

ESTTA Tracking number: **ESTTA532223**

Filing date: **04/15/2013**

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 parties oppose registration of the indicated application.

Opposers Information

Name	Norwex Malta Limited
Granted to Date of previous extension	04/13/2013
Address	Pama, No. 6 Triq Sant Anna, Zebbiegh Mgarr, MST10 MALTA

Name	Norwex USA, Inc.
Granted to Date of previous extension	04/13/2013
Address	14679 Midway Road Suite 115 Addison, TX 75001 UNITED STATES

Name	Norwex Canada, Inc.
Granted to Date of previous extension	04/13/2013
Address	871 Whitmore Ave. E.Box 714 Dauphin, Manitoba, R7N 3B3 CANADA

Name	Norwex Holdings, AS
Granted to Date of previous extension	04/13/2013
Address	Taerudgata 3 Lillestrom, 2004 NORWAY

Attorney information	Thomas A. Kulik Scheef & Stone, L.L.P. 500 North Akard Suite 2700 Dallas, TX 75201 UNITED STATES trademarks@solidcounsel.com, tom.kulik@solidcounsel.com Phone:214-706-4200
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Applicant Information

Application No	85725688	Publication date	02/12/2013
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Opposition Filing Date	04/15/2013	Opposition Period Ends	04/13/2013
Applicant	Menper Distributors Inc. 6500 NW 35th. Ave. Miami, FL 33147 UNITED STATES		

Goods/Services Affected by Opposition

Class 005. First Use: 2011/04/11 First Use In Commerce: 2011/04/11 All goods and services in the class are opposed, namely: Laxatives
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Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
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.	3387701	Application Date	12/27/2006
Registration Date	02/26/2008	Foreign Priority Date	NONE
Word Mark	NORWEX		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use: First Use: 2005/01/00 First Use In Commerce: 2005/01/00 Cleaning preparations for household purposes; dishwashing detergents; dishwasher detergents; facial lotion; foam soap for hands; pumice stone for personal use; hand, body and foot lotion; lip balm; laundry detergent; mattress cleaning preparation for elimination and removal of all organic waste inside mattresses; deodorant for personal use; hair conditioner; rust and lime removing preparations; skin cleansers; hair shampoo; fabric softeners for laundry use; tongue cleaning preparations; decalcifying and descaling preparations for cleaning household products</p> <p>Class 005. First use: First Use: 2005/09/00 First Use In Commerce: 2005/09/00 Hand sanitizing and disinfecting preparation with anti-bacterial and anti-microbial properties; odor neutralizing preparations for use in litter boxes, garbage disposals, diaper pails, musty basement smells, shoes, clothing, and carpeting</p> <p>Class 021. First use: First Use: 2005/01/00 First Use In Commerce: 2005/01/00 Cleaning products, namely, mops and ergonomic attachments therefor, namely,</p>		

	<p>mopheads and telescopic handles; stainless steel scrub sponges for cleaning; spray bottles sold empty; microfiber toothbrushes; toilet cleaning kit comprised of toilet brushes; cleaning cloths for removing wax, dirt, debris, pesticides and bacteria from fruits and vegetables; cleaning cloths for removing make up, cleansing and exfoliating; cleaning cloths for cleaning, wiping and dusting; wiping cloths, namely, shammies or chamois; dusting mitts; cleaning cloths for wiping windows; brushes for removing hair, lint and dust from textiles, car seats, and pets; eyeglass cleaning cloths; abrasive pads for kitchen or domestic purposes; cleaning sponges</p> <p>Class 024. First use: First Use: 2005/01/00 First Use In Commerce: 2005/01/00 Hooded towels, hooded baby bed blanket, bath towels; kitchen towel sets comprised of kitchen towels; sport towels; cloth napkins for removing makeup</p> <p>Class 027. First use: First Use: 2005/01/00 First Use In Commerce: 2005/01/00 Bathmats</p> <p>Class 035. First use: First Use: 2005/01/00 First Use In Commerce: 2005/01/00 Retail services by direct solicitation by sales agents in the field of cleaning products; providing on-line ordering services in the field of cleaning products; providing technical assistance in the establishment of and/or operation of independent direct sales businesses; business information services in the nature of providing information on business opportunities related to independent direct sales businesses</p> <p>Class 041. First use: First Use: 2005/01/00 First Use In Commerce: 2005/01/00 Providing education services, namely, training services to independent sales representatives in the field of cleaning products and personal care products, and sales techniques</p>
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U.S. Registration No.	4026206	Application Date	02/22/2011
Registration Date	09/13/2011	Foreign Priority Date	NONE
Word Mark	NORWEX		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use: First Use: 2005/09/01 First Use In Commerce: 2005/09/01 Organic shea butter skin cream; organic leg cream; organic face and neck gel; organic herbs skin cream; organic day skin cream; organic night skin cream; organic hand cream; organic face lifting beauty serum; bath and shower gel; bath, shower and personal care products, namely, organic olive oil salt scrub; oven and grill cleaner; drain opener; carpet stain remover</p> <p>Class 011. First use: First Use: 1999/04/01 First Use In Commerce: 2000/08/01 Water softening apparatus for use in a dishwasher, namely a rubber ball with a magnet inside that softens water</p>		

