

ESTTA Tracking number: **ESTTA729811**

Filing date: **02/26/2016**

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	Essilor International (Compagnie Generale d'Optique)
Granted to Date of previous extension	03/02/2016
Address	147 rue de Paris Charenton Le Pont, 94220 FRANCE

Domestic Representative	Kay Lyn Schwartz Attorney Gardere Wynne Sewell LLP 1601 Elm Street, Suite 3000 Dallas, TX 75201 UNITED STATES ip@gardere.com, kschwartz@gardere.com, jfulmer@gardere.com Phone:2149994702
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Applicant Information

Application No	86663294	Publication date	11/03/2015
Opposition Filing Date	02/26/2016	Opposition Period Ends	03/02/2016
Applicant	Werbner, Jerry 2760 NW Birkendene St Portland, OR 97229 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Cases for eyeglasses and sunglasses; Children's eye glasses; Corrective glasses; Eye glasses; Eyeglass chains and cords; Eyeglass frames; Eyeglass lenses; Eyeglasses; Eyewear, namely, sunglasses, eyeglasses and ophthalmic frames and cases therefor; Eyewear, namely, Reading Glasses, Sunglasses, Computer Glasses, Lenses and similar goods; Frames for spectacles and sunglasses; Lenses for sunglasses; Magnifying glasses that fit on the user's face in the manner of eyeglasses; Magnifying lenses; Optical frames; Optical glasses; Optical lenses; Protective eyewear and component parts thereof; Reading glasses; Spectacle frames made of metal or a combination of metal and plastics; Spectacle lenses; Spectacles and sunglasses; Sunglass lenses; Sunglasses

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.	970710	Application Date	06/12/1972
Registration Date	10/16/1973	Foreign Priority Date	NONE
Word Mark	ESSILOR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U026 (International Class 001, 009, 010). First use: First Use: 0 First Use In Commerce: 0 OPHTHALMIC LENSES AND FRAMES, PROTECTIVEGLASSES AND LENSES THEREFOR; MATERIALS AND DEVICES USED BY OPTOMETRISTS AND OPTHAMOLOGISTS FOR THE EXAMINATION AND CORRECTION OF VISION-NAMELY, FOCOMETERS, PUPILMETERS AND KERATOMETERS, AND SKIASCOPIES, READING SCALES, [RANGE AND DISTANCE FINDERS, TACHOMETERS, THEODOLITES, LEVELS, SURVEYOR POLES AND SEXTANTS, BAROMETERS, THERMOMETERS, COMPASSES] AND MAGNIFYING GLASSES		

U.S. Registration No.	1756467	Application Date	06/29/1992
Registration Date	03/09/1993	Foreign Priority Date	NONE
Word Mark	ESSILOR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 007. First use: First Use: 1972/00/00 First Use In Commerce: 1972/00/00 machines for manufacturing corrective lenses for eyeglasses		

U.S. Registration No.	4890842	Application Date	09/29/2014
Registration Date	01/26/2016	Foreign Priority Date	03/31/2014
Word Mark	ESSILOR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 0 First Use In Commerce: 0 Optical, facial and/or ophthalmic measurement apparatus, namely, near vision measurement instruments, lens engraving detectors, lensmeters, cornea topographersfor non-medical use, keratometers for non-medical use, apparatus for determining lens diameter, apparatus for lens fitting measurements, apparatus for testing the performances of lenses, automatic refractors, manual refractors; software for measuring and displaying ophthalmic, optical and/or facial parameters; software recorded on physical media for acquisition, measurement, processing and storage of data in relation to lenses and/or wearer parameters, software for tracing spectacle frames rims, spectacles lenses, ophthalmic tenses and lens patterns, software for engraving, cutting, edging and remote edging of spectacles and ophthalmic lenses, software for quality control of spectacle		

