

ESTTA Tracking number: **ESTTA543955**

Filing date: **06/19/2013**

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	MERZ PHARMACEUTICALS, LLC
Granted to Date of previous extension	06/19/2013
Address	4215 Tudor Lane Greensboro, NC 27410 UNITED STATES

Attorney information	G. Patrick SAGE HUESCHEN & SAGE PLLC 107 West Michigan Avenue, Seventh Floor, Kalamazoo Building Kalamazoo, MI 49007 UNITED STATES gps@hueschen-sage.us, jtf@hueschen-sage.us Phone:269-382-0030
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Applicant Information

Application No	85580587	Publication date	02/19/2013
Opposition Filing Date	06/19/2013	Opposition Period Ends	06/19/2013
Applicant	MURAD, INC. 2121 Rosecrans Avenue, Fifth Floor El Segundo, CA 90245 UNITED STATES		

Goods/Services Affected by Opposition

Class 003. All goods and services in the class are opposed, namely: Facial scrubs; Non-medicated acne treatment preparations; Non-medicated skin care preparations, namely, creams, lotions, gels, toners, cleaners and peels
Class 005. All goods and services in the class are opposed, namely: Dietary and nutritional supplements; Vitamins

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2360460	Application Date	07/03/1995
Registration Date	06/20/2000	Foreign Priority	NONE

		Date	
Word Mark	MEDERMA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 2000/03/03 First Use In Commerce: 2000/03/03 skin care products, namely, essential oils for personal use		

U.S. Registration No.	2464771	Application Date	10/10/1996
Registration Date	07/03/2001	Foreign Priority Date	NONE
Word Mark	MEDERMA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1997/04/04 First Use In Commerce: 1997/04/04 cosmetic and cleaning preparations, namely, a gel, cream, or ointment designed to improve the appearance of scars, blemishes, and other skin imperfections Class 005. First use: First Use: 1997/04/04 First Use In Commerce: 1997/04/04 pharmaceuticals, namely, a gel, cream, or ointment designed to improve the appearance of scars, blemishes, and other topical imperfections		

U.S. Registration No.	3139600	Application Date	09/16/2004
Registration Date	09/05/2006	Foreign Priority Date	NONE
Word Mark	MEDERMA FOR KIDS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 2004/12/15 First Use In Commerce: 2004/12/15 Non-medicated cosmetic and cleaning preparations for skin, namely, a gel, cream, and ointment for improving the appearance of scars, blemishes, and other skin imperfections Class 005. First use: First Use: 2004/12/15 First Use In Commerce: 2004/12/15 Pharmaceuticals, namely, a gel, cream, and ointment designed to improve the appearance of scars, blemishes, and other skin imperfections		

U.S. Registration No.	4084438	Application Date	01/07/2010
Registration Date	01/10/2012	Foreign Priority Date	NONE
Word Mark	MEDERMA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1997/00/00 First Use In Commerce: 1997/00/00 Non-medicated cosmetics for skin, namely, a gel, cream, or ointment for improving the appearance of stretch marks or other skin imperfections		

	Class 005. First use: First Use: 1997/00/00 First Use In Commerce: 1997/00/00 Pharmaceuticals, namely, a gel, cream or ointment designed to improve the appearance of stretch marks or other skin imperfections
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U.S. Registration No.	3233153	Application Date	06/14/2006
Registration Date	04/24/2007	Foreign Priority Date	NONE
Word Mark	MEDERMA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 1997/04/04 First Use In Commerce: 1997/04/04 Pharmaceuticals, namely, a gel, cream, or ointment designed to improve the appearance of scars, blemishes, and other topical imperfections		

Attachments	Notice of Opposition.pdf(4899993 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	/gpsage/
Name	G. Patrick SAGE
Date	06/19/2013

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

In the Matter of Trademark
Application Serial No. 85/580,587

MERZ PHARMACEUTICALS, LLC

Opposer,

v.

MURAD, INC.

Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

MERZ PHARMACEUTICALS, LLC (“Opposer”), a North Carolina Limited Liability Company, located at 4215 Tudor Lane , Greensboro, NC 27410, believes that it will be damaged by registration of the mark MY DERM, which is the subject of Application Serial No. 85/580,587, filed by MURAD, INC., a California Corporation, identifying the goods “Facial scrubs; Non-medicated acne treatment preparations; Non-medicated skin care preparations, namely, creams, lotions, gels, toners, cleaners and peels” and “Dietary and nutritional supplements; Vitamins”, in International Class(es) 03 and 05, respectively (“Application”), published in the Official Gazette on 19 February 2013, and hereby opposes the same.

