

ESTTA Tracking number: **ESTTA120476**

Filing date: **01/19/2007**

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 parties oppose registration of the indicated application.

### Opposers Information

Name	O Beverages, LLC
Granted to Date of previous extension	01/21/2007
Address	45 Dunster Street Cambridge, MA 02138 UNITED STATES

Name	O Waters LLC
Granted to Date of previous extension	01/21/2007
Address	1740 West Broadway Rd Mesa, AZ 85202 UNITED STATES

Attorney information	Erik Bertin Dechert LLP Cira Centre, 2929 Arch Street Philadelphia, PA 19104-2808 UNITED STATES erik.bertin@dechert.com Phone:202.261.3407
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### Applicant Information

Application No	78386337	Publication date	07/25/2006
Opposition Filing Date	01/19/2007	Opposition Period Ends	01/21/2007
Applicant	Biota Brands of America, Inc. P.O. Box 2812 Telluride, CO 81435 UNITED STATES		

### Goods/Services Affected by Opposition

Class 032. First Use: 2004/03/17 First Use In Commerce: 2004/03/17  
All goods and services in the class are opposed, namely: Mineral waters, spring waters, drinking waters, bottled waters, fruit juices, and enhanced waters

Attachments	OWaters.pdf ( 7 pages )(273539 bytes )
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Signature	/tad/
Name	Terence A. Dixon

Date	01/19/2007
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Biota Brands of America, Inc.

Mark: O and Design

Serial No.: 78/386,337

Published in the *Official Gazette* of  
July 25, 2006

O WATERS, LLC and O BEVERAGES, LLC	:	
	:	
Opposers,	:	
	:	
v.	:	Opposition No.
	:	
BIOTA BRANDS OF AMERICA, INC.	:	
	:	
Applicant.	:	

NOTICE OF OPPOSITION

Applicant, Biota Brands of America, Inc., a Colorado corporation with offices at P.O. Box 2812, Telluride, CO 81435 (“Applicant”) is seeking to register O and Design (Serial No. 78/386,337) as a mark for “mineral waters, spring waters, drinking waters, bottled waters, fruit juices, and enhanced waters” in International Class 32 on the Principal Register of the U.S. Patent and Trademark Office. This application was filed on March 17, 2004 and was published in the *Official Gazette* of July 25, 2006.

Opposers, O Waters, LLC, a Delaware limited liability company with offices at 1740 West Broadway Road, Mesa, AZ 85202 (“O Waters”), and O Beverages, LLC, a Delaware limited liability corporation with offices at 45 Dunster Street, Cambridge, MA 02138 (“O Beverages,” O Waters and O Beverages are referred to collectively as “Opposers”) believe that

they will be damaged by the registration of the mark shown in Application Serial No. 78/386,337, and therefore oppose registration.

The grounds for this opposition are as follows:

1. O Waters sells drinking water products in the United States, via home and office delivery, under the marks O, O PREMIUM WATERS, and various other O formative marks. O Waters uses O WATERS as the trade name for its business in the United States.

2. O Waters licenses its various O marks to O Beverages, which uses the O and O formative marks on its bottled water products sold in retail outlets in the United States. O Beverages uses O BEVERAGES as the trade name for its business in the United States.

3. On December 5, 2002, O Waters filed an application with the U.S. Patent and Trademark Office to register O PREMIUM WATERS on the Principal Register for “retail services by direct solicitation by sales agents in the field of water” in International Class 35. This application was designated as Serial No. 76/472,601 and was published for opposition on October 14, 2003. This application matured into a registration, which was designated Registration No. 2,801,988 and issued on January 6, 2004.

4. On December 5, 2002, O Waters filed an application with the U.S. Patent and Trademark Office to register PREMIUM O PURIFIED WATER and Design on the Principal Register for “drinking water” in International Class 32. This application was designated as Serial No. 76/472,600 and was published for opposition on January 4, 2005. This application matured into a registration, which was designated Registration No. 2,935,693 and issued on March 29, 2005.

