07-08 - Non-final action mailed

1994-06-25 - Assigned To Examiner

1994-06-10 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

ROBERT E. MCDONALD,

Correspondent

JAMES V. TURA

1123 MIDLAND BUILDING

THE SHERWIN-WILLIAMS COMPANY

CLEVELAND OH 44115
