

ESTTA Tracking number: **ESTTA369184**

Filing date: **09/20/2010**

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	Ferrosan A/S
Granted to Date of previous extension	09/22/2010
Address	Sydmarken 5 Soborg, DK-2860 DENMARK

Domestic Representative	B. Brett Heavner Attorney for Opposer Finnegan Henderson Farabow Garrett & Dunner 901 New York Avenue NW Washington, DC 20001 UNITED STATES b.brett.heavner@finnegan.com, steven.claremon@finnegan.com, docketing@finnegan.com Phone:2024084000
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Applicant Information

Application No	77905234	Publication date	05/25/2010
Opposition Filing Date	09/20/2010	Opposition Period Ends	09/22/2010
Applicant	HUGHES - MEDICAL, CORPORATION 11355 NW 66 STREET MIAMI, FL 33178 UNITED STATES		

Goods/Services Affected by Opposition

Class 005. First Use: 2009/12/28 First Use In Commerce: 2009/12/28 All goods and services in the class are opposed, namely: Dietary and nutritional supplements; Dietary beverage supplements for human consumption in liquid and dry mix form for therapeutic purposes; Dietary food supplements; Dietary supplemental drinks in the nature of vitamin and mineral beverages; Dietary supplements; Food supplements; Mineral food supplements; Mineral nutritional supplements; Mineral supplements; Nutritional additives for medical purposes for use in foods and dietary supplements for human consumption; Powdered fruit-flavored dietary supplement drink mix; Vitamin and mineral supplements

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	79046689	Application Date	10/31/2007
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	FERROSAN		
Design Mark	FERROSAN		
Description of Mark	NONE		
Goods/Services	Class 003. First use: Cosmetics, namely, non-medicated skin care preparations Class 005. First use: medical and surgical dressings; medical dressings for veterinary and dental use; medicated haemostatic powders for controlling bleeding and treating burns; medicinal herbal preparations to improve the softness and thickness of skin, hair, and nails; medicinal herbal preparations to counteract drying and formation of wrinkles; natural medicinal herbal preparations to treat and prevent pain in joints and limbs; medicinal herbal preparations to stimulate the immune system; medicinal herbal preparations to counteract light sensitivity to the skin and eyes and to prevent and cure tired and dry eyes; food supplements for healthcare and medical purposes derived from plant or animal ingredients; vitamin and mineral preparations; dietetic foods adapted for medical use		

Attachments	79046689#TMSN.jpeg (1 page)(bytes) FERROSTAT Notice of Opposition.pdf (18 pages)(137656 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	/B. Brett Heavner/
Name	B. Brett Heavner
Date	09/20/2010

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

FERROSAN A/S,)	
)	
Opposer,)	Opposition No.
)	
v.)	Serial No. 77905234
)	Mark: FERROSTAT
HUGHES-MEDICAL CORP.,)	Filing Date: January 5, 2010
Applicant.)	
)	
)	
)	

NOTICE OF OPPOSITION

Opposer Ferrosan A/S (“Opposer”), a Danish corporation, having a business address at Sydmarken 5 DK-2860 Søborg, Denmark, believes that it will be damaged by the registration of the mark FERROSTAT as shown in Application Serial No. 77905234, filed by Hughes-Medical Corp. (“Applicant”) and hereby opposes same. As grounds for its opposition, Opposer alleges as follows upon actual knowledge as to its own acts and upon information and belief as to all other matters.

Opposer and its FERROSAN Mark

1. Opposer Ferrosan A/S is a Danish corporation having a business address at Sydmarken 5 DK-2860 Søborg, Denmark.
2. Opposer is an international consumer healthcare and medical device company dedicated to enhancing the quality of life. For over 90 years, Opposer has brought its high quality health products to the public under the FERROSAN name. Opposer offers a line of naturopathic and dietary supplement products, as well as a line of haemostatic medical products.

3. Opposer has continuously used the FERROSAN mark in the United States since at least as early as 2004 for its naturopathic, featuring protein, vitamins, and minerals.

