

ESTTA Tracking number: **ESTTA539099**

Filing date: **05/21/2013**

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 parties oppose registration of the indicated application.

Opposers Information

Name	Colgate-Palmolive Company
Granted to Date of previous extension	05/22/2013
Address	300 Park Avenue New York, NY 10022 UNITED STATES

Name	IES Enterprises, Inc.		
Entity	Corporation	Citizenship	Massachusetts
Address	300 Park Avenue New York, NY 10022 UNITED STATES		

Attorney information	James D. Weinberger Fross Zelnick Lehrman & Zissu, P.C. 866 United Nations Plaza 6th Floor New York, NY 10017 UNITED STATES jweinberger@frosszelnick.com, lkittay@frosszelnick.com Phone:(212) 813-5900
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Applicant Information

Application No	85691008	Publication date	01/22/2013
Opposition Filing Date	05/21/2013	Opposition Period Ends	05/22/2013
Applicant	The Theraplex Company, LLC Suite 110 6410 Poplar Avenue Memphis, TN 38119 UNITED STATES		

Goods/Services Affected by Opposition

Class 003. All goods and services in the class are opposed, namely: Skin and body topical lotions; Emollient for skin care; Cosmetic creams for skin care; cosmetic oils for skin care
Class 005. All goods and services in the class are opposed, namely: Pharmaceutical preparations for the treatment of skin

Grounds for Opposition

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

U.S. Registration No.	4109651	Application Date	07/21/2010
Registration Date	03/06/2012	Foreign Priority Date	NONE
Word Mark	PAMPERED HANDS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 2011/02/04 First Use In Commerce: 2011/02/04 Personal care products, namely, non-medicated skin cleansing preparations		

U.S. Registration No.	4258546	Application Date	06/30/2011
Registration Date	12/11/2012	Foreign Priority Date	NONE
Word Mark	SOFTSOAP PAMPERED HANDS COCONUT LIME PARFAIT		
Design Mark			
Description of Mark	The mark consists of a stylized green banner featuring the term "SOFTSOAP" in white stylized letters contained in a blue stylized banner shape with a grey bar running along the bottom edge and curving upward in the lower right hand corner of the banner shape. Immediately beneath that is the trademark "Pampered Hands" in stylized white lettering. Beneath that is an image of fruits consisting of brown and white coconuts and a green and white slice of lime. A white swoosh of foam with sparkles and bubbles appear to float over the image of fruits. Under that is the phrase "COCONUT LIME PARFAIT" in white letters.		
Goods/Services	Class 003. First use: First Use: 2012/07/18 First Use In Commerce: 2012/07/18 Personal care products, namely, non-medicated skin cleansing preparations		

Attachments	F1230548.pdf(76130 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	/s/ James D. Weinebrger
Name	James D. Weinberger
Date	05/21/2013

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

COLGATE-PALMOLIVE COMPANY and
IES ENTERPRISES, INC.,

Opposers,

-against-

THE THERAPLEX COMPANY, LLC,

Applicant.

NOTICE OF OPPOSITION

Colgate-Palmolive Company (“Colgate”), a corporation organized and existing under the laws of Delaware and IES Enterprises, Inc. a corporation organized and existing under the laws of Massachusetts¹ (“IES” and, together with Colgate, “Opposers”), both having an office and principal place of business at 300 Park Avenue, New York, New York 10022, believes that they will be damaged by the issuance of a registration for the mark PAMPERED FEET to The Theraplex Company (“Applicant”) in International Classes 3 and 5, applied for in Application Serial No. 85/691,008 and therefore opposes the same pursuant to Section 13(a) of the Lanham Trademark Act of 1946, 15 U.S.C. § 1063(a).

As grounds therefore, Opposers allege as follows:

1. Colgate has for many years been engaged in the manufacture, distribution, marketing and sale of a wide variety of personal care products, including skin soaps and cleansers. IES is a wholly owned subsidiary of Colgate.

¹ Opposers respectfully submit that Opposer IES Enterprises, Inc. is a wholly-owned subsidiary of Colgate, in whose name prior extensions of time to oppose were obtained. IES Enterprises is thus in privity with Opposer Colgate-Palmolive Company for purposes of Trademark Rule of Practice 2.012(b), 37 C.F.R. § 2.102(b) and TBMP 206.02.

