

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

IN THE MATTER OF Application Serial No. 76/387354 filed March 25, 2002
PUBLISHED IN THE OFFICIAL GAZETTE of October 8, 2002, Vol. 1263, No. 2
Page TM 249

THE PROCTER & GAMBLE COMPANY)	
Opposer,)	
)	
v.)	Opposition No. _____
)	
OLAX INTERNATIONAL, INC.)	
Applicant.)	

12/12/2002 ZCARRITH 00000009 162488 76387354
01 FC:6402 900.00 CH

OPPOSITION

THE PROCTER & GAMBLE COMPANY, a corporation organized and existing under the laws of the State of Ohio, located and doing business at One Procter & Gamble Plaza, Cincinnati, Ohio 45202, believes it will be damaged by the registration of the mark shown in the above-identified application and hereby opposes same.

As grounds of opposition, it is alleged that:

1. Since long prior to March 25, 2002, the date OLAX INTERNATIONAL, INC. (hereinafter referred to as Applicant) filed the present application to register the mark OLAX for, in part, "skin care products, namely skin moisturizer, cleanser, sun block, tanning gel, skin care mask" in International Class 3, THE PROCTER & GAMBLE COMPANY (hereinafter referred to as Opposer) has engaged in the development, manufacture, advertising, distribution, and sale in interstate commerce for "skin lotion", "skin cleanser" and related goods bearing the trademark OLAY and/or OIL OF OLAY.

2. The trademark OLAY was adopted by Opposer (and its predecessors in interest) as a trademark for "skin lotion" as early as 1957, and is currently in use by Opposer in conjunction with "skin care products, namely, skin lotion, skin cream, toilet soap, bath soap, moisturizing body wash, facial cleanser" in interstate commerce by applying labels bearing said trademark to the packages in which said goods are shipped and sold, by displaying representations of said mark in advertising and in other ways customary to the trade.

3. Opposer is the owner of the entire right, title and interest in and to the trademark OLAY, as evidenced by the following registrations: OLAY & design, Registration No. 825,078, which issued on February 28, 1967, for use in connection with "skin lotion"; and OLAY, Registration No. 1,130,648, which issued on February 12, 1980, for use in connection with "non-medicated skin cleanser." These registrations were issued by the U.S. Patent and Trademark Office on the Principal Register, all registrations are in all respects valid, subsisting and owned by Opposer, and the trademark is currently in use. Affidavits of continued use and incontestability under §§8 & 15 of the Act of 1946 have been filed and accepted with respect to these registrations noted above. Two (2) copies of each of said registrations showing status and title are attached hereto as Opposer's Exhibits 1 and 2.

4. Opposer is also the owner of the following trademark registrations: OIL OF OLAY, Registration No. 2,071,918, which issued June 17, 1997, for use in connection with "skin care products, namely skin lotion, skin cream, toilet soap, bath soap, moisturizing body wash, facial cleanser; cosmetics, namely foundation, facial powder, eyeshadow, mascara, blush, concealer, eye liner, nail enamel, lipstick"; OIL OF OLAY, Registration No. 1,109,850, which issued on December 26, 1978, for "non-medicated skin preparation"; NIGHT OF OLAY, Registration No. 1,089,006, which issued on April 11, 1978, for use in connection with

“cosmetic skin preparation”, OIL OF OLAY Registration No. 1,019,120, which issued on September 2, 1975, for use in connection with “skin lotion”, and OIL OF OLAY & design, Registration No.787,645, which issued March 30, 1965, for use in connection with “skin lotion.”

5. Opposer has spent and continues to spend large sums of money in the advertisement and promotion of its goods bearing the trademark OLAY and by reason of such advertising and the high quality of its products carrying such trademark, Opposer enjoys a valuable goodwill and an enviable reputation with respect to its trademark.

6. Opposer’s trademark OLAY is a famous mark.

7. Opposer’s trademark OLAY became famous long prior to March 25, 2002, the date Applicant filed the present application to register the mark OLAX.

8. Opposer’s trademark OLAY and Applicant’s claimed mark OLAX are substantially similar. They share the identical first three letters (O, L and A), and have a substantially similar last letter, Y and X.