4. Opposer is also the owner of U.S. Application No. 79046689 for the mark FERROSAN filed on October 31, 2007, long before Applicant's priority date, covering "medical and surgical dressings; medical dressings for veterinary and dental use; medicated haemostatic powders for controlling bleeding and treating burns; medicinal herbal preparations to improve the softness and thickness of skin, hair, and nails; medicinal herbal preparations to counteract drying and formation of wrinkles; natural medicinal herbal preparations to treat and prevent pain in joints and limbs; medicinal herbal preparations to stimulate the immune system; medicinal herbal preparations to counteract light sensitivity to the skin and eyes and to prevent and cure tired and dry eyes; food supplements for healthcare and medical purposes derived from plant or animal ingredients; vitamin and mineral preparations; dietetic foods adapted for medical use."

5. Application 79046689 is valid and subsisting and has been approved for publication. (Printouts from the PTO TESS/TARR and Assignment databases for this application are attached as Exhibit A):

Applicant and its FERROSTAT Application

6. Applicant Hughes-Medical Corp., a Delaware corporation with an address of 11355 NW 66 Street, Miami, Florida 33178, is the listed owner of Application Serial No. 77905234 for the mark FERROSTAT for "dietary and nutritional supplements; dietary

beverage supplements for human consumption in liquid and dry mix form for therapeutic purposes; dietary food supplements; dietary supplemental drinks in the nature of vitamin and mineral beverages; dietary supplements; food supplements; mineral food supplements; mineral nutritional supplements; mineral supplements; nutritional additives for medical purposes for use in foods and dietary supplements for human consumption; powdered fruit flavored dietary supplement drink mix; vitamin and mineral supplements”, filed on January 5 ,2010, based on a claim that the mark has been used in U.S. commerce for all of the listed goods since December 28, 2009 (the “Application”).

I. Likelihood of Confusion, 15 U.S.C. § 1052(d)

7. Opposer has used the FERROSAN trade name and trademark in the United States long before the filing date of the opposed application and any date of first use alleged by Applicant.

8. Applicant’s FERROSTAT mark is identical to Opposer’s FERROSAN trade name and trademark except for the last three letters. The dominant “A” vowel sound in the last syllable of both marks is the same. And, both marks have the same number of syllables. The goods identified in Application No. 77905234 are identical to or closely related to Opposer’s goods.

9. In view of the similarity of the parties’ marks and the overlapping or closely related nature of the parties’ goods, Applicant’s mark FERROSTAT so resembles Opposer’s previously used and previously applied-for FERROSAN mark and FERROSAN trade name as to be likely to cause confusion, or to cause mistake, or to deceive under Section 2(d) of the Lanham Act, as amended, 15 U.S.C. § 1052(d).

II. Fraud on the USPTO

10. On January 5, 2010, Applicant, by and through its attorney, signed and filed the application that was assigned Serial No. 77905234, identifying the goods as “Dietary and nutritional supplements; Dietary beverage supplements for human consumption in liquid and dry mix form for therapeutic purposes; Dietary food supplements; Dietary supplemental drinks in the nature of vitamin and mineral beverages; Dietary supplements; Food supplements; Mineral food supplements; Mineral nutritional supplements; Mineral supplements; Nutritional additives for medical purposes for use in foods and dietary supplements for human consumption; Powdered fruit-flavored dietary supplement drink mix; Vitamin and mineral supplements,” and stating that “the mark was first used at least as early as 12/28/2009, and first used in commerce at least as early as 12/28/2009, and is now in use in such commerce.”

11. In the application, Applicant, through its attorney, attested that “all the statements made of his/her own knowledge are true.”

12. Along with the application, Applicant submitted as the specimen of use for the FERROSTAT mark artwork of a box flattened box for “fast dissolving flavored tablets” containing a “high potency iron supplement.”