2. For at least the past two years, Opposers have manufactured and marketed skin cleansers under the mark PAMPERED HANDS. Opposers' PAMPERED HANDS® products have been sold extensively throughout the U.S. with significant sales and advertising expenditures.

3. Prior to any date upon which Applicant can rely, Opposers have manufactured and marketed skin cleansers under the PAMPERED HANDS mark and under PAMPERED HANDS-formative marks including SOFTSOAP PAMPERED HANDS, SOFTSOAP PAMPERED HANDS JASMINE OATS, and SOFTSOAP PAMPERED HANDS COCONUT LIME PARFAIT (the "PAMPERED HANDS Marks").

4. As a result of their reputation, use and substantial sales success, and Opposers' significant investment in advertising, the PAMPERED HANDS Marks have become a strong trademark identifying Opposers' products exclusively. As such, the PAMPERED HANDS Marks represent significant goodwill and are substantial assets to Opposers.

5. Opposers are the owners of all right, title, and interest in and to the PAMPERED HANDS Marks in connection with skin cleansers and related goods based on first use in commerce at least as early as February 2011.

6. Additionally, Opposers own two U.S. trademark registrations for the PAMPERED HANDS Marks, including the following:

- PAMPERED HANDS, U.S. Reg. No. 4,109,651, registered March 6, 2012 based on first use in February 2011, for "Personal care products, namely, non-medicated skin cleansing preparations." in International Class 3 (owned by Colgate); and
- SOFTSOAP PAMPERED HANDS COCONUT LIME PARFAIT & Design, U.S. Reg. No. 4,258,546, registered December 11, 2012 based on first use in July 2012, for

“Personal care products, namely, non-medicated skin cleansing preparations.” in International Class 3 (owned by IES).

A printout from the TSDR electronic database records of the U.S. Patent and Trademark Office showing the current status and title of the registrations relied upon herein is attached hereto as Exhibit A.

7. The registrations for the PAMPERED HANDS Marks relied upon herein are valid, subsisting and in full effect and serve as *prima facie* evidence of the validity of the mark, pursuant to Section 33(a) of the Lanham Act, 15 U.S.C. § 1115(a).

8. Upon information and belief, Applicant is a Tennessee corporation with its principal place of business at Suite 110, 6410 Poplar Avenue, Memphis, Tennessee 38119.

9. On July 31, 2012, after Opposers first used and registered the mark PAMPERED HANDS, Applicant filed an application with the U.S. Patent and Trademark Office to register the mark PAMPERED FEET for “Skin and body topical lotions; Emollient for skin care; Cosmetic creams for skin care; cosmetic oils for skin care” in International Class 3 and for “Pharmaceutical preparations for the treatment of skin” in International Class 5, Application Serial No. 85/691,008, on an intent-to-use basis pursuant to Section 1(b) of the Lanham Act, 15 U.S.C. § 1051(b), disclaiming the exclusive right to use “FEET” apart from the mark as shown in the application.

10. Upon information and belief, Applicant has not used the PAMPERED FEET mark in commerce in the United States.

11. The PAMPERED HANDS Marks have been used continuously and/or registered by Opposers since a date prior to any date on which Applicant can rely.

12. The term PAMPERED, the primary and most prominent term contained in Opposers’ PAMPERED HANDS mark, is identical to the primary and most prominent term

contained in Applicant's PAMPERED FEET mark in sight, sound, and commercial impression. Moreover, Applicant has disclaimed the remaining term, FEET. Finally, the full marks PAMPERED HANDS and PAMPERED FEET provide consumers with a similar commercial impression.

13. Applicant's International Class 3 and Class 5 goods to be offered under the PAMPERED FEET mark are highly similar and/or related to International Class 3 goods sold under Opposers' PAMPERED HANDS Marks and, upon information and belief, will be sold to the same customers or types of customers to whom goods bearing Opposers' PAMPERED HANDS Marks are sold.

14. Based on the similarity of the marks and goods, consumers are likely to be deceived into falsely believing that the goods offered by Applicant under the PAMPERED FEET mark originate from or are otherwise associated with or endorsed by Opposers, or that there is some relationship between Applicant and Opposers or the goods of Applicant and Opposers, all to Opposers' injury and harm.

