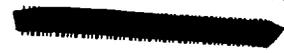


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of application Serial No. 75/662,006
For the Trademark ORALMAX & design
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GILLETTE CANADA COMPANY)
dba ORAL-B LABORATORIES,)
Opposer,)
v.)
ROBIN RESEARCH LABORATORIES, INC.)
Applicant.)

Opposition No. 124,984

OPPOSER'S BRIEF IN SUPPORT OF OPPOSITION

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4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*
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I. INTRODUCTION

Opposer, Gillette Canada Company, which does business under the name Oral-B Laboratories ("Oral-B" or "Opposer"), seeks to enforce its rights in its famous ORAL-B trademark and trade name, which it uses in connection with preventive dentistry products, including toothbrushes (manual and electric), dental floss, interdental products, specialty toothpastes and mouth rinses. ORAL-B is by far the leading brand for manual toothbrushes and the ORAL-B mark is one of the most famous marks in this country. Oral-B submits this brief in support of its Opposition to the proposed registration of ORALMAX and design as a trademark for electric toothbrush and dental flossing units.

II. PROCEEDINGS HEREIN

Oral-B submitted the testimony of and numerous exhibits identified by Heather Gregg, who has been a marketing director with Oral-B for four years and has held a number of other positions within Opposer's parent company, The Gillette Company. Opposer has also submitted a Notice of Reliance on eight federal registrations of ORAL-B trademarks, which it owns and on which it relies in this proceeding.

III. STATEMENT OF FACTS

A. Use of ORAL-B by Opposer

Opposer has a long history of use of the ORAL-B trademark. Opposer, and its predecessors in interest, have used the mark since at least as early as 1949. *See* U.S. Reg. No. 547,130 (attached to Opposer's Notice of Reliance). Oral-B is, by far, the market leader in both the manual and electric toothbrush segments, with a 37 percent share of the power toothbrush market and a 30 percent share of the manual toothbrush market. (Deposition of Heather Gregg ("Gregg Dep.") at 21-22.)

Oral-B's product line is broad. It includes manual and electric toothbrushes, dental floss and tape, toothpaste, specialty brushes (such as sulcus, orthodontic or interdental brushes), and professional products such as fluoride treatments and prophy angles. (*Id.* at 6-10; Exs. 1, 17.) Nearly every Oral-B product is paired with a sub-brand to form compound identifiers such as ORAL-B STAGES, ORAL-B ADVANTAGE or ORAL-B HUMMINGBIRD. (*Id.*)

The preeminence of Oral-B's position in the toothbrush market is indisputable. As mentioned above, ORAL-B toothbrushes hold a market share of 37 percent of the power toothbrush market, and 30 percent of the manual toothbrush market. Oral-B's next closest competitors hold shares of 29 percent of the power market and 19 percent in the manual market. (*Id.* at 21-22.) Oral-B's total U.S. sales in 2003 were 461 million dollars, with 252 million dollars in manual toothbrush sales and the remaining 209 million dollars in power toothbrush sales. (*Id.* at 23.) Oral-B's sales have been steadily growing in recent years. (*Id.* at 24.)

Oral-B's dominance of the toothbrush market has resulted, in large part, from Oral-B's efforts at building brand recognition through aggressive advertising and promotion. Oral-B spent more than 60 million dollars in advertising, promotion and public relations in 2003. (*Id.* at 10, 14.) Oral-B devotes between 75 to 80 percent of its 46.7 dollar million advertising budget to television advertising with national reach, with ads appearing on such popular prime time shows as *Everybody Loves Raymond*, *Friends*, *West Wing* and *Survivor*. (*Id.* at 10-11.; Exs. 3-8) The remaining advertising expenditures are on national print advertising in such well-known publications as *People*, *Cosmopolitan* and *Redbook*. (*Id.* at 11.) Both Oral-B's television and print campaigns reach between 70 and 80 percent of its target market, consumers aged 18 to 54. (*Id.* at 11-12, 14.) Oral-B also promotes its products through promotion to dental professionals, through point of sale displays that are provided to retailers and through freestanding inserts (FSIs) in the Sunday newspapers. (*Id.* at 14-18; Exs. 9-12.) Each FSI typically reaches more

than 40 million households. (*Id.* at 16; Exs. 9-11.) Oral-B promotes consumer awareness by promoting its products to dental professionals, who, in turn, recommend them to their patients. (*Id.* at 17-18; Ex. 12.)

