

TTAB

TRADEMARK

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

In the Matter of Trademark Application
Serial No. 76/438,534
Published April 29, 2003



07-28-2003

U.S. Patent & TMOfc/TM MailRcpt Dt. #22

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HERAEUS-KULZER, INC.)
))
Opposer,))
))
v.))
))
MANUFACTURERA DENTAL))
CONTINENTAL, S.A. de C.V.))
))
Applicant))

Opposition No. 91156701

APPLICANT'S ANSWER TO NOTICE OF OPPOSITION

Applicant, MANUFACTURERA DENTAL CONTINENTAL, S.A. de C.V.,
hereby sets forth its Answer to the Notice of Opposition filed by Opposer, HERAEUS-KULZER, INC., and states as follows:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 1 of the Notice of Opposition and therefore denies those allegations.
2. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 2 of the Notice of Opposition and therefore denies those allegations.

3. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 3 of the Notice of Opposition and therefore denies those allegations.

4. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 4 of the Notice of Opposition and therefore denies those allegations.

5. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 5 of the Notice of Opposition and therefore denies those allegations.

6. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 6 of the Notice of Opposition and therefore denies those allegations.

7. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 7 of the Notice of Opposition and therefore denies those allegations.

8. For various reasons, Applicant denies the allegations of Paragraph 8 of the Notice of Opposition. For example, there are significant distinctions between each of the marks cited in the Opposition and Applicant's BLU JEL MDC mark. None of the cited marks contains the term BLU or MDC. Further, the only common term shared by Applicant's BLU JEL MDC mark and each of the marks listed in the Notice of Opposition is the term JEL. This term (and its phonetic equivalent, GEL) is descriptive and was appropriately disclaimed by Applicant in U.S. Application Serial No. 76/438,534. Still further, the term JEL/GEL is commonly used in the dental industry as

illustrated by the co-existence of the registered marks ORTHO-JEL (U.S. Reg. 1,036,048), UNIJEL (U.S. Reg. 904,795), POLYJEL (U.S. Reg. 985,109), ENDO GEL (U.S. Reg. 2,482,546), GEL WHITE (U.S. Reg. 1,869,175), and SUPERGEL (U.S. Reg. 794,147), each owned by a different third party and covering dental products. Printouts of these registrations from the U.S. Patent and Trademark Office database are attached hereto at Exhibit A. It is clear from the co-existence of these references and Applicant's disclaimer of the descriptive term JEL that no one entity is able to claim exclusive rights to this term or its phonetic equivalent. As such, there is no likelihood of confusion between Applicant's composite BLU JEL MDC mark and any or all of the marks listed in the Notice of Opposition.

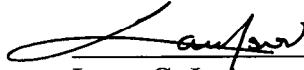
9. Applicant denies the allegations of Paragraph 9 of the Notice of Opposition.

10. Applicant denies the allegations of Paragraph 10 of the Notice of Opposition.

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WHEREFORE, Applicant requests that the Board dismiss the Notice of Opposition filed in this proceeding.

Respectfully submitted,

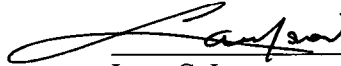


Larry C. Jones
Brian M. Davis
ALSTON & BIRD LLP
Bank of America Plaza
101 S. Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Telephone: (704) 444-1000
Fax: (704) 444-1111

Attorneys for Applicant,
MANUFACTURERA DENTAL
CONTINENTAL, S.A. de C.V.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, Attn: BOX TTAB - NO FEE, 2900 Crystal Drive, Arlington, Virginia 22202-3513 on the date indicated below.




Larry C. Jones
Date of Signature: July 25, 2003

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CERTIFICATE OF SERVICE

I certify that the foregoing "Applicant's Answer To Notice Of Opposition" was served on Opposer by mailing a copy of same by U.S. first class mail, postage prepaid, on the 25th day of July 2003, to Opposer's counsel, addressed as follows:

Wm. W. Rymer
400 South Main Street
Providence, Rhode Island 02903



Larry C. Jones

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Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-07-24 16:04:55 ET

Serial Number: 73007643

Registration Number: 1036048

Mark (words only): ORTHO-JEL

Current Status: This registration has been renewed.

