

ESTTA Tracking number: **ESTTA463028**

Filing date: **03/21/2012**

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	Novartis AG
Granted to Date of previous extension	03/21/2012
Address	CH-4002 Basel, SWITZERLAND

Attorney information	John P. Margiotta Fross Zelnick Lehrman & Zissu, PC 866 United Nations Plaza New York, NY 10017 UNITED STATES jm@fzlz.com Phone:212-813-5900
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Applicant Information

Application No	79094917	Publication date	11/22/2011
Opposition Filing Date	03/21/2012	Opposition Period Ends	03/21/2012
International Registration No.	1070604	International Registration Date	02/09/2011
Applicant	DEFIANTE FARMACÃ#UTICA, S.A. RUA DOS FERREIROS, NÂ° 260 P-9000-082 MADEIRA FUNCHAL PORTUGAL		

Goods/Services Affected by Opposition

Class 005. All goods and services in the class are opposed, namely: Pharmaceutical preparations, namely, chemotherapeutic agents

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2336960	Application Date	07/09/1996
Registration Date	04/04/2000	Foreign Priority Date	02/15/1996

Word Mark	NOVARTIS
Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 001. First use: [chemicals and chemical preparations for use in industry, agriculture, horticulture and forestry, namely, chemicals for use in manufacturing optical lenses; Adjuvants for use in manufacturing agricultural preparations; Adjuvants for use in manufacturing pharmaceutical preparations; Chemical additives for use in manufacturing - pharmaceutical preparations, defoliants, wound pastes for trees and plants, plant growth regulators, preparations for the treatment of seeds, preparations for the protection of seeds and plants against plant pathogens, plant protection agents of a prophylactic nature; and Manures]</p> <p>Class 005. First use: pharmaceutical preparations for the treatment of - dermatological, cardiovascular, hematological, bone, respiratory, central nervous system, endocrinological, circulatory, gastroenterological, hormonal and diabetic disorders, coughs, colds, influenza, headaches, stomach and digestive disorders, muscular and/or rheumatic disorders, anti-inflammatory agents, immune system disorders and related diseases, allergic reactions, metabolic disorders, anti-infectives, ocular disorders, and for use in oncology; diagnostic preparations and/or reagents for clinical or medical laboratory use; Contact lens and eyecare solutions and preparations, namely, disinfectants, cleaning solutions, saline solutions and wetting solutions; Nicotine for medicinal purposes in liquid, pill, tablet, caplet, powder or transdermal patch form; [Hormones;] Dietetic substances for medical purposes, namely, nutritional, vitamin, [herbal and] mineral supplements and preparations, nutritional drink mix for use as a meal replacement, [nutritional supplements in snack bar form for use as a meal replacement;] Food and beverages for [babies,] nfants and invalids, namely, [baby food, infant formula,] food for enteral administration and food for medically restricted diets; and [Pesticides,] fungicides, [herbicides] and insecticides, all for commercial, [agricultural] and/or domestic use</p> <p>Class 009. First use: [contact lenses; Eyeglasses; Sunglasses; and Optical lenses not for medical use]</p> <p>Class 010. First use: [artificial or biological skin tissue for subsequent implantation; Intraocular lenses]</p> <p>Class 029. First use: [prepared entrees consisting primarily of meat, fish, poultry, game and/or vegetables; Meat extracts; Preserved, dried, frozen or cooked fruits and vegetables; Jams and fruit or vegetable preserves; Fruit-based snack foods; Fruit toppings; Dairy products, excluding ice cream, ice milk and frozen yogurt; Milk]</p> <p>Class 030. First use: [ready to eat snack bars made from combinations of cereal, fruit, grains and</p>

