

ESTTA Tracking number: **ESTTA420848**

Filing date: **07/20/2011**

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	Colgate-Palmolive Company
Granted to Date of previous extension	07/20/2011
Address	300 Park Avenue New York, NY 10022 UNITED STATES

Attorney information	Brendan J. O'Rourke Proskauer Rose LLP Eleven Times Square New York, NY 10036-8299 UNITED STATES trademark@proskauer.com Phone:(212) 969-3000
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**Applicant Information**

Application No	85058679	Publication date	03/22/2011
Opposition Filing Date	07/20/2011	Opposition Period Ends	07/20/2011
Applicant	Dentsoll Inc 5836 Buford Hwy Ste B Norcross, GA 30071 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 021. First Use: 2009/06/01 First Use In Commerce: 2009/06/01 All goods and services in the class are opposed, namely: Oral hygiene devices, namely, interdental cleaners
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**Grounds for Opposition**

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	2142102	Application Date	09/26/1996
Registration Date	03/10/1998	Foreign Priority Date	NONE
Word Mark	TOTAL		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 003. First use: First Use: 1995/03/22 First Use In Commerce: 1995/03/22 oral care products, namely, toothpaste

U.S. Registration No.	2015834	Application Date	01/11/1996
Registration Date	11/12/1996	Foreign Priority Date	NONE
Word Mark	TOTAL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 021. First use: First Use: 1992/10/00 First Use In Commerce: 1992/10/00 oral care products, namely toothbrushes		

Attachments	85058679 Notice of Opposition.pdf ( 16 pages )(492947 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	/Brendan J. O'Rourke/
Name	Brendan J. O'Rourke
Date	07/20/2011



and first use in commerce dates of June 1, 2009. A copy of the trademark record for this application is attached as Exhibit 2.

5. Colgate has continuously used the TOTAL mark in connection with Colgate's oral care products since long prior to Dentsoll's acts alleged herein.

6. Dentsoll has disclaimed "dental care solution" in the Dentsoll Mark but did not disclaim "Total." This establishes not only that Dentsoll intends to use "Total" as a source-identifier, but also that "Total" is the dominant portion of the Dentsoll Mark.

7. The Dentsoll Mark is highly similar in overall commercial impression, appearance, and sound to Colgate's TOTAL mark, such that use of the Dentsoll Mark is likely to cause confusion, mistake, or deception with Colgate's TOTAL mark.

8. Colgate's TOTAL mark and the Dentsoll Mark also both cover oral care products, further increasing the likelihood of confusion.

9. In light of the fame and distinctiveness that have attached to Colgate's oral care products and Colgate's TOTAL mark, Dentsoll's inclusion of the "Dentsoll" term would not prevent a likelihood of consumer confusion. Rather, upon seeing the Dentsoll Mark, consumers will likely believe that Colgate has licensed the TOTAL brand to Dentsoll, that Dentsoll's and Colgate's goods emanate from the same source, and/or that Dentsoll is in some other fashion connected, affiliated, or associated with Colgate, all to Colgate's injury.

10. In sum, for several reasons, including the close similarity of Colgate's TOTAL mark and the Dentsoll Mark, the resulting confusing similarity with respect to sight, sound, and meaning, the fact that the Dentsoll Mark and Colgate's TOTAL Mark both cover oral care products, and the enormous consumer recognition and goodwill associated with Colgate's oral care products and its TOTAL mark, there is the clear likelihood that consumers will mistakenly believe

that Dentsoll's goods that are sold and advertised using the Dentsoll Mark are licensed by, originate with, or are otherwise affiliated with Colgate.

11. Concurrent use of Colgate's TOTAL mark and the Dentsoll Mark will likely result in consumer confusion as to source, sponsorship, approval, or affiliation within the meaning of 15 U.S.C. §§ 1114 and 1125(a), and as such, Colgate is likely to be damaged by registration of the Dentsoll Mark within the meaning of 15 U.S.C. § 1063(a).

12. Registration of the Dentsoll Mark is barred by 15 U.S.C. § 1052(d) because it consists of or comprises a mark that so resembles Colgate's TOTAL marks previously registered in the Patent and Trademark Office and previously used by Colgate and not abandoned, as to be likely, when applied to Dentsoll's goods, to cause confusion, mistake, or to deceive.

