

ESTTA Tracking number: **ESTTA592562**

Filing date: **03/14/2014**

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	Norwex Malta Ltd.
Granted to Date of previous extension	03/15/2014
Address	Pama, No. 6 Triq Sant Anna Zebbiegh Mgarr, MST10 MALTA

Name	Norwex Holdings, AS
Granted to Date of previous extension	03/15/2014
Address	Taerudgata 3 Lillestrom, 2004 NORWAY

Name	Norwex USA, Inc.
Granted to Date of previous extension	03/15/2014
Address	14679 Midway Road Addison, TX 75001 UNITED STATES

Name	Norwex Canada, Inc.
Granted to Date of previous extension	03/15/2014
Address	871 Whitmore Ave. EBox 714 Dauphin, Manitoba, R7N 3B3 CANADA

Attorney information	Thomas A, Kulik Scheef & Stone, L.L.P. 500 N. Akard Suite 2700 Dallas, TX 75201 UNITED STATES trademarks@solidcounsel.com, tom.kulik@solidcounsel.com, bryan.haynes@solidcounsel.com Phone:214-706-4200
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**Applicant Information**

Application No	86020758	Publication date	01/14/2014
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Opposition Filing Date	03/14/2014	Opposition Period Ends	03/15/2014
Applicant	Fanning, Francis G. PMB 306, PO Box 30000 Jackson, WY 83002 USX		


## Goods/Services Affected by Opposition


<p>Class 003. First Use: 2011/03/04 First Use In Commerce: 2011/03/04  All goods and services in the class are opposed, namely: After sun creams; After-sun lotions; Age retardant lotion; Anti-aging cream; Anti-freckle creams; Anti-wrinkle cream; Body cream; Body lotion; Cosmetic creams; Cosmetic creams for skin care; Cosmeticsuntan lotions; Face and body beauty creams; Face and body creams; Face and body lotions; Face creams; Face creams for cosmetic use; Facial cream; Facial lotion; Fair complexion cream; Hand cream; Lotions for cosmetic purposes; Lotions for face and body care; Moisturizing creams; Non-medicated skin care creams and lotions; Non-medicated skin creams; Skin cream; Skin lotion; Sun care lotions; Sun creams; Sun-block lotions; Sunscreen cream; Wrinkle resistant cream</p>
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## Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
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.	2798028	Application Date	06/18/1999
Registration Date	12/23/2003	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 021. First use: First Use: 1999/04/01 First Use In Commerce: 1999/04/01  Mops and ergonomic attachments therefor; mop bases, namely, mopheads; stainlesssteel scrubbers for cleaning; stainlesssteel soap dishes; spray bottles sold empty; toilet cleaning kits consisting primarily of a toilet brush and plastic toilet brush holder; non-electric carpetsweeper; microfiber cleaning towels and cloths; mugs; thermal insulated containersfor food and beverages</p> <p>Class 024. First use: First Use: 1999/04/01 First Use In Commerce: 1999/04/01  [ Microfiber bath towels ]</p>		

