

ESTTA Tracking number: **ESTTA275614**

Filing date: **04/01/2009**

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	Moroccan Gold LLC
Granted to Date of previous extension	04/01/2009
Address	620 Valley Health Plaza Paramus, NJ 07652 UNITED STATES

Attorney information	James H. Donoian, Esq. Greenberg Traurig, LLP 230 Park Avenue, Suite 1847 New York, NY 10166 UNITED STATES donoianj@gtlaw.com, falbyo@gtlaw.com, gerhiserl@gtlaw.com, biancoc@gtlaw.com Phone: 212.801.9200
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Applicant Information

Application No	77359584	Publication date	12/02/2008
Opposition Filing Date	04/01/2009	Opposition Period Ends	04/01/2009
Applicant	MOROCCANOIL, INC. 5757 WEST CENTURY BOULEVARD, SUITE 880 LOS ANGELES, CA 90045 UNITED STATES		

Goods/Services Affected by Opposition

Class 003. First Use: 2007/03/11 First Use In Commerce: 2007/03/11 All goods and services in the class are opposed, namely: Hair conditioners, namely, curl creams, hydrating style creams, intense moisturizing masques, and styling and finishing oils

Applicant Information

Application No	77359562	Publication date	12/02/2008
Opposition Filing Date	04/01/2009	Opposition Period Ends	
Applicant	MOROCCANOIL, INC. 5757 WEST CENTURY BOULEVARD, SUITE 880 LOS ANGELES, CA 90045 UNITED STATES		

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Grounds for Opposition

The mark is merely descriptive	Trademark Act section 2(e)(1)
The mark is primarily geographically descriptive	Trademark Act section 2(e)(2)
The mark is primarily geographically deceptively misdescriptive	Trademark Act section 2(e)(3)

Related Proceedings	91188537
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Attachments	NOT OPP Moroccanoil.pdf (6 pages)(26202 bytes)
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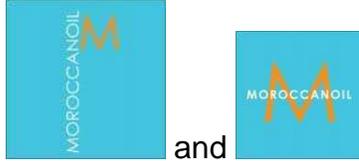
Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/JHD/
Name	James H. Donoian, Esq.
Date	04/01/2009

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

In re: U.S. Application Serial Nos. 77/359,584 and 77/359,562



Marks:

Published: December 2, 2008

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MOROCCAN GOLD, LLC

Opposition No.

Opposer,

-against-

MOROCCANOIL, INC.

Applicant.

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Moroccan Gold, LLC (“Opposer”) believes that they will be damaged by the registration of the above-identified trademarks and hereby opposes the registration thereof and allege as follows:

FACTS

1. Opposer is a limited liability company organized and existing under the laws of the state of New York, having a place of business at 620 Valley Health Plaza, Paramus, New Jersey 07652.
2. Opposer and or its parent is engaged in the manufacture, promotion and distribution of hair and non-medicated skin care preparations (“Opposer’s Products”).
3. Opposer’s Products are promoted, distributed, offer sale and sold under the trademark MOROCCAN MIRACLE and MOROCCAN GOLD (Opposer’s Marks”).

4. On or about May 13, 2008, Opposer filed Trademark Application Serial No. 77473045 to register MOROCCAN MIRACLE with Opposer's Products ("Opposer's Application").

5. On September 2, 2008, Opposer's Application was refused registration and the Examining Attorney requested that Opposer "disclaim the geographically descriptive wording "MOROCCAN" apart from the mark as shown because it is primarily geographically descriptive of the origin of a major ingredient [sic] of the goods—oil from the Argan tree, which is a plant native to Morocco".

6. On October 8, 2008, Opposer agreed to disclaim the geographic term MOROCCAN in Opposer's Application.

7. On November 25, 2008, Opposer's Mark was published in the Official Trademark Gazette for opposition.

8. On or about January 23, 2009, Applicant MoroccanOil, Inc. ("Applicant") commenced an opposition against Opposer's Mark in the Trademark Trial and Appeal Board on the grounds that Opposer's Mark is likely to Cause confusion with Applicant's previously registered mark for MOROCCANOIL.

