

ESTTA Tracking number: **ESTTA152580**

Filing date: **07/23/2007**

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	MICROBAN PRODUCTS COMPANY
Granted to Date of previous extension	07/21/2007
Address	11515 Vanstory Drive Suite 125 Huntersville, NC 28078 UNITED STATES
Correspondence information	Cliff D. Weston Patent Counsel MICROBAN PRODUCTS COMPANY 11515 Vanstory Drive Suite 125 Huntersville, NC 28078 UNITED STATES cliff.weston@microban.com Phone:704-875-1178

Applicant Information

Application No	77019426	Publication date	05/22/2007
Opposition Filing Date	07/23/2007	Opposition Period Ends	07/21/2007
Applicant	Guthery, Eugene B. 111 Lukfapa St. Brokenbow, OK 74728 UNITED STATES		

Goods/Services Affected by Opposition

Class 005. All goods and services in the class are opposed, namely: Dermatological pharmaceutical products

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2227218	Application Date	04/25/1997
Registration Date	03/02/1999	Foreign Priority Date	NONE
Word Mark	MICROBAN		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 001. First use: First Use: 1994/01/23 First Use In Commerce: 1994/01/23 antimicrobial, antibacterial, and antifungal chemical additives for incorporation into plastic resins and products made from such additives, namely, fibers, fabrics, and wide variety of plastic resin consumer goods Class 040. First use: First Use: 1994/01/23 First Use In Commerce: 1994/01/23 treatment of plastic resins and products made from such plastic resins, namely, fibers and fabrics, and a wide variety of plastic resin consumer goods, with antimicrobial, antibacterial, and antifungal chemical additives

U.S. Registration No.	1141006	Application Date	04/03/1978
Registration Date	11/04/1980	Foreign Priority Date	NONE
Word Mark	MICROBAN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 001. First use: First Use: 1975/09/17 First Use In Commerce: 1975/09/17 Additive to Impart Antibacterial, Antifungal and Antimicrobial Properties to Plastic Resins		

U.S. Registration No.	2220264	Application Date	09/10/1997
Registration Date	01/26/1999	Foreign Priority Date	NONE
Word Mark	MICROBAN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 040. First use: First Use: 1975/09/17 First Use In Commerce: 1975/09/17 treatment of plastic resins and products made from such plastic resins, namely, fibers and fabrics, and a wide variety of plastic resin consumer goods, with antimicrobial, antibacterial, and antifungal chemical additives		

U.S. Registration No.	2611477	Application Date	05/08/2000
Registration Date	08/27/2002	Foreign Priority Date	NONE
Word Mark	MICROBAN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 001. First use: First Use: 1975/09/17 First Use In Commerce: 1975/09/17 ANTIMICROBIAL, ANTIBACTERIAL, AND ANTIFUNGAL CHEMICAL ADDITIVES FOR INCORPORATION INTO PLASTIC RESINS AND PRODUCTS MADE FROM SUCH ADDITIVES, NAMELY, FIBERS, FABRICS, AND A WIDE VARIETY OF PLASTIC RESIN CONSUMER GOODS		

U.S. Registration No.	2380284	Application Date	02/02/1998
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Registration Date	08/29/2000	Foreign Priority Date	NONE
Word Mark	MICROBAN ANTIBACTERIAL PROTECTION		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 001. First use: First Use: 1995/10/00 First Use In Commerce: 1995/10/00 antimicrobial, antibacterial, and antifungal chemical additives for incorporation into plastic resins and products made from such additives, namely, fibers, fabrics, and a wide variety of plastic resin consumer goods</p> <p>Class 040. First use: First Use: 1995/10/00 First Use In Commerce: 1995/10/00 treatment of plastic resins and products made from such plastic resins, namely, fibers, fabric, and a wide variety of plastic resin consumer goods, with antimicrobial, antibacterial, and antifungal chemical additives</p>		

