

ESTTA Tracking number: **ESTTA1073284**

Filing date: **08/06/2020**

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	Mapei S.p.A.		
Entity	Corporation	Citizenship	Italy
Address	VIA CAFIERO 22 MILAN, 20158 ITALY		

Attorney information	JESS M. COLLEN 80 S. HIGHLAND AVE OSSINING, NY 10562 UNITED STATES Primary Email: docket@collenip.com Secondary Email(s): mnesheiwat@collenip.com, jcollen@collenip.com 9149415668		
Docket Number	AX736		

Applicant Information

Application No.	79263306	Publication date	07/07/2020
Opposition Filing Date	08/06/2020	Opposition Period Ends	08/06/2020
International Registration No.	1477851	International Registration Date	06/06/2019
Applicant	Argelith Bodenkeramik H. Bitter GmbH SCHLEDEHAUSER STRAÄ#E 133 49152 BAD ESSEN FED REP GERMANY		

Goods/Services Affected by Opposition

Class 019. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Non-metal building materials, namely, clinker bricks, clinker tiles, facing brick, tile trim, split tiles, strip tiles;ceramic building materials, namely, dry-pressed floorboards, not of metal, building panels, not of metal, floor tiles, not of metal, paving slabs, not of metal, tile flooring, not of metal, none of the aforesaid goods being of glass
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1533801	Application Date	12/24/1987
Registration Date	04/11/1989	Foreign Priority Date	NONE
Word Mark	KERAPOXY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 001. First use: First Use: 1985/12/24 First Use In Commerce: 1985/12/24 SOLID EPOXY FOR SETTING AND GROUTING TILES FOR INDUSTRIAL, COMMERCIAL AND INSTITUTIONAL APPLICATIONS, NAMELY, CERAMIC FLOOR AND WALL TILES, QUARRY TILES, ACID-RESISTANT FLOOR BRICKS AND PAVERS		

U.S. Registration No.	1538742	Application Date	09/26/1988
Registration Date	05/16/1989	Foreign Priority Date	NONE
Word Mark	KERASET		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 001. First use: First Use: 1986/03/23 First Use In Commerce: 1986/03/23 CEMENT GLUE USED FOR FIXTURE OF CERAMICTILES		

U.S. Registration No.	3210579	Application Date	09/28/2005
Registration Date	02/20/2007	Foreign Priority Date	NONE
Word Mark	KERALASTIC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 001. First use: First Use: 1978/00/00 First Use In Commerce: 1978/00/00 Mortar latex additive		

U.S. Registration No.	3217157	Application Date	09/28/2005
Registration Date	03/13/2007	Foreign Priority Date	NONE
Word Mark	KERAFLOR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 019. First use: First Use: 1985/00/00 First Use In Commerce: 1985/00/00 Tile and stone installation mortar		

U.S. Registration No.	3217158	Application Date	09/28/2005
Registration Date	03/13/2007	Foreign Priority	NONE

		Date	
Word Mark	KERACALK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 017. First use: First Use: 1987/00/00 First Use In Commerce: 1987/00/00 Caulk		

U.S. Registration No.	3219593	Application Date	09/28/2005
Registration Date	03/20/2007	Foreign Priority Date	NONE
Word Mark	KERABOND		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 019. First use: First Use: 1978/00/00 First Use In Commerce: 1978/00/00 Mortar		

U.S. Registration No.	3224229	Application Date	09/28/2005
Registration Date	04/03/2007	Foreign Priority Date	NONE
Word Mark	KERACRETE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 017. First use: First Use: 1982/00/00 First Use In Commerce: 1982/00/00 Synthetic latex tile and stone setting adhesive		

U.S. Registration No.	3339353	Application Date	09/28/2005
Registration Date	11/20/2007	Foreign Priority Date	NONE
Word Mark	KERAPLY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 001. First use: First Use: 1985/00/00 First Use In Commerce: 1985/00/00 Latex mortar additive		

U.S. Registration No.	4582143	Application Date	09/28/2005
Registration Date	08/12/2014	Foreign Priority Date	NONE
Word Mark	KERACOLOR		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 019. First use: First Use: 1985/00/00 First Use In Commerce: 1985/00/00 Sanded grout
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Attachments	AX736_Notice of Opposition_200805.pdf(147441 bytes)
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Signature	/Michael Nesheiwat/
Name	Michael Nesheiwat
Date	08/06/2020

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

Applicant : Argelith Bodenkeramik H. Bitter GmbH
Serial No. : 79/263,306
Filed : June 16, 2019
Mark : KERASIG
Published : July 7, 2020

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

NOTICE OF OPPOSITION

The Opposer, MAPEI S.P.A., a società per azioni duly organized and existing under the laws of Italy with a principal place of business located at Via Cafiero 22, Milan, Italy 20158 ("MAPEI" or "Opposer"), through its attorneys, believes that it would be damaged by the registration of the mark shown in the above-identified application, and hereby opposes the same, pursuant to 15 U.S.C. § 1063 and 37 C.F.R. § 2.104.

As grounds for opposition, it is alleged that:

1) MAPEI is and has been engaged in the business of manufacturing, marketing, and selling a variety of construction and building industry related goods in interstate commerce for many years.

2) MAPEI owns the following marks (collectively, the "KERA- Marks") in connection with the goods listed (collectively referred to as "Opposer's Goods"): KERAPOXY for solid epoxy for setting and grouting tiles for industrial, commercial and institutional applications, namely, ceramic floor and wall tiles, quarry tiles, acid-resistant floor bricks and pavers; KERASET for cement glue used for fixture of ceramic tiles; KERALASTIC for mortar

latex additive; KERAFLOOR for tile and stone installation mortar; KERACAULK for caulk; KERABOND for mortar; KERACRETE for synthetic latex tile and stone setting adhesive; KERAPLY for latex mortar additive; and KERACOLOR for sanded grout.

