

ESTTA Tracking number: **ESTTA482967**

Filing date: **07/12/2012**

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

Proceeding	91204337
Party	Plaintiff Endo Pharmaceuticals Inc.
Correspondence Address	JAMES R MEYER SCHNADER HARRISON SEGAL & LEWIS LLP 1600 MARKET ST, STE 3600 PHILADELPHIA, PA 19103 UNITED STATES jmeyer@schnader.com, trademarks@schnader.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Ronald J. Ventola II
Filer's e-mail	rventola@schnader.com, trademarks@schnader.com
Signature	/Ronald J. Ventola II/
Date	07/12/2012
Attachments	Amended Notice of Opposition.pdf (6 pages)(17398 bytes)

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

ENDO PHARMACEUTICALS INC.,)	Opposition No. 91204337
)	
Opposer,)	
)	Opposed Applications:
v.)	
)	Mark: ENDOCYTE
ENDOCYTE, INC.,)	Serial #: 85306842
)	
Applicant.)	Mark: ENDOCYTE EC
)	Serial #: 85308111

AMENDED NOTICE OF OPPOSITION

A Notice of Opposition may be amended, other than to add goods or services to the opposed goods or services, as of right “in the same manner and to the same extent as in a civil action in a United States district court.” 37 CFR § 2.107; TBMP § 315. Opposer’s Notice of Opposition, a pleading to which a responsive pleading must be filed, may be amended once as a matter of course within 21 days of the service of the Applicant’s Answer. Fed. R. Civ. P. 15(a). Applicant’s Answer was served on June 22, 2012, and this Amended Notice of Opposition may be filed as of right because it is being filed on or before July 13, 2012, the 21st day after Applicant’s Answer was filed.

ALLEGATIONS OF OPPOSITION

Endo Pharmaceuticals Inc., a Delaware corporation located and doing business at 100 Endo Boulevard, Chadds Ford PA 19317 (“Endo”) believes it will be damaged by the registration of the above-identified marks (hereinafter “Applicant’s

Marks”), and having sought and obtained extensions of the time to file a Notice of Opposition, hereby opposes the same.

The grounds for the opposition are as follows:

1. Endo is a U.S.-based, specialty healthcare solutions company, focused on high-value branded pharmaceutical preparations and specialty generic pharmaceutical preparations. In addition, Endo delivers an innovative suite of complementary diagnostics, drugs, devices, and clinical data to meet the needs of patients in areas such as pain, urology, oncology, and endocrinology. These goods and services are described in detail and are advertised on Endo’s website, www.endo.com.

2. Endo’s predecessor first used the ENDO® trademark for pain relief tablets almost one hundred years ago, beginning in 1916. Since that time, the ENDO® name and mark has developed invaluable good will and reputation among health care providers and patients as a designator of source for prescription pharmaceutical preparations and related goods and services. Such good will, together with the registrations symbolizing such good will, are now owned by Endo.

3. Since its early use, Endo has expanded its use of the ENDO® mark to include other registered trademarks using ENDO... as a prefix, including ENDOCET®, ENDODAN®, and a registered service mark, ENDOCARE® (Reg. Nos. 1897762 and 414232), which is used through a subsidiary, Endocare, Inc.

4. Endo uses its ENDO® name and mark as a house mark to identify its broad range of pharmaceutical and healthcare goods and services.

5. Endo is the owner of the registered ENDO® mark for pharmaceutical preparations as well as other registered marks beginning ENDO... for pharmaceutical preparations and related goods and services (the “ENDO® Marks”), including: ENDO® (Reg. Nos. 0324936, 2004648, 2189503, and 2921176); ENDOCET® (Reg. No. 1993892) ; ENDODAN® (Reg. No. 1995948) ; ENDOCARE® (Reg. No. 1897762); ENDO GENERIC PRODUCTS (Reg. No. 2267677); ENDO ENDO GENERIC PRODUCTS (Reg. No. 3075226); and ENDO LABORATORIES (Reg. No. 2317044). In addition, Endo provides athletic jerseys and coordinates league sports teams under the mark TEAM ENDO (Reg. No. 3155766).

6. Endo also intends to use and/or has used ENDO marks for which applications to register are pending, including E ENDO & DESIGN (App. Ser. No. 85498455, filed December 19, 2011); ENDO HEALTH SOLUTIONS (App. Ser. No. 85549539, filed February 22, 2012); ENDO (stylized lower case, App. Ser. No. 85549674, filed February 22, 2012); and E (stylized, App. Ser. No. 85549621, filed February 22, 2012).