	<p>nuts; Breakfast and processed cereals; Cereal based snack foods; Bread; Biscuits; Chocolate; Candy; Cocoa; Sugar; Tapioca; Sago; Rusks; Desserts, namely, cakes and puddings; Malt for food purposes; Ice cream, frozen yogurt, ice milk and ice cream substitute; Chocolate syrup; Corn syrup; and Food additives for non-nutritional purposes for use as a flavoring, ingredient or filler]</p> <p>Class 031. First use: [bran, cereal and protein based foodstuffs for animals; Vegetable, fruit and flower seeds for agricultural and horticultural purposes; Fresh fruits and vegetables; Living plants and live flowers]</p> <p>Class 032. First use: [non-alcoholic beverages, namely, soft drinks, fruit drinks, fruit juices; Concentrates, syrups or powders used in the preparation of soft drinks; and Fruit syrups used in the preparation of soft drinks]</p> <p>Class 042. First use: [engineering services; plant, tree and seed breeding services; Horticultural services; Printing; and Material testing]</p>
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U.S. Registration No.	2997235	Application Date	02/10/2004
Registration Date	09/20/2005	Foreign Priority Date	NONE
Word Mark	NOVARTIS		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 005. First use: First Use: 1997/09/30 First Use In Commerce: 1997/09/30</p> <p>Adjuvants for use with veterinary vaccines and veterinary vaccines for companion animals, farmed fish and livestock; veterinary products for companion animals, farmed fish and livestock, namely, cardiovascular treatment preparations, arthritis treatment preparations, renal treatment preparations, respiratory treatment preparations, reproductive treatment preparations, allergy treatment preparations, antibiotics, insecticides, pesticides and feed additives for veterinary use in the treatment of parasites, fleas, worms, renal diseases, heart diseases, allergic diseases, parasitic and bacterial infections, lameness, respiratory diseases, scours or enteritis, viral diseases, clostridial diseases, pinkeye, liver abscesses, influenza, pneumonia, mastitis, West Nile virus and erysipelas; insecticides and rodenticides for agricultural use, disinfectants for veterinary use</p>		

Attachments	<p>75131409#TMSN.gif (1 page)(bytes)</p> <p>78365657#TMSN.jpeg (1 page)(bytes)</p> <p>12 03 21 Notice of Opposition (F0980480).PDF (14 pages)(549934 bytes)</p>
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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	/John P. Margiotta/
Name	John P. Margiotta
Date	03/21/2012

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

In the Matter of Application Serial No. 79/094,917
Published in the *Official Gazette* on November 22, 2011
Mark: ONVERTIS

NOVARTIS AG,	Opposer,
v.	
DEFIANTE FARMACÊUTICA, S.A.,	Applicant.

NOTICE OF OPPOSITION

Novartis AG (“Opposer”), a corporation organized and existing according to the laws of Switzerland, located and doing business at CH-4002, Basel, Switzerland, believes that it will be damaged by the issuance of a registration for the mark ONVERTIS, applied for in Application Serial No. 79/094,917 for “pharmaceutical preparations, namely, chemotherapeutic agents” in International Class 5, and therefore opposes the same. As grounds for the opposition, Opposer, by its attorneys Fross Zelnick Lehrman & Zissu, P.C., alleges as follows:

1. Opposer is the owner of the trademark and trade name NOVARTIS in connection with a wide variety of pharmaceutical preparations for human and veterinary medicines. Opposer has used the mark NOVARTIS in commerce since at least as early as 1997, and the mark is now famous.
2. Novartis is the owner of the following U.S. trademark registrations:
 - NOVARTIS, Reg. No. 2,336,960, registered April 4, 2000 for pharmaceuticals in International Class 5.

- NOVARTIS, Reg. No. 2,997,235, registered September 20, 2005, for veterinary pharmaceuticals in International Class 5.

3. These registrations are valid, subsisting and in full force and effect, and constitute evidence of the validity of the marks and of Opposer's exclusive right to use them on the goods identified in the registrations. Both registrations have also become incontestable under Section 15 of the Trademark Act. Printouts from the United States Patent and Trademark Office's online databases reflecting these registrations are attached as **Exhibit A**.

