

ESTTA Tracking number: **ESTTA323927**

Filing date: **12/23/2009**

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	ViroPharma Incorporated
Granted to Date of previous extension	12/30/2009
Address	730 Stockton Drive Exton, PA 19341 UNITED STATES
Correspondence information	Anita B. Polott Morgan, Lewis & Bockius LLP 1111 Pennsylvania Avenue, NW Washington, DC 20004 UNITED STATES trademarks@morganlewis.com, apolott@morganlewis.com, nward@morganlewis.com, fgordon@morganlewis.com Phone:202-739-3000

**Applicant Information**

Application No	79058308	Publication date	09/01/2009
Opposition Filing Date	12/23/2009	Opposition Period Ends	12/30/2009
International Registration No.	0975870	International Registration Date	02/12/2008
Applicant	Galenica AG Untermattweg 8 CH-3001 Bern, SWITZERLAND		

**Goods/Services Affected by Opposition**

<p>Class 003. All goods and services in the class are opposed, namely: Soaps, perfumery, essential oils, cosmetics, hair lotions; dentifrices</p>
<p>Class 005. All goods and services in the class are opposed, namely: Pharmaceutical and veterinary preparations for the treatment of immunologic diseases, namely, auto immune diseases; pharmaceuticals for the treatment of acute or chronic conditions or consequences of or associated with acute or chronic renal disease, namely, acute renal insufficiency, intrinsic kidney disease, glomerulonephritis, tubular disorders, and tubulointerstitial diseases, vasculitis of the kidney, vascular injury to the kidney, infection related kidney disorders, kidney neoplasms, congenital and genetic disorders, cystic disorders of the kidney, systemic diseases effecting the kidney, drugs, contrast agents, and toxin damage to the kidney; pharmaceutical preparations for dialysis and conditions associated with dialysis; pharmaceutical preparations for transplantation and transplant related conditions affecting the kidney; preparations used to treat patients suffering from iron deficiency anemia; sanitary preparations for medical purposes, namely, parapharmaceutical products in the nature of surgical</p>

dressings and wound dressings; dietetic foods adapted for medical use, food for babies; medical plasters, materials for dressings, namely, surgical dressings and wound dressings; material for stopping teeth, dental wax; all purpose disinfectants

**Class 035.**

All goods and services in the class are opposed, namely: Import agency services in the field of medicines and pharmaceutical preparations; retail stores featuring pharmaceuticals and parapharmaceutical and healthcare products, namely, preparations for the treatment of immunologic diseases, pharmaceuticals for the treatment of acute or chronic conditions or consequences of or associated with acute or chronic renal disease, pharmaceutical preparations for dialysis and conditions associated with dialysis, preparations for transplantation and transplant related conditions affecting the kidney, preparations used to treat patients suffering from iron deficiency anemia, parapharmaceutical preparations in the nature of surgical dressings and wound dressings, dietetic foods adapted for medical use, food for babies, medical plasters, material for stopping teeth, dental wax, and all purpose disinfectants; arranging for storage, transportation, and delivery of packages, namely, medicaments, pharmaceutical products, parapharmaceutical products, and products for healthcare via ground and air carriers; import-export agency services in the field of medicines, pharmaceutical, and sanitary preparations; education leadership development in the field of pharmacy and healthcare

**Class 039.**

All goods and services in the class are opposed, namely: Transport and warehousing services, namely, transport, storage, and delivery and packaging of goods, namely, medicines, pharmaceutical, parapharmaceutical, healthcare, and sanitary preparations

**Class 041.**

All goods and services in the class are opposed, namely: Providing of training, namely, training sessions in the fields of pharmacy, healthcare, and sanitary practices and products

**Class 042.**

All goods and services in the class are opposed, namely: Scientific research and development in the field of medicines, pharmaceutical preparations, and pharmaceutical, parapharmaceutical, healthcare, and sanitary care products

**Class 045.**

All goods and services in the class are opposed, namely: Legal services and legal representation of third parties to the authorities and administration, namely, for the purposes of approval of pharmaceuticals and parapharmaceuticals

### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Lack of bona fide intent to use the mark on all of Applicant's goods and services in the application as required by section 66(a) of the Lanham Act, 15 U.S.C. Â§ 1141f(a)

### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2459907	Application Date	09/19/1996
Registration Date	06/12/2001	Foreign Priority Date	NONE
Word Mark	VIROPHARMA		

Design Mark	<b>VIROPHARMA</b>
Description of Mark	NONE
Goods/Services	Class 005. First use: First Use: 2000/09/18 First Use In Commerce: 2000/09/18 pharmaceutical preparations for the treatment of infectious diseases

U.S. Registration No.	2457511	Application Date	09/19/1996
Registration Date	06/05/2001	Foreign Priority Date	NONE

Word Mark	VIROPHARMA INCORPORATED		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 2000/09/18 First Use In Commerce: 2000/09/18 pharmaceutical preparations for the treatment of infectious diseases		

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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 Overnight Courier on this date.