U.S. Registration No.	3964282	Application Date	03/15/2010
Registration Date	05/24/2011	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of a drop of liquid positioned above a series of concentric circles that form a water drop wave.		
Goods/Services	<p>Class 003. First use: First Use: 2000/01/00 First Use In Commerce: 2000/01/00  Cleaning preparations for household purposes; dishwashing detergents; dishwasher detergents; facial lotion; foam soap for hands; hand, body and non-medicated foot lotion; laundry detergent; mattress cleaning preparation for elimination and removal of all organic waste inside mattresses; deodorant for personal use; hair conditioner; lime removing preparations; bath and shower gels; hair shampoo; fabric softeners for laundry use; laundry stain remover; drain opener; oven and grill cleaners; cleaning preparations for fruit and vegetables; bath, shower and personal care products, namely, olive oil salt scrub; beauty serums; carpet stain remover</p> <p>Class 005. First use: First Use: 2000/01/00 First Use In Commerce: 2000/01/00  Hand sanitizing and disinfecting preparation with anti-bacterial and anti-microbial properties; odor neutralizing preparations for use in litter boxes, garbage disposals, diaper pails, musty basement smells, shoes, clothing, and carpeting; air fresheners</p> <p>Class 016. First use: First Use: 1999/04/00 First Use In Commerce: 1999/04/00  Newsletters, manuals, catalogs, printed flyers and printed advertisements in the field of cleaning products; writing instruments</p> <p>Class 018. First use: First Use: 2000/01/00 First Use In Commerce: 2000/01/00  Tote bags</p> <p>Class 021. First use: First Use: 1999/04/00 First Use In Commerce: 1999/04/00  Cleaning products, namely, stainless steel scrub sponges for cleaning; brushes for removing hair, lint and dust from textiles, car seats, and pets; cleaning cloths and towels for cleaning, wiping and dusting; abrasive pads for kitchen or domestic purposes; plastic water bottles sold empty; toilet cleaning kits consisting primarily of a toilet brush and plastic toilet brush holder</p> <p>Class 025. First use: First Use: 2000/08/00 First Use In Commerce: 2000/08/00  Clothing, namely, bath robes, socks, t-shirts, jackets and men's neck ties</p> <p>Class 035. First use: First Use: 2005/01/00 First Use In Commerce: 2005/01/00  Retail services by direct solicitation by sales agents in the field of cleaning products; providing on-line ordering services in the field of cleaning products; providing technical assistance in the establishment of and/or operation of independent direct sales businesses; business information services in the nature of providing information on business opportunities related to independent</p>		

	direct sales businesses Class 041. First use: First Use: 2005/01/00 First Use In Commerce: 2005/01/00 Providing education services, namely, training services to independent sales representatives in the field of cleaning products and personal care products, and sales techniques		
U.S. Registration No.	4034517	Application Date	02/23/2011
Registration Date	10/04/2011	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of a drop of liquid positioned above a series of concentric circles that form a water drop wave.		
Goods/Services	Class 003. First use: First Use: 2007/09/01 First Use In Commerce: 2007/09/01 Organic leg cream; organic face and neck gel; organic herbs skin cream; organic day skin cream; organic night skin cream; organic hand cream Class 021. First use: First Use: 1999/04/01 First Use In Commerce: 2000/08/01 Eyeglass cleaning cloths		

Attachments	75731819#TMSN.gif( bytes ) 77959173#TMSN.jpeg( bytes ) 85249205#TMSN.jpeg( bytes ) EDOCS- #47657-v1-2014-03-14_Norwex___Fanning___Notice_of_Opposition.pdf(69853 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/ Bryan Haynes
Name	Bryan Haynes
Date	03/14/2014

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

NORWEX HOLDING AS, NORWEX )  
MALTA LIMITED, NORWEX )  
CANADA, INC. and NORWEX )  
USA INC. )

**Opposers,**

vs.

**FRANCIS G. FANNING**

**Applicant.**

**Opposition No.** \_\_\_\_\_  
**Serial No.:** 86/020,758

**Mark:**



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**NOTICE OF OPPOSITION**

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Norwex Holding AS, a limited liability corporation duly organized and existing under the laws of Norway, with a mailing address of Taerudgata 3 Lillestrom, Norway 2004; Norwex Malta Limited, a limited liability company, organized under the laws of Malta, with a mailing address of Pama, No. 6 Triq Sant Anna, Zebbiegh Mgarr, MST10, Malta; Norwex Canada, Inc., a corporation organized under the laws of Canada, with an address of 871 Whitmore Ave. E., Box 714, Dauphin, Manitoba, R7N 3B3, Canada; and Norwex USA Inc., a corporation organized under the laws of Texas, with an address of 14679 Midway Road, Suite 115, Addison, Texas 75001, United States (collectively, the “Opposers”), believe that they will be damaged by the registration of the droplet & design mark (the “Applicant’s Mark”) shown in Application Serial

No. 86/020,758 (the "Application"), filed July 26, 2013, by Applicant Francis G. Fanning, with a mailing address of PMB 306, PO Box 30000 Jackson, Wyoming 83002 (the "Applicant"), and each Opposer hereby accordingly opposes registration of the Applicant's Mark. The Grounds for opposition are as follows:

