

ESTTA Tracking number: **ESTTA611500**

Filing date: **06/23/2014**

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	Technopharma Limited		
Entity	Limited Company	Citizenship	United Kingdom
Address	Regent House, 316 Beulah Hill London SE1, UNITED KINGDOM		
Attorney information	David M. Rogero David M. Rogero, P.A. 2625 Ponce de Leon Boulevard, Suite 280 Coral Gables, FL 33134 UNITED STATES dmrogero@dmrpa.com Phone:3054410200		

Applicant Information

Application No	85818821	Publication date	05/27/2014
Opposition Filing Date	06/23/2014	Opposition Period Ends	06/26/2014
International Registration No.	NONE	International Registration Date	NONE
Applicant	Unilever Plc Port Sunlight Wirral, Merseyside, CH624ZD UNITED KINGDOM		

Goods/Services Affected by Opposition

<p>Class 003. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Soaps; cleaning preparations; perfumery; essential oils; essential oils for use in aromatherapy; non-medicated skin creams with essential oils for use in aromatherapy; massage preparations in the nature of massage oils, lotions and creams; body deodorants and antiperspirants; hair care preparations; non-medicated toiletries; cosmetic preparations for bath and shower; cosmetic preparations for skin care; skin creams, lotions, oils and preparations and skin lightening creams, lotions, oils and preparations for cosmetic use; shaving preparations; pre-shave creams and liquid and aftershave preparations; depilatory preparations; sun-tanning and sun screen preparations; cosmetics; makeup and make-up removing preparations; petroleum jelly for cosmetic purposes; non-medicated lip care preparations; talcum powder; cotton wool and cotton sticks for cosmetic purposes; cosmetic pads, pre-moistened cosmetic tissues and moistened cosmetic wipes; pre-moistened cosmetic wipes, tissues and towelettes; impregnated cleansing cloths; wipes impregnated with a cleaning preparation; beauty masks; facial masks</p>
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Applicant Information

Application No	85818836	Publication date	05/27/2014
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Opposition Filing Date	06/23/2014	Opposition Period Ends	06/26/2014
International Registration No.	NONE	International Registration Date	NONE
Applicant	Unilever Plc Port Sunlight Wirral, Merseyside, CH624ZD UNITED KINGDOM		

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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)
<i>Torres v. Cantine Torresella S.r.l. Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3071686	Application Date	11/22/2002
Registration Date	03/21/2006	Foreign Priority Date	NONE
Word Mark	NEW YORK FAIR AND LOVELY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 2003/12/01 First Use In Commerce: 2005/11/30 Skin soaps, skin cleansers, cosmetics [, perfume and cologne, hair lotions and dentifrices] Class 005. First use: First Use: 2003/12/01 First Use In Commerce: 2005/11/30 Medicated skin creams and medicated skin lotions [medicated shampoos]		

Related Proceedings	92056654
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Attachments	Opposition statement 06232014.pdf(28540 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	/s/David M. Rogero/
Name	David M. Rogero
Date	06/23/2014

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

TECHNOPHARMA LIMITED,)	
)	
Opposer,)	Opposition No. _____
)	Mark: FAIR AND LOVELY
v.)	Serial Nos. 85818821 and 85818836
)	
)	
UNILEVER, PLC.,)	
)	
Applicant.)	
_____)	

CONSOLIDATED OPPOSITION STATEMENT

Technopharma Limited, a limited company organized under the laws of the United Kingdom, having a place of business at Regent House, 316 Beulah Hill London SE19 3HE, United Kingdom, (hereinafter “Opposer”) believes it will be damaged and injured by the registration of the mark FAIR & LOVELY as shown in Applications bearing Serial Nos. 85818821 and 85818836 (hereinafter the “Applications”), filed by Applicant Unilever, PLC, (hereinafter “Applicant”), and published for opposition on May 27, 2014, in the Official Gazette for Trademarks. Opposer opposes the Applications under the provisions of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

Opposer alleges, solely for the purpose of this proceeding, as grounds for opposition, the following:

1. Opposer is the owner of all right, title and interest in and to the trademark NEW YORK FAIR & LOVELY, and U.S. Registration No. 3071686 for this mark, covering beauty and skin care products, namely skin soaps, skin cleansers, in International Class 3, and medicated skin creams and medicated skin lotions, in International Class 5 (hereinafter “Opposer’s

Goods”). Opposer’s mark was registered with the U.S. Patent and Trademark Office on March 21, 2006. A declaration of incontestability was filed on May 3, 2011. Opposer’s Registration No. 3071686 is valid and subsisting and is prima facie evidence of Opposer’s exclusive right to use the NEW YORK FAIR & LOVELY mark in commerce on Opposer’s Goods.

2. Opposer has sold and continues to sell Opposer’s Goods under its NEW YORK FAIR & LOVELY mark in U.S. commerce and has used the NEW YORK FAIR & LOVELY mark in U.S. interstate commerce for more than nine years.

3. As a result of Opposer’s continuous use of its NEW YORK FAIR & LOVELY mark, Opposer’s NEW YORK FAIR & LOVELY mark has become recognized by Opposer’s customers and the purchasing public as being associated with Opposer’s high quality goods and has become synonymous with the goodwill and reputation of Opposer.

