

ESTTA Tracking number: **ESTTA443674**

Filing date: **11/29/2011**

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	Paper Street Soap, Ltd.
Granted to Date of previous extension	11/30/2011
Address	731 Arbor Chase Drive Dundee, MI 48131 UNITED STATES

Correspondence information	Paper Street Soap, Ltd. President 731 Arbor Chase Drive Dundee, MI 48131 UNITED STATES kindow@paperstreetsoapltd.com Phone:(734) 528-3556
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Applicant Information

Application No	85258735	Publication date	08/02/2011
Opposition Filing Date	11/29/2011	Opposition Period Ends	11/30/2011
Applicant	Twentieth Century Fox Film Corporation 10201 West Pico Boulevard Los Angeles, CA 90035 UNITED STATES		

Goods/Services Affected by Opposition

Class 003. All goods and services in the class are opposed, namely: Bath soaps; hand soaps; liquid soaps; detergents for household use; hair shampoos and conditioners; shower and bath gel; perfumes and colognes; eau de toilette; lip balm; toothpaste and mouthwashes; bubble bath; bath oil and bath salts; bath powder; lotions for skin, hair, face and body; face and body cream; hair cream; hand cream; sunscreen cream; suntan cream; body spray; hair spray and hair gel; scented room sprays; body and beauty care cosmetics; massage cream; massage lotion; massage oil; shaving cream; shaving foam; shaving gel; shaving lotion; shaving soap
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		

Word Mark	PAPER STREET, PAPER STREET SOAP, PAPER STREET SOAP, LTD.
Goods/Services	Bath soaps; hand soaps; liquid soaps; detergents for household use; hair shampoos and conditioners; shower and bath gel; perfumes and colognes; eau de toilette; lip balm; toothpaste and mouthwashes; bubble bath; bath oil and bath salts; bath powder; lotions for skin, hair, face and body; face and body cream; hair cream; hand cream; sunscreen cream; suntan cream; body spray; hair spray and hair gel; scented room sprays; body and beauty care cosmetics; massage cream; massage lotion; massage oil; shaving cream; shaving foam; shaving gel; shaving lotion; shaving soap.

Attachments	Trademark Appeal.pdf (10 pages)(90659 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	/Kenneth A. Lindow/
Name	Paper Street Soap, Ltd.
Date	11/29/2011

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

Serial Number: 85258735

Paper Street Soap, Ltd. v. Twentieth Century Fox Film Corporation

Opposition Number:

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information (Plaintiff)

Name: Paper Street Soap, Ltd.

Granted to Date
In Previous Extention: November 30, 2011

Address: 731 Arbor Chase Drive
Dundee, Michigan 48131
United States

Contact Information: Kenneth Lindow
731 Arbor Chase Drive
Dundee, Michigan 48131
klindow@paperstreetsoapltd.com
Phone: (734) 528-3556

Applicant Information (Defendant)

Application Number: 85258735

Publication Date: August 2, 2011

Opposition Filing Date: November 30, 2011

Opposition Period Ends: November 30, 2011

Applicant: TWENTIETH CENTURY FOX FILM CORPORATION
10201 WEST PICO BOULEVARD
LOS ANGELES, CA 90035
UNITED STATES

Applicant's Attorney: TINA M. POMPEY, ESQ.
FOX GROUP LEGAL
PO BOX 900
BEVERLY HILLS, CA 90213-0900
UNITED STATES

Goods / Services Affected by Opposition

IC 003: All goods or services in this class are opposed, namely: Bath soaps; hand soaps; liquid soaps; detergents for household use; hair shampoos and conditioners; shower and bath gel; perfumes and colognes; eau de toilette; lip balm; toothpaste and mouthwashes; bubble bath; bath oil and bath salts; bath powder; lotions for skin, hair, face and body; face and body cream; hair cream; hand cream; sunscreen cream; suntan cream; body spray; hair spray and hair gel; scented room sprays; body and beauty care cosmetics; massage cream; massage lotion; massage oil; shaving cream; shaving foam; shaving gel; shaving lotion; shaving soap.

Attachments	NOTICE OF OPPOSITION PSS_Opposition.pdf (9 pages) (bytes)
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Signature	/KAL/
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Name	Kenneth A. Lindow
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Date	November 30, 2011
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

Paper Street Soap, Ltd.

Opposer,

v.

Twentieth Century Fox Film Corporation

Applicant.

Trademark Application

Mark: Paper Street Soap Co.

