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Filing date: **02/14/2007**

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

Proceeding	91173697
Party	Plaintiff Barr Laboratories, Inc. Barr Laboratories, Inc. Barr Laboratories, Inc. 223 Quaker Road, P.O. Box 2900 Pomona, NY 10970 UNITED STATES
Correspondence Address	Tracy-Gene G. Durkin Sterne, Kessler, Goldstein & Fox PLLC 1100 New York Avenue, NW Washington, DC 20005 UNITED STATES tdurkin@skgf.com, jshirk@skgf.com
Submission	Other Motions/Papers
Filer's Name	Tracy-Gene G. Durkin
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Signature	/Tracy Durkin/
Date	02/14/2007
Attachments	1710756opt0.pdf (8 pages)(361071 bytes)

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

Barr Laboratories, Inc.,

Opposer,

v.

W.M. Barr & Company, Inc.,

Applicant.

Opposition No.: 91173697
U.S. Appl. Serial No.: 78/256,902

Request to Consider and Enter Amendment

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Madam:


On October 30, 2006, Opposer filed a Notice of Opposition against U.S. Application Serial No. 78/256,902 for the mark BARR and design ("the application"), to W.M. Barr & Company, Inc., Applicant. The Notice of Opposition was limited to the goods in International Class 5. The Opposition was instituted by the Trademark Trial and Appeal Board (TTAB) on November 1, 2006.

As listed in the attached TARR print-out, Applicant electronically filed an amendment in the application on October 30, 2006 (the same date of filing as Opposer's Notice of Opposition). In it, Applicant seeks to amend the identification of goods in International Class 5 from "house mark for fungicides, herbicides, disinfectants; insecticides; pesticides" to "house mark for household, commercial and industrial fungicides, herbicides, disinfectants, insecticides, pesticides." As of this date, it does not appear that the amendment has been considered by the Examining Attorney assigned to the application or the TTAB.

Inasmuch as the amendment is limiting in nature and resolves the dispute encompassed by the Notice of Opposition, Opposer hereby consents to the amendment, and requests that the same be considered and entered in the application.

Service upon Applicant of this Request to Consider and Enter Amendment is made on same date, via email, to Applicant's attorney of record.

Date: February 14, 2007

By: 
Tracy-Gene G. Durkin
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 New York Avenue, NW
Washington, D.C. 20005-3934
(202) 371-2600

Attorneys for Opposer
Barr Laboratories, Inc.

641703v1

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

This page was generated by the TARR system on 2007-02-13 15:14:00 ET

Serial Number: 78256902 Assignment Information

Registration Number: (NOT AVAILABLE)

Mark



(words only): BARR

Standard Character claim: No

Current Status: An opposition is now pending at the Trademark Trial and Appeal Board.

Date of Status: 2006-11-01

Filing Date: 2003-06-02

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 107

Attorney Assigned:
ENGEL MICHAEL L Employee Location

Current Location: 650 -Publication And Issue Section

Date In Location: 2006-03-22

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. W.M. Barr & Company, Inc.

Address:

W.M. Barr & Company, Inc.
2105 Channel Avenue
Memphis, TN 38113
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Tennessee

GOODS AND/OR SERVICES

International Class: 001

Class Status: Active

House mark for chemicals used in industrial, commercial and residential settings, namely, chemicals used in wood finishes, protectants and restorers, deck and other wood stains, water proofing agents, toner, paint thinners, solvents and removers of chemical agents, varnishes and stains, lacquers, preservatives against rust and against deterioration of wood, colorants, blend of resins and waxes for use on wood floors, varnish thinners, shellac thinners, lacquer thinners, turpentine substitutes for use as a thinner and brush cleaner for oil based paints, varnish and stains, methyl ethyl ketone substitutes for use as a thinner, cleaner and remover for coatings such as polyurethane, paint and baked on enamel, resins and adhesives, xylene substitutes for use as a thinner of oil based paint, lacquer, varnish and adhesives, toluol substitutes for use as a thinner of oil based paint, lacquer, varnish and adhesives, naphtha substitutes for use as a thinner of oil based paint, lacquer, varnish, enamel and adhesives, metal conditioners for use in ensuring good adhesion of paint to treated metal surfaces and in inhibiting the formation of new rust under finishes on iron and steel, linseed oil for use in improving the flow and gloss of oil based paint and as a finish for natural wood which seals and protects, denatured alcohol for use in thinning shellac and cleaning brushes, water proofing agents, waterproofing sealer coatings, coatings, namely, coatings for paint spray booth surfaces, wood preservatives for industrial and residential use, coatings, namely, concrete protectors and waterproofing sealers for exterior use, metal refinishers, namely refurbishers for solid brass, copper and bronze, coatings, namely coatings for brass and blackboards, primer, sealers and paint thinners for use in thinning oil based paint and varnish, in cleaning brushes, and degreasing tools and equipment, shellac thinners for use in thinning shellac, lacquer thinners for use in thinning lacquer, turpentine gum spirits for use as a thinner and brush cleaner for oil based paints, turpentine substitutes for use as a thinner and brush cleaner for oil based paints, varnish and stains, mineral spirits for use in thinning oil based paint and varnish, and for cleaning brushes, and linseed oil for improving the flow and gloss of exterior oil based paint as a finish for natural wood which seals and protects