As grounds for opposition, it is alleged that:

1. By the Application herein opposed, Applicant seeks to register the mark MY DERM for

"Facial scrubs; Non-medicated acne treatment preparations; Non-medicated skin care preparations, namely, creams, lotions, gels, toners, cleaners and peels" and "Dietary and nutritional supplements; Vitamins", in International Class(es) 03 and 05, respectively. The Application was filed on 27 March 2012 under an intent-to-use basis pursuant to 15 U.S.C. §1051(b).

2. Opposer owns the entire right, title and interest in and to the trademark MEDERMA and related marks as evidenced by the following (herein collectively referred to as "MEDERMA"):

Mark	Registration No.	Registration Date	Goods
MEDERMA	2,360,460	20 June 2000	"Skin care products, namely, essential oils for personal use," in International Class 3
MEDERMA (Stylized)	2,464,771	3 July 2001	"Cosmetic and cleaning preparations, namely, a gel, cream, or ointment designed to improve the appearance of scars, blemishes, and other skin imperfections," in International Class 3; and "Pharmaceuticals, namely, a gel, cream, or ointment designed to improve the appearance of scars, blemishes, and other topical imperfections," in International Class 5
MEDERMA FOR KIDS (Stylized)	3,139,600	5 Sept. 2006	"Non-medicated cosmetic and cleaning preparations for skin, namely, a gel, cream, and ointment for improving the appearance of scars, blemishes, and other skin imperfections," in International Class 3; and "Pharmaceuticals, namely, a gel, cream, and ointment designed to improve the appearance of scars, blemishes, and other skin imperfections," in International Class 5
MEDERMA	4,084,438	10 Jan. 2012	"Non-medicated cosmetics for skin, namely, a gel, cream, or ointment for improving the appearance of stretch marks or other skin imperfections," in International Class 3; and "Pharmaceuticals, namely, a gel, cream or ointment designed to improve the appearance of stretch marks or other skin imperfections," in International Class 5
MEDERMA	3,233,153	24 April 2007	"Pharmaceuticals, namely a gel, cream, or ointment designed to improve the appearance of scars, blemishes, and other topical imperfections," in International Class 5

The above-identified registrations on the Principal Register of the U.S. Patent and Trademark Office are in all respects valid, subsisting and owned by Opposer. Further, U.S. Registration Nos. 2,360,460, 2,464,771, 3,139,600 and 3,233,153 are incontestable pursuant to 15 U.S.C. §1065. Extracts from the Trademark Status & Document Retrieval (TSDR) of the U.S. Patent and Trademark Office showing the current status and particulars of Opposer's Registrations are attached hereto as Exhibit A and are made of record in this proceeding.

3. Opposer has spent and continues to spend large sums of money on the advertisement and promotion of the goods bearing the mark MEDERMA and related marks, and by reason of such advertising and the high quality of the goods carrying these marks, Opposer enjoys valuable goodwill and an enviable reputation with respect to the MEDERMA marks.
4. The trademark MEDERMA and related marks were adopted by Opposer as trademarks as early as 4 April 1997.
5. Opposer has engaged in the development, manufacture, advertising, distribution and sale in interstate commerce of the above-identified goods under the MEDERMA trademarks for more than fifteen (15) years. As such, Opposer claims the benefit of all statutory and common law rights which inure to the benefit of Opposer from the use of the MEDERMA trademarks.
6. The MEDERMA trademarks have been in continuous use in interstate commerce by Opposer for approximately fifteen (15) years on or in connection the above-identified goods on labels bearing the trademark as applied to the goods, on packaging in which

the goods are shipped and sold, on display in advertising and in other manners which are customary in the trade.

7. Opposer's development, manufacture, advertising, distribution and sale in interstate commerce of products under the MEDERMA trademarks significantly predate the filing date of the Application and any potential alleged use of the MY DERM mark by the Applicant.
8. Applicant's MY DERM mark, when considered in its entirety, is similar in sight, sound, appearance, and commercial impression to Opposer's MEDERMA trademarks. Further, the mark, when applied to Applicant's goods, which are closely related to Opposer's goods bearing the MEDERMA trademarks, or used in association with Applicant's goods, are likely to cause confusion and mistake, and to deceive and mislead consumers into believing that Applicant's goods originated, are sponsored by, are licensed from, or are jointly owned by or otherwise associated with Opposer and/or Opposer's goods marked with its MEDERMA trademarks.
9. Opposer will be irreparably damaged and/or injured by the registration sought by Applicant because such registration will support and assist Applicant in the confusing and misleading use of Applicant's mark sought to be registered in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), and will give color of statutory rights to Applicant in violation and derogation of the statutory and common law rights of Opposer in its MEDERMA trademarks.

Wherefore, Opposer believes that it will be damaged by the registration of Applicant's mark and respectfully requests that this opposition be sustained and that registration of Application Serial No. 85/580,587 be refused.

