

ESTTA Tracking number: **ESTTA537659**

Filing date: **05/14/2013**

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	EVONIK TEGO CHEMIE GMBH
Granted to Date of previous extension	05/18/2013
Address	GOLDSCHMIDTSTRASSE 100 ESSEN, 45127 GERMANY

Domestic Representative	Scott Woldow Attorney Smith, Gambrell & Russell, LLP 1130 Connecticut Avenue, NW, Suite 1130 Washington, DC 20036 UNITED STATES sdwoldow@sgrlaw.com Phone:202-263-4300
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Applicant Information

Application No	85736164	Publication date	03/19/2013
Opposition Filing Date	05/14/2013	Opposition Period Ends	05/18/2013
Applicant	XIM Products, Inc. 1169 Basset Road Westlake, OH 44145 UNITED STATES		

Goods/Services Affected by Opposition

Class 002. All goods and services in the class are opposed, namely: Paint additives for enhancing toughness and durability; paint additives for enhancing adhesion; paint additives for enhancing moisture resistance; paint additives for enhancing leveling and flowability; and paint additives for enhancing rust and discoloration resistance

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.	2113440	Application Date	02/15/1996
Registration Date	11/18/1997	Foreign Priority Date	NONE

Word Mark	ADDID
Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 001. First use: chemical products, namely, organosilicon compounds for use in the fields of agriculture, horticulture and forestry; artificial unprocessed resins used in the lacquer and paint industry, the aerospace, automotive engineering, [electrical engineering, electronics], transmission and distribution industries, [mechanical engineering], chemical [and food] processing, construction, [textiles, paper, rubber and plastics, cable, medicine and pharmaceuticals, polishes and cosmetics] industries; unprocessed plastics used in the lacquer and paint industry, the aerospace, automotive engineering, [electrical engineering,] electronics, transmission and distribution industries, mechanical engineering, [chemical and food processing], construction, [textiles, paper, rubber and plastics, cable, medicine and pharmaceuticals, polishes and cosmetics] industries; chemical additives for use in the manufacture of plastics and chemicals, namely, silanes, organosilanes, silicic acid esters, polysilanes, polysilazanes, silicones, silicone oils, silicone resins and silicone greases, silicone plasters and silicone elastomers for general purposes and chemical additives for use in the manufacture of lacquers and paints</p> <p>Class 002. First use: paints, varnishes, lacquers in the nature of a coating, wood preservatives and anti-rust oils; color pigments, paint thinners, bactericidal paints, and lacquers in the nature of a coating for electrical and electronic parts and components</p> <p>Class 017. First use: insulating paints for insulating purposes, [and general purpose silicone rubber sealant]</p>

Attachments	TRADEMARK 1.PDF(177830 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	/SW/
Name	Scott Woldow
Date	05/14/2013

Attorney Docket No.
034569.002Opp

TRADEMARK

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

In the Matter of Application Serial No. 85/736164
Published: March 19, 2013

Evonik Tego Chemie GmbH)	
)	
Opposer,)	
)	
v.)	Opposition No. _____
)	
XIM Products, Inc.)	
)	
Applicant.)	

Commissioner for Trademarks
Box TTAB FEE
P.O. Box 1451
Alexandria, Virginia 22313-1451

Madam:

NOTICE OF OPPOSITION

In the matter of the application of XIM Products, Inc. for registration of the mark ADD-IT, filed on September 24, 2012, application Serial No. 85/736164, published in the Official Gazette on March 19, 2013, Evonik Tego Chemie GmbH believes that it will be damaged by registration of the mark shown in Serial No. 85/736164, and hereby opposes registration.

Evonik Tego Chemie GmbH (hereinafter “OPPOSER”), a Limited Liability Company of the Federal Republic of Germany, having offices located at Goldschmidtstrasse 100, 45127, Essen, Germany, believes that it will be damaged by registration of the mark ADD-IT, Application Serial No. 85/736164, and hereby opposes the same.

