

ESTTA Tracking number: **ESTTA625763**

Filing date: **09/08/2014**

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	Johnson & Johnson
Granted to Date of previous extension	09/06/2014
Address	One Johnson & Johnson Plaza New Brunswick, NJ 08933-7001 UNITED STATES

Attorney information	Jeffrey T. Baravetto Drinker Biddle & Reath LLP 191 North Wacker Drive Suite 3700 Chicago, IL 60606 UNITED STATES trademark.docket@dbr.com, melissa.dillenbeck@dbr.com, michelle.junkas@dbr.com, jeffrey.baravetto@dbr.com Phone:312-569-1491
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Applicant Information

Application No	86204429	Publication date	07/08/2014
Opposition Filing Date	09/08/2014	Opposition Period Ends	09/06/2014
Applicant	AG Essence Inc. 9702 Gayton Road, Suite 142 Richmond, VA 23238 UNITED STATES		

Goods/Services Affected by Opposition

Class 005. First Use: 2014/01/10 First Use In Commerce: 2014/01/10
All goods and services in the class are opposed, namely: Pharmaceutical preparations for wounds

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	194123	Application Date	06/24/1924
Registration Date	01/13/1925	Foreign Priority Date	NONE
Word Mark	BAND-AID		

Design Mark	BAND-AID
Description of Mark	NONE
Goods/Services	Class 005. First use: First Use: 1920/11/00 First Use In Commerce: 1920/11/00 PROTECTIVE SURGICAL DRESSING IN THE FORM OF A BANDAGE

U.S. Registration No.	2373302	Application Date	09/08/1997
Registration Date	08/01/2000	Foreign Priority Date	NONE

Word Mark	BAND-AID FLEXIBLE FABRIC BRAND ADHESIVE BANDAGES FLEXIBLE PROTECTION JOHNSON & JOHNSON
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Design Mark	
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Description of Mark	The dotted lines shown in the drawing are used to show the position of the mark on the packaging for the goods and are not part of the mark.
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Goods/Services	Class 005. First use: First Use: 1998/11/18 First Use In Commerce: 1998/11/18 adhesive bandages
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U.S. Registration No.	2471737	Application Date	08/16/2000
Registration Date	07/24/2001	Foreign Priority Date	NONE

Word Mark	BAND-AID
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Design Mark	BAND-AID
Description of Mark	NONE
Goods/Services	Class 003. First use: First Use: 2000/01/15 First Use In Commerce: 2000/01/15 non-medicated soothing foot gel preparations Class 005. First use: First Use: 1998/01/15 First Use In Commerce: 1998/01/15 [calamine and anti-itch preparations;] first aid antibiotic and pain relief preparations for wounds; [a full line of]foot care products, namely, [self-adhering corn, callus, bunion and] blister pads, cushions, and patches

U.S. Registration No.	3998862	Application Date	10/26/2009
Registration Date	07/19/2011	Foreign Priority Date	NONE

Word Mark	BAND-AID BRAND ADHESIVE BANDAGES
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Design Mark	
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Description of Mark	The mark consists of the words "BAND-AID" in red and the words "BRAND ADHESIVE BANDAGES" in blue appearing underneath a beige colored bandage.
Goods/Services	Class 005. First use: First Use: 2009/12/31 First Use In Commerce: 2009/12/31 Wound dressings, namely, adhesive bandages

U.S. Registration No.	3998863	Application Date	10/26/2009
Registration Date	07/19/2011	Foreign Priority Date	NONE

Word Mark	BAND-AID BRAND ADHESIVE BANDAGES		
Design Mark			
Description of Mark	The mark consists of a rectangle with the words "BAND-AID" in red and "BRAND ADHESIVE BANDAGES" in blue on a white background on the top third of the rectangle with the rest of the rectangle in blue.		
Goods/Services	Class 005. First use: First Use: 2009/12/31 First Use In Commerce: 2009/12/31 Wound dressings, namely, adhesive bandages		