	<p>lenses and ophthalmic lenses, software for placing orders for spectacle lenses and ophthalmic lenses, software for measuring and displaying ophthalmic, optical and facial parameters, software for manufacturing, grinding, machining and processing lenses and ophthalmic lenses; software for the management of shops for ophthalmic optics professionals, sales assistance software for ophthalmic optics professionals for facilitating purchasing transactions; software platforms dedicated to opticians and other professionals in the field of ophthalmic optics for sharing, exchanging and storing data and information related to ophthalmic optics; pupillometers for measuring pupillary distance and eye position in the spectacle frame by digital capture of corneal reflections and for measuring lens/eye distance not for medical use; corneal reflection pupillometers for measuring pupillary distance and eye position in the spectacle frame by digital capture of corneal reflections and for measuring lens/eye distance not for medical use; frontofocometers; apparatus and instruments not for medical use for carrying out reading and visual faculty tests, namely, pupillometers, refractors, lensmeters, frontofocometers, topographers, keratometers; structural parts and structural fittings for all the aforesaid goods, namely, head rests, chin rests and nose rests; structural parts for eye testing machines not for medical use, namely, separators and removable covers for eyesight testing; structural parts for eye testing machines not for medical use, namely, power correcting lenses and color filters for eyesight tests; spectacles; sunglasses; goggles for sports; spectacle frames; ophthalmic lenses; spectacle lenses, including organic plastic lenses, mineral lenses, corrective lenses, progressive lenses, sunglass lenses, polarized lenses, filtering lenses, tinted lenses, colored lenses, light-sensitive lenses, photochromic lenses, treated lenses, coated lenses, anti-reflective lenses, semi-finished lenses; contact lenses; cases for spectacle lenses; cases for ophthalmic lenses; spectacle cases; cords and chains for spectacles; blank magnetic recording discs, blank sound recording optical discs, blank recordable CD-Rs, blank recordable DVDs and other blank digital recording media, namely, blank flash memory cards and blank hard disk drives; downloadable electronic publications in the nature of magazines, newsletters, catalogs, brochures, manuals, and booklets in the field of optics and ophthalmic optics; downloadable electronic information guides and documents in the nature of reports, all in the field of optics and ophthalmic optics; quality certificates for ophthalmic lenses, origin control certificates for ophthalmic lenses, analysis reports and certification documents in the nature of reports, booklets, leaflets, information sheets, newsletters and manuals in relation to the manufacture and processing of ophthalmic lenses, and information booklets relating to certification, standardization and normalization concerning the manufacture and processing of ophthalmic lenses, all of the aforementioned products being in downloadable electronic form</p>
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U.S. Registration No.	3876464	Application Date	03/25/2009
Registration Date	11/16/2010	Foreign Priority Date	10/01/2008
Word Mark	E ESSILOR		
Design Mark			
Description of Mark	The mark consists of a blue rectangle with a white oval cut out in the center with a smaller blue oval with a white letter "E" in the center below which is the grey wording ESSILOR.		
Goods/Services	<p>Class 005. First use: First Use: 0 First Use In Commerce: 0 disinfectant solutions for contact lenses and glasses, products for maintaining contact lenses and glasses, namely, cleaners, disinfectants, products for cleaning contact lenses and glasses, namely, cleaners, disinfectants, wetting solutions, contact lenses solutions</p> <p>Class 007. First use: First Use: 0 First Use In Commerce: 0 machine tools, namely, grinding machines for ophthalmic lenses, polishing ma-</p>		

chines for ophthalmic lenses; machines for working, processing, cutting, drilling, grinding, trimming, grooving, bevelling, counter-bevelling, chamfering, finishing, lapping, polishing, adjusting and cleaning spectacle glasses and ophthalmic lenses; grinders for spectacle glasses and ophthalmic lenses; parts and components of all the aforesaid products

Class 009. First use: First Use: 0 First Use In Commerce: 0

measuring apparatus and instruments, namely, focimeter, ocular lens meter and optical apparatus and instruments, namely, centering device; spectacles; spectacle frames; non-implacable ophthalmic lenses; spectacle glasses and spectacle glasses in the nature of organic glasses, mineral glasses, correcting glasses, unifocal glasses, progressive glasses, solar glasses, polarizing glasses, tinted glasses, coloured glasses, photosensitive glasses, photochromic glasses, treated glasses, coated glasses, anti-reflective glasses, semi-finished glasses, blanks and rough shapes for spectacle glasses; semi-finished blanks for spectacle glasses, protective glasses and spectacles; contact lenses; cases for all the aforesaid products; software for operating and controlling measuring and optical apparatus and instruments; software for remote grinding of spectacle glasses and ophthalmic lenses; software for managing laboratories for manufacturing, machining and treating ophthalmic lenses and spectacle glasses; software for remote control of products and services in ophthalmic optics and for assistance with sales; software for use by ophthalmic opticians, namely, store management software, software for online ordering of goods and services in the ophthalmic optical field, software for the production, machining and treatment of ophthalmic lenses and spectacles lenses; software that provides access to opticians' sites on telecommunications or computer networks; laboratory and scientific research equipment all for scientific and research use by opticians and ophthalmologists, namely, pupilometers, refractors, autorefractors, optometers, keratometers, ophthalmometers, skiascopes and reading scales