4. On information and belief, Defiante Farmacêutica, S.A. ("Applicant") is a company organized and existing according to the laws of Portugal, located and doing business at Rua Dos Ferreiros, Nº 260, Madeira, Funchal, P-9000-082.

5. On February 9, 2011, Applicant filed as Application Serial No. 79/094,917 a request for an extension of protection to the United States of an International Registration for the mark ONVERTIS under Section 66(a) of the Lanham Act, 15 U.S.C. § 1141f(a), based on the existence of an International Registration and an alleged *bona fide* intent to use the mark in commerce (the "Application").

6. The Application specifies the following goods in International Class 5, "pharmaceutical preparations, namely, chemotherapeutic agents."

7. The Application filing date, as well as the date of the international registration on which the Application is based, is many years after Opposer obtained its above-mentioned registrations for its NOVARTIS mark.

8. The Application filing date, as well as the date of the international registration on which the Application is based, is also long after Opposer's NOVARTIS mark has become famous.

9. The mark ONVERTIS to be registered by Applicant is confusingly similar in sound, appearance, and commercial impression to Opposer's registered, long-used and famous trademark NOVARTIS, in that ONVERTIS only inverts the first two characters of Opposer's NOVARTIS mark and otherwise differs by just one letter. Moreover, the use of "ON" as the prefix to the mark that otherwise is nearly identical to Novartis is likely to be perceived by consumers not as source identifying, but as a reference to "oncology," the field in which Applicant's chemotherapy would be used.

10. Moreover, the goods covered in the Application are closely related to products and services offered by Opposer under its NOVARTIS mark, such that consumer confusion is likely to result. Namely, NOVARTIS has a unit of its company that is referred to as Novartis Oncology, which unit is dedicated to consistently discovering, developing and making broadly available novel therapies that may improve and extend the lives of people living with cancer. In light of the prominence of the Novartis name in the field of oncology, it is likely that consumers will be confused into thinking that ONVERTIS is a new oncology drug from Opposer Novartis. This is particularly true since the "ON" prefix of Applicant's mark is also a shortening of oncology.

11. Upon information and belief, Applicant applied to register the ONVERTIS mark with full knowledge of Opposer's rights to the NOVARTIS mark and with full knowledge of Opposer's then-existing federal trademark registrations for the NOVARTIS mark.

12. The registration of Applicant's mark is inconsistent with Opposer's prior rights in the NOVARTIS mark and is inconsistent with Opposer's statutory grant of exclusivity of use of the registered NOVARTIS mark, and would destroy Opposer's investment and goodwill in its NOVARTIS mark.

13. The mark ONVERTIS sought to be registered by Applicant is so similar to Opposer's NOVARTIS mark as to be likely to cause confusion, or to cause mistake, or to deceive the purchasing public by creating the erroneous impression that Applicant's goods are authorized, licensed or sponsored by Opposer, or in some other way connected with Opposer. As such, any use or registration of the mark ONVERTIS by Applicant would violate Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

14. Because Opposer's NOVARTIS mark is famous, Applicant's use and registration of a highly similar mark ONVERTIS will dilute the distinctiveness of Opposer's mark by blurring or tarnishing it. Accordingly, Applicant's use and registration of ONVERTIS is in violation of Section 43(c) of the Federal Trademark Act, 15 U.S.C. §1125(c).

15. By reason of the foregoing, Opposer is likely to be harmed by registration of the Application for Applicant's Mark.

WHEREFORE, it is respectfully requested that this opposition be sustained and that the registration sought by Applicant in Application Serial No. 79/094,917 be denied.

Dated: New York, New York
March 21, 2012

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By: 
John P. Margiotta
Alexander L. Greenberg
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New York, New York 10017
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jmargiotta@fzlj.com
agreenberg@fzlj.com

Attorneys for the Opposer

EXHIBIT A

Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2012-03-21 15:08:41 ET

Serial Number: 75131409 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 2336960

Mark(words only): NOVARTIS

Standard Character claim: No

Current Status: The registration has been renewed.

