

ESTTA Tracking number: **ESTTA453488**

Filing date: **01/27/2012**

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	Zino Davidoff SA
Granted to Date of previous extension	01/29/2012
Address	Rue Faucigny 5 Fribourg, 1700 SWITZERLAND

Attorney information	Brian P. Gregg McNees Wallace & Nurick 100 Pine Street Harrisburg, PA 17108 UNITED STATES trademarks@mwn.com, bgregg@mwn.com Phone: 7172328000
----------------------	---

**Applicant Information**

Application No	85255642	Publication date	08/02/2011
Opposition Filing Date	01/27/2012	Opposition Period Ends	01/29/2012
Applicant	Shiseido Company, Limited 7-5-5 Ginza, Chuo-Ku Tokyo, 104-8010 JAPAN		

**Goods/Services Affected by Opposition**

Class 003. All goods and services in the class are opposed, namely: Soaps, perfumeries, and cosmetics; non-medicated skin care preparations, hair care preparations, body care cosmetics, and make-up
--

**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.	1735965	Application Date	07/16/1991
Registration Date	12/01/1992	Foreign Priority Date	NONE
Word Mark	COOL WATER		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 003. First use: First Use: 1988/06/00 First Use In Commerce: 1989/06/06 toilettries; namely, eau de toilette, aftershave lotion, skin energizer (tonic), shower gel, shampoo, body lotion, personal deodorants and antiperspirants, and body soap

U.S. Application No.	79083241	Application Date	04/09/2010
Registration Date	NONE	Foreign Priority Date	10/12/2009

Word Mark	COOL WATER
-----------	------------

Design Mark	
-------------	--

Description of Mark	The mark consists of the wording "COOL WATER" in stylized font.
---------------------	---

Goods/Services	Class 003. First use: Soaps, especially toilet soaps; perfumery; essential oils; cosmetics; sun screen preparations for tanning, namely creams and lotions; foam and gels for use in the bath and shower; skin care preparations in the nature of tonics; cosmetic skin lotions; tanning creams; body moisturizing concentrates not for medical use; oils, creams, powders and lotions for aftershave; shaving creams; preparations used for pre-shaving, namely oils, creams, gels and lotions; eau de Cologne; toilet water; deodorants for intimate use in the form of sprays and sticks
----------------	--

U.S. Registration No.	1735958	Application Date	04/01/1991
Registration Date	12/01/1992	Foreign Priority Date	NONE


Word Mark	DAVIDOFF COOL WATER
-----------	---------------------

Design Mark	
-------------	--

Description of Mark	NONE
---------------------	------

Goods/Services	Class 003. First use: First Use: 1988/06/00 First Use In Commerce: 1989/06/06 toilettries; namely, eau de toilette, aftershave lotion, skin energizer (tonic), shower gel, shampoo, body lotion, personal deodorants and antiperspirants, and body soap
----------------	---

U.S. Registration No.	2950263	Application Date	10/07/2003
Registration Date	05/10/2005	Foreign Priority Date	NONE
Word Mark	DAVIDOFF COOL WATER DEEP		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 2004/03/01 First Use In Commerce: 2004/09/01 toiletries, namely, after-shave lotion, skin energizer, skin tonic, shower gel, shampoo, body lotion, personal deodorants and anti-perspirants, and body soap; perfumery, eau de toilette		

U.S. Registration No.	3449751	Application Date	03/08/2007
Registration Date	06/17/2008	Foreign Priority Date	12/15/2006
Word Mark	DAVIDOFF COOL WATER WAVE		
Design Mark	 <p>The design mark for 'DAVIDOFF COOL WATER WAVE' features the word 'DAVIDOFF' in a bold, sans-serif font at the top. Below it, 'Cool Water' is written in a large, elegant, cursive script. At the bottom, the word 'wave' is written in a bold, lowercase, sans-serif font.</p>		
Description of Mark	NONE		
Goods/Services	Class 003. First use: Eau-de-toilette, anti-perspirants and deodorants for personal use, shower gel, body lotion		

