

ESTTA Tracking number: **ESTTA1165591**

Filing date: **10/13/2021**

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	Beiersdorf AG
Granted to Date of previous extension	10/13/2021
Address	UNNASTRASSE 48 HAMBURG, D-20245 GERMANY
Attorney information	FRANCIS J. DUFFIN WIGGIN AND DANA LLP ONE CENTURY TOWER, 265 CHURCH STREET NEW HAVEN, CT 06510 UNITED STATES Primary Email: fduffin@wiggin.com Secondary Email(s): trademarkdocketing@wiggin.com, pbushnell@wiggin.com 203.498.4347
Docket Number	401555/GEN00

Applicant Information

Application No.	90340688	Publication date	06/15/2021
Opposition Filing Date	10/13/2021	Opposition Period Ends	10/13/2021
Applicant	PHARMADEL, LLC 650 CENTERPOINT BLVD NEWCASTLE, DE 19720 UNITED STATES		

Goods/Services Affected by Opposition

Class 005. First Use: 2020/09/03 First Use In Commerce: 2020/09/03 All goods and services in the class are opposed, namely: Adhesive plasters for medical purposes; Analgesic and muscle relaxant pharmaceutical preparations; Analgesic balm; Analgesic preparations; Analgesics; Corn and callus creams; Pain relief medication; Wart removing preparations; Preparation for the relief of pain; Sports cream for relief of pain; Topical analgesic creams; Topical analgesics

Grounds for Opposition

Applicant not rightful owner of mark for identified goods or services	Trademark Act Section 1
False suggestion of a connection with persons, living or dead, institutions, beliefs, or national	Trademark Act Section 2(a)

symbols, or brings them into contempt, or disrepute	
Deceptiveness	Trademark Act Section 2(a)
Other	Likelihood of confusion

Attachments	Notice of Opposition - PARCHE LEON.pdf(242027 bytes)
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Signature	/fjd/
Name	FRANCIS J. DUFFIN
Date	10/13/2021

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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BEIERSDORF AG	:
	:
Opposer,	:
	:
v.	:
	:
PHARMADEL, LLC	:
	:
Applicant.	:
-----X	

Opposition No.

NOTICE OF OPPOSITION

In the matter of the trademark application of Pharmadel, LLC, for registration of the designation "PARCHE LEON WITH LION DESIGN" for "Adhesive plasters for medical purposes; Analgesic and muscle relaxant pharmaceutical preparations; Analgesic balm; Analgesic preparations; Analgesics; Corn and callus creams; Pain relief medication; Wart removing preparations; Preparation for the relief of pain; Sports cream for relief of pain; Topical analgesic creams; Topical analgesics" in International Class 005, Application Serial No. 90/340688, filed November 24, 2020, and published in the *Official Gazette* of June 15, 2021, Opposer, Beiersdorf AG, a joint stock company organized and existing under the laws of the Federal Republic of Germany, with a place of Unnastrasse 48, Hamburg, 20253, Germany, believes it will be damaged by the registration of the mark shown in the above application for the

goods in Class 005, and hereby opposes same.

As grounds for the opposition Opposer alleges:

1. Opposer is a preeminent manufacturer of cosmetic and personal care products, with operations worldwide, including the United States, and is therefore engaged in commerce that may be lawfully regulated by Congress. Opposer manufactures and sells a broad range of personal care products in International Class 3, and plasters, medicated plasters, healing ointments and medicated skin and lip care preparations for dermatological use in International Class 5.

2. Amongst the various marks Opposer uses in conducting its business, opposer has long used the mark PARCHE LEON, and variants of the “LEON” designation, which it has used in various countries in connection with plasters, medicated plasters and healing ointments in Class 5 (collectively the “Beiersdorf goods”).

3. On November 24, 2020, applicant applied for federal registration of the “PARCHE LEON WITH LION Design” designation in respect of goods in Class 5, identified as “Adhesive plasters for medical purposes; Analgesic and muscle relaxant pharmaceutical preparations; Analgesic balm; Analgesic preparations; Analgesics; Corn and callus creams; Pain relief medication; Wart removing preparations; Preparation for the relief of pain; Sports cream for relief of pain; Topical analgesic creams; Topical analgesics” under Serial Number 90/340688.

4. The “PARCHE LEON WITH LION DESIGN” designation was published for opposition in the *Trademark Official Gazette* of June 15, 2021.

The grounds for the opposition are:

5. Opposer is a preeminent manufacturer of cosmetic and personal care products, with operations worldwide, including the United States, and is therefore engaged in commerce that may

be lawfully regulated by Congress. Amongst the various marks Opposer uses in conducting its business, opposer uses the mark **PARCHE LEON** and variants on the **LEON** designation.

