

ESTTA Tracking number: **ESTTA384446**

Filing date: **12/17/2010**

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

Proceeding	91197857
Party	Plaintiff The Procter & Gamble Company
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Date	12/17/2010
Attachments	Oppositon 91197857.pdf (24 pages)(777515 bytes)

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

In the Matter of

Application No. 77/519,722
Applicant Schering-Plough HealthCare Products, Inc.
Mark Miscellaneous Design (shown at right)
Filing Date July 11, 2008
Publication Date August 17, 2010



THE PROCTER & GAMBLE
COMPANY,

Opposer

- v -

SCHERING-PLOUGH HEALTHCARE
PRODUCTS, INC.,

Applicant

Opposition No. _____

NOTICE OF OPPOSITION

The Procter & Gamble Company, a corporation organized and existing under the laws of the State of Ohio, having a principal place of business at One Procter & Gamble Plaza, Cincinnati, Ohio 45202 (hereinafter referred to as "Opposer"), believes that it will be damaged by registration of the mark shown in trademark application Serial No. 77/519,722, filed July 11, 2008, and published for opposition August 17, 2010, and hereby opposes said application.

As grounds for opposition, it is alleged that:

1. Applicant Schering-Plough HealthCare Products, Inc. (hereinafter “Applicant”), filed an application to register a Miscellaneous Design in connection with “laxatives” in International Class 5, alleging February 19, 2007, as a date of first use. The application was filed on July 11, 2008, and was assigned Serial No. 77/519,722 (the “Application”).

2. In the Application as originally filed, Applicant claimed the color pink as a *feature* of a ribbed bottle cap configuration, and described the mark as follows:

The mark consists of in part the configuration of a pink ribbed cap on the container for the goods. The dotted outline of the container for the goods is intended to show the position of the mark and is not part of the mark.

(Emphasis added.) A copy of the drawing submitted with the Application as originally filed is attached as Exhibit A.

3. During prosecution of the Application, Applicant amended its description of the mark such that color became the *essence* of the mark, with the description reading as follows:

The mark consists of the color pink as displayed on the bottle cap on the container for the goods. The bottle cap color is claimed as the mark. The dotted outlines of the container and cap for the goods are intended to show the position of the mark and are not claimed as part of the mark.

(Emphasis added.) A new drawing was also submitted, a copy of which is attached as Exhibit B (the “Amended Application”).

4. Also during prosecution of the Application, Applicant further amended its Application to seek registration of the mark under Section 2(f) of the Trademark Act, 15 U.S.C.

§ 1052(f), on the ground that the mark had acquired distinctiveness as a trademark for Applicant's goods.

5. The Application was approved and published for opposition on August 17, 2010.

A copy of the Application, as published, is attached as Exhibit C.

6. Applicant's claim of rights to a mark as set forth in the Amended Application comprised of the single color pink as applied to the cap for any type of container for the goods is very broad. No limitations are included with respect to the color claim; hence, Applicant's claim of the color pink as a mark encompasses a broad family of related colors of various shades and hues that are recognized as being "pink." See Exhibit D, which shows a number of different shades of the color pink. Further, although Applicant's initial Application was limited to a particular configuration of a bottle cap that included the color pink, the application was amended during prosecution — through what Opposer views to be a material alteration of the mark — to eliminate the particular shape and other structural features of the cap configuration, leaving in the Amended Application a mark which consists of only a claim to the color pink as applied to any bottle cap that serves as a container for the goods. Accordingly, if the Amended Application were to mature into a registration, Applicant would enjoy very broad rights in the color pink in the fields of over-the-counter medications and especially with respect to products related to gastro-intestinal and digestive health.

7. Opposer is now and has for many years been engaged in the manufacture and sale of a wide range of products, including products in the fields of beauty and grooming, health and well-being, and household care. Opposer sells a number of over-the-counter medications and

products related to gastro-intestinal and digestive health. Among these products are well-known brands such as Pepto-Bismol® and Metamucil®.