13. Dentsoll's use of the Dentsoll Mark is likely to cause dilution of the distinctiveness and goodwill associated with Colgate's famous TOTAL mark within the meaning of 15 U.S.C. § 1125(c). As such, Colgate is likely to be damaged by registration of the Dentsoll Mark within the meaning of 15 U.S.C. § 1063(a), and registration should be denied pursuant to 15 U.S.C. § 1125(c).

WHEREFORE, Colgate respectfully prays that this opposition be sustained and Dentsoll be denied registration of the mark covered by Serial No. 85/058,679.

Respectfully submitted,



Brendan J. O'Rourke  
Adam D. Siegartel  
Dolores F. DiBella  
Proskauer Rose LLP  
Eleven Times Square  
New York, NY 10036  
Tel.: 212.969.3000  
Fax: 212.969.2900

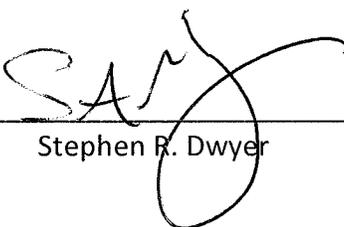
*Attorneys for Opposer  
Colgate-Palmolive Company*

Date: July 20, 2011

CERTIFICATE OF SERVICE

The undersigned does hereby certify that on July 20, 2011, I served a true copy of the foregoing Notice of Opposition by first class mail on Applicant as follows:

Yun Soon Kim  
President  
Dentsoll Inc.  
5836 Buford Highway; STE B  
Norcross, Georgia 30071



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Stephen R. Dwyer

# **EXHIBIT 1**

**Thank you for your request. Here are the latest results from the TARR web server.**

**This page was generated by the TARR system on 2011-07-20 13:33:05 ET**

**Serial Number:** 75172706 [Assignment Information](#)      [Trademark Document Retrieval](#)

**Registration Number:** 2142102

**Mark (words only):** TOTAL

**Standard Character claim:** No

**Current Status:** A cancellation proceeding is pending at the Trademark Trial and Appeal Board. For further information, see TTABVUE on the Trademark Trial and Appeal Board web page.

**Date of Status:** 2010-10-07

**Filing Date:** 1996-09-26

**Transformed into a National Application:** No

**Registration Date:** 1998-03-10

**Register:** Principal

**Law Office Assigned:** LAW OFFICE 106

**If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)**

**Current Location:** 830 -Post Registration

**Date In Location:** 2008-03-05

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**LAST APPLICANT(S)/OWNER(S) OF RECORD**

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1. Colgate-Palmolive Company

**Address:**

Colgate-Palmolive Company  
300 Park Avenue  
New York, NY 10022  
United States

**Legal Entity Type:** Corporation

**State or Country of Incorporation:** Delaware

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**GOODS AND/OR SERVICES**

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**International Class:** 003  
**Class Status:** Active  
oral care products, namely, toothpaste  
**Basis:** 1(a)  
**First Use Date:** 1995-03-22  
**First Use in Commerce Date:** 1995-03-22

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#### ADDITIONAL INFORMATION

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**Prior Registration Number(s):**  
1928463  
2015834

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#### MADRID PROTOCOL INFORMATION

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(NOT AVAILABLE)

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#### PROSECUTION HISTORY

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**NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.**

2011-06-21 - Attorney Revoked And/Or Appointed  
2011-06-21 - TEAS Revoke/Appoint Attorney Received  
2010-10-07 - Cancellation Instituted No. 999999  
2010-05-20 - Notice Of Suit  
2009-08-26 - Notice Of Suit  
2009-08-13 - Counter claim opp. for Proceeding No.  
2008-03-05 - First renewal 10 year  
2008-03-05 - Section 8 (10-year) accepted/ Section 9 granted  
2008-03-03 - Assigned To Paralegal  
2008-02-26 - TEAS Section 8 & 9 Received  
2007-03-29 - Case File In TICRS  
2006-03-13 - Undeliverable Mail - No Action Taken  
2006-03-07 - PAPER RECEIVED

