

ESTTA Tracking number: **ESTTA706915**

Filing date: **11/05/2015**

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	Dr. Richard G. Asarch
Granted to Date of previous extension	11/07/2015
Address	3701 S. Clarkson Street, Fourth Floor Englewood, CO 80113-3958 UNITED STATES

Attorney information	Daniel R. Johnson Waskowski Johnson Yohalem LLP 954 W. Washington Blvd., Suite 720 Chicago, IL 60607 UNITED STATES djohnson@wjylegal.com Phone:312-278-3153
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Applicant Information

Application No	86312163	Publication date	09/08/2015
Opposition Filing Date	11/05/2015	Opposition Period Ends	11/07/2015
Applicant	Conopco, Inc. 700 Sylvan Avenue Englewood Cliffs, NJ 07632 UNITED STATES		

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: Soap; medicated soap; cleaning preparations; perfumery; essential oils; deodorants and antiperspirants; hair care preparations; hair shampoos and hair conditioners; hair colourants; hair styling gel; non-medicated toilet preparations; non-medicated preparations for the bath and shower; non-medicated skin care preparations; oils, creams and lotions for the skin; shaving preparations; pre-shave and aftershave preparations; cologne; depilatory preparations; sun-tanning preparations and sun protection preparations, namely, sun-tanning oils, ointments, lotions and creams, sunscreen, sunblock and after-sun lotion, cosmetic skin care preparations for protection from the effects of the sun; cosmetics; make-up and make-up removing preparations; petroleum jelly for cosmetic purposes; non-medicated lip care preparations; talcum powder; cotton wool for cosmetic purposes; cotton sticks for cosmetic purposes; tissues, pads or wipes impregnated or pre-moistened with personal cleansing or cosmetic lotions; beauty masks, facial packs, namely, facial masks</p>

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Confusion under Trademark Act section 43(a)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	2846200	Application Date	02/03/2003
Registration Date	05/25/2004	Foreign Priority Date	NONE
Word Mark	DERMASPA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 2003/07/21 First Use In Commerce: 2003/07/21 Cosmetics and non-medicated skin care preparations		

Attachments	76486742#TMSN.png(bytes) Notice of Opposition.pdf(238550 bytes) Exhibits A to C.pdf(1620145 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	/Daniel R. Johnson/
Name	Daniel R. Johnson
Date	11/05/2015

UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

In the matter of trademark application Serial No. 86312163
For the mark “DERMASERIES SPA”
Published in the Official Gazette on September 8, 2015

Dr. Richard G. Asarch

Opposer,

v.

Conopco, Inc.

Applicant.

OPPOSITION NO. _____

NOTICE OF OPPOSITION

Opposer, Dr. Richard G. Asarch (“Opposer”), believes that he will be damaged by registration of the mark DERMASERIES SPA in Class 3 as shown in the Application Serial No. 86312163 (“Application”), filed by Conopco, Inc. (“Applicant”). Opposer hereby opposes the Application under the provisions of Sections 2(d), 13, and 43(a) of the Trademark Act of July 5, 1946 (the “Lanham Act”), 15 U.S.C. §§ 1052(d), 1063, and 1125(a).

As grounds for opposition, Opposer, through his undersigned counsel, alleges as follows:

1. Dr. Asarch is the owner of all right, title and interest in and to the DERMASPA trademark, Registration No. 2846200, for “[c]osmetics and non-medicated skin care preparations” (“the DERMASPA trademark”), issued by the United States Patent and Trademark Office.

2. The DERMASPA trademark is incontestable pursuant to the provisions of Section 15 of the Lanham Act, 15 U.S.C. § 1065, and accordingly constitutes conclusive evidence of the validity of the registered mark and the registration therefor, of Opposer’s ownership of the registered mark, and of Opposer’s exclusive right to use the mark covered by the registration in commerce in connection with the goods specified in the registration.

3. For more than twelve years, Dr. Asarch has used the DERMASPA trademark in nationwide, distribution, sale, and promotion of cosmetics and non-medicated skin care preparations.