8. Opposer and its predecessors in interest have manufactured and sold Pepto-Bismol products for more than 100 years. Pepto-Bismol is medicine that relieves five stomach problems: heartburn, nausea, indigestion, upset stomach, and diarrhea. Pepto-Bismol has long been associated with the color pink, and has been sold in bottles featuring either a pink cap or a pink plastic cap overlay. See Exhibit E.

9. Opposer and its predecessors-in-interest have manufactured and sold Metamucil products for more than seventy years. Metamucil is a fiber product used to treat occasional constipation and help lower cholesterol. Metamucil has been sold in containers featuring a pink cap. See Exhibit F.

10. The applied-for mark, as identified in the Amended Application, does not function as a trademark to identify and distinguish Applicant's goods from those of others and/or to indicate the source of Applicant's goods.

11. The color pink is a common color used by various unrelated parties — including but not limited to Opposer — in connection with over-the-counter medications and products related to gastro-intestinal and digestive health and well-being. These products are often sold in the same stores, in the same sections of the stores, and are often displayed in close proximity to one another. The color pink is also common color used by unrelated parties to signify a “women's formulation” and/or a “gentle” remedy. Examples of third party use of the color pink (in various shades and hues) with such products, including caps, are shown in Exhibit G. Because of the widespread use of the color pink in this field, consumers are not likely to rely on

the color pink alone to distinguish one party's goods from those of another. Accordingly, Applicant is not entitled to a registration of the mark depicted in the Amended Application.

12. The mark depicted in the Amended Application is not inherently distinctive. Further, the mark has not acquired distinctiveness as a trademark for Applicant's goods. Applicant has failed to establish that the color pink, as applied to the cap of a container, has been used exclusively by Applicant in the fields of over-the-counter medications and products related to gastro-intestinal and digestive health and well-being, or that consumers have learned to associate a pink cap on containers of such products as emanating from a single source. The evidence of acquired distinctiveness produced by Applicant during prosecution of the application is insufficient to establish that the mark depicted in the Amended Application has acquired distinctiveness under Section 2(f).

13. Upon information and belief, unrelated parties — including but not limited to Opposer — have used and continue to use the color pink for products and packaging, including pink caps, for over-the-counter products and gastro-intestinal and digestive remedies. See Exhibits E, F and G. A number of these uses were prior to Applicant's stated first use of the applied-for mark and/or prior to the date upon which Applicant alleged that the applied-for mark had acquired distinctiveness. These uses show that the use of the color pink for products and product packaging (including for bottle caps) in the fields of over-the-counter medications and products related to gastro-intestinal and digestive health has not been substantially exclusive and was not substantially exclusive either at the time Applicant filed its application or represented to the Trademark Office that the mark had acquired distinctiveness. In light of these uses by other parties, consumers do not (and can not) associate the color pink or pink caps exclusively with

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Applicant, and Applicant cannot reasonably assert that it is the owner of trademark rights in the color pink as applied to bottle caps in the fields of over-the-counter products and gastro-intestinal and digestive remedies, or that pink caps are unique to Applicant in those fields. Accordingly, Applicant is not entitled to a registration of the mark depicted in the Amended Application.

14. If registration of the applied-for mark were to be granted to Applicant, the effect would be to create in Applicant statutory rights under the Trademark Act of 1946, and such registration would restrict, interfere with, and damage Opposer in the unhampered conduct of its business and its legitimate right to use the color pink in connection with over-the-counter medications and products related to gastro-intestinal and digestive health, as well as on the packaging (including caps for bottles) for such goods, and on other goods sold by Opposer related to such products.

WHEREFORE Opposer prays that this opposition be sustained, that the application hereby opposed be rejected, and for such other and further relief as may be deemed appropriate.

Please charge the required fees in this action to Deposit Account No. 16-2488.