9. Upon information and belief, Applicant is a corporation organized and existing under the laws of the state of California, having a place of business at 5757 West Century Boulevard, Suite 880, Los Angeles, California 90045.

10. On or about March 12, 2008, Applicant filed Trademark Application Serial Nos. 77/359,584 and 77/359,562 (the "Applications") for registration of the marks  and



(“Applicant’s Marks”), pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), for use on or in connection with: hair conditioners, namely, curl creams, hydrating style creams, intense moisturizing masques, and styling and finishing oils (“Applicant’s Goods”).

11. On or about December 2, 2008, Applicant’s Marks were published in the Official Trademark Gazette for opposition.

12. Upon information and belief, Applicant’s Goods are manufactured in the country of Israel.

13. The predominant feature of Applicant’s Marks is the term MOROCCANOIL.

14. Upon information and belief, the term MOROCCANOIL is a composite, which combines the terms “Moroccan” and “oil”.

15. MOROCCAN is recognized throughout the world and in the United States to denote the country of Morocco.

16. Morocco is not an obscure or remote location.

17. The primary significance of the term MOROCCAN in Applicant’s Marks is its geographic connotation.

18. Webster’s Ninth New Collegiate Dictionary defines the term “oil”, as used in connection with Applicant’s Goods, as “a substance (as a cosmetic preparation) of oily consistency”.

19. The term “oil” as used in Applicant’s Marks refers to an ingredient in Applicant’s Goods.

20. Upon information and belief, a main ingredient in Applicant’s Goods is “argan oil”, also know as “argania spinoza kernel oil”.

21. Argan oil is produced from the kernels of the Argan tree, a species that is habitable to southwestern Morocco.

22. Morocco is known for its production of argan oil.

23. The term Moroccan oil is regularly and consistently used to refer to argan oil by Applicant's competitors and the consuming public.

24. Applicant's marketing materials emphasize and promote Applicant's use of argan oil in Applicant's Goods.

25. Consumers are likely to make an association between Morocco and Applicant's Goods.

26. Upon information and belief, Applicant has adopted the term MOROCCANOIL because Applicant's Goods contain argan oil.

27. The combination of MOROCCAN and OIL, when used in connection with Applicant's Goods, does not alter the primarily geographic significance of MOROCCAN.

28. The combination of MOROCCAN and OIL to form MOROCCANOIL and when used in connection with Applicant's Goods, does not change the connotation and commercial impression of constituent elements.

FIRST CAUSE OF ACTION

29. Applicant, repeats and realleges each and every allegation set forth in paragraphs 1 through 28 above, as if fully set forth herein.

30. MOROCCANOIL, as used on or in connection with Applicant's Goods, is merely descriptive within the meaning of Section 2(e)(1) of the Lanham Act, 15 U.S.C. §1052(e)(1).

SECOND CAUSE OF ACTION

31. Applicant, repeats and realleges each and every allegation set forth in paragraphs 1 through 30 above, as if fully set forth herein.

32. MOROCCANOIL, as used on or in connection with Applicant's Goods, is primarily geographically descriptive within the meaning of Section 2(e)(2) of the Lanham Act, 15 U.S.C. §1052(e)(2).

THIRD CAUSE OF ACTION

33. Applicant, repeats and realleges each and every allegation set forth in paragraphs 1 through 32 above, as if fully set forth herein.

34. MOROCCANOIL, as used on or in connection with Applicant's Goods, is primarily geographically deceptively misdescriptive within the meaning of Section 2(e)(3) of the Lanham Act, 15 U.S.C. §1052(e)(3).

W H E R E F O R E, Opposers pray that, the Board sustain the Opposition and refuse the registration of Applicant's Marks

Dated: New York, New York
April 1, 2009

Respectfully submitted,

GREENBERG TRAURIG LLP

By: /JHD/
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CERTIFICATE OF SERVICE

I hereby certify that on this 1st day of April, 2009, the foregoing NOTICE OF OPPOSITION was served upon Applicant by delivering same to Applicant's counsel of record, via First Class Mail:

Annette Kazmerski
Conkle, Kremer & Engel PLC
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Santa Monica, CA 90403

 /OAF/
Orrin A. Falby