

ESTTA Tracking number: **ESTTA108582**

Filing date: **11/08/2006**

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 parties oppose registration of the indicated application.

Opposers Information

Name	Henkel KGaA
Granted to Date of previous extension	11/08/2006
Address	Henkelstrasse 67 Duesseldorf, D-40191 GERMANY

Name	Henkel Consumer Adhesives, Inc.
Granted to Date of previous extension	11/08/2006
Address	32150 Just Imagine Drive Avon, OH 44011-1335 UNITED STATES

Attorney information	Christel Emerson Henkel of America, Inc. 2200 Renaissance Boulevard, The Triad, Suite 200 Gulph Mills, PA 19406 UNITED STATES christel.emerson@us.henkel.com, christine.mchale@us.henkel.com Phone:610-270-8163
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Applicant Information

Application No	78576190	Publication date	07/11/2006
Opposition Filing Date	11/08/2006	Opposition Period Ends	11/08/2006
Applicant	Bison Capital LLC 981 Ridgewood Ave Suite 105 Venice, FL 34285 UNITED STATES		

Goods/Services Affected by Opposition

<p>Class 017. All goods and services in the class are opposed, namely: Adhesive tape for industrial and commercial use; tape having pressure sensitive adhesive on one side, tape for use in the hunting, fishing and recreational outdoor applications; adhesive tape, sealing tape, insulating tape, reinforcing tape and decorative tape for outdoor, hunting and fishing use; featuring tape with imprinted outdoor, camo, hunting or fishing motives</p>

Attachments	BUCKTAPE_NOTopp110806.pdf (14 pages)(613959 bytes)
Signature	/christel emerson/
Name	Christel Emerson
Date	11/08/2006

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

In the Matter of Application Serial No. : 78/576,190
Filed : February 28, 2005
For the Mark : BUCK TAPE
Published in the *Official Gazette* on : July 11, 2006

Henkel KGaA :
and :
Henkel Consumer Adhesives, Inc. :

Opposers : Opposition No.: _____

vs. :

Bison Capital LLC :

Applicant :

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

NOTICE OF OPPOSITION

Henkel KGaA, a German partnership limited by shares, having offices at Henkelstrasse 67, D-40191 Duesseldorf, Germany, (“Henkel KGaA”), and Henkel Consumer Adhesives, Inc., a corporation organized under the laws of Ohio, having offices at 32150 Just Imagine Drive, Avon, Ohio 44011-1335 (“HCA”), (together the “Opposers”), believe that they will be damaged by registration of the mark shown in the above-referenced application, which was published in the Official Gazette of July 11, 2006, and hereby oppose issuance of the registration.

As grounds for opposition, Opposers allege that:

1. On February 28, 2005, Applicant Bison Capital LLC filed intent-to-use trademark application Serial No. 78/576,190 for the mark BUCK TAPE for the following goods: adhesive tape for industrial and commercial use; tape having pressure sensitive adhesive on one side, tape for use in the hunting, fishing and recreational outdoor applications; adhesive tape, sealing tape, insulating tape, reinforcing tape and decorative tape for outdoor, hunting and fishing use; featuring tape with imprinted outdoor, camo (sic), hunting or fishing motives (sic), (“Applicant’s Goods”).
2. Opposers have obtained extensions of time to oppose this application up until now.
3. Upon information and belief, Applicant has not yet used BUCK TAPE in Commerce on or in association with any of the goods set forth in the application so that Applicant’s filing date is the earliest first use date it can claim.
4. Opposers, their predecessor in interest, and/or related companies have used the trademarks DUCK TAPE, DUCK and various DUCK Design marks (collectively the “DUCK TAPE Marks”) in Commerce beginning at least as early as January 14, 1980 in association with a variety of tapes, adhesives and related goods.
5. Opposer Henkel KGaA, by assignment from Opposer HCA, is the owner of Registration No. 1,223,446 for the trademark DUCK TAPE for “elongated tape having a pressure sensitive adhesive on one side,” which registration is valid and incontestable. Opposers and their predecessor in interest have used the DUCK TAPE trademark since at least as early as January 14, 1980. A copy of Registration No. 1,223,446 is attached hereto at Exhibit A.
6. Opposer Henkel KGaA, by assignment from Opposer HCA, is the owner of Registration No. 1,391,591 for the trademark DUCK for “elongated tape having a pressure sensitive adhesive on one side,” which registration is valid and incontestable. Opposers and their predecessor in interest have used the DUCK trademark since at least as early as April 19, 1985. A copy of Registration No. 1,391,591 is attached hereto at Exhibit B.

