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

Proceeding	91255820
Party	Plaintiff Hy-Tape International, Inc.
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Attachments	HY-TAPE AMENDED NOTICE OF OPPOSITION.pdf(149545 bytes)

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

HY-TAPE INTERNATIONAL, INC.,	)	
	)	Opposition No. 91255820
Opposer	)	
	)	App. Ser. No. 88361479
v.	)	Opposed Mark: ORIGINAL PINK
	)	
The Boots Company PLC,	)	
	)	
Applicant.	)	

AMENDED NOTICE OF OPPOSITION

Opposer is HY-TAPE INTERNATIONAL, INC., a New York corporation with an address at P.O. Box 540, Patterson, New York 12563 ("Opposer"). Opposer believes that it will be damaged by the registration of the trademark shown in Application Serial No. 88361479 (the "Application") and hereby opposes the same pursuant to 15 U.S.C. § 1063. The Application was filed by The Boots Company PLC, an entity with an address at 1 Thane Road West, Nottingham, United Kingdom NG23AA ("Applicant"). As grounds for its opposition, Opposer alleges as follows:

1. For more than seven decades, Opposer (and its predecessors-in-interest) has been a leader in surgical adhesives and waterproof medical tape. Opposer is an internationally recognized company that designs, markets, and sells multiple types of medical adhesives, including but not limited to adhesive patches for use on human skin. To meet the fast-growing global demand for its products, Opposer has augmented its distributor network and partners with other medical device manufacturers and wound clinics to sell and distribute Opposer's high-quality medical adhesive products. In addition to exhibiting at

an ever-increasing number of trade shows both in the U.S. and outside the U.S., Opposer offers its products through its website at https://hytape.com/.

2. Since at least as early as 1985, Opposer has continuously used the mark THE ORIGINAL PINK TAPE® in interstate commerce in the U.S. to identify Opposer's well-known adhesive products used by medical professionals and consumers.

3. Over the past 35 years, Opposer has spent substantial sums of money to promote the goods offered under the mark THE ORIGINAL PINK TAPE®. Based on Opposer's extensive use and promotion of the mark THE ORIGINAL PINK TAPE® ("Opposer's Mark"), Opposer's Mark has acquired a highly favorable reputation and goodwill, and has come to be immediately identified with Opposer. Accordingly, Opposer has developed broad rights at common law in the mark THE ORIGINAL PINK TAPE® used in connection with multiple adhesive products, including adhesive patches for use on human skin.

4. In addition to its common law rights, Opposer owns U.S. Trademark Registration No. 2399299 ("Opposer's Registration") on the Principal Register of the U.S. Patent and Trademark Office ("USPTO") for THE ORIGINAL PINK TAPE, covering the following goods in International Class 5: "Plastic adhesive tape for medical use."

5. Opposer first used Opposer's Mark in January 1985.

6. Opposer's Registration for Opposer's Mark was registered on October 31, 2000. It has become incontestable.

Applicant's Intended Mark

7. Notwithstanding Opposer's long-established, prior rights in Opposer's Mark, Applicant filed the Application to register the mark ORIGINAL PINK on March 28, 2019, more than 34 years after Opposer began using Opposer's Mark, and more than 18 years after Opposer's Registration was issued by the USPTO.

8. The Application to register ORIGINAL PINK ("Applicant's Intended Mark") identifies the following long list of goods in International Class 3:

Cosmetics; cosmetic preparations for skin renewal; face, body, and hand moisturizers; non-medicated skin care preparations, namely, toners; nonmedicated serums for use on hair, skin, and lips; skin, body, beauty, and facial masks; skin, anti-aging, and facial cleansers; non-medicated toiletry preparations, namely body soap, body moisturiser, bath and shower soap, body lotion, shower and bath foam, foam skin cleansers, body scrub, body exfoliator in the nature of exfoliant creams, body wash, body butter, fragranced body soap, fragranced body moisturiser, fragranced bath and shower soap, fragranced body lotion, fragranced shower and bath foam, fragranced foam cleansers, fragranced body scrub, fragranced body exfoliator in the nature of exfoliant creams, fragranced body wash, fragranced body butter, body spray, fragranced body spray, fragrances; non-medicated hand, bath, beauty, skin, and toilet soaps; essential oils; nonmedicated lotions for skin, hair, face, and body; non-medicated skin care preparations, namely, creams; non-medicated preparations for the care of the body, face, skin, and hair; non-medicated hair treatment preparations for cosmetic purposes; shower gels; moisturizing skin, hair, face, and body lotions; moisturizing creams; body scrubs; bath gels; bath oils; bath creams; facial moisturizing lotions; facial masks; non-medicated skin care preparations, namely, body gels; body lotions; body creams; body butter; skin creams; anti-wrinkle creams; body masks; body contouring patches being patches used on the skin for cosmetic purposes impregnated with cosmetic preparations in the nature of firming creams and lotions; facial creams, lotions and toners; non-medicated hand care creams, facial masks, skin serums and body scrubs; skin moisturizers (collectively, "Applicant's Intended Products").