Class 035. First use: First Use: 0 First Use In Commerce: 0

Providing online electronic catalogues and price lists of ophthalmic optical products and spectacles and opticians' services; publication and dissemination of publicity materials in the nature of promotional and advertising matter relating to the aforesaid products and services; customer loyalty development services and customer club services for commercial, promotional and/or publicity purposes

Class 038. First use: First Use: 0 First Use In Commerce: 0

information transmission of data by electronic communications networks; transmission of information from databases via electronic communication networks; rental of access time to global computer networks featuring databases relating to optical, ophthalmological and spectacle manufacturers' products and opticians' services intended for opticians' shops, optical stores, optical laboratories and workshops and for opticians' and ophthalmic opticians' sites on telecommunications or computer networks

Class 040. First use: First Use: 0 First Use In Commerce: 0

treatment of spectacle glasses and ophthalmic lenses in the nature of imparting resistance to scratching, impact, glare, ultraviolet rays, dirt dust, rain and in the nature of hydrophobic and oleophobic treatments; services of providing spectacle glasses and ophthalmic lenses with coatings for imparting hydrophobic and oleophobic properties, of application of overcoatings and temporary adherence coatings, of deposition of thin surface layers using dipping, and of application or deposition of treatment coatings, composite varnishes, glazes, over coatings having one or more of the following properties: resistance to scratching, impact, glare, ultraviolet rays, dirt dust, rain; removal of previously-applied surface treatments from eyeglasses and lenses

Class 042. First use: First Use: 0 First Use In Commerce: 0

Design, maintenance, lending, rental and installation of computer software and databases relating to ophthalmic optical products and spectacles and opticians'

	services intended for opticians' shops, optical stores, and optical laboratories and workshops Class 044. First use: First Use: 0 First Use In Commerce: 0 Opticians' services; information and consultancy relating to visual correction and comfort
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U.S. Registration No.	2079702	Application Date	02/16/1995
Registration Date	07/15/1997	Foreign Priority Date	NONE
Word Mark	ESSILOR NATURAL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1995/09/30 First Use In Commerce: 1995/09/30 ophthalmic lenses, namely, eyeglass lenses		

U.S. Registration No.	3781481	Application Date	05/20/2009
Registration Date	04/27/2010	Foreign Priority Date	NONE
Word Mark	ESSILOR IDEAL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2009/08/04 First Use In Commerce: 2009/08/04 Optical lenses		

Attachments	Essilor EI Notice of Opposition against VISILOR.pdf(360148 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	/Kay Lyn Schwartz/
Name	Kay Lyn Schwartrz
Date	02/26/2016

1. Commencing prior to Applicant’s filing date, and continuing without interruption to the present time, Essilor (itself, or through its related companies and/or licensees) continuously has used, and continues to use, the trademark “ESSILOR”, as well as many other “ESSILOR”-derivative marks including “ESSILOR NATURAL”, “E ESSILOR” (with design), and “ESSILOR IDEAL” among others, alone, and in combination with other terms and design elements, in connection with various optical and ophthalmic related goods/services (collectively, the “*ESSILOR Marks*”).

2. Essilor’s ESSILOR Marks have been so extensively used and advertised by Essilor in the United States the marks have come to indicate to the relevant trade and consumers, goods and services having their source of origin in, or connected with, Essilor.

3. Essilor is the owner of, and will rely upon herein, its common law rights and usage of the ESSILOR Marks throughout the United States.

