

ESTTA Tracking number: **ESTTA276161**

Filing date: **04/03/2009**

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 | Cell Genesys, Inc. |
| Granted to Date of previous extension | 04/05/2009 |
| Address | 400 Oyster Point Boulevard Suite 525 South San Francisco, CA 94080 UNITED STATES |
| Attorney information | Chelseaa Bush Orrick Herrington & Sutcliffe LLP The Orrick Building 405 Howard Street San Francisco, CA 94105 UNITED STATES ipprosecutionsf@orrick.com |

Applicant Information

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|------------------------|---|------------------------|------------|
| Application No | 77469080 | Publication date | 10/07/2008 |
| Opposition Filing Date | 04/03/2009 | Opposition Period Ends | 04/05/2009 |
| Applicant | CellCeuticals Skin Care, Inc. Suite 222 120 South Spalding Drive Beverly Hills, CA 90212 UNITED STATES | | |

Goods/Services Affected by Opposition

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| Class 003. All goods and services in the class are opposed, namely: non-medicated skin care preparations, namely, creams, lotions, gels and serums |
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Grounds for Opposition

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

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|-----------------------|--------------|-----------------------|------------|
| U.S. Registration No. | 1772613 | Application Date | 12/05/1990 |
| Registration Date | 05/18/1993 | Foreign Priority Date | NONE |
| Word Mark | CELL GENESYS | | |
| Design Mark | | | |
| Description of | NONE | | |

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| Mark | |
| Goods/Services | Class 042. First use: First Use: 1992/09/25 First Use In Commerce: 1992/09/25 research and product development services concerning biotechnology |

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|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 2604222 | Application Date | 03/29/2001 |
| Registration Date | 08/06/2002 | Foreign Priority Date | NONE |

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| Word Mark | CELL GENESYS |
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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: 1994/10/24 First Use In Commerce: 1994/10/24 PHARMACEUTICAL PREPARATIONS IN THE NATURE OF VIRAL VECTORS, CANCER VACCINES, PACKAGING CELLS AND CELLS TRANSFORMED WITH VIRAL VECTORS, ALL FOR THE TREATMENT OF CANCER, [AUTOIMMUNE DISEASES,] INFECTIOUS DISEASES, INFLAMMATORY DISEASES AND GENETIC DISEASES |
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| U.S. Registration No. | 2604223 | Application Date | 03/29/2001 |
| Registration Date | 08/06/2002 | Foreign Priority Date | NONE |

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| Word Mark | CELL GENESYS |
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| Design Mark |  |
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| Description of Mark | NONE |
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|----------------|---|
| Goods/Services | Class 001. First use: First Use: 1994/10/24 First Use In Commerce: 1994/10/24 BIOCHEMICAL PREPARATIONS IN THE NATURE OF VIRAL VECTORS, PACKAGING CELLS AND CELLS TRANSFORMED WITH VIRAL VECTORS, ALL FOR RESEARCH USE |
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| | |
|-------------|---|
| Attachments | 76232409#TMSN.gif (1 page)(bytes) 76232410#TMSN.gif (1 page)(bytes) CELLGENESIS.pdf (5 pages)(96024 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 | /ChelseaaBush/ |
| Name | Chelseaa Bush |
| Date | 04/03/2009 |

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

In the Matter of Application Serial No. 77/469080
Published in the *Official Gazette* on October 7, 2008
Trademark: **CELLGENESIS**

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|--------------------------------|--|
| Cell Genesys, Inc., | |
| Opposer | |
| v. | |
| CellCeuticals Skin Care, Inc., | |
| Applicant. | |

NOTICE OF OPPOSITION

Cell Genesys, Inc. (“Opposer”), a Delaware corporation having a principal place of business at 400 Oyster Point Boulevard, Suite 525, South San Francisco, California 94080, believes it will be damaged by registration of the mark CELLGENESIS shown in Serial No. 77/469080 in International Class 3 and hereby opposes the same.