U.S. Registrat No.	3998861	Application Date	10/26/2009
Registration Date	07/19/2011	Foreign Priority Date	NONE
Word Mark	BAND-AID BRAND ADHESIVE BANDAGES		

Design Mark	
Description of Mark	The mark consists of the words "BAND-AID" in red and "BRAND ADHESIVE BANDAGES" in blue appearing underneath a clear bandage with the middle portion of the bandage in beige.
Goods/Services	Class 005. First use: First Use: 2010/02/15 First Use In Commerce: 2010/02/15 Wound dressings, namely, adhesive bandages

Related Proceedings	BAND-A-SIL trademark application #86115297 Opposition 91217827
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Attachments	71199064#TMSN.png(bytes) 75353004#TMSN.png(bytes) 76109649#TMSN.png(bytes) 77856994#TMSN.png(bytes) 77856995#TMSN.png(bytes) 77856977#TMSN.png(bytes) BAND-A-PET Notice of Opposition.pdf(5251752 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	/Jeffrey T. Baravetto/
Name	Jeffrey T. Baravetto
Date	09/08/2014

as November 1920. Opposer first used the BAND-AID mark in connection with antibiotic and pain relief preparations for wounds in 2001.

3. Opposer has registered its long-established rights in the BAND-AID mark in the United States Patent and Trademark Office owning numerous federal registrations, including:

- a) Reg. No. 194,123 - BAND-AID for protective surgical dressing in the form of a bandage; registered January 13, 1925. The registration is incontestable and is based on use since at least as early as November 1920.
- b) Reg. No. 2,373,302 - BAND-AID FLEXIBLE FABRIC BRAND ADHESIVE BANDAGES FLEXIBLE PROTECTION JOHNSON & JOHNSON & Design for adhesive bandages; registered August 1, 2000; based on use since at least as early as November 18, 1998.
- c) Reg. No. 2,471,737 - BAND-AID for calamine and anti-itch preparations; first aid antibiotic and pain relief preparations for wounds; a full line of foot care products namely, self-adhering corn, callus, bunion and blister pads, cushions, and patches; registered July 24, 2001; based on use since at least as early as January 15, 1998.
- d) Reg. No. 3,998,862 – BAND-AID BRAND ADHESIVE BANDAGES & Design for wound dressings, namely adhesive bandages; registered July 19, 2011; based on use since at least as early as December 31, 2009.
- e) Reg. No. 3,998,863 – BAND-AID BRAND ADHESIVE BANDAGES & Design for wound dressings, namely adhesive bandages; registered July 19, 2011; based on use since at least as early as December 31, 2009.
- f) Reg. No. 3,998,861 – BAND-AID BRAND ADHESIVE BANDAGES & Design for wound dressings, namely, adhesive bandages; registered July 19, 2011; based on use since at least as early as February 15, 2010.

4. Opposer's registrations are valid and subsisting. Copies of the certificates of registration are attached.

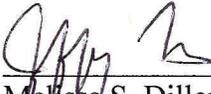
5. Over the years, Opposer has sold many millions of dollars of products under the BAND-AID mark, and marks incorporating the BAND-AID mark, to institutional customers, distributors, retail store customers, and to the general public.

6. Opposer has extensively advertised its BAND-AID brand products to the trade and to the general public through all available media, including but not limited to national print publications, broadcast and cable television media, social media, and point-of-sale advertising in regional and national retailers, including mass merchants and via the Internet and social media.
7. Opposer's BAND-AID mark has become a well-known and famous mark as an indicator of source and origin in Opposer as a result of the marks' long and prominent use in connection with the goods identified in the registrations listed above in Paragraph 3.
8. Opposer's rights in the BAND-AID mark predate any use in commerce or other prior rights that may be claimed by Applicant.
9. Since long prior to Applicant's application filing date of February 26, 2014, and its claimed first use date of January 10, 2014, Opposer has used one or more of a series of marks that feature the BAND-AID mark by itself or in combination with other words and/or design elements to identify a variety of first aid, medical, therapeutic, and other products and services, including antibiotic and pain relief preparations for wounds.
10. Applicant's BAND-A-PET mark so resembles Opposer's long-used and famous BAND-AID mark for closely related goods as to be likely to cause confusion, mistake or deception in violation of Section 2(d) of the Act, 15 U.S.C. § 1052(d).
11. Applicant's BAND-A-PET mark is confusingly similar to Opposer's BAND-AID mark in appearance, sound and commercial impression.
12. The goods on which Opposer uses the BAND-AID mark and the goods for which Applicant seeks to register the BAND-A-PET mark are closely related.