13. On March 31, 2010, Applicant, through its attorney, submitted an office action response purporting to amend the goods to read as follows: “Dietary and nutritional supplements; Dietary beverage supplements for human consumption in liquid and dry mix form for therapeutic purposes; Dietary food supplements; Dietary supplemental drinks in the nature of vitamin and mineral beverages; Dietary supplements; Food supplements; Mineral food supplements; Mineral nutritional

supplements; Mineral supplements; Nutritional additives for medical purposes for use in foods and dietary supplements for human consumption; Powdered fruit-flavored dietary supplement drink mix; Vitamin and mineral supplements.”

14. Applicant’s office action response Applicant attested through its attorney that “The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 12/28/2009 and first used in commerce at least as early as 12/28/2009, and is now in use in such commerce.”

15. In the office action response, Applicant attested, through its attorney, that “the mark was in use in commerce on or in connection with the goods and/or services listed in the application as of the application filing date” and that “all the statements made in the original application and this submission made of the declaration signer’s knowledge are true.”

16. In the office action response, Applicant also submitted a new specimen consisting of photographs of a container for “fast dissolving flavored tablets” containing a “high potency iron supplement.”

17. At the time the declarations for both the Application and the office action response were signed and filed, Applicant was not using the FERROSTAT mark on or in connection with the following goods listed in the identification of goods: “dietary beverage supplements for human consumption in liquid and dry mix form for therapeutic purposes; dietary supplemental drinks in the nature of vitamin and mineral beverages;

nutritional additives for medical purposes for use in foods; powdered fruit flavored dietary supplement drink mix.”

18. At the time the declarations for both the application and the office action response were signed and filed, Applicant knew that it was not using the FERROSTAT mark in connection with all of the goods listed in the Application, and thus willfully or recklessly made false statements to the PTO, with the intent to deceive, in order to obtain the registration of a mark to which it knew it was not entitled.

19. The USPTO accepted and relied on the statements in the Application and supporting declaration in approving the Application for publication. But for Applicant’s material, false statements or reckless disregard of the truth concerning use of its mark in connection with the goods identified in the Application, the USPTO would not have approved the Application for publication.

20. Accordingly, Applicant committed fraud on the USPTO and the Application is void and should be refused registration.

WHEREFORE, Opposer believes that it is being and will be damaged by the registration of the mark shown in Application Serial No. 77905234, and respectfully requests that the opposition be sustained and registration be refused.

A filing fee has been submitted herewith. If the filing fee is found to be insufficient for any reason, please charge the deficiency to our Deposit Account No. 06-0916.

Respectfully submitted,

FERROSAN A/S

Dated: September 20, 2010

By: /B. Brett Heavner/

B. Brett Heavner
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER L.L.P.
901 New York Avenue, NW
Washington, D.C. 20001-4413
(202) 408-4000

Attorneys for Opposer

CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing NOTICE OF OPPOSITION was served by first class mail, postage prepaid, on this 20th day of September 2010, on Applicant at the following addresses of record for Applicant:

Hughes - Medical Corporation
11355 NW 66 Street
Miami, FL 33178

Dr. Mario S. Golab
Intellectual Property Business Consultant
1413 Santa Cruz Ave
Coral Gables, FL 33134-2257

/Steven K. Claremon/
Steven K. Claremon
Litigation Legal Assistant

FERROSAN A/S, v. HUGHES-MEDICAL CORP.,

Notice of Opposition
Mark: FERROSTAT
Serial No. 77905234

Exhibit A



Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Sat Sep 18 04:05:46 EDT 2010

[TESS HOME](#) | [NEW USER](#) | [STRUCTURED](#) | [FREE FORM](#) | [BROWSE DICT](#) | [SEARCH OG](#) | [BOTTOM](#) | [HELP](#) | [PREV LIST](#) | [CURR LIST](#)
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List At: OR to record: **Record 1 out of 3**

[TARR Status](#) | [ASSIGN Status](#) | [TDR](#) | [TTAB Status](#) *(Use the "Back" button of the Internet Browser to return to TESS)*

FERROSAN

Word Mark FERROSAN

Goods and Services IC 003. US 001 004 006 050 051 052. G & S: Cosmetics, namely, non-medicated skin care preparations