As grounds for opposition, Opposer alleges:

1. Opposer has obtained all necessary extensions of time in which to oppose the challenged trademark following publication.

2. CellCeuticals Skin Care, Inc. (“Applicant”) has filed an application to register the mark CELLGENESIS for “non-medicated skin care preparations, namely, creams, lotions, gels and serums” in International Class 3, as evidenced by the publication of such mark in the *Official Gazette* on October 7, 2008.

3. Applicant is, upon information and belief, a California corporation having a place of business at 120 South Spalding Drive, Suite 222, Beverly Hills, California 90212.

4. Opposer has used the mark CELL GENESYS since at least as early as 1992. Opposer is the owner of numerous registrations for CELL GENESYS, including Registration No. 1772613 registered May 18, 1993 for research and product development services concerning biotechnology, Registration No. 2604222 registered August 6, 2002 for pharmaceutical preparations, and Registration No. 2604223 registered August 6, 2002 for biochemical preparations.

5. There is no issue as to priority. Upon information and belief, Applicant has not used CELLGENESIS on its goods prior to May 8, 2008, as is evidenced by Applicant's filing of its subject application on an intent-to-use basis on that date. The date of registration and use of Opposer's CELL GENESYS marks is thus well before use by Applicant of the CELLGENESIS mark, and Opposer's CELL GENESYS mark therefore has priority over Applicant's CELLGENESIS application.

6. Opposer has sold its goods and services under the mark CELL GENESYS, throughout the United States and in foreign countries and has developed exceedingly valuable goodwill with respect to the CELL GENESYS mark.

7. By virtue of its efforts and the expenditure of considerable sums for promotional and advertising activities and by virtue of the excellence of its goods and services, Opposer has gained for its CELL GENESYS mark a most valuable reputation

and has created, in the minds of the buying public, an exclusive association between the CELL GENESYS mark and its goods and services.

8. The trademark proposed for registration by Applicant, namely, CELLGENESIS, is likely to be confused with Opposer's CELL GENESYS mark because the marks are highly similar in appearance, sound and overall commercial impression.

9. Applicant seeks to register CELLGENESIS as a mark in connection with goods that are highly related to the goods of Opposer and such use so nearly resembles Opposer's use as to be likely to cause confusion, to cause mistake or to deceive within the meaning of 15 U.S.C. § 1052(d).

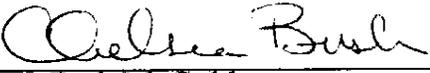
10. If Applicant is permitted to use and register CELLGENESIS for its goods as specified in the opposed application, confusion in trade resulting in damage and injury to Opposer would be caused and would result by reason of the fact that Applicant's mark is confusingly similar to Opposer's CELL GENESYS mark. Persons familiar with Opposer's CELL GENESYS mark would be likely to purchase Applicant's CELLGENESIS goods as goods offered and sold by Opposer. Furthermore, any defect, objection, or fault found with Applicant's goods marketed under CELLGENESIS would be likely to reflect upon and seriously injure the reputation that Opposer has established for its goods offered under its CELL GENESYS mark.

11. If Applicant is granted the registration herein opposed, such registration would be a source of damage and injury to Opposer.

WHEREFORE, Opposer prays that the opposition be sustained and that the application be refused for registration.

Respectfully submitted,
ORRICK HERRINGTON & SUTCLIFFE LLP

Dated: April 3, 2009

By: 
Beth M. Goldman
Chelsea Bush
Attorneys for Cell Genesys, Inc.
405 Howard Street
San Francisco, CA 94105
415-773-5700

CERTIFICATE OF SERVICE

I certify that a copy of the foregoing Notice of Opposition was served by First Class Mail, on April 3, 2009, on counsel for Applicant at the following address:

Louis C. Paul
Louis C. Paul & Associates, PLLC
420 East 61st Street, 8E
New York, NY 10028

Dated: April 3, 2009

By: 

Chelseaa E. L. Bush
Attorneys for Opposer
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San Francisco, California 94105