



05-07-2003

U.S. Patent & TMOs/TM Mail Rpt Dt. #22

TRADEMARK

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

IN THE MATTER OF Application Serial No. 78/087,111 filed October 5, 2001
PUBLISHED IN THE OFFICIAL GAZETTE of February 4, 2003, Vol. 1267, No. 1
Page TM 216

THE PROCTER & GAMBLE COMPANY)
Opposer,)
v.)
SOTHYS INTERNATIONAL)
Applicant.)

Opposition No. _____

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 October 5, 2001, the date SOTHYS INTERNATIONAL (hereinafter referred to as Applicant) filed the present application to register the mark SECRETS DE SOTHYS (& Design) for "toilet soaps; bath and shower products: namely bath and shower gel, bath soap, bath oil, bath pearls, hair shampoos, skin soap, and bath foam; bath salts; perfume; eau de toilette; eau de parfum; lipstick; eye make-up; facial make-up; foundation make-up; make-up remover; body powder; face powder; nail polish; essential oils for personal use as a tonic or for relaxing, slimming or relieving congestion; body and face cream; hand cream; night

cream; massage cream for body and face; skin modeling cream for body and face; skin cleansing cream for body and face; cream and cleanser for body and face; exfoliating preparations for body and face; exfoliating marine salts; slimming cream and gel; refreshing cream for heavy legs; cream and gel for busts, cosmetic algae wraps; cosmetics marine mud wraps; cosmetic mineral mud wraps; mineral and marine mud; marine salts; sea water; thermal water; and spring water preparations for all cosmetic purposes; non-medicated hair care preparations; hair lotions; and dentifrices" 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 of "personal deodorant/antiperspirant" bearing the trademark SECRET.

2. The trademark SECRET was adopted by Opposer as a trademark for "personal deodorant/antiperspirant" in March of 1956. The trademark SECRET has been used continuously since 1956 by Opposer on such goods 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 SECRET for use in connection with "personal deodorant/antiperspirant" as well as several related marks consisting primarily of the term SECRET as evidenced by the following: SECRET, Registration No. 1,351,236, which issued on July 30, 1985, for use on "anti-perspirant and deodorant"; and SECRET SKIN RENEWAL, Application No. 78/126,136 filed on May 3, 2002, for use on "personal deodorant and anti-perspirant." The above listed application and registration are in all respects valid, subsisting and owned by Opposer, and the registered mark 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 the registration noted above. Two (2) copies of said registration showing status and title are attached hereto as Opposer's Exhibit 1.

4. Opposer has spent and continues to spend large sums of money in the advertisement and promotion of its goods bearing the trademark SECRET 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.

5. Opposer's trademark SECRET is a famous mark.

6. Opposer's trademark SECRET became famous long prior to October 5, 2001, the date Applicant filed the present application to register the mark SECRETS DE SOTHYS (& Design).

7. Opposer's trademark SECRET and Applicant's claimed mark SECRETS DE SOTHYS (& Design) are substantially similar. They share the identical word "SECRET".

8. Opposer's goods bearing its trademark SECRET and Applicant's goods bearing its trademark SECRETS DE SOTHYS (& Design) are substantially very closely related.

9. 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.

10. As a result of the foregoing, the purchasing public familiar with Opposer's products and Opposer's SECRET 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.

11. Opposer will be injured if registration is granted to Applicant for its goods because its mark, SECRETS DE SOTHYS (& Design), falsely suggests a connection with

Opposer and Opposer's SECRET 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 SECRET mark.

12. Opposer will also be injured if registration is granted to Applicant for its goods because its mark, SECRETS DE SOTHYS (& Design), will diminish and dilute the distinctiveness, uniqueness, and effectiveness of Opposer's famous SECRET trademark.

13. For the reasons set forth above, Opposer believes and accordingly asserts that the goodwill in its SECRET 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.

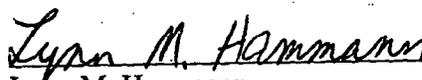
The fee of \$300.00 per class as provided by Sections 13 and 31 of the Act of 1946 is paid by a cover letter requesting that it be charged to Deposit Account No. 16-2488 c/o Trademark Section, Legal Division, The Procter & Gamble Company, One Procter & Gamble Plaza, Cincinnati, OH 45202.

THE PROCTER & GAMBLE COMPANY

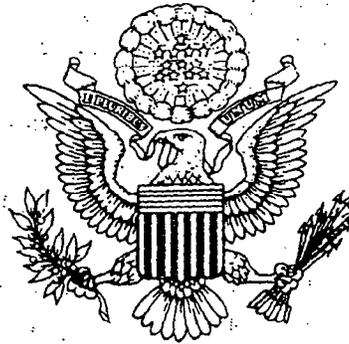
By: Tanya M. Lee
Tanya M. Lee
Its Attorney
The Procter & Gamble Company
One Procter & Gamble Plaza
Cincinnati, OH 45202
(513) 983-9529

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 May 5, 2003.


