

ESTTA Tracking number: **ESTTA61163**

Filing date: **01/10/2006**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

| | | | |
|---------|---|-------------|------|
| Name | The Procter & Gamble Company | | |
| Entity | Corporation | Citizenship | Ohio |
| Address | One Procter & Gamble Plaza Cincinnati, OH 45202 UNITED STATES | | |

| | |
|----------------------|---|
| Attorney information | Lynda E. Roesch Dinsmore & Shohl LLP 1900 Chemed Center 255 East Fifth Street Cincinnati, OH 45202 UNITED STATES lynda.roesch@dinslaw.com Phone:513.977.8139 |
|----------------------|---|

Registration Subject to Cancellation

| | | | |
|--|--|---------------------------------|------------|
| Registration No | 2956430 | Registration date | 05/31/2005 |
| International Registration No. | NONE | International Registration Date | NONE |
| Registrant | Lidl Stiftung & Co. KG Stiftsbergstraße 1 D-74167 Neckarsulm, GERMANY | | |
| Goods/Services Subject to Cancellation | Class 003 Goods/Services: Bleaching preparations for laundry use; general purpose cleaning, polishing and abrasive liquids and powders; skin soaps; perfumes; essential oils for personal use; cosmetics, hair lotions, dentifrices, cotton balls and swabs for cosmetic use, and pre-moistened cosmetic wipes | | |
| | Class 016 Goods/Services: Goods made from paper, namely face towels, paper table napkins, filter paper handkerchiefs, and toilet paper; cardboard boxes for packaging; bags for packaging made of paper and plastic; kitchen papers, namely household towels, wax paper, art paper, bond paper, computer paper and copy paper, disposable diapers | | |

Attachments

Signature
Name
Date

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

IN THE MATTER OF U.S. Registration No. 2,956,430
Registration Date: May 31, 2005

| | | |
|---|---|---|
| THE PROCTER & GAMBLE COMPANY | : | |
| | : | |
| Petitioner, | : | |
| | : | Cancellation No.: _____ |
| v. | : | Registration No.: <u>2,956,430</u> |
| | : | |
| LIDL STIFTUNG & CO. | : | |
| | : | |
| Registrant. | : | |

PETITION FOR CANCELLATION

The Procter & Gamble Company (hereinafter "Procter & Gamble" or "Petitioner"), a corporation organized and existing under the laws of the State of Ohio, having its principal office and place of business at One Procter & Gamble Plaza, Cincinnati, Ohio 45202, believes that it will be damaged by U.S. Registration No. 2,956,430 for the mark TOUJOURS & design as it relates to goods in Classes 3, 5 and 16.

Procter & Gamble hereby petitions to cancel the above-identified registration on the following grounds:

1. Petitioner, The Procter & Gamble Company (hereinafter referred to as "Petitioner"), is a corporation organized and existing under the laws of the State of Ohio, located and doing business at One Procter & Gamble Plaza, Cincinnati, Ohio 45202.

2. Lidl Stiftung & Co., (hereinafter "Registrant"), a corporation of the Republic of Germany, having a principal place of business at Striftsbergstrasse, D-74167 Neckarsulm, Germany, is the owner of record at the Trademark Office for U.S. Registration No. 2,956,430 for

the mark **TOUJOURS & design** for "Bleaching preparations for laundry use; general purpose cleaning, polishing and abrasive liquids and powders; skin soaps; perfumes; essential oils for personal use; cosmetics, hair lotions, dentifrices, cotton balls and swabs for cosmetic use, and pre-moistened cosmetic wipes" in Class 3; "sanitary preparations, namely medical plasters; wound, burn and surgical dressings; sanitary articles for women, namely sanitary pads, panty liners and tampons; cotton for medical use" in class 5; and "Goods made from paper, namely face towels, paper table napkins, filter paper handkerchiefs, and toilet paper; cardboard boxes for packaging; bags for packaging made of paper and plastic; kitchen papers, namely household towels, wax paper, art paper, bond paper, computer paper and copy paper, disposable diapers" in class 16; which issued on May 31, 2005.

3. Since long prior to October 26, 2001, the date on which Lidl Stiftung & Co. KG (hereinafter referred to as "Registrant") filed its application to register the trademark **TOUJOURS & design** for goods including "sanitary articles for women, namely sanitary pads, panty liners and tampons," Petitioner has engaged in the business of manufacturing and selling in interstate commerce catamenial products; namely, maxi pads, mini pads, pantliners, interlabial pads and sanitary pads bearing the **ALWAYS** trademark.

