

ESTTA Tracking number: **ESTTA230295**

Filing date: **08/13/2008**

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 | DrugTech Corporation |
| Granted to Date of previous extension | 08/13/2008 |
| Address | 300 Delaware Avenue, Suite 1270 Wilmington, DE 19801 UNITED STATES |

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| Attorney information | Bryce J. Maynard Buchanan Ingersoll & Rooney PC P.O. Box 1404 Alexandria, VA 22313-1404 UNITED STATES bryce.maynard@bipc.com |
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Applicant Information

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|------------------------|--|------------------------|------------|
| Application No | 77318993 | Publication date | 04/15/2008 |
| Opposition Filing Date | 08/13/2008 | Opposition Period Ends | 08/13/2008 |
| Applicant | Upsher-Smith Laboratories, Inc. 6701 Evenstad Drive Maple Grove, MN 55369 UNITED STATES | | |

Goods/Services Affected by Opposition

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|--|
| Class 005. All goods and services in the class are opposed, namely: Prenatal vitamins |
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Grounds for Opposition

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

Marks Cited by Opposer as Basis for Opposition

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|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 1365182 | Application Date | 04/01/1985 |
| Registration Date | 10/15/1985 | Foreign Priority Date | NONE |
| Word Mark | PRECARE | | |
| Design Mark | | | |

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|---------------------|--|
| Description of Mark | NONE |
| Goods/Services | Class 005. First use: First Use: 1980/07/17 First Use In Commerce: 1980/07/17 NUTRITIONAL SUPPLEMENTS |

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|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 2721740 | Application Date | 10/08/1999 |
| Registration Date | 06/03/2003 | Foreign Priority Date | NONE |

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|-----------|------------|
| Word Mark | PREMESISRX |
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|-------------|--|
| Design Mark | |
|-------------|--|

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|---------------------|------|
| Description of Mark | NONE |
|---------------------|------|

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|----------------|--|
| Goods/Services | Class 005. First use: First Use: 1999/09/22 First Use In Commerce: 1999/09/22 ANTI-NAUSEA PHARMACEUTICAL PREPARATIONS; NUTRITIONAL SUPPLEMENTS FOR TREATING NAUSEA; AND NUTRITIONAL SUPPLEMENT AND VITAMINS |
|----------------|--|

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|-------------|---|
| Attachments | Notice of Opposition PRENEX.pdf (5 pages)(31462 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 | /Bryce J. Maynard/ |
| Name | Bryce J. Maynard |
| Date | 08/13/2008 |

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

RE: U.S. Trademark Application Serial No. 77/318,993
Published in the *Official Gazette* on April 15, 2008

| | | |
|------------------------------------|---|----------------------|
| DRUGTECH CORPORATION, |) | |
| |) | |
| Opposer, |) | |
| |) | Opposition No. _____ |
| -v- |) | |
| |) | |
| UPSHER-SMITH LABORATORIES, INC. |) | |
| |) | |
| Applicant |) | |
| |) | |
| Attorney Docket No. 1032058-000737 |) | |
| _____ |) | |

NOTICE OF OPPOSITION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

Commissioner:

In the matter of U.S. Trademark Application Serial No. 77/318,993, filed on November 1, 2007 by Upsher-Smith Laboratories (“Applicant”), to register the mark PRENEX (“Applicant’s PRENEX Mark”) in connection with "prenatal vitamins" in International Class 5 (“Applicant’s Goods”), and published in the *Official Gazette* on April 15, 2008, Drugtech Corporation ("Opposer")

believes that it will be damaged by registration of Applicant's PRENEX Mark and hereby opposes same. The grounds for this opposition are as follows:

1. Applicant is the record owner of Application Serial No. 77/318,993 for Applicant's PRENEX Mark in connection with Applicant's Goods.

2. Upon information and belief, Applicant did not use Applicant's PRENEX Mark in connection with Applicant's Goods prior to November 1, 2007, the filing date of Application Serial No. 77/318,993.

3. Upon information and belief, Applicant did not use Applicant's PRENEX Mark in connection with Applicant's Goods in interstate commerce in the United States prior to November 1, 2007, the filing date of Application Serial No. 77/318,993.

4. Opposer is a Delaware Corporation with a business address at 900 Market Street, Wilmington, Delaware 19801.

5. Opposer is the owner of U.S. Trademark Registration No. 2,721,740 for the mark PREMESISRX (hereinafter "Opposer's PREMESISRX Mark") in connection with "anti-nausea pharmaceutical preparations; nutritional supplements for treating nausea; and nutritional supplement and vitamins" in International Class 5 (hereinafter referred to as "Opposer's PREMESISRX Goods").