Date of Status: 2010-03-25

Filing Date: 1996-07-09

Transformed into a National Application: No

Registration Date: 2000-04-04

Register: Principal

Law Office Assigned: LAW OFFICE 105

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: (NOT AVAILABLE)

Date In Location: 2010-03-25

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

1. NOVARTIS AG

Address:

NOVARTIS AG
CH-4002 BASEL
CH-4002 BASEL
Switzerland

Legal Entity Type: Corporation

State or Country of Incorporation: Switzerland

GOODS AND/OR SERVICES

International Class: 001**Class Status:** Section 8 - Cancelled**Basis:** 44(e)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)**International Class: 005****Class Status:** Active

pharmaceutical preparations for the treatment of - dermatological, cardiovascular, hematological, bone, respiratory, central nervous system, endocrinological, circulatory, gastroenterological, hormonal and diabetic disorders, coughs, colds, influenza, headaches, stomach and digestive disorders, muscular and/or rheumatic disorders, anti-inflammatory agents, immune system disorders and related diseases, allergic reactions, metabolic disorders, anti-infectives, ocular disorders, and for use in oncology; diagnostic preparations and/or reagents for clinical or medical laboratory use; Contact lens and eyecare solutions and preparations, namely, disinfectants, cleaning solutions, saline solutions and wetting solutions; Nicotine for medicinal purposes in liquid, pill, tablet, caplet, powder or transdermal patch form; Dietetic substances for medical purposes, namely, nutritional, vitamin, mineral supplements and preparations, nutritional drink mix for use as a meal replacement, Food and beverages for infants and invalids, namely, food for enteral administration and food for medically restricted diets; and fungicides, and insecticides, all for commercial, and/or domestic use

Basis: 44(e)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)**International Class: 009****Class Status:** Section 8 - Cancelled**Basis:** 44(e)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)**International Class: 010****Class Status:** Section 8 - Cancelled**Basis:** 44(e)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)**International Class: 029****Class Status:** Section 8 - Cancelled**Basis:** 44(e)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)**International Class: 030****Class Status:** Section 8 - Cancelled**Basis:** 44(e)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)

International Class: 031
Class Status: Section 8 - Cancelled
Basis: 44(e)
First Use Date: (DATE NOT AVAILABLE)
First Use in Commerce Date: (DATE NOT AVAILABLE)

International Class: 032
Class Status: Section 8 - Cancelled
Basis: 44(e)
First Use Date: (DATE NOT AVAILABLE)
First Use in Commerce Date: (DATE NOT AVAILABLE)

International Class: 042
Class Status: Section 8 - Cancelled
Basis: 44(e)
First Use Date: (DATE NOT AVAILABLE)
First Use in Commerce Date: (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

Foreign Application Number: 01044/1996
Foreign Registration Number: 427370
Foreign Registration Date: 1996-02-15
Country: Switzerland
Foreign Filing Date: 1996-02-15
Foreign Expiration Date: 2006-02-15

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

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

2010-03-25 - First renewal 10 year

2010-03-25 - Section 8 (10-year) accepted/ Section 9 granted

2010-03-24 - Case Assigned To Post Registration Paralegal

2010-03-23 - TEAS Section 8 & 9 Received

2006-06-23 - Partial Section 8 (6-year) accepted & Section 15 acknowledged

2006-06-21 - Assigned To Paralegal
2006-04-03 - Section 8 (6-year) and Section 15 Filed
2006-04-12 - Case File In TICRS
2006-04-03 - PAPER RECEIVED
2004-08-05 - PAPER RECEIVED
2000-04-04 - Registered - Principal Register
2000-02-17 - Opposition terminated for Proceeding
2000-02-17 - Opposition dismissed for Proceeding
1998-11-02 - Opposition instituted for Proceeding
1998-08-25 - Opposition papers filed
1998-07-28 - Published for opposition
1998-06-26 - Notice of publication
1998-04-23 - Approved For Pub - Principal Register
1998-03-13 - Communication received from applicant
1998-03-05 - Inquiry as to suspension mailed
1997-09-04 - Letter of suspension mailed
1997-07-10 - Communication received from applicant
1997-01-07 - Non-final action mailed
1996-12-23 - Assigned To Examiner
1996-12-06 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record
NANCY SABARRA

