

ESTTA Tracking number: **ESTTA420415**

Filing date: **07/19/2011**

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	Medicis Pharmaceutical Corporation
Granted to Date of previous extension	07/20/2011
Address	7720 North Dobson Road Scottsdale, AZ 85256 UNITED STATES

Attorney information	Gina Durham DLA Piper LLP (US) 203 N. LaSalle St.Suite 1900 Chicago, IL 60601 UNITED STATES gina.durham@dlapiper.com, ch.tm@dlapiper.com, erin.wright@dlapiper.com, deanne.vannatta@dlapiper.com Phone:312-368-4000
----------------------	--

Applicant Information

Application No	85146921	Publication date	03/22/2011
Opposition Filing Date	07/19/2011	Opposition Period Ends	07/20/2011
Applicant	Coats, Zianni 47 Garden Drive Alexandria, VA 22304 UNITED STATES		

Goods/Services Affected by Opposition

Class 003. All goods and services in the class are opposed, namely: Cosmetics, namely, all-in-one cleanser, conditioner and moisturizing preparations for the hair, essential oils for the skin and hair
Class 021. All goods and services in the class are opposed, namely: Cosmetic brushes, hair brushes

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
--------------------------------------	----------------------------

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3288465	Application Date	05/02/2002
Registration Date	09/04/2007	Foreign Priority Date	NONE

Word Mark	ZIANA
Design Mark	ZIANA
Description of Mark	NONE
Goods/Services	Class 005. First use: First Use: 2006/12/19 First Use In Commerce: 2006/12/19 pharmaceutical preparations for dermatologic use, namely, topical preparations for the treatment of acne and topical preparations for the treatment of steroid-responsive dermatoses, excluding preparations for the treatment, or alleviation of viral infections, regardless of their dosage form

U.S. Registration No.	3313332	Application Date	12/01/2006
Registration Date	10/16/2007	Foreign Priority Date	NONE

Word Mark	ZIANA
Design Mark	 ZIANA
Description of Mark	The mark consists of a swirl.
Goods/Services	Class 005. First use: First Use: 2006/12/19 First Use In Commerce: 2006/12/19 pharmaceutical preparations for dermatologic use, namely, topical preparations for the treatment of acne and topical preparations for the treatment of steroid-responsive dermatoses, excluding preparations for the treatment, or alleviation of viral infections, regardless of their dosage form

U.S. Registration No.	3319298	Application Date	12/01/2006
Registration Date	10/23/2007	Foreign Priority Date	NONE
Word Mark	ZIANA (CLINDAMYCIN PHOSPHATE 1.2% AND TRETINOIN 0.025%) GEL		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 005. First use: First Use: 2006/12/19 First Use In Commerce: 2006/12/19 pharmaceutical preparations for dermatologic use, namely, topical preparations for the treatment of acne and topical preparations for the treatment of steroid-responsive dermatoses, excluding preparations for the treatment, or alleviation of viral infections, regardless of their dosage form

Attachments	76402959#TMSN.gif (1 page)(bytes) 77055120#TMSN.jpeg (1 page)(bytes) 77055122#TMSN.jpeg (1 page)(bytes) Notice of Opposition Against the Mark ZIANNI (for Medicis - ZIANA) to be filed July 19.pdf (5 pages)(53054 bytes)
-------------	---

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	/Gina L. Durham/
Name	Gina L. Durham
Date	07/19/2011

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

In re: Serial No. 85/146,921
Mark: ZIANNI
Published: March 22, 2011

Medicis Pharmaceutical Corporation,)	
)	
Opposer,)	
)	Opposition No.
v.)	
)	Mark: ZIANNI
ZIANNI COATS,)	
)	
Applicant.)	

NOTICE OF OPPOSITION

U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

Medicis Pharmaceutical Corporation, a Delaware corporation, located at 7720 North Dobson Road, Scottsdale, Arizona 85256 (hereinafter “Opposer”), believes that it would be damaged by registration of the mark shown in Application Serial No. 85/146,921 (“the ‘921 Application”), filed October 7, 2010, by Zianni Coats (hereinafter “Applicant”), published in the Official Gazette of the United States Patent and Trademark Office on March 22, 2011, and hereby opposes the registration of such mark.