6. Commencing long prior to the filing date of Application Serial No. 77/318,993, Opposer has been and is now engaged in the business of advertising, offering for sale and selling Opposer's PREMESISRX Goods under Opposer's PREMESISRX Mark.

7. Commencing long prior to the filing date of Application Serial No. 77/318,993, Opposer has used and is now using Opposer's PREMESISRX Mark in connection with the

advertising, offering for sale and selling of Opposer's PREMESISRX Goods in interstate commerce in the United States.

8. Due to Opposer's longstanding and continuous use of Opposer's PREMESISRX Mark in connection with Opposer's PREMESISRX Goods, Opposer's PREMESISRX Mark has become well known as designating Opposer's PREMESISRX Goods throughout the United States. Opposer's PREMESISRX Mark has also become famous.

9. Opposer enjoys substantial and exclusive goodwill and a fine reputation throughout the United States in connection with Opposer's PREMESISRX Mark.

10. Opposer is also the owner of U.S. Trademark Registration No. 1,365,182 for the mark PRECARE (hereinafter "Opposer's PRECARE Mark") in connection with "nutritional supplements" in International Class 5 (hereinafter referred to as "Opposer's PRECARE Goods").

11. Commencing long prior to the filing date of Application Serial No. 77/318,993, Opposer has been and is now engaged in the business of advertising, offering for sale and selling Opposer's PRECARE Goods under Opposer's PRECARE Mark.

12. Commencing long prior to the filing date of Application Serial No. 77/318,993, Opposer has used and is now using Opposer's PRECARE Mark in connection with the advertising, offering for sale and selling of Opposer's PRECARE Goods in interstate commerce in the United States.

13. Due to Opposer's longstanding and continuous use of Opposer's PRECARE Mark in connection with Opposer's PRECARE Goods, Opposer's PRECARE Mark has become well known as designating Opposer's Goods throughout the United States. Opposer's PRECARE Mark has also become famous.

14. Opposer enjoys substantial and exclusive goodwill and a fine reputation throughout the United States in connection with Opposer's PRECARE Mark.

15. Applicant's PRENEX Mark in Application Serial No. 77/318,993 is highly similar to Opposer's PREMESISRX Mark in sight, sound, and commercial impression.

16. Applicant's PRENEX Mark in Application Serial No. 77/318,993 is highly similar to Opposer's PRECARE Mark in sight, sound, and commercial impression.

17. Applicant's Goods are identical or closely related to Opposer's PREMESISRX Goods and Opposer's PRECARE Goods and are sold or will be sold to identical or highly similar types of consumers through identical or highly similar channels of trade.

18. Applicant's PRENEX Mark in Application Serial No. 77/318,993 so resembles Opposer's previously registered and used PREMESISRX Mark as to be likely, when applied to Applicant's Goods, to cause confusion, to cause mistake, or to deceive, by creating the erroneous impression that Applicant's Goods originate from or are associated with Opposer, or that Applicant's Goods are authorized, endorsed or sponsored by Opposer.

19. Applicant's PRENEX Mark in Application Serial No. 77/318,993 so resembles Opposer's previously registered and used PRECARE Mark as to be likely, when applied to Applicant's Goods, to cause confusion, to cause mistake, or to deceive, by creating the erroneous impression that Applicant's Goods originate from or are associated with Opposer, or that Applicant's Goods are authorized, endorsed or sponsored by Opposer.

20. Applicant's PRENEX Mark in Application Serial No. 77/318,993 is likely to cause dilution of Opposer's PREMESISRX and PRECARE Marks.

21. Applicant's filing of Application Serial No. 77/318,993 for Applicant's PRENEX Mark was without license, authorization or permission from Opposer.

22. The granting of a trademark registration for Applicant's PRENEX Mark would violate and diminish the prior and superior rights of Opposer in Opposer's PREMESISRX Mark and Opposer's PRECARE Mark and would be in violation of 15 U.S.C. § 1052(d).

23. Opposer would be damaged if Application Serial No. 77/318,993 is allowed to register because Applicant will obtain statutory rights in Applicant's PRENEX Mark in violation and derogation of the established prior rights of Opposer in Opposer's PREMESISRX Mark and Opposer's PRECARE Mark.

WHEREFORE, Opposer requests that its Opposition be sustained, that Application Serial No. 77/318,993 be rejected and that the registration of Applicant's PRENEX Mark as a trademark to Applicant be refused, and for such other relief as may be deemed just and proper.

Respectfully submitted,

DRUGTECH CORPORATION

Date: August 13, 2008

/Bryce J. Maynard/

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Attorneys for Opposer