6. Indeed, Opposer has used and registered in various countries the following pertinent marks:

MARK	COUNTRY(IES) REGISTERED	CLASS
PARCHE LEON	Colombia, Ecuador, El Salvador, Honduras, Panama, Nicaragua, Peru, Venezuela	005
PARCHE LEON WITH LION Design	Bolivia, Chile, China, Colombia, Cuba, Dominican Republic, Ecuador, Guatemala, Haiti, Honduras, Mexico, Nicaragua, Panama, Paraguay, Peru, Trinidad and Tobago, Uruguay, Venezuela	005
PARCHE TERMICO LEON WITH LION Design	Chile, Colombia, Ecuador, Guatemala, Mexico, Paraguay, Peru, Uruguay, Venezuela	005
LEON	Bolivia, Chile, Ecuador, El Salvador, Guatemala, Mexico, Panama, Peru	005
LEON WITH LION Design	Colombia	005
LEONTOS	Greece	005
LEONTOS IN GREEK WITH LION Design	Cyprus, Greece	005
LION	India, New Zealand, United Arab Emirates	005
LION PLASTER	Gaza, Tunisia	005
LION PLASTER WITH LION Design	Afghanistan, Cyprus, India, Jordan, Syria, Thailand	005
LION WITH ARABIC CHARACTERS	Morocco, Tunisia	005
LION PLASTER IN CHINESE CHARACTERS	Taiwan	005
LION WITH LION Design	Singapore	005
LION LOGO	Algeria, Cyprus, European Union, Greece, Morocco, Tunisia, United Kingdom, WIPO (Madrid)	005
LION PLASTER WITH LION DESIGN WITH ARABIC CHARACTERS	Bahrain, Gaza, Iran, Iraq, Jordan, Kuwait, Lebanon, Lybia (P), Oman, Pakistan, Qatar, Saudi Arabia, Syria, Taiwan, United Arab Emirates, West Bank, Yemen	005

BALSAMO LEON	Venezuela	005
BALSAMO LEON WITH LION Design	Chile, Dominican Republic, Ecuador, Paraguay, Peru, Venezuela	005
EMPLASTRO LEÃO WITH LION Design	Brazil	005
EMPLASTRO LEON WITH LION Design	Portugal	005
HANSAPLAST LION WITH LION Design	India, Maldives, Sri Lanka	005
UNGÜENTO LEON WITH LION Design	Bolivia, Chile, Costa Rica, Dominican Republic, Ecuador, Honduras, Panama, Paraguay, Peru, Uruguay, Venezuela	005
UNGÜENTO LEÃO	Brazil	005
UNGÜENTO LEON	Paraguay, Uruguay	005

Neither the **PARCHE LEON**, **PARCHE LEON WITH LION DESIGN**, **PARCHE TERMICO LEON WITH LION Design**, nor the other marks reflected in the above chart are registered in the United States.

7. Long prior to Applicant's September 3, 2020 claimed date of first use in commerce, Opposer commenced use of the **PARCHE LEON** mark. Indeed, Opposer has been using the **PARCHE LEON** mark in respect of the Beiersdorf Goods outside the United States since at least as early as 1966.

8. In view of Opposer's worldwide business presence and significant reputation, consumers worldwide are familiar with Opposer, its business, and its brands.

9. Applicant has long been aware of Opposer's long-standing rights in the **PARCHE LEON** mark in numerous countries around the world, not only because of Opposer's use of the **PARCHE LEON** mark in numerous countries around the world but, specifically, as the result of having been involved in previous opposition proceedings between the parties concerning the **PARCHE LEON** designation in Colombia and Mexico (resolved in favor of Opposer). Despite

direct knowledge of Opposer's claim to, and long-standing rights in, the PARCHE LEON mark, applicant nevertheless is seeking registration for the PARCHE LEON mark.

10. Although Opposer has not directly used the mark in the United States, upon information and belief as a result of Opposer's extensive rights in the PARCHE LEON mark in numerous countries around the world, which rights Applicant was aware of at the time the subject application was filed, Opposer believes and submits that Applicant is not, and was not at the time the subject application was filed, the rightful owner of the mark for which registration was applied in contravention of Section 1 of the Lanham Act, 15 U.S.C.1051.

11. Because of Opposer's extensive rights in the PARCHE LEON mark in numerous countries around the world, which rights Applicant was aware of at the time the subject application was filed, Opposer believes and submits that Applicant's alleged use and application for registration of the PARCHE LEON designation falsely suggests a connection, affiliation, or association with Opposer when there is none, all in contravention of Section 1 of the Lanham Act, 15 U.S.C.1051. Indeed, the Lanham Act's intended prohibition against a party's making a false designation or origin or false or misleading representation of fact that is likely to result in consumer confusion or deception as to affiliation, connection or association with another party is indicated in Section 43(a) of the Lanham Act, clearly bolstering Opposer's claim that registration to Applicant of the PARCHE LEON designation would violate Section 1 of the Lanham Act.