The grounds for opposition are as follows.

1. Opposer is now and has been engaged in the specialty chemical, coatings, and paint businesses.

2. Opposer manufactures chemicals, coatings and paints for use in a wide variety of fields.

3. Opposer manufactures chemicals and chemical additives for use in the manufacture of paints.

4. Opposer is the owner of United States Registration No. 2,113,440, for the mark ADDID which registered on November 18, 1997, in association with “chemical products, namely, organosilicon compounds for use in the fields of agriculture, horticulture and forestry; artificial unprocessed resins used in the lacquer and paint industry, the aerospace, automotive engineering, transmission and distribution industries, chemical processing, construction, industries; unprocessed plastics used in the lacquer and paint industry, the aerospace, automotive engineering, electronics, transmission and distribution industries, mechanical engineering, construction, industries; chemical additives for use in the manufacture of plastics and chemicals, namely, silanes, organosilanes, silicic acid esters, polysilanes, polysilazanes, silicones, silicone oils, silicone resins and silicone greases, silicone plasters and silicone elastomers for general purposes and chemical additives for use in the manufacture of lacquers and paints,” in Class 1; “paints, varnishes, lacquers in the nature of a coating, wood preservatives and anti-rust oils; color

pigments, paint thinners, bactericidal paints, and lacquers in the nature of a coating for electrical and electronic parts and components,” in Class 2; and “insulating paints for insulating purposes,” in Class 17.

5. Opposer is now and has been using the ADDID mark in United States commerce.

6. Opposer’s ownership of United States Trademark Registration No. 2,113,440 has been valid and continuous and has not been abandoned.

7. Opposer’s mark is symbolic of extensive goodwill and consumer recognition built up by Opposer through substantial amounts of time and effort in advertising, promotion and sales of products thereunder.

8. Notwithstanding Opposer’s rights in and to its trademark, Applicant on September 24, 2012, filed an application for registration of the mark ADD-IT.

9. The ADD-IT mark was approved for publication in association with “paint additives for enhancing toughness and durability; paint additives for enhancing adhesion; paint additives for enhancing moisture resistance; paint additives for enhancing leveling and flowability; and paint additives for enhancing rust and discoloration resistance.”

10. The application was assigned Serial No. 85/736,164 and was published for opposition in the Official Gazette on March 19, 2013.

11. Applicant’s mark ADD-IT, when used in connection with the goods set forth in its application, is confusingly similar to Opposer’s use of its mark, as set forth and protected by Opposer’s above-identified registration.

12. Purchasers of Applicant’s goods and Opposer’s goods are likely to be confused, mistaken or deceived as to the source of the goods. Applicant’s mark, in association with the

products identified in the trademark application, is likely to cause confusion, mistake or deception when compared to Opposer's mark.

13. Applicant's mark, ADD-IT, and the registered mark, ADDID, are highly similar in appearance.

14. Applicant's mark, ADD-IT, and the registered mark, ADDID, are phonetic equivalents.

15. Applicant's mark and the registered mark share the first letters "ADD" in common.

16. Each mark contains five letters and each mark begins with the letters "ADD."

17. The first four letters in both marks are "ADD" and "I."

18. Applicant's mark and Opposer's mark are similar in sound and appearance such that when used on highly similar goods there is a likelihood of confusion, mistake or deception.

19. Applicant's goods and Registrant's goods are highly similar so that there would be a likelihood of such confusion, mistake or deception.

20. Applicant's goods, in part, are paint additives.

21. Registrant's goods, in part, are paints and chemical additives for use in the manufacture of paints.

22. Applicant and Opposer use their respective marks in the same or similar fields of use thereby exacerbating the likelihood of confusion regarding the marks and the likelihood of confusion as to sponsorship or affiliation.