13. The goods on which Opposer uses the BAND-AID mark and the goods for which Applicant seeks to register the BAND-A-PET mark would be sold or rendered through the same channels of trade.
14. The goods on which Opposer uses the BAND-AID mark and the goods for which Applicant seeks to register the BAND-A-PET mark would be sold or rendered to the same class of purchasers.
15. The use and registration by Applicant of the BAND-A-PET mark for the goods identified in Ser. No. 86/204,429 are likely to cause confusion, mistake or deception by having the public erroneously assume or believe that the goods emanate from Opposer, or are in some other way associated or connected with Opposer's prior used and registered BAND-AID mark, all to Opposer's irreparable damage.

For the reasons set forth above, Opposer believes and believing asserts that it will be damaged by the registration of Ser. No. 86/204,429 – BAND-A-PET. Accordingly, Opposer prays that this Opposition be sustained, and that Applicant be refused registration of the BAND-A-PET mark for the goods set forth in application Ser. No. 86/204,429.

Dated: September 8, 2014

Respectfully submitted,
JOHNSON & JOHNSON
By: 
Melissa S. Dillenbeck
Jeffrey T. Baravetto
DRINKER BIDDLE & REATH LLP
191 N. Wacker Drive, Suite 3700
Chicago, Illinois 60606
(312) 569-1000

Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Notice of Opposition was served on Applicant at the following address by first class mail, postage prepaid, this 8th day of September 2014:

AG Essence Inc.
9702 Gayton Rd. Ste 142
Richmond, VA 23238-490

Although not listed as counsel of record at the USPTO, Opposer has been corresponding with counsel listed below who has represented Applicant in preliminary discussions. A copy of the foregoing Notice of Opposition is also served on counsel at the following address by first class mail.

Pamela Chestek
Chestek Legal
PO Box 2492
Raleigh, NC 27602



Registered Jan. 13, 1925.

Trade-Mark 194,123

Republished, under the Act of 1946, June 14, 1949, by
Johnson & Johnson, New Brunswick, N.J.

RENEWED

JAN 13 1945

UNITED STATES PATENT OFFICE.

JOHNSON & JOHNSON, OF NEW BRUNSWICK, NEW JERSEY.

ACT OF FEBRUARY 20, 1905.

Application filed June 24, 1924. Serial No. 199,064.

BAND-AID

STATEMENT.

To the Commissioner of Patents:

Johnson & Johnson, a corporation organized and existing under the laws of the State of New Jersey, and located at New Brunswick, in the county of Middlesex, in said State of New Jersey, and doing business at said New Brunswick, in said State of New Jersey, has adopted and used the trade-mark shown in the accompanying drawing, for a PROTECTIVE SURGICAL DRESSING IN THE FORM OF A BANDAGE, in Class 44, Dental, medical, and surgical appliances, and presents herewith five specimens showing the trade-mark as actually used by applicant upon the goods, and requests that the same be registered in the United States Patent Office in accordance with the act of February 20, 1905, as amended.

The trade-mark has been continuously

used and applied to said goods in applicant's business since November, 1920.

The trade-mark is applied or affixed to the goods, or to the packages containing the same, by placing thereon a printed label on which the trade-mark is shown.

The undersigned hereby appoints Archibald Cox, Esq., whose postal address is No. 233 Broadway, New York city, State of New York, its attorney, to prosecute this application for registration, with full powers of substitution and revocation, and to make alterations and amendments therein, to receive the certificate and to transact all business in the Patent Office connected therewith.