7. Endo further has used and registered in the past (but no longer uses or maintains registrations for) several additional marks using ENDO... as a prefix, including ENDO-OVATRIN, ENDO-MAGSAL, ENDOLIN, ENDOFER, ENDOTUSSIN, ENDOCIDIN, ENDOCAINE, ENDOPRIN, and ENDOGESIC.

8. Based on its long and substantially exclusive use of ENDO® and marks beginning ENDO... for prescription pharmaceutical preparations, the ENDO® Marks have acquired and maintain distinctiveness in identifying prescription

pharmaceutical preparations and related goods and services sourced from or sponsored by Endo.

9. On April 28, 2011, Applicant filed its application to register ENDOCYTE for, *inter alia*, pharmaceutical preparations for the diagnosis and treatment of cancer; pharmaceutical preparations for the diagnosis and treatment of diseases; pharmaceutical preparations for the purpose of increasing the effectiveness of other pharmaceutical products; drug delivery agents consisting of compounds that facilitate delivery of a wide range of pharmaceuticals in Class 5 based on an asserted bona fide intent to use the mark in commerce. On April 29, 2011, Applicant filed its application to register ENDOCYTE EC & Design for, *inter alia*, pharmaceutical preparations for the diagnosis and treatment of cancer; pharmaceutical preparations for the diagnosis and treatment of diseases; pharmaceutical preparations for the purpose of increasing the effectiveness of other pharmaceutical products; drug delivery agents consisting of compounds that facilitate delivery of a wide range of pharmaceuticals in Class 5 based on based on an asserted bona fide intent to use the mark in commerce.

10. Applicant's ENDOCYTE mark and ENDOCYTE EC & DESIGN mark were published for opposition on September 20, 2011. Endo has sought and obtained extensions of the opposition period.

11. There is no issue as to priority. Endo's rights in its ENDO® Marks long predate any rights of Applicant.

12. Endo's rights in the following registrations of ENDO® Marks are incontestable: ENDO® (Reg. Nos. 0324936, 2004648, 2189503, and 2921176); ENDOCET® (Reg. No. 1993892); ENDODAN® (Reg. No. 1995948); ENDOCARE®

(Reg. No. 1897762); ENDO GENERIC PRODUCTS (Reg. No. 2267677); and ENDO LABORATORIES (Reg. No. 2317044).

13. Applicant's ENDOCYTE mark and ENDOCYTE EC & DESIGN mark are similar to the ENDO® Marks in sound, meaning and appearance.

14. Applicant's goods in Class 5 are substantially identical to the pharmaceutical preparations and other goods and services on which Endo uses its ENDO® Marks.

15. Applicant's use and registration of the ENDOCYTE mark and/or the ENDOCYTE EC & DESIGN mark for the goods of the applications herein opposed will likely lead to confusion, to mistake, or to deception of the public within the meaning of Section 2(d) of the Trademark Act of 1946.

16. On July 11, 2011 Applicant submitted an Amendment to Allege Use in each of the opposed applications, declaring that Applicant's ENDOCYTE mark and ENDOCYTE EC & DESIGN mark are in use on all of the goods of the application, and asserting a date of first use in commerce of July 6, 2000 for both marks as to the goods in class 5. On information and belief, Applicant had not used in commerce the ENDOCYTE mark and ENDOCYTE EC & DESIGN mark on all of the goods in Class 5 covered by the Amendment.

17. Applicant's ENDOCYTE mark and ENDOCYTE EC & DESIGN mark are not entitled to registration based on Section 2(d) of the Trademark Act of 1946.

18. By reason of the foregoing, Applicant's registration of the ENDOCYTE mark and/or the ENDOCYTE EC & DESIGN mark for the goods of the applications herein opposed would cause injury and damage to Endo.

WHEREFORE, Opposer prays that its opposition to Application Serial Nos. 85308111 and 85306842 for goods in Class 5 be sustained and that the application for goods in Class 5 be refused.

By: /Ronald J. Ventola II/
James R. Meyer
Ronald J. Ventola II
SCHNADER HARRISON SEGAL & LEWIS LLP
1600 Market Street, Suite 3600
Philadelphia, PA 19103
(215)751-2000

Attorneys For Opposer, Endo Pharmaceuticals Inc.

CERTIFICATE OF SERVICE

I hereby certify that on July 12, 2012, a copy of the AMENDED NOTICE OF OPPOSITION was served by U.S. Mail first class postage prepaid accompanied by the documents cited therein, on Applicant's counsel of record, and by electronic mail, at the following addresses:

Frances M. Jagla
Lane Powell PC
1420 Fifth Avenue Suite 4100
Seattle, WA 98101

trademarks@lanepowell.com, jaglaf@lanepowell.com

/Ronald J. Ventola II /

Ronald J. Ventola II
Attorney
SCHNADER HARRISON SEGAL & LEWIS LLP