U.S. Registration No.	2365607	Application Date	02/02/1998
Registration Date	07/11/2000	Foreign Priority Date	NONE
Word Mark	MICROBAN ANTIMICROBIAL PROTECTION		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 001. First use: First Use: 1995/05/00 First Use In Commerce: 1995/05/00 antimicrobial, antibacterial, and antifungal chemical additives for incorporation into plastic resins and products made from such additives, namely, fibers, fabrics, and a wide variety of plastic resin consumer goods</p> <p>Class 040. First use: First Use: 1995/05/00 First Use In Commerce: 1995/05/00 treatment of plastic resins and products made from such plastic resins, namely, fibers, fabric, and a wide variety of plastic resin consumer goods, with antimicrobial, antibacterial, and antifungal chemical additives</p>		

U.S. Registration No.	2365610	Application Date	02/04/1998
Registration Date	07/11/2000	Foreign Priority Date	NONE
Word Mark	MICROBAN PROTECTION		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 001. First use: First Use: 1995/10/00 First Use In Commerce: 1995/10/00 antimicrobial, antibacterial, and antifungal chemical additives for incorporation into plastic resins and products made from such additives, namely, fibers, fabrics, and a wide variety of plastic resin consumer goods</p> <p>Class 040. First use: First Use: 1995/10/00 First Use In Commerce: 1995/10/00 treatment of plastic resins and products made from such plastic resins, namely, fibers, fabric, and a wide variety of plastic resin consumer goods, with antimicrobial, antibacterial, and antifungal chemical additives</p>		

U.S. Registration No.	2330038	Application Date	10/02/1995
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Registration Date	03/14/2000	Foreign Priority Date	NONE
Word Mark	MICROSURE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 001. First use: First Use: 1999/09/20 First Use In Commerce: 1999/09/20 antimicrobial chemical additives used in the manufacture of polymers, fibers and fabric</p> <p>Class 040. First use: First Use: 1999/09/20 First Use In Commerce: 1999/09/20 textile treatment for polymers, fibers and fabrics in the nature of an anti-microbial and sanitary coating or impregnation</p>		

U.S. Registration No.	3263245	Application Date	12/11/2003
Registration Date	07/10/2007	Foreign Priority Date	NONE
Word Mark	MICROFRESH		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 001. First use: First Use: 2003/03/01 First Use In Commerce: 2006/03/01 ANTIMICROBIAL, ANTIBACTERIAL, AND ANTIFUNGAL CHEMICAL ADDITIVES FOR INCORPORATION INTO PLASTIC RESINS AND PRODUCTS MADE FROM SUCH ADDITIVES, NAMELY, FIBERS, FABRICS, AND A WIDE VARIETY OF PLASTIC RESIN CONSUMER GOODS</p>		

Attachments	<p>75280847#TMSN.gif (1 page)(bytes)</p> <p>76042781#TMSN.gif (1 page)(bytes)</p> <p>75426927#TMSN.gif (1 page)(bytes)</p> <p>75426926#TMSN.gif (1 page)(bytes)</p> <p>75428733#TMSN.gif (1 page)(bytes)</p> <p>75000582#TMSN.gif (1 page)(bytes)</p> <p>78977379#TMSN.jpeg (1 page)(bytes)</p> <p>30101_358_opp.pdf (8 pages)(55288 bytes)</p>
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Signature	/CLIFF D. WESTON/
Name	Cliff D. Weston
Date	07/23/2007

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

In re Serial No.: 77/019426
Mark: MIKRO-BAN
Published: May 22, 2007

MICROBAN PRODUCTS COMPANY,)	
)	
Opposer,)	Opposition No.
)	
v.)	
)	Mark: MIKRO-BAN
Eugene B. Guthery, M.D.,)	
)	
Applicant.)	
)	

NOTICE OF OPPOSITION

U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, Virginia 22313-1451

Sir:

MICROBAN PRODUCTS COMPANY, a North Carolina corporation located at 11515 Vanstory Drive, Suite 125, Huntersville, North Carolina 28078 (hereinafter “Opposer”), believes that it would be damaged by registration of the mark shown in Application Serial No. 77/019426 (“the’426 Application”), filed October 12, 2006, by Eugene B. Guthery, M.D. (hereinafter “Applicant”), published in the Official Gazette of the United States Patent and Trademark Office on May 22, 2007, and hereby opposes the registration of such mark. The time to oppose was extended by a timely request for extension of time to file this opposition.

