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TRADEMARK
Reference No. 30610/10013

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

Biomira, Inc.,)	
)	
Opposer,)	Opposition No. 91157636
)	
v.)	Application No. 76/240,537
)	
BioMarin Pharmaceutical, Inc.,)	
)	
Applicant.)	

Applicant's Substitution of Counsel



Box TTAB NO FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

10-16-2003
U.S. Patent & TMO/TM Mail Rcpt Dt. #22

Dear Madam:

BioMarin Pharmaceutical, Inc., Applicant and owner of the above application, the subject of this opposition proceeding, hereby notifies the Board that it will no longer be represented in this proceeding by Cynthia R. Hirschl and the law firm of Howrey Simon Arnold & White in connection with this proceeding.

Applicant hereby substitutes and appoints Beau D. Barberis and the law firm of Marshall, Gerstein & Borum LLP, 6300 Sears Tower, 233 South Wacker Drive, Chicago, Illinois 60606-6357 (telephone 312/474-6300), which has associated with it Beau D. Barberis, Richard H. Anderson, Scott E. Baxendale, Michael F. Borum, Paul C. Craane, Thomas L. Duston, Patrick D. Ertel, Kevin M. Flowers, David A. Gass, Allen H. Gerstein, Robert M. Gerstein, Michael R.

Graham, Roger A. Heppermann, Martin J. Hirsch, Richard B. Hoffman, Kevin D. Hogg,
Michael R. Hull, William J. Kramer, Richard M. Labarge, Bryan J. Lempia, John B. Lungmus,
Bradford P. Lyerla, Brent E. Matthias, Gregory C. Mayer, William K. Merkel, Thomas A.
Miller, Carl E. Moore, Jr., James J. Napoli, Sandip H. Patel, Thomas J. Ramsdell, David C.
Read, Thomas I. Ross, Jeffrey S. Sharp, Anthony G. Sitko, Thomas K. Stine, Michael R. Weiner,
Joseph A. Williams, Jr., James P. Zeller, Matthias Abrell, Jill Anderfuren, William H. Baker,
Kurt T. Buechle, Gregory J. Chinlund, Pamela L. Cox, Rashmi Gupta, Julianne M. Hartzell,
Anthony S. Hind, Jennifer L. Holmes, Marla L. Hudson, Mark Izraelewicz, Keith R. Jarosik,
Adam G. Kelly, Jeremy R. Kriegel, Lloyd K. Kwak, Andrew M. Lawrence, Saad Mirsafian,
Michael Muczynski, Carl E. Myers, Matthew C. Nielsen, Chitag B. Patel, Aaron M. Peters,
Russell C. Petersen, Matthew T. Ridsdale, Randall G. Rueth, Alisa C. Simmons, Gregory E.
Stanton, Gina M. Steele, Paul B. Stephens and Thomas J. Wrona, all members of the bar of the
State of Illinois, as its attorneys with respect to this proceeding.

All communications, pleadings, inquiries and materials relating to this proceeding should
be addressed to Attorney Beau D. Barberis at the firm and address set out in the previous
paragraph.

BIOMARIN PHARMACEUTICAL, INC.

By: 
Name: _____
Title: _____

Dated: 10/3/03, 2003

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Substitution of Counsel was served on October 13, 2003, by depositing said copy with the U.S. Postal Service as first-class mail, postage prepaid, addressed to the following counsel for Opposer:

Mark E. Ungerman, Esq.
Katherine M. DuBray
FULBRIGHT & JAWORSKI L.L.P.
801 Pennsylvania Avenue, N.W.
Washington, D.C. 20004



Beau D. Barberis

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

BIOMIRA INC.,)	Opposition No. 157,636
)	
Opposer,)	
)	Mark: BIOMARIN
v.)	
)	Serial No. 76/240,537
BIOMARIN PHARMACEUTICAL INC.,)	
)	Published: April 1, 2003
Applicant.)	
_____)	

10-16-2003
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ANSWER TO NOTICE OF OPPOSITION

Applicant, Biomarin Pharmaceutical Inc., responds to the notice of opposition of Opposer, Biomira, Inc., as follows:

1) Opposer Biomira Inc., a Canadian corporation, has a place of business at 2011-94 Street, Edmonton, Alberta, Canada T6N 1H1.

ANSWER: Admitted.

2) Opposer, using the trade name BIOMIRA, is an established biotechnology company that has built a large and successful business in the biotechnology and health fields, engaging in, inter alia, research and development of various pharmaceutical preparations.

ANSWER: Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 2.

3) Opposer owns Application Serial No. 75/552,893, filed September 14, 1998, for the mark BIOMIRA, covering pharmaceutical preparations used in the diagnosis and treatment of cancer; pharmaceutical preparations used in active specific immunotherapy for the treatment of cancer; vaccines for prophylactic use; and in vivo and in vitro medical diagnostic kits

comprised primarily of reagents, in International Class 5; manufacture services for others, namely manufacture of pharmaceutical preparations used in the diagnosis and treatment of cancer; pharmaceutical preparations used in active specific immunotherapy for the treatment of cancer; vaccines for prophylactic use; and in vivo and in vitro medical diagnostic kits comprised primarily of reagents, in International Class 40; and pharmaceutical research in the fields of pharmaceutical preparations used in the diagnosis and treatment of cancer; pharmaceutical preparations used in active specific immunotherapy for the treatment of cancer; vaccines for prophylactic use; and in vivo and in vitro medical diagnostic kits comprised primarily of reagents, in International Class 42.