7. Opposer Henkel KGaA, by assignment from Opposer HCA, is the owner of Registration No. 1,431,129 for the trademark DESIGN OF A DUCK for “elongated tape having a pressure sensitive adhesive on one side,” which registration is valid and incontestable. Opposers and their predecessor in interest have used the DESIGN OF A DUCK trademark since at least as early as January 14, 1980. A copy of Registration No. 1,431,129 is attached hereto at Exhibit C.
8. Opposer Henkel KGaA, by assignment from Opposer HCA, is the owner of Registration No. 2,060,608 for the trademark DESIGN OF A DUCK for, inter alia, “adhesive tape for household use,” which registration is valid and incontestable. Opposers and their predecessor in interest have used the DESIGN OF A DUCK trademark since at least as early as July 30, 1995. A copy of Registration No. 2,060,608 is attached hereto at Exhibit D.
9. Opposer Henkel KGaA, by assignment from Opposer HCA, is the owner of Registration No. 2,922,717 for the trademark DESIGN OF A DUCK for “elongated tape having a pressure sensitive adhesive on one side,” which registration is valid. Opposers and their predecessor in interest have used the DESIGN OF A DUCK trademark since at least as early as 1984. A copy of Registration No. 2,922,717 is attached hereto at Exhibit E.
10. Opposer Henkel KGaA, by assignment from Opposer HCA, is the Applicant for intent to use Application Serial No. 75/658,203 for the trademark DUCK, filed March 11, 1999, covering, inter alia, “adhesives for stationery or household purposes and dispensers and applicators therefore; adhesive tapes for stationery or household purposes and dispensers therefore; adhesive mounting tapes and tabs for stationery or household purposes; correction tape and applicators therefore; materials for packaging, namely mailing, packaging, and masking tapes, carton sealing tape; adhesive, duct, masking, sealing, insulating and strapping tapes in tape and strip form, and dispensers therefore for industrial, commercial and household use; drywall joint tape, pre-taped plastic sheeting for use as drop cloths; weather-stripping for home use; window insulating materials, namely window insulating kits consisting of clear plastic film and adhesive tape.” A copy of Application Serial No. 75/658,203 is attached hereto at Exhibit F.

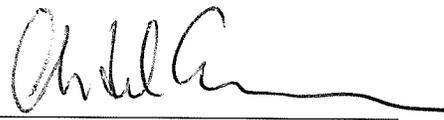
11. Opposer Henkel KGaA, by assignment from Opposer HCA, is the Applicant for Application Serial No. 78/531,763 for the trademark DUCK and Design, filed December 13, 2004, covering, inter alia, “home insulation products, namely foam tapes, adhesive-backed sealing tapes; duct tape; masking tape; adhesive tapes, namely, rug and carpet tape, electrical tape, joint tape, metal repair tape, drywall tape, automotive tape; paint preparation products, namely, painting tape, dispensers for painting tape; adhesives for stationery and household purposes; adhesive tapes for stationery and household purposes, and for hobbies and crafts; dispensers for adhesive tape; mounting tapes; moving and storage supplies, namely, packaging tape, strapping tape, tape dispensers.” Opposers have used the DUCK and Design mark since at least as early as October 25, 2002. A copy of Application Serial No. 78/531,763 is attached hereto at Exhibit G.
12. Opposer HCA is the exclusive licensee of Opposer Henkel KGaA for the DUCK TAPE Marks.
13. Opposers have invested considerable effort and resources in advertising and promoting the DUCK TAPE Marks and the goods sold under the marks, with the result that the purchasing public has come to know, rely upon, and recognize the goods of Opposers by the DUCK TAPE Marks. Opposers have established valuable goodwill in the DUCK TAPE Marks and the DUCK TAPE Marks have become well known to the purchasing public.
14. There is no issue as to priority. Opposers have used and registered the DUCK TAPE Marks since long before the Applicant’s application date.
15. The goods identified in Applicant’s application are identical or virtually identical to the goods with which Opposers’ DUCK TAPE Marks are used and for which they are registered, and Applicant’s Goods are intended for sale to the same customers and through the same channels of trade.
16. Applicant’s proposed trademark BUCK TAPE so resembles Opposers’ DUCK TAPE Marks as to be likely, when applied to Applicant’s Goods, to cause confusion or to cause mistake or to deceive within the meaning of 15 U.S.C. §1052(d).
17. Registration should therefore be refused under 15 U.S.C. §1052(d).