9. There is no issue as to priority. Opposer began using Opposer's Mark in commerce at least as early as 1985. Opposer's use of its THE ORIGINAL PINK TAPE® mark clearly

pre-dates Applicant's actual or constructive first use of Applicant's Intended Mark.

Ground I: Likelihood of Confusion

10. Opposer repeats and realleges each and every allegation above as if fully set forth herein.

11. Applicant's Intended Mark, as set forth in the Application, is essentially identical to Opposer's Mark visually, aurally, phonetically, in connotation, and in commercial impression. Applicant's Intended Mark consists of two words that are exactly identical to the dominant two words in Opposer's Mark. Applicant's Intended Mark is confusingly similar to Opposer's Mark, particularly considering that Applicant purportedly intends to use its mark in conjunction with numerous products related to and focused on human skin, including but not limited to "body contouring patches being patches used on the skin for cosmetic purposes impregnated with cosmetic preparations in the nature of firming creams and lotions."

12. The mark that Applicant seeks to register contains the exact, visually and aurally dominant portion of Opposer's Mark. Applicant's Intended Mark is likely to create confusion as to the source of Applicant's skin-focused goods, which include, *inter alia*, "patches used on the skin," and cause consumers to mistakenly believe that Applicant is affiliated with, or sponsored or endorsed or licensed by, Opposer and Opposer's well known goods used on and in connection with human skin.

13. The goods offered by Opposer under Opposer's Mark and identified in Opposer's Registration, and the goods purportedly to be offered by Applicant under Applicant's Intended Mark, overlap and/or are highly related such that consumers are likely to be confused.

14. Accordingly, Applicant's use of Applicant's Intended Mark for the goods set forth in the Application is likely to cause consumers to be confused, to be deceived, and to assume erroneously that Applicant's goods are those of Opposer, or that Applicant is in some way licensed by, sponsored by, or connected with Opposer, all in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), and with consequent injury to Opposer and the public.

15. Pursuant to Section 13(a) of the Lanham Act, 15 U.S.C. § 1063(a), Opposer believes that it will be damaged by registration of Applicant's ORIGINAL PINK mark in that members of the purchasing public are likely to be confused or mistaken that Applicant's skin-focused goods offered under Applicant's Intended Mark originate from Opposer, or from the same source as skin-focused goods offered under Opposer's decades-old THE ORIGINAL PINK TAPE® mark, or that such goods of Applicant are sponsored by, endorsed by, or affiliated with the source of goods offered under Opposer's prior-used and prior-registered mark. Such likelihood of confusion results in damage to the goodwill among purchasers and the trade that Opposer's Mark symbolizes.

16. Registration of Applicant's Intended Mark will support and assist Applicant in the confusing and misleading use of Applicant's Intended Mark, and, in addition, will give color and exclusive statutory right to Applicant in violation and derogation of Opposer's prior and superior rights in its THE ORIGINAL PINK TAPE® mark.

Ground II: Dilution

17. Opposer repeats and realleges each and every allegation above as if fully set forth herein.

18. Opposer and its predecessors in interest have spent to date a substantial amount of money marketing, advertising, and promoting the sale of multiple medical and skin-related products under Opposer's Mark. Opposer's Mark is extremely well-known to the consuming public and the trade in the United States.

19. Because of the high degree of acquired distinctiveness of Opposer's Mark, the length of time and extent to which Opposer has used its THE ORIGINAL PINK TAPE® mark, the vast advertising and publicity its THE ORIGINAL PINK TAPE® mark has received, the nationwide trading area in which its THE ORIGINAL PINK TAPE® mark is used, and the high degree of consumer recognition of its THE ORIGINAL PINK TAPE® mark, all of which have existed for several decades, the THE ORIGINAL PINK TAPE® mark is a famous trademark pursuant to 15 U.S.C. §1125(c)(1).