1. Applicant seeks to obtain under the provisions of the Trademark Act of 1946 as amended, registration on the Principal Register of the Applicant's Mark for:

International Class 3: After sun creams; After-sun lotions; Age retardant lotion; Anti-aging cream; Anti-freckle creams; Anti-wrinkle cream; Body cream; Body lotion; Cosmetic creams; Cosmetic creams for skin care; Cosmetic suntan lotions; Face and body beauty creams; Face and body creams; Face and body lotions; Face creams; Face creams for cosmetic use; Facial cream; Facial lotion; Fair complexion cream; Hand cream; Lotions for cosmetic purposes; Lotions for face and body care; Moisturizing creams; Non-medicated skin care creams and lotions; Non-medicated skin creams; Skin cream; Skin lotion; Sun care lotions; Sun creams; Sun-block lotions; Sunscreen cream; Wrinkle resistant cream (the "Applicant's Goods")

2. The Application is based on Applicant's purported first use of Applicant's Mark in commerce on or after March 4, 2011.

3. Applicant's Mark published for opposition on January 14, 2014. On February, 13, 2014, within the time allowed for opposition of Applicant's Mark, each of the Opposers filed a Request for Extension of Time to Oppose (the "Requests"). On February 13, 2014, the Board granted the Requests and extended the time to oppose the Applicant's Mark to March 15, 2014. This Notice of Opposition is therefore timely filed.

4. Opposer Norwex Holding AS is the owner of the following U.S. Trademark Registrations (the "Registered Marks"):



Reg. No. 2,798,028



Reg. No. 3,964,282



Reg. No. 4,034,517

5. Opposer Norwex Holding AS licensed the use of the Registered Marks to Opposer Norwex Malta Limited, which in turn has sub-licensed the Registered Marks to each of Norwex Canada, Inc. (formerly known as Norwex Enviro Products, Inc.) and Norwex USA Inc.

6. Opposers use the Registered Marks in connection with, among others, mops and ergonomic attachments therefor; mop bases, namely, mopheads; stainless steel scrubbers for cleaning; stainless steel soap dishes; spray bottles sold empty; toilet cleaning kits consisting primarily of a toilet brush and plastic toilet brush holder; non-electric carpetsweeper; microfiber cleaning towels and cloths; mugs; thermal insulated containers for food and beverages; cleaning preparations for household purposes; dishwashing detergents; dishwasher detergents; facial lotion; foam soap for hands; pumice stone for personal use; hand, body and foot lotion; lip balm; laundry detergent; mattress cleaning preparation for elimination and removal of all organic waste inside mattresses; deodorant for personal use; hair conditioner; lime removing preparations; bath and shower gels; hair shampoo; fabric softeners for laundry use; laundry stain remover; drain opener; oven and grill cleaners; cleaning preparations for fruit and vegetables; bath, shower and personal care products, namely, olive oil salt scrub; beauty serums; carpet stain remover; hand sanitizing and disinfecting preparation with anti-bacterial and anti-microbial properties; odor

neutralizing preparations for use in litter boxes, garbage disposals, diaper pails, musty basement smells, shoes, clothing, and carpeting; air fresheners; newsletters, manuals, catalogs, printed flyers and printed advertisements in the field of cleaning products; writing instruments; Tote bags; Cleaning products, namely, stainless steel scrub sponges for cleaning; brushes for removing hair, lint and dust from textiles, car seats, and pets; cleaning cloths and towels for cleaning, wiping and dusting; abrasive pads for kitchen or domestic purposes; plastic water bottles sold empty; toilet cleaning kits consisting primarily of a toilet brush and plastic toilet brush holder; clothing, namely, bath robes, socks, t-shirts, jackets and men's neck ties, Retail services by direct solicitation by sales agents in the field of cleaning products; providing on-line ordering services in the field of cleaning products; providing technical assistance in the establishment of and/or operation of independent direct sales businesses; business information services in the nature of providing information on business opportunities related to independent direct sales businesses; providing education services, namely, training services to independent sales representatives in the field of cleaning products and personal care products, and sales techniques; organic leg cream; organic face and neck gel; organic herbs skin cream; organic day skin cream; organic night skin cream; organic hand cream, eyeglass cleaning cloths, and other related goods and services (“Opposers’ Goods and Services”).