Serial Number: 85258735

Filed Date: March 4, 2011

Published Date: August 2, 2011

Opposition Number: _____

NOTICE OF OPPOSITION

Paper Street Soap, Ltd. (Opposer), a Michigan corporation, located and doing business at 731 Arbor Chase Drive, Dundee, Michigan 48131, believes that it will be damaged by registration by Twentieth Century Fox Film Corporation (Applicant) of the mark PAPER STREET SOAP CO or the exclusive use of PAPER STREET (as stated in Applicant's disclaimer) in connection with the products listed in Application Serial Number 85258735 and hereby opposes the same.

As grounds for opposition, Opposer alleges:

1. Twentieth Century Fox Film Corporation filed a trademark application assigned Application Serial Number 85258735 in the United States Patent and Trademark Office (“PTO”) on March 4, 2011 (“the Application”) to register the mark PAPER STREET SOAP CO. generally and the mark PAPER STREET in particular as stated in the Application disclaimer (“the Applicant’s Mark”) for use in connection with providing “Bath soaps; hand soaps; liquid soaps; detergents for household use; hair shampoos and conditioners; shower and bath gel; perfumes and colognes; eau de toilette; lip balm; toothpaste and mouthwashes; bubble bath; bath oil and bath salts; bath powder; lotions for skin, hair, face and body; face and body cream; hair cream; hand cream; sunscreen cream; suntan cream; body spray; hair spray and hair gel; scented room sprays; body and beauty care cosmetics; massage cream; massage lotion; massage oil; shaving cream; shaving foam; shaving gel; shaving lotion; shaving soap” in class IC 003. (“the Applicant’s Goods”).
2. The Application filed by Twentieth Century Fox Film Corporation on March 4, 2011 (“the Applicant’s Filing Date”) was based, Opposer assumes, on the use of the Applicant’s Mark as a fictional business name in the film “Fight Club” released by Twentieth Century Fox Film Corporation on October 15, 1999. It does not appear, after due diligence was performed, that the Applicant has sold any of the Applicant’s Goods under the Applicant’s Mark in the preceding twelve years.
3. Opposer does not believe that the use of the fictional business name “Paper Street Soap Co.” in the film mentioned above constitutes an integral part of the film nor does Opposer attempt to access or utilize knowledge of or notoriety from the film in any way to

- consumers for sales, distribution, marketing, or any other purpose. Indeed, the few consumers with knowledge of the film appear deterred from or disinterested in purchase.
4. The Application for the Applicants Mark was published for opposition in the *Official Gazette* on August 2, 2011. On September 1, 2011, the Opposer timely filed a request for a 30-day extension of time to oppose the Application for Applicant's Mark, which was granted until October 1, 2011. On September 27, 2011, Opposer timely filed a request for a 60-day extension of time to oppose the Application for Applicant's Mark, which was granted until November 30, 2011.
 5. The Opposer is a provider of bar soaps and bath products, including body butters, shower gels, and bubble baths ("Opposer's Goods"), with plans to create additional products in its natural zone of expansion. Opposer has engaged in the sale of Opposer's Goods since filing a Certificate of Assumed Name in Monroe County, Michigan on July 8, 2008. Opposer was established as a Michigan corporation, ID Number 02162X, on October 1, 2008. Since this time, Opposer has actively engaged in the sale of Opposer's Goods through retail, wholesale, and on-line markets, including a website sponsored by the Opposer – www.paperstreetsoapltd.com ("Opposer's Website"). Websites of third parties also mention and include information regarding the Opposer's Goods ("Third Party Websites").
 6. The Opposer has utilized the Trademark Symbol (TM) in conjunction with the words PAPER STREET, PAPER STREET SOAP, and PAPER STREET SOAP, LTD. ("the Opposer's Marks") on Opposer's Goods in commerce since at least as early as January 21, 2009 ("the Opposer's First Use Date"). The Trademark Symbol has at least since the

Opposer's First Use Date been applied on Opposer's Website, labeling, point of sale materials, correspondence, and other materials that are utilized by Opposer. The Opposer's Marks are currently in use in commerce with Opposer's Goods.