Lynn M. Hammann





Nº 1351236

THE UNITED STATES OF AMERICA

CERTIFICATE OF REGISTRATION

This is to certify that the records of the Patent and Trademark Office show that an application was filed in said Office for registration of the Mark shown herein, a copy of said Mark and pertinent data from the Application being annexed hereto and made a part hereof,

And there having been due compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks,

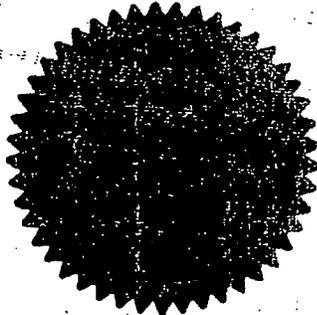
Upon examination, it appeared that the applicant was entitled to have said Mark registered under the Trademark Act of 1946, and the said Mark has been duly registered this day in the Patent and Trademark Office on the

PRINCIPAL REGISTER

to the registrant named herein.

This registration shall remain in force for Twenty Years unless sooner terminated as provided by law.

In Testimony Whereof I have hereunto set my hand and caused the seal of the Patent and Trademark Office to be affixed this thirtieth day of July, 1985.



Ronald J. Zigg

Acting Commissioner of Patents and Trademarks

Int. Cl.: 3

Prior U.S. Cl.: 51

United States Patent and Trademark Office

Reg. No. 1,351,236

Registered July 30, 1985

**TRADEMARK
PRINCIPAL REGISTER**

SECRET

PROCTER & GAMBLE COMPANY, THE (OHIO
CORPORATION)
ONE PROCTER & GAMBLE PLAZA
CINCINNATI, OH 45202

FIRST USE 3-27-1956; IN COMMERCE
3-27-1956.

OWNER OF U.S. REG. NO. 645,874.

SER. NO. 516,849, FILED 1-9-1985.

FOR: ANTI-PERSPIRANT AND DEODOR-
ANT, IN CLASS 3 (U.S. CL. 51).

MICHELLE S. WISEMAN, EXAMINING AT-
TORNEY



Nº 1351236

THE UNITED STATES OF AMERICA

CERTIFICATE OF REGISTRATION

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And there having been due compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks,

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Ronald J. Higgins
Acting Commissioner of Patents and Trademarks

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MICHELLE S. WISEMAN, EXAMINING AT-
TORNEY



Tanya M. Lee
Intellectual Property Counsel

TTAB

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May 5, 2003

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



05-07-2003

U.S. Patent & TMO/TM Mail Ropt Dt. #22

Attention: Trademark Trial & Appeal Board

Dear Sir:

Re: THE PROCTER & GAMBLE COMPANY
Opposer
v.
SOTHYS INTERNATIONAL
Applicant

: OPPOSITION To Trademark SECRETS DE SOTHYS
: (& Design)
: Application Serial No. 78/087,111
: for TOILET SOAPS, BATH AND SHOWER PRODUCTS;
: NAMELY BATH AND SHOWER GEL, BATH SOAP,
: BATH OIL, BATH PEARLS; HAIR SHAMPOOS, SKIN
: SOAP, AND BATH FOAM; BATH SALTS; PERFUME;
: EAU DE TOILETTE; EAU DE PARFUM; LIPSTICK; EYE
: MAKE-UP; FACIAL MAKE-UP; FOUNDATION
: MAKE-UP; MAKE-UP REMOVER; BODY POWDER;
: FACE POWDER NAIL POLISH; ESSENTIAL OILS
: FOR PERSONAL USE AS A TONIC OR FOR
: RELAXING, SLIMMING OR RELIEVING
: CONGESTION; BODY AND FACE CREAM; HAND
: CREAM; NIGHT CREAM; MASSAGE CREAM
: FOR BODY AND FACE; SKIN MODELING
: CREAM FOR BODY AND FACE, SKIN CLEANSING
: CREAM FOR BODY AND FACE; CREAM AND
: CLEANSER FOR BODY AND FACE; EXFOLIATING
: PREPARATIONS FOR BODY AND FACE;
: EXFOLIATING MARINE SALTS; SLIMMING CREAM
: AND GEL; REFRESHING CREAM FOR HEAVY LEGS;
: CREAM AND GEL FOR BUSTS; COSMETIC ALGAE
: WRAPS; COSMETIC MARINE MUD WRAPS;
: COSMETIC MINERAL MUD WRAPS; MINERAL AND
: MARINE MUD, MARINE SALTS, SEA WATER,
: THERMAL, WATER AND SPRING WATER
: PREPARATIONS FOR ALL COSMETIC
: PURPOSES; NON-MEDICATED HAIR CARE
: PREPARATIONS, HAIR LOTIONS; AND DENTIFRICES
: International Class 3

Enclosed herein are two (2) copies of a Notice of Opposition, duly executed by Opposer, THE PROCTER & GAMBLE COMPANY.

Procter & Gamble

BOX TTAB FEE

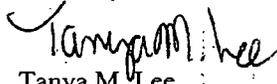
May 5, 2003

Page 2

The filing fee of \$300.00 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,


Tanya M. Lee

Enclosures

cc: PTO Accounting

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