Date of Status: 1996-03-12

Filing Date: 1973-11-30

Registration Date: 1976-03-23

Law Office Assigned: Unknown

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 1996-05-15

CURRENT APPLICANT(S)/OWNER(S)

1. RMO, INC.

Address:

RMO, INC.
650 W. COLFAX
DENVER, CO 80204
United States

State or Country of Incorporation: Colorado

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

DENTAL IMPRESSION MATERIAL

International Class: 005

First Use Date: 1973-04-01

First Use in Commerce Date: 1973-08-30

Basis: 1(a)

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ADDITIONAL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

1996-03-12 - Registration renewed - 10 year

1996-01-26 - Section 9 filed/check record for Section 8

1981-09-09 - Section 8 (6-year) accepted & Section 15 acknowledged

CONTACT INFORMATION

Correspondent (Owner)

THOMAS R. MARSH (Attorney of record)

THOMAS R. MARSH
SHERIDAN ROSS & MCINTOSH
1700 LINCOLN STREET
SUITE 3500
DENVER, CO 80203
United States

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Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-07-24 16:05:13 ET

Serial Number: 72352270

Registration Number: 904795

Mark (words only): UNIJEL

Current Status: This registration has been renewed.

Date of Status: 2001-04-30

Filing Date: 1970-02-24

Registration Date: 1970-12-22

Law Office Assigned: (NOT AVAILABLE)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2001-12-13

CURRENT APPLICANT(S)/OWNER(S)

1. MINNESOTA MINING AND MANUFACTURING COMPANY

Address:

MINNESOTA MINING AND MANUFACTURING COMPANY
3M CENTER 2501 HUDSON ROAD
ST. PAUL, MN 55144
United States

State or Country of Incorporation: Delaware

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

ALGINATE IMPRESSION MATERIALS FOR DENTAL USE

U.S. Class: 044 (International Class 005)

First Use Date: 1970-01-28

First Use in Commerce Date: 1970-01-28

Basis: 1(a)

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ADDITIONAL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

- 2001-04-30 - Registration renewed - 10 year
 - 2001-04-30 - Section 8 (10-year) accepted/ Section 9 granted
 - 2000-12-06 - Combined Section 8 (10-year)/Section 9 filed
 - 1990-09-12 - Registration renewed - 10 year
 - 1990-08-13 - Section 9 filed/check record for Section 8
 - 1977-01-26 - Section 15 acknowledged
 - 1976-12-13 - Section 8 (6-year) accepted
 - 1976-12-01 - Section 15 affidavit received
 - 1976-11-19 - Section 8 (6-year) filed
-

CONTACT INFORMATION

Correspondent (Owner)
MICHELLE M. MICHEL (Attorney of record)

MICHELLE M. MICHEL
MINNESOTA MINING & MFG. COMPANY
3M CENTER
P. O. BOX 33427
ST. PAUL, MN 55133-3427
United States

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Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-07-24 16:05:36 ET

Serial Number: 72427307

Registration Number: 985109

Mark (words only): POLYJEL

Current Status: This registration has been renewed.

Date of Status: 1994-08-10

Filing Date: 1972-06-14

Registration Date: 1974-05-28

Law Office Assigned: Unknown

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 1994-10-14

CURRENT APPLICANT(S)/OWNER(S)

1. DENTSPLY RESEARCH & DEVELOPMENT CORP.

Address:

DENTSPLY RESEARCH & DEVELOPMENT CORP.

LAKEVIEW AND CLARKE AVES.

MILFORD, DE 19963

United States

State or Country of Incorporation: Delaware

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

DENTAL IMPRESSION MATERIAL AND COMPONENTS

U.S. Class: 044 (International Class 005)

First Use Date: 1972-06-02

First Use in Commerce Date: 1972-06-02

Basis: 1(a)

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ADDITIONAL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

1994-08-10 - Registration renewed - 10 year

1994-05-19 - Section 9 filed/check record for Section 8

1994-05-19 - Section 9 filed/check record for Section 8

1980-03-03 - Section 8 (6-year) accepted & Section 15 acknowledged

CONTACT INFORMATION

Correspondent (Owner)

EDWARD J. HANSON, JR.
DENTSPLY LEGAL DEPARTMENT
570 W. COLLEGE AVE.
YORK, PA 17405-0872
United States

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-07-24 16:05:53 ET

Serial Number: 78030129

Registration Number: 2482546

Mark (words only): ENDOGEL

Current Status: Registered.