The end result of Oral-B's extensive advertising and promotion efforts is an extremely high brand awareness among consumers with respect to the ORAL-B brand. 95 percent of consumers are aware of the ORAL-B brand in general, and 73 percent of consumers are aware of ORAL-B as a power toothbrush brand. (*Id.* at 18-20; Exs. 13, 14.) This brand awareness rate is higher than any competitor in the manual or power toothbrush categories. (*Id.*) 76 percent of U.S. consumers have tried ORAL-B manual toothbrush products, a higher trial rate than for any other competitor in the manual toothbrush category. (*Id.*)

Oral-B is such a well-known brand that it has been the subject of features in the press that were unsolicited by Oral-B public relations efforts. (*Id.* at 24-25.) For example, in August of 2002, The New York Times approached Oral-B for its input on an article it planned to publish about the redesign of the look of Oral-B's classic INDICATOR toothbrush. (*Id.*) It is highly unusual to get this kind of press coverage for oral care products without paying for it. (*Id.*) The fame of the ORAL-B trademark is also readily apparent in its appearance in crossword puzzles in *The New York Times* and *The Wall Street Journal* as the answer to the clues "big name in brushwork" and "toothbrush brand." (*Id.* at 25-26; Exs. 19, 20.)

ORAL-B is a federally registered, incontestable trademark. (Opposer's Notice of Reliance.)

B. Use By Applicant

Applicant seeks to register ORALMAX & design as a trademark for electric toothbrush and dental flossing units. Its application claims a first use in commerce of September 11, 1997, which is clearly subsequent to Opposer's first use in commerce. Applicant failed to respond to

document requests and interrogatories and did not present any testimony in this case, so we do not have any information on how the Applicant is using its trademark, except the information shown on its Internet web site, www.oralmax.com. (See Opposer's Motion to Compel Responses to Discovery Requests, filed October 15, 2002; Gregg Dep. at 26-27; Ex. 21.) The application shows the mark with ORAL in white letters on a blue background with the word MAX in blue letters on a white background. (See drawing below.) The Applicant's web site shows the mark in substantially the form shown in the drawing, with ORAL in white letters on a blue color background that is extremely similar to the color Oral-B uses for its ORAL-B logo, while MAX appears in blue lettering on a white background. (Gregg Dep. at 26-27, Ex. 21.)



IV. QUESTIONS PRESENTED

There is no real dispute concerning Oral-B's ownership and extensive, lengthy use of the ORAL-B trademark. Nor can it be disputed that the goods covered by the application are the same or closely related to those on which the ORAL-B mark has been used. There is also no dispute as to Oral-B's priority of use of its mark. Thus, the two issues before the Board are: (1) whether Applicant's ORALMAX & Design trademark, when applied to Applicant's goods, is likely to cause confusion, mistake, or deception as to the source or sponsorship of those goods; and (2) whether the ORALMAX & Design trademark, when applied to Applicant's goods, is likely to dilute the distinctive quality of the ORAL-B mark.

V. ARGUMENT

A. Applicant's Mark is Confusingly Similar to Oral-B's Mark

Oral-B contends that consumers and dental professionals familiar with its ORAL-B trademark and trade name, and with the products, including electric toothbrushes and dental floss products, long sold under that mark, will be likely to believe that Applicant's products sold under the ORALMAX & Design mark are additions to Oral-B's products line or are in some other way connected with Opposer or its ORAL-B brand.