4. Opposer's DERMASPA trademark symbolizes the extensive goodwill and consumer recognition that Opposer has established through the devotion of substantial time, effort, costs, and other resources to the development, advertising, and promotion of the goods sold and services rendered under the DERMASPA trademark.

5. Through the extensive and continuous use and promotion of the DERMASPA trademark, Opposer has established a public perception of the distinctive DERMASPA trademark as an indication of source of only Opposer's goods.

6. As a result of the regular, extensive, and well-published use of the DERMASPA trademark, the DERMASPA trademark is widely recognized as associated exclusively with Opposer and his high quality products.

7. Accordingly, the public will perceive that any mark similar to DERMASPA, particularly when used in connection with cosmetics and non-medicated skin care preparations, is another of Opposer's products, and will believe that any such products emanate from or are otherwise associated with Opposer and his products sold under the DERMASPA trademark.

8. On June 17, 2014, Conopco filed a trademark application, Serial Number 86312163 ("the Application"), to register the standard character mark "DERMASERIES SPA" for "[s]oap; medicated soap; cleaning preparations; perfumery; essential oils; deodorants and antiperspirants; hair care preparations; hair shampoos and hair conditioners; hair colourants; hair styling gel; non-medicated toilet preparations; non-medicated preparations for the bath and shower; non-medicated skin care preparations; oils, creams and lotions for the skin; shaving preparations; pre-shave and

aftershave preparations; cologne; depilatory preparations; sun-tanning preparations and sun protection preparations, namely, sun-tanning oils, ointments, lotions and creams, sunscreen, sunblock and after-sun lotion, skin care preparations for protection from the effects of the sun; cosmetics; make-up and make-up removing preparations; petroleum jelly for cosmetic purposes; non-medicated lip care preparations; talcum powder; cotton wool for cosmetic purposes; cotton sticks for cosmetic purposes; tissues, pads or wipes impregnated or pre-moistened with personal cleansing or cosmetic lotions; beauty masks, facial packs, namely, facial masks” in International Class 3 pursuant to an intent-to-use application under Section 1(b) of the Lanham Act, 15 U.S.C. § 1051(b).

9. On August 22, 2014, Applicant’s Application was refused registration in an Office Action from the USPTO on the grounds that, *inter alia*, Applicant’s DERMASERIES SPA mark was confusingly similar with Opposer’s DERMASPA trademark.

10. On February 23, 2015, Applicant responded to the August 22, 2014 Office Action claiming that DERMASPA was weak, citing third-party use of the terms DERMA and SPA.

11. None of the citations to other registered marks in Applicant’s response addressed the entire term DERMASPA or any combination of “derma” and “spa.” Moreover, none of the uses of DERMASPA as a complete term provided in Applicant’s Response included products sold under the mark, but instead concern services. Accordingly, it was improper and clear error on the part of the Examining Attorney to consider such arguments in making a determination as to whether or not to maintain the likelihood of confusion refusal based upon Opposer’s Reg. No. 2846200, to the extent it did so.

12. Further, Applicant or its affiliates have filed applications to register DERMASPA as a trademark in other countries, like the United Kingdom, France, Australia, and Canada.

13. In its February 23, 2015 response, Applicant also modified its description for the DERMASERIES trademark to read: “Soap; medicated soap; cleaning preparations; perfumery; essential oils; deodorants and antiperspirants; hair care preparations; hair shampoos and hair conditioners; hair colourants; hair styling gel; non-medicated toilet preparations; non-medicated preparations for the bath and shower; non-medicated skin care preparations; oils, creams and lotions for the skin; shaving preparations; pre-shave and aftershave preparations; cologne; depilatory preparations; sun-tanning preparations and sun protection preparations, namely, sun-tanning oils, ointments, lotions and creams, sunscreen, sunblock and after-sun lotion, cosmetic skin care preparations for protection from the effects of the sun; cosmetics; make-up and make-up removing preparations; petroleum jelly for cosmetic purposes; non-medicated lip care preparations; talcum powder; cotton wool for cosmetic purposes; cotton sticks for cosmetic purposes; tissues, pads or wipes impregnated or pre-moistened with personal cleansing or cosmetic lotions; beauty masks, facial packs, namely, facial masks.”

