

ESTTA Tracking number: **ESTTA797675**

Filing date: **01/26/2017**

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	Xpel Technologies Corp.		
Entity	Corporation	Citizenship	Nevada
Address	618 W. Sunset Road San Antonio, TX 78216 UNITED STATES		

Attorney information	J. Daniel Harkins Dykema Gossett PLLC 112 E. Pecan Street Suite 1800 San Antonio, TX 78205 UNITED STATES ipdocket@dykema.com, dharkins@dykema.com, swilson@dykema.com Phone:214-554-5500		
----------------------	--	--	--

**Applicant Information**

Application No	87094285	Publication date	12/27/2016
Opposition Filing Date	01/26/2017	Opposition Period Ends	01/26/2017
Applicant	Guangzhou Suizhong Auto Accessories Co., Ltd. No. B109, Yunshangyichengchanyuan, No. 3 Guangzhou, CHINA		

**Goods/Services Affected by Opposition**

Class 017. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Plastic film coating for vehicle paint surfaces; automotive paint protective urethane film
---

**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
Dilution by tarnishment	Trademark Act Sections 2 and 43(c)
Deceptiveness	Trademark Act Section 2(a)
Fraud on the USPTO	In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)

**Mark Cited by Opposer as Basis for Opposition**

U.S. Registration No.	3542360	Application Date	04/08/2008
-----------------------	---------	------------------	------------

Registration Date	12/09/2008	Foreign Priority Date	NONE
Word Mark	XPEL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 017. First use: First Use: 2007/12/00 First Use In Commerce: 2007/12/00 Plastic film for protecting paint and glass; kits containing plastic film for protecting paint and glass		

Attachments	76688462#TMSN.png( bytes ) 2017-01-26 Notice of Opposition-XPPF.pdf(1256065 bytes )
-------------	--

Signature	/Sherri Wilson/
Name	Sherri Wilson
Date	01/26/2017

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

In the Matter of Serial No. 87/094,285  
For the Mark: XPPF  
Published: December 27, 2016

XPEL TECHNOLOGIES CORP.,

Opposer,

v.

GUANGZHOU SUIZHONG AUTO  
ACCESSORIES CO., LTD.,

Applicant.

§  
§  
§  
§  
§  
§  
§  
§  
§  
§

Oppositor No. \_\_\_\_\_

**NOTICE OF OPPOSITION**

Trademark Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1451  
Arlington, VA 22313-1451

Dear Sir/Madam:

Xpel Technologies Corp. (“Opposer”) believes that it will be damaged by the registration of the alleged mark XPPF on the Principal Register for “plastic film coating for vehicle paint surfaces; automotive paint protective urethane film” in U.S. Trademark Application Serial No. 87/094,285, and hereby files its notice of opposition under Section 14 of the Trademark Act of 1946, as amended, 15 U.S.C. § 1063.

The grounds for opposition are as follows:

1. Opposer Xpel Technologies Corp. is a Nevada Corporation, having its business address at 618 W. Sunset Road, San Antonio, Texas 78216.

2. Applicant Guangzhou Suizhong Auto Accessories Co., Ltd. is a Chinese Limited Company, having its address of record at No. B109, Yunshangyichengchanyuan, No. 3, North 2nd Road, Jiangzia, Baiyun, Guangzhou, China.
3. On July 6, 2016, Applicant filed U.S. Trademark Application Serial No. 87/094,285 (the “Opposed Application”).
4. On December 27, 2016, the Opposed Application published in the Official Gazette.
5. The Opposed Application is for the alleged standard character mark XPPF (“Opposed Mark”) in International Class 17 for “plastic film coating for vehicle paint surfaces; automotive paint protective urethane film” (“Applicant’s Goods”).
6. The Applicant filed the Opposed Application to register the mark XPPF under the bona fide intention to use provisions of Section 1(b) of the Trademark Act of 1946, as amended, 15 U.S.C. § 1051.
7. There are no known assignments recorded with the United States Patent and Trademark Office (“USPTO”) or claimed in the Opposed Application.
8. For all asserted grounds and bases, Opposer timely files this Notice of Opposition.
9. Opposer seeks refusal to register the Opposed Mark in whole pursuant to Sections 14 and 18 of the Trademark Act of 1946, as amended, 15 U.S.C. §§ 1063, 1068.
10. Opposer is a manufacturer, distributor and retailer of after-market automotive goods including, but not limited to, automotive paint protection films and headlight protection products, as well as, window film products.
11. Opposer has expended significant time, money, and effort in promoting its XPEL mark and the goods offered under such mark, with the result that the purchasing public has come to know, rely upon and recognize the high quality of the goods that Opposer offers

under the XPEL mark. Indeed, Opposer has exceedingly valuable goodwill established in this mark.

12. Opposer has marketed and distributed its goods and services under the trademark XPEL. Opposer owns the trademark XPEL, U.S. Reg. No. 3,542,360 (depicted below in Figure 1), registered in International Class 17 on the Principal Register of the Federal Trademark Register of the United States (“Opposer’s Registered Mark”).



