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03-21-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #61

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

In the Matter of Application Serial No. 76/165,659
Filed on November 15, 2000
For the Mark ORLEN
Published in the *Official Gazette* on December 31, 2002

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Orlane S.A.,	:	
	:	
	:	Opposer, : Opposition No. _____
	:	
-v-	:	
	:	
Polski Koncern Naftowy Orlen Spolka Ackyjna,	:	
	:	
	:	Applicant. :
-----	X	

BOX TTAB FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513.

NOTICE OF OPPOSITION

Opposer, Orlane S.A., a corporation organized and existing under the laws of France, having an address at 12/14 Rond Point des Champs - Elysees, Paris believes that it will be damaged by the registration of the mark ORLEN in International Class 42, published in the *Official Gazette* on December 31, 2002. Opposer has applied for an extension of time to oppose up to and including March 31, 2003, and hereby opposes such application.

As grounds for this Opposition, Orlane S.A. relies upon the rights developed by it and related companies (hereinafter referred to as "Orlane" or "Opposer") and alleges on knowledge as to itself and otherwise upon information and belief, as follows:

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1. Opposer is engaged, and for many years has been engaged, in selling cosmetics and skincare products and related services in the United States.

2. For many years, and long prior to Applicant's filing of its application, Opposer has used the mark ORLANE in interstate commerce throughout the United States in connection with its health and therapeutic services and sale of cosmetics and skincare products.

3. Prior to Applicant's alleged date of first use, Opposer obtained registrations for the following marks annexed hereto as Exhibit A (the "ORLANE Registrations" or the "ORLANE Marks"):

- ORLANE, Reg. No. 1,251,902 for "health and therapeutic services-namely, hygienic and beauty care and studies related thereto" in International Class 42, issued on September 20, 1983;
- EAU D'ORLANE, Reg. No. 1,730,559 for "perfumes, including toilet water; cosmetics; namely, perfumed cream; and hair lotions" in International Class 3, issued on November 10, 1992;
- EXTRAIT VITAL ORLANE, Reg. No. 1,499,159 for "cosmetics and toiletries, namely-eye shadow, eyebrow pencil, mascara, face powder, liquid powder, milk lotion, toilet cream, cleansing cream, foundation cream, lipsticks and rouges, skin lotions and depilatories" in International Class 3, issued on August 9, 1988;
- ORLANE, Reg. No. 1,496,430 for "cosmetics, namely-perfumed water, perfumed oil, eye shadow, eyebrow pencil, mascara, face powder, liquid powder, general toilet waters, milk lotion, skin lotion, toilet cream, eau de cologne, cold cream, cleansing cream, medicated cream, foundation cream, lipstick, rouge, pomade, manicure enamel and toilet soaps" in International Class 3, issued on July 19, 1988;
- HYDRO-CLIMAT ORLANE, Reg. No. 1,451,650 for "milk lotion, toilet cream, foundation cream, skin cream" in International Class 3, issued on August 11, 1987;
- FLEURS D'ORLANE, Reg. No. 1,335,000 for "cosmetics and toiletry items-namely, perfumery; fragrances, colognes; perfumed bath oil, essential oils, bath soaps; scented soaps; toilet water; bath oils; astringents;

personal deodorants; talcum powder; bath powder and after-shave lotion” in International Class 3, issued on May 14, 1985; and

- ORLANE, Reg. No. 0617607 for “cosmetics-namely, cold cream vanishing cream, face powder, rouge, skin tonic, hormone cream, skin lotions, camphor lotion, lipsticks, eye shadow” in International Class 3, issued on December 13, 1955.

4. The ORLANE Registrations are valid and subsisting, unrevoked and uncanceled, and are conclusive evidence of the validity of Opposer’s exclusive right to use the ORLANE marks in commerce in connection with the goods and services described in the registrations, without condition or limitation, and constitutes constructive notice of Opposer’s ownership of the ORLANE marks for the goods and services described in the registrations, as provided for by Sections 7(b), 22, and 33(a) of the Lanham Act. The ORLANE Marks are also incontestable under Section 15 of the Lanham Act.

