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Filing date: **05/25/2021**

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	Toto Ltd.
Granted to Date of previous extension	06/05/2021
Address	NO. 1-1 NAKASHIMA 2-CHROME KOKURAKITA-KU KITAKYUSHU-SHI, 802-8601 JAPAN
Attorney information	JASON D. JONES FROSS ZELNICK LEHRMAN & ZISSU, P.C. 151 WEST 42ND STREET, 17TH FLOOR NEW YORK, NY 10036 UNITED STATES Primary Email: jjones@fzlz.com Secondary Email(s): dnuzzaci@fzlz.com, ttabfiling@fzlz.com 212-813-5900
Docket Number	TLTD 2106402

Applicant Information

Application No.	90225047	Publication date	04/06/2021
Opposition Filing Date	05/25/2021	Opposition Period Ends	06/05/2021
Applicant	XU ZENING 1501, TOWER B, BLDG 2, HECHENGSHIJIMINGYUAN NO.118, WUHE AV. SOUTH, LONGGANG DIST., SHENZHEN, GUANGDONG, 518000 CHINA		


Goods/Services Affected by Opposition

Class 011. First Use: 2020/09/14 First Use In Commerce: 2020/09/14
All goods and services in the class are opposed, namely: Humidifiers; Lamps; Rotisseries; Anti-splash tap nozzles; Bath tubs; Baths, bathtubs, whirlpool baths and bath installations; Desk lamps; Electric footwarmers in the nature of footmuffs; Electrically heated clothing; Heaters, electric, for feeding bottles; Heating pads, electric, not for medical purposes; Heating systems composed primarily of tubes, pipes and manifolds through which warm or high temperature water circulates; Hot water bottles; Lamp glasses; Refrigerating cabinets; Socks, electrically heated; USB-powered hand warmers; Water filtering apparatus; Air diffusers being parts of refrigerators; Barbecue grills; Electric grills; Electric air deodorizers; Hot water heating installations; Portable foot baths; Water filtering devices, namely, water purification installations for waste water and sewage consisting of curtains and textile fabrics

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
No use of mark in commerce before application or amendment to allege use was filed	Trademark Act Sections 1(a) and (c)
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.	3405304	Application Date	03/04/2005
Registration Date	04/01/2008	Foreign Priority Date	NONE
Word Mark	TOTO		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 001. First use: First Use: 0 First Use In Commerce: 0 [(BASED ON FOREIGN REG #1741315)ANTI-TARNISHING CHEMICALS FOR VEHICLE WINDOWS]</p> <p>Class 002. First use: First Use: 0 First Use In Commerce: 0 (BASED ON FOREIGN REG #4042553)[CLEAR AND PIGMENTED COATINGS USED IN THE NATUREOF PAINTS,] PAINTS [; COATINGS IN THE NATURE OF AUTOMOBILE FINISHING]</p> <p>Class 006. First use: First Use: 0 First Use In Commerce: 0 (BASED ON FOREIGN REG #4360259)HAND RAILS OF METAL; METAL PIPES</p> <p>Class 007. First use: First Use: 0 First Use In Commerce: 0 (BASED ON FOREIGN REG #1408448)MACHINE PARTS, NAMELY, ELECTROSTATIC CHUCKS FOR USE IN THE PRODUCTION OF SEMICONDUCTOR WAFERS; [DISHWASHERS, GARBAGE DISPOSALS, DISPOSAL SYSTEM FOR WASTE CONSISTING OF DISPOSERS, DRAIN PIPES AND DRAINAGE TREATMENT EQUIPMENT, NAMELY, WASTEWATER PURIFICATIONS MACHINES USED FOR COMPLEX HOUSING, DRAINAGE TREATMENT EQUIPMENT, NAMELY, WASTEWATER PURIFICATION MACHINES, HOT-WATER HEATERS; MACHINE PARTS, NAMELY, CLACK VALVES AND VALVES; REGULATORS BEINGPARTS OF MACHINES, NAMELY, FEED WATER REGULATORS;] SEMICONDUCTOR MANUFACTURING MACHINES AND STRUCTURAL PARTS AND ACCESSORIES THEREFOR, LIQUID CRYSTAL MANUFACTURING MACHINES AND STRUCTURAL PARTS AND ACCESSORIES THEREFOR[; METAL MACHINE PARTS, NAMELY, PIPE</p>		

