

ESTTA Tracking number: **ESTTA83819**

Filing date: **06/05/2006**

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	Warner-Lambert Company LLC
Granted to Date of previous extension	08/16/2006
Address	201 Tabor Road Morris Plains, NJ 07950 UNITED STATES
Attorney information	J. Paul Williamson Fulbright & Jaworski L.L.P. 801 Pennsylvania Ave., N.W. 5th Floor Washington, DC 20004 UNITED STATES wotrademark@fulbright.com Phone:2026620200

**Applicant Information**

Application No	78549688	Publication date	04/18/2006
Opposition Filing Date	06/05/2006	Opposition Period Ends	08/16/2006
Applicant	Quality Brands LLC P.O. Box 363 Carmel, IN 460820363 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 003. All goods and services in the class are opposed, namely: skin cleanser, exfoliating body scrub, skin and facial moisturizer	
Related Proceedings	91170279
Attachments	PHRC754 - Notice of Opposition.pdf ( 6 pages )(310574 bytes )
Signature	/jpw/
Name	J. Paul Williamson
Date	06/05/2006

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

Warner-Lambert Company LLC,	§	
	§	
Opposer,	§	
	§	Application Serial
v.	§	No. 78/549,688 - LISTEREX
	§	
Quality Brands LLC,	§	Published:
	§	April 18, 2006
Applicant.	§	

**NOTICE OF OPPOSITION**

Opposer, Warner-Lambert Company LLC (“Opposer”), a Delaware limited liability company, having a place of business at 201 Tabor Road, Morris Plains, New Jersey 07950, believes it will be damaged by the registration of the mark shown in Application Serial No. 78/549,688, and therefore opposes registration of this mark under the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. Section 1063.

Application Serial No. 78/549,688, for the mark LISTEREX, was filed on January 19, 2005, for a “skin cleanser, exfoliating body scrub, skin and facial moisturizer,” in International Class 3. The mark was published for opposition in the Trademark Official Gazette of April 18, 2006, and Opposer has timely obtained extensions of time to oppose out to August 16, 2006.

The grounds for opposition are as follows:

1. Opposer is engaged in the development, manufacture and sale of a variety of over-the-counter personal care and healthcare products, and has built a large and successful business in the personal care and healthcare fields.

2. Opposer is the owner of the mark LISTERINE for a variety of personal care and personal healthcare products in the nature of antiseptics, antiseptics for medicinal use and personal hygiene, toothpaste, antiseptic throat lozenges, mouthwashes and non-medicated breath fresheners. The first use of the LISTERINE mark for antiseptics dates back approximately 125 years, to 1881, and the use of the LISTERINE mark has been continuous from that date through to the present.

3. Opposer owns numerous valid and subsisting United States trademark registrations incorporating its LISTERINE mark. Among these are:

<u>Mark</u>	<u>Registration No.</u>	<u>Registration Date</u>	<u>Goods</u>
LISTERINE (Stylized)	41,413	November 3, 1903	Liquid chemical or medical preparation manufactured by us under a private formula and more specially known as an antiseptic
LISTERINE (Stylized)	45,682	August 29, 1905	Antiseptic medicinal preparations
LISTERINE (Stylized)	85,150	January 30, 1912	Antiseptic for medicinal use, personal hygiene and toilet
LISTERINE (Stylized)	118,052	August 14, 1917	Toothpaste
LISTERINE	240,162	March 20, 1928	Medicinal, antiseptic compound
LISTERINE	834,258	August 29, 1967	Antiseptic throat lozenges
COOL MINT LISTERINE	1,728,521	October 27, 1992	Antiseptic mouthwash
LISTERINE ESSENTIAL CARE	2,488,147	September 11, 2001	Oral care products, namely toothpaste
LISTERINE POCKETPAKS	2,607,796	August 13, 2002	Non-medicated breath fresheners

Each of the above registrations, except for Registration Nos. 2,488,147 and 2,607,796, is incontestable. Opposer also owns recently filed Application Serial No. 78/852,253 for the mark LISTERINE WHITENING, for pre-brush rinse and tooth whitening products. These registrations and the application are collectively referred to as “the LISTERINE Registrations.” The marks which are the subject of these registrations and the pending application shall be referred to as “the LISTERINE Marks.”