20. As noted above, Applicant filed the Application to register the mark ORIGINAL PINK on March 28, 2019, more than 34 years after Opposer began using Opposer's Mark, and more than 18 years after Opposer's Registration was issued by the USPTO, and Applicant's use of the ORIGINAL PINK mark, and/or the filing of the trademark application for the ORIGINAL PINK mark, took place long after the Opposer's mark became famous.

21. Applicant's Intended Mark, if registered and used, would lessen the capacity of Opposer's famous THE ORIGINAL PINK TAPE® mark to identify and distinguish Opposer's goods sold thereunder and, consequently, would dilute the THE ORIGINAL PINK TAPE® mark in violation of 15 U.S.C. § 1125(c).

22. Opposer will be damaged by the registration sought by Applicant because such registration will support and assist Applicant in diluting the distinctive quality of

Opposer's famous THE ORIGINAL PINK TAPE® mark.

Ground III: Applicant's Mark Is Deceptive

23. Opposer repeats and realleges each and every allegation above as if fully set forth herein.

24. Opposer has used its THE ORIGINAL PINK TAPE® mark for 35 years in the U.S., and Opposer's Mark has become a distinctive indicator of source that consumers and the trade can look to in ensuring the quality of the products being purchased and used.

25. Applicant's Intended Mark, ORIGINAL PINK, consists of the term "original," that misdescribes the character, quality, function, composition and/or use of the goods associated with the Intended Mark. For example, term "original" misdescribes the character, quality and composition of the goods of the Intended Mark as being "original," when in fact such goods are neither the first (original) pink skin-related products, nor the only authentic (original) pink skin-related products.

26. Applicant's Intended Mark, consists of, and makes the claim that Applicant provides the "Original Pink" skin care products. This statement is false, untrue and inaccurate because Opposer has been selling such products decades before Applicant filed its trademark application and thus Applicant is not providing, or proposing to provide, the first or only authentic, such skin care products.

27. Prospective purchasers are likely to believe that Applicant's misdescription of Applicant's Intended Products actually describes the goods because, *inter alia*, prospective purchasers are likely to believe that Applicant's Intended Products are the first, or only authentic, pink skin-related products.

28. The misdescription inherent in the term "original" is likely to affect a significant portion of the relevant consumers' decision to purchase Applicant's Intended Products. Consumers' product choices are such that they are shaped by a desire for a product's authenticity or originality. Consumers are therefore more likely to buy goods that are represented to be original.

29. Opposer will be damaged by the registration sought by Applicant because such registration will support and assist Applicant in deceptively, falsely, and misleadingly indicating and implying that Applicant's products offered under Applicant's Intended Mark are the first (original) such skin-related products, or the only authentic (original) such skin-related products.

Ground IV: Applicant's Mark Is Desceptively Misdescriptive

30. Opposer repeats and realleges each and every allegation above as if fully set forth herein.

31. Applicant's Intended Mark indicates to consumers and the trade, in a misdescriptive and inaccurate way, that Applicant is providing the first (original) pink, skin-related products, or the only authentic (original) pink, skin-related products.

32. Applicant's Intended Mark, ORIGINAL PINK, includes the word "original" which is misdescriptive of the goods identified in the subject application, i.e., Applicant's Intended Products. This statement is false, untrue and inaccurate because Opposer has been selling such products decades before Applicant filed its trademark application, and thus Applicant is not, in fact, providing or proposing to provide "original pink" skin care products.

33. Applicant's misdescriptive use of the word "original" is deceptive, i.e., plausible and likely to be believed by consumers. The term "original" has a strong and well-known meaning, signifying the first, or only, authentic such skin-related products.

34. Opposer will be damaged by the registration sought by Applicant because such registration will support and assist Applicant, in a deceptive and misdescriptive manner, to indicate and convey to consumers that Applicant's products offered under Applicant's Intended Mark are the first (original) such skin-related products, or the only authentic (original) such skin-related products.

Wherefore, Opposer respectfully requests that registration of Application Serial No. 88361479 be denied.

DATED: November 23, 2020

Respectfully submitted,

/David A. Einhorn/
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Attorneys for Opposer

CERTIFICATE OF FILING

I certify that a true copy of the foregoing Amended Notice of Opposition is being filed electronically with the TTAB via ESTTA on November 23, 2020.

Respectfully submitted,

/David A. Einhorn/

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing has been served on the date indicated below by emailing said copy to Applicant's counsel at:

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Dated: November 23, 2020

By: /David A. Einhorn/

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