14. Notwithstanding the irrelevant nature of Applicant’s purported evidence of weakness of the DERMASPA trademark, the Examining Attorney withdrew the refusal based upon Section 2(d) of the Lanham Act, and Opposer’s Reg. Nos. 2846200.

15. The mark DERMASERIES SPA was published for opposition in the Official Gazette on September 8, 2015. Opposer filed a Request for an Extension of Time, and then timely filed this Notice of Opposition.

16. Applicant has not filed an Amendment to Allege Use under Section 1(c) of the Lanham Act, 15 U.S.C. § 1051(c).

17. Opposer acquired the exclusive right to the DERMASPA trademark that substantially predates any rights upon which Applicant may rely.

18. Opposer's right to the DERMASPA trademark is superior to that of Applicant.

19. The DERMA and SPA portions of Applicant's DERMASERIES SPA designation are identical to Opposer's DERMASPA trademarks.

20. Applicant's designation DERMASERIES SPA, particularly because it is used in connection with goods which include "cosmetics" and "non-medicated skin care preparations" including "sun protection preparations, ... after-sun lotion, skin care preparations for protection from the effects of the sun; ... make-up removing preparations; ... non-medicated lip care preparations; ... pads or wipes impregnated or pre-moistened with personal cleansing or cosmetic lotions; beauty masks," will evoke the "cosmetics" and "non-medicated skin care preparations" sold under Opposer's DERMASPA trademark.

21. Indeed, the two terms are so similar that, in other countries wherein Applicant has filed applications to register "Dermaspa" as a trademark, its description of the goods associated with the trademark almost exactly matches its description of the goods associated with the DERMASERIES SPA trademark in its application here.

22. In the United Kingdom, Applicant or its affiliates own the trademark for "Dermaspa" with registration number UK00003127200, which is described as: "Soap; medicated soap; cleaning preparations; perfumery; essential oils; deodorants and antiperspirants; hair care preparations; shampoos and conditioners; hair colourants; hair styling products; non-medicated toilet preparations; bath and shower preparations; skin care preparations; oils, creams and lotions for the skin; shaving preparations; pre-shave and aftershave preparations; cologne; depilatory preparations; sun-tanning and sun protection preparations; cosmetics; make-up and make-up removing preparations; petroleum jelly; lip care preparations; talcum powder; cotton wool for

cosmetic purposes; cotton sticks for cosmetic purposes; tissues, pads or wipes impregnated or pre-moistened with personal cleansing or cosmetic lotions; beauty masks, facial packs” in Class 3.¹

23. In Canada, Applicant or its affiliates applied for a trademark for “Dermaspa” with Application Number 1730674, described as “soap; medicated soap; cleaning preparations; perfumery; essential oils; deodorants and antiperspirants; hair care preparations; shampoos and conditioners; hair colourants; hair styling products; non-medicated toilet preparations; bath and shower preparations; skin care preparations; oils, creams and lotions for the skin; shaving preparations; pre-shave and aftershave preparations; cologne; depilatory preparations; sun-tanning and sun protection preparations; cosmetics; make-up and make-up removing preparations; petroleum jelly; lip care preparations; talcum powder; cotton wool for cosmetic purposes; cotton sticks for cosmetic purposes; tissues, pads or wipes impregnated or pre-moistened with personal cleansing or cosmetic lotions; beauty masks, facial packs” in Class 3.²

24. In Australia, Applicant or its affiliates applied for a trademark for “Dermaspa” with Registration Number 1668853, described as “Soap; medicated soap; cleaning preparations; perfumery; essential oils; deodorants and antiperspirants; hair care preparations; shampoos and conditioners; hair colourants; hair styling products; non-medicated toilet preparations; bath and shower preparations; skin care preparations; oils, creams and lotions for the skin; shaving preparations; pre-shave and aftershave preparations; cologne; depilatory preparations; sun-tanning and sun protection preparations; cosmetics; make-up and make-up removing preparations; petroleum jelly; lip care preparations; talcum powder; cotton wool for cosmetic purposes; cotton

¹ See Case Details for DermaSpa trade mark in the United Kingdom, Intellectual Property Office, attached as Exhibit C.

