

ESTTA Tracking number: **ESTTA305987**

Filing date: **09/14/2009**

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	Bio-K Plus International, Inc.
Granted to Date of previous extension	09/13/2009
Address	495 boulevard Armand-Frappier Laval, QC H7V 4A7 CANADA
Attorney information	Heather E. Balmat Choate, Hall & Stewart LLP Two International Place Attn: Trademark Administrator Boston, MA 02110 UNITED STATES hbalmat@choate.com, trademarkdocket@choate.com Phone:617-248-5000

**Applicant Information**

Application No	77482825	Publication date	03/17/2009
Opposition Filing Date	09/14/2009	Opposition Period Ends	09/13/2009
Applicant	ProbioHealth, LLC 9595 Wilshire Blvd. #810 Beverly Hills, CA 90212 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 005. First Use: 2007/02/01 First Use In Commerce: 2007/02/01  
All goods and services in the class are opposed, namely: Probiotics for equine nutrition in the nature of a dietary supplement including lactobacillus casei

**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.	1950091	Application Date	03/01/1994
Registration Date	01/23/1996	Foreign Priority Date	01/24/1994
Word Mark	BIO-K PLUS		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 029. First use: dairy products, namely acidiphilic concentrates in the nature of a milk solid

U.S. Registration No.	2101998	Application Date	10/10/1995
Registration Date	09/30/1997	Foreign Priority Date	NONE

Word Mark	BIO-K+PLUS
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 001. First use: First Use: 1997/05/09 First Use In Commerce: 1997/05/09 microbiological fermentation extracts using milk as a carrier
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U.S. Registration No.	3580572	Application Date	07/29/2006
Registration Date	02/24/2009	Foreign Priority Date	05/09/2006

Word Mark	BIO-K PLUS PHARMA
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 003. First use: Probiotic body cream for cosmetic purposes only Class 005. First use: Lactic ferments for medical and non-medical use; soya ferments for medical and non-medical use; capsules made up of lactobacillus acidophilus and/or lactobacillus casei bacteria for the prevention or treatment of intestinal disorders; natural health products, namely, microbiological fermentation extracts using milk or soya as a carrier for the prevention or treatment of intestinal disorders, concentrates using milk and soya solids as carriers for the prevention or treatment of intestinal disorders; symbiotic, prebiotic and probiotic products
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	<p>made of lactobacillus acidophilus and/or lactobacillus casei concentrates using milk and soya as carriers for the prevention or treatment of intestinal disorders</p> <p>Class 029. First use: probiotic lactobacillus acidophilus milk, rice and soya based drinks used as a milk substitute</p> <p>Class 032. First use: probiotic energy drinks; rice and soya based drinks not being milk substitutes</p>
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Attachments	<p>75003270#TMSN.gif ( 1 page )( bytes )</p> <p>78940522#TMSN.jpeg ( 1 page )( bytes )</p> <p>PRO-BIOKoppexhibits.pdf ( 9 pages )(396217 bytes )</p>
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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	/Heather E. Balmat/
Name	Heather E. Balmat
Date	09/14/2009

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

In the Matter of Application Serial No.: 77/482,825

BIO-K PLUS INTERNATIONAL INC.,	)
Opposer,	)
v.	)
PROBIOHEALTH, LLC,	)
Applicant.	)
	)

**NOTICE OF OPPOSITION**

Bio-K Plus International Inc. (“Opposer”), a corporation duly organized and existing under the laws of Canada, with a principal place of business at 495 Boul. Armand Frappier, Laval H7V 4A7, Canada, believes that it will be damaged by registration of the mark shown in Application Serial No. 77/482,825 , and hereby opposes same. As grounds for opposition, Opposer alleges:

1. On May 23, 2008, Applicant filed Application Serial No. 77/482,825, which is the subject of this opposition, for the mark “PRO-BIOK” (the “Opposed Mark”) for use in connection with “probiotics for equine nutrition in the nature of a dietary supplement including lactobacillus casei” in International Class 3. The application claimed a date of first use of the mark of February 1, 2007.

2. In October 1995, Opposer filed an application to register the mark “BIO-K PLUS” in International Class 29. In January 1996, the mark “BIO-K PLUS” was registered as U.S. Reg. No. 1,950,091 for use in connection with “dairy products, namely acidiphilic concentrates in the nature of a milk solid.” Proof of such registration is attached as Exhibit A. Since at least as early as 1996, Opposer has used the mark “BIO-K PLUS” to market and sell its goods in the United States. As a result of such use, Opposer’s “BIO-K PLUS” mark has established valuable goodwill in the mark, and the public, and in particular to the probiotic goods industry, have come to associate the “BIO-PLUS” mark with Opposer.