4. The **ALWAYS** trademark was adopted by Petitioner on May 18, 1982 as a trademark for catamenial products; namely, maxi pads, mini pads, pantliners, interlabial pads and sanitary pads in interstate commerce by using the trademark on the packaging for such products, and by displaying representations of said mark in advertising and in other ways customary to the trade.

5. Petitioner is the owner of the entire right, title and interest in and to the **ALWAYS** trademark for use in connection with catamenial products; namely, maxi pads, mini

pads, pantliners, interlabial pads and sanitary pads as evidenced by the following U.S. Trademark Registrations issued by the U.S. Patent and Trademark Office on the Principal Register (hereinafter, the "ALWAYS Marks"):

| Mark | Goods | Reg. No. | Issued |
|-------------------|--|-----------|------------|
| ALWAYS | Catamenial products, namely, maxi pads, mini pads, and pantliners. | 1,601,853 | 06/19/1990 |
| ALWAYS ALLDAYS | Pantliners. | 2,010,627 | 10/22/1996 |
| ALWAYS CHANGING | Educational and instructional material, namely, pamphlets, brochures, booklets and posters all on the subject of personal hygiene. | 2,086,011 | 08/05/1997 |
| ALWAYS | Pre-moistened cosmetic wipes for external vaginal and perineal cleansing. | 2,369,464 | 07/18/2000 |
| ALWAYS | Interlabial pads for feminine hygiene. | 2,456,168 | 05/29/2001 |
| ALWAYS THIN MAXI | Catamenial products, namely maxi pads, mini pads and pantliners. | 2,470,616 | 07/17/2001 |
| ALWAYS MULTIPAX | Catamenials, namely, sanitary pads. | 2,474,366 | 07/31/2001 |
| ALWAYS THIN ULTRA | Catamenial products, namely maxi pads, mini pads and pantliners. | 2,486,276 | 09/04/2001 |

The above registrations are, in all respects, valid, subsisting and owned by Petitioner and are currently in use in interstate commerce. Affidavits of continued use and incontestability under §§ 8 & 15 of the Act of 1946 have been filed and accepted with respect to Registration Nos. 1,601,853, 2,010,627 and 2,086,011. Registration No. 1,601,853 was renewed.

6. Petitioner has spent and continues to spend large sums of money in the advertisement of goods bearing its ALWAYS Marks and by reason of such advertising and the high quality of the ALWAYS products, Petitioner enjoys a valuable goodwill and an enviable reputation with respect to its trademarks and the goods associated therewith in connection with the ALWAYS brand name. Petitioner offers educational services for Women's Health covering numerous issues, including puberty, personal hygiene, breast health, pregnancy, and menopause.

7. Petitioner's ALWAYS Marks and Registrant's TOUJOURS & design trademark are confusingly similar in connotation as applied to the registered goods listed in Paragraph 9 of this petition.

8. The literal element of Registrant's **TOUJOURS & design** mark, the word "toujours," translates from French into English as "always." French is a language familiar to an appreciable segment of American consumers.

9. Petitioner's goods, "catamenial products; namely, maxi pads, mini pads, pantliners, interlabial pads and sanitary pads;" are identical to Registrant's goods in International Class 005, "*sanitary articles for women, namely sanitary pads, panty liners and tampons; cotton for medical use*" and nearly identical to Registrant's goods in International Class 016, "*goods made from paper, namely, face towels, paper table napkins, filter paper handkerchiefs, and toilet paper; cardboard boxes for packaging; bags for packaging made of paper and plastic; kitchen papers, namely household towels, wax paper, art paper, bond paper, computer paper and copy paper, disposable diapers*" and nearly identical to Registrant's Goods International Class 003, "*cotton balls and swabs for cosmetic use, and pre-moistened cosmetic wipes*" and are likely to be associated with Registrant's mark.

10. The products for which Registrant sought registration and Petitioner's products would ordinarily be sold to the same consumers.

11. As a result of the foregoing, the purchasing public familiar with Petitioner's products and Petitioner's **ALWAYS** Marks for catamenial products is likely to be confused, misled or deceived into thinking that the products Registrant will be selling are in some way sponsored by or connected with Petitioner to Petitioner's irreparable damage and injury.