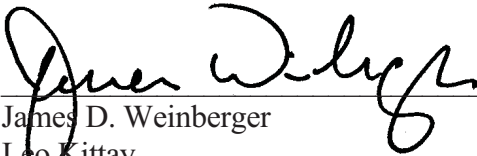
15. Thus, registration of the PAMPERED FEET mark in connection with the International Class 3 goods and International Class 5 goods set forth in Application Serial No. 85/691,008 is likely to cause confusion, cause mistake, or to deceive the public into the false belief that the goods offered by Applicant under the PAMPERED FEET mark come from or are otherwise sponsored by or connected with Opposers, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

16. By reason of the foregoing, Opposers are likely to be harmed by a registration of Application Serial No. 85/691,008 for the mark PAMPERED FEET in International Classes 3 and 5.

THEREFORE, it is respectfully requested that this Opposition be sustained and that registration of the mark shown in Application Serial No. 85/691,008 in International Classes 3 and 5 be refused in its entirety.

Dated: New York, New York
May 21, 2013

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By: 
James D. Weinberger
Leo Kittay

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lkittay@frosszelnick.com

Attorneys for Opposers

EXHIBIT A

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Mark: PAMPERED HANDS

PAMPERED HANDS

US Serial Number: 85089973 Application Filing Date: Jul. 21, 2010
US Registration Number: 4109651 Registration Date: Mar. 06, 2012
Register: Principal
Mark Type: Trademark
Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.
Status Date: Mar. 06, 2012
Publication Date: Apr. 19, 2011 Notice of Allowance Date: Jun. 14, 2011

Mark Information

Mark Literal Elements: PAMPERED HANDS
Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.
Mark Drawing Type: 4 - STANDARD CHARACTER MARK
Disclaimer: "HANDS"

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks *.* identify additional (new) wording in the goods/services.

For: Personal care products, namely, non-medicated skin cleansing preparations
International Class(es): 003 - Primary Class U.S Class(es): 001, 004, 006, 050, 051, 052
Class Status: ACTIVE
Basis: 1(a)
First Use: Feb. 04, 2011 Use in Commerce: Feb. 04, 2011

Basis Information (Case Level)

Filed Use: No	Currently Use: Yes	Amended Use: No
Filed ITU: Yes	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: Colgate-Palmolive Company
Owner Address: 300 Park Avenue
New York, NEW YORK 10022
UNITED STATES
Legal Entity Type: CORPORATION State or Country Where Organized: DELAWARE

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Anita K. Yeung
Attorney Primary Email Address: Anita_Yeung@colpal.com Attorney Email Authorized: No

Correspondent

Correspondent Name/Address: ANITA K. YEUNG
COLGATE-PALMOLIVE COMPANY

300 PARK AVE FL 8
NEW YORK, NEW YORK 10022-7499
UNITED STATES

Phone: 212-310-2122

Fax: 212-310-3406

Correspondent e-mail: Anita_Yeung@colpal.com

Correspondent e-mail No
Authorized:

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Mar. 06, 2012	REGISTERED-PRINCIPAL REGISTER	
Jan. 31, 2012	NOTICE OF ACCEPTANCE OF STATEMENT OF USE E-MAILED	
Jan. 30, 2012	LAW OFFICE REGISTRATION REVIEW COMPLETED	70997
Jan. 25, 2012	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Jan. 05, 2012	NOTICE OF APPROVAL OF EXTENSION REQUEST E-MAILED	
Jan. 04, 2012	STATEMENT OF USE PROCESSING COMPLETE	76538
Dec. 09, 2011	USE AMENDMENT FILED	76538
Jan. 04, 2012	EXTENSION 1 GRANTED	76538
Dec. 09, 2011	EXTENSION 1 FILED	76538
Jan. 04, 2012	CASE ASSIGNED TO INTENT TO USE PARALEGAL	76538
Dec. 30, 2011	CASE ASSIGNED TO INTENT TO USE PARALEGAL	74193
Dec. 09, 2011	TEAS EXTENSION RECEIVED	
Dec. 09, 2011	TEAS STATEMENT OF USE RECEIVED	
Jun. 14, 2011	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
Apr. 19, 2011	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Apr. 19, 2011	PUBLISHED FOR OPPOSITION	
Mar. 15, 2011	LAW OFFICE PUBLICATION REVIEW COMPLETED	70997
Mar. 15, 2011	ASSIGNED TO LIE	70997
Feb. 25, 2011	APPROVED FOR PUB - PRINCIPAL REGISTER	
Feb. 24, 2011	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Feb. 23, 2011	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Feb. 23, 2011	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Aug. 31, 2010	NOTIFICATION OF EXAMINER'S AMENDMENT/PRIORITY ACTION E-MAILED	6326
Aug. 31, 2010	EXAMINER'S AMENDMENT/PRIORITY ACTION E-MAILED	6326
Aug. 31, 2010	EXAMINERS AMENDMENT AND/OR PRIORITY ACTION - COMPLETED	81852
Aug. 27, 2010	ASSIGNED TO EXAMINER	81852
Jul. 26, 2010	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jul. 24, 2010	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Jan. 30, 2012