Figure 1

13. Opposer’s Registered Mark was registered on the Principal Register on December 9, 2008 under U.S. Reg. No. 3,542,360 and was first used in commerce at least as early as December 2007. This mark is incontestable, which pursuant to Lanham Act, 15 U.S.C. § 1115, conclusively establishes both Opposer’s exclusive right to use this mark in commerce and its validity. A copy of its registration is attached hereto as Exhibit A.
14. Opposer’s Registered Mark has been registered for use with plastic film for protecting paint and glass; kits containing plastic film for protecting paint and glass (“Opposer’s Goods”).
15. In addition to the goodwill resulting from Opposer’s Registered Mark, Opposer owns common law trademark rights and associated goodwill in its current Xpel design mark as well as Xpel’s word mark dating back to at least as early as January 1999 based on widespread use of those marks in the after-market automotive and parts industry (“Opposer’s Common-Law Marks”).

16. Opposer’s Registered Mark and Common-Law Marks (collectively, “the Opposer Marks”) are composed and used in such a way that the public associates those marks with Opposer.
17. Opposer owns and operates its website [www.xpel.com](http://www.xpel.com) (“Opposer Website”) that advertises and promotes its XPEL branded goods worldwide. The Opposer Marks are displayed throughout the Opposer Website, including the use of Opposer’s Registered Mark of Figure 1 above on product packaging. Examples of product packaging with Opposer’s Registered Mark are shown below in Figures 2, 3 and 4.



Figure 2



Figure 3



Figure 4

18. Opposer has continuously used the XPEL mark and has not abandoned its use thereof.
19. By virtue of the continuous and substantially exclusive and extensive use in commerce of the XPEL mark and the commercial success of the goods provided under such mark, such mark has come to have significance in the mind of the relevant public as an indicator of goods originating with, sponsored by, or otherwise associated with Opposer, and no other person or entity.

20. Upon information and belief, Applicant is in the business of marketing and selling aftermarket automotive paint protection goods similar to the automotive paint protection film goods sold by Opposer, which bear the mark XPPF shown above that is confusingly similar to Opposer Marks.
21. At least as early as 2014, Applicant (or related entity) was a customer of Opposer and had knowledge of Opposer's use of Opposer's Registered Mark on its after-market automotive goods including, but not limited to, automotive paint protection films and headlight protection products, as well as, window film products.
22. In November 2016, Applicant (or related entity) attended the SEMA Tradeshow in Las Vegas, Nevada and was marketing and selling aftermarket automotive paint protection goods, including the automotive paint protection film similar to those products sold by Opposer, but was marketing them under the trademark "XPPF" which is confusingly similar to the Opposer Marks. The stylized form of the XPPF mark used by Applicant is set forth below in Figures 5 and 6.



**Figure 5**



**Figure 6**

23. Depicted below in Figure 7 is a photo of Applicant's (or a related entity) booth at the 2016 SEMA Tradeshow. As reflected in the photo of the tradeshow booth, Applicant (or related entity) was marketing and selling in the United States automotive paint protection goods and other after-market automotive goods utilizing the XPPF mark, which is confusingly similar to the Opposer Marks under Section 2 of the Trademark Act of 1946, as amended, 15 U.S.C. § 1052(d).



**Figure 7: Photo of Applicant's Booth at 2016 SEMA Tradeshow**

24. Upon information and belief, Applicant owns and operates several websites, including [www.usaxppf.com](http://www.usaxppf.com) ("USA XPPF Website"), which advertise and promote its "XPPF" goods in the United States. The "XPPF" marks are each displayed throughout USA XPPF Website, including the use of "XPPF" mark on product packaging, examples of which are shown below in Figures 11, 12 and 13.



**Figure 11**



**Figure 12**



**Figure 13**

25. Applicant's continued use of the mark XPPF in connection with the marketing and sale of automotive paint protection film goods is confusingly similar to the Opposer's Marks and is likely to confuse the public that the "XPPF" goods are the same or related to Opposer's "XPEL" goods and will cause irreparable damage to Opposer.
26. Applicant's XPPF mark so resembles Opposer's Registered Mark that, when used in connection with Applicant's Goods, there is a strong likelihood that consumer confusion under Section 2 of the Trademark Act of 1946, as amended, 15 U.S.C. § 1052(d). The public is likely to believe that there is some connection, sponsorship, affiliation, or association between the source of Applicant's Goods and that of Opposer.
27. Applicant's Goods are the same or similar to Opposer's Goods and are in the same channels of trade as Opposer's Goods and target the same customers as Opposer's Goods.
28. Applicant's use of the "XPPF" mark in connection with its goods is likely to impede Opposer's ability to market its "XPEL" goods in the after-market automotive and parts industry.
29. Upon information and belief, Applicant's intentionally used a similar mark and product packaging in order to pass off its "XPPF" goods as Opposer's "XPEL" goods and to trade

off the goodwill and reputation of Opposer, thereby misrepresenting the source of the “XPPF” goods.

