ESTTA Tracking number: **ESTTA657626**

Filing date: **02/24/2015**

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	Henkel Corporation
Granted to Date of previous extension	02/25/2015
Address	One Henkel Way Rocky Hill, CT 06067 UNITED STATES

Correspondence information	Amy Span Wergeles Senior Trademark Counsel Henkel Corporation One Henkel Way Law Department - Trademarks Rocky Hill, CT 06067 UNITED STATES amy.wergeles@henkel.com, lizette.sayah@henkel.com Phone:8605712661

Applicant Information

Application No	79139923	Publication date	10/28/2014
Opposition Filing Date	02/24/2015	Opposition Period Ends	02/25/2015
International Registration No.	1185333	International Registration Date	09/26/2013
Applicant	Oil Mist Australia Pty Ltd 176 Carthage Street TAMWORTH NSW 2340, AUSTRALIA		

Goods/Services Affected by Opposition

Class 004. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: greases for the lubrication of cables; lubricating grease; cable lubricants; lubricants for use on wire ropes
Class 007. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: lubricating apparatus in the nature of lubrication machines for applying lubricant or grease to cables or ropes that are used in conjunction with cranes, hoists, winches or remotely operated vehicles

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2792571	Application Date	06/05/2002
Registration Date	12/09/2003	Foreign Priority Date	NONE
Word Mark	VIPERLUBE		
Design Mark	VIPERLUBE		
Description of Mark	NONE		
Goods/Services	Class 004. First use: First Use: 2002/11/25 First Use In Commerce: 2002/11/25 Industrial lubricants		

U.S. Registration No.	2792589	Application Date	06/11/2002
Registration Date	12/09/2003	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 004. First use: First Use: 2002/11/25 First Use In Commerce: 2002/11/25 Industrial lubricants		

Related Proceedings	Serial No. 79/139694

Attachments	76415278#TMSN.png(bytes) 76419281#TMSN.png(bytes) VIPERLUBE - VIPER (word).pdf(2729648 bytes)

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	//Amy Span Wergeles//
Name	Amy Span Wergeles
Date	02/24/2015

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

In the Matter of the United States Trademark Application:

Applicant: Oil Mist Australia Pty. Ltd.

Serial No.: 79/139923

Filed: September 26, 2013

Mark: VIPER

Henkel Corporation ,	:	
	:	
Opposer	:	
	:	Opposition No._____
v.	:	
	:	
Oil Mist Australia Pty. Ltd.,	:	
	:	
Applicant	:	:
	:	

United States Patent and Trademark Examiner
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

NOTICE OF OPPOSITION

Henkel Corporation, of One Henkel Way, Rocky Hill, CT ("Henkel"), believes that it will be damaged by registration of the mark shown in the above-referenced application, which was published in the Official Gazette of October 28, 2014, and hereby opposes issuance of the registration.

As grounds for opposition, Henkel alleges as follows:

1. Henkel has used the wordmark VIPERLUBE and its VIPER LOGO as shown here:

in commerce since 2002, in association with industrial lubricants ("Henkel's Goods").

2. Henkel has engaged in the manufacture, distribution, and sale of industrial lubricants in conjunction with the VIPERLUBE word mark and with the VIPER LOGO since at least as early as November 25, 2002, and both marks have been in continuous use by Henkel since that time.

3. Henkel is the owner of United States Trademark Registration No. 2792589, which issued on December 9, 2003 for the VIPER logo trademark for "industrial lubricants" in International Class 004. The mark was first used in commerce on November 25, 2002. Henkel is also the owner of United States Trademark Registration No. 2792571, also issued on December 9, 2003 for the VIPERLUBE mark for "industrial lubricants" in International Class 004. A copy of the TESS database record for each Registration, is attached hereto as Exhibit B.

4. These registrations are valid and incontestable.

5. Henkel has invested considerable effort and resources in advertising and promoting its VIPER LOGO and VIPERLUBE marks and the goods sold under the marks, with the result that the relevant purchasing public has come to know, rely upon, and recognize Henkel's goods by these marks. Henkel has established valuable goodwill in its VIPER LOGO and VIPERLUBE marks and the marks have become well known to the purchasing public.

6. Upon information and belief, Applicant is an Australian company with an address of 176 Carthage Street, Tamworth NSW 2340, Australia.

7. On September 26, 2013, Applicant filed application Serial No. 79/139923 for the wordmark VIPER under Section 66A for "greases for the lubrication of cables; lubricating grease; cable lubricants; lubricants for use on wire ropes" in International Class 004 and "lubricating apparatus in the nature of lubrication machines for applying lubricant or grease to cables or ropes that are used in conjunction with cranes, hoists, winches, or remotely operated vehicles" in International Class 007 ("Applicant's Goods").

8. Application Serial No. 79/139923 was published for opposition in the USPTO Official Gazette of October 28, 2014. Henkel obtained extensions of time to oppose this application to February 25, 2015.