	Class 018. First use: First Use: 2010/09/01 First Use In Commerce: 2010/09/01 Sack packs, namely, drawstring bags used as backpacks Class 022. First use: First Use: 2010/09/01 First Use In Commerce: 2010/09/01 Laundry wash bags
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Attachments	77071573#TMSN.jpeg (1 page)(bytes) 85248357#TMSN.jpeg (1 page)(bytes) EDOCS-#2286-v1-Norwex___Menper___Notice_of_Opposition.pdf (7 pages))(43507 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	/Thomas A. Kulik/
Name	Thomas A. Kulik
Date	04/15/2013

each Opposer hereby accordingly opposes registration of the Applicant's Mark. The Grounds for opposition are as follows:

1. Applicant seeks to obtain under the provisions of the Trademark Act of 1946 as amended, registration on the Principal Register of the Applicant's Mark for:

International Class 5: Laxatives (the "Applicant's Goods")

2. The Application is based on Applicant's purported first use of Applicant's Mark in commerce on or after April 11, 2011.

3. Applicant's Mark published for opposition on February 12, 2013. On March 14, 2013, within the time allowed for opposition of Applicant's Mark, each of the Opposers filed a Request for Extension of Time to Oppose (the "Requests"). The Board granted the Requests and extended the time to oppose the Applicant's Mark to April 13, 2013, which fell on a Saturday. This Notice of Opposition is therefore timely filed on the first day after April 13, 2013 which was not a Saturday, Sunday or a federal holiday within the District of Columbia.

4. Opposer Norwex Holding AS is the owner of the following U.S. Trademark Registrations (the "Registered Marks"):

NORWEX, Reg. No. 3,387,701

NORWEX, Reg. No. 4,026,206

5. Opposer Norwex Holding AS licensed the use of the Registered Marks to Opposer Norwex Malta Limited, which in turn has sub-licensed the Registered Marks to each of Norwex Canada, Inc. (formerly known as Norwex Enviro Products, Inc.) and Norwex USA Inc.

6. Opposers use the Registered Marks in connection with, among others, cleaning preparations for household purposes; dishwashing detergents; dishwasher detergents; facial lotion; foam soap for hands; pumice stone for personal use; hand, body and foot lotion; lip balm;

laundry detergent; mattress cleaning preparation for elimination and removal of all organic waste inside mattresses; deodorant for personal use; hair conditioner; rust and lime removing preparations; skin cleansers; hair shampoo; fabric softeners for laundry use; tongue cleaning preparations; decalcifying and de-scaling preparations for cleaning household products; hand sanitizing and disinfecting preparation with anti-bacterial and anti-microbial properties; odor neutralizing preparations for use in litter boxes, garbage disposals, diaper pails, musty basement smells, shoes, clothing, and carpeting; cleaning products, namely, mops and ergonomic attachments, such as mop-heads and telescopic handles; stainless steel scrub sponges for cleaning; spray bottles sold empty; microfiber toothbrushes; toilet cleaning kit comprised of toilet brushes; cleaning cloths for removing wax, dirt, debris, pesticides and bacteria from fruits and vegetables; cleaning cloths for removing make up, cleansing and exfoliating; cleaning cloths for cleaning, wiping and dusting; wiping cloths, namely, shammies or chamois; dusting mitts; cleaning cloths for wiping windows; brushes for removing hair, lint and dust from textiles, car seats, and pets; eyeglass cleaning cloths; abrasive pads for kitchen or domestic purposes; cleaning sponges; hooded towels, hooded baby bed blanket, bath towels; kitchen towel sets comprised of kitchen towels; sport towels; cloth napkins for removing makeup; bathmats; retail services by direct solicitation by sales agents in the field of cleaning products; providing on-line ordering services in the field of cleaning products; providing technical assistance in the establishment of and/or operation of independent direct sales businesses; business information services in the nature of providing information on business opportunities related to independent direct sales businesses; providing education services, namely, training services to independent sales representatives in the field of cleaning products and personal care products, and sales techniques, and other related goods and services (“Opposers’ Goods and Services”).