2006-02-15 - Section 8 (6-year) accepted & Section 15 acknowledged

2006-02-15 - Assigned To Paralegal

2004-02-04 - Section 8 (6-year) and Section 15 Filed

2004-02-04 - TEAS Section 8 & 15 Received

1998-03-10 - Registered - Principal Register

1997-12-16 - Published for opposition

1997-11-14 - Notice of publication

1997-10-09 - Approved for Pub - Principal Register (Initial exam)

1997-09-08 - Communication received from applicant

1997-03-27 - Non-final action mailed

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**ATTORNEY/CORRESPONDENT INFORMATION**

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**Attorney of Record**

Nadine Flynn

**Correspondent**

Nadine Flynn

Colgate-Palmolive Company

300 Park Avenue

New York NY 10022

Phone Number: 212.310.3647

Fax Number: 212.310.3406

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**Thank you for your request. Here are the latest results from the TARR web server.**

**This page was generated by the TARR system on 2011-07-20 13:33:35 ET**

**Serial Number:** 75041948 [Assignment Information](#)      [Trademark Document Retrieval](#)

**Registration Number:** 2015834

**Mark (words only):** TOTAL

**Standard Character claim:** No

**Current Status:** A cancellation proceeding is pending at the Trademark Trial and Appeal Board. For further information, see TTABVUE on the Trademark Trial and Appeal Board web page.

**Date of Status:** 2010-10-07

**Filing Date:** 1996-01-11

**Transformed into a National Application:** No

**Registration Date:** 1996-11-12

**Register:** Principal

**Law Office Assigned:** LAW OFFICE 108

**If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)**

**Current Location:** 830 -Post Registration

**Date In Location:** 2007-02-03

---

**LAST APPLICANT(S)/OWNER(S) OF RECORD**

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1. Colgate-Palmolive Company

**Address:**

Colgate-Palmolive Company  
300 Park Avenue  
New York, NY 10022  
United States

**Legal Entity Type:** Corporation

**State or Country of Incorporation:** Delaware

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**GOODS AND/OR SERVICES**

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**International Class:** 021  
**Class Status:** Active  
oral care products, namely toothbrushes  
**Basis:** 1(a)  
**First Use Date:** 1992-10-00  
**First Use in Commerce Date:** 1992-10-00

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#### ADDITIONAL INFORMATION

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**Prior Registration Number(s):**  
1928463

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#### MADRID PROTOCOL INFORMATION

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(NOT AVAILABLE)

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#### PROSECUTION HISTORY

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**NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.**

2010-10-07 - Cancellation Instituted No. 999999  
2009-08-13 - Counter claim opp. for Proceeding No.  
2007-02-03 - First renewal 10 year  
2007-02-03 - Section 8 (10-year) accepted/ Section 9 granted  
2007-01-25 - Assigned To Paralegal  
2006-11-15 - Combined Section 8 (10-year)/Section 9 filed  
2006-11-15 - TEAS Section 8 & 9 Received  
2006-09-15 - Case File In TICRS  
2004-10-25 - TEAS Change Of Correspondence Received  
2002-05-03 - Section 8 (6-year) accepted & Section 15 acknowledged  
2002-03-07 - Section 8 (6-year) and Section 15 Filed  
1996-11-12 - Registered - Principal Register  
1996-08-20 - Published for opposition

1996-07-19 - Notice of publication

1996-06-06 - Approved for Pub - Principal Register (Initial exam)

1996-05-30 - Assigned To Examiner

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**ATTORNEY/CORRESPONDENT INFORMATION**

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**Attorney of Record**

AMANDA SAMUEL

**Correspondent**

BRENDAN J O'ROURKE

PROSKAUER ROSE LLP

ELEVEN TIMES SQUARE TRADEMARK FILE ROOM

NEW YORK, NY 10036-8299

Phone Number: 212-310-2826

Fax Number: 212-310-3406

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## **EXHIBIT 2**

**Thank you for your request. Here are the latest results from the TARR web server.**

**This page was generated by the TARR system on 2011-07-20 13:35:02 ET**

**Serial Number:** 85058679 [Assignment Information](#) [Trademark Document Retrieval](#)

**Registration Number:** (NOT AVAILABLE)

**Mark**



**The Total Dental Care Solution**

**(words only):** DENTSOLL THE TOTAL DENTAL CARE SOLUTION

**Standard Character claim:** No

**Current Status:** A request for an extension of time to file an opposition has been filed with the Trademark Trial and Appeal Board. For further information, see TTABVUE on the Trademark Trial and Appeal Board web page.