Basis: 1(a)

First Use Date: 1946-12-31

First Use in Commerce Date: 1946-12-31

International Class: 002

Class Status: Active

House mark for wood finishes, protectants and restorers, deck and other wood stains, paint toner, paint thinners, solvents and removers of chemical agents, varnishes and stains, paint brush cleaner, lacquers, preservatives against rust and against deterioration of wood, colorants, blend of resins and waxes for use on wood floors, varnish thinners, shellac thinners, lacquer thinners, mask and peel spray booth coating, turpentine substitutes for use as a thinner and brush cleaner for oil based paints, varnish and stains, methyl ethyl ketone substitutes for use as a thinner, cleaner and remover for coatings such as polyurethane, paint and baked on enamel, resins and adhesives, xylene substitutes for use as a thinner of oil based paint, lacquer, varnish and adhesives, toluol substitutes for use as a thinner of oil based paint, lacquer, varnish and adhesives, naphtha substitutes for use as a thinner of oil based paint, lacquer, varnish, enamel and adhesives, metal conditioners for use in ensuring good adhesion of paint to treated metal surfaces and in inhibiting the formation of new rust under finishes on iron and steel, linseed oil for use in improving the flow and gloss of oil based paint and as a finish for natural wood which seals and protects, denatured alcohol for use in thinning shellac and cleaning brushes, waterproofing sealer coatings, coatings, namely, coatings for paint spray booth surfaces, wood preservatives for industrial and

residential use, coatings, namely, concrete protectors and waterproofing sealers for exterior use, metal refinishers, namely refurbishers for solid brass, copper and bronze, coatings, namely coatings for brass and blackboards, primer, sealers and paint thinners for use in thinning oil based paint and varnish, in cleaning brushes, and degreasing tools and equipment, shellac thinners for use in thinning shellac, turpentine gum spirits for use as a thinner and brush cleaner for oil based paints, turpentine substitutes for use as a thinner and brush cleaner for oil based paints, varnish and stains, mineral spirits for use in thinning oil based paint and varnish, and for cleaning brushes, and linseed oil for improving the flow and gloss of exterior oil based paint as a finish for natural wood which seals and protects

Basis: 1(a)

First Use Date: 1946-12-31

First Use in Commerce Date: 1946-12-31

International Class: 003

Class Status: Active

House mark for household and industrial cleaning products, cleaning preparations and solvents, polishing preparations, soaps, removers, strippers, and cleaners of paint, varnish, lacquer, shellac, stain, polyurethane and other finishes and clear coatings, all purpose removers, namely, remover of adhesives, tar, lipstick, grease, rust, resins, inks, wax, chewing gum, contact cement, oil stains and sticky residue, cleaning and bleaching preparations for use on concrete, stucco, wood and other related surfaces, wallpaper removing preparations; liquid deglosser preparations for cleaning and deglossing to make new paint stick to existing paint, brass cleaners and tarnish removers, cleaning preparations and surface preparations for industrial and residential use, namely, brush and roller cleaners, paint cleaners, pre-paint cleaners, driveway and patio cleaners, masonry cleaners, mildew removers, hand cleaners, all-purpose cleaners not for use on wood floors, wood cleaners not for use on wood floors, metal parts cleaners, brake cleaners, engine cleaners, carburetor choke cleaners, and automotive paint removers, remover preparations, namely, sprayable paint removers, chemical products used to clean a variety of surfaces, including metal, wood, synthetics and skin, automobile care products, namely car polish treatment and car wash concentrate, rinse agent to prevent drying spots in cleaning applications, surface preparations for industrial and residential use, namely, afterwash for first removing the paint remover residues and secondly cleaning the stripped surface by dissolving traces of paint remover and old finish, liquid sanding preparations, rust remover, general purpose wax and grease remover for use prior to sanding and priming automobile exterior, first step wax and grease remover used prior to sanding and priming automobile exterior, general purpose aerosol wax and grease remover for use prior to sanding and priming automobile exterior, bumper paint stripper, bumper sticker remover, graffiti remover, fiberglass paint stripper, glass cleaner, mildew stain remover, multi wash surface preparation for painting, pre-paint cleaner and degreaser, liquid sander, and surface deglosser

