

ESTTA Tracking number: **ESTTA392924**

Filing date: **02/11/2011**

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	The Mentholatum Company
Granted to Date of previous extension	02/13/2011
Address	707 Sterling Drive Orchard Park, NY 14127 UNITED STATES

Attorney information	Richard A. Sharpe Pearne & Gordon LLP 1801 East Ninth Street Suite 1200 Cleveland, OH 44114-3108 UNITED STATES ulauricia@pearne.com, tmdocket@pearne.com, dpeterlin@pearne.com Phone:216-579-1700
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Applicant Information

Application No	77690325	Publication date	08/17/2010
Opposition Filing Date	02/11/2011	Opposition Period Ends	02/13/2011
Applicant	FUJIFILM Corporation 26-30, Nishiazabu 2-chome, Minato-ku Tokyo, JAPAN		

Goods/Services Affected by Opposition

<p>Class 005. All goods and services in the class are opposed, namely: Dietary and nutritionally fortified food supplements adapted for medical use; dietary and nutritional supplements; dietetic nutritionally fortified beverages adapted for medical use; dietary beverage supplements for human consumption in liquid and dry mix form for the therapeutic purposes; dietetic foods adapted for medical use; vitamin and mineral supplements; Nutritional supplements; Astaxanthin nutritional supplements; nutritional supplements containing concentrated salasia extract; nutritional supplements containing astaxanthin as a main component; nutritional supplements containing concentrated salasia extract as a main component; nutritional supplements containing vitamin E as a main component; nutritional supplements containing lycopene as a main component; nutritional supplements containing vitamin C as a main component; nutritional supplements containing selenium yeast as a main component; nutritional supplements containing zinc yeast as a main component; nutritional supplements containing concentrated salasia extracts as a main component; nutritional supplements containing onion skin extracts as a main component; nutritional supplements containing chitosan as a main component; nutritional supplements containing apple polyphenol as a main component; nutritional supplements containing tea catechin as a main component; nutritional supplements containing chrome yeast as a main component; pharmaceutical preparations for the treatment of obesity</p>
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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.	1141969	Application Date	12/06/1978
Registration Date	12/02/1980	Foreign Priority Date	NONE
Word Mark	OXY 10		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 1977/10/19 First Use In Commerce: 1977/10/19 Medication for Treatment of Acne		

U.S. Registration No.	1869207	Application Date	02/01/1994
Registration Date	12/27/1994	Foreign Priority Date	NONE
Word Mark	OXY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 1975/03/00 First Use In Commerce: 1975/03/00 acne medication		

U.S. Registration No.	1873555	Application Date	02/01/1994
Registration Date	01/17/1995	Foreign Priority Date	NONE
Word Mark	OXY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 1991/01/00 First Use In Commerce: 1991/01/00 acne medication		

U.S. Registration No.	2874733	Application Date	07/08/2003
Registration Date	08/17/2004	Foreign Priority	NONE

		Date	
Word Mark	OXY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 2002/07/31 First Use In Commerce: 2002/07/31 TOPICAL ACNE MEDICATION, MEDICATED FACE WASH AND MEDICATED SKIN WIPES		

U.S. Registration No.	2919983	Application Date	05/23/2003
Registration Date	01/18/2005	Foreign Priority Date	NONE
Word Mark	OXY		
Design Mark			
Description of Mark	The mark consists of the stylized word "OXY" slanted upwards from left to right; the design appears in the color dark pink and color is claimed as a feature of the mark.		
Goods/Services	Class 005. First use: First Use: 2003/06/30 First Use In Commerce: 2003/06/30 Topical acne medication, medicated face wash and medicated skin wipes		

U.S. Registration No.	2919984	Application Date	05/23/2003
Registration Date	01/18/2005	Foreign Priority Date	NONE
Word Mark	OXY		

Design Mark	
Description of Mark	The mark consists of the stylized word "OXY" slanted upwards from left to right with a sunburst and tornado swirl behind the word "OXY".
Goods/Services	Class 005. First use: First Use: 2003/06/30 First Use In Commerce: 2003/06/30 Topical acne medication, medicated face wash and medicated skin wipes

U.S. Registration No.	3514158	Application Date	12/15/2005
Registration Date	10/07/2008	Foreign Priority Date	NONE
Word Mark	OXY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 2005/08/14 First Use In Commerce: 2005/08/14 Medicated or non-medicated soaps, facial scrubs and skin washes and pre-moistened or non-pre-moistened cosmetic wipes, shaving creams and gels, facial creams and lotions, skin moisturizers, sunscreen, anti-aging creams and lotions		

