

ESTTA Tracking number: **ESTTA221551**

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

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	McNEIL-PPC, Inc.
Granted to Date of previous extension	07/02/2008
Address	199 Grandview Road Skillman, NJ 08558 UNITED STATES

Attorney information	James D. Weinberger Fross Zelnick Lehrman & Zissu, P.C. 866 United Nations Plaza New York, NY 10017 UNITED STATES jweinberger@fzlz.com,psilverman@fzlz.com,lpopp-rosenberg@fzlz.com Phone:212.813.5900
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Applicant Information

Application No	76682070	Publication date	03/04/2008
Opposition Filing Date	07/01/2008	Opposition Period Ends	07/02/2008
Applicant	Walgreen Co. 200 Wilmot Road Deerfield, IL 60015 UNITED STATES		

Goods/Services Affected by Opposition

Class 005. All goods and services in the class are opposed, namely: pharmaceuticals, namely, allergy medications

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	2024253	Application Date	12/28/1993
Registration Date	12/17/1996	Foreign Priority Date	NONE
Word Mark	ZYRTEC		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 005. First use: First Use: 1987/10/01 First Use In Commerce: 1996/02/18 antihistamines

Attachments	Notice of Opposition - WAL-ZYR (F0312267).PDF (10 pages)(39492 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	/Laura Popp-Rosenberg/
Name	Laura Popp-Rosenberg
Date	07/01/2008

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

McNEIL-PPC, INC.,

Opposer,

-against-

WALGREEN CO.,

Applicant.

NOTICE OF OPPOSITION

Opposer, McNEIL PPC, Inc. (“Opposer”), a corporation organized and existing under the laws of New Jersey and having an office and principal place of business at 199 Grandview Road, Skillman, New Jersey, believes that it would be damaged by the registration of the trademark WAL-ZYR in International Class 5 as applied for in Application Serial No. 76/682,070, filed on September 19, 2007 under Section 1(b) the Lanham Act based on a bona fide intent to use. As grounds for its opposition, Opposer, by its attorneys Fross Zelnick Lehrman & Zissu, P.C., alleges as follows:

1. ZYRTEC is the trademark for a leading allergy medication featuring the active ingredient cetirizine HCl.
2. ZYRTEC allergy medication was developed by UCB Pharma, S.A. (“UCB”).
3. Following approval by the U.S. Food and Drug Administration (the “FDA”), ZYRTEC allergy medication was offered for sale in the United States by Pfizer Inc. under license from UCB on a prescription basis beginning in 1996 and continuing through early 2008.
4. With over \$12 billion in prescription sales and \$775 million in marketing expenditures, ZYRTEC allergy medication was until early 2008 the leading prescribed allergy treatment, with a reputation for high quality and safety.

5. Opposer, a subsidiary of Johnson & Johnson, is a leading supplier of consumer health care products.
6. In 2007 Opposer became UCB's exclusive U.S. licensee for the over-the-counter version of ZYRTEC.
7. In late 2007, ZYRTEC allergy medication was approved by the FDA for over-the-counter use.
8. In advance of over-the-counter launch of ZYRTEC, and shortly following the launch, Opposer undertook a huge marketing push to promote the product, both in television and print media, on the internet (including on such websites as zyrtecotc.com, zyrtec.com, and zyrtopia.com), through specially sponsored events (including the creation of a ZYRTEC dome in Manhattan's Central Park), in direct-to-consumer mailings (to each of the approximately nine million people in the U.S. who had ever filled a prescription for ZYRTEC allergy medication) and at direct retail points such as drug stores.
9. ZYRTEC allergy medication was made available over-the-counter in the United States in the last week of January, 2008 and continues to be sold by Opposer's McNeil Consumer Healthcare Division since that time.
10. Since the over-the-counter ZYRTEC was launched, sales of the product have totaled over \$60 million through March, 2008.
11. Opposer and UCB have invested a substantial amount of time, effort and money in promoting the ZYRTEC mark and the goods offered thereunder.
12. As a result of 12 years of marketing ZYRTEC as a prescription drug with substantial sales, marketing and promotion, and as result of Opposer's investment of time, money and effort in over-the-counter ZYRTEC, the ZYRTEC mark has come to be recognized

as well known and famous, identifying goods finding their origin exclusively in or otherwise associated with Opposer and UCB, and represents a substantial goodwill of Opposer and UCB.