9. Opposer’s goods bearing its trademark OLAY and Applicant’s goods bearing its trademark OLAX are identical or at least substantially very closely related.

10. With no limitation on trade channels, the products for which Applicant seeks registration and Opposer’s products would ordinarily be sold and distributed to the same classes of the purchasing public and pass through the same channels of trade sold in the same point-of-sale retail establishments.

11. As a result of the foregoing, the purchasing public familiar with Opposer’s products and Opposer’s OLAY trademark are likely to be confused, misled or deceived into thinking the products of Applicant are products of Opposer or are in some way sponsored by or connected with Opposer, to Opposer’s irreparable damage and injury.

12. Opposer will be injured if registration is granted to Applicant for its goods because its mark, OLAX, falsely suggests a connection with Opposer and Opposer's OLAY goods. Opposer has no control over the nature and quality of the goods produced by Applicant and thus will be damaged and irreparably harmed by reason of the loss of control over its reputation and the erosion of its goodwill in the OLAY mark.

13. Opposer will also be injured if registration is granted to Applicant for its goods because its mark, OLAX, will diminish and dilute the distinctiveness, uniqueness, and effectiveness of Opposer's famous OLAY trademark.

14. For the reasons set forth above, Opposer believes and accordingly asserts that the goodwill in its OLAY trademark will be damaged and that Applicant should be denied registration of its mark for which it has made application.

WHEREFORE, Opposer respectfully prays the registration sought by Applicant be refused and this opposition be sustained.

The fee of \$300.00 per class as provided by Sections 13 and 31 of the Act of 1946 is paid by a cover letter requesting that it be charged to Deposit Account No. 16-2488 c/o Trademark Section, Legal Division, The Procter & Gamble Company, One Procter & Gamble Plaza, Cincinnati, OH 45202.

THE PROCTER & GAMBLE COMPANY

By: Vanessa M. Nichols
Vanessa M. Nichols
Its Attorney
The Procter & Gamble Company
One Procter & Gamble Plaza
Cincinnati, OH 45202
(513) 983-3817

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: BOX TTAB FEE, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on November 21, 2002.

Lynn M. Hammann
Lynn M. Hammann

United States Patent Office

825,078
Registered Feb. 28, 1967

PRINCIPAL REGISTER Trademark

Ser. No. 254,021, filed Sept. 8, 1966

OLAY

Adams National Industries (Pty.) Ltd. (South African
corporation)
5 Station Road
Durban, Natal, Republic of South Africa

For: SKIN LOTION, in CLASS 51.
First use 1951; in commerce June 1, 1957.
Owner of U.S. Reg. No. 787,645.

MC 01 COMB. AEF. SEC 8 & 15

3 1-26-73

EXHIBIT 1

United States Patent Office

825,078
Registered Feb. 28, 1967

PRINCIPAL REGISTER Trademark

Ser. No. 254,021, filed Sept. 8, 1966

OLAY

Adams National Industries (Pty.) Ltd. (South African
corporation)
5 Station Road
Durban, Natal, Republic of South Africa

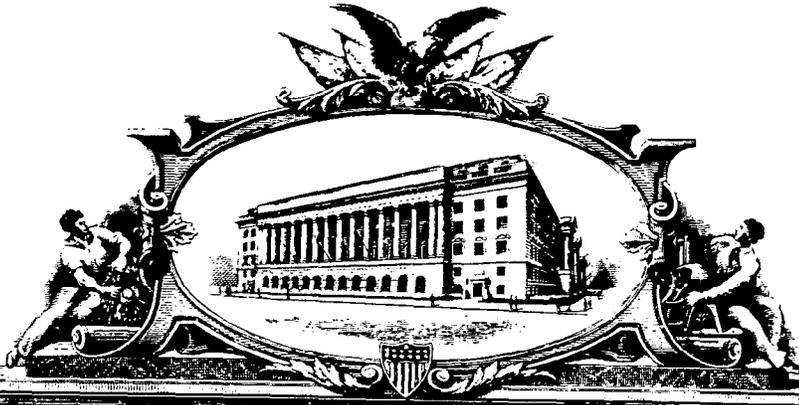
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3

