

ESTTA Tracking number: **ESTTA185012**

Filing date: **01/07/2008**

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	Merck & Co., Inc.
Granted to Date of previous extension	01/06/2008
Address	One Merck Drive, P. O. Box 100 Whitehouse Station, NJ 08889-0100 UNITED STATES
Attorney information	William R. Hansen, Bridget A. Short Lathrop & Gage L.C. 230 Park Avenue Suite 1847 New York, NY 10169 UNITED STATES whansen@lathropgage.com, bshort@lathropgage.com, smorales@lathropgage.com

**Applicant Information**

Application No	77083225	Publication date	07/10/2007
Opposition Filing Date	01/07/2008	Opposition Period Ends	01/06/2008
Applicant	Duramed Pharmaceuticals, Inc. 5040 Duramed Drive Cincinnati, OH 452132520 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 005. First Use: 2006/04/17 First Use In Commerce: 2006/04/17 All goods and services in the class are opposed, namely: Pharmaceuticals for the treatment of female hormonal dysfunction
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
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**Mark Cited by Opposer as Basis for Opposition**

U.S. Registration No.	3261637	Application Date	04/07/2005
Registration Date	07/10/2007	Foreign Priority Date	NONE
Word Mark	JANUVIA		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 005. First use: First Use: 2006/10/20 First Use In Commerce: 2006/10/20 Pharmaceutical preparations for the treatment of diabetes

Related Proceedings	91179289, 91175312
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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	/suzanna m m morales/
Name	Suzanna M. M. Morales
Date	01/07/2008



published in The Official Gazette of July 10, 2007, and having previously been granted an extension of time to oppose, hereby opposes the same.

The grounds for opposition are as follows:

1. Opposer is a leading research-driven pharmaceutical products and services company, which discovers, develops, manufactures, and markets a broad range of innovative medical and pharmaceutical products and services designed to improve and preserve human health.

2. Since long prior to the filing date of the application herein opposed, Opposer has been and continues to be a world business leader in the distribution and sale of medical and pharmaceutical preparations throughout the United States and the world.

3. Since October 20, 2006, the Opposer has used, and continues to use the trademark JANUVIA for pharmaceutical preparations for the treatment of diabetes. Opposer is the owner of the trademark JANUVIA registered on the Principal Register on July 10, 2007 under Reg. No. 3,261,637 for pharmaceutical preparations for the treatment of diabetes. Opposer's application that matured into Reg. No. 3,261,637 was filed on April 7, 2005, more than one year and nine months prior to Applicant's Application No. 77/083,225 for ENJUVIA and Design was filed.

4. Opposer has distributed and offered for sale and sold pharmaceutical preparations bearing the distinctive trademark JANUVIA, which identifies and distinguishes Opposer's pharmaceutical preparation from those of others.

5. Opposer has made use of the trademark JANUVIA by applying it to labeling, packaging, promotional materials, and product literature, and by featuring the mark in national print and television advertising, and by using the mark on other

materials promoting the pharmaceutical product distributed by Opposer in interstate commerce.

6. As a result of the quality of Opposer's product and its growing acceptance in the health care industry, Opposer's distinctive trademark JANUVIA has come to have great value to Opposer, and the health care industry and the public have come to use the famous mark to identify and distinguish Opposer's goods from those of others.

7. Upon information and belief, Applicant filed its application to register the designation ENJUVIA and Design as a trademark on January 15, 2007 under Section 1(a) of the Trademark Law on the basis of use of the mark in interstate commerce (Serial No. 77/083,225) on and in connection with Applicant's Goods.

8. Upon information and belief, Applicant has alleged use of the mark ENJUVIA and Design in interstate commerce as of April 17, 2006. Therefore, Applicant did not allege a first use in commerce until a year after Opposer filed the application on April 4, 2007 that matured into Reg. No. 3,261,637.

9. Upon information and belief, Applicant is a subsidiary of Barr Laboratories, Inc. ("Barr"). On March 9, 2006, Barr filed Opposition No. 91175312 (the "Parallel Proceeding") before this Board against a separate application filed by Merck for its United States Trademark Application Serial No. 78/833,412 for JANUVIA and Design, for pharmaceutical preparations for the treatment of addiction, urinary incontinence, diabetes, cardiovascular diseases and disorders, cerebrovascular diseases and disorders, anxiety, depression, insomnia, cognitive disorders, diseases and disorders of the central nervous system, gastrointestinal diseases and disorders, obesity, inflammation and inflammatory diseases, respiratory diseases and disorders, musculo-

skeletal disorders and osteoporosis—Anti-infective preparations; Anti-viral preparations; Immunological preparations; Analgesic preparations; Antiemetic preparations.

10. In response to the notice of opposition in the Parallel Proceeding, Merck alleged, *inter alia*, that there is no likelihood of confusion between its JANUVIA and Design mark (Serial No. 78/833,412) and Barr's claimed ENJUVIA mark (Serial No. 78/719,505) because the marks and goods identified in the respective parties' applications are not confusingly similar.

11. Merck also has filed an opposition against Barr's Application No. 78/719,505 (ENJUVIA) based upon the same registration at issue in the present Opposition, namely Reg. No. 3,261,637 (JANUVIA), claiming that, if the Board finds confusing similarity, then it should also find that Merck has attained priority (Opposition No. 91179289).

12. Opposer respectfully submits that, if this Board finds in either the present proceeding or the two above-mentioned proceedings involving Opposer and Barr that the parties' marks are confusingly similar, the Board should additionally find that Opposer's JANUVIA mark (Reg. No. 3,261,637) has attained priority over Applicant's claimed ENJUVIA and Design mark based upon the filing date for the registered JANUVIA mark of April 7, 2005.

13. Moreover, Opposer's JANUVIA mark (Reg. No. 3,261,637) is registered in standard character form and is not limited to a specific design. As a result, Applicant cannot claim that its claimed ENJUVIA and Design mark can be differentiated due to its design.

14. Therefore, should this Board conclude that there would be a likelihood of confusion, Opposer would be damaged by the registration sought by Applicant because such registration would support and assist Applicant in the confusing and misleading use of Applicant's mark; would be likely to cause confusion, or to cause mistake, or to deceive, or to cause confusion as to connection, association, or sponsorship of the Opposer.

WHEREFORE, Opposer respectfully requests that the opposition to the application for registration of the mark ENJUVIA and Design be sustained and that the registration sought by Applicant be refused.

Dated: New York, New York  
January 7, 2008

LATHROP & GAGE L.C.  
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