[I. s.] JOHNSON & JOHNSON,
By ROBT. C. NICHOLAS,
Secy.

Registered Jan. 13, 1925.

Trade-Mark

UNITED STATES PATENT OFFICE.

JOHNSON & JOHNSON, OF NEW BRUNSWICK, NEW JERSEY.

ACT OF FEBRUARY 20, 1905.

Application filed June 24, 1924. Serial No. 199,064.

BAND-AID

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The undersigned hereby appoints Archibald Cox, Esq., whose postal address is No. 253 Broadway, New York city, State of New York, its attorney, to prosecute this application for registration, with full powers of substitution and revocation, and to make alterations and amendments therein, to receive the certificate and to transact all business in the Patent Office connected therewith.

[i. s.] JOHNSON & JOHNSON.
By ROBT. C. NICHOLAS.

Secy.

REPUBLISHED IN O. G.

Int. Cl.: 5

Prior U.S. Cls.: 6, 18, 44, 46, 51, and 52

Reg. No. 2,373,302

United States Patent and Trademark Office

Registered Aug. 1, 2000

TRADEMARK
PRINCIPAL REGISTER



JOHNSON & JOHNSON (NEW JERSEY CORPORATION)
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 089337001

FOR: ADHESIVE BANDAGES, IN CLASS 5 (U.S. CLS. 6, 18, 44, 46, 51 AND 52).

FIRST USE 11-18-1998; IN COMMERCE 11-18-1998.

OWNER OF U.S. REG. NOS. 194,123, 568,161, AND 2,107,863.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BRAND ADHESIVE BANDAGES FLEXIBLE FABRIC FLEXIBLE PROTECTION" AND THE

DEPICTION OF ADHESIVE BANDAGES, APART FROM THE MARK AS SHOWN.

THE DRAWING IS LINED FOR THE COLORS RED, BLUE, BEIGE AND YELLOW. IN ADDITION, "BRAND ADHESIVE BANDAGES" AND "JOHNSON & JOHNSON" APPEAR IN THE COLOR RED.

THE DOTTED LINES SHOWN IN THE DRAWING ARE USED TO SHOW THE POSITION OF THE MARK ON THE PACKAGING FOR THE GOODS AND ARE NOT PART OF THE MARK.

SN 75-353,004, FILED 9-8-1997.

BRIAN RUPP, EXAMINING ATTORNEY

Int. Cls.: 3 and 5

Prior U.S. Cls.: 1, 4, 6, 18, 44, 46, 50, 51 and 52

United States Patent and Trademark Office

Reg. No. 2,471,737

Registered July 24, 2001

**TRADEMARK
PRINCIPAL REGISTER**

BAND-AID

**JOHNSON & JOHNSON (NEW JERSEY CORPORATION)
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 089337001**

FOR: NON-MEDICATED SOOTHING FOOT GEL PREPARATIONS, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).

FIRST USE 1-15-2000; IN COMMERCE 1-15-2000.

FOR: CALAMINE AND ANTI-ITCH PREPARATIONS; FIRST AID ANTIBIOTIC AND PAIN RELIEF

PREPARATIONS FOR WOUNDS; A FULL LINE OF FOOT CARE PRODUCTS, NAMELY, SELF-ADHERING CORN, CALLUS, BUNION AND BLISTER PADS, CUSHIONS, AND PATCHES, IN CLASS 5 (U.S. CLS. 6, 18, 44, 46, 51 AND 52).

FIRST USE 1-15-1998; IN COMMERCE 1-15-1998.

SER. NO. 76-109,649, FILED 8-16-2000.

PATRICK JENNINGS, EXAMINING ATTORNEY

United States of America

United States Patent and Trademark Office

BAND-AID

Reg. No. 3,998,862

Registered July 19, 2011

Int. Cl.: 5

TRADEMARK

PRINCIPAL REGISTER

JOHNSON & JOHNSON (NEW JERSEY CORPORATION)
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 089337001

FOR: WOUND DRESSINGS, NAMELY, ADHESIVE BANDAGES, IN CLASS 5 (U.S. CLS. 6, 18, 44, 46, 51 AND 52).

