

ESTTA Tracking number: **ESTTA1015684**

Filing date: **11/14/2019**

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	THERMA-COTE, INC.
Granted to Date of previous extension	11/16/2019
Address	1369 HERRINGTON ROAD LAWRENCEVILLE, GA 30044 UNITED STATES
Attorney information	LAURA A. KEES, ESQ. WOMBLE BOND DICKINSON (US) LLP POST OFFICE BOX 7037 ATLANTA, GA 30357-0037 UNITED STATES tmdocketing@wbd-us.com, linda.liebl@wbd-us.com 404-872-7000

**Applicant Information**

Application No	79249501	Publication date	09/17/2019
Opposition Filing Date	11/14/2019	Opposition Period Ends	11/16/2019
International Registration No.	1444178	International Registration Date	10/11/2018
Applicant	Sika AG Zugerstrasse 50 CH-6340 Baar SWITZERLAND		

**Goods/Services Affected by Opposition**


Class 001. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Chemical products and unprocessed inorganic products for building façade preparation, being industrial chemicals
Class 002. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Inorganic decorative and protective coatings in the form of paints for buildingfaçades; paints used as primers for building façade
Class 017. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Insulating materials, particularly thermal insulation materials and acoustic insulation materials for façade
Class 019. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Building materials, particularly, ready-to-use inorganic cement, lime and mortar for leveling and repairing and façade coating; façade


coatings, namely, decorative solvent-based and water-based coatings being ready-to-use inorganic cement, lime and mortar; leveling materials, namely, inorganic paste, lime and cement-based mortar in the form of finishing plaster; building pastes for leveling and repairing and facade coating and as a decorative coating in the nature of plasters

## Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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## Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3311719	Application Date	05/25/2005
Registration Date	10/16/2007	Foreign Priority Date	NONE
Word Mark	THERMACOTE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 017. First use: First Use: 1987/11/12 First Use In Commerce: 1987/11/12 Fluid applied ceramic insulating coatings for use as a radiant heat barrier and applied to prepared surfaces of wood, metal, fiberglass, rubber, asphalt shingles, plastic and masonry finishes		

U.S. Registration No.	5200721	Application Date	08/28/2015
Registration Date	05/09/2017	Foreign Priority Date	NONE
Word Mark	THERMACOTE NANO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 017. First use: First Use: 2017/02/17 First Use In Commerce: 2017/02/17 Fluid applied ceramic insulating coatings for residential, commercial, and construction use		

Attachments	78636656#TMSN.png( bytes ) 86740849#TMSN.png( bytes ) Notice of Opposition ThermaCote 2019-11-14.pdf(142341 bytes )
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Signature	/ Jacob S. Wharton /
Name	Jacob S. Wharton
Date	11/14/2019

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

**In the Matter of Trademark Application No. 79/249,501**

Mark : SIKA THERMOCOAT  
Applicant : Sika AG  
Serial No. : 79/249,501  
Filed : Oct. 11, 2018  
Published : Sep. 17, 2019

<b>THERMA-COTE, INC.</b>	)	
	)	
	)	
<b>Opposer,</b>	)	
	)	
v.	)	<b>Opposition No.</b> _____
	)	
<b>SIKA AG,</b>	)	
	)	
<b>Applicant.</b>	)	
	)	
	)	

**NOTICE OF OPPOSITION**

Opposer, Therma-Cote, Inc. (“ThermaCote” or “Opposer”), a Georgia corporation, having a place of business at 1369 Herrington Road, Lawrenceville, Georgia 30044, believes that it will be damaged by the registration of United States Trademark Application Serial No. 79/249,501, filed on October 11, 2018, in the name of Sika AG (hereinafter “Applicant”) for the mark SIKA THERMOCOAT based on use of the mark in connection with goods and services in International Classes 001, 002, 017, 019 as more fully set forth in the application (the “Mark” or “Application”). The Application was published in the *Official Gazette* on September 17, 2019, and after Opposer was properly granted an extension of time to oppose, it hereby opposes the Application. As grounds for the opposition, Opposer alleges:

1. ThermaCote has been in the weather barrier and protective coatings business since 1985. That year, Tommy Sharp Sr. and Thomas Sharp Jr. founded ThermaCote to

manufacturer a durable, energy-saving weather barrier for the construction industry based on years of personal experience installing foam insulation products. During its more than 30 years in business, ThermaCote has become well and favorably known to its customers and consumers for developing new products that add energy efficiency and sustainability to any substrate or structure without polluting the indoor or outdoor environments to which they are applied.