	<p>HOLDERS; HARD DISK DRIVE MANUFACTURING MACHINES]</p> <p>Class 009. First use: First Use: 0 First Use In Commerce: 0 [(BASED ON FOREIGN REG #1027893) MEASURING APPARATUS AND INSTRUMENTS AND THEIR PARTS AND ACCESSORIES, NAMELY, HIGH-PRECISION LARGE-SIZE STRAIGHT EDGES, SURFACE PLATES, NAMELY, CERAMIC SURFACE PLATES FOR PROVIDING AN ACCURATE REFERENCE PLANE FOR WORK INSPECTION AND FOR WORK LAYOUT AND T-SQUARES; DRAFTING SQUARES, GUIDE SHAFTS FOR COORDINATE MEASURING MACHINES, AND PORTABLE STRAIGHTNESS TESTERS;] CONNECTORS FOR OPTICAL FIBER CABLES AND THEIR COMPONENT PARTS, OPTICAL FIBER CABLES AND THEIR COMPONENT PARTS</p> <p>Class 011. First use: First Use: 0 First Use In Commerce: 0 (BASED ON FOREIGN REG #998594) WATER CLOSETS, [GAS WATER HEATERS,] ELECTRIC HOT AIR HAND DRYER FOR WASHROOMS, [ELECTRIC APPARATUS FOR BATHROOM FOR HEATING, DRYING AND VENTILATING, NAMELY, AIR-CONDITIONING MACHINES INSTALLED ONTO BATHROOM CEILINGS, WATER PURIFYING APPARATUS, SOLAR WATER HEATERS;] ACCESSORIES FOR BATHTUBS AND BATHROOM, NAMELY, SHOWERS; PLUMBING AND BATHROOM FITTINGS, NAMELY, BALL TAPS FOR USE WITH WATER CLOSET TANK, LEVEL CONTROLLING VALVES IN TANKS, [WATER TREATMENT TANKS FOR HOUSEHOLD PURPOSES,] AUTOMATICALLY FLUSHING APPARATUS FOR TOILETS ACTIVATED BY A SENSOR CONSISTING OF SENSORS, FLUSHOMETERS AND CONTROLLERS, AERATORS IN THE NATURE OF BUBBLE MAKERS FIXED TO FAUCETS; PLUMBING FITTINGS, NAMELY, SAFETY VALVES, DECOMPRESSION VALVES, WATER STOPPING VALVES, [AUTOMATIC SEAT TOILET PAPER DISPENSER,] AUTOMATIC WASH-HAND BOWLS, WASH-HAND BASINS, [SHOWER BOOTH, GAS BURNER,] FLUSH VALVES, [SHOWER PANS, LAMPS;] PLUMBING FITTINGS, NAMELY, PLASTIC DRAIN TRAPS AND VALVES; INFLOW AND OUTFLOW PLUMBING FITTINGS, NAMELY, PLASTIC WATER PIPE VALVES; PLUMBING FITTINGS, NAMELY, DRAIN COCKS</p> <p>Class 019. First use: First Use: 0 First Use In Commerce: 0 [(BASED ON FOREIGN REG #1413992) TILES, NOT OF METAL]</p> <p>Class 035. First use: First Use: 0 First Use In Commerce: 0 [(BASED ON FOREIGN REG #3044724) ADVERTISING AGENCY SERVICES; PLANNING AND CONDUCTING EXHIBITIONS FOR COMMERCIAL OR ADVERTISING PURPOSES; PROVISION OF BUSINESS INFORMATION OF INSTALLATIONS FOR KITCHENS, BATHS, TOILETS VIA INTERNET]</p> <p>Class 042. First use: First Use: 0 First Use In Commerce: 0 [(BASED ON FOREIGN REG #3005051) ENGINEERING]</p>
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Attachments	78580607#TMSN.png(bytes) Notice of Opposition GUEATOTO.PDF(20809 bytes)
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Signature	/Jason D. Jones/
Name	Jason D. Jones
Date	05/25/2021

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

TOTO LTD.,

Opposer,

-against-

XU ZENING,

Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

Opposer Toto Ltd. (“Opposer”) believes that it will be damaged by the issuance of a registration to Applicant Xu Zening (“Applicant”) for the mark GUEATOTO as applied for in U.S. Trademark Application Serial No. 90/225,047, and therefore opposes the same. As grounds for this opposition, Opposer alleges as follows:

