

ESTTA Tracking number: **ESTTA399511**

Filing date: **03/23/2011**

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	Merial
Granted to Date of previous extension	03/23/2011
Address	29 Avenue Tony Garnier Lyon, F-69007 FRANCE

Attorney information	Brewster Taylor Stites & Harbison PLLC 1199 North Fairfax St.Suite 900 Alexandria, VA 22314 UNITED STATES btaylor@stites.com Phone:703-739-4900
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Applicant Information

Application No	85120994	Publication date	11/23/2010
Opposition Filing Date	03/23/2011	Opposition Period Ends	03/23/2011
Applicant	Sergeant's Pet Care Products, Inc. 2625 S. 158th Plaza Omaha, NE 681301770 UNITED STATES		

Goods/Services Affected by Opposition

Class 005. All goods and services in the class are opposed, namely: Flea and tick control products, namely, antiparasitic collars, sprays, shampoos, medicated powders and topical ointments for pets not for sale to or through licensed veterinarians
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Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
The mark is merely descriptive	Trademark Act section 2(e)(1)
The mark is deceptively misdescriptive	Trademark Act section 2(e)(1)
Genericness	Trademark Act section 23

Mark Cited by Opposer as Basis for Opposition

Related Proceedings	91197053
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Attachments	NOT OF OPP.pdf (6 pages)(594747 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	/BT/
Name	Brewster Taylor
Date	03/23/2011

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

**IN THE MATTER OF TRADEMARK
APPLICATION SERIAL NO. 85/120,994**

MERIAL)	
)	
Opposer)	
)	
v.)	Opposition No.
)	
SERGEANT’S PET CARE PRODUCTS, INC.)	
)	
Applicant)	
)	

NOTICE OF OPPOSITION

MERIAL, a Société Par Actions Simplifiée of France, with principal offices located at 29 Avenue Tony Garnier 69007 Lyon France (hereinafter “Opposer”), believes that it would be damaged by registration of the mark “PRONYL OTC” (Serial No. 85/120,994) for “[f]lea and tick control products, namely, antiparasitic collars, sprays, shampoos, medicated powders and topical ointments for pets not for sale to or through licensed veterinarians” in the name of **SERGEANT’S PET CARE PRODUCTS, INC.**, a Nevada Corporation with principal offices located at 2625 S. 158th Plaza, Omaha, Nebraska, 68130 (hereinafter “Applicant”), and Opposer, by its undersigned attorneys, hereby requests that registration of the mark be denied on the following grounds:

1. In U.S. Application Serial No. 85/120,994, Applicant seeks registration of the alleged mark “PRONYL OTC” for “[f]lea and tick control products, namely, antiparasitic collars, sprays, shampoos, medicated powders and topical ointments for pets not for sale to or through licensed veterinarians”. The application was filed on September 1, 2010, and is based on Applicant’s

alleged bona fide intention to use the mark in commerce in connection with said goods under Section 1(b) of the Trademark Act (15 U.S.C. §1051(b)).

2. Opposer has used its marks “FRONTLINE”, “FRONTLINE PLUS” and “FRONTLINE TOP SPOT” for flea and tick control products for animals sold in commerce in the United States continuously for years prior to the filing date of Applicant’s application for registration of “PRONYL OTC”. Opposer has used its “FRONTLINE” and “FRONTLINE TOP SPOT” marks for flea and tick control products sold in commerce since at least as early as 1996, and its “FRONTLINE PLUS” mark for flea and tick control products sold in commerce since at least as early as 2000. The active ingredient in the products sold under these FRONTLINE marks is fipronil. Opposer has been the exclusive user of fipronil in flea and tick products sold in the United States for many years and has heavily advertised “fipronil” as the main active ingredient of its flea and tick products such that “fipronil” is closely associated with its products by consumers.

3. Opposer is the owner of U.S. Registration No. 2,049,456 for “FRONTLINE” for insecticides and antiparasitic agents for veterinary use and of U.S. Registration No. 2,763,796 for “FRONTLINE PLUS” for, insecticides and antiparasitic agents for veterinary use. Both registrations are “incontestable” and operate as conclusive evidence of Opposer’s ownership of the marks set forth therein and of Opposer’s exclusive right to use the marks in connection with the goods listed in the registrations. *See* 15 U.S.C. §§ 1065 and 1115(b).