Signature	/Anita B. Polott/
Name	Anita B. Polott
Date	12/23/2009

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

VIROPHARMA INCORPORATED

Opposer,

v.

GALENICA AG SOCIÉTÉ ANONYME  
Applicant.

In re Application Serial No. 79/058,308  
Published: September 1, 2009  
Opposition No. \_\_\_\_\_

**NOTICE OF OPPOSITION**

Opposer, ViroPharma Incorporated, a corporation organized and existing under the laws of Delaware, having a principal place of business at 730 Stockton Drive, Exton, Pennsylvania 19341 (“Opposer” or “ViroPharma”), believes that it will be damaged by registration of the mark VIFOR PHARMA and Design, covering the following goods:

“Soaps, perfumery, essential oils, cosmetics, hair lotions; dentifrices,” in Class 3;  
“Pharmaceutical and veterinary preparations for the treatment of immunologic diseases, namely, auto immune diseases; pharmaceuticals for the treatment of acute or chronic conditions or consequences of or associated with acute or chronic renal disease, namely, acute renal insufficiency, intrinsic kidney disease, glomerulonephritis, tubular disorders, and tubulointerstitial diseases, vasculitis of the kidney, vascular injury to the kidney, infection related kidney disorders, kidney neoplasms, congenital and genetic disorders, cystic disorders of the kidney, systemic diseases effecting the kidney, drugs, contrast agents, and toxin damage to the kidney; pharmaceutical preparations for dialysis and conditions associated with dialysis; pharmaceutical preparations for transplantation and transplant related conditions affecting the kidney; preparations used to treat patients suffering from iron deficiency anemia; sanitary preparations for medical purposes, namely, parapharmaceutical products in the nature of surgical dressings and wound dressings; dietetic foods adapted for medical use, food for babies; medical plasters, materials for dressings, namely, surgical dressings and wound dressings; material for stopping teeth, dental wax; all purpose disinfectants,” in Class 5;

“Import agency services in the field of medicines and pharmaceutical preparations; retail stores featuring pharmaceuticals and parapharmaceutical and healthcare products, namely, preparations for the treatment of immunologic diseases, pharmaceuticals for the treatment of acute or chronic conditions or consequences of or associated with acute or chronic renal disease, pharmaceutical preparations for dialysis and conditions associated with dialysis, preparations for transplantation and transplant related conditions affecting the kidney, preparations used to treat patients suffering from iron deficiency anemia, parapharmaceutical preparations in the nature of surgical dressings and wound dressings, dietetic foods adapted for medical use, food for babies, medical plasters, material for stopping teeth, dental wax, and all purpose disinfectants; arranging for storage, transportation, and delivery of packages, namely, medicaments, pharmaceutical products, parapharmaceutical products, and products for healthcare via ground and air carriers; import-export agency services in the field of medicines, pharmaceutical, and sanitary preparations; education leadership development in the field of pharmacy and healthcare,” in Class 35;

“Transport and warehousing services, namely, transport, storage, and delivery and packaging of goods, namely, medicines, pharmaceutical, parapharmaceutical, healthcare, and sanitary preparations,” in Class 39;

“Providing of training, namely, training sessions in the fields of pharmacy, healthcare, and sanitary practices and products,” in Class 41;

"Scientific research and development in the field of medicines, pharmaceutical preparations, and pharmaceutical, parapharmaceutical, healthcare, and sanitary care products,” in Class 42; and

“Legal services and legal representation of third parties to the authorities and administration, namely, for the purposes of approval of pharmaceuticals and parapharmaceuticals,” in Class 45,

(the “Applicant’s Goods and Services”) as shown in Application Serial No. 79/058,308 (the “VIFOR PHARMA Mark”) and owned by Galenica AG Société anonyme (“Applicant”).

