

emulsifier for use in the manufacture of foods, lecithin for industrial use in the manufacture of food products for pharmaceutical preparations for use in the treatment of cardiovascular, gastroenteric, bone metabolism, dermatological, central nervous systems disease and tumors, angina, diabetes, insomnia, anti-bacterial pharmaceutical, diabetic substances adapted for medical use; namely baby food, food for medically restricted diets, foods for diabetics, dietary food supplements (International Class 5) and for surgical, medical and dental devices and instruments, namely, artificial limbs, surgical prostheses, materials for stopping teeth, dental wax, gauze (International Class 10), as evidenced by the publication of the mark in the *Official Gazette* of March 19, 2002. To the best of Biogen's knowledge, Abiogen's current address is Via S. Antonio 61, 56125 Pisa, Italian Republic.

2. The application herein opposed was filed February 15, 2000 on the basis of "intent to use" and Abiogen's Italian Republic Reg. No. 765014. Applicant claims no date earlier than February 15, 2000 for the purpose of priority in the United States.

3. Biogen is and has been engaged in research and consultation services in the field of biotechnology and in connection with pharmaceutical preparations for more than twenty (20) years, and has built a successful business in connection therewith.

4. Biogen has used "BIOGEN" as a name and mark in commerce in connection with its business, its services and its pharmaceutical preparations. Material showing Biogen's use of the BIOGEN name and mark is attached as Exhibit A.

5. Since at least as early as October 29, 1981, Biogen's use of the BIOGEN name and mark in connection with biotechnology research and consultation services and pharmaceutical preparations has been continuous, commercially significant and substantially exclusive.

6. Biogen has, since at least as early as August 8, 1983, used continuously a logo form of its name and mark having the letters O and G interlocking, as shown in Exhibit B.

Biogen's use of such logo form of its name and mark has been commercially significant and substantially exclusive.

7. Biogen has secured and is the owner of U.S. Trademark Registrations Nos. 1,314,274 and 1,343,559 directed to the BIOGEN mark with the O and G interlocking. These registrations are valid, subsisting and incontestable. The pertinent information about these registrations from the USPTO website is attached as Exhibits C and D respectively.

8. Biogen has secured and is the owner of U.S. Trademark Registrations Nos. 1,275,543 and 1,961,898 directed to the BIOGEN mark. These registrations are valid, subsisting and incontestable. The pertinent information about these registrations from the USPTO website is attached as Exhibits E and F, respectively.

9. Biogen has, since long prior to the February 15, 2000 filing date of the application herein opposed, used BIOGEN as a name and as a mark in connection with its business, its services and its pharmaceutical preparations.

10. Biogen's BIOGEN name and mark, and the BIOGEN name and mark with the O and G interlocking, are inherently distinctive as applied to Biogen's business, services and pharmaceutical preparations.

11. By virtue of Biogen's continuous use in commerce of its BIOGEN name and mark as shown in Exhibits A and B in connection with such business, services and pharmaceutical preparations, such business, services and pharmaceutical preparations have become well and favorably known to the relevant trade and public under such name and mark.

12. The BIOGEN name and mark as shown in Exhibits A and B are famous in the United States in connection with the business, services and pharmaceutical preparations of Biogen; and such name and mark have been famous since long prior to the February 15, 2000 filing date of the application herein opposed.

13. In the application herein opposed, there are no restrictions on trade channels, so it must be assumed that the goods identified in the application, including prescription pharmaceutical preparations, will travel through all trade channels appropriate for goods of that type.

14. Abiogen's mark is essentially identical to Biogen's BIOGEN name and mark.

15. Abiogen has appropriated the whole of Biogen's name and mark.

16. Abiogen has blatantly simulated the interlocking O and G long used by Biogen in the logo form of its name and mark and shown in Biogen's U.S. Trademark Registration Nos. 1,314,274 and 1,343,559.

17. Abiogen has added to the BIOGEN name and mark only the non-distinctive prefix "A", which is partially obscured in the mark of the application herein opposed by the leaning tower and ellipses design, and has added in smaller letters the generic designation "PHARMA", which identifies the nature of Biogen's business as it does Abiogen's.