In determining likelihood of confusion, the Board should apply the factors set forth in *In re DuPont deNemours & Co.*, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). Different factors may play dominant roles in making the determination in each case. *Nina Ricci S.A.R.L. v. E.T.F. Enters., Inc.*, 12 U.S.P.Q.2d 1901, 1903 (Fed. Cir. 1989). In this case, the dominant factors are these: (1) the fame of Opposer's mark; (2) the similarity of the goods; (3) the similarity of the marks; and (4) the similarity of trade channels.

In analyzing the relevant factors, two broad principles apply. First, newcomers such as Applicant have the duty to avoid selecting a mark close to an established mark in order to protect the senior user's goodwill and to protect consumers from confusion. *Kenner Parker Toys Inc. v. Rose Art Indus., Inc.*, 22 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1992). Second, all doubts must be resolved in favor of the prior user. *Id.*; *Nina Ricci*, 12 U.S.P.Q.2d at 1904.

Analysis of the *DuPont* factors and the application of these broad principles lead to the inevitable conclusion that Applicant's ORALMAX & Design mark so resembles Opposer's ORAL-B mark as to be likely, when used on or in connection with toothbrushes, to cause confusion, or to cause mistake, or to deceive.

1. Opposer's ORAL-B Trademark is Strong and Entitled to a Broad Scope of Protection

The fame and strength of the ORAL-B mark is beyond doubt. The Board has previously ruled that the ORAL-B trademark is famous and entitled to a broad scope of protection. In *Gillette Canada Inc. v. Ranir Corp.*, 23 U.S.P.Q.2d 1768 (T.T.A.B. 1992), which also involved the trademark ORAL-B, the applicant sought to register the mark ORAL-ANGLE for toothbrushes. The opposition was sustained, and the Board noted:

"[T]he fifth du Pont factor, fame of the prior mark, plays a dominant role in cases featuring a famous or strong mark. Famous or strong marks enjoy a wide latitude of legal protection. Opposer's ORAL-B marks are undoubtedly famous. They have been in use for many years; they represent the leading brand of toothbrushes sold in the United States; they have held the number one sales position, among both consumers and dentists, since about 1978; and they receive significant advertising and promotional outlays . . . Opposer's ORAL-B marks are thus strong marks meriting a wide latitude of protection from imitators.

Id. at 1774. (citation omitted).

The ORAL-B trademark was famous when the *Ranir* case was decided in 1992, and is even more famous today. ORAL-B is still the number one selling toothbrush in the United States. (Gregg Dep. at 21-22.) To highlight briefly what is set forth in the Statement of Facts, in 2003 alone, Opposer's U.S. sales of products under the ORAL-B mark totaled 461 million dollars and Opposer spent more than 60 million dollars in advertising, promotion and public relations with respect to the ORAL-B brand. (*Id.* at 10, 14.) As a result of its extensive advertising and promotion efforts, Opposer holds the biggest share of the market in both the manual and power toothbrush segments, with 8 percentage points more than its closest competitor in power and 11 percentage points more than its closest competitor in manual. (*Id.* at 21-22.) The ORAL-B brand has become so famous that it is not uncommon to see it as an answer in crossword puzzles in such national publications as *The New York Times* and the *Wall Street Journal*. (*Id.* at 25-26; Exs. 19, 20.)

Opposer's ORAL-B trademark has also long been the subject of federal registrations, and is entitled to all of the strong presumptions of validity that they signify. *American Home Prods. Corp. v. Johnson Chem. Co.*, 200 U.S.P.Q. 417, 420 (2d Cir. 1978). Opposer's right to the exclusive use of the marks shown in its registrations is incontestable. See Opposer's Notice of Reliance and attached Title and Status Registration Certificates; 15 U.S.C. § 1065.

Under these circumstances, Opposer's ORAL-B trademark is clearly entitled to the broadest range of protection. *Miles Labs. Inc. v. Naturally Vitamin Supplements, Inc.*, 1 U.S.P.Q.2d 1445, 1453 (T.T.A.B. 1987); *Specialty Brands, Inc. v. Coffee Bean Distribs.*, 223 U.S.P.Q. 1281, 1284 (Fed. Cir. 1984). This is not only a famous trademark, but one of the most famous trademarks.