The grounds for the opposition are as follows:

OPPOSER AND ITS RIGHTS IN A “MICROBAN” FAMILY OF MARKS

1. Opposer is a leading provider of antimicrobial compositions and custom antimicrobial services, and its trademarks and service marks appear on a broad range of consumer products incorporating such compositions and services.
2. Since at least 1975, Opposer has continuously used the mark MICROBAN in interstate commerce in connection with a wide range of goods and services of a pharmaceutical nature. More specifically, Opposer’s goods include an array of compounds having an antibacterial, antifungal, mildewcidal or other antimicrobial effect. Opposer’s services comprise conferring a pharmaceutical property to products in many International Classes. These products and services exist in International Classes 001, 005, and 040.
3. When used in connection with the Opposer’s products, the MICROBAN mark is inherently distinctive. Although not necessarily because of the mark’s inherent distinctiveness, the MICROBAN mark has also acquired secondary meaning by reason of Opposer’s years of advertising, promotion, and other use thereof.
4. Moreover, Opposer is the owner of the following the United States Trademark Registrations for the MICROBAN family of house marks:

Mark	Reg. No.	Goods/Services	Appl. Date	Reg. Date
MICROBAN	1063362	Anti-bacterial polyethylene packaging bags (Class 022)	Oct 9, 1975	Apr 12, 1977
MICROBAN	1141006	Additive to impart antibacterial, antifungal and antimicrobial properties to plastic resins (Class 001)	Apr 3, 1978	Nov 4, 1980
MICROBAN	2227218	Antimicrobial, antibacterial, and antifungal chemical additives for incorporation into plastic resins and products made from such additives, namely, fibers, fabrics, and wide variety of plastic resin consumer goods (Class 001)	Apr 25, 1997	Mar 2, 1999
MICROBAN	2227218	Treatment of plastic resins and products made from such plastic resins, namely,	Apr 25, 1997	Mar 2, 1999

		fibers and fabrics, and a wide variety of plastic resin consumer goods, with antimicrobial, antibacterial, and antifungal chemical additives (Class 040)		
MICROBAN	2220264	Treatment of plastic resins and products made from such plastic resins, namely, fibers and fabrics, and a wide variety of plastic resin consumer goods, with antimicrobial, antibacterial, and antifungal chemical additives (Class 040)	Sep 10, 1997	Jan 26, 1999
MICROBAN	2611477	Antimicrobial, antibacterial, and antifungal chemical additives for incorporation into plastic resins and products made from such additives, namely, fibers, fabrics, and a wide variety of plastic resin consumer goods (Class 001)	May 8, 2000	Aug 27, 2002
MICROBAN ANTIBACTERIAL PROTECTION	2380284	Antimicrobial, antibacterial, and antifungal chemical additives for incorporation into plastic resins and products made from such additives, namely, fibers, fabrics, and a wide variety of plastic resin consumer goods (Class 001)	Feb 2, 1998	Aug 29, 2000
MICROBAN ANTIBACTERIAL PROTECTION	2380284	Treatment of plastic resins and products made from such plastic resins, namely, fibers, fabric, and a wide variety of plastic resin consumer goods, with antimicrobial, antibacterial, and antifungal chemical additives (Class 040)	Feb 2, 1998	Aug 29, 2000
MICROBAN ANTIMICROBIAL PROTECTION	2365607	Antimicrobial, antibacterial, and antifungal chemical additives for incorporation into plastic resins and products made from such additives, namely, fibers, fabrics, and a wide variety of plastic resin consumer goods (Class 001)	Feb 2, 1998	Jul 11, 2000
MICROBAN ANTIMICROBIAL PROTECTION	2365607	Treatment of plastic resins and products made from such plastic resins, namely, fibers, fabric, and a wide variety of plastic resin consumer goods, with antimicrobial, antibacterial, and antifungal chemical additives (Class 040)	Feb 2, 1998	Jul 11, 2000
MICROBAN PROTECTION	2365610	Antimicrobial, antibacterial, and antifungal chemical additives for incorporation into plastic resins and products made from such additives, namely, fibers, fabrics, and a wide variety of plastic resin consumer goods (Class 001)	Feb 4, 1998	Jul 11, 2000
MICROBAN PROTECTION	2365610	Treatment of plastic resins and products made from such plastic resins, namely,	Feb 4, 1998	Jul 11, 2000