18. Abiogen has added to the BIOGEN name and mark a non-distinctive leaning tower and ellipses design which does nothing more than falsely suggest that Abiogen is an Italian affiliate of Biogen.

19. The business, services and pharmaceutical preparations of Biogen and the goods of Abiogen as identified in the application herein opposed are closely related.

20. Abiogen seeks registration of the mark which is the subject of this opposition for, inter alia, pharmaceutical preparations for use in the treatment of cardiovascular, gastroenteric, bone metabolism, dermatological, central nervous systems disease and tumors, angina, diabetes, insomnia, anti-bacterials. Biogen is engaged in research and in the development and sale of pharmaceutical preparations for use in the prevention and treatment of, inter alia, central nervous system disorders, cardiovascular disorders, dermatologic disorders,

inflammatory and hepatic and immunological disorders. The close relationship and the overlap in goods is evident and strong.

21. The pharmaceutical preparations and other goods identified in the application herein opposed are customarily sold and marketed through the same channels of trade as Biogen employs. Therefore, Abiogen's goods travel through the same and overlapping channels of trade as Biogen's.

22. The services rendered under Biogen's BIOGEN name and mark, and the pharmaceutical preparations and some of the other products intended to be sold under Abiogen's mark are closely related, since Biogen's research is directed to the development of pharmaceutical preparations with others for treatment and prevention of disease and disorders including dermatologic and neurologic disorders, inter alia.

23. Abiogen's "ABIOGEN PHARMA & Design" trademark as applied to the goods set forth in the application herein opposed so resembles Biogen's BIOGEN name and mark as used and as applied to Biogen's business, services and pharmaceutical preparations that it is likely to cause confusion, mistake, and/or deception.

24. If Abiogen is permitted to register "ABIOGEN PHARMA & Design" for the goods set forth in the application herein opposed, confusion of the relevant trade and public is likely to result, which is likely to damage and injure Biogen.

25. Purchasers or potential purchasers of Abiogen's goods would likely believe in error that such goods are offered by or in association with Biogen, or that Biogen and Abiogen are affiliated.

26. Any defect, objection to or fault found with Abiogen's goods sold under the mark "ABIOGEN PHARMA & Design" would necessarily reflect on and seriously injure the reputation that Biogen has established for its business, services and its pharmaceutical preparations.

27. Registration of the mark of the application which is the subject of this opposition will dilute the distinctiveness of the BIOGEN name and mark as previously used and registered by Biogen.

28. If Abiogen is granted a registration for the mark herein opposed, it would obtain thereby at least a *prima facie* exclusive right to use the mark. Such registration would be a source of damage and injury to Biogen.

WHEREFORE, Biogen prays that registration of the mark of Application Serial No. 75/918,909 for the goods identified therein be refused and that this Opposition be sustained.

A duplicate copy of this Notice of Opposition is enclosed herewith.

The \$900.00 filing fee for this Opposition may be charged to Deposit Account No. 02-0755. Any additional fees in connection with this opposition may also be charged to this account and any overpayment may be credited to this account.

Respectfully submitted,

Dated: 3-25-02

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U.S. Patent & TMOtc/TM Mail Rcpt Dt. #57

BOX TTAB - FEE
Commissioner Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Dear Sir:

We are enclosing herewith the following documents set forth below, which are to be filed in the Patent and Trademark Office.

Please charge all government filing fees with respect to the enclosed documents to our Miscellaneous Account No. 02-0755.

Very truly yours,

BALLARD SPAHR ANDREWS & INGERSOLL, LLP


ROBERTA JACOBS-MEADWAY
RICHARD E. PEIRCE

Enclosures: Notice of Opposition

Biogen, Inc. v. Abiogen Pharma S.P.A.

Serial No.: 75/918,900 for "ABIOGEN PHARMA and Design"

Fee: \$900.00

Attorney Docket No. 888466

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO THE COMMISSIONER FOR TRADEMARKS, 2900 CRYSTAL DRIVE, ARLINGTON, VA 22202-3513 ON THE DATE INDICATED BELOW

By: Carpey Andrew

DATE: 03/25/02

RJM/cda

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