30. In the current application for registration, Applicant has declared, under penalties provided by 18 U.S.C. § 1001, that it is the owner of the XPPF mark, and that “no other persons ... have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other persons, to cause confusion or mistake, or to deceive.”
31. At the time the representations were made, Applicant knew or should have known that these representations were false. At the time of filing, the Applicant knew of Opposer’s Registered Mark and Opposer’s right to use the similar mark in the United States on the same or similar goods in the same channels of trade and, upon information and belief, Applicant intentionally used a similar mark in order to confuse or deceive the public as to the origin of the Applicant’s Goods. Upon information and belief, Applicant knew at the time of filing this application that its XPPF mark was similar to Opposer Marks and would likely cause confusion or mistake. Upon information and belief, the Applicant has no good-faith basis in seeking its application for registration for the Opposed Mark and filing of the current application is based on fraud.
32. Applicant did not use the mark XPPF in the United States prior to December 2007, the date of first use and the date of first use in commerce in Opposer’s Registered Mark.
33. Opposer is the first and senior user of the mark. Opposer’s use of its XPEL mark long pre-dates Applicant’s use of the XPPF mark. Opposer has continuously used the XPEL mark and has not abandoned its use thereof.

34. Applicant's use of and/or application for the mark XPPF is without Opposer's consent or permission.
35. The business and goodwill of Opposer is or will be damaged if Applicant is permitted to register the mark XPPF because any statutory rights that may be created or maintained due to the registration would be in violation and derogation of the established rights of Opposer.
36. Based on the foregoing, Opposer believes, and in so believing asserts, that its distinctive and famous XPEL mark and the goodwill in its XPEL mark will be diluted under Section 43(c) of the Trademark Act of 1946, as amended, 15 U.S.C. § 1125.
37. For at least the reasons set forth above, the Opposer is or will be damaged by the registration of the Opposed Mark upon the Principal Register and, pursuant to Section 23 of the Trademark Act of 1946, as amended, 15 U.S.C. § 1068, the registration of the Opposed Mark in U.S. Trademark Application 87/094,285 should be refused.

Wherefore, Opposer believes that it is or will be damaged by the registration on the Principal Register of the alleged mark XPPF for "plastic film coating for vehicle paint surfaces; automotive paint protective urethane film" in U.S. Trademark Application 87/094,285 and respectfully requests that this notice of opposition be sustained and the Opposed Mark be refused registration in whole pursuant to Sections 14 and 18 of the Trademark Act of 1946, as amended, 15 U.S.C. §§ 1063, 1068.

The required fee of \$300 is submitted herewith. If any additional fees are required, the Commissioner is hereby authorized to charge any such deficiency to Deposit Account No. 042223.

Dated: January 26, 2017

/J. Daniel Harkins/

J. Daniel Harkins (Texas Bar No. 09008990)  
Pamela B. Huff (Reg. No. 35,901)  
Sherri A. Wilson (Reg. No. 67,907)  
DYKEMA GOSSETT PLLC  
112 E. Pecan Street, Suite 1800  
San Antonio, Texas 78205  
Tel: (210) 554-5500  
Fax: (210) 226-8395  
Email: dharkins@dykema.com  
phuff@dykema.com  
swilson@dykema.com

Attorneys for Opposer  
Xpel Technologies Corp.

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the foregoing Notice of Opposition has been sent to the following by certified U.S. first-class mail, return receipt requested, to the correspondence address for the attorney of record for the Applicant on this the 26 day of January, 2017.

Victor Wu  
Law Office of Victor Wu  
P.O. Box 3188  
Ontario, CA 91761  
victorwutrademark@gmail.com

*Attorney of Record for Applicant*

**/Sherri A. Wilson/**

\_\_\_\_\_  
Sherri A. Wilson

# **EXHIBIT A**

**Int. Cl.: 17**

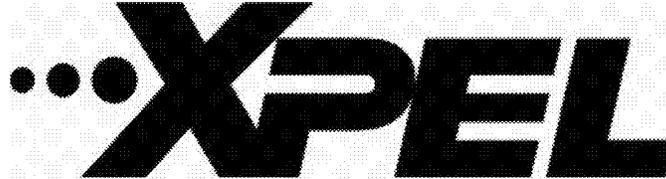
**Prior U.S. Cls.: 1, 5, 12, 13, 35 and 50**

**Reg. No. 3,542,360**

**United States Patent and Trademark Office**

**Registered Dec. 9, 2008**

**TRADEMARK  
PRINCIPAL REGISTER**



XPEL TECHNOLOGIES CORP. (NEVADA CORPORATION)  
13750 SAN PEDRO AVENUE, SUITE 530  
SAN ANTONIO, TX 78232

FIRST USE 12-0-2007; IN COMMERCE 12-0-2007.

OWNER OF U.S. REG. NO. 3,052,131.

FOR: PLASTIC FILM FOR PROTECTING PAINT AND GLASS; KITS CONTAINING PLASTIC FILM FOR PROTECTING PAINT AND GLASS, IN CLASS 17 (U.S. CLS. 1, 5, 12, 13, 35 AND 50).

SER. NO. 76-688,462, FILED 4-8-2008.

THOMAS MANOR, EXAMINING ATTORNEY