

ESTTA Tracking number: **ESTTA571862**

Filing date: **11/20/2013**

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 party opposes registration of the indicated application.

Opposer Information

Name	The BioSolve Company
Granted to Date of previous extension	01/22/2014
Address	329 Massachusetts Avenue Lexington, MA 02420 UNITED STATES

Attorney information	John H. Pearson, Jr. Pearson & Pearson, LLP 10 George Street Lowell, MA 01852 UNITED STATES patlaw@pearson-pearson.com Phone:978452-1971
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Applicant Information

Application No	85893885	Publication date	09/24/2013
Opposition Filing Date	11/20/2013	Opposition Period Ends	01/22/2014
Applicant	Biocenosis Solutions, Inc. 16 Greve Dr. Centralia, IL 62801 ISRAEL		

Goods/Services Affected by Opposition

Class 001. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Products used in connection with waste water systems, namely, waste water treatment chemicals for industrial, municipal, and residential use for the purpose of enhancing microbial activity and performance

Grounds for Opposition

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.	1924960	Application Date	09/29/1994
Registration Date	10/10/1995	Foreign Priority Date	NONE
Word Mark	BIO SOLVE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 001. First use: First Use: 1975/03/31 First Use In Commerce: 1975/03/31 water soluble petroleum neutralizing and dispersing agent that renders petroleum based spills non-flammable and biodegradable

U.S. Registration No.	4266461	Application Date	03/08/2011
Registration Date	01/01/2013	Foreign Priority Date	NONE

Word Mark	BIOSOLVE
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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: 1975/03/31 First Use In Commerce: 1975/03/31 Chemicals, namely, water based chemicalformulations used to mitigate contamination from hydrocarbons through soil remediation, surface cleaning, vapor and/or odor suppression, gas scrubbing, bioremediation, and grease and/or paraffin control in the fields of environmental protection, industrial maintenance, water treatment, firefighting and commercial and/or industrial kitchens
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Attachments	85261227#TMSN.jpeg(bytes) Notice of Opposition.pdf(19092 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	/John H. Pearson, Jr./
Name	John H. Pearson, Jr.
Date	11/20/2013

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

THE BIOSOLVE COMPANY)	
)	Opposition No.
)	
Opposer)	MARK: BIO-SOL
)	
vs.)	
)	Serial No. 85/893,885
BIOCENOSIS SOLUTIONS, INC.)	
)	Published in the Official
)	Gazette on September 24, 2013
Applicant)	
)	
)	

NOTICE OF OPPOSITION

THE BIOSOLVE COMPANY, a corporation duly organized and existing under the laws of the Commonwealth of Massachusetts, having its principal place of business at 329 Massachusetts Avenue, Lexington, Massachusetts 02420 ("Opposer"), believes that it will be damaged by the registration of the mark shown in Application Serial No. 85/893,885, filed April 3, 2013, by BIOCENOSIS SOLUTIONS, INC., 16 Greve Drive, Centralia, Illinois 62801("Applicant"), published in the Official Gazette on September 24, 2013, and hereby opposes registration of the mark on the grounds that the mark is likely to cause confusion or mistake, or to deceive consumers regarding the source,

sponsorship or affiliation of the parties' respective goods and services in light of:

(a) Opposer's incontestable U.S. Registration No. 1,924,960 for "BIO SOLVE" (Attached and marked **Exhibit A**);

(b) Opposer's U.S. Registration No. 4,266,461 for "BIOSOLVE" (Attached and marked **Exhibit B**); and

(c) Opposer's prior adoption, use of "BIO-SOLVE" and "BIOSOLVE" as trade names.

(Hereinafter Opposer's U.S. Registrations and trade names "BIO SOLVE" and "BIOSOLVE" are collectively referred to as "Opposer's Marks and Trade Names".)

The grounds for the opposition are as follows:

INTRODUCTION

1. Opposer is a well known national provider and seller of various goods, including, chemicals, namely, water based chemical formulations used to mitigate contamination from hydrocarbons through soil remediation, surface cleaning, vapor and/or odor suppression, gas scrubbing, bioremediation, and grease and/or paraffin control in the fields of environmental protection, industrial maintenance, water treatment, firefighting and commercial and/or industrial kitchens under the mark "BIOSOLVE" and water soluble petroleum neutralizing and dispersing agent that renders petroleum based spills non-flammable and biodegradable under the mark "BIO SOLVE".

