

ESTTA Tracking number: **ESTTA145027**

Filing date: **06/08/2007**

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	Nice-Pak Products, Inc.
Granted to Date of previous extension	06/10/2007
Address	Two Nice-Pak Park Orangeburg, NY 10962 UNITED STATES

Attorney information	Keith E. Sharkin King & Spalding LLP 1185 Avenue of the Americas New York, NY 10036 UNITED STATES nytrademarks@kslaw.com,ksharkin@kslaw.com,mrupp@kslaw.com
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Applicant Information

Application No	76630045	Publication date	12/12/2006
Opposition Filing Date	06/08/2007	Opposition Period Ends	06/10/2007
Applicant	PDI, Inc. Saddle River Executive Center (SREC) 1 Route 17 South Saddle River, NJ 07458 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 2001/04/05 First Use In Commerce: 2001/04/05 All goods and services in the class are opposed, namely: Promoting and marketing of medical equipment, pharmaceutical products and medicines of others; and providing employment staffing featuring auxiliary medical personnel to deal with customer care of patients by companies to which such personnel are assigned
Class 041. All goods and services in the class are opposed, namely: Education services, namely conducting classes, seminars, conferences and workshops in the field of drug, healthcare and medical issues

Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1163330	Application Date	07/29/1977
Registration Date	08/04/1981	Foreign Priority Date	NONE
Word Mark	PDI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 1975/07/01 First Use In Commerce: 1975/07/01 Flexible Pouch Containing Medicinals Such as: a Non Woven Fiber Impregnated with 70% Isopropyl Alcohol; Non Woven Towelette Containing Benzalkonium Chloride; Applicator Impregnated with Adhesive Solubilizer for Adhesive Removal; Non Woven Applicator Impregnated with Iodine Poloxamer Preparation; Rayon Tipped Plastic Applicator Impregnated with Poloxamer Iodine Preparation; Rayon Tipped Swabs Moistened with Glycerin and Lemon Flavor; Applicator Impregnated with Deodorant Material; Castile Soap Consisting of Soap Water Glycerin as a Soap Suds Enema; Electrode Skin Prep Pad Consisting of Applicator Alcohol and Pumice; Towelette Impregnated with Poloxamer Iodine Compound; Liquid Benzalkonium Chloride and Isopropyl Alcohol; Scrub Sponge Consisting of Plastic Hand and Nail Brush Combined with Porous Sponge Impregnated with Poloxamer Iodine and Lathering Agent; Water Soluble Lube Jelly; and the Like		

U.S. Registration No.	2367823	Application Date	12/04/1998
Registration Date	07/18/2000	Foreign Priority Date	NONE
Word Mark	PDI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1975/07/01 First Use In Commerce: 1975/07/01 Pre-moistened cosmetic towelettes for personal cleansing and skin cleansers Class 005. First use: First Use: 1975/07/01 First Use In Commerce: 1975/07/01 Pre-moistened medicated towelettes and pads impregnated with antiseptic, iodine or alcohol; pre-moistened medicated cotton swabs; pre-moistened medicated wipes for perineal use impregnated with disinfectants namely antimicrobials		

Related Proceedings	Opposition No 91177663
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Signature	/Keith E. Sharkin/
Name	Keith E. Sharkin
Date	06/08/2007

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

In the Matter of Application
Serial No. 76/630,045 Published
in the Official Gazette of
December 12, 2006 at Page TM 14

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NICE-PAK PRODUCTS, INC.,	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No.
	:	
PDI, INC.,	:	
	:	
Applicant.	:	
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NOTICE OF OPPOSITION

TO THE COMMISSIONER FOR TRADEMARKS:

NICE-PAK PRODUCTS, INC., a New York corporation located and doing business at Two Nice-Pak Park, Orangeburg, New York 10962 believes that it will be damaged by the registration of application Serial No. 76/630,045 for the designation PDI and Design, for promoting and marketing of medical equipment, pharmaceutical products and medicines of others; and providing employment staffing featuring auxiliary medical personnel to deal with customer care of patients by companies to which such personnel are assigned in Class 35; and educational services, namely conducting classes, seminars, conferences and workshops in the field of drug, healthcare and medical issues in Class 41, filed on January 26, 2005 by PDI, Inc., a Delaware corporation, located and doing business at Saddle River Executive Center, 1 Route 17 South, Saddle

River, New Jersey 07458, and having previously been granted extensions of time to oppose, hereby opposes the same.

The grounds for opposition are as follows:

1. Opposer, through its PDI healthcare division has been using the PDI mark in commerce for more than thirty years, and has sold and continues to sell various healthcare products using the PDI trademark, with sales throughout the United States and the world. In addition, Opposer operates its healthcare division as, and is widely referred to by the trade and public as, PDI.