3. Also in October 1995, Opposer filed an application to register the design mark “BIO-K+PLUS” in International Class 1. In September 1997, the “BIO-K+PLUS & Design” mark was registered as U.S. Reg. No. 2,101,998. Proof of such registration is attached as Exhibit B. Since at least as early as May 1997, Opposer has used the “BIO-K+PLUS & Design” mark to market and sell microbiological fermentation extracts using milk as a carrier. By virtue of such use, Opposer has established valuable goodwill in the mark, and the public has come to associate the “BIO-K PLUS” mark with Opposer.

4. The United States Patent and Trademark Office issued Notices of Acceptance and Acknowledgement of Combined Declarations of Use and Incontestability of Opposer’s “BIO-K PLUS” and “BIO-K+PLUS & Design” marks on August 15, 2002 and November 21, 2003, respectively.

5. In July 2006, Opposer filed an application to register the mark “BIO-K PLUS PHARMA” in International Classes 3, 5, 29 and 32. In February 2009, the “BIO-K PLUS PHARMA” mark was registered as U.S. Reg. No. 3,580,572 for use in connection with “probiotic body cream, lactic ferments for medical and non-medical use; soya ferments for medical and non-medical use; capsules made up of lactobacillus acidophilus and/or lactobacillus casei bacteria for the prevention or treatment of intestinal disorders; natural health products, namely, microbiological fermentation extracts using milk or soya as a carrier for the prevention or treatment of intestinal disorders, concentrates using milk and soya solids as carriers for the prevention or treatment of intestinal disorders; symbiotic, prebiotic and probiotic products made of lactobacillus acidophilus and/or lactobacillus casei concentrates using milk and soya as carriers for the prevention or treatment of intestinal disorders; probiotic lactobacillus acidophilus milk, rice and soya based drinks used as a milk substitute; probiotic energy drinks and rice and soya based drinks.” Proof of registration of the “BIO-K PLUS PHARMA” mark is attached as Exhibit C.

6. Not only did Opposer file applications for its “BIO-K PLUS” and “BIO-K+PLUS & Design” marks before Applicant’s filing date and claimed date of use, but Opposer also began use of these marks in commerce prior to Applicant’s filing date and claimed date of first use in commerce.

7. Opposer filed its application to register its BIO-K PLUS PHARMA mark prior to Applicant’s claimed date of first use of the Opposed Mark.

8. The goods identified in Application Serial No. 77/482,825 for the Opposed Mark are substantially similar to Opposer's goods covered by its "BIO-K PLUS," "BIO-K+PLUS & Design" and "BIO-K PLUS PHARMA" trademark registrations.

9. The Opposed Mark so resembles Opposer's previously registered marks that, when applied to the goods set forth in Applicant's application, it is likely cause mistake, or to deceive, particularly as to the source or origin of the goods with which Applicant uses its mark, to induce purchasers to believe that the goods of Applicant are those of Opposer, or are endorsed by, or are in some way affiliated or associated with Opposer.

10. If Application Serial No. 77/482,825 for "PRO-BIOK" is permitted to register, the registration by Applicant would presumptively entitle it to *prima facie* exclusive ownership and rights to the Opposed Mark and would damage Opposer's goodwill in its "BIO-K PLUS," "PRO-BIOK+PLUS & Design" and "BIO-K PLUS PHARMA" marks, diluting the value thereof and causing Opposer's business and reputation irreparable harm, all to the detriment of Opposer who has expended considerable sums and effort in promoting its mark.

Wherefore, Opposer prays that this Opposition be sustained and that registration of Application Serial No. 77/482,825 for "PRO-BIOK" be denied.

Date: September 14, 2009

By its attorneys,  
CHOATE, HALL & STEWART LLP

By:   
Heather E. Balmat  
John D. Lanza  
Two International Place  
Boston, MA 02110  
Tel: (617) 248-5000  
Attorneys for Bio-K Plus International, Inc.

# **EXHIBIT A**

Int. Cl.: 29

Prior U.S. Cl.: 46

**United States Patent and Trademark Office**

**Reg. No. 1,950,091**

Registered Jan. 23, 1996

**TRADEMARK  
PRINCIPAL REGISTER**

**BIO-K PLUS**

DYNAMARK MANAGEMENT CORP.  
(CANADA CORPORATION)  
1155, METCALFE ST.  
SUITE 920  
MONTREAL, QUEBEC, H3B 2V6, CANADA

PRIORITY CLAIMED UNDER SEC. 44(D) ON  
CANADA APPLICATION NO. 745830, FILED  
1-24-1994, REG. NO. TMA442355, DATED  
4-28-1995, EXPIRES 4-28-2010.

