

ESTTA Tracking number: **ESTTA211913**

Filing date: **05/15/2008**

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	WD-40 Manufacturing Company
Granted to Date of previous extension	05/21/2008
Address	1061 Cudahy Street San Diego, CA 92110 UNITED STATES

Correspondence information	Kathleen A. Pasulka Attorney of Record Procopio Cory Hargreaves & Savitch LLP 530 B Street, Suite 2100 San Diego, CA 92101 UNITED STATES docketing@procopio.com, glj@procopio.com Phone:6195253827
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**Applicant Information**

Application No	77251231	Publication date	01/22/2008
Opposition Filing Date	05/15/2008	Opposition Period Ends	05/21/2008
Applicant	Wick Jacobi Design Group, Inc. 118 E. Fisher Ave Greensboro, NC 27401 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 003. All goods and services in the class are opposed, namely: Cologne; Perfume
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**Grounds for Opposition**

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	1007258	Application Date	06/21/1974
Registration Date	03/25/1975	Foreign Priority Date	NONE

Word Mark	WD-40
Design Mark	
Description of Mark	NONE
Goods/Services	Class 004. First use: First Use: 1957/01/07 First Use In Commerce: 1957/05/10 LUBRICATING OIL AND PENETRATING OIL

U.S. Registration No.	3010487	Application Date	04/18/2003
Registration Date	11/01/2005	Foreign Priority Date	NONE
Word Mark	WD-40		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 004. First use: First Use: 1963/07/00 First Use In Commerce: 1963/07/00 LUBRICATING OIL AND PENETRATING OIL		

U.S. Registration No.	670503	Application Date	04/30/1958
Registration Date	12/02/1958	Foreign Priority Date	NONE
Word Mark	WD-40		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U016 (International Class 002). First use: First Use: 1957/01/07 First Use In Commerce: 1957/05/10 RUST PREVENTION AND CORROSION CONTROL, PROTECTIVE AND DECORATIVE COATINGS		

Attachments	78239699#TMSN.jpeg ( 1 page )( bytes ) glj notice opp wd40.pdf ( 6 pages )(108428 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/kap/
Name	Kathleen A. Pasulka
Date	05/15/2008

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

In the Matter of Application Serial No. 77/251,231: 10W40.

Published in the Official Gazette of January 22, 2008

WD-40 MANUFACTURING COMPANY,	)	Opposition No. _____
	)	
Opposer,	)	
	)	Application Serial No. 77/251,231
vs.	)	Filing Date: August 9, 2007
	)	Published: January 1, 2008
WICK JACOBI DESIGN GROUP, INC.	)	Trademark: 10W40
	)	Classes Opposed: 03
Applicant.	)	
	)	
	)	
	)	

**NOTICE OF OPPOSITION**

WD-40 Manufacturing Company, a California Corporation, with an address of 1061 Cudahy Place San Diego, CA 92110 (“**Opposer**”), by its attorneys, hereby opposes registration of the mark “10W40”, filed by Wick Jacobi Design Group, Inc. (“**Applicant**”), which mark is the subject of application Serial No. 77/251,231, published January 1, 2008 (Class 03), and requests that registration of the application be refused.

The above-identified Opposer believes that it will be damaged by registration of the mark shown in the above-identified application, and hereby opposes the same and requests that registration to Applicant be refused.

As grounds in support of its opposition, Opposer asserts as follows:

1. Opposer, long prior to the intent-to-use filing date of Applicant's mark, has continuously used the marks "WD-40" and "WD-40 Design" ("Opposer's marks") worldwide, including but not limited to the United States, for household oils, lubricating oils, motor oils, penetrating oils and cleaning preparations for rust prevention.

2. Opposer is the owner of Registration Numbers 670,503, 1,007,258 and 3,010,487 (design mark) for household oils, lubricating oils, motor oils, dry lubricants penetrating oils, rust preventing oils, cleaning preparations for use on metal surfaces, and protective and decorative coatings. All of Opposer's aforesaid registrations are valid and subsisting, and the two word marks are incontestable.