Respectfully submitted,

THE PROCTER & GAMBLE COMPANY

By


Rene L. Guess


Attorney for Opposer
The Procter & Gamble Company
299 East Sixth Street, S8-226
Cincinnati, Ohio 45202
Office: (513) 983-2059
Fax: (513) 945-6798

Dated: December 15, 2010

CERTIFICATE OF MAILING

I hereby certify that a true and correct copy of the attached NOTICE OF OPPOSITION, dated December 15, 2010 was served on Applicant by mailing a copy thereof via Federal Express, addressed to Applicant at the following addresses on December 15, 2010:

Sophie B. Anger
Schering Corporation
2000 Galloping Hill Rd
Kenilworth, NJ 07033-1310



Rene LaForte Guess

EXHIBIT A

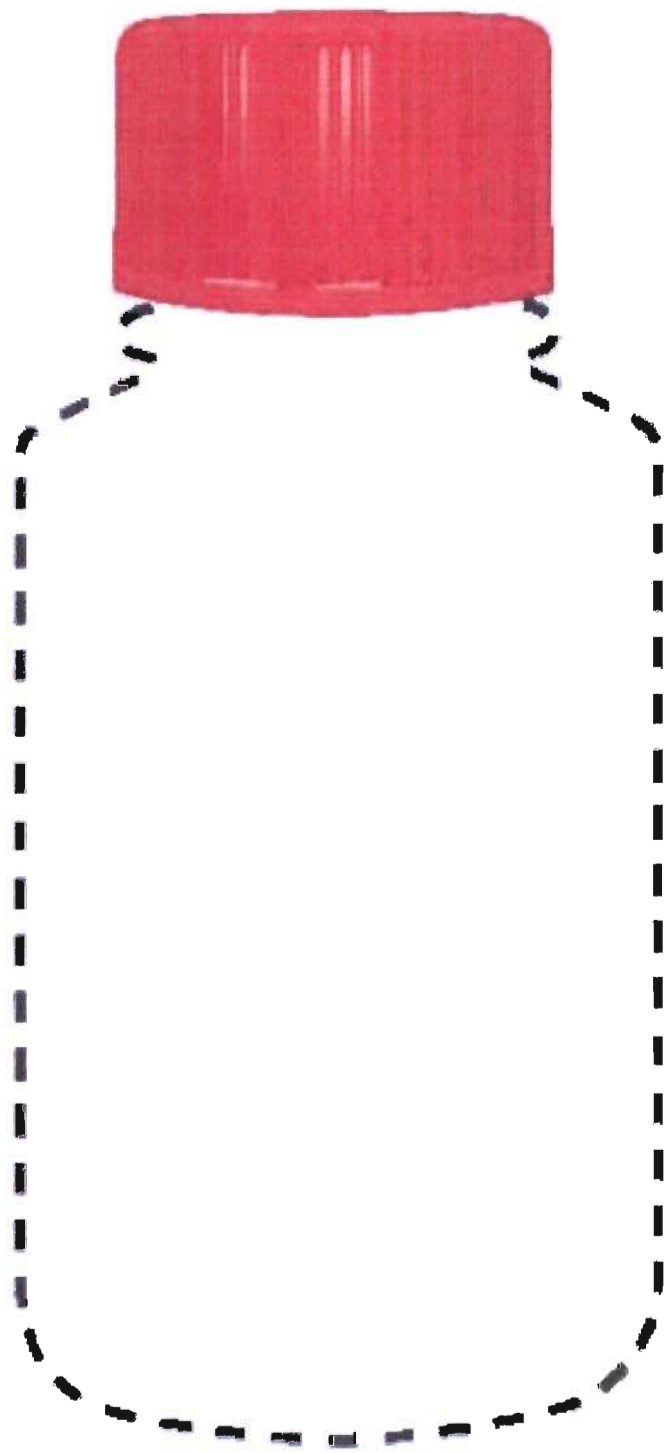


EXHIBIT B

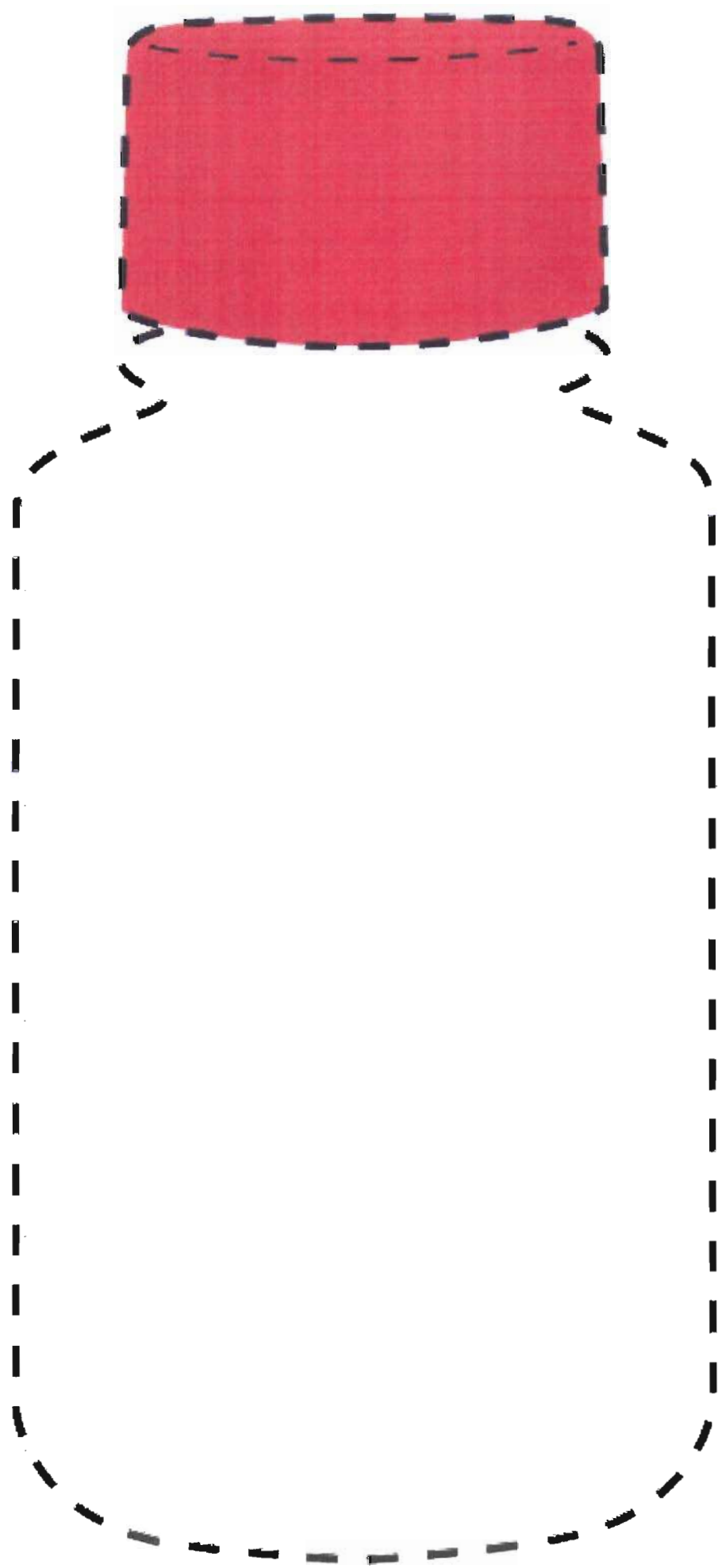


EXHIBIT C

CLASS 5—(Continued).

SN 77-433,477. DAVID KIRSCH WELLNESS CO., INC., NEW YORK, NY. FILED 3-27-2008.