IC 005. US 006 018 044 046 051 052. G & S: medical and surgical dressings; medical dressings for veterinary and dental use; medicated haemostatic powders for controlling bleeding and treating burns; medicinal herbal preparations to improve the softness and thickness of skin, hair, and nails; medicinal herbal preparations to counteract drying and formation of wrinkles; natural medicinal herbal preparations to treat and prevent pain in joints and limbs; medicinal herbal preparations to stimulate the immune system; medicinal herbal preparations to counteract light sensitivity to the skin and eyes and to prevent and cure tired and dry eyes; food supplements for healthcare and medical purposes derived from plant or animal ingredients; vitamin and mineral preparations; dietetic foods adapted for medical use

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 79046689

Filing Date October 31, 2007

Current Filing Basis 66A

Original Filing Basis 66A

Published for Opposition September 28, 2010

International

Registration Number 0812411

Owner (APPLICANT) Ferrosan A/S CORPORATION DENMARK Sydmarken 5 DK-2860 Søborg DENMARK

Attorney of Record B. BRETT HEAVNER

Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead Indicator LIVE

-
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This page was generated by the TARR system on 2010-09-20 16:04:19 ET

Serial Number: 79046689 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: (NOT AVAILABLE)

Mark

FERROSAN

(words only): [FERROSAN](#)

Standard Character claim: [Yes](#)

Current Status: [Final review prior to publication has been completed, application will be published for opposition.](#)

Date of Status: [2010-08-26](#)

Filing Date: [2007-10-31](#)

The Information will be/was published in the Official Gazette on [2010-09-28](#)

Transformed into a National Application: [No](#)

Registration Date: (DATE NOT AVAILABLE)

Register: [Principal](#)

Law Office Assigned: [LAW OFFICE 102](#)

Attorney Assigned:
[BUONGIORNO CHRISTOPHER L](#)

Current Location: [650 -Publication And Issue Section](#)

Date In Location: [2010-08-26](#)

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

1. [Ferrosan A/S](#)**Address:**

[Ferrosan A/S](#)
[Sydmarken 5 DK-2860 Søborg](#)
[Denmark](#)

Legal Entity Type: [Corporation](#)**State or Country of Incorporation:** [Denmark](#)

GOODS AND/OR SERVICES

International Class: [003](#)**Class Status:** [Active](#)[Cosmetics, namely, non-medicated skin care preparations](#)**Basis:** [66\(a\)](#)**First Use Date:** [\(DATE NOT AVAILABLE\)](#)**First Use in Commerce Date:** [\(DATE NOT AVAILABLE\)](#)**International Class:** [005](#)**Class Status:** [Active](#)

[medical and surgical dressings; medical dressings for veterinary and dental use; medicated haemostatic powders for controlling bleeding and treating burns; medicinal herbal preparations to improve the softness and thickness of skin, hair, and nails; medicinal herbal preparations to counteract drying and formation of wrinkles; natural medicinal herbal preparations to treat and prevent pain in joints and limbs; medicinal herbal preparations to stimulate the immune system; medicinal herbal preparations to counteract light sensitivity to the skin and eyes and to prevent and cure tired and dry eyes; food supplements for healthcare and medical purposes derived from plant or animal ingredients; vitamin and mineral preparations; dietetic foods adapted for medical use](#)

Basis: [66\(a\)](#)**First Use Date:** [\(DATE NOT AVAILABLE\)](#)**First Use in Commerce Date:** [\(DATE NOT AVAILABLE\)](#)

ADDITIONAL INFORMATION

[\(NOT AVAILABLE\)](#)

MADRID PROTOCOL INFORMATION

International Registration Number: [0812411](#)**International Registration Date:** [2003-06-11](#)**Priority Claimed:** [No](#)**Date of Section 67 Priority Claim:** [\(DATE NOT AVAILABLE\)](#)**International Registration Status:** [Request For Extension Of Protection Processed](#)**Date of International Registration Status:** [2007-12-13](#)