² See Canadian Trade-Mark Data from Canadian Intellectual Property Office, attached as Exhibit B.

sticks for cosmetic purposes; tissues, pads or wipes impregnated or pre-moistened with personal cleansing or cosmetic lotions; beauty masks, facial packs” in Class 3.³

25. These filings in the United Kingdom, Canada, and Australia and their substantial – if not identical – similarity with Applicant’s description in its DERMASERIES SPA application here, illustrate that Applicant intends to use the terms “Dermaspa” and DERMASERIES SPA to identify the same types of goods and seeks to draw a connection between the terms “Dermaspa” and DERMASERIES SPA.

26. Opposer believes that he will be damaged by registration of Applicant’s DERMASERIES SPA designation under Section 13 of the Lanham Act, 15 U.S.C. § 1063, because consumers familiar with Opposer’s DERMASPA trademark are likely to mistakenly believe that Applicant and or its products emanate from, are sponsored or authorized by and/or are otherwise associated or affiliated with Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. 1052(d).

27. Opposer believes that he will be damaged by registration of the DERMASERIES SPA designation under Section 13 of the Lanham Act, 15, U.S.C. § 1063, because the use and registration of the DERMASERIES SPA designation is likely to cause confusion or to cause mistake with products sold under Opposer’s DERMASPA trademark in violation of Section 43(a) of the Lanham Act, 15 U.S.C. §1125.

WHEREFORE, Opposer Dr. Richard G. Asarch requests that Conopco’s application to register the trademark “DERMASERIES SPA,” Serial No. 86312163 be refused.

³ See Australian Trademark Details, attached as Exhibit C.

Dated: November 5, 2015

Dr. Richard G. Asarch

By: /Daniel R. Johnson/
One of His Attorneys

Daniel R. Johnson
Adam Waskowski
Seth Yohalem
WASKOWSKI JOHNSON YOHALEM LLP
954 W. Washington Blvd., Suite 720
Chicago, Illinois 60607
(312) 278-3153
djohnson@wjylegal.com

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Notice of Opposition has been served on Conopco, Inc. by mailing said copy on November 5, 2015, via First Class Mail, postage prepaid to:

LISA W. ROSAYA
BAKER & MCKENZIE LLP
452 5TH AVE
NEW YORK, NY 10018-2706

/Daniel R. Johnson/

Exhibit A



Intellectual Property Office

Case details for trade mark UK00003127200

Trade mark

The image shows the trade mark 'Dove DermaSpa'. 'Dove' is written in a blue, cursive-style font, and 'DermaSpa' is written in a blue, sans-serif font to its right.

Status: Examination

Relevant dates

Filing date: 22 January 2014

Converted trade mark details

Converted trade mark details

Indicates an application converted from a Community Trade Mark to a UK national Trade Mark.

Conversion number: 012582862

Filing date: 22 January 2014

List of goods

Class 3: Soap; medicated soap; cleaning preparations; perfumery; essential oils; deodorants and

antiperspirants; hair care preparations; shampoos and conditioners; hair colourants; hair styling products; non-medicated toilet preparations; bath and shower preparations; skin care preparations; oils, creams and lotions for the skin; shaving preparations; pre-shave and aftershave preparations; cologne; depilatory preparations; sun-tanning and sun protection preparations; cosmetics; make-up and make-up removing preparations; petroleum jelly; lip care preparations; talcum powder; cotton wool for cosmetic purposes; cotton sticks for cosmetic purposes; tissues, pads or wipes impregnated or pre-moistened with personal cleansing or cosmetic lotions; beauty masks, facial packs.