Respectfully submitted,

THE FIRM OF HUESCHEN AND SAGE

//gpsage//

Dated: 19 June 2013

G. Patrick SAGE (37,710)
Joanna T. FRENCH (59,688)
Attorney for Applicant
Seventh Floor, Kalamazoo Building
107 West Michigan Avenue
Kalamazoo, Michigan 49007
Phone: (269-382-0030)

EXHIBIT A

The USPTO is pleased to report that the TSDR problem with the display of mark images has been resolved. Please clear your individual browser cache prior to accessing TSDR. If you continue to experience technical difficulties, [please email](#).

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Mark: MEDERMA

MEDERMA

US Serial Number: 74696128

Application Filing Date: Jul. 03, 1995

US Registration Number: 2360460

Registration Date: Jun. 20, 2000

Register: Principal

Mark Type: Trademark

Status: The registration has been renewed.

Status Date: Apr. 12, 2010

Publication Date: May 21, 1996

Notice of Allowance Date: Mar. 11, 1997

Mark Information

Mark Literal Elements: MEDERMA

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [.] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks "*" identify additional (new) wording in the goods/services.

For: skin care products, namely, essential oils for personal use

International Class(es): 003 - Primary Class

U.S Class(es): 001, 004, 006, 050, 051, 052

Class Status: ACTIVE

Basis: 1(a)

First Use: Mar. 03, 2000

Use in Commerce: Mar. 03, 2000

Basis Information (Case Level)

Current Owner(s) Information

Owner Name: MERZ PHARMACEUTICALS, LLC

Owner Address: 4215 TUDOR LANE
GREENSBORO, NORTH CAROLINA 27410
UNITED STATES

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: NORTH CAROLINA

Attorney/Correspondence Information

Prosecution History

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

Renewal Date: Jun. 20, 2010

TM Staff and Location Information

Assignment Abstract Of Title Information - [Click to Load](#)

Proceedings - [Click to Load](#)

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Mark: MEDERMA



US Serial Number: 75179474

Application Filing Date: Oct. 10, 1996

US Registration Number: 2464771

Registration Date: Jul. 03, 2001

Register: Principal

Mark Type: Trademark

Status: The registration has been renewed.

Status Date: Jun. 08, 2011

Publication Date: Mar. 13, 2001

Mark Information

Mark Literal Elements: MEDERMA

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Design Search Code(s): 26.17.13 - Letters or words underlined and/or overlined by one or more strokes or lines; Underlined words or letters; Overlined words or letters

Related Properties Information

Claimed Ownership of US [1981076](#), [2360460](#)
Registrations:

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks "*" identify additional (new) wording in the goods/services.

For: cosmetic and cleaning preparations, namely, a gel, cream, or ointment designed to improve the appearance of scars, blemishes, and other skin imperfections

International Class(es): 003 - Primary Class

U.S Class(es): 001, 004, 006, 050, 051, 052

Class Status: ACTIVE

Basis: 1(a)

First Use: Apr. 04, 1997

Use in Commerce: Apr. 04, 1997

For: pharmaceuticals, namely, a gel, cream, or ointment designed to improve the appearance of scars, blemishes, and other topical imperfections

International Class(es): 005 - Primary Class

U.S Class(es): 006, 018, 044, 046, 051, 052

Class Status: ACTIVE

Basis: 1(a)

First Use: Apr. 04, 1997

Use in Commerce: Apr. 04, 1997

Basis Information (Case Level)

Current Owner(s) Information

Owner Name: MERZ PHARMACEUTICALS, LLC

Owner Address: 4215 TUDOR LANE
GREENSBORO, NORTH CAROLINA 27410
UNITED STATES

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: NORTH CAROLINA

Attorney/Correspondence Information

Prosecution History

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

Renewal Date: Jul. 03, 2011

TM Staff and Location Information

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Mark: MEDERMA FOR KIDS



US Serial Number: 76611608

Application Filing Date: Sep. 16, 2004

US Registration Number: 3139600

Registration Date: Sep. 05, 2006

Register: Principal

Mark Type: Trademark

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

Status Date: Sep. 24, 2012

Publication Date: Jan. 03, 2006

Notice of Allowance Date: Mar. 28, 2006

Mark Information

Mark Literal Elements: MEDERMA FOR KIDS

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Color(s) Claimed: Color is not claimed as a feature of the mark.

Disclaimer: "FOR KIDS"

Design Search Code(s): 26.17.13 - Letters or words underlined and/or overlined by one or more strokes or lines; Underlined words or letters; Overlined words or letters

Related Properties Information

Claimed Ownership of US [1981076](#), [2360460](#), [2464771](#)
Registrations:

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [.] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of
- Astensks "*" identify additional (new) wording in the goods/services.