1-26-73

457395



THE UNITED STATES OF AMERICA

**TO ALL TO WHOM THESE PRESENTS SHALL COME:
UNITED STATES DEPARTMENT OF COMMERCE**

United States Patent and Trademark Office

August 28, 2001

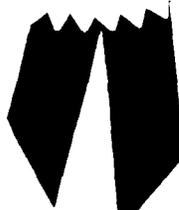
THE ATTACHED U.S. TRADEMARK REGISTRATION 1,130,648 IS CERTIFIED TO BE A TRUE COPY WHICH IS IN FULL FORCE AND EFFECT WITH NOTATIONS OF ALL STATUTORY ACTIONS TAKEN THEREON AS DISCLOSED BY THE RECORDS OF THE UNITED STATES PATENT AND TRADEMARK OFFICE.

REGISTERED FOR A TERM OF 10 YEARS FROM *February 12, 1980*
1st RENEWAL FOR A TERM OF 10 YEARS FROM *February 12, 2000*
SECTION 8 & 15

SAID RECORDS SHOW TITLE TO BE IN:

*THE PROCTOR & GAMBLE COMPANY
AN OHIO CORPORATION*

By Authority of the
COMMISSIONER OF PATENTS AND TRADEMARKS


T. Wallace
T. WALLACE

Certifying Officer

EXHIBIT 2



Int. Cl.: 3

U.S. Cl.: 52

Reg. No. 1,130,648

U.S. Patent and Trademark Office

Reg. Feb. 12, 1980

TRADEMARK

Principal Register

OLAY

Olay Company, Inc. (Delaware corporation)
Ten Westport Rd.
Wilton, Conn. 06897

For: Non-Medicated Skin Cleanser —in Class 3. (U.S. Cl.
52).
First use Oct. 13, 1978; in commerce Oct. 13, 1978.
Owner of U.S. Reg. Nos. 825,078, 825,081 and 1,019,120.

Ser. No. 190,792. Filed Oct. 26, 1978.

JOHN C. DEMOS, Primary Examiner

J. J. FINGERET, Examiner

457395



THE UNITED STATES OF AMERICA

**TO ALL TO WHOM THESE PRESENTS SHALL COME:
UNITED STATES DEPARTMENT OF COMMERCE**

United States Patent and Trademark Office

August 28, 2001

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T. Wallace
T. WALLACE

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JOHN C. DEMOS, Primary Examiner

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Vanessa M. Nichols
Intellectual Property Counsel

November 18, 2002

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NOV 20 2002
UNITED STATES
DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

BOX TTAB FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Attention: Trademark Trial & Appeal Board

Dear Sir:

<p>Re: THE PROCTER & GAMBLE COMPANY Opposer</p> <p>v. OLAX INTERNATIONAL, INC. Applicant</p>	<p>: OPPOSITION To Trademark OLAX : Application Serial No. 76/387,354 : for SKIN CARE PRODUCTS, NAMELY, SKIN : MOISTURIZER, CLEANSER, SUN BLOCK, : TANNING GEL, SKIN CARE MASK : International Class 3 : : NUTRITIONAL SUPPLEMENTS : International Class 5 : : CLOTHING, NAMELY, SOCKS, PANTS, JEANS, : SHORTS, T-SHIRTS, SHIRTS, UNDERWEAR, : TIES, JACKETS, COATS, SKIRTS, BLOUSES, : HATS, BELTS, SWEATSHIRTS, SWEATPANTS, : SWEATERS, VESTS, SWEATSUITS, SHOES, : BOOTS AND SNEAKERS : International Class 25</p>
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Enclosed herein are two (2) copies of a Notice of Opposition, duly executed by Opposer, THE PROCTER & GAMBLE COMPANY.

The filing fee of \$900.00 is to be charged to Deposit Account No. 16-2488 c/o The Procter & Gamble Company, Trademark Section, Legal Division, One Procter & Gamble Plaza, Cincinnati, Ohio 45202.

Please stamp the date of receipt of these documents on the attached postcard and return to me.

Sincerely,

Vanessa M. Nichols

Enclosures
cc: PTO Accounting