2. The Goods are Identical or Very Closely Related

Applicant seeks to register its ORAL-MAX & design trademark for electric toothbrush and dental flossing units. Opposer's ORAL-B trademark is the leading brand of electric toothbrushes in the United States. (Gregg. Dep. at 21-22.) Moreover, in addition to selling electric toothbrushes by themselves, Opposer also sells replacement brushheads for its electric toothbrushes, including ones that are designed to clean between teeth and a center that includes Opposer's high-end "3D" electric toothbrush with an oral irrigator that massages gums. (Ex. 1 to Gregg. Dep., at pp. 3, 5, 8.) Opposer also introduced a battery-operated flossing device called ORAL-B HUMMINGBIRD in March of this year. (Gregg. Dep. at 10.) Because Applicant's goods are substantially identical to Opposer's goods, consumers are likely to believe that Applicant's goods originate from Opposer.

3. The Marks are Confusingly Similar

In *Ranir*, the Board stated that "[t]he degree of similarity of the marks needed to prove likely confusion will vary with the difference in the goods . . . of the parties. Where the goods . .

. are directly competitive, the degree of similarity required to prove a likelihood of confusion is less than in the case of dissimilar products." *Ranir*, 23 U.S.P.Q.2d at 1773 (citations omitted). Just as the Board found ORAL-B and ORAL-ANGLE confusingly similar in *Ranir*, the marks here at issue, ORAL-B and ORALMAX & design, are confusingly similar. The dominant portion of each, the word ORAL, is identical. *See id.*

Applicant's addition of the word MAX to ORAL does not lessen the likelihood of confusion. "One cannot take the trademark of another and, by adding thereto descriptive or subordinate matter, avoid a likelihood of confusion or mistake or deception." *S. Gumpert Co. v. ITT Continental Baking Co.*, 191 U.S.P.Q. 409, 411 (T.T.A.B. 1976); *In re Rexel, Inc.*, 223 U.S.P.Q. 830, 831 (T.T.A.B. 1984). "Max" is an abbreviation for "maximum." *See Webster's New Universal Unabridged Dictionary* 886 (1989). Accordingly, "max" should be viewed as a weak, laudatory term that should be given little weight in the likelihood of confusion determination. Rather, the identity of the dominant term, ORAL, should be given pre-eminent consideration. *Ranir*, 23 U.S.P.Q.2d at 1773.

Given the facts of this case, Applicant's addition of the weak word MAX to the word ORAL to form the ORALMAX & design trademark enhances rather than eliminates confusion. Opposer's ORAL-B trademark typically appears on its toothbrush packaging, advertising and promotion together with a sub-brand trademark such as INDICATOR, ADVANTAGE, CROSSACTION, HUMMINGBIRD or STAGES. (Gregg Dep. at 6-10 & Exs. 1, 9-11, 17) Consumers are therefore likely to believe that Applicant's products are just another new sub-brand of ORAL-B product, a likely conclusion given the fact that Opposer is frequently introducing new products into the market. (Gregg Dep. at 6, 9-10).

Finally, it bears mention that the likelihood of confusion is further increased in this case by the fact that Applicant has adopted a color scheme for its mark that resembles Opposer's

ORAL-B logo as it is displayed on Opposer's packaging. Applicant's drawing of its mark shows the word ORAL in white displayed on a blue background. For many years Opposer has used its ORAL-B trademark in white letters on a blue background. (Gregg. Dep. at 27; Exs. 1-12, 17) The similarity in the color schemes used by Applicant and Opposer can only exacerbate the already strong likelihood of confusion in this case.

4. The Trade Channels are Identical.

In the absence of any restriction in the description of goods as to the channels of trade or the target consumers it is presumed that Applicant's goods also travel in all of the normal channels of trade for electric toothbrushes and to all consumers of such goods. *See Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 1 U.S.P.Q.2d 1813, 1816 (Fed. Cir. 1987). Applicant has not offered any testimony to rebut this presumption.