13. In view of Opposer's longstanding use and registration of the PARCHE LEON mark in numerous Latin American countries and the likelihood that consumers familiar with Opposer's PARCHE LEON brand in such Latin American countries have immigrated to the United States bringing with them their familiarity with Opposer's PARCHE LEON brand, it is

likely that such consumers seeing Applicant's literally identical PARCHE LEON designation will be confused or deceived into mistakenly believing that Applicant's goods emanate from or are otherwise associated with, affiliated with, or sponsored or endorsed by Opposer, when in fact such is not the case, in contravention of Section 2(d) of the Lanham Act, 15 U.S.C.1052(d).

13. Opposer has extensively used the PARCHE LEON mark in numerous countries around the world, particularly in Mexico where the PARCHE LEON WITH LION Design (subject of 2 registrations in Mexico) and PARCHE TERMICO LEON WITH LION Design marks have been extensively used and registered. One of Opposer's PARCHE LEON WITH LION Design marks has been registered in Mexico since 1983. In view of Opposer's extensive use of the PARCHE LEON mark in Mexico, particularly in geographic areas that border the United States, it is believed and submitted that it is likely that goods bearing Opposer's PARCHE LEON mark may well have spilled over into the United States.

14. As a result of Opposer's extensive use and registration of the PARCHE LEON mark in Mexico, coupled with the fact that there are significant areas of Mexico that are contiguous to the United States, and states in which there is significant migration from Mexico into the United States, it is submitted that consumers long familiar with the Opposer's PARCHE LEON mark in Mexico and seeing a mark used by Applicant in the United States that is literally identical to Opposer's PARCHE LEON mark, and confusingly similar in overall appearance, sound and commercial impression, used on or in association with essentially identical goods, Applicant's use and registration of the PARCHE LEON mark is likely to cause confusion or to cause mistake or to deceive within the meaning of Section 2(d) of the Lanham Act, 15 U.S.C.1052(d).

15. As a result of Opposer's extensive use and registration of the PARCHE LEON mark in Mexico, coupled with the fact that there are significant areas of Mexico that are contiguous to the United States, and states in which there is significant migration from Mexico into the United States,

it is submitted that consumers long familiar with the Opposer's PARCHE LEON mark in Mexico and seeing a mark used by Applicant in the United States that is literally identical to Opposer's PARCHE LEON mark, and confusingly similar in overall appearance, sound and commercial impression, used on, or in association with, essentially identical goods, Opposer believes and alleges that Applicant's "PARCHE LEON WITH LION DESIGN" designation, when used in connection with the goods set forth in the application is likely to cause confusion, or mistake or to deceive and will deceive and mislead the purchasing public into believing that Applicant is licensed or controlled by Opposer when it is not, that Applicant is a subsidiary of or in some way associated or affiliated with Opposer when it is not, or that Opposer is the source or sponsor of the goods provided by Applicant when it is not and is, therefore, likely to cause mistake or to deceive within the meaning of Section 2(d) of the Lanham Act, 15 U.S.C.1052(d).

16. Applicant's registration and use of its "PARCHE LEON WITH LION DESIGN" designation will enable Applicant to trade upon and utilize the good will established by Opposer in its PARCHE LEON mark in violation of Opposer's long-standing rights.

17. By reason of the foregoing, Opposer believes and submits that it will be irreparably damaged by the registration of Applicant's mark in respect of the goods covered in the application.

WHEREFORE, Opposer believes it will be damaged by the registration of the claimed mark in Application Serial No. 90/340688 in respect of the goods in Class 005 and prays that such registration be denied. Opposer appoints as its attorney, Francis J. Duffin, a member in good standing of the Bar of the state of Connecticut, Joseph Casino, and all duly-admitted attorneys with the firm of Wiggin and Dana LLP.

Dated: October 13, 2021

Respectfully submitted,

Francis J. Duffin
Francis J. Duffin

WIGGIN AND DANA LLP
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New Haven, Connecticut 06510
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Attorneys for Opposer
Beiersdorf AG

CERTIFICATE OF SERVICE

It is hereby certified that this Notice of Opposition was served by sending a copy to:
Harold G. Furlow, Esq., 260 West Main Street, Suite 10, Bay Shore, New York, 11706, by
electronic mail at harold.g.furlowc@gmail.com, on October 13, 2021.

Francis J. Duffin
Francis J. Duffin
Attorney for Opposer

If counsel for applicant wishes, a printed copy will be sent to counsel for applicant, upon counsel
for Opposer's return to the office from the COVID-19 outbreak.

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