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Mark: SOFTSOAP PAMPERED HANDS COCONUT LIME PARFAIT



US Serial Number: 85360122

Application Filing Date: Jun. 30, 2011

US Registration Number: 4258546

Registration Date: Dec. 11, 2012

Register: Principal

Mark Type: Trademark

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Dec. 11, 2012

Publication Date: Feb. 28, 2012

Notice of Allowance Date: Apr. 24, 2012

Mark Information

Mark Literal Elements: SOFTSOAP PAMPERED HANDS COCONUT LIME PARFAIT

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Description of Mark: The mark consists of a stylized green banner featuring the term "SOFTSOAP" in white stylized letters contained in a blue stylized banner shape with a grey bar running along the bottom edge and curving upward in the lower right hand corner of the banner shape. Immediately beneath that is the trademark "Pampered Hands" in stylized white lettering. Beneath that is an image of fruits consisting of brown and white coconuts and a green and white slice of lime. A white swoosh of foam with sparkles and bubbles appear to float over the image of fruits. Under that is the phrase "COCONUT LIME PARFAIT" in white letters.

Color Drawing: Yes

Color(s) Claimed: The color(s) blue, white, grey, green and brown is/are claimed as a feature of the mark.

Disclaimer: "HANDS" "COCONUT LIME" OR THE DEPICTION OF A COCONUT AND LIME

Acquired Distinctiveness Claim: In part

Distinctiveness Limitation Statement: as to "SOFTSOAP"

Design Search Code(s): 01.15.02 - Sparks (jagged lines); Lightning; Electricity
01.15.11 - Soap suds; Suds, soap; Bubbles; Foam (bubbles); Foamy mass
05.09.04 - Lemons; Limes
05.09.13 - Fruits (slices or quarters of)
05.09.25 - Coconuts; Other fruits
24.09.07 - Advertising, banners; Banners
26.13.13 - Quadrilateral (two quadrilaterals); Two quadrilaterals
26.13.21 - Quadrilaterals that are completely or partially shaded
26.13.25 - Quadrilaterals with one or more curved sides

Related Properties Information

Claimed Ownership of US Registrations: 1457886, 2098824, 2711651

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;

- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Personal care products, namely, non-medicated skin cleansing preparations

International Class(es): 003 - Primary Class

U.S Class(es): 001, 004, 006, 050, 051, 052

Class Status: ACTIVE

Basis: 1(a)

First Use: Jul. 18, 2012

Use in Commerce: Jul. 18, 2012

Basis Information (Case Level)

Filed Use: No

Currently Use: Yes

Amended Use: No

Filed ITU: Yes

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: IES Enterprises, Inc.