2. By this intent-to-use application herein opposed, Applicant seeks to obtain under the provisions of the Trademark Act of 1946 as amended, registration on the Principal Register of the trademark "BIO-SOL" for inter alia:

International Class: 01

Products used in connection with waste water systems, namely, waste water treatment chemicals for industrial, municipal, and residential use for the purpose of enhancing microbial activity and performance

FACTS

3. Opposer's "BIO SOLVE" and "BIOSOLVE" trademarks and trade names have been extensively used, advertised and promoted throughout the United States at least as early as March 31, 1975.

Opposer is the rightful owner of Opposer's:

<u>MARK</u>	<u>REG. No.</u>	<u>CLASS</u>	<u>ISSUE DATE</u>	<u>GOODS</u>
BIO SOLVE	1,924,960	1	10/10/1995	water soluble Petroleum neutralizing and dispersing agent that renders petroleum based spills non flammable and biodegradable
BIOSOLVE	4,266,461	1	1/1/2013	chemicals, namely, water based chemical formulations used

to mitigate
contamination from
hydrocarbons
through soil
remediation,
surface cleaning,
vapor and/or odor
suppression, gas
scrubbing,
bioremediation, and
grease and/or
paraffin control in
the fields of
environmental
protection,
industrial
maintenance, water
treatment,
firefighting and
commercial and/or
industrial kitchens

4. In connection with the sale and offering of Opposer's Goods, Opposer has adopted Opposer's Marks and Trade Names and has continuously used these marks and name in connection with Opposer's Goods and Services since as early as 1975.

5. Opposer's Goods provided under Opposer's Marks and Trade Names have been extensively and continuously marketed and promoted by the Opposer. As a result of the quality of Opposer's Goods and the widespread promotion thereof under Opposer's Marks and Trade Names, the Opposer's Goods have met with great commercial success and widespread consumer recognition. In addition, Opposer's Marks and Trade Names have become symbols of Opposer, Opposer's Goods, and Opposer's good will.

6. Opposer first used its marks "BIO SOLVE" and "BIOSOLVE" in interstate commerce at least as early as March 31, 1975 in connection with chemicals, etc. Opposer first used its marks "BIO SOLVE" and "BIOSOLVE" in interstate commerce at least as early as March 31, 1975 in connection with chemicals, etc.

7. On April 3, 2013, Applicant filed its intent-to-use trademark application to register the mark "BIO-SOL" more than thirty-eight (38) years after Opposer first used its mark "BIO SOLVE".

8. On September 24, 2013, the United States Patent and Trademark Office issued a Notice of Publication for the Applicant's application for its mark "BIO-SOL".

GROUNDS

9. Opposer states that the goods of Opposer and Applicant are offered in the same channels of trade and commerce and the goods are offered to similar customers.

10. Opposer will be damaged by registration of Serial No. 85/893,885 for the mark "BIO-SOL" and hereby opposes the same under the provisions of § (a), (d), (e), and (f) of the United States Trademark Act, 15 U.S.C. 1052.

11. Applicant's mark is substantially identical to Opposer's Marks and Trade Names.

12. In addition, both Applicant and Opposer are engaged in the business of providing goods which are identical or similar. In view of these similarities and others, Applicant's "BIO-SOL"

mark so resembles Opposer's Marks and Trade Names for "BIO SOLVE" and "BIOSOLVE" for chemicals, etc., as to likely cause confusion, mistake or to deceive consumers.

13. There is no issue as to priority. The Applicant's date of its Intent-to-Use Application is long after the date of Opposer's first use and registration.

14. Opposer has sold goods using the mark "BIO SOLVE" and "BIOSOLVE" throughout the United States. Opposer has developed an exceedingly valuable good will in regard to the mark covered by Opposer's Marks and Trade Names.

15. By virtue of its efforts, and the expenditure of considerable sums for promotional activities, and by virtue of the excellence of its products, Opposer has gained for Opposer's Marks and Trade Names a valuable reputation.

16. The trademark proposed for registration by the Applicant is substantially identical for identical products and therefore, raises a substantially similar image engendered by the Opposer's Marks and Trade Names "BIO SOLVE" and "BIOSOLVE" so that when the Applicant's mark is applied to goods which are substantially identical to those sold by the Opposer is identical to the Opposer's Marks and Trade Names as to be likely to be confused therewith and mistaken therefor.