7. The Registered Marks are valid and subsisting, and are prima facie evidence of Opposers' exclusive rights to use said mark in commerce on the goods and services specified in each registration.

8. Since at least as early as September 2005, one or more of the Opposers, themselves and/or through licensees, have used the Registered Marks in the United States. Said use has been continuous since the date of first use and has not been abandoned.

9. Opposers have advertised and promoted the Registered Marks extensively. Opposers have also made substantial sales of Opposers' Goods and Services using the Registered Marks. As a result of such use and promotion, the Registered Marks have developed and represent valuable goodwill inuring to the benefit of Opposers.

10. The Registered Marks had priority over Applicant's Mark long before the February 12, 2013 filing date of the Application.

11. Applicant's Mark is essentially identical to and otherwise deceptively and confusingly similar to each of the Registered Marks. Applicant's Mark has an overall confusingly similar appearance, sound, meaning and commercial impression. Further Applicant's Goods are highly related to Opposers' Goods and Services, and Applicant's Goods marketed and sold under Applicant's Mark are within the zone of natural expansion of Opposers' Goods and Services marketed and sold under the Registered Marks. Consumers are therefore likely to mistakenly believe that Applicant's Goods are offered by, affiliated with and/or sponsored by Opposers, when such is not true.

12. Due to the essentially identical nature of Applicant's Mark and the Registered Marks, the closely related nature of the goods and services provided by the respective parties, and the fact that Opposers' goods are within the zone of natural expansion of Opposers' Goods

and Services, consumer and potential consumers are likely to believe that Applicant's Goods originate from Opposers, resulting in a likelihood of confusion in the marketplace, and damage to Opposers.

13. Upon information and belief, Opposers' Goods and Services marketed and sold under the Registered Marks and Applicant's Goods sold under Applicant's Mark will be promoted and sold in similar channels of trade to the same consumers or class of consumers.

14. The use and registration by Applicant of Applicant's Mark for Applicant's Goods are likely to cause confusion or to cause mistake or deception among consumers and potential consumers, with the Registered Marks, again resulting in damage to Opposers.

15. Because of the highly related nature of the goods and services, the fact that the Applicant's goods are within the zone of natural expansion of Opposers' Goods and Services, and the highly similar nature of the marks in overall appearance, sound, meaning and commercial impression, the use and registration of the Applicant's Mark is likely to cause confusion, mistake, or deception that Applicant's Goods are those of Opposers, or are otherwise endorsed, sponsored, or approved by Opposers causing further damage to Opposers.

16. The Registered Marks are famous and distinctive, and were famous prior to any first use of the Applicant's Mark. Applicant's Mark is likely to cause dilution and is likely to harm the reputation of the Registered Marks.

17. If Applicant is granted registration of Applicant's Mark, it would thereby obtain at least a *prima facie* exclusive right to use of its alleged mark. Such registration would be a source of further damage and injury to Opposers.

18. Registration of the Applicant's Mark will result in damage to Opposers under the provisions of §2(a), §2(d) §43(c) and of the U.S. Trademark Act, 15 U.S.C. §1052, §1125 pursuant to the allegations stated above.

WHEREFORE, Opposers ask that their opposition to this Application be sustained and that the registration of the Applicant's Mark in the Application be refused. Please direct all correspondence to the attention of:

Tom A. Kulik
Bryan Haynes
Scheef & Stone, L.L.P.
500 North Akard
Suite 2700
Dallas, Texas 75201
Telephone: (214) 706-4223
Facsimile: (214) 706-4242

Opposers hereby appoint Tom A. Kulik and Bryan Haynes, of Scheef & Stone, L.L.P., as their attorneys with the full power to represent the Opposers in connection with this proceeding.

Respectfully submitted,

/s/ Bryan Haynes

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