18. Registration of Applicant's proposed mark on the Principal Register would be inconsistent with Opposers' rights under the aforementioned registration, and its common-law rights, and would be damaging to Opposers.

WHEREFORE, Opposers pray that the opposition be sustained and that the registration sought by Applicant be refused.

Respectfully submitted,

By:



Christel Emerson
Attorney for Opposers
c/o Henkel of America, Inc.
2200 Renaissance Boulevard
Suite 200, The Triad
Gulph Mills, PA 19406
Telephone: (610) 270-8163

Dated: November 8, 2006

Int. Cl.: 17

Prior U.S. Cl.: 5

United States Patent and Trademark Office

Reg. No. 1,223,446

Registered Jan. 11, 1983

TRADEMARK
Principal Register

DUCK TAPE

Manco Tape, Inc. (Ohio corporation)
2040 W. 110 St.
Cleveland, Ohio 44107

For: ELONGATED TAPE HAVING A PRES-
SURE SENSITIVE ADHESIVE ON ONE SIDE,
in CLASS 17 (U.S. Cl. 5).

First use Jan. 14, 1980; in commerce Jan. 14, 1980.

Applicant disclaims the word "Tape" apart from
the mark as shown.

Ser. No. 300,816, filed Mar. 12, 1981.

ROBERT M. ANDERSON, Examining Attorney

EXHIBIT A

Int. Cl.: 17

Prior U.S. Cl.: 5

United States Patent and Trademark Office

Reg. No. 1,391,591

Registered Apr. 29, 1986

**TRADEMARK
PRINCIPAL REGISTER**

DUCK

MANCO, INC. (OHIO CORPORATION)
2040 WEST 110TH STREET
CLEVELAND, OH 44102

FIRST USE 4-19-1985; IN COMMERCE
4-19-1985.

OWNER OF U.S. REG. NOS. 1,202,030,
1,223,445, AND 1,223,446.

FOR: ELONGATED TAPE HAVING A PRES-
SURE SENSITIVE ADHESIVE ON ONE SIDE,
IN CLASS 17 (U.S. CL. 5).

SER. NO. 560,478, FILED 9-27-1985.

FRED MANDIR, EXAMINING ATTORNEY

EXHIBIT B

Int. Cl.: 17

Prior U.S. Cl.: 5

United States Patent and Trademark Office **Reg. No. 1,431,129**
Registered Mar. 3, 1987

**TRADEMARK
PRINCIPAL REGISTER**



MANCO, INC. (OHIO CORPORATION)
P.O. BOX 685
CLEVELAND, OH 44107

FIRST USE 4-0-1985; IN COMMERCE
4-0-1985.
OWNER OF U.S. REG. NOS. 1,202,030, 1,346,147
AND OTHERS.

FOR: ELONGATED TAPE HAVING A PRES-
SURE SENSITIVE ADHESIVE ON ONE SIDE,
IN CLASS 17 (U.S. CL. 5).

SER. NO. 601,265, FILED 5-29-1986.

CRAIG R. GILBERT, EXAMINING ATTORNEY

EXHIBIT C

Int. Cls.: 16 and 20

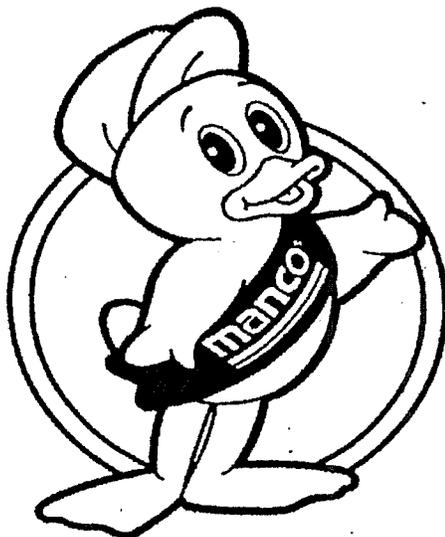
Prior U.S. Cls.: 2, 5, 13, 22, 23, 25, 29, 32, 37, 38
and 50