4. Opposer is a world-leading animal health company. The flea and tick control products sold by Opposer under its long-used and registered “FRONTLINE” marks are the leading flea and tick control products for dogs and cats in the United States. It is well known that

the primary active ingredient in Opposer's flea and tick control products sold under its "FRONTLINE" marks is fipronil.

5. Applicant has developed flea and tick control products containing fipronil that are intended to be Applicant's version of Opposer's "FRONTLINE" flea and tick control products and which are advertised as containing the same active ingredients (fipronil) as the "FRONTLINE TOP SPOT" and "FRONTLINE PLUS" products and as providing the same level of protection and safety, and Applicant intends to use the alleged "PRONYL OTC" mark in connection with these flea and tick control products containing fipronil which will be sold over the counter.

6. Applicant has also sought registration of "F-PRONIL" (Serial No. 85/021,258), which is currently being opposed by Opposer (Opposition No. 91197053) on the basis that Applicant's purported "F-PRONIL" mark is generic or descriptive or deceptive or deceptively misdescriptive as a slight misspelling of the active ingredient "fipronil" and thereby falls within the proscription of Section 2(a) or 2(e) of the statute, 15 U.S.C. § 1052(a) and (e), and should be denied registration on that basis as well as under Section 1 of the Trademark Act since the application was based on the false claim of exclusive rights. The fact that Applicant has sought registration of more than one mark that is a slight misspelling of the active ingredient "fipronil" shows Applicant's intent to gain rights and an unfair advantage in use of a generic, descriptive, deceptive or deceptively misdescriptive term.

7. Registration of Applicant's purported mark "PRONYL OTC" for the goods in the application will give Applicant exclusive rights to a term which is another slight misspelling of the term "fipronil" together with the descriptive term "OTC", which is the commonly used and recognized acronym for "Over The Counter" and will place Opposer at risk of being accused of

infringement in continuing to use the common descriptive term “fipronil” to identify the active ingredient in Opposer’s flea and tick control products. Applicant is seeking to obtain an unfair advantage by using a minor misspelling and near variation of the active ingredient fipronil as the name of its products. This equation of “PRONYL” with fipronil is reinforced by the use of “OTC”. The term “PRONYL OTC” would be understood by potential purchasers as describing a flea and tick product containing fipronil that is sold over the counter.

8. “PRONYL OTC” is generic or merely descriptive for a flea or tick product containing fipronil sold “over the counter” or is deceptive or deceptively misdescriptive for a flea and tick product that does not contain fipronil and therefore cannot function to identify or become distinctive of Applicant’s products within the meaning of the Trademark Act. Registration of Applicant’s alleged “PRONYL OTC” mark will not only cause Opposer injury and damage in the sale of its flea and tick control products but will also affect other manufacturers and retailers in their ability to continue to appropriately their fipronil-based flea and tick control products.

9. Applicant’s purported “PRONYL OTC” mark appropriates most of the term “fipronil”, the most well-known and heavily promoted ingredient in Opposer’s products and combines it with the purely descriptive term “OTC”. Applicant’s purported “PRONYL OTC” mark is generic or merely descriptive or is deceptive or deceptively misdescriptive as used in connection with the goods thereby falls within the proscription of Section 2(e) or Section 2(a) of the statute, 15 U.S.C. § 1052 (a) and (e), and should be denied registration. The purported mark is also invalid under Section 1 of the Trademark Act (15 U.S.C. §§ 1051(a)(3) and (b)(3) in that Applicant falsely declared that it had exclusive rights in the generic or merely descriptive or deceptive or deceptively misdescriptive term.

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing NOTICE OF OPPOSITION was served on counsel for Applicants, this 23rd day of March, 2011, by sending it via First Class Mail, postage prepaid, to:

Keith Grady Esq.
Polsinelli Shugart PC
100 S. Fourth Street
Suite 1000
St. Louis, MO 63102

/s/
Brewster Taylor