9. There is no issue as to priority. Henkel has priority based on its use and registration of the VIPER LOGO and VIPERLUBE trademarks in the United States. Henkel used and registered the VIPER LOGO and VIPERLUBE trademarks long before the Applicant's application date.

10. Applicant's proposed VIPER mark is visually and phonetically very similar to Henkel's VIPER marks and creates a commercial impression which is very similar to Henkel's marks.

11. The lubricants, greases, and other International Class 4 goods identified in Applicant's application are virtually identical to the goods with which Henkel's VIPER marks are used and for which they are registered, and appear to be offered for sale to the same customers and through the same channels of trade. Henkel's lubricants are used on all

types of industrial machinery, including but not limited to, cables and wire ropes. Similarly, the lubricating machines and other International Class 7 goods identified in Applicant's application are likely to be offered for sale to the same customers as Henkel's industrial lubricants.

12. Applicant's proposed VIPER trademark so resembles Henkel's VIPER trademarks as to be likely, when applied to Applicant's Goods, to cause confusion or to cause mistake or to deceive within the meaning of 15 U.S.C. §1052(d), in view of Henkel's prior use, ownership, and registration of its trademark. See Exhibit A.
13. Registration of Applicant's proposed mark on the Principal Register would be inconsistent with Henkel's rights under the aforementioned registrations, and its common law rights, and would be damaging to Henkel.
14. Registration should therefore be refused under 15 U.S.C. §1052(d).

WHEREFORE, Henkel prays that its opposition be sustained and that the registration sought by Applicant be refused.

Respectfully submitted,

By: _____

Amy Span Wergeles
Attorney for Henkel Corporation

Dated: 2/24/15

EXHIBIT A

Henkel's marks:

VIPERLUBE (RN 2792571)

and

(RN 2792589)

Goods: Industrial lubricants in IC 4

Applicant's marks:

VIPER (SN 79/139923)

and

(SN 79/139694)

Goods: IC 4 - Greases for the lubrication of cables; cable lubricants; lubricants for use on wire ropes

IC 7 - Lubricating apparatus in the nature of lubrication machines for applying lubricant or grease to cables or ropes that are used in conjunction with cranes, hoists, winches or remotely operated vehicles

EXHIBIT B

United States Patent and Trademark Office

Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Fri Feb 20 03:20:58 EST 2015

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TSDR | ASSIGN Status | TTAB Status *(Use the "Back" button of the Internet Browser to return to TESS)*

VIPERLUBE

Word Mark	VIPERLUBE
Goods and Services	IC 004. US 001 006 015. G & S: Industrial lubricants. FIRST USE: 20021125. FIRST USE IN COMMERCE: 20021125
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	76415278
Filing Date	June 5, 2002
Current Basis	1A
Original Filing Basis	1B
Published for Opposition	December 3, 2002
Registration Number	**2792571**
Registration Date	December 9, 2003
Owner	(REGISTRANT) Henkel Loctite Corporation CORPORATION DELAWARE One Henkel Way Henkel Corporation Rocky Hill CONNECTICUT 06067 (LAST LISTED OWNER) HENKEL CORPORATION CORPORATION DELAWARE One Henkel Way Rocky Hill CONNECTICUT 06067
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	Amy Span Wergeles

Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20130716.
Renewal	1ST RENEWAL 20130716
Live/Dead Indicator	LIVE

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NEXT LIST | FIRST DOC | PREV DOC | NEXT DOC | LAST DOC

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United States Patent and Trademark Office

Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Fri Feb 20 03:20:58 EST 2015

Logout Please logout when you are done to release system resources allocated for you.

Start List At: OR Jump to record: **Record 1 out of 2**

TSDR [illegible] [illegible] *(Use the "Back" button of the Internet Browser to return to TESS)*

Goods and Services	IC 004. US 001 006 015. G & S: Industrial lubricants. FIRST USE: 20021125. FIRST USE IN COMMERCE: 20021125
Mark Drawing Code	(2) DESIGN ONLY
Design Search Code	03.21.02 - Snakes 03.21.24 - Stylized reptiles, frogs and snails
Serial Number	76419281
Filing Date	June 11, 2002
Current Basis	1A
Original Filing Basis	1B
Published for Opposition	December 3, 2002
Registration Number	**2792589**
Registration Date	December 9, 2003
Owner	(REGISTRANT) Henkel Loctite Corporation CORPORATION DELAWARE One Henkel Way Henkel Corporation Rocky Hill CONNECTICUT 06067 (LAST LISTED OWNER) HENKEL CORPORATION CORPORATION DELAWARE One Henkel Way Rocky Hill CONNECTICUT 06067
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	Amy Span Wergeles

Description of Mark	Color is not claimed as a feature of the mark.
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20130716.
Renewal	1ST RENEWAL 20130716
Live/Dead Indicator	LIVE

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing Notice of Opposition was served on:

Michael A. Bondi
Dicke, Billig & Czaja, PLLC
100 S. 5th St.
Suite 2250
Minneapolis, Minnesota

by first class mail, postage prepaid, this 24th day of February, 2015.

Barbara Kevassen