For: Non-medicated cosmetic and cleaning preparations for skin, namely, a gel, cream, and ointment for improving the appearance of scars, blemishes, and other skin imperfections

International Class(es): 003 - Primary Class

U.S Class(es): 001, 004, 006, 050, 051, 052

Class Status: ACTIVE

Basis: 1(a)

First Use: Dec. 15, 2004

Use in Commerce: Dec. 15, 2004

For: Pharmaceuticals, namely, a gel, cream, and ointment designed to improve the appearance of scars, blemishes, and other skin imperfections

International Class(es): 005 - Primary Class

U.S Class(es): 006, 018, 044, 046, 051, 052

Class Status: ACTIVE

Basis: 1(a)

First Use: Dec. 15, 2004

Use in Commerce: Dec. 15, 2004

Basis Information (Case Level)

Current Owner(s) Information

Owner Name: MERZ PHARMACEUTICALS, LLC

Owner Address: 4215 Tudor Lane
Greensboro, NORTH CAROLINA 27410
UNITED STATES

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: NORTH CAROLINA

Attorney/Correspondence Information

Prosecution History

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

TM Staff and Location Information

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Mark: MEDERMA

MEDERMA

US Serial Number: 77907204

Application Filing Date: Jan. 07, 2010

US Registration Number: 4084438

Registration Date: Jan. 10, 2012

Register: Principal

Mark Type: Trademark

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Jan. 10, 2012

Publication Date: May 25, 2010

Notice of Allowance Date: Nov. 23, 2010

Mark Information

Mark Literal Elements: MEDERMA

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Related Properties Information

Claimed Ownership of US [2360460](#), [2464771](#), [3233153](#) and others
Registrations:

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [.] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks "*" identify additional (new) wording in the goods/services.

For: Non-medicated cosmetics for skin, namely, a gel, cream, or ointment for improving the appearance of stretch marks or other skin imperfections

International Class(es): 003 - Primary Class

U.S Class(es): 001, 004, 006, 050, 051, 052

Class Status: ACTIVE

Basis: 1(a)

First Use: 1997

Use in Commerce: 1997

For: Pharmaceuticals, namely, a gel, cream or ointment designed to improve the appearance of stretch marks or other skin imperfections

International Class(es): 005 - Primary Class

U.S Class(es): 006, 018, 044, 046, 051, 052

Class Status: ACTIVE

Basis: 1(a)

First Use: 1997

Use in Commerce: 1997

Basis Information (Case Level)

Current Owner(s) Information

Owner Name: MERZ PHARMACEUTICALS, LLC

Owner Address: 4215 Tudor Lane
Greensboro, NORTH CAROLINA 27410
UNITED STATES

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: NORTH CAROLINA

Attorney/Correspondence Information

Prosecution History

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Mark: MEDERMA

MEDERMA

US Serial Number: 78908193

Application Filing Date: Jun. 14, 2006

US Registration Number: 3233153

Registration Date: Apr. 24, 2007

Register: Principal

Mark Type: Trademark

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

Status Date: May 03, 2013

Publication Date: Feb. 06, 2007

Mark Information

Mark Literal Elements: MEDERMA

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Related Properties Information

Claimed Ownership of US [1981076](#), [2360460](#), [2464771](#)

Registrations:

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks "*" identify additional (new) wording in the goods/services

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International Class(es): 005 - Primary Class

U.S Class(es): 006, 018, 044, 046, 051, 052

Class Status: ACTIVE

Basis: 1(a)

First Use: Apr. 04, 1997

Use in Commerce: Apr. 04, 1997

Basis Information (Case Level)

Current Owner(s) Information

Owner Name: MERZ PHARMACEUTICALS, LLC

Owner Address: 4215 Tudor Lane
Greensboro, NORTH CAROLINA 27410
UNITED STATES

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: NORTH CAROLINA

Attorney/Correspondence Information

Prosecution History

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

TM Staff and Location Information

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Application Serial No. 85/580,587

MERZ PHARMACEUTICALS, LLC

Opposer,

v.

MURAD, INC.

Applicant.

Opposition No. _____

CERTIFICATE OF SERVICE

I hereby certify that the foregoing Notice of Opposition is being served on the "Attorney of Record" for the Applicant by mailing a true copy via First Class Mail, postage prepaid, addressed to:

Michael A. PAINTER, ESQ.
ISAACMAN, KAUFMAN & PAINTER
10250 Constellation Blvd Ste 2900
Los Angeles, CA 90067-6229

THE FIRM OF HUESCHEN AND SAGE

//jtfrench//

Dated: 19 June 2013

Joanna T. FRENCH