



07-31-2003

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #22

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

In re Trademark Application of:  
3M ESPE AG  
Federal Republic of Germany

Serial No.: 75/086,162  
Filing Date: April 10, 1996  
Mark: Miscellaneous Design  
For: Impression compounds for dental purposes  
Class: International Class 05

Published in the Official Gazette on April 1, 2003

DENTSPLY INTERNATIONAL INC., )  
Opposer )  
v. ) Opposition No.  
3M ESPE AG., )  
Applicant )

08/13/2003 TSMITH 00000177 75086162  
01 FC:6402 300.00 OP

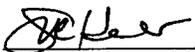
NOTICE OF OPPOSITION

DENTSPLY International Inc., ("Opposer"), a Delaware corporation having its principal place of business at 570 West College Avenue, York, PA 17404, believes and alleges that it will be damaged by registration of the mark shown in Serial No. 75/086,162 in International Class 05 and hereby opposes the same.

As grounds for opposition, Opposer alleges that:

CERTIFICATE OF MAILING

I hereby certify that this document is being deposited with the United States Postal Service as first class mail in an envelope addressed to BOX RESPONSES, FEE, Ass't Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 on 7 / 29 / 03.

  
Signature

7.29.03  
Date of Signature

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1. Opposer is a major manufacturer of products used in the dental profession, including impression materials for use in various dental procedures.

2. Since at least 1983, Opposer has sold impression materials in various shades of purple and violet, under several different trademarks, including REGISIL, HYDROSIL and AQUASIL.

3. Applicant 3M ESPE AG ("Applicant") seeks to register a miscellaneous design mark in International Class 05, having filed an application (the "Application") on April 10, 1996. The description of the mark, as published in the Official Gazette of April 1, 2003, is as follows: "The mark consists of the color violet as applied to the entirety of the goods. The closest shade of the Pantone color scale is number '2622'. The dotted outline of a square is intended to show that the mark is applied to goods in no fixed shape. The drawing of the mark is lined for violet."

4. Opposer opposes registration of Applicant's mark on the following grounds:

(a) The proposed color mark cannot be inherently distinctive, and Applicant has not proven, nor can it prove, that the mark has attained secondary meaning in order to establish that the mark has acquired distinctiveness.

(b) The proposed color mark is inadequately described in the Application and neither Applicant's product nor its packaging correspond to the number "2622" on the Pantone color scale.

(d) Applicant alleges in its response to Second Office Action dated September 21, 1998, that "there is only one competitor [the L.D. Caulk Company, a division of DENTSPLY] that has sold the impression material in the color violet...." Applicant's statement is false and misleading and should result in refusal to register the proposed mark, because, contrary to Applicant's representation, there are several manufacturers of impression materials who use various shades of violet or purple for their product. Applicant is well aware of the identity of those manufacturers. Indeed, Applicant is involved in litigation in Germany with at least one of those manufacturers, Heraeus Kulzer GmbH & Co. KG.

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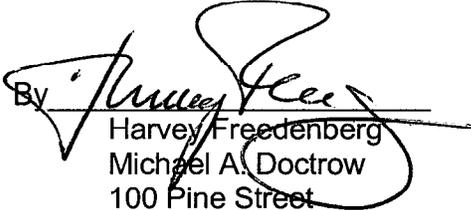
5. If Applicant is granted the registration herein opposed, it would thereby obtain at least a prima facie exclusive right to use of its mark. Such registration would be a source of damage and injury to Opposer, as well as other manufacturers of impression materials.

6. Opposer alleges that it will be irreparably damaged by the registration of Applicant's mark.

WHEREFORE, Opposer respectfully requests that this opposition be sustained; that application 75/086,162 be refused; and that the U.S. Patent & Trademark Office refuse to register Applicant's mark.

A duplicate copy of this Notice of Opposition and the fee required by §2.6(a)(17) are enclosed herewith.

McNEES WALLACE & NURICK LLC

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Attorneys for Opposer

Dated: July 28 2003

TTAB



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attorneys at law

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U.S. Patent & TMOtc/TM Mail Rcpt Dt. #22

SUSAN F. HEBERLIG  
Paralegal  
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July 29, 2003

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

Re: Miscellaneous Design  
Serial No. 75/086,162

Dear Commissioner:

Pursuant to 37 C.F.R. §2.101, enclosed for filing please find an original and one copy of the Notice of Opposition to the above-referenced application, together with the appropriate filing fee. This notice is filed on behalf of Dentsply International Inc.

Thank you for your attention to this filing request.

Very truly yours,

Sue Heberlig  
Paralegal

Enclosures

cc: Douglas J. Hura