7. The Registered Marks are valid and subsisting, and are prima facie evidence of Opposers’ exclusive rights to use said marks in commerce on the goods and services specified in each registration.

8. Since at least as early as April 1999, one or more of the Opposers, themselves and/or through licensees, have used the Registered Marks in the United States for one or more of the Opposers Goods and Services. Said use has been continuous since the date of first use and has not been abandoned.

9. Opposers have advertised and promoted the Registered Marks extensively.



Opposers have also made substantial sales of Opposers' Goods and Services using the Registered Marks. As a result of such use and promotion, the Registered Marks have developed and represent valuable goodwill inuring to the benefit of Opposers.

10. The Registered Marks had priority over Applicant's Mark long before the March 4, 2011 filing date of the Application.

11. Applicant's Mark is essentially identical to and otherwise deceptively and confusingly similar to each of the Registered Marks. Applicant's Mark has an overall confusingly similar appearance, sound, meaning and/or commercial impression.

12. Further, Applicant's Goods are related to Opposers' Goods and Services, and Applicant's Goods marketed and sold under Applicant's Mark are within the zone of natural expansion of Opposers' Goods and Services marketed and sold under the Registered Marks. Opposers' Goods and Services are designed to improve quality of life by radically reducing the use of chemicals in personal care and cleaning while Applicant's Goods involve the promotion of environmentally conscious research. Consumers are therefore likely to mistakenly believe that Applicant's Goods are offered by, affiliated with and/or sponsored by Opposers, when such is not true.

13. Due to the virtually identical nature of Applicant's Mark and the Registered Marks, the closely related nature of the goods and services provided by the respective parties, and the fact that Applicant's Goods are within the zone of natural expansion of Opposers' Goods and Services, consumer and potential consumers are likely to believe that Applicant's Goods originate from Opposers, resulting in a likelihood of confusion in the marketplace, and damage to Opposers.

14. Upon information and belief, Opposers' Goods and Services marketed and sold under the Registered Marks and Applicant's Goods sold under Applicant's Mark will be promoted and sold in similar channels of trade to the same consumers or class of consumers.

15. The use and registration by Applicant of Applicant's Mark for Applicant's Goods are likely to cause confusion or to cause mistake or deception among consumers and potential consumers, with the Registered Marks, again resulting in damage to Opposers.

16. Because of the highly related nature of the goods and services, the fact that the Applicant's Goods are within the zone of natural expansion of Opposers' Goods and Services, and the highly similar nature of the marks in overall appearance, sound, meaning and commercial impression, the use and registration of the Applicant's Mark is likely to cause confusion, mistake, or deception that Applicant's Services are those of Opposers, or are otherwise endorsed, sponsored, or approved by Opposers causing further damage to Opposers.

17. The Registered Marks are famous and distinctive, and were famous prior to any first use of the Applicant's Mark. Applicant's Mark is likely to cause dilution and is likely to harm the reputation of the Registered Marks.

18. If Applicant is granted registration of Applicant's Mark, it would thereby obtain at least a prima facie exclusive right to use of its alleged mark. Such registration would be a source of further damage and injury to Opposers.

19. Registration of the Applicant's Mark will result in damage to Opposers under the provisions of §2(a), §2(d) §43(c) and of the U.S. Trademark Act, 15 U.S.C. §1052, §1125 pursuant to the allegations stated above.

WHEREFORE, Opposers ask that their opposition to this Application be sustained and that the registration of the Applicant's Mark in the Application be refused. Please direct all correspondence to the attention of:

Tom A. Kulik  
Bryan Haynes  
Scheef & Stone, L.L.P.  
500 North Akard  
Suite 2700  
Dallas, Texas 75201  
Telephone: (214) 706-4223  
Facsimile: (214) 706-4242

Opposers hereby appoint Tom A. Kulik and Bryan Haynes, of Scheef & Stone, L.L.P., as their attorneys with the full power to represent the Opposers in connection with this proceeding.

Respectfully submitted,

/s/ Bryan Haynes

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