

ESTTA Tracking number: **ESTTA238080**

Filing date: **09/22/2008**

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	National Safety Council
Granted to Date of previous extension	09/21/2008
Address	1211 Spring Lake Drive Itasca, IL 60143 UNITED STATES

Attorney information	Hadi S. Al-Shathir Thompson Coburn LLP One US Bank Plaza St. Louis, MO 63101 UNITED STATES hal-shathir@thompsoncoburn.com, ipdocket@thompsoncoburn.com
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### Applicant Information

Application No	77134180	Publication date	03/25/2008
Opposition Filing Date	09/22/2008	Opposition Period Ends	09/21/2008
Applicant	Comprehensive Applied Safety 1 9211 Kendale Drive Houston, TX 77083 UNITED STATES		

### Goods/Services Affected by Opposition

Class 045. First Use: 2005/09/15 First Use In Commerce: 2005/12/01  
All goods and services in the class are opposed, namely: Consultation services in the field of safety needs of commercial and industrial companies

### Grounds for Opposition

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.	2837027	Application Date	07/01/2002
Registration Date	04/27/2004	Foreign Priority Date	NONE
Word Mark	NATIONAL SAFETY COUNCIL		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 016. First use: First Use: 2002/09/00 First Use In Commerce: 2002/09/00 printed publications, namely, pamphlets, leaflets, brochures, catalogs, newsletters, charts, workbooks, posters, safety seals, booklets, training kits, magazines, catalogs and educational and course materials in the fields of safety, health and the environment

U.S. Registration No.	2837029	Application Date	07/01/2002
Registration Date	04/27/2004	Foreign Priority Date	NONE
Word Mark	NATIONAL SAFETY COUNCIL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2002/09/00 First Use In Commerce: 2002/09/00 educational services, namely, conducting classes, seminars and workshops and providing education and training to industry, government and individuals in the fields of health, safety and the environment		

U.S. Registration No.	2942519	Application Date	07/01/2002
Registration Date	04/19/2005	Foreign Priority Date	NONE
Word Mark	NATIONAL SAFETY COUNCIL		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 2002/09/00 First Use In Commerce: 2002/09/00 Promoting the interests of safety, health and the environment through distributing books, films, audio tapes, video tapes and educational training products in connection therewith</p> <p>Class 041. First use: First Use: 2002/09/00 First Use In Commerce: 2002/09/00 Publication of books and production of films, audio tapes and video tapes</p> <p>Class 042. First use: First Use: 2002/09/00 First Use In Commerce: 2002/09/00 Consulting services in the field of product safety and the environment</p> <p>Class 044. First use: First Use: 2002/09/00 First Use In Commerce: 2002/09/00 Consulting services in the field of medical health</p> <p>Class 045. First use: First Use: 2002/09/00 First Use In Commerce: 2002/09/00 Consulting services in the fields of personal safety and job safety</p>		

U.S. Registration No.	510030	Application Date	06/07/1947
Registration Date	05/24/1949	Foreign Priority Date	NONE
Word Mark	GREEN CROSS FOR SAFETY		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class U038 (International Class 016). First use: First Use: 1946/01/02 First Use In Commerce: 1946/01/02 VARIOUS EDUCATIONAL PUBLICATIONS ISSUED FROM TIME TO TIME ON THE SUBJECT OF ACCIDENT PREVENTION INCLUDING PERIODICALS, POSTERS, SAFETY SEALS, AND MISCELLANEOUS ARTICLES
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U.S. Registration No.	527024	Application Date	10/28/1947
Registration Date	06/27/1950	Foreign Priority Date	NONE
Word Mark	GREEN CROSS FOR SAFETY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U107 (International Class 041). First use: First Use: 1946/01/02 First Use In Commerce: 1946/01/02 PREPARATION AND DISTRIBUTION OF EDUCATIONAL MATERIALS DESIGNED TO HELP INDIVIDUALS AND ORGANIZATIONS IN ACCIDENT PREVENTION		

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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	/s/ Hadi S. Al-Shathir
Name	Hadi S. Al-Shathir
Date	09/22/2008

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

NATIONAL SAFETY COUNCIL,	)	
	)	
Opposer,	)	
	)	Opposition No. _____
v.	)	
	)	Directed to U.S. Serial No. 77/134,180
COMPREHENSIVE APPLIED	)	
SAFETY 1,	)	
	)	
Applicant.	)	

**NOTICE OF OPPOSITION**

Opposer National Safety Council (“Opposer”) believes it will be damaged by registration of the mark LEADING TO THE HEART OF SAFETY and Cross in Circle Logo in International Class 045, as shown in U.S. Serial No. 77/134,180, filed by Comprehensive Applied Safety 1, and therefore opposes the registration of that application. As grounds for its opposition, Opposer alleges the following:

**BACKGROUND**

- (1) Opposer is a congressionally chartered non-profit organization with offices at 1211 Spring Lake Drive, Itasca, IL 60143-3201.
- (2) On information and belief, Applicant is a limited liability company organized and existing under the laws of Texas with a place of business at 9211 Kendale Drive, Houston, TX 77083.
- (3) On information and belief, Applicant is the owner of U.S. Trademark Application Serial No. 77/134,180 (“Application”) for the mark LEADING TO THE HEART OF SAFETY and Cross in Circle Logo in International Class 045 for *consultation services in the field of safety needs of commercial and industrial companies* (“Applicant’s Services”).

(4) The Application was published for opposition on March 25, 2008. Opposer has been granted extensions of up to and including September 21, 2008 (a Sunday) to oppose the Application. This Notice of Opposition is therefore timely.

(5) Since 1946, Opposer has continuously used in interstate commerce trademarks comprising a Cross in Circle Logo in connection with providing safety programs and related consulting services.

(6) Opposer owns the following United States trademark registrations for its Cross in Circle Logo marks: U.S. Reg. Nos. 2,837,027; 2,837,029; 2,942,519; 510,030; and 527,024. These registrations are valid and in good standing.

(7) Opposer has promoted and sold its goods and services in interstate and intrastate commerce under its Cross in Circle Logo marks since long prior to any alleged use by Applicant of the mark shown in the Application. As a result of the use, promotion, and advertising of Opposer's Cross in Circle Logo marks, the marks have become well known to the trade and to the public, and have therefore acquired significant goodwill. Opposer's Cross in Circle Logo marks identify and distinguish its goods and services from the goods and services of others, and identify the source and origin of Opposer's goods and services to both the trade and the public.

**COUNT I**  
**(Likelihood of Confusion)**

(8) Opposer re-alleges and incorporates by reference the allegations of paragraphs 1 through 7.

(9) On information and belief, Applicant has made no use of the mark shown in the Application, nor of any word, letter or design confusingly similar thereto, as a trademark or service mark, prior to the date of first use of Opposer's Cross in Circle Logo marks.

(10) Applicant's registration and use of the mark shown in the Application is likely to cause confusion in the minds of the trade and of the public that Applicant's Services emanate from or are licensed, sponsored, or otherwise authorized by Opposer, when in fact they are not.

(11) The mark shown in the Application so resembles Opposer's Cross in Circle marks, previously used in the United States by Opposer, and not abandoned, as to be likely, when applied to Applicant's Services, to cause confusion or to cause mistake or to deceive, and is an attempt to deceive the trade and the public and to benefit from the reputation and goodwill developed by Opposer.

(12) Opposer will be injured and damaged by the registration of the mark shown in the Application because the mark, when applied to Applicant's Services:

- (a) is likely to cause confusion, or to cause mistake, or to deceive;
- (b) falsely suggests a connection with Opposer; and
- (c) will damage Opposer's valuable goodwill in its Cross in Circle Logo

marks.

**COUNT II**  
**(Dilution)**

(13) Opposer re-alleges and incorporates by reference the allegations of paragraphs 1-12.

(14) Opposer's Cross in Circle Logo marks have become famous as that term is defined in 15 U.S.C. § 1125.

(15) Opposer will be injured and damaged by the registration of the mark shown in the Application because the mark, when applied to Applicant's Services:

- (a) will damage Opposer's valuable goodwill in its marks;
- (b) will dilute the distinctive quality of Opposer's famous Cross in Circle

Logo marks.

ACCORDINGLY, Opposer requests that the Opposition be sustained and that registration of the mark shown in the Application be refused.

Opposer authorizes the Commissioner for Trademarks to charge the fee of \$300 to Deposit Account 20-0823 for filing this Notice of Opposition. Opposer believes that no additional fees are due; however, the Commissioner for Trademarks is authorized to debit our Account 20-0823 for any additional fees.

Respectfully submitted,

THOMPSON COBURN LLP

By: /s/ Hadi S. Al-Shathir  
Mark Sableman  
Hadi S. Al-Shathir  
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Attorneys for Opposer National Safety Council

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of this Notice of Opposition was sent via First Class Mail, postage prepaid, this 22<sup>nd</sup> day of September, 2008, to the Applicant at the following address:

Comprehensive Applied Safety 1  
9211 Kendale Drive  
Houston, TX 77083-8011

and to Applicant's counsel at the following address:

Anastassios Triantaphyllis  
Triantaphyllis Law Firm  
The Civil Justice Center  
112 E. 4<sup>th</sup> Street  
Houston, TX 77007

/s/ Hadi S. Al-Shathir