

ESTTA Tracking number: **ESTTA112086**

Filing date: **11/29/2006**

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	Guthy-Renker Corporation
Granted to Date of previous extension	11/29/2006
Address	41-550 Eclectic Street, Suite 200 Palm Desert, CA 92260 UNITED STATES
Correspondence information	Marnie Wright Barnhorst, Esq. Attorney for Opposer The Trademark Group, APLC 1200 Prospect Street, G-100 La Jolla, CA 92037 UNITED STATES docketing@trademarkgroup.com Phone:(858) 456-4801

Applicant Information

Application No	78772403	Publication date	08/01/2006
Opposition Filing Date	11/29/2006	Opposition Period Ends	11/29/2006
Applicant	BOTICA COMERCIAL FARMACÊUTICA LTDA. Av. Rui Barbosa, 3450 S. Jose dos Pinhais - PR, 83065-260 BRAZIL		

Goods/Services Affected by Opposition

Class 003. All goods and sevicees in the class are opposed, namely: Products for skin care, namely, skin cleansing lotions, skin tonics, skin refreshing mousse, skin refreshing lime, skin masks and skin exfoliants
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Attachments	PROACTIV - PREACTIVE O BOTICARIO NOO.pdf (4 pages)(29271 bytes)
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Signature	/MWB/
Name	Marnie Wright Barnhorst, Esq.
Date	11/29/2006

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

Guthy-Renker Corporation) Opposition No. _____
)
) In the matter of Application
) Serial No. 78/772,403
vs.) Mark: PRACTIVE O
) BOTICÁRIO
) Published in the *Official Gazette* on
) August 1, 2006
)
Botica Comercial Farmaceutica Ltda.)

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

NOTICE OF OPPOSITION

OPPOSER'S STANDING

1. Opposer is the owner of United States Trademark Registration No. 1,890,769 for the word mark PROACTIV which issued on April 25, 1995 from an application filed on September 30, 1991. Opposer is also the owner of United States Trademark Registration No. 2,850,933 for the stylized mark PROACTIV SOLUTION Stylized which issued on June 8, 2004 from an application filed on May 22, 2003.

2. Opposer or its predecessors have since at least as early as February 15, 1991 used the mark PROACTIV in connection with acne treatment preparations and skin care preparations, since at least as early as February 7, 1995 used the mark with hair care preparations and since at least as early as October 16, 1991 used the mark with make-up and sunscreen preparations. These dates are between eleven and fifteen years prior to the December 13, 2005 filing date of Applicant's mark PRACTIVE O BOTICÁRIO skin care, namely, skin cleansing lotions, skin tonics, skin refreshing mousse, skin refreshing lime, skin masks and skin exfoliants.

3. Opposer or its predecessors have since as early as October 16, 1991 used the mark PROACTIV SOLUTION Stylized in connection with make-up, foundation make-up, skin

concealer, face powder, sunscreen preparations, and acne treatment preparations.

4. Opposer's trademarks have been popular and well-known throughout the U.S. for the past fifteen years. The marks are, therefore, entitled to strong protection under trademark law.

5. Said marks of Opposer are symbolic of extensive good will and consumer recognition built through substantial effort and expense in advertising and promotion over a fifteen year period. The product has acquired extensive fame and notoriety in the United States and throughout the world because of its celebrity endorsements. Registration of Applicant's alleged mark would deprive Opposer of the exclusive use of its trademarks, would infringe said trademarks, would violate Opposer's rights therein, would expose Opposer to further violation of its trademarks by others, and would diminish the commercial value of the trademarks to Opposer in various ways. In addition, such registration would be a source of damage and injury to Opposer's customers.

GROUND FOR OPPOSITION

6. Opposer has clear priority of use. Opposer's date of first use is February 15, 1991. Applicant's application is based on "intent-to-use" in commerce. Thus, Opposer has at least fifteen years of priority over Applicant.

7. The alleged mark PRACTIVE O BOTICÁRIO intended to be registered by the Applicant is nearly confusingly similar to Opposer's mark(s). Consumers are highly likely to be confused into thinking this alleged mark is related to Opposer. They are even more likely to be confused because Applicant's alleged mark and Opponent's marks are used in the same industry, the skin care/cosmetics industry. Applicant proposes to sell products for skin care, namely, skin cleansing lotions, skin tonics, skin refreshing mousse, skin refreshing lime, skin masks and skin exfoliants. Use and registration of Applicant's alleged mark PRACTIVE O

BOTICÁRIO will cause confusion, mistake or deception. The public is likely to be deceived as to the source of Applicant's goods and/or falsely infer a connection with or endorsement by Opposer. In view of the similarity of the respective marks and the related nature of the goods of the respective parties, it is alleged that Applicant's mark so resembles Opposer's marks previously used in the United States, and not abandoned, as to be likely to cause confusion, or to cause mistake, or to deceive.

8. Consequently, Applicant's alleged mark does not and cannot exclusively identify goods on which it is used as the goods of the Applicant, nor can it serve as an indication of the source of origin of such goods. Therefore, Applicant should not be entitled to registration of its alleged mark.

9. On information and belief Applicant's alleged mark PREACTIVE O BOTICÁRIO was adopted in bad faith with knowledge of Opposer's prior and superior rights in the PROACTIV and PROACTIV SOLUTION Stylized marks. On information and belief Applicant knew it was not entitled to the mark for which it seeks registration, but nevertheless alleged ownership of the mark and swore that no one else had the right to use the same or similar mark in commerce. Applicant should, therefore, not be entitled to registration of its alleged mark.

10. On information and belief Applicant adopted an alleged mark confusingly similar to Opposer's marks in order to trade on the extensive good will acquired through the expense and efforts of the Opposer over a fifteen year period. On information and belief Applicant intends to mislead the public into believing it is associated with or endorsed by the Opposer in order to gain an unfair advantage in the marketplace. Applicant should, therefore, not be entitled to registration of its alleged mark.

11. Opposer or its predecessors have had trademark rights in the PROACTIV and PROACTIV SOLUTION Stylized marks for over fifteen years. Opposer has invested hundreds of thousands of dollars in the development of good will in these properties and in the

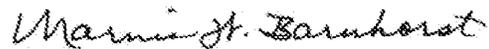
protection of them as trademarks in the United States and foreign countries. Therefore, Applicant should choose a new mark, one which is not confusingly similar and one that is not an unfair attempt to take advantage of Opposer's years of work and financial investment to develop a famous mark.

12. Opposer's mark has since at least as early as 2002 become famous and use of the proposed mark would cause dilution of the distinctive quality of the mark.

13. Opposer hereby gives notice under 37 C.F.R. 2.122 that at any hearing and on any appeal of this opposition proceeding it will rely on any existing trademark and copyright registrations, common law trademark rights, and pending trademark applications.

WHEREFORE, Opposer prays that this opposition be sustained in favor of Opposer, that application Serial No. 78/772,403 be rejected, and that no registration be issued thereon to Applicant.

Respectfully submitted,



Marnie Wright Barnhorst, Esq.
Registration Number 36,740

Date: November 29, 2006

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