DAVID KIRSCH'S METABOLIC MAKEOVER

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 3,254,704, 3,279,917 AND 3,321,787.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "METABOLIC", APART FROM THE MARK AS SHOWN.

THE NAME(S), PORTRAIT(S), AND OR SIGNATURE(S) SHOWN IN THE MARK IDENTIFIES "DAVID KIRSCH", WHOSE CONSENT(S) TO REGISTER IS SUBMITTED.

FOR DIETARY SUPPLEMENTS; POWDERED PROTEIN NUTRITIONAL SUPPLEMENT DRINK MIX; APETITE SUPPRESSANTS; AND VITAMIN SUPPLEMENTS (U.S. CLS 6, 18, 44, 46, 51 AND 52).

MICHELE SWAIN, EXAMINING ATTORNEY

CLASS 5—(Continued).

SN 77-537,393. DISTRIBUTION NEXXUS INC., MONTREAL, QUEBEC, CANADA. FILED 8-1-2008.



PRIORITY CLAIMED UNDER SEC. 44(D) ON CANADA APPLICATION NO. 1,401,362, FILED 6-27-2008.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "INULIN", APART FROM THE MARK AS SHOWN.

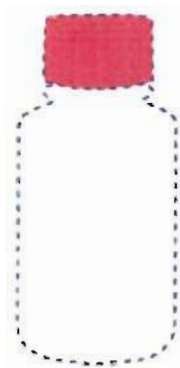
THE MARK CONSISTS OF THE TERMS "INULIN FRUCTANEX" AND THE DESIGN OF 2 CRESCENT SHAPED BANDS.

FOR DIETARY FIBER, NAMELY, INULIN FOR USE AS AN INGREDIENT FOR PROCESSED FOOD PRODUCTS AND INULIN FIBER FOR USE AS A DIETARY SUPPLEMENT (U.S. CLS. 6, 18, 44, 46, 51 AND 52).

FIRST USE 11-0-2009; IN COMMERCE 11-0-2009.

JOHN DALIER, EXAMINING ATTORNEY

SN 77-519,722. SCHERING-PLOUGH HEALTHCARE PRODUCTS, INC., MEMPHIS, TN. FILED 7-11-2008.



THE COLOR(S) PINK IS/ARE CLAIMED AS A FEATURE OF THE MARK.

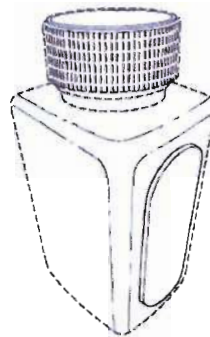
THE MARK CONSISTS OF THE COLOR PINK AS DISPLAYED ON THE BOTTLE CAP ON THE CONTAINER FOR THE GOODS. THE BOTTLE CAP COLOR IS CLAIMED AS THE MARK. THE DOTTED OUTLINES OF THE CONTAINER AND CAP FOR THE GOODS ARE INTENDED TO SHOW THE POSITION OF THE MARK AND ARE NOT CLAIMED AS PART OF THE MARK.

SEC. 2(F).

FOR LAXATIVE (U.S. CLS. 6, 18, 44, 46, 51 AND 52). FIRST USE 2-19-2007; IN COMMERCE 2-19-2007.

GRETCHEN ULRICH, EXAMINING ATTORNEY

SN 77-564,813. THE TYLENOL COMPANY, SOMERVILLE, NJ. FILED 9-8-2008.