5. Opposer has expended substantial amounts of time and effort in advertising and promoting its goods and services under the ORLANE marks. As a result of such advertising and promotional activities, the relevant public has come to associate and identify ORLANE with Opposer, and Opposer derives substantial goodwill from such identification by consumers.

6. Applicant filed an application for the mark ORLEN, Serial No. 76/165,659, on November 15, 2000 and the mark was published in the *Official Gazette* on December 31, 2002, for various goods and services, including “Catering services; bar, restaurant and hotel services; charitable services, namely, providing food, clothing, shelter and medicine; medical services; research in the fields of hygenics and cosmetics; legal services; patent exploitation; copyright management; scientific searches in the filed of chemical technologies; chemical and mechanical research; research in the filed of transformation, storing, blending and distribution of fuels, both

liquid and gas as well as derivative chemical products; and computer programming for others” in International Class 42.

7. Applicant’s mark ORLEN, as set forth in the application here opposed, is substantially similar and nearly identical in sight, sound, connotation and commercial impression to Opposer’s ORLANE mark and there is a direct overlap between the services covered by Applicant in International Class 42 and those covered by Opposer’s ORLANE Marks.

8. Opposer currently uses its ORLANE mark in connection with services for “hygienic and beauty care and studies related thereto” and there are no other similar federally registered mark in use for similar goods or services.

9. Accordingly, Applicant’s mark is likely to cause confusion, mistake or to deceive under Section 2(d) of the Lanham Act.

10. Opposer’s ORLANE marks were registered and used in the United States well prior to Applicant’s filing date of November 15, 2000.

11. If Applicant is permitted to use and register its mark for its services in International Class 42 as specified in the application herein opposed, there would be likely confusion in the trade resulting in damage and injury to Opposer by reason of the similarity between Applicant’s mark and Opposer’s marks. Persons familiar with Opposer’s ORLANE marks would be likely to purchase Applicant’s services believing them to be offered by Opposer. Likewise, persons exposed to Applicant’s mark ORLEN who subsequently become acquainted with Opposer’s ORLANE marks are likely to conclude that the goods and services offered by Opposer under its marks are in some manner related to the services that Applicant offers under its mark. Any such confusion in the trade inevitably would result in damage and injury to Opposer.

12. Opposer will be damaged by registration of Applicant's mark in International Class 42, as shown in the application here opposed, because such registration will support and assist Applicant in the confusing and misleading use of Applicant's mark, and will give color of rights to Applicant in violation of Opposer's prior and superior statutory and common-law rights in the ORLANE marks.

WHEREFORE, Orlane prays that this Opposition be sustained and that the application for registration of the mark ORLEN in International Class 42 be in all respects denied.

Dated: New York, New York
March 21, 2003

HUGHES HUBBARD & REED LLP

By: Perla M. Kuhn
Perla M. Kuhn
Kristin B. Whiting
Attorneys for Opposer
One Battery Park Plaza
New York, New York 10004
(212) 837-6000

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Start List At: OR Jump to record: Record 1 out of 7

Check Status (TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)

Typed Drawing

Word Mark EAU D'ORLANE
 Goods and Services IC 003. US 051. G & S: perfumes, including toilet water; cosmetics; namely, perfumed cream; and hair lotions
 Mark Drawing Code (1) TYPED DRAWING
 Serial Number 74218426
 Filing Date November 4, 1991
 Published for Opposition August 18, 1992
 Registration Number 1730559
 Registration Date November 10, 1992
 Owner (REGISTRANT) ORLANE S.A. COMPANY FRANCE 12-14 Rond Point des Champs-Elysees 75008 Paris FRANCE
 Section 44 Indicator SECT44
 Priority Date August 2, 1991
 Prior Registrations 1496430;1499159;1537105;AND OTHERS
 Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "EAU" APART FROM THE MARK AS SHOWN
 Type of Mark TRADEMARK
 Register PRINCIPAL
 Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20021028.
 Renewal 1ST RENEWAL 20021028
 Live/Dead Indicator LIVE

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EXTRAIT VITAL

ORLANE

Word Mark EXTRAIT VITAL ORLANE

Translations THE ENGLISH TRANSLATION OF THE WORDS "EXTRAIT VITAL" IN THE MARK IS "VITAL EXTRACT".