Name and Address details

Owner(s) name: Unilever N.V.
Weena 455, Rotterdam 3013 AL,
Netherlands, Netherlands

Country of Incorporation: Netherlands

[View owner's other trade marks](#)

IPO representative name: Baker & McKenzie LLP
100 New Bridge Street, London,
United Kingdom, EC4V 6JA

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Intellectual Property Office is an operating name of the Patent Office

Exhibit B



Canadian Intellectual
Property Office
An Agency of
Industry Canada

Office de la propriété
intellectuelle du Canada
Un organisme
d'Industrie Canada



Canadian Intellectual Property Office

Canadian trade-mark data

Third-Party Information Liability Disclaimer

[Back to search](#)

The database was last updated on:2015-11-03

APPLICATION NUMBER:

1730674

STATUS:

FILED:

FORMALIZED:

REGISTRATION NUMBER:

not registered

FORMALIZED

2015-06-01

2015-06-04

APPLICANT:

Unilever Canada Inc.
160 Bloor Street East, Suite 1400
Toronto
M4W 3R2
ONTARIO

AGENT:

BAKER & MCKENZIE LLP
BROOKFIELD PLACE
181 BAY STREET, SUITE 2100
P.O. BOX 874
TORONTO
ONTARIO M5J 2T3

REPRESENTATIVE FOR SERVICE:

BAKER & MCKENZIE LLP
BROOKFIELD PLACE
181 BAY STREET, SUITE 2100
P.O. BOX 874
TORONTO
ONTARIO M5J 2T3

TRADE-MARK (Word):

DERMASPA

INDEX HEADINGS:

DERMASPA

DERMA SPA

GOODS:

(1) soap; medicated soap; cleaning preparations; perfumery; essential oils; deodorants and antiperspirants; hair care preparations; shampoos and conditioners; hair colourants; hair styling products; non-medicated toilet preparations; bath and shower preparations; skin care preparations; oils, creams and lotions for the skin; shaving preparations; pre-shave and aftershave preparations; cologne; depilatory preparations; sun-tanning and sun protection preparations; cosmetics; make-up and make-up removing preparations; petroleum jelly; lip care preparations; talcum powder; cotton wool for cosmetic purposes; cotton sticks for cosmetic purposes; tissues, pads or wipes impregnated or pre-moistened with personal cleansing or cosmetic lotions; beauty masks, facial packs

CLASSIFICATION DATA:

The Classification data is provided for information and searching purposes only. CIPO does not warrant the accuracy of the classes assigned to the trademark. This data has no legal value of any kind.

3 - Bleaching, cleaning preparations and cosmetics

CLAIMS:

Proposed Use in CANADA.

Action Information

<u>ACTION</u>	DATE	BF	COMMENTS
Filed	2015-06-01		
Created	2015-06-02		
Formalized	2015-06-04		

Last updated: 2015-11-03

Exhibit C

Trade Mark Details

Trade Mark : 1668853

Word: DERMASPA
Image:
Lodgement Date: 13-JAN-2015
Registered From: 13-JAN-2015
Date of Acceptance: 09-APR-2015
Acceptance Advertised: 04-JUN-2015
Registration Advertised: 20-AUG-2015
Entered on Register: 12-AUG-2015
Renewal Due: 13-JAN-2025
Class/es: 3
Status: Registered/Protected
Kind: n/a
Type of Mark: Word

Owner/s: **Unilever Plc**
 Port Sunlight Wirral
 Merseyside
 England CH62 4ZD
 UNITED KINGDOM

Address for Service: Baker & McKenzie
 27th Floor
 AMP Centre
 50 Bridge Street
 SYDNEY NSW 2000
 AUSTRALIA

Goods & Services

Class 3: Soap; medicated soap; cleaning preparations; perfumery; essential oils; deodorants and antiperspirants; hair care preparations; shampoos and conditioners; hair colourants; hair styling products; non-medicated toilet preparations; bath and shower preparations; skin care preparations; oils, creams and lotions for the skin; shaving preparations; pre-shave and aftershave preparations; cologne; depilatory preparations; sun-tanning and sun protection preparations; cosmetics; make-up and make-up removing preparations; petroleum jelly; lip care preparations; talcum powder; cotton wool for cosmetic purposes; cotton sticks for cosmetic purposes; tissues, pads or wipes impregnated or pre-moistened with personal cleansing or cosmetic lotions; beauty masks, facial packs

Indexing Details - Word Constituents

DERMASPA

Indexing Details - Image Constituents