4. On January 9, 2013, Applicant filed its Applications for the purported mark FAIR & LOVELY, in both standard character and stylized forms, for the following described goods in International Class 3:

Soaps; cleaning preparations; perfumery; essential oils; essential oils for use in aromatherapy; non-medicated skin creams with essential oils for use in aromatherapy; massage preparations in the nature of massage oils, lotions and creams; body deodorants and antiperspirants; hair care preparations; non-medicated toiletries; cosmetic preparations for bath and shower; cosmetic preparations for skin care; skin creams, lotions, oils and preparations and skin lightening creams, lotions, oils and preparations for cosmetic use; shaving preparations; pre-shave creams and liquid and aftershave preparations; depilatory preparations; sun-tanning and sun screen preparations; cosmetics; makeup and make-up removing preparations; petroleum jelly for cosmetic purposes; non-medicated lip care preparations; talcum powder; cotton wool and cotton sticks for cosmetic purposes; cosmetic pads, pre-moistened cosmetic tissues and moistened cosmetic wipes; pre-moistened cosmetic wipes, tissues and towelettes; impregnated cleansing cloths; wipes impregnated with a cleaning preparation; beauty masks; facial masks

(hereinafter “Applicant's Goods”). The Applications are based upon registrations of the mark in the two forms in the United Kingdom and upon Applicant’s alleged bona fide intention to use the mark in commerce on or in connection with Applicant’s Goods, pursuant to Section 44(e) of the Lanham Act, 15 U.S.C. § 1126(e).

5. Notwithstanding Opposer’s prior Registration No. 3071686, Applicant's Applications were approved for publication, and were published for opposition in the Official Gazette for Trademarks on May 27, 2014.

6. Upon information and belief, Applicant’s Applications are not based upon Section 44(d) of the Lanham Act, 15 U.S.C. § 1126(d), and Applicant does not therefore claim a priority date earlier than the date of filing of its Applications, January 9, 2013. *See* Section 7(c) of the Lanham Act, 15 U.S.C. § 1057(c).

7. Opposer’s November 22, 2002, filing date as well as Opposer's earliest use of its mark in U.S. interstate commerce both predate Applicant's January 9, 2013, filing date for its Applications, the earliest date on which Applicant can rely, and thus Opposer’s rights are senior to those of Applicant.

8. Upon information and belief, at the time of the filing of its Applications for registration of Applicant’s mark, Applicant was fully aware of Opposer’s prior use of its NEW YORK FAIR & LOVELY mark in commerce, Opposer’s prior registration of the NEW YORK FAIR & LOVELY mark, and that, because of the near resemblance of Applicant’s FAIR & LOVELY mark when used in connection with related goods, confusion, mistake and/or deception were likely to be caused. Accordingly, Applicant’s declaration of its right to use its mark in commerce was false and fraudulent.

9. Upon information and belief, Applicant lacks a bona fide intention to use the mark FAIR & LOVELY on all of Applicant's Goods as described in the Applications.

10. Applicant's FAIR & LOVELY mark, as it will be used on Applicant's Goods, is confusingly similar to Opposer's NEW YORK FAIR & LOVELY mark.

11. Upon information and belief, Opposer's Goods and Applicant's Goods are likely to be offered, promoted and sold to the same class of purchasers.

12. Upon information and belief, Opposer's Goods and Applicant's Goods are likely to be offered, promoted or sold in the same channels of trade.

13. As noted in Paragraph 4, Applicant's mark FAIR & LOVELY is allegedly intended to be used with beauty and skin care products in International Class 3. As such, consumers will undoubtedly associate these goods with Opposer's Goods covered under Opposer's Reg. No. 3071686 and sold under Opposer's NEW YORK FAIR & LOVELY mark. Accordingly, Applicant's use of its alleged FAIR & LOVELY mark is calculated to trade off Opposer's goodwill in its NEW YORK FAIR & LOVELY mark.

14. Opposer believes and alleges that Applicant's alleged mark, when applied to the Applicant's Goods as listed in Applications is likely to cause confusion or mistake or to deceive, and will deceive and mislead the trade and the purchasing public into believing that Opposer is the source of Applicant's Goods, that Opposer sponsors, approves or endorses Applicant's Goods, that Applicant is authorized, licensed or controlled by Opposer, or that Applicant is a division or subsidiary of, or in some way related to Opposer.

15. Applicant's alleged mark "so resembles a mark registered in the Patent and Trademark Office, or a mark ... previously used in the United States and not abandoned, as to be

likely, when applied to the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d).

16. If Applicant is permitted to register its alleged mark in connection with Applicant's Goods, confusion in trade and dilution of the distinctive quality of Opposer's NEW YORK FAIR & LOVELY mark resulting in damage and injury to Opposer would be caused and would result by reason of the confusingly similar nature of Applicant's alleged mark and Opposer's NEW YORK FAIR & LOVELY mark. Furthermore, any misrepresentation, objection or fault found with Applicant's Goods promoted or sold under its alleged mark would necessarily reflect on and seriously injure the reputation that Opposer has established through its long and continuous use of its NEW YORK FAIR & LOVELY mark.

17. If Applicant is granted registration of its alleged FAIR & LOVELY mark, it would thereby obtain at least a prima facie exclusive right to use its alleged mark. This would be a source of further damage and injury to Opposer.

18. For the reasons set forth in the foregoing paragraphs, Applicant is not entitled to register its alleged FAIR & LOVELY mark and the Applications should be refused registration in accordance with Sections 2(d) and 43(c) of the Lanham Act.

[Continued on next page]

WHEREFORE, Opposer prays that the Applications bearing Serial Nos. 85818821 and 85818836 be rejected, that registration of Applicant's alleged mark shown therein be refused and that this Opposition be sustained in favor of Opposer.

Respectfully submitted,

/s/David M. Rogero/

David M. Rogero, Esq.

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