4. The LISTERINE Marks of Opposer are in use in commerce for antiseptic, mouthwash, toothpaste, teeth whitening products and breath fresheners, and this use has been continuous since before the respective dates of registration of or application for the LISTERINE Registrations and back to the dates alleged for first use in each of such registrations or application, all of which registrations long predate the application filing of Quality Brands LLC (“Applicant”) for the mark LISTEREX.

5. Opposer, through its predecessors-in-interest, has prominently and extensively used, promoted and advertised the LISTERINE Marks for many decades through varied promotional and advertising media. On information and belief, promotional activity for the LISTERINE mark would go back for well over a century.

6. As a result of Opposer’s extensive investment and effort in promoting the LISTERINE Marks, the LISTERINE mark has become recognized as a well known mark and, indeed, a famous mark uniquely associated with Opposer. As a consequence, Opposer owns an extremely valuable goodwill represented by the LISTERINE Marks.

7. During a period of over 20 years, beginning in 1971, Opposer, through its predecessors-in-interest, used and registered the mark LISTEREX for a preparation for treating acne and for a skin cleanser. While Opposer’s registrations for the LISTEREX mark expired in

2002, there continue to be references on the Internet to the Opposer's LISTEREX acne treating preparation and skin cleanser – uses reflecting a residual goodwill in the LISTEREX mark for Opposer.

8. Applicant seeks registration of the designation LISTEREX for a “skin cleanser, exfoliating body scrub, skin and facial moisturizer,” in International Class 3.

9. Upon information and belief, Applicant, prior to January 19, 2005, the date that Applicant's intent-to-use application was filed with the Patent and Trademark Office, had made no use of the designation LISTEREX for any of the designated goods in the application or for any other product.

10. Upon information and belief, Applicant, today and at the time Applicant filed its application for LISTEREX, has and had no ongoing business related to the manufacture or sale of skin cleanser products, exfoliating body scrub products or skin and facial moisturizing products, and has and had no contracts or arrangements in place with others to assist Applicant with the manufacture and/or sale of any such products under the LISTEREX mark.

11. Applicant has filed a number of other applications for marks previously owned by various third parties that were well known at one time and where the registrations have subsequently expired. Such applications cover a wide range of products, running the gamut from food items to tennis rackets to window shades to consumer health and hygiene type products.

12. Applicant's alleged mark LISTEREX, which is identical to Opposer's now-expired registered mark LISTEREX, and which is so similar in overall commercial impression to the LISTERINE Marks, is likely, when used for the goods identified in paragraph 8, to cause confusion, or to cause mistake or to deceive, in violation of Section 2(d) of the Trademark Act of 1946, 15 U.S.C. Section 1052(d).

13. Opposer is not connected in any way with the Applicant or the intended use by Applicant of the alleged mark LISTEREX.

14. Opposer's fanciful LISTERINE Marks are of sufficient fame and have a sufficient reputation among consumers that when Applicant's alleged LISTEREX mark is used for a skin cleanser, exfoliating body scrub or skin and facial moisturizer, a connection with Opposer will be presumed by consumers.

15. Upon information and belief, Applicant's use of the alleged mark LISTEREX will falsely suggest a connection with Opposer.

16. Opposer's LISTERINE mark is famous and was famous at the time Application Serial No. 78/549,688 was filed and, on information and belief, Applicant's alleged LISTEREX mark is likely to dilute the distinctive quality of Opposer's LISTERINE mark, to Opposer's detriment.

17. The registration of Applicant's alleged LISTEREX mark would be inconsistent with Opposer's rights under its aforementioned registrations and the common law, and would be damaging to Opposer.

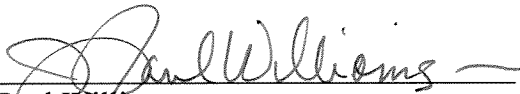
18. Upon information and belief, Applicant did not have the requisite bona fide intention to use the alleged mark LISTEREX at the time Application Serial No. 78/549,688 was filed.

WHEREFORE, Opposer requests that Application Serial No. 78/549,688 be rejected, that no registration be issued on that application, and that this opposition be sustained in favor or Opposer.

Respectfully submitted,

Warner-Lambert Company LLC

Date: 6-5-06

By: 

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