Owner Address: 300 Park Avenue
New York, NEW YORK 10022
UNITED STATES

Legal Entity Type: CORPORATION

State or Country Where Organized: MASSACHUSETTS

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Anita K. Yeung

Attorney Primary Email Address: Anita_Yeung@colpal.com

Attorney Email Authorized: No

Correspondent

Correspondent Name/Address: ANITA K. YEUNG
COLGATE-PALMOLIVE COMPANY
300 PARK AVE
FL 8
NEW YORK, NEW YORK 10022-7499
UNITED STATES

Phone: 212-310-2122

Fax: 212-310-3406

Correspondent e-mail: Anita_Yeung@colpal.com

Correspondent e-mail Authorized: No

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Dec. 11, 2012	REGISTERED-PRINCIPAL REGISTER	
Nov. 07, 2012	NOTICE OF ACCEPTANCE OF STATEMENT OF USE E-MAILED	
Nov. 06, 2012	LAW OFFICE REGISTRATION REVIEW COMPLETED	69712
Nov. 02, 2012	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Oct. 24, 2012	NOTICE OF APPROVAL OF EXTENSION REQUEST E-MAILED	
Oct. 23, 2012	STATEMENT OF USE PROCESSING COMPLETE	66154
Oct. 22, 2012	USE AMENDMENT FILED	66154
Oct. 23, 2012	EXTENSION 1 GRANTED	66154
Oct. 22, 2012	EXTENSION 1 FILED	66154
Oct. 23, 2012	CASE ASSIGNED TO INTENT TO USE PARALEGAL	66154
Oct. 22, 2012	TEAS EXTENSION RECEIVED	
Oct. 22, 2012	TEAS STATEMENT OF USE RECEIVED	

Apr. 24, 2012	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
Feb. 28, 2012	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Feb. 28, 2012	PUBLISHED FOR OPPOSITION	
Feb. 08, 2012	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Jan. 23, 2012	LAW OFFICE PUBLICATION REVIEW COMPLETED	69712
Jan. 13, 2012	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jan. 13, 2012	EXAMINER'S AMENDMENT ENTERED	88888
Jan. 13, 2012	NOTIFICATION OF EXAMINERS AMENDMENT E-MAILED	6328
Jan. 13, 2012	EXAMINERS AMENDMENT E-MAILED	6328
Jan. 13, 2012	EXAMINERS AMENDMENT -WRITTEN	78447
Jan. 13, 2012	PREVIOUS ALLOWANCE COUNT WITHDRAWN	
Jan. 12, 2012	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jan. 12, 2012	EXAMINER'S AMENDMENT ENTERED	88888
Jan. 12, 2012	NOTIFICATION OF EXAMINERS AMENDMENT E-MAILED	6328
Jan. 12, 2012	EXAMINERS AMENDMENT E-MAILED	6328
Jan. 12, 2012	EXAMINERS AMENDMENT -WRITTEN	78447
Jan. 12, 2012	PREVIOUS ALLOWANCE COUNT WITHDRAWN	
Nov. 21, 2011	WITHDRAWN FROM PUB OTQR REQUEST	71359
Nov. 05, 2011	LAW OFFICE PUBLICATION REVIEW COMPLETED	69712
Nov. 04, 2011	ASSIGNED TO LIE	69712
Oct. 11, 2011	APPROVED FOR PUB - PRINCIPAL REGISTER	
Oct. 11, 2011	EXAMINER'S AMENDMENT ENTERED	88888
Oct. 11, 2011	NOTIFICATION OF EXAMINERS AMENDMENT E-MAILED	6328
Oct. 11, 2011	EXAMINERS AMENDMENT E-MAILED	6328
Oct. 11, 2011	EXAMINERS AMENDMENT -WRITTEN	78447
Oct. 07, 2011	ASSIGNED TO EXAMINER	78447
Jul. 08, 2011	NOTICE OF DESIGN SEARCH CODE AND PSEUDO MARK MAILED	
Jul. 07, 2011	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jul. 04, 2011	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

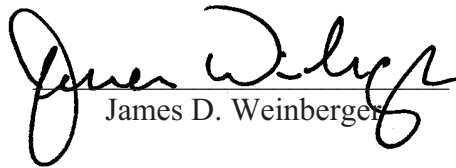
Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Nov. 06, 2012

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **NOTICE OF OPPOSITION** was sent by first class mail postage pre-paid to Applicant's Attorney of Record, this 22nd day of May, 2013, to the following:

ANTHONY C. PIETRANGELO, ESQ.
PIETRANGELO COOK, PLC
STE 190
6410 POPLAR AVE
MEMPHIS, TENNESSEE 38119


James D. Weinberger