International Registration Renewal Date: 2013-06-11

Notification of Designation Date: 2007-12-13

Date of Automatic Protection: 2009-06-13

Date International Registration Cancelled: (DATE NOT AVAILABLE)

First Refusal: Yes

PROSECUTION HISTORY

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

2010-08-26 - Law Office Publication Review Completed

2010-08-26 - Approved for Pub - Principal Register (Initial exam)

2010-08-26 - Examiner's Amendment Entered

2010-08-26 - Notification Of Examiners Amendment E-Mailed

2010-08-26 - EXAMINERS AMENDMENT E-MAILED

2010-08-26 - Examiners Amendment - Written

2010-08-04 - Jurisdiction Restored To Examining Attorney

2010-07-16 - Amendment From Applicant Entered

2010-07-16 - Communication received from applicant

2010-07-09 - PAPER RECEIVED

2010-05-06 - Notification Of Action Denying Req For Recon E-Mailed

2010-05-06 - ACTION DENYING REQ FOR RECON E-MAILED

2010-05-06 - Continuation of final refusal mailed

2010-05-04 - Jurisdiction Restored To Examining Attorney

2010-03-06 - Amendment From Applicant Entered

2010-03-06 - Communication received from applicant

2010-03-04 - PAPER RECEIVED

2009-12-16 - Notification Of Action Denying Req For Recon E-Mailed

2009-12-16 - ACTION DENYING REQ FOR RECON E-MAILED

2009-12-16 - Continuation of final refusal mailed

2009-11-16 - Jurisdiction Restored To Examining Attorney

2009-11-13 - TEAS Request For Reconsideration Received

2009-10-06 - Notification Of Action Denying Req For Recon E-Mailed

2009-10-06 - ACTION DENYING REQ FOR RECON E-MAILED

2009-10-06 - Continuation of final refusal mailed

2009-09-28 - Jurisdiction Restored To Examining Attorney

2009-09-22 - Amendment From Applicant Entered

2009-09-22 - Communication received from applicant

2009-09-18 - PAPER RECEIVED

2009-09-16 - Ex parte appeal - Instituted

2009-09-16 - EXPARTE APPEAL RECEIVED AT TTAB

2009-05-28 - Notification Of Possible Opposition - Processed By IB

2009-05-14 - Notification Of Possible Opposition Sent To IB

2009-05-14 - Notification Of Possible Opposition Created, To Be Sent To IB

2009-03-18 - Notification Of Final Refusal Emailed

2009-03-18 - Final refusal e-mailed

2009-03-18 - Final Refusal Written

2009-03-09 - Amendment From Applicant Entered

2009-03-09 - Communication received from applicant

2009-03-06 - PAPER RECEIVED

2008-09-10 - Notification Of Non-Final Action E-Mailed

2008-09-10 - NON-FINAL ACTION E-MAILED

2008-09-10 - Non-Final Action Written

2008-08-20 - Amendment From Applicant Entered

2008-08-20 - Communication received from applicant

2008-08-13 - PAPER RECEIVED

2008-08-11 - Amendment From Applicant Entered

2008-08-11 - Communication received from applicant

2008-08-11 - Assigned To LIE

2008-08-06 - PAPER RECEIVED

2008-03-14 - Refusal Processed By IB

2008-02-20 - Non-Final Action Mailed - Refusal Sent To IB

2008-02-20 - Refusal Processed By MPU

2008-02-20 - Non-Final Action (Ib Refusal) Prepared For Review

2008-02-19 - Non-Final Action Written

2008-02-13 - Assigned To Examiner

2007-12-17 - New Application Entered In Tram

2007-12-14 - Limitation Of Goods/Services From IB Entered

2007-12-13 - Sn Assigned For Sect 66a Subseq Desig From IB

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

B. BRETT HEAVNER

Correspondent

B. BRETT HEAVNER

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901 NEW YORK AVENUE NW
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Phone Number: 202-408-4000
Fax Number: 202-408-4400



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For Serial Number: 79046689

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Web interface last modified: October 18, 2008 v.2.0.2

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