B. Allowing Applicant's Registration Will Dilute Opposer's Famous Mark

Pursuant to Section 13 of the Lanham Act, 15 U.S.C. § 1063, Opposer also asks the Board to deny registration of Applicant's ORALMAX & Design trademark because it dilutes the distinctiveness of the ORAL-B trademark in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

Courts have traditionally recognized two types of dilution, "blurring" and "tarnishment." 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 24:67 at 24-128 (4th ed. 2004). "Blurring" occurs where there is no confusion as to source, sponsorship, affiliation or connection, but the unique and distinctive significance of the mark is threatened by the existence of another mark. *Id.* § 24:68 at 24-129.

To succeed on a claim of dilution, courts and the Board have held that the moving party must establish five necessary elements: (1) the senior mark must be famous; (2) the senior mark must be distinctive; (3) the junior use must be a commercial use in commerce; (4) the junior use

must begin after the senior mark has become famous; and (5) the junior use must cause dilution of the distinctive quality of the senior mark. *Nabisco, Inc. v. PF Brands, Inc.*, 51 U.S.P.Q.2d 1882, 1886 (2d Cir. 1999); *The Toro Company v. ToroHead, Inc.*, 61 U.S.P.Q.2d 1164, 1173 (T.T.A.B. 2001). Opposer makes the necessary showing under each of these factors to prevail on its claim of dilution by blurring.

1. The ORAL-B Trademark is Famous.

As established above, ORAL-B is a famous mark, as the Board already held in *Ranir*. The dilution provision of the Lanham Act lists eight non-exclusive factors that courts may consider in determining whether a mark is famous. In addition, courts may conclude that a mark is famous simply by construing the word "famous" according to its common sense meaning. *Nabisco*, 51 U.S.P.Q.2d 1882 at 1886.

Using the plain meaning analysis articulated in *Nabisco*, it is obvious that ORAL-B is a famous mark. Among marks held famous by the Board and courts for purposes of dilution are NASDAQ, *NASDAQ Stock Market, Inc. v. Antartica, S.r.l.*, 69 U.S.P.Q.2d 1718 (T.T.A.B. 2003); PANAVISION, *Panavision Int'l L.P. v. Toeppen*, 40 U.S.P.Q.2d 1908 (C.D. Cal. 1996), *aff'd*, 46 U.S.P.Q.2d 1511 (9th Cir. 1998); TYLENOL, *McNeil Consumer Brands, Inc. v. U.S. Dentek Corp.*, 56 U.S.P.Q.2d 1758, 1762 (E.D. Pa. 2000); CENTURY 21, *Century 21 Real Estate Corp. v. Sandlin*, 6 U.S.P.Q.2d 2034 (9th Cir. 1988); and GODIVA, *Grey v. Campbell Soup Co.*, 231 U.S.P.Q. 562 (C.D. Cal. 1986), *aff'd without op.*, 830 F.2d 197 (9th Cir. 1987). Certainly Opposer's ORAL-B trademark is at least as famous as these marks, if not more so.

An eight-factor test for fame is set forth in 15 U.S.C. § 1125(c)(1) (and adopted by the Board in *Toro, supra*). The factors are: (A) the degree of inherent or acquired distinctiveness of the mark; (B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used; (C) the duration and extent of advertising and publicity of the mark;

(D) the geographical extent of the trading area in which the mark is used; (E) the channels of trade for the goods or services with which the mark is used; (F) the degree of recognition of the mark in the trading area and channels of trade of the mark's owner and the person against whom the injunction is sought; (G) the nature and extent of use of the same or similar marks by third parties; and (H) whether the mark was registered on the Principal Register.