Attachments	79083241#TMSN.jpeg ( 1 page )( bytes ) 74153663#TMSN.gif ( 1 page )( bytes ) 79039539#TMSN.jpeg ( 1 page )( bytes ) A2750979.PDF ( 6 pages )(23903 bytes )
-------------	---

### 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	/BrianPGregg/
Name	Brian P. Gregg
Date	01/27/2012

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

In re Application of  
Shiseido Company, Limited

Serial No. : 85/255,642  
Mark : L'EAU FROIDE  
Filing Date : March 2, 2011  
Published : Official Gazette  
August 2, 2011

Zino Davidoff SA, :  
Opposer :  
v. : Opposition No. \_\_\_\_\_  
Shiseido Company, Limited, :  
Applicant :

BOX TTAB FEE  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**NOTICE OF OPPOSITION**

1. Zino Davidoff SA, a company organized and existing under the laws of Switzerland, with an address of rue Faucigny 5, 1700 Fribourg, Switzerland ("Opposer") believes and alleges that it will be damaged by registration of the mark shown in Serial No. 85/255,642 and hereby oppose the same.

2. Applicant Shiseido Company, Limited ("Applicant") is a Japanese entity with an address of 7-5-5 Ginza, Chuo-Ku, Tokyo, Japan 104-8010.

3. Applicant seeks to register the word mark, L'EAU FROIDE, in International Class 3 for use with soaps, perfumeries, and cosmetics; non-medicated skin care

preparations, hair care preparations, body care cosmetics, and make-up goods ("Applicant's Goods"), having filed an intent-to-use federal application on March 2, 2011, Serial No. 85/255,642 (the "Application").

4. Opposer is the owner of the following federal registrations and pending applications for marks which consist of or contain the phrase "cool water" (collectively, the "COOL WATER Marks"), for use with a variety of fragrances and other personal care products:

- (i) COOL WATER, Reg. No. 1,735,965 for use with:
  - International Class 3 - Toiletries; namely, eau de toilette, aftershave lotion, skin energizer (tonic), shower gel, shampoo, body lotion, personal deodorants and antiperspirants, and body soap with a date of first use in commerce of June 1989;
- (ii) COOL WATER (Stylized), Ser. No. 79/083,241 for use with:
  - International Class 3 - Soaps, especially toilet soaps; perfumery; essential oils; cosmetics; sun screen preparations for tanning, namely creams and lotions; foam and gels for use in the bath and shower; skin care preparations in the nature of tonics; cosmetic skin lotions; tanning creams; body moisturizing concentrates not for medical use; oils, creams, powders and lotions for aftershave; shaving creams; preparations used for pre-shaving, namely oils, creams, gels and lotions; eau de Cologne; toilet water; deodorants for intimate use in the form of sprays and sticks with a filing date of April 9, 2010;
- (iii) DAVIDOFF COOL WATER and Design, Reg. No. 1,735,958 for use with:
  - International Class 3 - toiletries; namely, eau de toilette, aftershave lotion, skin energizer (tonic), shower gel, shampoo, body lotion, personal deodorants and antiperspirants, and body soap with a date of first use in commerce of June 1989;
- (iv) DAVIDOFF COOL WATER DEEP, Reg. No. 2,950,263 for use with:
  - International Class 3 - toiletries, namely, after-shave lotion, skin energizer, skin tonic, shower gel, shampoo, body lotion, personal deodorants and anti-perspirants, and body soap; perfumery, eau de toilette with a date of first use of March 2004;

(v) DAVIDOFF COOL WATER WAVE (Stylized), Reg. No. 3,449,751 for use with:

- International Class 3 - Eau-de-toilette, anti-perspirants and deodorants for personal use, shower gel, body lotion with a priority date of December 15, 2006.

5. Since at least as early as June 1989, Opposer has continuously promoted and sold a variety of fragrances and other personal care products in connection with the marks COOL WATER and DAVIDOFF COOL WATER and Design.

6. Opposer's use of the COOL WATER Marks has been valid and continuous since its date of first use.

7. Opposer's COOL WATER Marks are symbolic of extensive good will established by Opposer, have acquired a high degree of consumer recognition and fame through continued use and expenditure of time, effort and money in advertising and promotion, and serve as unique identifiers of the goods offered by Opposer.