23. If Applicant is permitted to register its mark, ADD-IT, and uses the ADD-IT mark for the goods specified in the application, confusion in the trade resulting in damage and injury

to Opposer would be caused and would result by reason of the similarity between Applicant's mark and Opposer's mark.

24. Persons familiar with Opposer's mark would be likely to confuse Applicant's goods as a product made, sold, or sponsored by Opposer. Any such confusion in the trade would inevitably result in loss of sales to Opposer.

25. In addition to the harm identified in the preceding paragraphs, any defect, objection or fault found with Applicant's products marketed under the ADD-IT mark would necessarily reflect badly upon and significantly injure the reputation which Opposer has established for its products.

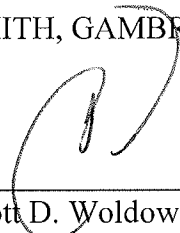
26. Current printouts of information from the electronic database records of the United States Patent and Trademark Office showing the current status and title of Opposer's Trademark Registration are attached hereto as Exhibit A and are properly made part of the record.

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's mark, and prays that registration be denied.

Please charge Deposit Account No. 02-4300 for any additional fees that may be required.

Respectfully submitted,

SMITH, GAMBRELL & RUSSELL, LLP



Scott D. Woldow
Attorney for Opposer
1130 Connecticut Avenue, N.W., Suite 1130
Washington, DC 20036
Telephone: (202) 263-4300
Facsimile: (202) 263-4329
Email: sdwoldow@sgrlaw.com

EXHIBIT A



United States Patent and Trademark Office

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Trademarks > Trademark Electronic Search System (TESS)

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Typed Drawing

Word Mark ADDID

Goods and Services IC 001. US 001 005 006 010 026 046. G & S: chemical products, namely, organosilicon compounds for use in the fields of agriculture, horticulture and forestry; artificial unprocessed resins used in the lacquer and paint industry, the aerospace, automotive engineering, [electrical engineering, electronics], transmission and distribution industries, [mechanical engineering], chemical [and food] processing, construction, [textiles, paper, rubber and plastics, cable, medicine and pharmaceuticals, polishes and cosmetics] industries; unprocessed plastics used in the lacquer and paint industry, the aerospace, automotive engineering, [electrical engineering,] electronics, transmission and distribution industries, mechanical engineering,[chemical and food processing], construction, [textiles, paper, rubber and plastics, cable, medicine and pharmaceuticals, polishes and cosmetics] industries; chemical additives for use in the manufacture of plastics and chemicals, namely, silanes, organosilanes, silicic acid esters, polysilanes, polysilazanes, silicones, silicone oils, silicone resins and silicone greases, silicone plasters and silicone elastomers for general purposes and chemical additives for use in the manufacture of lacquers and paints

IC 002. US 006 011 016. G & S: paints, varnishes, lacquers in the nature of a coating, wood preservatives and anti-rust oils; color pigments, paint thinners, bactericidal paints, and lacquers in the nature of a coating for electrical and electronic parts and components

IC 017. US 001 005 012 013 035 050. G & S: insulating paints for insulating purposes,[and general purpose silicone rubber sealant]

Mark Drawing Code (1) TYPED DRAWING
Serial Number 75058465
Filing Date February 15, 1996
Current Basis 44E
Original 1B;44E

Filing Basis

Published for Opposition July 8, 1997

Registration Number 2113440

Registration Date November 18, 1997

Owner (REGISTRANT) WACKER-CHEMIE GmbH LIMITED LIABILITY COMPANY FED REP GERMANY
Hanns-Seidel-Platz 4 D-81737 Munich FED REP GERMANY

(LAST LISTED OWNER) EVONIK TEGO CHEMIE GMBH LIMITED LIABILITY COMPANY FED REP GERMANY
GOLDSCHMIDTSTRASSE 100 45127 ESSEN FED REP GERMANY

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record STEWART J BELLUS

Type of Mark TRADEMARK

Register PRINCIPAL

Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20070428.