FIRST USE 12-31-2009; IN COMMERCE 12-31-2009.

OWNER OF U.S. REG. NOS. 194,123 AND 2,471,737.

THE COLOR(S) BEIGE, RED AND BLUE IS/ARE CLAIMED AS A FEATURE OF THE MARK.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BRAND ADHESIVE BANDAGES" AND THE DESIGN OF THE ADHESIVE BANDAGE, APART FROM THE MARK AS SHOWN.

THE MARK CONSISTS OF THE WORDS "BAND-AID" IN RED AND THE WORDS "BRAND ADHESIVE BANDAGES" IN BLUE APPEARING UNDERNEATH A BEIGE COLORED BANDAGE.

SN 77-856,994, FILED 10-26-2009.

AMY C. KEAN, EXAMINING ATTORNEY

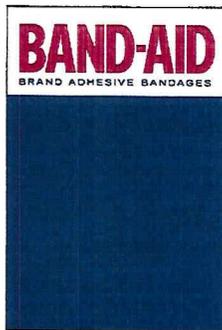


David J. Kappas

Director of the United States Patent and Trademark Office

United States of America

United States Patent and Trademark Office



Reg. No. 3,998,863

Registered July 19, 2011

Int. Cl.: 5

TRADEMARK

PRINCIPAL REGISTER

JOHNSON & JOHNSON (NEW JERSEY CORPORATION)
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 089337001

FOR: WOUND DRESSINGS, NAMELY, ADHESIVE BANDAGES, IN CLASS 5 (U.S. CLS. 6, 18, 44, 46, 51 AND 52).

FIRST USE 12-31-2009; IN COMMERCE 12-31-2009.

OWNER OF U.S. REG. NOS. 194,123 AND 2,471,737.

THE COLOR(S) RED, WHITE AND BLUE IS/ARE CLAIMED AS A FEATURE OF THE MARK.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BRAND ADHESIVE BANDAGES", APART FROM THE MARK AS SHOWN.

THE MARK CONSISTS OF A RECTANGLE WITH THE WORDS "BAND-AID" IN RED AND "BRAND ADHESIVE BANDAGES" IN BLUE ON A WHITE BACKGROUND ON THE TOP THIRD OF THE RECTANGLE WITH THE REST OF THE RECTANGLE IN BLUE.

SN 77-856,995, FILED 10-26-2009.

AMY C. KEAN, EXAMINING ATTORNEY



David J. Kappas

Director of the United States Patent and Trademark Office

United States of America

United States Patent and Trademark Office

BAND-AID



Reg. No. 3,998,861

Registered July 19, 2011

Int. Cl.: 5

TRADEMARK

PRINCIPAL REGISTER

JOHNSON & JOHNSON (NEW JERSEY CORPORATION)
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 089337001

FOR: WOUND DRESSINGS, NAMELY, ADHESIVE BANDAGES, IN CLASS 5 (U.S. CLS. 6, 18, 44, 46, 51 AND 52).

FIRST USE 2-15-2010; IN COMMERCE 2-15-2010.

OWNER OF U.S. REG. NOS. 194,123 AND 2,471,737.

THE COLOR(S) BEIGE, RED, AND BLUE IS/ARE CLAIMED AS A FEATURE OF THE MARK.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BRAND ADHESIVE BANDAGES" AND THE DESIGN OF THE ADHESIVE BANDAGE, APART FROM THE MARK AS SHOWN.

THE MARK CONSISTS OF THE WORDS "BAND-AID" IN RED AND "BRAND ADHESIVE BANDAGES" IN BLUE APPEARING UNDERNEATH A CLEAR BANDAGE WITH THE MIDDLE PORTION OF THE BANDAGE IN BEIGE.

SN 77-856,977, FILED 10-26-2009.

AMY C. KEAN, EXAMINING ATTORNEY



David J. Kappas

Director of the United States Patent and Trademark Office