FOR: DAIRY PRODUCTS, NAMELY ACIDI-  
PHILIC CONCENTRATES IN THE NATURE OF  
A MILK SOLID, IN CLASS 29 (U.S. CL. 46).

SER. NO. 74-495,523, FILED 3-1-1994.

DONNA MIRMAN, EXAMINING ATTORNEY

# **EXHIBIT B**

Int. Cl.: 1

Prior U.S. Cls.: 1, 5, 6, 10, 26, and 46

United States Patent and Trademark Office

Reg. No. 2,101,998

Registered Sep. 30, 1997

TRADEMARK  
PRINCIPAL REGISTER

**Bio-K<sup>PLUS</sup>**

BIO-K PLUS INTERNATIONAL INC. (CANADA  
CORPORATION)  
1155, METCALFE STREET, SUITE 920  
MONTREAL, PROVINCE OF QUEBEC,  
CANADA H3B 2V6

FOR: MICROBIOLOGICAL FERMENTATION  
EXTRACTS USING MILK AS A CARRIER, IN  
CLASS 1 (U.S. CLS. 1, 5, 6, 10, 26 AND 46).

FIRST USE 5-9-1997; IN COMMERCE  
5-9-1997.

OWNER OF U.S. REG. NO. 1,950,091.

SN 75-003,270, FILED 10-10-1995.

MITCHELL FRONT, EXAMINING ATTORNEY

# **EXHIBIT C**

Int. Cls.: 3, 5, 29 and 32

Prior U.S. Cls.: 1, 4, 6, 18, 44, 45, 46, 48, 50, 51 and 52

Reg. No. 3,580,572

United States Patent and Trademark Office

Registered Feb. 24, 2009

**TRADEMARK  
PRINCIPAL REGISTER**

**BIO-K PLUS PHARMA**

BIO-K PLUS INTERNATIONAL INC. (CANADA CORPORATION)  
495, ARMAND FRAPPIER BLVD.  
LAVAL, CANADA H7V 4A7

FOR: PROBIOTIC BODY CREAM FOR COSMETIC PURPOSES ONLY, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).

FOR: LACTIC FERMENTS FOR MEDICAL AND NON-MEDICAL USE; SOYA FERMENTS FOR MEDICAL AND NON-MEDICAL USE; CAPSULES MADE UP OF LACTOBACILLUS ACIDOPHILUS AND/OR LACTOBACILLUS CASEI BACTERIA FOR THE PREVENTION OR TREATMENT OF INTESTINAL DISORDERS; NATURAL HEALTH PRODUCTS, NAMELY, MICROBIOLOGICAL FERMENTATION EXTRACTS USING MILK OR SOYA AS A CARRIER FOR THE PREVENTION OR TREATMENT OF INTESTINAL DISORDERS, CONCENTRATES USING MILK AND SOYA SOLIDS AS CARRIERS FOR THE PREVENTION OR TREATMENT OF INTESTINAL DISORDERS; SYMBIOTIC, PREBIOTIC AND PROBIOTIC PRODUCTS MADE OF LACTOBACILLUS ACIDOPHILUS AND/OR LACTOBACILLUS CASEI CONCENTRATES USING MILK AND SOYA AS CARRIERS FOR THE PREVENTION OR TREATMENT OF INTESTINAL DISORDERS, IN CLASS 5 (U.S. CLS. 6, 18, 44, 46, 51 AND 52).

FOR: PROBIOTIC LACTOBACILLUS ACIDOPHILUS MILK, RICE AND SOYA BASED DRINKS USED AS A MILK SUBSTITUTE, IN CLASS 29 (U.S. CL. 46).

FOR: PROBIOTIC ENERGY DRINKS; RICE AND SOYA BASED DRINKS NOT BEING MILK SUBSTITUTES, IN CLASS 32 (U.S. CLS. 45, 46 AND 48).

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

PRIORITY CLAIMED UNDER SEC. 44(D) ON CANADA APPLICATION NO. 1300963, FILED 5-9-2006, REG. NO. TMA692149, DATED 7-17-2007, EXPIRES 7-17-2022.

OWNER OF U.S. REG. NOS. 1,950,091 AND 2,101,998.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "PHARMA", APART FROM THE MARK AS SHOWN.

SER. NO. 78-940,522, FILED 7-29-2006.

CURTIS FRENCH, EXAMINING ATTORNEY