8. Opposer's COOL WATER Marks were well established and famous long before the filing date of the Application.

9. There is no issue as to priority of use by Opposer and Applicant. Opposer's earliest date of first use in commerce for the COOL WATER mark June 1989, and the dates of first use and the filing dates for all goods claimed under each of Opposer's registered or applied-for COOL WATER Marks predate the filing date of Applicant's Application for the L'EAU FROIDE mark.

10. Applicant states in its Application that the English translation of the applied for mark, L'EAU FROIDE, is "the cold water."

11. By virtue of its English equivalent, Applicant's mark L'EAU FROIDE is confusingly similar to Opposer's COOL WATER Marks.

12. Applicant's Goods are identical to the goods claimed in Opposer's COOL WATER Marks and may be sold through the same channels of trade and at the same retail outlets as Opposer's goods.

13. Opposer believes that the consumers to whom Applicant intends to market Applicant's Goods under its L'EAU FROIDE mark are the same as those whom Opposer markets its identical goods under the COOL WATER Marks.

**COUNT 1**  
**LIKELIHOOD OF CONFUSION**

14. Opposer hereby incorporates by reference and realleges each and every allegation set forth in Paragraphs 1 through 13.

15. The dates of first use in commerce and the application filing dates for the COOL WATER Marks are prior to the date of filing of the Application.

16. The COOL WATER Marks are valid and subsisting and are *prima facie* evidence of Opposer's exclusive right to use such marks in commerce on the goods specified in such registrations and applications.

17. In view of the similarity of the English equivalent of L'EAU FROIDE and Opposer's COOL WATER Marks, the identical channels of trade and the identical goods offered for sale by the respective parties, Applicant's L'EAU FROIDE mark so resembles the COOL WATER Marks, previously used in the United States, and not abandoned, as to be likely to cause confusion, or to cause mistake, or to deceive as to source by suggesting that Applicant's goods are associated with or approved, endorsed, affiliated, authorized or sponsored by Opposer.

**COUNT II**  
**DILUTION BY BLURRING**

18. Opposer hereby incorporates by reference and realleges each and every allegation set forth in Paragraphs 1 through 13.

19. The COOL WATER Marks are distinctive and famous within the meaning of 15 U.S.C. §1125(c), and were distinctive and famous prior to the filing date of the Application.

20. Applicant's intended use is likely to dilute the distinctiveness of the famous COOL WATER Marks by blurring their considerable power to identify and distinguish products marketed and sold by Opposer featuring such mark, and by impeding Opposer's ability to sell products featuring the COOL WATER Mark.

21. Opposer is or will be damaged by the registration of Applicant's L'EAU FROIDE mark, since, by virtue of such registration, (1) Applicant's use of the mark will dilute the strength and distinctive quality of Opposer's COOL WATER Marks and its rights therein; and (2) doubt would be raised as to the exclusive right of Opposer to use the COOL WATER Marks.

**WHEREFORE**, Opposer, Zino Davidoff SA, respectfully requests that this opposition be sustained, that application 85/255,642 be refused, and that the United States Patent and Trademark Office refuse to register Applicant's mark.

McNEES WALLACE & NURICK LLC

By           /s/ Brian P. Gregg            
Harvey Freedenberg  
Brian P. Gregg  
100 Pine Street  
P. O. Box 1166  
Harrisburg, PA 17108-1166  
(717) 232-8000

Attorneys for Opposer  
Zino Davidoff SA

Dated: January 27, 2012



**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that on this date a true and correct copy of the **Notice of Opposition** was mailed via First Class Mail, postage prepaid, to:

Mary Margaret L. O'Donnell, Esquire  
Blue Filament Intellectual Property LLC  
401 South Old Woodward, Suite 315  
Birmingham, Michigan 48009

/s/ Brian P. Gregg  
Brian P. Gregg  
Of Counsel for Opposer  
Zino Davidoff SA

Dated: January 27, 2012