

ESTTA Tracking number: **ESTTA82843**

Filing date: **05/30/2006**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

| | |
|---------------------------------------|---|
| Name | 3M ESPE AG |
| Granted to Date of previous extension | 05/31/2006 |
| Address | ESPE Platz Seefeld, 82229 GERMANY |

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| Attorney information | Michael S. Metteauer, Martin Hernandez Fulbright & Jaworski L.L.P. 600 Congress Ave., Ste. 2400 Austin, TX 78701 UNITED STATES aotrademark@fulbright.com, aburns@fulbright.com, mhernandez@fulbright.com Phone:512.474.5201 |
|----------------------|---|

Applicant Information

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|------------------------|--|------------------------|------------|
| Application No | 78536986 | Publication date | 01/31/2006 |
| Opposition Filing Date | 05/30/2006 | Opposition Period Ends | 05/31/2006 |
| Applicant | Oralogix Corporation 8011 Stenton Avenue Wyndmoor, PA 19038 UNITED STATES | | |

Goods/Services Affected by Opposition

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|--|
| Class 010. All goods and services in the class are opposed, namely: Dental prostheses |
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|-------------|---|
| Attachments | 20060530095919.pdf (9 pages)(241933 bytes) |
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| | |
|-----------|--|
| Signature | /Martin Hernandez/ |
| Name | Michael S. Metteauer, Martin Hernandez |
| Date | 05/30/2006 |

TRADEMARK

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

In the matter of Application Serial No.: 78/536,986
by Oralogix Corporation for the Mark: **ESPRI**
Filed: December 22, 2004

Published in the Official Gazette
on January 31, 2006

3M ESPE AG
Opposer,
v.

ORALOGIX CORPORATION
Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Commissioner:

3M ESPE AG, a German corporation having a principal place of business at ESPE Platz, 82229, Seefeld, Germany, believes that it will be damaged by registration of the mark in Application Serial No. 78/536,986, and hereby opposes same under the provisions of 15 U.S.C. § 1063.

As grounds of opposition, 3M ESPE AG asserts that:

1. 3M ESPE AG is the owner of the mark ESPE and uses the mark in the United States through its parent company 3M Company. 3M Company is a Delaware corporation having a principal place of business at 2501 Hudson Road, St. Paul, MN 55144. 3M ESPE AG and 3M Company are collectively referred to herein as "3M."

2. 3M has been a leader in the field of dental care for over four decades and now offers a wide range of products that facilitate the practice of dentistry.

3. 3M and its predecessors have used the mark ESPE in the United States for over four decades in connection with dental products.

4. 3M currently manufactures and markets under the mark ESPE more than 2,000 products used by dentists to improve oral health.

5. 3M's product offerings under the mark ESPE include dental prostheses (including crowns and bridges), bonding products, cement products, curing light products, direct and indirect restorative products, finishing and polishing products, impression system products, infection control products, and dental instruments and apparatus. A number of the products offered by 3M under the ESPE mark are used in connection with dental prostheses.

6. 3M ESPE AG is the owner of U.S. Trademark Reg. No. 759,295 for the mark E S P E, registered October 29, 1963, covering "insulating material for plaster casts and material for dental impressions and provisional dental filling material" in International Class 10. A true and correct copy of this registration is attached hereto as Exhibit A. This registration is valid and subsisting and is incontestable pursuant to 15 U.S.C. § 1065.

7. 3M ESPE AG is the owner of U.S. Trademark Reg. No. 1,158,767 for the mark ESPE, registered June 30, 1981, covering "chemical products for dental uses-namely, plastics in the form of pastes or powders and materials mainly consisting of plastics in the form of pastes or powders for tooth crowns, tooth bridges, artificial teeth and plastic prostheses; plastics for use as modeling material for dental purposes; impression material for dental uses; dental fillers; dental lacquers; insulating material for dental uses, such as gypsum models for the manufacture of plastic tooth prostheses; drying and cleaning material for teeth" in International Class 5, and "medical,

dental and veterinary instruments-namely, hypodermic needles, injection supports for cylinder ampoules; electronic mixers for dental compounds; and light sources for curing polymerizing dental materials” in International Class 10. A true and correct copy of this registration is attached hereto as Exhibit B. This registration is valid and subsisting and is incontestable pursuant to 15 U.S.C. § 1065.

8. 3M offers under the mark ESPERTISE an interactive CD-ROM containing educational information about the use of 3M’s dental products. 3M has also offered a newsletter containing information on 3M’s dental products under the ESPERTISE mark.

9. 3M and its predecessors have expended considerable effort and expense in promoting the ESPE and ESPERTISE marks and the products and services offered under those marks with the result that the purchasing public has come to know, rely upon and recognize the products and services of 3M by such marks. 3M has established valuable goodwill in its ESPE and ESPERTISE marks.

10. The ESPE and ESPERTISE marks are inherently distinctive.

11. Applicant Oralogix Corporation (“Applicant”) seeks to register the mark ESPRI for “dental prostheses” in International Class 10 (“Applicant’s goods”).