Goods and Services IC 003. US 051. G & S: COSMETICS AND TOILETRIES, NAMELY-EYESHADOW, EYEBROW PENCIL, MASCARA, FACE POWDER, LIQUID POWDER, MILK LOTION, TOILET CREAM, CLEANSING CREAM, FOUNDATION CREAM, LIPSTICKS AND ROUGES, SKIN LOTIONS AND DEPILATORIES. FIRST USE: 19830300. FIRST USE IN COMMERCE: 19830300

Mark Drawing Code (5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Serial Number 73678203

Filing Date August 13, 1987

Published for Opposition May 17, 1988

Registration Number 1499159

Registration Date August 9, 1988

Owner (REGISTRANT) ORLANE S.A. JOINT STOCK COMPANY FRANCE 12/14, ROND POINT DES CHAMPS-ELYSEES PARIS FRANCE

Attorney of Record H. JOHN CAMPAIGN

Prior Registrations 0617607

Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "EXTRAIT" APART FROM THE MARK AS SHOWN

Type of Mark TRADEMARK

Register PRINCIPAL

Affidavit Text SECT 15. SECT 8 (6-YR).

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Word Mark ORLANE

Goods and Services IC 003. US 051 052. G & S: COSMETICS, NAMELY-PERFUMED WATER, PERFUMED OIL, EYE SHADOW, EYEBROW PENCIL, MASCARA, FACE POWDER, LIQUID POWDER, GENERAL TOILET WATERS, MILK LOTION, SKIN LOTION, TOILET CREAM, EAU DE COLOGNE, COLD CREAM, CLEANSING CREAM, MEDICATED CREAM, FOUNDATION CREAM, LIPSTICK, ROUGE, POMADE, MANICURE ENAMEL AND TOILET SOAPS

Mark Drawing Code (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Search Code 260102 260920 261121

Serial Number 73659235

Filing Date May 6, 1987

Published for Opposition April 26, 1988

Registration Number 1496430

Registration Date July 19, 1988

Owner (REGISTRANT) ORLANE S.A. JOINT STOCK COMPANY FRANCE 12/14, ROND-POINT DES CHAMPS-ELYSEES PARIS FRANCE

Attorney of Record H. JOHN CAMPAIGN

Section 44 SECT44
Indicator
Priority Date March 17, 1987
Prior Registrations 0617607;1157817;1190375;1392039;AND OTHERS
Type of Mark TRADEMARK
Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR).
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Typed Drawing

Word Mark HYDRO-CLIMAT ORLANE
Goods and Services IC 003. US 051. G & S: MILK LOTION, TOILET CREAM, FOUNDATION CREAM, SKIN CREAM
Mark Drawing Code (1) TYPED DRAWING
Serial Number 73615228
Filing Date August 18, 1986
Published for Opposition May 19, 1987
Registration Number 1451650
Registration Date August 11, 1987
Owner (REGISTRANT) ORLANE S.A. JOINT STOCK COMPANY FRANCE 12/14, ROND POINT DES CHAMPS ELYSEES PARIS FRANCE
Attorney of Record KEITH E. DANISH
Section 44 Indicator SECT44
Priority Date April 9, 1986
Prior Registrations 0617607;1157817;1190375;1251902;1343708;1355000;1392039;AND OTHERS
Type of Mark Register TRADEMARK PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR).
Live/Dead LIVE