		fibers, fabric, and a wide variety of plastic resin consumer goods, with antimicrobial, antibacterial, and antifungal chemical additives (Class 040)		
MICROSURE	2330038	Antimicrobial chemical additives used in the manufacture of polymers, fibers and fabric (Class 001)	Oct 2, 1995	Mar 14, 2000
MICROSURE	2330038	Textile treatment for polymers, fibers and fabrics in the nature of an anti-microbial and sanitary coating or impregnation (Class 040)	Oct 2, 1995	Mar 14, 2000
MICROFRESH	3263245	Antimicrobial, antibacterial, and antifungal chemical additives for incorporation into plastic resins and products made from such additives, namely, fibers, fabrics, and a wide variety of plastic resin consumer goods (Class 001)	Dec 11, 2003	Jul 10, 2007

5. Opposer has used its MICROBAN and related marks in commerce across a broad range of products. Products marketed in association with the MICROBAN mark and to the healthcare industry include Zirc[®] dental trays; Microtek[®] surgical drapes; Medwrap[®] and other wound dressings; and Inva-Care[®] home medical equipment. Lay consumer-facing products of particular note include Elizabeth[™] SPA[™] and Purely Bath[™] bath and body accessories intended to be used on the skin; Johnson & Johnson REACH[®] toothbrushes; and Scunci/Conair[®] beauty aids. However, Opposer's MICROBAN mark can be found on many other products presented to the same relevant consumer as Applicant's goods: American Standard[®] sanitary ware; Lucite[®] bathtubs and showers; Lennox[®] home heating and cooling products; Rubbermaid[®] sinkware; Bissell[®] and Oreck[®] vacuum cleaners and carpet scrubbers; Silestone[®] countertop material; Bonaire[®], Holmes[®], du Pont[®] and FamilyCare[®] air filtration devices; Amana[®] laundry machines; Rival[®] kitchen products; Infantino[®] baby care items; and Koala Care[®] diaper stations. These uses include substantial sales and advertising activities to promote the pharmaceutical (i.e., antimicrobial, antibacterial, mildewcidal and/or antifungal) property of Opposer's goods.

6. Opposer, through extensive use, advertising and promotion of its MICROBAN, MICROSURE, MICROBAN PROTECTION, MICROBAN ANTIBACTERIAL PROTECTION, MICROBAN ANTIMICROBIAL PROTECTION and MICROFRESH marks in

association with the above and other products, has developed and now enjoys a high degree of brand recognition in connection with pharmaceutical/antimicrobial products.

7. Opposer's foregoing Registration Nos. 1063362, 1141006, 2227218, 2220264, 2380284, 2365607, 2365610, and 2330038 for the marks MICROBAN, MICROSURE, MICROBAN PROTECTION, MICROBAN ANTIBACTERIAL PROTECTION, MICROBAN ANTIMICROBIAL PROTECTION and MICROFRESH are valid, subsisting, and are incontestable pursuant to 15 U.S.C. § 1065.

8. Opposer has used and is using the foregoing trademarks and service marks in interstate commerce in connection with the goods and services described in the Opposer's Registrations.

COUNT I

THERE IS A LIKELIHOOD OF CONFUSION WITH OPPOSER'S MARKS

9. Opposer reiterates paragraphs 1 through 7 as paragraph 8 of this Count I.

10. On October 12, 2006, Applicant filed the '426 Application for the mark MIKRO-BAN for "Dermatological pharmaceutical products" in Class 005, based on an intent to use the mark in the United States.