5. On December 5, 2002, O Waters filed an application with the U.S. Patent and Trademark Office to register PREMIUM O ELECTRO-LITE WATER and Design for

“nutritionally fortified water” in International Class 5. This application was designated as Serial No. 76/472,605 and was published for opposition on January 4, 2005. This application matured into a registration, which was designated Registration No. 2,935,694 and issued on March 29, 2005.

6. O Waters is also the owner of the federal registrations of the marks TAKE THE O PREMIUM WATERS CHALLENGE (Registration No. 3,049,761) for “home and office delivery of water” in International Class 39, and two design marks consisting of a water drop in an oval circle for “bottled water” in International Class 32 (Registration No. 3,028,610) and “home and office delivery of water” in International Class 39 (Registration No. 3,023, 615).

7. On January 26, 2005, O Waters filed an application with the U.S. Patent and Trademark Office to register O on the Principal Register for “bottled water” in International Class 32. This application, which claims first use in commerce at least as early as April 2001, was designated as Serial No. 78/554,417. This application has been suspended pending the disposition of Applicant’s application Serial No. 78/386,337.

8. On January 26, 2005, O Waters filed an application with the U.S. Patent and Trademark Office to register O on the Principal Register for “home and office delivery of bottled water” in International Class 39 and “retail store services featuring bottled water and delivery” in International Class 35. This application, which claims first use in commerce at least as early as April 2001, was designated as Serial No. 78/554,262. This application has been suspended pending the disposition of Applicant’s application Serial No. 78/386,337.

9. O Waters is also the owner of the pending federal applications of the marks PREMIUM O ANTIOXIDANT WATER and Design (Serial No. 76/472,602) for “nutritionally supplemented water” in International Class 5, PREMIUM O GLUCOSAMINE WATER and

Design (Serial No. 76/472,603) for “nutritionally supplemented water” in International Class 5 and PREMIUM O SLIMMING WATER and Design (Serial No. 76/472,694) for “nutritionally supplemented water” in International Class 5.

10. On March 17, 2004, Applicant filed an application under Section 1(b) of the Trademark Act to register the mark O and Design for “mineral waters, spring waters, drinking waters, bottled waters, fruit juices, and enhanced waters” in International Class 32 on the Principal Register. The application was designated Serial No. 78/386,337.

11. On October 26, 2004, Applicant filed an Amendment to Allege Use (15 U.S.C. Section 1051(c)) for application Serial No. 78/386,337 alleging use of the mark in commerce “on or in connection with all goods and/or services listed in the application” since at least as early as March 17, 2004.

12. The declaration supporting the Amendment to Allege Use for application Serial No. 78/386,337 was signed by Jill J. Chalmers, as attorney for Applicant, and was dated October 26, 2004. On information and belief, Jill J. Chalmers is an attorney with the firm of Holmes Robert Owen LLP.

13. The specimen included with the Amendment to Allege Use for application Serial No. 78/386,337 was a photograph of the back of a bottle of spring water. The specimen shows a reflection of the letter O that is part of the full BIOTA mark that appears on the front of the bottle. The mark O and Design does not appear on its own in the specimen.

14. On information and belief, as of March 17, 2004, Applicant was not using the mark O and Design in commerce in the United States as a stand-alone mark separate from the BIOTA mark.

15. On information and belief, Applicant has never used the mark O and Design in commerce in the United States as a stand-alone mark separate from the BIOTA mark.

16. On information and belief, as of March 17, 2004, Applicant was not using the mark O and Design in commerce in the United States on all the goods that were included in the identification of goods in application Serial No. 78/386,337.

17. On information and belief, Applicant has never used the mark O and Design in commerce in the United States on all the goods that were included in the identification of goods in application Serial No. 78/386,337.

18. On information and belief, Applicant has never used the mark O and Design in commerce in the United States on “fruit juices” or “enhanced waters.”

19. On information and belief, Applicant has never used the mark O and Design in commerce in the United States on “enhanced waters.”