2. Since at least as early as July 1, 1975, and long prior to April 5, 2001, the date of first use alleged for the Class 35 services in the application herein opposed, and January 26, 2005, the filing date of the intent-to-use application for the Class 41 services in the application herein opposed, opposer has used and continues to use the mark PDI, in interstate commerce in connection with healthcare products, including pre-moistened cosmetic and medicated towelettes, and antimicrobial skin cleansers. Since the date of first use of said mark as aforesaid, opposer has continuously used said mark to identify and distinguish opposer's goods from those of others.

3. The mark PDI is now and ever since its date of first use in 1975 has been applied to the goods and to advertisements, brochures, promotional literature, and other materials used in connection with the sale and distribution of healthcare products, including pre-moistened cosmetic and medicated towelettes, and antimicrobial skin cleansers. The goods offered for sale and sold under the mark PDI have been extensively advertised and promoted. As a result of the quality of opposer's goods, the extensive advertising for such goods, and opposer's reputation for fair dealing with the trade and the public, the mark PDI has become well-known with goodwill of inestimable value to opposer.

4. Opposer is the owner of the following registrations on the Principal Register of the United States Patent and Trademark Office:

Mark	Registration No.	Goods	Class
PDI	1,163,330	Flexible Pouch Containing Medicinals Such as: a Non Woven Fiber Impregnated with 70% Isopropyl Alcohol; Non Woven Towelette Containing Benzalkonium Chloride; Applicator Impregnated with Adhesive Solubilizer for Adhesive Removal; Non Woven Applicator Impregnated with Iodine Poloxamer Preparation; Rayon Tipped Plastic Applicator Impregnated with Poloxamer Iodine Preparation; Rayon Tipped Swabs Moistened with Glycerin and Lemon Flavor; Applicator Impregnated with Deodorant Material; Castile Soap Consisting of Soap Water Glycerin as a Soap Suds Enema; Electrode Skin Prep Pad Consisting of Applicator Alcohol and Pumice; Towelette Impregnated with Poloxamer Iodine Compound; Liquid Benzalkonium Chloride and Isopropyl Alcohol; Scrub Sponge Consisting of Plastic Hand and Nail Brush Combined with Porous Sponge Impregnated with Poloxamer Iodine and Lathering Agent; Water Soluble Lube Jelly; and the Like	5
PDI	2,367,823	Pre-moistened cosmetic towelettes for personal cleansing and skin cleansers; pre-moistened medicated towelettes and pads impregnated with antiseptic, iodine or alcohol; pre-moistened medicated cotton swabs; pre-moistened medicated wipes for perineal use impregnated with disinfectants namely antimicrobials	3, 5

Both of the above-referenced registrations are valid and subsisting, unrevoked and uncancelled, in full force and effect, and have become incontestable pursuant to 15 U.S.C. §1065.

5. By the application herein opposed, applicant seeks to register the designation PDI and Design as a service mark for “promoting and marketing of medical equipment, pharmaceutical products and medicines of others; and providing employment staffing featuring auxiliary medical personnel to deal with customer care of patients by companies to which such

personnel are assigned; education services, namely conducting classes, seminars, conferences and workshops in the field of drug, healthcare and medical issues”.

6. Applicant’s services, which are offered under the alleged mark PDI, are closely related to the goods which opposer has long used and continues to use the well-known mark PDI.

7. The services covered by the application for the alleged mark PDI will be encountered by the same or similar class of purchasers as those who are interested in or familiar with the goods promoted, offered and provided by opposer under the well-known mark PDI.

8. Applicant’s PDI designation is identical to opposer’s previously used and registered PDI mark so as to be likely, when applied to applicant’s services, to cause confusion, to cause mistake and to deceive with consequent injury to opposer and the public.

9. Applicant’s use of the PDI designation, which is identical to opposer’s previously used and registered PDI mark, would likely cause potential purchasers of the services offered under applicant’s mark to believe that opposer is the source of such services, or that opposer has authorized, sponsored, approved of, or in some other manner associated itself with the services of applicant, thereby creating a likelihood of confusion, deception or mistake, all to the damage of opposer.

10. Opposer will be damaged by the registration sought by applicant because such registration would support and assist applicant in the confusing and misleading use of applicant’s mark and would give color of exclusive statutory rights to applicant in violation and derogation of the prior and superior rights of opposer to the mark PDI.

11. By reason of the foregoing, opposer believes it will be damaged by the registration of applicant’s claimed service mark.

WHEREFORE, opposer requests that the opposition to Application Serial No. 76/630,045 for registration of PDI and Design be sustained and that the registration sought by applicant be denied.

KING & SPALDING LLP
Attorneys for Opposer

Dated: June 8, 2007

By: /Keith E. Sharkin/
 Keith E. Sharkin

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