Applying that test, the ORAL-B trademark is extraordinarily distinctive and famous. Turning to the first factor, the fact that ORAL-B is registered on the Principal Register without a showing of acquired distinctiveness affords it a presumption that its mark is inherently distinctive. Moreover, as discussed above, Opposer's extensive advertising and promotional efforts have led to a 95% consumer brand awareness in the marketplace. (Gregg. Dep. at 18-20 & Ex. 13). Accordingly, even if one were to question the degree of inherent distinctiveness in the mark, it certainly enjoys a high degree of acquired distinctiveness.

Turning to the second, third and fourth factors, the mark has been in use since 1949, and sales of products under the mark have continually grown so that last year's sales totaled 461 million dollars. (Reg. No. 547,130 (attached to Opposer's Notice of Reliance); Gregg. Dep. at 23.) Opposer reaches this level of sales by distributing its products throughout the entire U.S. Opposer advertises the ORAL-B brand extensively, on television and widely distributed national magazines and local newspapers. (Gregg Dep. at 10-17.) In 2003, Oral-B spent nearly 47 million dollars in advertising, and another 16 million dollars in promotion and public relations. (*Id.* at 10-11, 14.) This level of spending is fairly typical compared to spending in recent years. (*Id.* at 11.) Oral-B's television and print advertising are each estimated to reach between 70 and 80 percent of Oral-B's target market, people in the 18-54 age group. (*Id.* at 12-14.) Oral-B also promotes its products by marketing to dentists and dental hygienists, providing displays to retailers and coupon advertisements inserted in Sunday newspapers. (*Id.* at 14.) One coupon

distribution on any particular Sunday typically reaches more than 40 million households. (*Id.* at 15-17; Exs. 9-11.) Thus, Opposer has very extensive use and advertising of its ORAL-B trademark.

Under the fifth and sixth factors, courts are traditionally required to define the product line or market within which the movant's mark is used and has become famous, and to identify whether there is any overlap in the channels of trade in which the movant and alleged infringer do business. McCarthy, *supra*, § 24:92 at 24-180 to 184. As already discussed, Opposer's ORAL-B products are advertised and sold extensively throughout the U.S. Given the ubiquity of ORAL-B toothbrushes, there is scarcely a place Applicant's product could be sold where ORAL-B toothbrushes are not already sold.

The seventh factor, the nature and extent of use of the same or similar mark by third parties, requires that the Board determine whether the mark at issue is so widely used by third parties that it is among a "crowd" of the same or similar marks. This factor strongly supports a finding that the ORAL-B trademark is famous, as there is no evidence in the record of any third-party use of trademarks that include the terms ORAL-B or ORAL.

Under the last factor, whether the mark is federally registered, there can be no dispute that the ORAL-B trademarks are protected by registration on the Principal Register in the United States Patent and Trademark Office. (*See* Opposer's Notice of Reliance.)

Thus, analysis of the statutory factors reveals that the ORAL-B trademark is famous within the meaning of Section 1125(c).

2. The ORAL-B Trademark is Distinctive.

The distinctiveness test is similar to the test for fame. *Toro, supra*, at 61 U.S.P.Q.2d at 1177 ("we view fame and distinctiveness as two overlapping, but slightly different concepts"). The Board will look at both the inherent and acquired distinctiveness of the mark. *Id.* The

ORAL-B trademark is highly distinctive both inherently and in terms of the distinctiveness it has acquired through Oral-B's years of advertising and promotion of its products under the mark.

As the Second Circuit explained in the *Nabisco* decision, there is a ladder of distinctiveness ranging from generic at the bottom, to descriptive, to suggestive, to arbitrary and fanciful marks at the top. *Nabisco, supra*, 51 U.S.P.Q.2d at 1887. The ORAL-B trademark is at best arbitrary, and at worst suggestive. It is certainly not generic in any way, i.e., it does not describe the type of product to which the mark applies. Neither is it descriptive, as the Board has already held in *Ranir*. 23 U.S.P.Q.2d at 1773. ORAL-B should be considered arbitrary because it consists of a unique combination of ORAL and the letter B, which together, do not convey any meaning about what the product is. At worst, the mark might be considered suggestive if one considers that the ORAL prefix may suggest the idea of a product having to do with the mouth. In either category, the ORAL-B trademark possesses a high degree of inherent distinctiveness.