17. The Applicant's mark is deceptively similar to Opposer's Marks and Trade Names so as to cause confusion and lead to deception as to the origin of Applicant's goods bearing

the Applicant's mark.

18. If the Applicant is permitted to use and register its mark for its goods, as specified in the application herein opposed, confusion in trade resulting in damage and injury to the Opposer would be caused and would result by reason of the similarity between the Applicant's mark and the Opposer's Marks and Trade Names. Persons familiar with Opposer's Marks and Trade Names would be likely to buy Applicant's goods as and for products sold by the Opposer. Any such confusion in the trade inevitably would result in loss of sales to the Opposer. Furthermore, any defect, objection or fault found with Applicant's products marketed under its mark would necessarily reflect upon and seriously injure the reputation which the Opposer has established for its products merchandised under Opposer's Marks and Trade Names.

19. If the Applicant is granted the registration herein opposed, it would thereby obtain at least a prima facie exclusive right to the use of its mark. Such registration would be a source of damage and injury to the Opposer.

20. The goods for which Applicant seeks to register its alleged mark are described in its said application as "products used in connection with waste water systems, namely, waste water treatment chemicals for industrial, municipal, and residential use for the purpose of enhancing microbial activity and performance." Opposer states that it has been for a number of

years engaged in the sale of chemicals, etc. which are similar to the goods as described in applicant's identification of goods and these goods are well known in the trade. Opposer's goods are sold to the same customers as applicant's goods.

21. On information and belief, the public is likely to be confused, mistaken or deceived into believing that the Applicant's goods identified by the mark "BIO-SOL" as set forth in application serial no. 85/893,885 emanates from the Opposer and others, or are endorsed, sponsored, licensed by or in some other way connected with Opposer or the Opposer's goods.

22. In view of the fact that Applicant's and Opposer's marks are substantially identical and the similarity of the goods offered by Applicant and Opposer in the same or similar channels of distribution of the respective parties, it is stated that Applicant's mark so resembles Opposer's mark as used in the United States, and not abandoned, as to be likely to cause confusion, or to cause mistake, or to deceive.

23. Any registration to Applicant of the mark shown in the aforesaid application is likely to, and will result in financial and other injury and damage to Opposer in its business and in its enjoyment of its established rights in and to Opposer's right to use "BIO SOLVE" and "BIOSOLVE".

WHEREFORE, Opposer requests that Application Serial No. 85/893,885 be refused registration, that no registration be issued thereon to Applicant, and that this Opposition be

sustained in favor of Opposer.

Please direct all correspondence to the law firm of Pearson & Pearson, LLP, 10 George Street, Lowell, Massachusetts 01852, attention: John H. Pearson, Jr.

The Opposer appoints John H. Pearson, Jr., Registration No. 32,288, Walter F. Dawson, Registration No. 30,046 of the firm of Pearson & Pearson, LLP, its attorneys, to prosecute this Opposition and to transact all business in the Patent and Trademark office connected therewith.

Accompanying this Notice of Opposition is the required fee of \$600.00. Please charge any excess fees or credit any overpayment to Deposit Account No. 16-0875 of Opposer's counsel noted below.

Respectfully submitted,
THE BIOSOLVE COMPANY
By its Attorneys,

DATE: November 20, 2013

/John H. Pearson, Jr./
JOHN H. PEARSON, JR.
WALTER F. DAWSON
PEARSON & PEARSON, LLP
ATTORNEYS FOR OPPOSER
10 George Street
Lowell, Massachusetts 01852
Tel: (978) 452-1971
Email: patlaw@pearson-pearson.com

CERTIFICATE OF MAILING

I hereby certify that this Notice of Opposition regarding Application Serial No. 85/893,885 is being filed online with the Trademark Trial and Appeal Office on November 20, 2013 and by mailing a copy to the Applicant, BIOCEANOSIS SOLUTIONS, INC., 16 Greve Drive, Centralia, Illinois 62801, and to Applicant's attorney, Annette P. Heller, Esq., Heller & Associates, 400 Chesterfield Ctr., Suite 400, Chesterfield, Missouri 63017-4800.

/John H. Pearson, Jr./
JOHN H. PEARSON, JR.

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