

ESTTA Tracking number: **ESTTA206714**

Filing date: **04/23/2008**

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	Pharmexa A/S
Granted to Date of previous extension	04/23/2008
Address	Kogle Alle 6 2970 Horsholm, DENMARK

Attorney information	Cynthia Clarke Weber Sughrue Mion, PLLC 2100 Pennsylvania Avenue, NW Washington, DC 20037 UNITED STATES tm@sughrue.com, mwhite@sughrue.com Phone:202-663-7927
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**Applicant Information**

Application No	78950638	Publication date	12/25/2007
Opposition Filing Date	04/23/2008	Opposition Period Ends	04/23/2008
International Registration No.	NONE	International Registration Date	NONE
Applicant	Pharmaxis Ltd Unit 2, 10 Rodborough Road Frenchs Forest, N.S.W., 2086 AUSTRALIA		

**Goods/Services Affected by Opposition**

<p>Class 005. All goods and services in the class are opposed, namely: Pharmaceutical preparations to treat and prevent diseases and disorders associated with the respiratory system; pharmaceutical preparations to treat and prevent chronic obstructive pulmonary diseases and disorders; pharmaceutical preparations for the treatment and prevention of bronchiectasis; pharmaceutical preparations for the treatment and prevention of chronic bronchitis; and pharmaceutical preparations for the treatment and prevention of cystic fibrosis; inhalers filled with pharmaceutical preparations to treat and prevent diseases and disorders associated with the respiratory system; inhalers filled with pharmaceutical preparations to treat and prevent chronic obstructive pulmonary diseases and disorders; inhalers filled with pharmaceutical preparations for the treatment and prevention of bronchiectasis; inhalers filled with pharmaceutical preparations for the treatment and prevention of chronic bronchitis; inhalers filled with pharmaceutical preparations for the treatment and prevention of cystic fibrosis</p>
<p>Class 010. All goods and services in the class are opposed, namely: Inhalers for medical purposes, sold empty; inhalers for therapeutic purposes, sold empty; pressurized metered dose medical inhalers, sold</p>

empty; dry powder inhalers for medical or therapeutic use, sold empty; medical inhalers sold empty; apparatus for administering drugs or pharmaceutical preparations by inhalation, namely, nebulizers for respiration therapy and medical apparatus for facilitating the inhalation of pharmaceutical preparations; and drug delivery apparatus, namely, drug delivery systems; replacement parts and fittings for the aforementioned goods

## 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.	3319312	Application Date	10/29/2001
Registration Date	10/23/2007	Foreign Priority Date	NONE
Word Mark	PHARMEXA		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 001. First use: First Use: 2001/06/01 First Use In Commerce: 2003/05/01            Chemical products for use in the development of pharmaceuticals, vaccines, namely, therapeutic, subcomponent, polypeptide and live vaccines, viral and nucleic acids vaccines, DNA vaccines, vaccine excipients, vaccine carriers, and vaccine adjuvants for medical science; chemical preparations for analyses in laboratories for in vivo analyses for medical purposes; non-pathogenic microorganisms and vira for vaccine use, polypeptides, protein and nucleic acids, including DNA for vaccine use</p> <p>Class 005. First use: First Use: 2001/06/01 First Use In Commerce: 2003/05/01            Pharmaceutical preparations and substances for the treatment of neoplastic disorders, inflammatory disorders, infectious diseases, traumatic disorders, metabolic disorders, hematologic respiratory disorders, vascular and cardiac disorders, endocrinologic disorders, muscular disorders, skeletal and bone disorders, neurological disorders, skin and mucosal disorders, psychiatric disorders, lymphatic disorders, intestinal disorders, urologic disorders, and reproductive disorders; vaccines, namely, therapeutic vaccines, subcomponent vaccines, polypeptide vaccines, live vaccines, viral vaccines, nucleic acid vaccines and DNA vaccines, vaccine recipients, vaccine carriers, vaccines adjuvants; vaccines containing non-pathogenic microorganisms and vira; vaccines containing polypeptides, protein and nucleic acids, including DNA</p> <p>Class 042. First use: First Use: 2001/06/01 First Use In Commerce: 2003/05/01            Scientific, industrial biotechnological and biomedical research; pharmaceutical, biomedical and biotechnological development of therapeutic vaccines, other vaccines and pharmaceuticals; chemical, biochemical and molecular biological analyses; medical and scientific research, namely, in vitro and in vivo preclinical tests of potential drugs; medical and scientific research, namely, in vitro and in vivo research concerning therapeutic vaccines, other vaccines and potential drugs; scientific, industrial biotechnological and biomedical consultancy concerning the above analyses, tests and research; biomedical and pharmaceutical clinical testing and research</p>		

Attachments	400130 Notice of Opposition (April 23, 2008).pdf ( 5 pages )(16596 bytes )
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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	/Cynthia C. Weber/
Name	Cynthia Clarke Weber
Date	04/23/2008

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

In re the Matter of

Applicant: Pharmaxis Ltd.