3) MAPEI is also the owner of the following valid and subsisting United States trademark registrations for the KERA- Marks, namely:

- KERAPOXY & Design Reg. No. 1,533,801
- KERASET Reg. No. 1,538,742
- KERALASTIC Reg. No. 3,210,579
- KERAFLOOR Reg. No. 3,217,157
- KERACAULK Reg. No. 3,217,158
- KERABOND Reg. No. 3,219,593
- KERACRETE Reg. No. 3,224,229
- KERAPLY Reg. No. 3,339,353
- KERACOLOR Reg. No. 4,582,143

MAPEI is and has been continuously engaged in the sale and marketing of goods under the registered KERA- Marks since at least as early as 1978.

4) Consumers have come to recognize the distinctive “KERA-” prefix of Opposer’s KERA- Marks as a common characteristic of Opposer’s products, and Opposer has advertised, promoted, and sold products in such a manner as to create a common impression and thereafter recognition among the purchasing public such that this distinctive “KERA-” prefix is itself indicative of a common origin of the goods or services, namely the Opposer. Opposer has developed, at great effort and expense, an exceedingly valuable goodwill with respect to the

KERA- Marks listed above, as well as for its entire “KERA-” family of marks (hereinafter, the “KERA- Family of Marks”), and thus these marks are entitled to the greatest scope of protection.

5) MAPEI has used its KERA- Marks in commerce extensively and has acquired considerable and valuable goodwill and wide scale recognition of its KERA- Marks. The public has come to associate the KERA- Marks with MAPEI and MAPEI’s goods for a variety of products for use in the construction and building industry, including but not limited to, adhesives, sealants and chemical products for construction.

6) MAPEI’s registrations are prima facie proof of ownership and use of the KERA- Marks from the original date of filing of each respective application, pursuant to 15 U.S.C. § 1057(b), and of the exclusive right to use the registered marks in commerce.

7) Argelith Bodenkeramik H. Bitter GmbH (“Applicant”) has applied to register the mark KERASIG (“Applicant’s Mark” or the “KERASIG Mark”) for use in connection with Non-metal building materials, namely, clinker bricks, clinker tiles, facing brick, tile trim, split tiles, strip tiles; ceramic building materials, namely, dry-pressed floorboards, not of metal, building panels, not of metal, floor tiles, not of metal, paving slabs, not of metal, tile flooring, not of metal, none of the aforesaid goods being of glass (“Applicant’s Goods”) in International Class 19. Said application (“Applicant’s Application”) was filed on June 16, 2019 and published for opposition on July 7, 2020.

8) Applicant’s Mark creates a highly similar commercial impression to MAPEI’s KERA- Marks and KERA- Family of Marks due to its incorporation and its manner of use of the KERA- prefix, which is the distinctive and dominant part of Opposer’s KERA- Marks, creating a virtually identical sound and appearance to that of the KERA- Marks and the KERA- Family of Marks.

9) The KERA- prefix is the most prominent component of Applicant's Mark. This additional prominence of the KERA- prefix in Applicant's Mark creates an increased likelihood of confusion between Applicant's Mark and Opposer's KERA- Marks and the KERA- Family of Marks.

10) Registration by Applicant is likely to diminish and dilute the distinctive quality of Opposer's rights in its KERA- Family of Marks in violation of 15 U.S.C. § 1125(c). Moreover, registration by Applicant is likely to diminish the advertising value of the KERA- Family of Marks, and such registration and use is likely to, in the event of any quality problems involving the goods offered by Applicant, tarnish the distinctiveness of MAPEI's KERA- Family of Marks.

11) Opposer has continuously used the KERA- Marks and the KERA- Family of Marks in commerce in the United States well before the filing date of Applicant's Application, and well before the priority date of Applicant's Application.

12) Applicant's Mark and Opposer's KERA- Marks and Opposer's KERA- Family of Marks are applied to identical or highly related goods.

13) On information and belief, Applicant's Goods and Opposer's Goods are likely to be sold through the same or similar channels of distribution.

14) Consumers encountering Applicant's Mark on Applicant's Goods are likely to believe that such goods originate from or are authorized or sponsored by Opposer.

15) Consumers encountering Applicant's Mark on Applicant's Goods are likely to believe that such mark is associated with the KERA- Family of Marks, in view of the similarity between Applicant's Goods and Opposer's Goods, the indistinguishable differences between Applicant's Mark and Opposer's KERA- Marks and the KERA- Family of Marks, and the wide renown of Opposer's KERA- Marks and KERA- Family of Marks.

16) On information and belief, the Applicant has adopted its trademark with full knowledge of MAPEI's KERA- Marks and KERA- Family of Marks.

17) Opposer will be irreparably damaged by registration of Applicant's Mark.

OPPOSER MAPEI S.P.A. prays that this application Serial No. 79/263,306 be refused, that no registration be issued thereon to Applicant and that this Opposition be sustained in favor of Opposer.

Respectfully submitted for
Opposer MAPEI S.P.A.

By: 

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August 6, 2020
JMC/MN

SHOULD ANY OTHER FEE BE REQUIRED, THE PATENT AND TRADEMARK OFFICE IS HEREBY REQUESTED TO CHARGE SUCH FEE TO OUR DEPOSIT ACCOUNT 03-2465.

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING FILED ELECTRONICALLY WITH THE UNITED STATES PATENT AND TRADEMARK OFFICE ON August 6, 2020.

By:  Dated: August 6, 2020