12. Applicant filed its trademark application on an intent-to-use basis. In contrast, the use of the ESPE mark commenced in the U.S. many years ago, has been continuous, and has not been abandoned. 3M has used the ESPERTISE mark for approximately five years.

13. Applicant’s ESPRI mark is highly similar visually and phonetically to 3M’s marks ESPE and ESPERTISE.

14. Applicant’s mark ESPRI differs in only the last two letters from ESPE.

15. Applicant's goods are identical to products offered by 3M under the ESPE mark and are highly related to the products and services offered by 3M under the ESPERTISE mark.

16. The mark that Applicant seeks to register so resembles 3M's ESPE and ESPERTISE marks as to be likely, when used on or in connection with Applicant's goods, to cause confusion, or to cause mistake, or to deceive. Purchasers and prospective purchasers are likely to falsely believe that Applicant's goods offered under the mark ESPRI are sponsored, endorsed, or approved by 3M, or are in some way affiliated, connected, or associated with 3M. Registration should therefore be refused under 15 U.S.C. § 1052(d).

17. Registration of the mark ESPRI would be a source of damage to 3M because purchasers are likely to attribute the source or sponsorship of Applicant's goods to 3M.

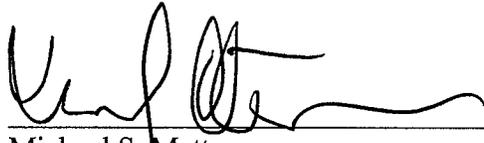
18. Registration of the mark ESPRI would be a further source of damage to 3M, as it would confer upon Applicant various statutory presumptions to which it is not entitled in view of 3M's long prior use and registration of its ESPE mark and prior use of its ESPERTISE mark.

WHEREFORE, 3M prays that Application Serial No. 78/536,986 be rejected, and that registration of the mark therein be refused.

The filing fee in the amount of \$300.00 required by 37 C.F.R. § 2.6(l) is being filed herewith. The Commissioner is authorized to draw on the Deposit Account of Fulbright & Jaworski L.L.P., Account No. 50-1212/10602535/THRT:160/MSM, if the accompanying payment is insufficient or inadvertently omitted.

Date: 5/26/06

Respectfully submitted,



Michael S. Metteauer
FULBRIGHT & JAWORSKI L.L.P.
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Austin, Texas 78701
(512) 474-5201

ATTORNEYS FOR 3M ESPE AG

EXHIBIT A

United States Patent Office

759,295
Registered Oct. 29, 1963

PRINCIPAL REGISTER Trademark

Ser. No. 119,948, filed May 15, 1961

E S P E

Espe Fabrik Pharmazeutischer Präparate G.m.b.H. (German limited liability corporation)
Seefeld, Upper Bavaria, Germany

For: INSULATING MATERIAL FOR PLASTER
CASTS AND MATERIAL FOR DENTAL IMPRES-
SIONS AND PROVISIONAL DENTAL FILLING MA-
TERIAL, in CLASS 44.

Owner of German Reg. No. 642,977, dated Aug. 21,
1953.

EXHIBIT B

Int. Cls.: 5 and 10

Prior U.S. Cl.: 44

United States Patent and Trademark Office

Reg. No. 1,158,767

Registered Jun. 30, 1981

TRADEMARK

Principal Register

ESPE

Espe Fabrik Pharmazeutischer Präparate GmbH (Fed.
Rep. of Germany limited joint stock company)
Seefeld, Oberbayern, Fed. Rep. of Germany

For: CHEMICAL PRODUCTS FOR DENTAL USES—NAMELY, PLASTICS IN THE FORM OF PASTES OR POWDERS AND MATERIALS MAINLY CONSISTING OF PLASTICS IN THE FORM OF PASTES OR POWDERS FOR TOOTH CROWNS, TOOTH BRIDGES, ARTIFICIAL TEETH AND PLASTIC PROSTHESES; PLASTICS FOR USE AS MODELING MATERIAL FOR DENTAL PURPOSES; IMPRESSION MATERIAL FOR DENTAL USES; DENTAL FILLERS; DENTAL LACQUERS; INSULATING MATERIAL FOR DENTAL USES, SUCH AS GYPSUM MODELS FOR THE MANUFACTURE OF PLASTIC TOOTH PROSTHESES; DRYING AND CLEANING MATERIAL FOR TEETH, in CLASS 5 (U.S. Cl. 44).

For: MEDICAL, DENTAL AND VETERINARY INSTRUMENTS—NAMELY, HYPODERMIC NEEDLES, INJECTION SUPPORTS FOR CYLINDER AMPOULES, ELECTRONIC MIXERS FOR DENTAL COMPOUNDS, AND LIGHT SOURCES FOR CURING POLYMERIZING DENTAL MATERIALS, in CLASS 10 (U.S. Cl. 44).

Priority claimed under Sec. 44(d) on Fed. Rep. of Germany application No. E21,302, filed Jan. 26, 1980, Reg. No. 998,138, dated Feb. 22, 1980, expires Jan. 26, 1990.

Ser. No. 263,035, filed May 21, 1980.

ROBERT PEVERADA, Primary Examiner