Date of Status: 2001-08-28

Filing Date: 2000-10-11

Registration Date: 2001-08-28

Law Office Assigned: TMO Law Office 112

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2001-09-17

CURRENT APPLICANT(S)/OWNER(S)

1. Jordco, Inc.

Address:

Jordco, Inc.
595 NW 167th Ave.
Beaverton, OR 97006
United States

State or Country of Incorporation: Oregon

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

Dental lubricating gel-compound used in the field of Endodontics also known as root canal procedures

International Class: 005

First Use Date: 2000-04-24

First Use in Commerce Date: 2000-05-00

Basis: 1(a)

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ADDITIONAL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2001-08-28 - Registered - Principal Register

2001-06-05 - Published for opposition

2001-05-23 - Notice of publication

2001-03-24 - Approved for Pub - Principal Register (Initial exam)

2001-03-22 - Examiner's amendment mailed

2001-03-19 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

JORDCO, INC.

595 NW 167TH AVE

BEAVERTON OR 97006-8374

United States

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Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-07-24 16:06:14 ET

Serial Number: 74394500

Registration Number: 1869175

Mark (words only): GEL WHITE

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 2000-11-01

Filing Date: 1993-05-25

Registration Date: 1994-12-27

Law Office Assigned: TMEO Law Office # 08

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2000-11-06

CURRENT APPLICANT(S)/OWNER(S)

1. TEMREX CORPORATION

Address:

TEMREX CORPORATION
112 Albany Avenue (P.O. Box 182)
Freeport, NY 11520
United States

State or Country of Incorporation: New York

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

dental bleaching gels

International Class: 003

First Use Date: 1993-05-00

First Use in Commerce Date: 1993-05-00

Basis: 1(a)

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ADDITIONAL INFORMATION

Disclaimer: "GEL"

PROSECUTION HISTORY

2000-11-01 - Section 8 (6-year) accepted & Section 15 acknowledged

2000-07-26 - Section 8 (6-year) and Section 15 Filed

1994-12-27 - Registered - Principal Register

1994-10-04 - Published for opposition

1994-09-02 - Notice of publication

1994-06-02 - Approved for Pub - Principal Register (Initial exam)

1994-05-10 - Communication received from applicant

1994-05-02 - Non-final action mailed

1994-04-13 - Amendment to Use approved

1994-02-07 - Communication received from applicant

1994-03-14 - Amendment to use processing complete

1994-02-07 - Amendment to Use filed

1993-09-20 - Non-final action mailed

1993-08-31 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

Stewart L. Gitler (Attorney of record)

STEWART L. GITLER
HOFFMAN WASSON & GITLER
2361 JEFFERSON DAVIS HWY STE 522
ARLINGTON VA 22202-3856
United States

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-07-24 16:06:30 ET

Serial Number: 72193623

Registration Number: 794147

Mark (words only): SUPERGEL

Current Status: This registration has been renewed.

Date of Status: 1985-06-28

Filing Date: 1964-05-18

Registration Date: 1965-08-10

Law Office Assigned: Unknown

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 1985-08-13

CURRENT APPLICANT(S)/OWNER(S)

1. HARRY J. BOSWORTH COMPANY

Address:

HARRY J. BOSWORTH COMPANY

531 S. PLYMOUTH COURT

CHICAGO, IL

United States

State or Country of Incorporation: Illinois

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

ALGINATE IMPRESSION MATERIAL FOR DENTAL IMPRESSIONS

U.S. Class: 044 (International Class 010)

First Use Date: 1957-07-22

First Use in Commerce Date: 1957-09-08

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

1985-08-10 - Registration renewed - 20 year

1985-02-25 - Section 9 filed/check record for Section 8

CONTACT INFORMATION

Correspondent (Owner)
SILVERMAN, CASS & SINGER, LTD.
105 W. ADAMS STREET, 27TH FLOOR
CHICAGO, IL 60603
United States

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