The grounds for the opposition are as follows:

1. Opposer is a leading provider of dermatological and aesthetic preparations. Opposer is well-known for its offerings in the pharmaceutical field.
2. Since well before the filing date of the ‘921 Application, Opposer has continuously used the mark ZIANA in interstate commerce in connection with its goods.

3. When used in connection with Opposer's goods, the ZIANA mark is inherently distinctive and has also acquired secondary meaning by reason of Opposer's extensive advertising, promotion and other use thereof.

4. Moreover, Opposer owns the following United States Trademark Registrations for the ZIANA mark and variations thereof (collectively referred to as the ZIANA marks):

Mark	Reg. No.	Goods	Appl. Date	Reg. Date
ZIANA	3288465	Pharmaceutical preparations for dermatologic use, namely, topical preparations for the treatment of acne and topical preparations for the treatment of steroid-responsive dermatoses, excluding preparations for the treatment, or alleviation of viral infections, regardless of their dosage form.	5/2/02	9/4/07
 ZIANA	3313332	Pharmaceutical preparations for dermatologic use, namely, topical preparations for the treatment of acne and topical preparations for the treatment of steroid-responsive dermatoses, excluding preparations for the treatment, or alleviation of viral infections, regardless of their dosage form.	12/1/06	10/16/07
 ZIANA (clindamycin phosphate 1.2% and tretinoin 0.025%) Gel	3319298	Pharmaceutical preparations for dermatologic use, namely, topical preparations for the treatment of acne and topical preparations for the treatment of steroid-responsive dermatoses, excluding preparations for the treatment, or alleviation of viral infections, regardless of their dosage form.	12/1/06	10/23/07

5. Opposer's foregoing registrations for the ZIANA marks are valid and subsisting.

6. Opposer has used and is using the ZIANA marks in interstate commerce in connection with the goods described in Opposer's foregoing registrations.

7. On October 7, 2010, Applicant filed the '921 Application based on an intent to use the mark ZIANNI for "Cosmetics, namely, all-in-one cleanser, conditioner and moisturizing preparations for the hair, essential oils for the skin and hair" and "Cosmetic brushes, hair brushes"

8. Opposer's use and registration of its ZIANA marks long pre-date the filing date of the '921 Application.

9. The grant of a registration to Applicant for the ZIANNI mark as sought in the '921 Application should be denied on the grounds of Opposer's prior use of the ZIANA marks. The mark sought to be registered by Applicant is confusingly similar to Opposer's ZIANA marks, and the use of the ZIANNI mark by Applicant is likely to cause confusion or mistake in the minds of the public and to lead the public and prospective purchasers to believe that Applicant's goods are those of Opposer or are endorsed, sponsored or otherwise affiliated or connected with Opposer, or that Opposer's goods are associated with Applicant, all to the damage and injury of the purchasing public and to the damage and injury of Opposer.

10. The grant of a registration to Applicant for the ZIANNI mark as sought in the '921 Application should be denied based on likelihood of confusion with Opposer's prior ZIANA marks.

WHEREFORE, Opposer files this Notice of Opposition and prays that the aforesaid application of Applicant herein opposed, be rejected; that no registration be issued thereon to Applicant; and for such other and further relief as may be deemed just and proper.

The filing fee of \$600.00 for two classes and any additional fees required for this Notice of Opposition should be charged to Deposit Account No. 18-2284. Please address all correspondence regarding this opposition to:

Gina L. Durham, Esq.
DLA PIPER LLP (US)
P.O. Box 64807
Chicago, Illinois 60664-0807
(312) 368-4000
gina.durham@dlapiper.com
ch.tm@dlapiper.com

July 19, 2011

Respectfully submitted,

**MEDICIS PHARMACEUTICAL
CORPORATION**

By: /Gina L. Durham/
Gina L. Durham
Erin E. Wright
DLA PIPER LLP (US)
P.O. Box 64807
Chicago, Illinois 60664-0807
gina.durham@dlapiper.com
erin.wright@dlapiper.com
ch.tm@dlapiper.com
(312) 368-4000

Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a copy of this correspondence is being deposited with the United States Postal Service as First-Class Mail in an envelope addressed to the Attorney of Record, Christopher Ditico, of Raj Abhyanker, P.C., 1580 W. El Camino Real, Suite 8, Mountain View, California, 94040 on July 19, 2011.

/Gina L. Durham/
Signature

Gina L. Durham
Name

July 19, 2011
Date of Signature