11. Opposer's use and registration of its MICROBAN marks long predates the filing date of the '426 application.

12. The grant of a registration to Applicant for its MIKRO-BAN market as sought in the '426 Application should be denied on the grounds of Opposer's prior use of the MICROBAN, MICROSURE, MICROBAN PROTECTION, MICROBAN ANTIBACTERIAL PROTECTION, MICROBAN ANTIMICROBIAL PROTECTION and MICROFRESH marks.

13. The mark sought to be registered by Applicant is confusingly similar to Opposer's MICROBAN mark for the following reasons:

- (a) On their face, the MICROBAN and MIKRO-BAN marks are nearly identical in sight, sound and meaning. Taking into account phonetic misspelling and hyphenation, an approach long approved by the courts and USPTO, the marks are identical.
- (b) On information and belief, Opposer believes Applicant's goods will encompass over-the-counter goods having a pharmaceutical component. Pharmaceutical components would likely be confused with goods containing other Class 005 components, namely disinfectants, fungicides, herbicides and antimicrobial ingredients. These latter components are exactly those which Opposer has become known for over the past decades.
- (c) Over-the-counter pharmaceutical skin care goods are likely to be carried in the same established, likely-to-continue trade channels as Opposer's goods.
- (d) Buyers of Applicant's and Opposer's goods are likely to exercise a low degree of care with regard to the pharmaceutical/antimicrobial character of the goods.
- (e) Opposer's MICROBAN mark enjoys wide fame through decades of sales, advertising, and market presence. Opposer's marks have appeared and continue to appear in print advertising, television advertising, and on products and their packaging in stores, in all cases associated with a multitude of consumer goods to which the typical purchaser has been exposed. Regardless of whether Opposer's MICROBAN mark is considered a house mark, the fame and wide recognition of the MICROBAN mark in association with pharmaceutical/antimicrobial products makes confusion likely.
- (f) Opposer is an essentially exclusive user of a "MICROBAN"-type mark in association with a variety of goods containing a pharmaceutical (i.e., antibacterial, antifungal, antialgal, mildewcidal, and the like) ingredient.
- (g) Opposer's MICROBAN and related marks have been used in association with a broad array of goods, including beauty aids found in the same store section as Applicant's goods would be expected to reside.

14. The use of the MIKRO-BAN marked by Applicant is likely to cause confusion or mistake in the minds of the public and to lead the public and prospective purchasers to believe that Applicant's goods are those of Opposer or are endorsed, sponsored or otherwise affiliated or connected with Opposer, or that Opposer's goods and services are associated with Applicant, all to the damage and injury of the purchasing public and to the damage and injury of Opposer. The potential for such confusion is heightened by Opposer's use of its family of MICROBAN marks (MICROSURE, MICROBAN PROTECTION, MICROBAN ANTIBACTERIAL PROTECTION, MICROBAN ANTIMICROBIAL PROTECTION and MICROFRESH) on a spectrum of goods encountered by members of the relevant consumer pool.

15. The grant of a registration to Applicant for its MIKRO-BAN mark as sought in the '426 application should be denied based on likelihood of confusion with Opposer's prior MICROBAN, MICROSURE, MICROBAN PROTECTION, MICROBAN ANTIBACTERIAL PROTECTION, MICROBAN ANTIMICROBIAL PROTECTION and MICROFRESH marks.

WHEREFORE, Opposer files this notice of opposition and prays that the aforesaid application of Guthery herein opposed, be rejected; that no registration be issued thereon to Applicant; and for such other and further relief as may be deemed just and proper.

Enclosed is payment in the amount of \$300.00 to cover the filing fees of this notice of opposition against the '426 application. Please charge any additional fees to Deposit Account No. 502714, and address all correspondence regarding this opposition to:

Clifford D. Weston
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11515 Vanstory Drive, Suite 125
Huntersville, North Carolina 28078
704-875-0806
cliff.weston@microban.com

Respectfully submitted,

MICROBAN PRODUCTS COMPANY

By:

/CLIFF D. WESTON/

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Opposer