

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

In the matter of :
PERFORMANCE HEALTH, INC. : Opposition No.
and BIOFREEZE ASSOCIATES :
Opposers, : Application Serial No. 78/137,603
v. :
BAYER AKTIENGESELLSCHAFT : Mark: THE POWER TO PERFORM
Applicant. : Filed: June 21, 2002

NOTICE OF OPPOSITION

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



04-09-2003

U.S. Patent & TMO/TM Mail Rpt Dt. #30

Performance Health, Inc., a Pennsylvania corporation (“Performance Health”) and Biofreeze Associates, a Pennsylvania partnership, both having their principal place of business at 1017 Boyd Road, Suite 105, Export, Pennsylvania, 15632 believe that they will be damaged by the registration of the alleged mark “THE POWER TO PERFORM” shown in Application Serial No. 78/137,603 (referred to hereinafter as “the Application”), and hereby oppose the Application under the provisions of 15 U.S.C. § 1063.

As grounds for opposing this registration, Performance Health and Biofreeze Associates aver as follows:

1. Upon information and belief, Applicant, Bayer Aktiengesellschaft, is a German corporation located at D-51368, Leverkusen-Bayerwerk, Germany.

05/05/2003 KGIBBONS 00000126 78137603

01 FC:6402

600.00 DP

{W0051710.1}

2. Applicant filed the Application for the registration of the mark "THE POWER TO PERFORM" on June 21, 2002 for the following goods in International Class 5: "pharmaceutical preparations for the treatment of sexual dysfunction, cardiovascular diseases, central nervous system diseases, cancer, respiratory and infectious diseases, diagnostic reagents adapted for medical use".

3. Applicant's mark "THE POWER TO PERFORM" was published in the January 7, 2003 issue of the Trademark Official Gazette of the United States Patent and Trademark Office.

4. Performance Health is the exclusive licensee of U.S. Trademark Registration No. 2,127,009 for the mark "PERFORM", for "cool pain relief medication in the form of a topical gel or liquid, namely an analgesic balm". This mark is registered in International Class 5. U.S. Trademark Registration No. 2,127,009 is owned by Biofreeze Associates, members of which own Performance Health.

5. Performance Health is engaged in the business of the sale of analgesic balm and other pain relief products. The "PERFORM" product is used for the temporary relief of muscle and joint pain.

6. Performance Health and/or Biofreeze Associates have been using the mark "PERFORM" in commerce in connection with the aforementioned goods since 1996. Performance Health and/or Biofreeze Associates have been using the mark "PERFORM" on the aforementioned goods since that time and this mark is still being used by Performance Health.

7. Performance Health spends substantial sums to advertise and otherwise promote its products under the mark "PERFORM".

8. Because of the long term and extensive use made of the mark "PERFORM" by Performance Health and Biofreeze Associates in connection with the aforementioned goods, the "PERFORM" mark enjoys strong name recognition and goodwill in the health/pain relief product market.

9. The continued strength of the mark "PERFORM" is crucial to the continued success of the business of Performance Health and Biofreeze Associates.

10. Because of the extensive use of the mark "PERFORM" by Performance Health and Biofreeze Associates, the public strongly associates the mark "PERFORM" with Opposers for general health and pain relief products.

11. Performance Health sells its "PERFORM" products through retail stores, distributors, and direct sales.

12. Upon information and belief, Applicant has not yet commenced use of the alleged mark "THE POWER TO PERFORM", but plans to manufacture and/or sell pharmaceutical preparations for the treatment of sexual dysfunction, cardiovascular diseases, central nervous system diseases, cancer, respiratory and infectious diseases, and/or diagnostic reagents adapted for medical uses under such alleged mark.

13. On June 21, 2002, Applicant filed the present intent-to-use application for the alleged mark "THE POWER TO PERFORM" for the aforementioned goods.

14. To the extent it has been used to date, Applicant commenced the use of the mark "THE POWER TO PERFORM" in connection with the manufacture and/or sale of the aforementioned goods in the United States after the date of registration for U.S. Trademark Registration No. 2,127,009.