United States Patent and Trademark Office

Reg. No. 2,060,608

Registered May 13, 1997

**TRADEMARK
PRINCIPAL REGISTER**



MANCO, INC. (OHIO CORPORATION)
32150 JUST IMAGINE DRIVE
AVON, OH 44011

FOR: CARDBOARD BOXES FOR MAILING
AND SHIPPING PURPOSES; WRAPPING
PAPER; TISSUE PAPER; PRINTED, PARTIAL-
LY PRINTED AND BLANK PAPER LABELS;
ADHESIVE TAPE FOR HOUSEHOLD USE;
ARTS AND CRAFT PAINT KITS FOR CHILD-
REN CONTAINING PAINTS, GLUE, PAPER
AND CARDBOARD SHEETS, PLASTIC EYES,
POM-POMS AND VARIOUS SIMILAR DECO-

RATIVE ITEMS, IN CLASS 16 (U.S. CLS. 2, 5, 22,
23, 29, 37, 38 AND 50).

FIRST USE 7-30-1995; IN COMMERCE
7-30-1995.

FOR: PLASTIC SHELF LINING MATERIAL,
IN CLASS 20 (U.S. CLS. 2, 13, 22, 25, 32 AND 50).

FIRST USE 7-30-1995; IN COMMERCE
7-30-1995.

OWNER OF U.S. REG. NOS. 1,346,147 AND
1,718,096.

SER. NO. 75-015,228, FILED 11-6-1995.

BRIAN WEBER, EXAMINING ATTORNEY

EXHIBIT D

Int. Cl.: 17

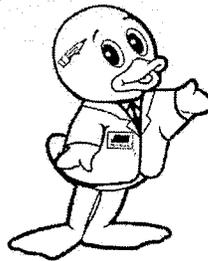
Prior U.S. Cls.: 1, 5, 12, 13, 35 and 50

United States Patent and Trademark Office

Reg. No. 2,922,717

Registered Feb. 1, 2005

TRADEMARK
PRINCIPAL REGISTER



HENKEL CONSUMER ADHESIVES, INC. (OHIO
CORPORATION)
32150 JUST IMAGINE DRIVE
AVON, OH 440111335

FOR: ELONGATED TAPE HAVING A PRESSURE
SENSITIVE ADHESIVE ON ONE SIDE, IN CLASS 17
(U.S. CLS. 1, 5, 12, 13, 35 AND 50).

FIRST USE 0-0-1984; IN COMMERCE 0-0-1984.

OWNER OF U.S. REG. NOS. 1,332,145, 2,060,608
AND OTHERS.

THE MARK CONSISTS OF A STYLIZED DUCK
WEARING A JACKET WITH A PATCH ON THE
RIGHT BREAST POCKET CONTAINING ILLEGI-
BLE WRITING.

SER. NO. 78-269,183, FILED 7-1-2003.

CAROLINE WOOD, EXAMINING ATTORNEY

EXHIBIT E



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Word Mark DUCK

Goods and Services IC 016. US 002 005 022 023 029 037 038 050. G & S: Adhesives for stationery or household purposes and dispensers and applicators therefor; adhesive tapes for stationery or household purposes and dispensers therefor; adhesive mounting tapes and tabs for stationery or household purposes; correction tape and applicators therefor; artists' materials, namely arts and crafts kits consisting primarily of paints, glue and decorative items, such as glitter, stickers, pom poms, beads and strings; office requisites, namely office organizers for stationery use, file folders, labels, note pads, highlighting pens; materials for packaging, namely mailing, packaging, and masking tapes, carton sealing tape, cardboard boxes, paper containers, envelopes, cushioned envelopes, cushions and padding for packing purposes; packing paper, wrapping paper, tissue paper, labels; printed newsletters on the subject of entrepreneurship, marketing, business relations, and management

IC 017. US 001 005 012 013 035 050. G & S: Adhesive, duct, masking, sealing, insulating and strapping tapes in tape and strip form, and dispensers therefor for industrial, commercial and household use; drywall joint tape, pre-taped plastic sheeting for use as drop cloths; weather-stripping for home use; window insulating materials, namely window insulating kits consisting of clear plastic film and adhesive tape

IC 020. US 002 013 022 025 032 050. G & S: Plastic mats and sheets for household and domestic use, namely plastic shelf lining material