Renewal 1ST RENEWAL 20070428

Live/Dead Indicator LIVE

TESS HOME	NEW USER	STRUCTURED	FREE FORM	BROWSE DICT	SEARCH OG	TOP	HELP	PREV LIST	CURR LIST
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Mark: ADDID

US Serial Number: 75058465

Application Filing Date: Feb. 15, 1996

US Registration Number: 2113440

Registration Date: Nov. 18, 1997

Register: Principal

Mark Type: Trademark

Status: The registration has been renewed.

Status Date: Apr. 28, 2007

Publication Date: Jul. 08, 1997

Mark Information

Mark Literal Elements: ADDID

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Foreign Information

Foreign Registration Number: 2086721

Foreign Registration Date: Dec. 09, 1994

Foreign Application/Registration Country: GERMANY

Foreign Expiration Date: Aug. 31, 2004

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks *...* identify additional (new) wording in the goods/services.

For: chemical products, namely, organosilicon compounds for use in the fields of agriculture, horticulture and forestry; artificial unprocessed resins used in the lacquer and paint industry, the aerospace, automotive engineering, [electrical engineering, electronics], transmission and distribution industries, [mechanical engineering], chemical [and food] processing, construction, [textiles, paper, rubber and plastics, cable, medicine and pharmaceuticals, polishes and cosmetics] industries; unprocessed plastics used in the lacquer and paint industry, the aerospace, automotive engineering, [electrical engineering,] electronics, transmission and distribution industries, mechanical engineering, [chemical and food processing], construction, [textiles, paper, rubber and plastics, cable, medicine and pharmaceuticals, polishes and cosmetics] industries; chemical additives for use in the manufacture of plastics and chemicals, namely, silanes, organosilanes, silicic acid esters, polysilanes, polysilazanes, silicones, silicone oils, silicone resins and silicone greases, silicone plasters and silicone elastomers for general purposes and chemical additives for use in the manufacture of lacquers and paints

International Class(es): 001 - Primary Class

U.S Class(es): 001, 005, 006, 010, 026, 046

Class Status: ACTIVE

Basis: 44(e)

For: paints, varnishes, lacquers in the nature of a coating, wood preservatives and anti-rust oils; color pigments, paint thinners, bactericidal paints, and lacquers in the nature of a coating for electrical and electronic parts and components

International Class(es): 002 - Primary Class

U.S Class(es): 006, 011, 016

Class Status: ACTIVE

Basis: 44(e)

For: insulating paints for insulating purposes, [and general purpose silicone rubber sealant]

International Class(es): 017 - Primary Class

U.S Class(es): 001, 005, 012, 013, 035, 050

Class Status: ACTIVE

Basis: 44(e)

Basis Information (Case Level)

Filed Use: No	Currently Use: No	Amended Use: No
Filed ITU: Yes	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: Yes	Currently 44E: Yes	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: EVONIK TEGO CHEMIE GMBH
Owner Address: GOLDSCHMIDTSTRASSE 100
45127 ESSEN
GERMANY
Legal Entity Type: LIMITED LIABILITY COMPANY
State or Country Where Organized: GERMANY

Attorney/Correspondence Information

Attorney of Record

Attorney Name: STEWART J BELLUS

Correspondent

Correspondent Name/Address: STEWART J BELLUS
COLLARD & ROE PC
1077 NORTHERN BLVD
ROSLYN, NEW YORK 11576
UNITED STATES