2. Since at least as early as 1985, ThermaCote has continuously used throughout the United States the name ThermaCote to identify itself and its goods and services. In addition to using ThermaCote standing alone since at least as early as 1985, ThermaCote has been adopted as part of several registered marks dating to at least November 1987 such as THERMACOTE and THERMACOTE NANO. THERMACOTE (the “THERMACOTE Mark”) is used and registered in connection with “Fluid applied ceramic insulating coatings for use as a radiant heat barrier and applied to prepared surfaces of wood, metal, fiberglass, rubber, asphalt shingles, plastic and masonry finishes.” THERMACOTE NANO is used and registered in connection with “Fluid applied ceramic insulating coatings for residential, commercial, and construction use.” THERMACOTE and THERMACOTE NANO are collectively referred to herein as the “THERMACOTE Marks.”

3. ThermaCote’s goods and services are supported by substantial advertising and promotion each year.

4. ThermaCote’s products are recognized for being technologically advanced, yet efficient solutions to address energy loss and safety concerns, corrosion problems, and personnel protection, often in highly specific application solutions to fit unique customer requirements.

5. The extensive commercial success of ThermaCote’s products is partially due to decades of extensive advertising and marketing efforts of ThermaCote. ThermaCote has, by

virtue of such extensive usage, advertising, and promotion, as well as a long-standing track record of developing and implementing durable, energy-saving weather barriers, built up a very high level of consumer and trade recognition.

6. ThermaCote also maintains a strong internet presence, through which it markets, advertises, and promotes its products as well as provides access to its customer service. ThermaCote’s website is <www.thermacote.com> which is operational twenty-four hours a day, seven days a week, and prominently displays the THERMACOTE Mark at the top and bottom of every page within the thermacote.com domain, in addition to extensive use of the THERMACOTE Mark throughout those pages as well.

7. In addition to its common law rights in the THERMACOTE Marks, and as mentioned above, Opposer is the owner of several United States trademark registrations, each of which incorporates the THERMACOTE Mark, including the following:

<b>Mark</b>	<b>Reg. No.</b>	<b>Reg. Date</b>	<b>First Use Date</b>	<b>ID of Goods</b>
THERMACOTE	3,311,719	Oct. 16, 2007	Nov. 12, 1987	Fluid applied ceramic insulating coatings for use as a radiant heat barrier and applied to prepared surfaces of wood, metal, fiberglass, rubber, asphalt shingles, plastic and masonry finishes
THERMACOTE NANO	5,200,721	May 9, 2017	Feb. 17, 2017	Fluid applied ceramic insulating coatings for residential, commercial, and construction use

8. Opposer’s registrations for these marks are valid, subsisting, in full force and effect, un-cancelled and unrevoked, and serve as evidence of Opposer’s exclusive right to use such marks in commerce on or in connection with the goods identified in the registrations, as provided by Section 33(a) of the United States Trademark (Lanham) Act, 15 U.S.C. Section 1115(a). Opposer’s registration for THERMACOTE is incontestable pursuant to Section 15 of

the Lanham Act, 15 U.S.C. Section 1065.

9. Use of the THERMACOTE Marks has been continuous and they have not been abandoned. As a result of the long, extensive, and widespread use, advertising, promotion, and registration of the THERMACOTE Marks in association with fluid applied ceramic insulating coatings, consumers are accustomed to associating the THERMACOTE Marks with a single source, that is, ThermaCote.

10. On information and belief, Applicant, Sika AG has an address of: Zugerstrasse 50, CH-6340 Baar Switzerland.

11. Upon information and belief, Applicant filed the Application pursuant to Section 66(a) based on International Registration Number 1444178 (the “International Registration”).