ANSWER: Applicant admits Application Serial No. 75/552,893, was filed on September 14, 1998, for the mark BIOMIRA in connection with the above listed goods and services. Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegation of Paragraph 3.

4) Opposer's Application Serial No. 75/552,893 was filed based on Section 1(b) and Section 44(e) of the Trademark Act, 15 U.S.C. § § 1051(b) and 1126(e). At the time of filing, September 14, 1998, and at all times thereafter, Opposer has maintained a good faith intent-to-use its mark in commerce in connection with all of the goods and services identified in the application.

ANSWER: Applicant admits Opposer's Application Serial No. 75/552,893 was filed based on Section 1(b) and Section 44(e) of the Trademark Act, 15 U.S.C. § § 1051(b) and 1126(e). Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations of Paragraph 4.

5) Applicant filed its intent-to-use application for BIOMARIN on April 10, 2001, for assays, screening kits, devices, and equipment for scientific analysis and diagnosis of disorders and physiological processes; assays, screening kits, devices, and equipment for measurement of disease markers for scientific purposes, in International Class 1; and pharmaceutical preparations for use in enzyme therapy; pharmaceutical preparations for use in treatment of genetic disorders; pharmaceutical preparations for use in burn and wound debridement or cleaning; pharmaceuticals for treatment of inflammation, infectious diseases and cardiovascular diseases; assays, screening kits, devices, and equipment for medical analysis and diagnosis of disorders and physiological processes; assays, screening kits, devices, and equipment for measurement of disease markers for medical purposes; carbohydrate inhibiting enzymes for use in disease treatment; fungal lytic enzymes for the treatment of fungal infections; pharmaceuticals for treatment of lysosomal storage diseases; pharmaceuticals for treatment of mucopolysaccharidoses; pharmaceuticals for treatment of carbohydrate-inhibiting enzyme disorders; proteins and enzymes for the production, purification and isolation of biologics for use in the treatment of medical conditions; biologics produced by recombinant DNA technology for use in the treatment of pathological medical conditions, in International Class 5.

ANSWER: Admitted.

6) Upon information and belief, Opposer's BIOMIRA application and use of the BIOMIRA trade name predates the Applicant's BIOMARIN application.

ANSWER: Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 6.

7) Upon information and belief, the assays, screening kits, devices, equipment and pharmaceutical preparations to be offered by Applicant under the BIOMARIN mark are closely

enough related to the pharmaceutical preparations, manufacturing services and research services sold and/or intended to be sold by Opposer under the BIOMIRA mark as to be likely to lead to confusion.

ANSWER: Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 7.

8) Applicant's intended use of the mark BIOMARIN, for the goods noted above so nearly resembles Opposer's BIOMIRA mark for the products and services covered in its application, specifically, pharmaceutical preparations used in the diagnosis and treatment of cancer; pharmaceutical preparations used in active specific immunotherapy for the treatment of cancer; vaccines for prophylactic use; and in vivo and in vitro medical diagnostic kits comprised primarily of reagents; manufacture services for others, namely manufacture of pharmaceutical preparations used in the diagnosis and treatment of cancer; pharmaceutical preparations used in active specific immunotherapy for the treatment of cancer; vaccines for prophylactic use; and in vivo and in vitro medical diagnostic kits comprised primarily of reagents; and pharmaceutical research in the fields of pharmaceutical preparations used in the diagnosis and treatment of cancer; pharmaceutical preparations used in active specific immunotherapy for the treatment of cancer; vaccines for prophylactic use; and in vivo and in vitro medical diagnostic kits comprised primarily of reagents, as to be likely to cause confusion, mistake or deception under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

ANSWER: Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 8.

9) The registration of Applicant's mark on the Principal Register would be inconsistent with Opposer's rights under its aforementioned application, and would be damaging to Opposer and its use of the trade name BIOMIRA.

ANSWER: Denied.

Respectfully submitted,
BIOMARIN PHARMACEUTICAL INC.

Dated: October 13, 2003



Beau D. Barberis
Richard M. LaBarge
Attorneys for Applicant

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6300 Sears Tower
Chicago, Illinois 60606
(312) 474-6300 (telephone)
(312) 474-0448 (facsimile)

CERTIFICATE OF MAILING

I hereby certify that the foregoing Answer to Notice of Opposition is being deposited with the United States Postal Service as first-class mail, postage prepaid, in an envelope addressed to BOX TTAB, U.S. Patent and Trademark Office, Trademark Trial and Appeal Board, 2900 Crystal Drive, Arlington, VA 22202-3514 on October 13, 2003.


Beau D. Barberis

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Mark E. Ungerman, Esq.
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801 Pennsylvania Avenue, N.W.
Washington, D.C. 20004


Beau D. Barberis

TTAB

MARSHALL, GERSTEIN & BORUN LLP

ATTORNEYS - AT - LAW

10-16-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

October 13, 2003

Commissioner for Trademarks
Box TTAB NO FEE
2900 Crystal Drive
Arlington, Virginia 22202-3514

Re: Biomira, Inc. v. Biomarin Pharmaceutical Inc.
Trademark Opposition No. 157,636
Mark: BIOMARIN - U.S. Serial No. 76/240,537

Dear Madam:

Enclosed please find the following documents for filing in the above opposition proceeding:

- (1) Answer to Notice of Opposition;
- (2) Applicant's Substitution of Counsel; and
- (3) postcard for use by TTAB in acknowledging receipt of enclosed documents.

Respectfully submitted,



Beau D. Barberis

Enclosures