FACTS

1. Opposer is a Japanese corporation located and doing business at No. 1-1 Nakashima 2-chrome Kokurakita-ku, Kitakyushu-shi, Japan.
2. Opposer is the owner of U.S. Trademark Reg. No. 3,405,304, issued April 1, 2008, for the mark TOTO and Design (“Opposer’s Mark”) for, *inter alia*, “water closets, electric hot air hand dryer for washrooms, accessories for bathtubs and bathroom, namely, showers; plumbing and bathroom fittings, namely, ball taps for use with water closet tank, level controlling valves in tanks, automatically flushing apparatus for toilets activated by a sensor consisting of sensors, flushometers and controllers, aerators in the nature of bubble makers fixed to faucets; plumbing fittings, namely, safety valves, decompression valves, water stopping valves, automatic wash-hand bowls, wash-hand basins, flush valves, plumbing fittings, namely, plastic drain traps and valves;

inflow and outflow plumbing fittings, namely, plastic water pipe valves; plumbing fittings, namely drain cocks” in International Class 11.

3. The above registration is valid, subsisting, and in full effect. Moreover, the registration has become incontestable pursuant to Section 15 of the Lanham Act, 15 U.S.C. § 1065, and thus constitutes conclusive evidence of the validity of the mark, of Opposer’s ownership of the mark, and of Opposer’s exclusive right to use the mark in connection with the goods identified in the registration. *See* 15 U.S.C. § 1115(b). Opposer’s trademark registration also place others, including Applicant, on constructive notice of its rights. *See* 15 U.S.C. § 1072.

4. According to the records of the U.S. Patent and Trademark Office (“USPTO”), Applicant is an individual of Chinese citizenship residing at 1501 Tower B, Building 2, Hecheng Shijimingyuan, No. 118, Wuhe Avenue South, Longgang District, Shenzhen, Guangdong 518000, China.

5. According to the records of the USPTO, on September 30, 2020, Applicant filed U.S. Trademark Application Serial No. 90/225,047 (the “Application”) to register the mark GUEATOTO (“Applicant’s Mark”) for “Humidifiers; Lamps; Rotisseries; Anti-splash tap nozzles; Bath tubs; Baths, bathtubs, whirlpool baths and bath installations; Desk lamps; Electric footwarmers in the nature of footmuffs; Electrically heated clothing; Heaters, electric, for feeding bottles; Heating pads, electric, not for medical purposes; Heating systems composed primarily of tubes, pipes and manifolds through which warm or high temperature water circulates; Hot water bottles; Lamp glasses; Refrigerating cabinets; Socks, electrically heated; USB-powered hand warmers; Water filtering apparatus; Air diffusers being parts of refrigerators; Barbecue grills; Electric grills; Electric air deodorizers; Hot water heating installations; Portable foot baths; Water filtering devices, namely, water purification installations for waste water and sewage consisting of

curtains and textile fabrics” in International Class 11, based on an alleged first use in commerce date of September 14, 2020, under Section 1(a) of the Lanham Act, 15 U.S.C. § 1051(a).

6. Opposer is the owner of all right, title, and interest in and to Opposer’s Mark.

7. Applicant is not connected to Opposer in any way, and Applicant has not been authorized by Opposer to register or use Applicant’s Mark.

8. Upon information and belief, at the time Applicant adopted Applicant’s Mark, Applicant had actual knowledge of Opposer’s prior rights in Opposer’s Mark.

9. The earliest date upon which Applicant can rely in support of Applicant’s Mark is long after the use of, registration of, and acquisition of rights in Opposer’s Mark by Opposer. As such, Opposer’s rights in Opposer’s Mark are prior and superior to any rights Applicant may claim in Applicant’s Mark. The registration of Applicant’s Mark is inconsistent with Opposer’s prior rights, statutory grant of exclusivity of use, and will substantially damage Opposer’s investment and goodwill in Opposer’s Mark.

10. Accordingly, Opposer is entitled to bring this statutory cause of action and has standing to assert the claims set forth herein.

**FIRST GROUND FOR RELIEF:
PRIORITY AND LIKELIHOOD OF CONFUSION UNDER 15 U.S.C. § 1052(d)**

11. Opposer repeats the allegations contained in Paragraphs 1 through 10 above as if fully set forth herein.

12. The Application filing date and the first use in commerce date alleged therein are subsequent to Opposer’s acquisition of rights in Opposer’s Mark in the United States. Accordingly, Opposer’s rights in Opposer’s Mark are prior and superior to any rights Applicant may claim in Applicant’s Mark.