3. Applicant has filed an intent-to-use application to register "10W40" for its cologne and perfume. That application was filed on August 9, 2007, and was assigned Serial No. 77/251,231.

4. As a result of the long term, continuous and extensive use of Opposer's marks by Opposer in the United States and elsewhere, Opposer's marks became famous well before the filing date of Applicant's intent-to-use application.

5. Applicant's mark so resembles the previously used and registered Opposer's marks as to be likely, when applied to the goods set forth in Applicant's application, to cause confusion, mistake, or deception within the meaning of Section 2(d) of the Trademark Act.

6. Applicant's mark, when used, also causes dilution of the distinctive quality of Opposer's marks.

7. On information and belief, Opposer avers that: (i) Applicant knew of Opposer's use of the WD-40 Marks as a result of the Opposer's advertising and sales and as a result of Opposer's numerous existing trademarks; (ii) Opposer's rights in the WD-40 Mark are superior to Applicant's rights in his confusingly similar mark; (iii) Applicant knew this to be the case and knew that confusion was likely; and (iv) by failing to disclose the foregoing items (i) through (iii) to the PTO, Applicant intended to obtain a registration to which it is not entitled.

**Count I: Likelihood of Confusion**

8. Opposer hereby incorporates by reference the allegations of Paragraph 1 through 7 hereof as if fully set forth herein.

9. Opposer is currently using and has been using its WD-40 Marks in commerce since 1957. Opposer's rights in the mark WD-40 are prior and superior to any rights that Applicant may claim in, and to that mark, in any form or style.

10. The mark 10W40 depicted in Applicant's 10W40 Application herein opposed is virtually identical in sight, sound, connotation and commercial impression to the mark depicted in Opposer's 10W40 Application.

11. When the mark 10W40 is used in commerce the connotation is that it means "10 weight 40" which makes the consumer think of an oil product which are the types of products sold by Opposer. This connection makes the two marks even more confusing to the consuming marketplace.

12. Accordingly, Applicant's 10W40 mark in Class 03 is likely to cause confusion, mistake or to deceive under § 2(d) of the Lanham Act.

13. If Applicant is permitted to use and register Applicant's 10W40 Mark in Class 03, there likely will be confusion in the relevant markets resulting in damage and injury to Opposer by reason of the similarity between Opposer's WD-40 Marks and Applicant's 10W40 Mark. Persons familiar with Opposer's WD-40 Mark would be likely to avail themselves of Applicant's goods once they start to sell them, believing them to be offered by Opposer. Likewise, persons exposed to Applicant's 10W40 Mark, who subsequently become acquainted with Opposer's 10W40 Mark, are likely to conclude that the goods offered by Opposer, are in some manner related to the goods that Applicant offers under Applicant's 10W40 Mark. Any such confusion inevitably would result in damage and injury to Opposer.

14. Opposer will be damaged by registration of Applicant's 10W40 Mark in Class 03 because such registration will support and assist Applicant in the confusing and misleading use of Applicant's 10W40 Mark, and will give color of rights to Applicant in violation of Opposer's prior and superior rights in the marks WD-40.

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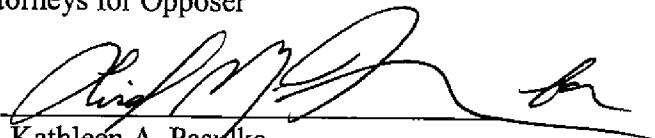
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WHEREFORE, Opposer prays that the Opposition be sustained and that the registration of the application that is the subject of this proceeding be refused.

Dated: May 15, 2008

Respectfully submitted,

Procopio, Cory, Hargreaves & Savitch LLP,  
Attorneys for Opposer

By:   
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**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing **NOTICE OF OPPOSITION** is being mailed on May 15, 2008 by First Class Mail to Applicant's counsel as follows:

Gilbert J. Andia, Jr., Esq.  
Hunter Higgins Miles Elam & Benjamin PLL  
101 W. Friendly Avenue, Suite 500  
Greensboro, North Carolina 27401-2521

Dated: May 15, 2008

By:   
Geena Jackson