4. In addition, Essilor is the owner of, and will rely upon herein, the following federally registered marks:

Trademark	App. No. (App. Date)	Reg. No. (Reg. Date)	Goods/Services
ESSILOR	72/426930 (Jun. 12, 1972)	970710 (Oct. 16, 1973)	Ophthalmic lenses and frames, protective glasses and lenses therefor; materials and devices used by optometrists and ophthalmologists for the examination and correction of vision—namely, focometers, pupilmeters and keratometers, and skiascopes, reading scales, and magnifying glasses
ESSILOR	74/289704 (Jun. 29, 1992)	1756467 (Mar. 9, 1983)	Machines for manufacturing corrective lenses for eyeglasses
ESSILOR	79/158651 (Sept. 29, 2014)	4890842 (Jan. 26, 2016)	Optical, facial and/or ophthalmic measurement apparatus, namely, near vision measurement instruments, lens engraving detectors, lensmeters, cornea topographers for non-medical use, keratometers for non-medical use, apparatus for determining lens diameter, apparatus for lens fitting measurements, apparatus for testing the performances of lenses, automatic refractors, manual refractors; software for measuring and displaying ophthalmic, optical and/or facial parameters; software recorded on physical media for acquisition, measurement, processing and storage of data in relation to lenses and/or wearer parameters, software for tracing spectacle frames rims, spectacles lenses, ophthalmic lenses and lens patterns, software for engraving, cutting, edging and remote edging of spectacles and ophthalmic lenses, software for quality control of spectacle lenses and ophthalmic lenses, software for placing orders for spectacle lenses and ophthalmic lenses, software for measuring and displaying ophthalmic, optical and facial parameters, software for manufacturing, grinding, machining and processing lenses and ophthalmic lenses; software for the management of shops for ophthalmic optics professionals, sales assistance software for ophthalmic optics professionals for facilitating purchasing transactions; software platforms dedicated to opticians and other professionals in the field of ophthalmic optics for sharing,

Trademark	App. No. (App. Date)	Reg. No. (Reg. Date)	Goods/Services
			<p>exchanging and storing data and information related to ophthalmic optics; pupillometers for measuring pupillary distance and eye position in the spectacle frame by digital capture of corneal reflections and for measuring lens/eye distance not for medical use; corneal reflection pupillometers for measuring pupillary distance and eye position in the spectacle frame by digital capture of corneal reflections and for measuring lens/eye distance not for medical use; frontofocometers. apparatus and instruments not for medical use for carrying out reading and visual faculty tests, namely, pupillometers, refractors, lensmeters, frontocofometers, topographers, keratometers; structural parts and structural fittings for all the aforesaid goods, namely, head rests, chin rests and nose rests; structural parts for eye testing machines not for medical use, namely, separators and removable covers for eyesight testing; structural parts for eye testing machines not for medical use, namely, power correcting lenses and color filters for eyesight tests; spectacles; sunglasses; goggles for sports; spectacle frames; ophthalmic lenses; spectacle lenses, including organic plastic lenses, mineral lenses, corrective lenses, progressive lenses, sunglass lenses, polarized lenses, filtering lenses, tinted lenses, colored lenses, light-sensitive lenses, photochromic lenses, treated lenses, coated lenses, anti-reflective lenses, semi-finished lenses; contact lenses; cases for spectacle lenses; cases for ophthalmic lenses; spectacle cases; cords and chains for spectacles; blank magnetic recording discs, blank sound recording optical discs, blank recordable CD-Rs, blank recordable DVDs and other blank digital recording media, namely, blank flash memory cards and blank hard disk drives; downloadable electronic publications in the nature of magazines, newsletters, catalogs, brochures, manuals, and booklets in the field of optics and ophthalmic optics; downloadable electronic information guides and documents in the nature of reports, all in the field of optics and ophthalmic optics. quality certificates for ophthalmic lenses, origin control certificates for ophthalmic lenses, analysis reports and certification documents in the nature of reports, booklets, leaflets, information sheets, newsletters and manuals in relation to the manufacture and processing of ophthalmic lenses, and information booklets relating to certification, standardization and normalization concerning the manufacture and processing of ophthalmic lenses, all of the aforementioned products being in downloadable electronic form</p>
	<p>79077051 (Mar. 25, 2009)</p>	<p>3876464 (Nov. 16, 2010)</p>	<p>disinfectant solutions for contact lenses and glasses, products for maintaining contact lenses and glasses, namely, cleaners, disinfectants, products for cleaning contact lenses and glasses, namely, cleaners, disinfectants, wetting solutions, contact lenses solutions</p> <p>machine tools, namely, grinding machines for ophthalmic lenses, polishing machines for ophthalmic lenses; machines for working, processing, cutting, drilling, grinding, trimming, grooving, bevelling, counter-bevelling, chamfering, finishing, lapping, polishing, adjusting and cleaning spectacle glasses and ophthalmic lenses; grinders for spectacle glasses and ophthalmic lenses; parts and components of all the aforesaid products</p> <p>measuring apparatus and instruments, namely, focimeter,</p>