THE MARK CONSISTS OF A THREE-DIMENSIONAL CONTOURED CONFIGURATION OF THE PACKAGING FOR THE GOODS, NAMELY, A QUADRILATERAL CONTAINER WITH ROUNDED CORNERS AND EDGES, HAVING SIDE PANELS WIDER THAN THE FRONT AND BACK PANELS; THE FRONT AND SIDE PANELS ARE SLIGHTLY CONVEX AND THE BACK PANEL IS SLIGHTLY CONCAVE; A RAISED OVAL DESIGN ELEMENT APPEARS ON THE FRONT PANEL; A RECESSED OVAL DESIGN ELEMENT OF THE SAME SIZE APPEARS ON THE BACK PANEL; THE MATTER SHOWN IN BROKEN LINES IS NOT PART OF THE MARK AND SERVES ONLY TO SHOW THE POSITION OR PLACEMENT OF THE MARK.

FOR NON-PRESCRIPTION ANALGESICS SOLD OVER-THE-COUNTER (U.S. CLS. 6, 18, 44, 46, 51 AND 52).

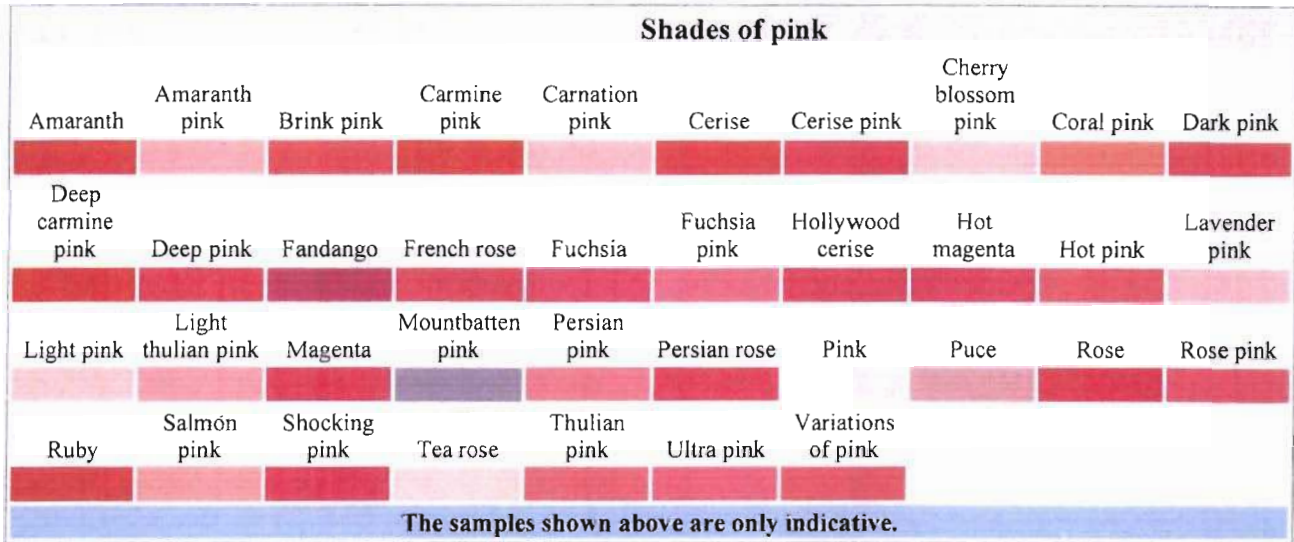
JOHN WILKE, EXAMINING ATTORNEY

EXHIBIT D

Category:Shades of pink

From Wikipedia, the free encyclopedia

Various shades of the color pink.



Pages in category "Shades of pink"

The following 16 pages are in this category, out of 16 total. This list may not reflect recent changes (learn more).

- Template:Shades of pink
- Coral (color)
 - Ruby (color)
- Pink
 - Salmon pink
- User:A2569875/Fast Page/Color
 - Amaranth (color)
 - Variations of magenta
 - Variations of pink
- Carnation pink
 - Cerise (color)
 - Puce
 - Rose (color)

Retrieved from "http://en.wikipedia.org/wiki/Category:Shades_of_pink"

Categories: [Shades of red](#) | [Shades of color](#)

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EXHIBIT E



EXHIBIT F



EXHIBIT G