U.S. Registration No.	3532521	Application Date	12/15/2005
Registration Date	11/11/2008	Foreign Priority Date	NONE
Word Mark	OXY		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 005. First use: First Use: 2005/08/14 First Use In Commerce: 2005/08/14 Medicated scrubs, pre-moistened or non-pre-moistened medicated wipes, and medicated skin washes for the treatment or prevention of acne or problem skin conditions

Attachments	74485351#TMSN.gif (1 page)(bytes) 78271745#TMSN.gif (1 page)(bytes) 78253503#TMSN.gif (1 page)(bytes) 78253505#TMSN.gif (1 page)(bytes) 78774055#TMSN.jpeg (1 page)(bytes) 78774029#TMSN.jpeg (1 page)(bytes) MENT-O1151-Notice of Opposition-ULL.pdf (7 pages)(83558 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	/Richard A. Sharpe/
Name	Richard A. Sharpe
Date	02/11/2011

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

THE MENTHOLATUM COMPANY

Opposer,

v.

FUJIFILM CORPORATION

Applicant.

Opposition No.: _____

Application No.:77/690,325

Mark: OXIBARRIER

Appl'n Filed: March 13, 2009

Published: August 17, 2010

NOTICE OF OPPOSITION

The Opposer, The Mentholatum Company (“TMC”), believing it will be damaged by Fujifilm Corporation’s (“FFC”) registration of the mark OXIBARRIER pursuant to application No. 77/690,325, hereby opposes the registration of said mark. Hereinafter, TMC may be referred to as the “Opposer,” and FFC may be referred to as “Applicant.”

Background

1. The OXIBARRIER mark that is the subject of application serial No. 77/690,325 was published for opposition on August 17, 2010. On September 10, 2010, Opposer timely filed a request for a 90-day extension of time to oppose the Applicant's registration of the mark, which was granted the same day on September 10, 2010. Accordingly, the deadline for Opposer to file its Notice of Opposition was extended to December 15, 2010. On December 15, 2010, Opposer timely filed a request for a 60-day extension of time to oppose the Applicant's registration of the mark, which was

granted the same day on December 15, 2010. Accordingly, the deadline for Opposer to file its Notice of Opposition was extended to February 13, 2011.

The Parties

2. The Mentholatum Company is a Delaware corporation having a place of business at 707 Sterling Drive, Orchard Park, New York, 14127 USA.

3. Fujifilm Corporation, on information and belief, is a Japanese corporation having a place of business at 26-30, Nishiazabu 2-chome, Minato-ku, Tokyo, Japan.

TMC's OXY registrations

4. The Mentholatum Company is the owner, by assignment, of valid and subsisting U.S. trademark registrations which comprise or include the term OXY either by itself, or together with another word or words. U.S. Trademark Registration No. 1,141,969 for OXY 10 was registered on December 2, 1980 for medication for treatment of acne in **Class 5**.

5. The Mentholatum Company is the owner of U.S. Trademark Registration No. 1,869,207 for OXY registered on December 27, 1994 for acne medication in **Class 5**.

6. The Mentholatum Company is the owner of U.S. Trademark Registration No. 1,873,555 for OXY and design registered on January 17, 1995 for acne medication in **Class 5**.

7. The Mentholatum Company is the owner of U.S. Trademark Registration No. 2,874,733 for OXY and design registered on August 17, 2004 for topical acne medication, medicated face wash and medicated skin wipes in **Class 5**.

8. The Mentholatum Company is the owner of U.S. Trademark Registration No. 2,919,983 for OXY and design registered on January 18, 2005 for topical acne

medication, medicated face wash and medicated skin wipes in **Class 5**.

9. The Mentholatum Company is the owner of U.S. Trademark Registration No. 2,919,984 for OXY and design registered on January 18, 2005 for topical acne medication, medicated face wash and medicated skin wipes in **Class 5**.

10. The Mentholatum Company is the owner of U.S. Trademark Registration No. 3,514,158 for OXY registered on October 7, 2008 for medicated or non-medicated soaps, facial scrubs and skin washes and pre-moistened or non-pre-moistened cosmetic wipes, shaving creams and gels, facial creams and lotions, skin moisturizers, sunscreen, anti-aging creams and lotions in **Class 3**.

11. The Mentholatum Company is the owner of U.S. Trademark Registration No. 3,532,521 for OXY registered on November 11, 2008 for medicated scrubs, pre-moistened or non-pre-moistened medicated wipes, and medicated skin washes for the treatment or prevention of acne or problem skin conditions in **Class 5**.