Trademark	App. No. (App. Date)	Reg. No. (Reg. Date)	Goods/Services
			<p>ocular lens meter and optical apparatus and instruments, namely, centering device; spectacles; spectacle frames; non-implacable ophthalmic lenses; spectacle glasses and spectacle glasses in the nature of organic glasses, mineral glasses, correcting glasses, unifocal glasses, progressive glasses, solar glasses, polarizing glasses, tinted glasses, coloured glasses, photosensitive glasses, photochromic glasses, treated glasses, coated glasses, anti-reflective glasses, semi-finished glasses, blanks and rough shapes for spectacle glasses; semi-finished blanks for spectacle glasses, protective glasses and spectacles; contact lenses; cases for all the aforesaid products; software for operating and controlling measuring and optical apparatus and instruments; software for remote grinding of spectacle glasses and ophthalmic lenses; software for managing laboratories for manufacturing, machining and treating ophthalmic lenses and spectacle glasses; software for remote control of products and services in ophthalmic optics and for assistance with sales; software for use by ophthalmic opticians, namely, store management software, software for online ordering of goods and services in the ophthalmic optical field, software for the production, machining and treatment of ophthalmic lenses and spectacles lenses; software that provides access to opticians' sites on telecommunications or computer networks; laboratory and scientific research equipment all for scientific and research use by opticians and ophthalmologists, namely, pupilometers, refractors, autorefractors, optometers, keratometers, ophthalmometers, skiascopes and reading scales</p> <p>Providing online electronic catalogues and price lists of ophthalmic optical products and spectacles and opticians' services; publication and dissemination of publicity materials in the nature of promotional and advertising matter relating to the aforesaid products and services; customer loyalty development services and customer club services for commercial, promotional and/or publicity purposes</p> <p>information transmission of data by electronic communications networks; transmission of information from databases via electronic communication networks; rental of access time to global computer networks featuring databases relating to optical, ophthalmological and spectacle manufacturers' products and opticians' services intended for opticians' shops, optical stores, optical laboratories and workshops and for opticians' and ophthalmic opticians' sites on telecommunications or computer networks</p> <p>treatment of spectacle glasses and ophthalmic lenses in the nature of imparting resistance to scratching, impact, glare, ultraviolet rays, dirt dust, rain and in the nature of hydrophobic and oleophobic treatments; services of providing spectacle glasses and ophthalmic lenses with coatings for imparting hydrophobic and oleophobic properties, of application of overcoatings and temporary adherence coatings, of deposition of thin surface layers using dipping, and of application or deposition of treatment coatings, composite varnishes, glazes, over coatings having one or more of the following properties: resistance to scratching, impact, glare, ultraviolet rays, dirt dust, rain;</p>

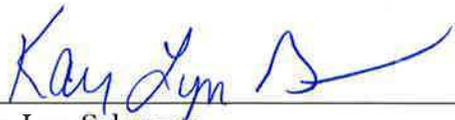
Trademark	App. No. (App. Date)	Reg. No. (Reg. Date)	Goods/Services
			removal of previously-applied surface treatments from eyeglasses and lenses Design, maintenance, lending, rental and installation of computer software and databases relating to ophthalmic optical products and spectacles and opticians' services intended for opticians' shops, optical stores, and optical laboratories and workshops
ESSILOR NATURAL	74/634913 (Feb. 16, 1995)	2079702 (Jul. 15, 1997)	Ophthalmic lenses, namely, eyeglass lenses
ESSILOR IDEAL	76/697495 (May 20, 2009)	3781481 (Apr. 27, 2010)	Optical lenses

5. The mark sought to be registered by Applicant in Application Serial No. 86/663,294 is confusingly similar to Essilor's ESSILOR Marks, as to be likely, when associated with the goods of Applicant, to cause confusion, to cause mistake or to deceive, thereby to Essilor's damage.

WHEREFORE, Essilor prays that Applicant be required to answer this Notice of Opposition; that the mark made the subject of U.S. Application Serial No. 86/663,294 be refused registration; and that Opposer be awarded such other and further relief as may be deemed to be just and proper.

Respectfully submitted,

Date: 2/26/14

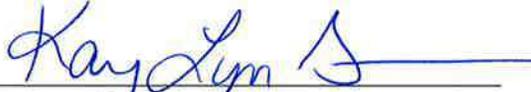

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 3000 Thanksgiving Tower
 1601 Elm Street
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 ATTORNEYS FOR OPPOSER

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing *Notice of Opposition* was served in accordance with 37 C.F.R. 2.101 upon Applicant at the correspondence address of record as indicated below on 2/26/16:

Jerry Werbner
2760 NW Birkendene St.
Portland, Oregon 97229-8080

[Via U.S. Mail]



Kay Lyn Schwartz