15. Applicant's proposed use of the mark "THE POWER TO PERFORM" for a product that is likewise directed to general health maintenance and/or treatment of an individual, and will likely be available in the same stores and/or channels of trade is likely to be confused with Performance Health's prior use of "PERFORM", in that consumers would believe that Applicant's products are made, sponsored by, affiliated with or approved by Performance Health and/or Biofreeze Associates.

16. Applicant's proposed use of the mark "THE POWER TO PERFORM" in connection with pharmaceutical preparations for the treatment of sexual dysfunction, cardiovascular diseases, central nervous system diseases, cancer, respiratory and infectious diseases, and/or diagnostic reagents adapted for medical uses is likely to cause confusion, or cause mistake or will deceive the public into believing that said products emanate from Performance Health and/or Biofreeze Associates, and/or are manufactured by Performance Health and/or Biofreeze Associates, and/or is approved or endorsed by Performance Health and/or Biofreeze Associates.

17. The registration of the mark "THE POWER TO PERFORM" by Applicant on the Principal or Supplemental Registers of the United States Patent and Trademark Office would be inconsistent with Opposers' rights, including those under U.S. Trademark Registration No. 2,127,009 and common law, and would damage Opposers.

18. 15 U.S.C. § 1052(d) bars Applicant's mark from registration.

19. By making use of the alleged mark "THE POWER TO PERFORM" and seeking registration thereof, Applicant has appropriated the goodwill associated with the mark "PERFORM" and Opposers' use thereof.

WHEREFORE, Opposers Performance Health and Biofreeze Associates pray that this Opposition be decided in their favor and that Application Serial No. 78/137,603 be rejected, and that no registration be issued for or in connection with that application.

An original and two copies of this Notice of Opposition and the required filing fee of \$600.00 are enclosed. The undersigned hereby authorizes the United States Patent and Trademark Office to charge any additional fees to Deposit Account No. 23-0650 and refund any overpayment in the form of a check.

Respectfully submitted,

WEBB ZIESENHEIM LOGSDON
ORKIN & HANSON, P.C.

Dated: April 7, 2003

By



Kent E. Baldauf
Registration No. 25,826
Kent E. Baldauf, Jr.
Registration No. 36,082
Nathan J. Prepelka
Registration No. 43,016
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219-1818
Telephone: (412) 471-8815
Facsimile: (412) 471-4094

Counsel for Opposers
Performance Health, Inc.
and Biofreeze Associates

TTAB

Application Serial No. 78/137,603

Date April 7, 2003
Case Docket No. 1853-030115

BOX TTAB - FEE
COMMISSIONER FOR TRADEMARKS
2900 CRYSTAL DRIVE
ARLINGTON, VA 22202-3513



04-09-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #30

Sir:

Transmitted herewith for filing with the United States Patent and Trademark Office
is:

OPPOSER: Performance Health, Inc. and Biofreeze Associates

FOR: Opposition to Trademark Application No. 78/137,603

INCLUDING: Transmittal Form (1 p triplicate); Notice of Opposition (5 pp. in triplicate);
check in the amount of \$600.00

The Commissioner of Patents and Trademarks is hereby authorized to charge any
additional payment of the fees associated with this communication to Deposit Account No. 23-0650.

Please refund any overpayment to Deposit Account No. 23-0650.

The original and two copies of this transmittal sheet are enclosed.

Respectfully submitted,

WEBB ZIESENHEIM LOGSDON
ORKIN & HANSON, P.C.

By

Kent E. Baldauf, Jr.
Reg. No. 36,082
Kent E. Baldauf
Reg. No. 25,826
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219-1818
Telephone: (412) 471-8815
Facsimile: (412) 471-4094
Attorneys for Applicant

04-09-2003
10:56 AM EST

I hereby certify that this correspondence is being deposited with
the United States Postal Service as first class mail in an envelope
addressed to TTAB Commissioner for Trademarks, 2900 Crystal
Drive, Arlington, VA 22202-3513 on April 7, 2003.

Maria N. Dupain
(Typed Name of Person Mailing Paper)

04/07/03
Signature Date