Correspondent
NANCY SABARRA

FROSS ZELNICK LEHRMAN ZISSU, P.C.
866 UNITED NATIONS PLAZA
NEW YORK NY 10017

Domestic Representative
FROSS ZELNICK LEHRMAN & ZISSU, P.C.

Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2012-03-21 15:09:54 ET

Serial Number: 78365657 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 2997235

Mark

NOVARTIS

(words only): NOVARTIS

Standard Character claim: Yes

Current Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.

Date of Status: 2011-09-29

Filing Date: 2004-02-10

Transformed into a National Application: No

Registration Date: 2005-09-20

Register: Principal

Law Office Assigned: LAW OFFICE 112

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: M30 -TMO Law Office 112

Date In Location: 2011-09-29

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

1. Novartis AG

Address:

Novartis AG

CH-4002

Basel

Switzerland

Legal Entity Type: Corporation**State or Country of Incorporation:** Switzerland

GOODS AND/OR SERVICES

International Class: 005**Class Status:** Active

Adjuvants for use with veterinary vaccines and veterinary vaccines for companion animals, farmed fish and livestock; veterinary products for companion animals, farmed fish and livestock, namely, cardiovascular treatment preparations, arthritis treatment preparations, renal treatment preparations, respiratory treatment preparations, reproductive treatment preparations, allergy treatment preparations, antibiotics, insecticides, pesticides and feed additives for veterinary use in the treatment of parasites, fleas, worms, renal diseases, heart diseases, allergic diseases, parasitic and bacterial infections, lameness, respiratory diseases, scours or enteritis, viral diseases, clostridial diseases, pinkeye, liver abscesses, influenza, pneumonia, mastitis, West Nile virus and erysipelas; insecticides and rodenticides for agricultural use, disinfectants for veterinary use

Basis: 1(a)**First Use Date:** 1997-09-30**First Use in Commerce Date:** 1997-09-30

ADDITIONAL INFORMATION

Prior Registration Number(s):

2336960

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

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

2011-09-29 - Notice Of Acceptance Of Sec. 8 & 15 - Mailed

2011-09-29 - Section 8 (6-year) accepted & Section 15 acknowledged

2011-09-29 - Case Assigned To Post Registration Paralegal
2011-09-13 - TEAS Section 8 & 15 Received
2005-09-20 - Registered - Principal Register
2005-06-28 - Published for opposition
2005-06-08 - Notice of publication
2005-03-23 - Law Office Publication Review Completed
2005-03-23 - Assigned To LIE
2005-03-11 - Approved for Pub - Principal Register (Initial exam)
2005-03-11 - Amendment From Applicant Entered
2005-02-18 - Communication received from applicant
2005-02-18 - PAPER RECEIVED
2004-09-08 - Non-final action mailed
2004-09-07 - Non-Final Action Written
2004-09-01 - Assigned To Examiner
2004-02-23 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record
NANCY SABARRA

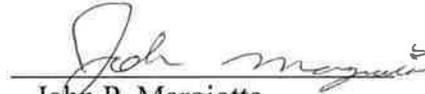
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CERTIFICATE OF SERVICE

The undersigned, counsel for Opposer, hereby certifies that a true and correct copy of the attached **NOTICE OF OPPOSITION** was served via first class mail, postage prepaid, upon Applicant's correspondent of record on this 21st day of March, 2012, as follows:

Paolo A. Strino, Esq
Lucas and Mercanti LLP
15th Floor
475 Park Avenue South
New York NY 10016


John P. Margiotta