Basis: 1(a)

First Use Date: 1946-12-31

First Use in Commerce Date: 1946-12-31

International Class: 004

Class Status: Active

House mark for fuels and surface preparations for bonding coatings to surface, namely, fuels for stoves, space heaters, and lamps; kerosene, alcohol fuel for use for marine stoves, rust converter, aerosol adhesion promoter for paint, liquid adhesion promoter for paint, gum and adhesive promoter

Basis: 1(a)

First Use Date: 1946-12-31

First Use in Commerce Date: 1946-12-31

International Class: 005

Class Status: Active

house mark for fungicides, herbicides, disinfectants; insecticides; pesticides

Basis: 1(b)

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

International Class: 008

Class Status: Active

hand tools, namely, paint scrapers

Basis: 1(a)

First Use Date: 1946-12-31

First Use in Commerce Date: 1946-12-31

International Class: 009

Class Status: Active

protective work gloves used for refinishing and paint stripping

Basis: 1(a)

First Use Date: 1946-12-31

First Use in Commerce Date: 1946-12-31

International Class: 021

Class Status: Active

Tack rags for removing dust and foreign matter from surfaces; abrasive pads and stripping brush

Basis: 1(a)

First Use Date: 1946-12-31

First Use in Commerce Date: 1946-12-31

ADDITIONAL INFORMATION

Design Search Code(s):

26.09.03 - Incomplete squares; Squares, incomplete

26.09.21 - Squares that are completely or partially shaded

26.17.09 - Bands, curved; Bars, curved; Curved line(s), band(s) or bar(s); Lines, curved

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2006-11-01 - Opposition instituted for Proceeding

2006-10-30 - TEAS Response to Office Action Received

2006-05-31 - Extension Of Time To Oppose Received

2006-05-02 - Published for opposition

2006-04-12 - Notice of publication

2006-03-13 - Law Office Publication Review Completed

2006-03-10 - Assigned To LIE

2006-03-08 - Approved for Pub - Principal Register (Initial exam)

2006-03-08 - Examiner's amendment mailed

2006-03-07 - Examiner's Amendment Entered

2006-03-07 - Examiners Amendment - Written

2006-02-28 - Previous allowance count withdrawn

2006-02-21 - Withdrawn From Pub - Og Review Query

2006-01-30 - Law Office Publication Review Completed

2006-01-23 - Assigned To LIE

2005-12-29 - Examiner's Amendment Entered

2005-12-29 - Approved for Pub - Principal Register (Initial exam)

2005-12-28 - Examiner's Amendment Entered

2005-12-27 - Examiner's amendment mailed

2005-12-26 - Examiners Amendment - Written

2005-12-23 - Examiner's Amendment Entered

2005-12-22 - Examiner's amendment mailed

2005-12-22 - Examiners Amendment - Written

2005-11-09 - Teas/Email Correspondence Entered

2005-11-04 - Communication received from applicant

2005-11-04 - TEAS Response to Office Action Received

2005-05-04 - Final refusal mailed

2005-05-03 - Final Refusal Written

2005-04-16 - Teas/Email Correspondence Entered

2005-03-18 - Communication received from applicant

2005-03-18 - TEAS Response to Office Action Received

2004-09-20 - Non-final action mailed
2004-09-20 - Non-Final Action Written
2004-09-17 - Assigned To Examiner
2004-09-17 - Assigned To LIE
2004-09-16 - Petition To Revive-Granted
2004-05-19 - Petition To Revive-Received
2004-05-27 - Abandonment - Failure To Respond Or Late Response
2004-05-24 - PAPER RECEIVED
2004-05-19 - Communication received from applicant
2004-05-19 - FAX RECEIVED
2003-11-18 - Non-final action mailed
2003-11-10 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Lea Hall Speed

Correspondent

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