12. Upon information and belief, the International Registration has a registration date of October 11, 2018.

13. Upon information and belief, at the time Applicant filed its application for SIKA THERMOCOAT, it was or should have been fully aware of ThermaCote and the THERMACOTE Marks, as well as ThermaCote’s rights therein, and at a minimum, Applicant had constructive notice of ThermaCote’s prior rights as a result of ThermaCote’s multiple active federal trademark registrations for its THERMACOTE Marks.

14. Applicant’s SIKA THERMOCOAT mark and Opposer’s THERMACOTE Marks differ only by slight spelling differences and the addition of a “housemark” for Sika AG before the prominent use of THERMOCOAT. Therefore, the marks are confusingly similar in sight, sound, and meaning.

15. On information and belief, the goods in connection with which Applicant’s mark is being applied for and the goods in connection with which the THERMACOTE Marks are

registered and/or used are similar, complementary, and/or related.

16. ThermaCote has priority over Applicant because ThermaCote's use and registration dates for ThermaCote's Marks precede Applicant's earliest possible priority date for its Application and/or any alleged date of first use of Applicant's SIKA THERMOCOAT mark.

17. Registration of Applicant's mark, which is the subject of the application-in-opposition, is barred by the provisions of Section 2(d) of the Trademark Act of 1946 because the mark consists of or comprises a mark which resembles the THERMACOTE Marks that have been in use and are the subject of prior registrations in the United States Patent and Trademark Office and common law rights, as to be likely, when used in connection with the goods in the Applicant's Application, to cause confusion, mistake, or deception.

18. Applicant's alleged mark so resembles ThermaCote's previously used and/or registered THERMACOTE Marks as to be likely to cause confusion, to cause mistake, or to deceive with consequent injury to ThermaCote because: (a) persons are likely to believe that the source of Applicant's goods/products is Opposer; or (b) that Applicant's mark or products are in some way legitimately connected or affiliated with, sponsored, approved, endorsed, or licensed by ThermaCote when, in fact, they are not.

19. ThermaCote will be damaged by the issuance of a registration sought by Applicant within the meaning of 15 U.S.C. § 1063 because such registration would support and assist Applicant in the confusing, misleading, and/or deceptive use of Applicant's alleged SIKA THERMOCOAT mark, and would give color of exclusive statutory rights to Applicant in violation and derogation of ThermaCote's prior and superior rights.



WHEREFORE, Opposer prays that this opposition be sustained entirely in its favor, that registration be denied to Applicant on its Application No. 79/249,501, and that the Board grant all further relief to Opposer that is necessary and just under these circumstances.

This the 14th day of November, 2019.

Respectfully submitted,

WOMBLE BOND DICKINSON (US) LLP

*/Jacob S. Wharton /*

Jacob S. Wharton, NCSB No. 37421  
John D. Wooten IV, NCSB No. 51074  
WOMBLE BOND DICKINSON (US) LLP  
One West Fourth Street  
Winston-Salem, NC 27101  
Tel: (336) 747-6609  
Fax: (336) 726-6986  
E-Mail: [Jacob.Wharton@wbd-us.com](mailto:Jacob.Wharton@wbd-us.com)  
[JD.Wooten@wbd-us.com](mailto:JD.Wooten@wbd-us.com)

*Attorneys for Therma-Cote, Inc.*

**CERTIFICATE OF MAILING**

I hereby certify that on November 14, 2019, I filed via electronic means (ESTTA) this NOTICE OF OPPOSITION with the:

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

/Linda T. Liebl/  
Linda T. Liebl

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing NOTICE OF OPPOSITION has been served on Applicant on November 14, 2019, via email, addressed to Applicant's attorney of record:

Michelle L. Visser, Esq.  
FISHMAN STEWART PLLP  
39533 Woodward Ave, Ste 140  
Bloomfield Hills, MI 48304  
tmdocketing@fishstewip.com

/Linda T. Liebl/  
Linda T. Liebl