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Typed Drawing

Word Mark FLEURS D'ORLANE
Translations THE WORD "FLEURS" IS TRANSLATED INTO ENGLISH AS "FLOWERS".
Goods and Services IC 003. US 051 052. G & S: Cosmetics and Toiletry Items-Namely, Perfumery; Fragrances, Colognes; Perfumed Bath Oil, Essential Oils, Bath Soaps; Scented Soaps; Toilet Water; Bath Oils; Astringents; Personal Deodorants; Talcum Powder; Bath Powder and After-Shave Lotion. FIRST USE: 19830323. FIRST USE IN COMMERCE: 19830323
Mark Drawing Code (1) TYPED DRAWING
Serial Number 73425205
Filing Date May 9, 1983
Published for Opposition March 5, 1985
Registration Number 1335000
Registration Date May 14, 1985
Owner (REGISTRANT) Orlane CORPORATION FRANCE 12-13 Rond Pont Champs Elysees Paris FRANCE
 (LAST LISTED OWNER) ORLANE, S.A. CORPORATION ASSIGNEE OF ORLANE, S.A. FRANCE 12/14, ROND POINT DES CHAMPS-ELYSEES PARIS
Assignment Recorded ASSIGNMENT RECORDED
Prior Registrations 0617607;1157817
Type of Mark TRADEMARK

Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR).
Live/Dead Indicator LIVE

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Typed Drawing

Word Mark	ORLANE
Goods and Services	IC 042. US 100. G & S: Health and Therapeutic Services-Namely, Hygienic and Beauty Care and Studies Related Thereto
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	73350654
Filing Date	February 17, 1982
Published for Opposition	June 28, 1983
Change In Registration	CHANGE IN REGISTRATION HAS OCCURRED
Registration Number	1251902
Registration Date	September 20, 1983
Owner	(REGISTRANT) Orlane JOINT STOCK COMPANY FRANCE 12/14, ROND POINT DES CHAMPS-ELYSEES Paris (Seine) FRANCE (LAST LISTED OWNER) ORLANE S.A. JOINT STOCK COMPANY ASSIGNEE OF FRANCE 12/14 ROND POINT DE CHAMPS-ELYSEES PARIS FRANCE
Assignment Recorded	ASSIGNMENT RECORDED
Section 44 Indicator	SECT44
Prior Registrations	0617607;1157817;1190375
Type of Mark	SERVICE MARK
Register	PRINCIPAL

Affidavit Text SECT 15. SECT 8 (6-YR).

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Indicator** **LIVE**

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Typed Drawing

Word Mark ORLANE

Goods and Services IC 003. US 051. G & S: COSMETICS-NAMELY, COLD CREAM, VANISHING CREAM, FACE POWDER, ROUGE, SKIN TONIC, HORMONE CREAM, SKIN LOTIONS, CAMPHOR LOTION, LIPSTICKS, EYE SHADOW. FIRST USE: 19480000. FIRST USE IN COMMERCE: 19540100

Mark Drawing Code (1) TYPED DRAWING

Serial Number 71679370

Filing Date January 4, 1955

Registration Number 0617607

Registration Date December 13, 1955

Owner (REGISTRANT) JEAN D'ALBRET, S.A.R.L. CORPORATION FRANCE 53 AVENUE GEORGE V PARIS FRANCE

(LAST LISTED OWNER) ORLANE S.A. JOINT STOCK COMPANY ASSIGNEE OF FRANCE 12-14, ROND POINT DES CHAMPS ELVSEES 75008 PARIS FRANCE

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record LAWRENCE E. ABELMAN

Type of Mark TRADEMARK

Register PRINCIPAL

Affidavit Text SECT 15.

Renewal 2ND RENEWAL 19960417

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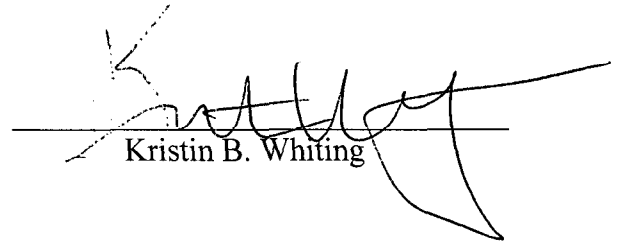
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CERTIFICATE OF MAILING

I hereby certify that an original and one copy of the foregoing NOTICE OF OPPOSITION is being deposited with the United States Postal Service as Express Mail in a postage prepaid envelope addressed to: Box TTAB FEE, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 on March 21, 2003.

Dated: March 21, 2003
New York, New York


Kristin B. Whiting