13. Opposer is the exclusive licensee of UCB's U.S. Reg. No. 2,024,253, issued December 17, 1996 for ZYRTEC for "antihistamines" in International Class 5 based on first use in commerce of February 18, 1996. This registration is valid, subsisting and in full force and effect, and constitutes evidence of UCB and Opposer's exclusive right to use the ZYRTEC mark pursuant to Sections 7 and 33 of the Lanham Act, 15 U.S.C. §§ 1057, 1115(b). Attached hereto as Exhibit A is a true and correct copy of the current status and title of U.S. Registration No. 2,024,253 from the U.S. Patent & Trademark Office's TARR web server.

14. Upon information and belief, Applicant is an Illinois corporation located and doing business at 200 Wilmot Road, Deerfield, Illinois.

15. On or about September 19, 2007 Applicant filed an application to register the mark WAL-ZYR for "pharmaceuticals, namely, allergy medications" in International Class 5, App. Ser. No. 76/682,070 based on an intent to use (the "Application").

COUNT I -- LIKELIHOOD OF CONFUSION

16. Opposer repeats and realleges the allegations set forth in paragraphs 1 through 15 as if fully set forth herein.

17. Applicant's WAL-ZYR mark is highly similar to Opposer's ZYRTEC mark.

18. The goods set forth in the Application are closely related if not identical to the goods in connection with which Opposer uses the ZYRTEC mark, as both Opposer's and Applicant's marks are used in connection with allergy medication.

19. Upon information and belief, Applicant has targeted and/or intends to target the same type of customers that now purchase Opposer's ZYRTEC products or to whom Opposer markets and promotes its ZYRTEC products.

20. Upon information and belief, Applicant markets and intends to market its WAL-ZYR product directly next to Opposer's ZYRTEC product on store shelves and in Opposer's in-store display units.

21. Based on the similarities of the parties' respective marks and goods, the public is likely to falsely associate the goods of Applicant under the WAL-ZYR mark with Opposer or with Opposer's goods; or to falsely believe that Applicant's goods emanate from or are sponsored, endorsed, manufactured by or licensed by Opposer; or to falsely believe that there is some relationship between Applicant and Opposer.

22. Applicant's Application and the presumption of exclusivity that would arise from a registration to Applicant of the WAL-ZYR mark are inconsistent with the prior rights of Opposer in the ZYRTEC mark and the rights of flowing from its UCB's federal trademark registration.

23. Upon information and belief, Applicant did not use the WAL-ZYR mark prior to the adoption and use of the ZYRTEC mark by UCB.

24. Upon information and belief, Applicant's retail pharmacies have sold the ZYRTEC product from when it was first licensed to Pfizer Inc. by prescription only, until present day, when it is sold over-the-counter by Opposer, both under license from UCB.

25. Use and registration of the WAL-ZYR mark by Applicant in connection with its goods in International Class 5 is likely to cause confusion, cause mistake or deceive consumers, and cause them to believe that the goods offered under Applicant's WAL-ZYR mark emanate from, or are sponsored by, manufactured by, endorsed by or otherwise connected with Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d). By reason of the foregoing, Opposer will be damaged by the registration of Applicant's WAL-ZYR mark.

COUNT II -- DILUTION

26. Opposer repeats and realleges the allegations set forth in paragraphs 1 through 25 as if fully set forth herein.

27. Long before any use of or alleged rights of Applicant in the mark hereby opposed, the ZYRTEC mark became famous and distinctive of the goods sold by Opposer under license from UCB.

28. Upon information and belief, Applicant adopted and applied to register WAL-ZYR with full knowledge of the prior use and fame of the ZYRTEC mark.

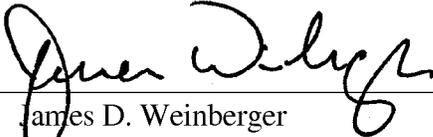
29. Applicant was also on constructive notice of Opposer and UCB's exclusive rights in ZYRTEC by virtue of UCB's federal trademark registration therefor.