13. Applicant's Mark is highly similar to Opposer's Mark in sight, sound, and overall commercial impression.

14. The goods identified in the Application are highly related and/or identical to the goods in International Class 11 covered by the registration for Opposer's Mark and to the goods that Opposer has long offered under Opposer's Mark. Upon information and belief, the goods offered under Applicant's Mark are or will be sold to the same customers and through the same channels of trade as goods offered under Opposer's Mark.

15. Based on Opposer's prior rights in Opposer's Mark, the similarity of the parties' marks, the relatedness of the parties' respective goods, and the overlapping consumers and trade channels, consumers are likely to falsely believe that the goods offered by Applicant under Applicant's Mark originate from or are otherwise associated with Opposer, or that there is some relationship between Applicant and Opposer or the goods of Applicant and Opposer, all to Opposer's injury and harm.

16. As a result of the foregoing, registration of Applicant's Mark as applied for in the Application is likely to cause confusion, to cause mistake, or to deceive the public into the false belief that the goods offered by Applicant under Applicant's Mark come from or are otherwise sponsored by or connected with Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

17. By reason of the foregoing, Opposer is likely to be harmed by the registration of the Application for Applicant's Mark.

**SECOND GROUND FOR RELIEF:
VOID AB INITIO FOR NON-USE UNDER 15 U.S.C. § 1051(a)**

18. Opposer repeats the allegations contained in Paragraphs 1 through 10 above as if fully set forth herein.

19. Upon information and belief, the specimen submitted by Applicant with the Application is digitally created and/or altered and, in fact, Applicant's Mark was not in use in commerce in connection with the goods listed in the Application at the time Applicant filed the Application under Section 1(a) of the Lanham Act, 15 U.S.C. § 1051(a).

20. Upon information and belief, Applicant's Mark is not presently being used in U.S. commerce in connection with any of the goods identified in the Application.

21. Because Applicant's Mark was not in use in commerce in connection with the goods identified in the Application on or before the filing date of the Application, the Application is *void ab initio* under Section 1(a) of the Lanham Act, 15 U.S.C. § 1051(a).

22. By reason of the foregoing, Opposer is likely to be harmed by the registration of the Application for Applicant's Mark.

**THIRD GROUND FOR RELIEF:
FRAUD BASED ON FALSE DECLARATION OF USE**

23. Opposer repeats the allegations contained in Paragraphs 1 through 10 above as if fully set forth herein.

24. Contemporaneously with its filing of the Application, Applicant submitted a Declaration that states, *inter alia*, Applicant's Mark "is in use in commerce and was in use in commerce as of the filing date of the application on or in connection with the goods/services in the application."

25. Based upon Opposer's investigation, the specimen submitted with the Application is digitally created and/or altered and, in fact, Applicant's Mark was not in use in commerce in connection with the goods identified in the Application at the time Applicant filed the Application under Section 1(a) of the Lanham Act, 15 U.S.C. § 1051(a).

26. Because, upon information and belief and based on Opposer's investigation, Applicant was not using Applicant's Mark in commerce in connection with the goods identified in the Application at the time Applicant filed the Application under Section 1(a) of the Lanham Act, 15 U.S.C. § 1051(a), the Declaration submitted in support of the Application was false.

27. Upon information and belief, Applicant knew at the time it filed the Application that the specimen submitted in support thereof was digitally created and/or altered, that it was not using Applicant's Mark in commerce in connection with the goods identified in the Application, and that the Declaration submitted in support of the Application was false.

28. Upon information and belief, Applicant intended to deceive the USPTO by falsely asserting that it was using Applicant's Mark in commerce in connection with the goods identified in the Application as of the filing date of the Application. Upon information and belief, Applicant's false statement—and digitally created or altered specimen—were made for the purpose of obtaining a registration to which Applicant is not entitled.

29. The USPTO would not have approved the Application for registration but for the false statement that Applicant was using Applicant's Mark in commerce in connection with the goods identified in the Application as of the filing date. Thus, the falsehood was a material misstatement of fact.

30. As a result of Applicant's willful and materially false statement made in connection with the Application, Applicant has committed fraud against the USPTO, which invalidates the Application.

31. By reason of the foregoing, Opposer is likely to be harmed by the registration of the Application for Applicant's Mark.