FFC's application to register

12. Fujifilm Corporation filed U.S. Trademark Application No. 77/690,325 on an intent-to-use basis seeking to register the mark OXIBARRIER for Dietary and nutritionally fortified food supplements adapted for medical use; dietary and nutritional supplements; dietetic nutritionally fortified beverages adapted for medical use; dietary beverage supplements for human consumption in liquid and dry mix form for the therapeutic purposes; dietetic foods adapted for medical use; vitamin and mineral supplements; Nutritional supplements; Astaxanthin nutritional supplements; nutritional supplements containing concentrated salasia extract; nutritional supplements containing astaxanthin as a main component; nutritional supplements containing concentrated

salasia extract as a main component; nutritional supplements containing vitamin E as a main component; nutritional supplements containing lycopene as a main component; nutritional supplements containing vitamin C as a main component; nutritional supplements containing selenium yeast as a main component; nutritional supplements containing zinc yeast as a main component; nutritional supplements containing concentrated salasia extracts as a main component; nutritional supplements containing onion skin extracts as a main component; nutritional supplements containing chitosan as a main component; nutritional supplements containing apple polyphenol as a main component; nutritional supplements containing tea catechin as a main component; nutritional supplements containing chrome yeast as a main component; pharmaceutical preparations for the treatment of obesity in **Class 5**.

Grounds for opposition

13. The goods listed in the '969 registration for TMC's OXY 10 mark are similar to those listed in FFC's application to register the OXIBARRIER mark.

14. The goods listed in the '207 registration for TMC's OXY mark are similar to those listed in FFC's application to register the OXIBARRIER mark.

15. The goods listed in the '555 registration for TMC's OXY and design mark are similar to those listed in FFC's application to register the OXIBARRIER mark.

16. The goods listed in the '733 registration for TMC's OXY and design mark are similar to those listed in FFC's application to register the OXIBARRIER mark.

17. The goods listed in the '983 registration for TMC's OXY and design mark are similar to those listed in FFC's application to register the OXIBARRIER mark.

18. The goods listed in the '984 registration for TMC's OXY and design mark are similar to those listed in FFC's application to register the OXIBARRIER mark.

19. The goods listed in the '158 registration for TMC's OXY mark are similar to those listed in FFC's application to register the OXIBARRIER mark.

20. The goods listed in the '521 registration for TMC's OXY mark are similar to those listed in FFC's application to register the OXIBARRIER mark.

21. The goods associated with each of the respective marks move or will move in similar or the same channels of trade.

22. The OXIBARRIER mark is similar in appearance, sound and commercial impression to the OXY marks owned by TMC. The respective OXY portions thereof are phonetically identical which creates a confusingly similar impression.

23. TMC believes that it will be, or that it is likely to be, damaged should the OXIBARRIER mark be registered to FFC, that mark being sufficiently similar to TMC's registered OXY marks in sound, appearance and commercial impression as to be likely to cause confusion or mistake, or to deceive, as to the source, origin and/or sponsorship of goods sold or distributed under the OXIBARRIER mark.

24. Consumers and the public are likely to confuse dietary and/or nutritional supplements and the like sold under the OXIBARRIER mark with the acne medications, skincare preparations, skin wash, skin cleansers and related products sold by TMC under its OXY marks, and to erroneously believe that the former goods also came from, is affiliated with or endorsed by TMC. As a result, any perceived defects or poor quality of FFC's goods sold under the OXIBARRIER mark are likely to be erroneously attributed to TMC, to the substantial detriment of TMC and of the goodwill that it has

developed and enjoys in its OXY marks.

25. Upon information and belief, FFC has not used the mark OXIBARRIER in commerce.

Conclusion

26. For the foregoing reasons, the present opposition should be sustained, and the Applicant should be refused registration of the OXIBARRIER mark on all goods identified in the application.

This Notice of Opposition is being filed electronically through the ESTTA system. The fee for opposing registration in one class is being paid on filing through our Deposit Account. If any additional fees are required by the filing of this Notice of Opposition, or if the correct fee for opposing one class was not paid on filing, then please charge all such fees to our Deposit Account No. 16-0820, and reference Order No. MENT-O1151.

Respectfully submitted,

By: /Una L. Lauricia/
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Attorneys for Opposer

Certificate of Service

I hereby certify that on the date indicated below the foregoing Notice of Opposition was served on the attorney for Applicant via first-class air mail in an envelope addressed as follows:

Doreen L. Costa
Baker Botts LLP
30 Rockefeller Plaza, Floor 44
New York, New York, 10112-0015

Date: February 11, 2011

/Una L. Lauricia/
Una L. Lauricia

One of the Attorneys for Opposer