Application Serial No.: 78950638

Mark: PHARMAXIS (Stylized)

Filed: August 11, 2006

Official Gazette: December 25, 2007

PHARMEXA A/S,

Opposer,

v.

PHARMAXIS LTD.,

Applicant.

Opposition No.:

**NOTICE OF OPPOSITION**

Pharmexa A/S, a public limited company of Denmark, with an address at Kogle Allé 6, 2970 Horsholm, Denmark, believes that it will be damaged by registration of the mark PHARMAXIS shown in Application Serial No. 78950638 and hereby opposes same.

As grounds for the opposition, it is alleged that:

1. Opposer is now, and has for several years, been engaged in providing research, testing, development and related services in International Class 42 in the United States and abroad under the trademark and trade name PHARMEXA.

2. Opposer's use of PHARMEXA in commerce precedes the priority filing date of Applicant's application, which is August 8, 2006.

3. Opposer is the owner of Registration No. 3319312 in the United States for PHARMEXA, which it relies on in this proceeding.

4. By virtue of advertising and sales in the United States, the trademark PHARMEXA has become known and well regarded for the services covered in Opposer's Registration No. 3319312. PHARMEXA is a valuable symbol of Opposer's goodwill.

5. The application herein opposed seeks to register the mark PHARMAXIS for "Pharmaceutical preparations to treat and prevent diseases and disorders associated with the respiratory system; pharmaceutical preparations to treat and prevent chronic obstructive pulmonary diseases and disorders; pharmaceutical preparations for the treatment and prevention of bronchiectasis; pharmaceutical preparations for the treatment and prevention of chronic bronchitis; and pharmaceutical preparations for the treatment and prevention of cystic fibrosis; inhalers filled with pharmaceutical preparations to treat and prevent diseases and disorders associated with the respiratory system; inhalers filled with pharmaceutical preparations to treat and prevent chronic obstructive pulmonary diseases and disorders; inhalers filled with pharmaceutical preparations for the treatment and prevention of bronchiectasis; inhalers filled with pharmaceutical preparations for the treatment and prevention of chronic bronchitis; inhalers filled with pharmaceutical preparations for the treatment and prevention of cystic fibrosis," in International Class 5 and "Inhalers for medical purposes, sold empty; inhalers for therapeutic purposes, sold empty; pressurized metered dose medical inhalers, sold empty; dry powder inhalers for medical or therapeutic use, sold empty; medical inhalers sold empty; apparatus for administering drugs or pharmaceutical preparations by inhalation, namely, nebulizers for respiration therapy and medical apparatus for facilitating the inhalation of pharmaceutical

preparations; and drug delivery apparatus, namely, drug delivery systems; replacement parts and fittings for the aforementioned goods,” in International Class 10.

6. The goods in the opposed application are confusingly similar to Opposer’s services offered under its PHARMEXA mark and name. Applicant’s goods would be likely to be thought to have emanated from the same source as Opposer’s goods and services, or to have been approved or endorsed by Opposer.

7. The trademark in the opposed application as applied to the goods set forth in that application is confusingly and deceptively similar to Opposer’s previously used and registered PHARMEXA mark and name.

8. Opposer believes and therefore alleges that the use and registration of the alleged trademark PHARMAXIS by Applicant will damage Opposer, for the reasons, among others:

a. That purchasers and persons in the trade will be deceived as to the source and origin of Applicant’s goods offered under the mark PHARMAXIS; and

b. Purchasers, persons in the trade and others will assume, contrary to fact, that Applicant’s goods are associated with, sponsored by or otherwise related to Opposer.

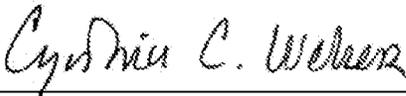
9. Registration of the mark sought by Applicant herein is barred by the provisions of Section 2(d) of the Trademark Act of 1946 for the reason that it consists of or comprises a mark which so resembles Opposer’s previously used and registered trademark and trade name as to be likely, when applied to the goods of Applicant, to cause confusion, mistake or deception.

WHEREFORE, Opposer respectfully prays that the registration sought by Applicant be refused and that this Opposition be sustained.

Please charge the \$600 opposition fee to the undersigned's Deposit Account No. 19-4880. Please charge any deficiency or credit any overpayment to the undersigned's Deposit Account No. 19-4880.

Respectfully submitted,

PHARMEXA A/S

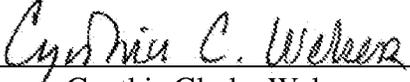
By: 

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(202) 663-7927  
Attorneys for Opposer

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing NOTICE OF OPPOSITION has been mailed this 23<sup>rd</sup> day of April, 2008, by first-class mail, postage prepaid to:

ELIZABETH A. WALKER  
KIRKPATRICK & LOCKHART NICHOLSON GRAHAM  
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BOSTON, MA 02111-2950

  
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Cynthia Clarke Weber