20. On information and belief, Applicant submitted a false Amendment to Allege Use for application Serial No. 78/386,337.

21. Applicant’s submission of a false Amendment to Allege Use for application Serial No. 78/386,337 constitutes fraud on the Patent and Trademark Office. Such fraud would render any resulting registration void ab initio in its entirety..

22. Since Applicant submitted a false Amendment to Allege Use, registration of application Serial No. 78/386,337 should be refused.

23. The filing dates of O Water’s registrations of O PREMIUM WATERS (Registration No. 2,801,988), PREMIUM O PURIFIED WATER and Design (Registration No. 2,935,693), PREMIUM O ELECTRO-LITE WATER and Design (Registration No. 2,935,694),

and water drop in oval designs (Registration Nos. 3,023,615 and 3,028,610) preceded the filing date of Applicant's intent-to-use application to register O and Design (Serial No. 78/386,337).

24. The dates of first use in commerce claimed in O Water's applications for O (Serial Nos. 78/554,262 and 78/554,417) precede the filing date and the date of first use in commerce claimed in Applicant's application to register O and Design (Serial No. 78/386,337).

25. Applicant's O and Design mark is visually, phonetically and aurally similar to Opposers' O and O formative marks.

26. Applicant is seeking to register a mark that is similar to Opposers' marks and that covers goods in Class 32 that are identical or closely related to the goods and/or services for which Opposers use their marks.

27. The goods for which Applicant is seeking registration of its O and Design mark are identical or closely related to goods and/or services covered by O Water's Registration Nos. 3,049,761; 3,028,610; 3,023,615; 2,935,693; 2,801,988 and 2,935,694 and application Serial Nos. 78/554,262; 78/554,417; 76/472,602; 76/472,603 and 76/472,604.

28. On information and belief, the goods identified in the Application will be sold through the same channels of trade as the goods and/or services covered by O Water's Registration Nos. 3,049,761; 3,028,610; 3,023,615; 2,935,693; 2,801,988 and 2,935,694 and application Serial Nos. 78/554,262; 78/554,417; 76/472,602; 76/472,603 and 76/472,604.

29. On information and belief, the goods identified in Applicant's application Serial No. 78/386,337 will be sold to the same or a similar class of consumers as the goods and/or services covered by O Water's Registration Nos. 3,049,761; 3,028,610; 3,023,615; 2,935,693; 2,801,988 and 2,935,694 and application Serial Nos. 78/554,262; 78/554,417; 76/472,602; 76/472,603 and 76/472,604.



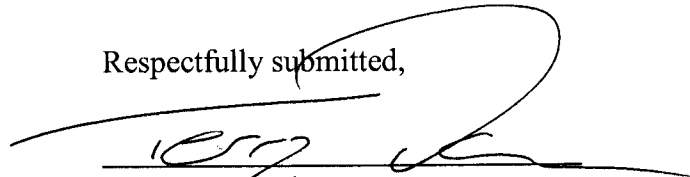
30. Applicant's use of O and Design in connection with the goods in Class 32 set forth in its application is likely to falsely suggest a connection with Opposers, or to cause confusion or mistake or to deceive or to create the false impression that Applicant's goods are related to, associated with, or endorsed by Opposers, all to the injury of Opposers' rights in their marks and their reputations and identities.

31. Applicant's use of O and Design in connection with the goods in Class 32 set forth in its application Serial No. 78/386,337 falsely suggests a connection with Opposers.

32. In light of the foregoing, Applicant's registration and use of O and Design in connection with the products specified in Applicant's application Serial No. 78/386,337 is likely to cause confusion or mistake or to deceive, or to create the false impression that Applicant's goods are provided by, related to, endorsed by, or associated with Opposers, or otherwise cause injury to Opposers' rights in their marks and their reputations and identities.

WHEREFORE Opposers pray that Application Serial No. 78/386,337 be refused registration and that this opposition be sustained.

Respectfully submitted,



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Attorneys for Opposers,  
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Dated: January 19, 2007

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