Moreover, as discussed above, the ORAL-B trademark has an extraordinarily high degree of acquired distinctiveness such that the consuming public automatically associates the mark with Opposer and its products. *See Citigroup Inc. v. City Holding Co.*, 171 F. Supp. 2d 333, 346 (S.D.N.Y. 2001) ("In addition to inherent distinctiveness, the CITI family of marks has, through extensive advertising and promotion over the decades, garnered extraordinary acquired distinctiveness.").

3. Applicant is a Commercial User in Commerce and Use Began After the ORAL-B Mark Became Famous.

For these two prongs of the dilution analysis, the Second Circuit tells us to "use terms in their ordinary language sense." *Nabisco*, 51 U.S.P.Q.2d at 1886-87. Here there can be no dispute that Applicant began its use of the ORALMAX and design trademark long after Opposer's ORAL-B trademark became famous, and that Applicant's use of its mark is commercial in nature.

4. Applicant's Use Will Cause Dilution of the Distinctive Quality of the ORAL-B Trademark.

To determine whether dilution will occur, the Board looks to the similarity of the marks in question and the renown of the senior mark. *Toro*, 61 U.S.P.Q.2d at 1183. As discussed above, the ORAL-B trademark is very similar to ORALMAX & design, because both trademarks share the same dominant portion. Dilution can occur when the marks are not identical. *McNeil Consumer Brands, Inc. v. U.S. Dentek Corp.*, 56 U.S.P.Q.2d 1758, 1762 (E.D. Pa. 2000) (finding TEMPANOL dilutive of TYLENOL); *Polaroid Corp. v. Polaroid, Inc.*, 138 U.S.P.Q. 265 (7th Cir. 1963) (POLARAID dilutive of POLAROID); *WAWA Dairy Farms v. Haaf*, 40 U.S.P.Q.2d 1629 (E.D. Pa. 1996) (HAHA dilutive of WAWA), *aff'd without op.*, 116 F.3d 471 (3d Cir. 1997); *Toro*, 61 U.S.P.Q.2d at 1183 (dilution plaintiff must show that marks are "very or substantially similar").

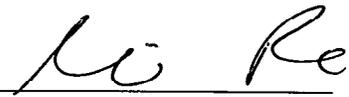
On the issue of renown, Opposer has amply demonstrated that its ORAL-B trademark is a household brand name, known everywhere as the source of toothbrushes and related products. Applicant, on the other hand, is a relative newcomer to the market and it has submitted no evidence that it is known to any consumers. On the record established, ORALMAX & design will undoubtedly dilute the distinctiveness of Oral-B's famous ORAL-B trademark.

VI. CONCLUSION

For the foregoing reasons, Oral-B respectfully submits that there is a strong likelihood of confusion, mistake and deception, as well as dilution, arising from Applicant's ORALMAX & design trademark, and requests that the application for registration be denied, and that this Opposition be sustained.

Dated: Boston, Massachusetts
June 10, 2004

GILLETTE CANADA COMPANY
dba ORAL-B LABORATORIES

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of Opposer's Notice Of Filing Of Trial Testimony Transcript And Exhibits Pursuant To 37 C.F.R. § 2.125(c) is being served today, June 16, 2004, by first class mail, postage prepaid, upon the Applicant's attorney of record, James Pacious, Esq., Collier Shannon Scott, Washington Harbour, Suite 400, 3050 K Street, N.W., Washington, D.C. 20007-5108.

Michelle Brownlee

Michelle Brownlee

6/10/04

Date

37 C.F.R. § 1.8 Certificate of Mailing:

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail, postage prepaid in an envelope addressed to: Commissioner for Trademarks 2900 Crystal Drive, Arlington, VA 22202-3513, Box TTAB - No Fee

Michelle Brownlee

(Name)

6/10/04

(Date)