Opposer opposes this application under the provisions of Sections 2(d), 13, and 66(a) of the Trademark Act of July 5, 1946 (the “Lanham Act”), 15 U.S.C. §§ 1052(d), 1063, and § 1141f(a).

As grounds for opposition, Opposer alleges that:

1. Opposer is a pharmaceutical company.

2. Opposer has used the mark VIROPHARMA as a company name and/or in connection with pharmaceutical products and related research, development, and other services since at least April 1995 - for almost fifteen (15) years.

3. In addition to the common law rights it owns in the different variations of the VIROPHARMA mark, Opposer owns all right, title and interest in and to U.S. Trademark Registration No. 2,459,907 for VIROPHARMA and U.S. Trademark Registration No. 2,457,511 for VIROPHARMA INCORPORATED (and Design) (collectively, "VIROPHARMA Marks").

4. Registration Nos. 2,459,907 and 2,457,511 are valid and subsisting, in full force and effect, incontestable pursuant to the provisions of Section 15 of the Lanham Act, 15 U.S.C. § 1065, and therefore constitute conclusive evidence of Opposer's ownership of and exclusive right to use the respective VIROPHARMA and VIROPHARMA and Design marks in commerce in connection with the goods specified in the registrations.

5. On February 12, 2008, Applicant filed a application under Section 66(a) of the Lanham Act, 15 U.S.C. § 1141f(a), for federal registration of the mark VIFOR PHARMA and Design for the Applicant's Goods and Services.

6. The application for registration of the VIFOR PHARMA Mark was published for opposition in the *Official Gazette* on September 1, 2009. The Trademark Trial and Appeal Board extended the opposition period for Applicant's VIFOR PHARMA application by granting Opposer's timely requests for extension. The extended opposition period is currently set to expire on December 30, 2009. Opposer therefore timely files this opposition.

7. Applicant is seeking registration of a mark that is substantially similar to Opposer's VIROPHARMA Marks.

8. The spelling of the VIFOR PHARMA Mark differs from the VIROPHARMA mark by only one letter, F, and the transposition of the letters O and R.

9. VIFOR PHARMA and VIROPHARMA share a common prefix, VI-.

10. The suffixes of VIFOR PHARMA and VIROPHARMA are identical.

11. Upon information and belief, Applicant filed its application, without a *bona fide* intent to use the mark VIFOR PHARMA in United States commerce with all of the Applicant's Goods and Services as required by Section 66(a) of the Lanham Act, 15 U.S.C. § 1141f(a).

12. As a result of Opposer's registrations for and longstanding and continuous use of its VIROPHARMA Marks, Opposer has acquired exclusive rights in its mark that predate any rights upon which Applicant may rely.

13. Opposer's rights to the VIROPHARMA Marks are superior to those of Applicant in the VIFOR PHARMA Mark.

14. Opposer believes it will be damaged by registration of Applicant's VIFOR PHARMA mark under Section 13 of the Lanham Act, 15 U.S.C. § 1063, because consumers, familiar with Opposer's VIROPHARMA Marks are likely to believe, mistakenly, that Applicant or its products or services emanate from, are sponsored by or authorized by, or are otherwise associated or affiliated with Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

15. Opposer believes it will be damaged by registration of VIFOR PHARMA, pursuant to Section 13 of the Lanham Act, 15 U.S.C. § 1063, because registration will give Applicant *prima facie* evidence of the validity of its alleged mark and of the exclusive, nationwide right to use a mark to which Applicant is not entitled due to a lack of *bona fide* intent to use the mark on

Applicant's Goods and Services at the time of filing as required by section 66(a) of the Lanham Act, 15 U.S.C § 1141f(a).

WHEREFORE, Opposer believes, for the reasons set forth above, it will be damaged by registration of Applicant's mark shown in Application Serial No. 79/058,308 and that Applicant is not entitled to the registration thereof. Opposer therefore respectfully requests that the registration sought by Applicant be refused.

Dated: December 23, 2009

Respectfully submitted,

By: 

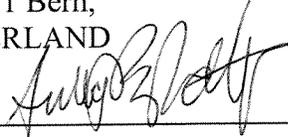
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Attorneys for Opposer  
VIROPHARMA INCORPORATED

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing Consolidated Notice of Opposition has been sent via international courier, postage pre-paid on this 23rd day of December 2009 to:

Troller Hitz Troller & Partner  
Münstergasse 38  
CH-3011 Bern,  
SWITZERLAND



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