7. The Opposer's First Use Date for the Opposer's Marks is earlier than Applicant's use of Applicant's Mark in commerce (the date of which is not identified on Applicant's Application). It appears that no commerce has been conducted of Applicant's Goods under the Applicant's Mark, nor can Opposer identify any intent to use Applicant's Mark in commerce.
8. Under the decision in *Honda Motor Co., Ltd. v. Friedrich Winkelmann*, 90 U.S.P.2d 1660 (TTAB 2009) an applicant who "has not had activities in the U.S. and has not made or employed a business plan, strategy, arrangements, or methods there" and "has not identified channels of trade that will be used in the United States," does not have a bona fide intent to use the mark.
9. The Opposer's First Use Date for the Opposer's Marks is earlier than Applicant's Filing Date for the Applicant's Mark.
10. Applicant's Mark PAPER STREET SOAP CO. or the exclusive use of PAPER STREET (as stated in Applicant's disclaimer) in connection with the products listed in Application Serial Number 85258735 is identical or nearly identical to the Opposer's Marks PAPER STREET, PAPER STREET SOAP, and PAPER STREET SOAP, LTD. The Applicant's PAPER STREET SOAP CO. or the exclusive use of the PAPER STREET Mark (as stated in Applicant's disclaimer) is confusingly similar in sound, meaning, and appearance to the Opposer's PAPER STREET, PAPER STREET SOAP, and PAPER STREET SOAP, LTD. Marks. The Applicant's registration and use of either PAPER

STREET or PAPER STREET SOAP CO. Mark, were Applicant's Goods ever to be commercially available by Applicant under the Applicant's Mark, would likely create confusion, mistake, or deception in the minds of prospective purchasers as to the origin or source of the Opposer's Goods associated with the PAPER STREET, PAPER STREET SOAP, and PAPER STREET SOAP, LTD. Marks.

11. The Applicant's Goods, were Applicant's Goods ever to be commercially available by Applicant under the Applicant's Mark, are closely related to and/or are in the natural zone of expansion of the Opposer's Goods. The Opposer's Goods are advertised and sold on-line on the Opposer's Website and commented upon and reviewed on Third Party Websites, sold as wholesale products to third party retailers, and sold as retail products to the public by the Opposer.
12. The Opposer's Goods and the Applicant's Goods, were Applicant's Goods ever to be commercially available by Applicant under the Applicant's Mark, would travel in the same channels of trade and would be viewed by the same customers. Applicant's Goods, were they ever to be commercially offered under the Applicant's Mark, would therefore be substantially similar to the Opposer's Goods with which the Opposer's Mark is used.
13. Purchasers familiar with the Opposer's Goods are likely to mistakenly believe that the Applicant's Goods, were Applicant's Goods ever to be commercially available by Applicant under the Applicant's Mark, are sponsored by, authorized, endorsed, affiliated, or otherwise approved by the Opposer because the PAPER STREET SOAP CO. or PAPER STREET (as stated in their disclaimer) Mark sought to be registered and theoretically used by the Applicant is identical to or confusingly similar to the Opposer's PAPER STREET, PAPER STREET SOAP, and PAPER STREET SOAP, LTD. Marks.

14. Applicant's use of Applicant's Mark would be an infringement upon Opposer's use of Opposer's Mark, as prior use in trade by Opposer is established, and would violate Opposer's use of Opposer's Mark and Applicant's Applications under guidelines of the Lanham Act 15 USC 1051.
15. For the foregoing reasons, Opposer believes that it would be damaged by the granting of registration of Applicant's Mark to the Applicant.
16. WHEREFORE, Opposer respectfully requests that registration of the mark shown in the Application Serial Number 85258735 be refused and that this Opposition be sustained in favor of the Opposer.

DATED: November 30, 2011

KENNETH A. LINDOW

Paper Street Soap, Ltd.

731 Arbor Chase Drive

Dundee, Michigan 48131

Telephone: (734) 528-3556

____/Kenneth A. Lindow/____

KENNETH A. LINDOW

President

Paper Street Soap, Ltd.

EXHIBIT A

Extension of Time

Number: 85258735

Filing Date: 09/01/2011

Status: Not Instituted

Status Date: 09/01/2011

Opposition #:

Defendant

Name: Twentieth Century Fox Film Corporation

Correspondence: TINA M. POMPEY, ESQ.

FOX GROUP LEGAL
PO BOX 900
BEVERLY HILLS, CA 90213-0900

Serial #: 85258735 Application File

Application Request For Extension of Time to File Opposition

Status:

Mark: PAPER STREET SOAP CO.

Potential Opposer

Name: Paper Street Soap, Ltd.

Correspondence: Kenneth Lindow

Paper Street Soap, Ltd.
731 Arbor Chase Drive
Dundee, MI 48131
UNITED STATES
klindow@paperstreetsoapltd.com

Granted To 11/30/2011

Date:

Prosecution History

#	Date	History Text
<u>4</u>	09/27/2011	<u>EXTENSION OF TIME GRANTED</u>
<u>3</u>	09/27/2011	<u>INCOMING - EXT TIME TO OPPOSE FILED</u>
<u>2</u>	09/01/2011	<u>EXTENSION OF TIME GRANTED</u>
<u>1</u>	09/01/2011	<u>INCOMING - EXT TIME TO OPPOSE FILED</u>