12. Petitioner is injured by the registration of **TOUJOURS & design**, because it falsely suggests a connection with Petitioner and Petitioner's **ALWAYS** brand of catamenial products which prominently features the **ALWAYS** Marks. Petitioner has no control over the nature and quality of the goods produced by Registrant and thus will be damaged and irreparably

harmd by reason of the loss of control over its reputation and the erosion of the goodwill in the **ALWAYS Marks**.

13. Registrant adopted its **TOUJOURS & design** mark for use on the goods enumerated in Registration No. 2,956,430 with prior knowledge of Petitioner's **ALWAYS Marks**.

14. As a result of over twenty-three (23) years of continuous and substantial use of its **ALWAYS Marks**, as well as extensive advertising, promotion and sales of products bearing its **ALWAYS Marks**, as well as the considerable goodwill it has developed in its **ALWAYS Marks**, Petitioner's **ALWAYS** mark has become a famous trademark within the meaning of Section 43(e) of the Lanham Act.

15. If Registrant is allowed continued registration of its **TOUJOURS & design** mark, Petitioner will be further damaged and irreparably harmed because registration and use of the **TOUJOURS & design** mark will dilute the distinctive quality of Petitioner's **ALWAYS Marks**.

16. For the reasons set forth above, Petitioner believes and accordingly asserts that the goodwill in its **ALWAYS Marks** will be damaged and that Registrant should be denied continued registration of the **TOUJOURS & design**.

17. Registration of **TOUJOURS & design** is specifically barred by the provisions of Section 2(d) of the Trademark Act of 1946 because said mark consists of or comprises a mark which so resembles marks or trade names previously used in the United States by Petitioner and not abandoned, as to be likely, when applied to the Respondent's goods to cause confusion, mistake or deception.

18. Petitioner petitions to cancel U.S. Registration 2,956,430 based upon likelihood of confusion.

WHEREFORE, Petitioner prays that this Petition for Cancellation be sustained and that U.S. Registration No. 2,956,430 for the **TOUJOURS & design** mark be cancelled.

Please recognize as attorneys of record of Petitioner, The Procter & Gamble Company, in this proceeding: Lynda E. Roesch, Steven A. Abreu, and Katherine Przywara all members of the Bar of the State of Ohio, whose address is Dinsmore & Shohl LLP, 1900 Chemed Center, 255 East Fifth Street, Cincinnati, OH 45202.

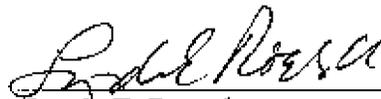
Please address all communications to Lynda E. Roesch, (513) 977-8200.

This petition for cancellation is being filed online and the requisite fee of \$300.00 is being paid via Visa online.

Date:

1-10-05

Respectfully submitted



Lynda E. Roesch
Dinsmore & Shohl LLP
1900 Chemed Center
255 East Fifth Street
Cincinnati, Ohio 45202

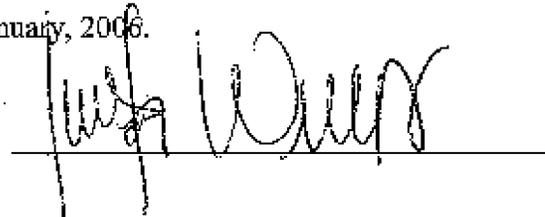
OF COUNSEL:

David M. Moyer
The Procter & Gamble Company
One Procter & Gamble Plaza
Cincinnati, Ohio 45202

Attorney for Petitioner
The Procter & Gamble Company

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a copy of the foregoing has been served electronically to Beth Liebling, Osha & May, One Houston Center, 1221 McKinney Street, Suite 2800, Houston, TX 77010-- liebling@oshamay.com on this 10th day of January, 2006.

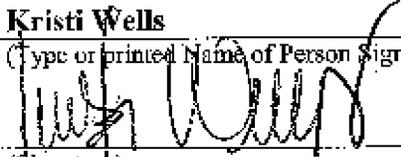


CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted electronically to the Trademark Trial and Appeal Board on the date shown below.

Kristi Wells

(Type or printed name of Person Signing Certificate)



(Signature)

January 10, 2006

(Date)