Domestic Representative

Domestic Representative Name: STEWART J. BELLUS

Phone: 5163659802

Fax: 5163659805

Prosecution History

Date	Description	Proceeding Number
Apr. 13, 2011	CASE FILE IN TICRS	
Apr. 08, 2011	CASE FILE IN TICRS	
Aug. 26, 2009	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Aug. 19, 2009	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Apr. 28, 2007	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	69471
Apr. 28, 2007	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Apr. 27, 2007	ASSIGNED TO PARALEGAL	69471
Mar. 29, 2007	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	
Mar. 29, 2007	TEAS SECTION 8 & 9 RECEIVED	
Oct. 25, 2004	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	
Jul. 13, 2004	POST REGISTRATION ACTION MAILED - SEC. 8 & 15	
Apr. 01, 2003	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	
Apr. 01, 2003	PAPER RECEIVED	
Nov. 18, 1997	REGISTERED-PRINCIPAL REGISTER	
Oct. 09, 1997	Sec. 1(B) CLAIM DELETED	73797
Oct. 09, 1997	NOTICE OF ALLOWANCE CANCELLED	
Sep. 30, 1997	NOA MAILED - SOU REQUIRED FROM APPLICANT	
Jul. 08, 1997	PUBLISHED FOR OPPOSITION	
Jun. 06, 1997	NOTICE OF PUBLICATION	
May 05, 1997	APPROVED FOR PUB - PRINCIPAL REGISTER	
Feb. 10, 1997	CORRESPONDENCE RECEIVED IN LAW OFFICE	

Aug. 06, 1996 NON-FINAL ACTION MAILED
Jul. 21, 1996 ASSIGNED TO EXAMINER

72150

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

Renewal Date: Nov. 18, 2007

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: SCANNING ON DEMAND

Date in Location: Apr. 13, 2011

Assignment Abstract Of Title Information

Summary

Total Assignments: 2

Registrant: WACKER-CHEMIE GmbH

Assignment 1 of 2

Conveyance: ASSIGNS THE ENTIRE INTEREST

Reel/Frame: 3038/0023

Pages: 4

Date Recorded: Mar. 03, 2005

Supporting Documents: assignment-tm-3038-0023.pdf

Assignor

Name: WACKER-CHEMIE GMBH

Execution Date: Feb. 18, 2005

Legal Entity Type: GMBH

State or Country Where Organized: GERMANY

Assignee

Name: TEGO CHEMIE SERVICES GMBH

State or Country Where Organized: GERMANY

Legal Entity Type: GMBH

Address: GOLDSCHMIDTSTRASSE 100
ESSEN, GERMANY 45127

Correspondent

Correspondent Name: MARK L. WHIPKEY

Correspondent Address: 379 INTERPACE PARKWAY
PARSIPPANY, NJ 07054

Domestic Representative - Not Found

Assignment 2 of 2

Conveyance: CHANGE OF NAME

Reel/Frame: 4043/0179

Pages: 3

Date Recorded: Aug. 12, 2009

Supporting Documents: assignment-tm-4043-0179.pdf

Assignor

Name: TEGO CHEMIE SERVICE GMBH

Execution Date: Oct. 16, 2007

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: GERMANY

Assignee

Name: EVONIK TEGO CHEMIE GMBH

State or Country Where Organized: GERMANY

Legal Entity Type: LIMITED LIABILITY COMPANY

Address: GOLDSCHMIDTSTRASSE 100
45127 ESSEN, GERMANY

Correspondent

Correspondent Name: CHRISTINA M. HILLSON, ESQ.

Correspondent Address: P.O. BOX 2207
WILMINGTON, DE 19899

Domestic Representative - Not Found

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

In the Matter of Application Serial No. 85/736164
Published: March 19, 2013


Evonik Tego Chemie GmbH)	
)	
Opposer,)	
)	
v.)	Opposition No. _____
)	
XIM Products, Inc.)	
)	
Applicant.)	

CERTIFICATE OF SERVICE

I, Scott D. Woldow, counsel for Evonik Degussa GmbH, do hereby certify that the **NOTICE OF OPPOSITION** was served upon applicant by placing a copy of same in the U.S. mail, postage prepaid, addressed as follows:

Richard A. Sharpe
Pearne & Gordon, LLP
1801 E 9th St. Ste. 1200
Cleveland, Ohio 44114-3108

This 14th day of May, 2013



Scott D. Woldow