Mark Drawing Code (1) TYPED DRAWING**Design Search Code****Serial Number** 75658203**Filing Date** March 11, 1999**Current Filing Basis** 1B**Original Filing Basis** 1B**Published for Opposition** December 12, 2006**Owner** (APPLICANT) HENKEL KOMMANDITGESELLSCHAFT AUF AKTIEN PARTNERSHIP LIMITED BY SHARES FED REP GERMANY HENKELSTRASSE 67 DUESSELDORF D-40191 FED REP GERMANY**Assignment Recorded** ASSIGNMENT RECORDED**Attorney of Record** Christel Emerson

EXHIBIT F

Prior Registrations 1202030;1223446;1332145;1340696;1346147;1391591;1431129;AND OTHERS
Type of Mark TRADEMARK
Register PRINCIPAL
Live/Dead Indicator LIVE

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Word Mark DUCK

Goods and Services IC 017. US 001 005 012 013 035 050. G & S: Home insulation products, namely foam tapes, adhesive-backed foam insulation, foam sealant kits for electrical outlets, rope caulk, sealing kits for air conditioners and turbines, adhesive-backed sealing tapes, foam pipe covers, foam faucet covers; duct tape; masking tape; adhesive tapes, namely, rug and carpet tape, electrical tape, joint tape, metal repair tape, drywall tape, automotive tape; paint preparation products, namely, painting tape, dispensers for painting tape, adhesive cleaner, drop cloths, tack cloths. FIRST USE: 20021025. FIRST USE IN COMMERCE: 20021025

IC 041. US 100 101 107. G & S: Entertainment services, namely providing on-line computer games and contests, interactive comedic and humorous information and advice in the field of duct tape and duct tape usage on a website via a global computer network; Entertainment services, namely conducting contests at proms. FIRST USE: 20030307. FIRST USE IN COMMERCE: 20030307

IC 020. US 002 013 022 025 032 050. G & S: Moving and storage supplies, namely, storage bags, furniture bags and covers made of plastic; kitchen, bath and home storage and organization products, namely shelving. FIRST USE: 20031024. FIRST USE IN COMMERCE: 20031024

IC 016. US 002 005 022 023 029 037 038 050. G & S: Adhesives for stationery and household purposes; adhesive tapes for stationery and household purposes, and for hobbies and crafts; dispensers for adhesive tape; office, school and art supplies, namely, self-stick labels, poster paper, mounting tapes, adhesive-backed hook and loop material for mounting purposes, mounting putty, laminating sheets and pouches, laminating machines; packaging, mailing and shipping materials, moving and storage supplies, namely, packaging tape, strapping tape, tape dispensers, stretch wrap, packing kits for glassware and dishes, cardboard mailing and shipping boxes and containers, envelopes, plastic and paper cushioned envelopes for packaging and mailing purposes, plastic cellular wrap with air cushioned pockets for wrapping and packaging, wrapping paper, paper mail pouches, plastic sheets for covering shelves and drawers. FIRST USE: 20020725. FIRST USE IN COMMERCE: 20020725

IC 021. US 002 013 023 029 030 033 040 050. G & S: Kitchen, bath and shower accessories, namely, humidity absorbers, suction hooks, turntables in the nature of a lazy Susan, containers for household, kitchen and bath use, toilet brushes, squeegees, plungers, bath and shower mats, kitchen sink mats. FIRST USE: 20031024. FIRST USE IN COMMERCE: 20031024

Mark Drawing (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Code

Design 03.15.06 - Ducks; Geese; Swan
Search Code 03.15.24 - Stylized birds and bats
24.09.07 - Advertising, banners; Banners

Serial Number 78531763

Filing Date December 13, 2004

Current Filing Basis 1A

Original Filing Basis 1A

Owner (APPLICANT) HENKEL KOMMANDITGESELLSCHAFT AUF AKTIEN PARTNERSHIP LIMITED BY SHARES FED REP GERMANY HENKELSTRASSE 67 DUESSELDORF D-40191 FED REP GERMANY

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record Christel Emerson

Prior Registrations 1223446;1391591;2060608;AND OTHERS

Description of Mark The mark consists of a duck wearing a cap with his one arm outstretched placed in front of a circle and above a banner in which the word DUCK appears.

Type of Mark TRADEMARK. SERVICE MARK

Register PRINCIPAL

Live/Dead Indicator LIVE

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