**Date of Status:** 2011-04-21

**Filing Date:** 2010-06-09

**Filed as TEAS Plus Application:** Yes

**Currently TEAS Plus Application:** Yes

**Transformed into a National Application:** No

**Registration Date:** (DATE NOT AVAILABLE)

**Register:** Principal

**Law Office Assigned:** LAW OFFICE 117

**Attorney Assigned:**  
LOTT MAUREEN DALL

**Current Location:** 650 -Publication And Issue Section

**Date In Location:** 2011-02-11

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**LAST APPLICANT(S)/OWNER(S) OF RECORD**

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1. Dentsoll Inc

**DBA/AKA/TA/Formerly:** DBA Dentsoll

**Address:**

Dentsoll Inc  
5836 Buford Hwy Ste B  
Norcross, GA 30071  
United States

**Legal Entity Type:** Corporation

**State or Country of Incorporation:** Georgia

**Phone Number:** 7703145226

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**GOODS AND/OR SERVICES**

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**International Class:** 021

**Class Status:** Active

Oral hygiene devices, namely, interdental cleaners

**Basis:** 1(a)

**First Use Date:** 2009-06-01

**First Use in Commerce Date:** 2009-06-01

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**ADDITIONAL INFORMATION**

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**Color(s) Claimed:** The color(s) red, blue, orange, yellow, and black is/are claimed as a feature of the mark.

**Disclaimer:** "DENTAL CARE SOLUTION"

**Description of Mark:** The mark consists of the stylized wording "DentSoll" with each letter "l" appearing as a dental instrument. An incomplete circle comprised of many small circles starts above the "t" in "DentSoll" and ends after "Soll" in "DentSoll". Underneath "DentSoll" in the mark is the stylized wording "The Total Dental Care Solution". The color black appears in the wording "The Total Dental Care Solution". The color blue appears in the word "Dent", and the color red appears in "Soll", except for the upper tips of the dental instruments, which are only outlined in red. The circles making up the larger incomplete circle begin with several in blue over the "t" in "Dent" followed by several that are red and blue combined, followed by a couple red circles, followed by several orange circles and ending with several yellow circles next to the last "l" in "Soll" in the mark. The white in the drawing including the white in the tips of each letter "l" in "Soll", represents transparent areas only and is not part of the mark.

**Design Search Code(s):**

**10.05.25** - Bathroom articles, soap dishes; Cotton balls; Cotton swabs; Dental floss; Emery boards; Eye patches; Feminine hygiene products; Files (nail); Floss, dental; Nail clippers; Nail files; Polisher/buffers, nail; Shoe horns; Tooth picks; Vibrators, massage

**26.01.05** - Circles made of broken or dotted lines

**27.03.05** - Objects forming letters or numerals

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**MADRID PROTOCOL INFORMATION**

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(NOT AVAILABLE)

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**PROSECUTION HISTORY**

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**NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.**

2011-04-21 - Extension Of Time To Oppose Received  
2011-03-22 - Notice Of Publication E-Mailed  
2011-03-22 - Published for opposition  
2011-02-11 - Law Office Publication Review Completed  
2011-02-10 - Approved for Pub - Principal Register (Initial exam)  
2011-01-31 - Teas/Email Correspondence Entered  
2011-01-31 - Communication received from applicant  
2011-01-28 - Assigned To LIE  
2011-01-18 - TEAS Response to Office Action Received  
2010-09-26 - Notification Of Non-Final Action E-Mailed  
2010-09-26 - Non-final action e-mailed  
2010-09-26 - Non-Final Action Written  
2010-09-19 - Assigned To Examiner  
2010-06-16 - Notice Of Design Search Code And Pseudo Mark Mailed  
2010-06-15 - New Application Office Supplied Data Entered In Tram  
2010-06-12 - New Application Entered In Tram

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**ATTORNEY/CORRESPONDENT INFORMATION**

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**Correspondent**  
DENTSOLL INC  
5836 BUFORD HWY STE B  
NORCROSS, GA 30071

Phone Number: 7703145226

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