30. The use of WAL-ZYR by Applicant will cause dilution of the distinctive quality of the famous ZYRTEC mark, in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c)(1), an independent and additional ground for opposing the subject application pursuant to Section 13(a) of the Lanham Act, 15 U.S.C. § 1063(a). By reason of the foregoing, Opposer will be damaged by the registration of the WAL-ZYR mark.

WHEREFORE, it is respectfully requested that this opposition be sustained and that the registration in Class 5 sought by Application Serial No. 76/682,070 be denied.

Dated: July 1, 2008

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By: 
James D. Weinberger
Laura Popp-Rosenberg

866 United Nations Plaza
New York, New York 10017
(212) 813-5900

Attorneys for Opposer

EXHIBIT A

Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2008-06-30 17:54:21 ET

Serial Number: 74473580 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 2024253

Mark (words only): ZYRTEC

Standard Character claim: No

Current Status: This registration has been renewed.

Date of Status: 2006-10-25

Filing Date: 1993-12-28

Transformed into a National Application: No

Registration Date: 1996-12-17

Register: Principal

Law Office Assigned: LAW OFFICE 105

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 830 -Post Registration

Date In Location: 2006-10-25

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. UCB PHARMA, S.A.

Address:

UCB PHARMA, S.A.

ALLEE DE LA RECHERCHE, 60 INTELLECTUAL PROPERTY DEPARTMENT

B-1070 BRUSSELS

Belgium

Legal Entity Type: Corporation

State or Country of Incorporation: Belgium

GOODS AND/OR SERVICES

International Class: 005

Class Status: Active

antihistamines

Basis: 1(a)

First Use Date: 1987-10-01

First Use in Commerce Date: 1996-02-18

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2007-05-30 - Automatic Update Of Assignment Of Ownership
2007-05-23 - Automatic Update Of Assignment Of Ownership
2007-05-23 - Assignment Of Ownership Not Updated Automatically
2007-05-23 - Automatic Update Of Assignment Of Ownership
2007-05-02 - Assignment Of Ownership Not Updated Automatically
2006-10-25 - First renewal 10 year
2006-10-25 - Section 8 (10-year) accepted/ Section 9 granted
2006-10-18 - Assigned To Paralegal
2006-09-13 - Case File In TICRS
2006-08-11 - Combined Section 8 (10-year)/Section 9 filed
2006-08-11 - PAPER RECEIVED
2006-08-11 - Applicant/Correspondence Changes (Non-Responsive) Entered
2006-08-11 - TEAS Change Of Owner Address Received
2003-01-24 - Section 8 (6-year) accepted & Section 15 acknowledged
2002-11-15 - Section 8 (6-year) and Section 15 Filed
2002-11-15 - PAPER RECEIVED
1996-12-17 - Registered - Principal Register
1996-09-27 - Allowed for Registration - Principal Register (SOU accepted)

1996-09-25 - Examiners Amendment -Written
1996-09-09 - Non-final action mailed
1996-08-12 - Statement of use processing complete
1996-05-14 - Amendment to Use filed
1996-02-02 - Extension 2 granted
1995-11-21 - Extension 2 filed
1995-07-15 - Extension 1 granted
1995-05-17 - Extension 1 filed
1994-11-22 - Notice of allowance - mailed
1994-08-30 - Published for opposition
1994-07-29 - Notice of publication
1994-05-16 - Approved for Pub - Principal Register (Initial exam)
1994-05-12 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

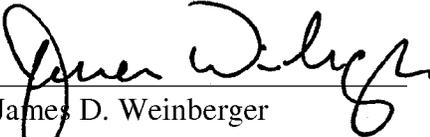
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Phone Number: 202-721-8200

Domestic Representative
WENDEROTH, LIND & PONACK

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing NOTICE OF OPPOSITION was sent by first class mail postage pre-paid to Applicant's attorney, Francis C. Kowalik, Esq., Walgreen & Co., 200 Wilmot Road Deerfield Illinois 60015, this 1st day of July, 2008.


James D. Weinberger