

ESTTA Tracking number: **ESTTA675285**

Filing date: **06/01/2015**

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	Allergan, Inc.
Granted to Date of previous extension	05/31/2015
Address	2525 Dupont Drive Irvine, CA 92612 UNITED STATES

Attorney information	Kenneth L. Wilton Seyfarth Shaw LLP 2029 Century Park East, Suite 3500 Los Angeles, CA 90067-3021 UNITED STATES kwilton@seyfarth.com, hinchey_susan@allergan.com, kelko@seyfarth.com Phone:(310) 277-7200
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**Applicant Information**

Application No	86334705	Publication date	12/02/2014
Opposition Filing Date	06/01/2015	Opposition Period Ends	05/31/2015
Applicant	Amorepacific Corporation 181, 2-ga, Hangang-ro, Yongsan-gu Seoul, KOREA, REPUBLIC OF		

**Goods/Services Affected by Opposition**

Class 003. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Bleaching preparations for household use; Cleaning preparations for household use; Cosmetic preparations for skin care;Cosmetic soaps; Cosmetics; Dentifrices;Essential oils for flavorings for confectionaries; Fabric softeners for laundryuse; Furniture polish; Hair shampoo; Laundry starch; Laundry wax; Lavender oil;Lipstick; Make-up foundations; Mask pack for cosmetic purposes; Perfumes; Polishing paper; Shoe cream; Skin lotions; Soap powder
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**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.	1692384	Application Date	12/21/1990
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Registration Date	06/09/1992	Foreign Priority Date	NONE
Word Mark	BOTOX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 1990/09/00 First Use In Commerce: 1992/01/22 pharmaceutical preparations; namely, ophthalmic muscle relaxants		

U.S. Registration No.	1709160	Application Date	02/06/1991
Registration Date	08/18/1992	Foreign Priority Date	NONE
Word Mark	BOTOX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 1990/09/00 First Use In Commerce: 1992/01/22 pharmaceutical preparations for the treatment of neurologic disorders		

U.S. Registration No.	2510675	Application Date	01/03/2001
Registration Date	11/20/2001	Foreign Priority Date	NONE
Word Mark	BOTOX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 1990/09/30 First Use In Commerce: 1992/01/22 Pharmaceutical preparations for the treatment of neurological disorders, muscledystonias, smooth muscle disorders, autonomic nerve disorders, headaches, wrinkles, hyperhydrosis, sports injuries, cerebral palsy, spasms, tremors and pain		

Attachments	78041618#TMSN.png( bytes ) Notice of Opposition.pdf(294457 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	/Kenneth L. Wilton/
Name	Kenneth L. Wilton
Date	06/01/2015

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

In the Matter of Application Serial No. 86/334,705  
Published in the Official Gazette of December 2, 2014

ALLERGAN, INC.,

Opposer,

v.

AMOREPACIFIC CORPORATION,

Applicant.

Opposition No.

**NOTICE OF OPPOSITION**

Opposer Allergan, Inc. (“Opposer”) believes that it will be damaged by registration of the mark shown in Application Serial No. 86/334,705, and hereby opposes the same. As grounds for opposition, Opposer alleges as follows:

1. Opposer is a corporation organized and existing under the laws of the State of Delaware, with a principal place of business at 2525 Dupont Drive, Irvine, California 92612. Opposer is, and has been, for many years engaged in the manufacture, development, sale and advertising of an extensive array of pharmaceutical, ophthalmic and dermatological products. Beginning in or about 1990, Opposer has continuously marketed a pharmaceutical product for the therapeutic treatment of neurological disorders and muscle dystonias under the trademark BOTOX<sup>®</sup> (the “BOTOX<sup>®</sup> Mark”) in the United States and globally (the “BOTOX<sup>®</sup> Product”).

2. In or about 1999, Opposer began clinical trials of the BOTOX<sup>®</sup> Product for a cosmetic indication, and shipped the BOTOX<sup>®</sup> Product under the BOTOX<sup>®</sup> Mark during those

trials. In 2002, following approval by the United States Food and Drug Administration of the BOTOX<sup>®</sup> Product for the temporary improvement in the appearance of moderate to severe glabellar lines, Opposer started promoting and marketing its BOTOX<sup>®</sup> Product under the BOTOX<sup>®</sup> Mark for that indication.

3. Opposer owns all right, title and interest in and to the BOTOX<sup>®</sup> Mark, as well as the following United States registrations of its BOTOX<sup>®</sup> Mark on the Principal Register:

a. Registration No. 1,692,384 granted June 9, 1992, for the mark BOTOX in International Class 5 for “pharmaceutical preparations; namely, ophthalmic muscle relaxants”;

b. Registration No. 1,709,160 granted August 18, 1992, for the mark BOTOX in International Class 5 for “pharmaceutical preparations for the treatment of neurologic disorders”;

c. Registration No. 2,510,675 granted November 20, 2001, for the mark BOTOX in International Class 5 for “pharmaceutical preparations for the treatment of neurological disorders, muscle dystonias, smooth muscle disorders, autonomic nerve disorders, headaches, wrinkles, hyperhidrosis, sports injuries, cerebral palsy, spasms, tremors and pain”;

All of these registrations are valid and subsisting and all have become incontestable. Copies of current printouts of information from the electronic database records of the USPTO showing the current status and title of these registrations are attached hereto as Exhibit 1 and are incorporated by reference herein as if set forth in full.

4. From a time long prior to the filing of the Application at issue, Opposer has used the BOTOX<sup>®</sup> Mark in commerce in the United States on and in connection with the foregoing

goods, for which the mark has become famous. Moreover, by virtue of the excellence of the product sold under the BOTOX<sup>®</sup> Mark, the mark has a valuable reputation.

5. Notwithstanding Opposer's long prior rights in and to the BOTOX<sup>®</sup> Mark, Applicant, on information and belief, on July 11, 2014, filed an application for registration of the trademark "SLEEPTOX" (the "SLEEPTOX Mark") for "Bleaching preparations for household use; Cleaning preparations for household use; Cosmetic preparations for skin care; Cosmetic soaps; Cosmetics; Dentifrices; Essential oils for flavorings for confectionaries; Fabric softeners for laundry use; Furniture polish; Hair shampoo; Laundry starch; Laundry wax; Lavender oil; Lipstick; Make-up foundations; Mask pack for cosmetic purposes; Perfumes; Polishing paper; Shoe cream; Skin lotions; Soap powder" in International Class 3, and the mark was published for opposition in the Trademark Official Gazette of December 2, 2014 (the "Opposed Application").

**FIRST CLAIM FOR RELIEF**  
**(Likelihood of Confusion With Registered Mark)**

6. Opposer repeats and realleges the allegations in preceding paragraphs 1 through 5, inclusive, as if fully set forth herein.

7. The SLEEPTOX Mark shown in the Opposed Application so resembles Opposer's registered BOTOX<sup>®</sup> Mark as to be likely, when used on or in connection with the goods and services identified in the Opposed Application, to cause confusion, to cause mistake, or to deceive, and Applicant's mark is thus unregistrable under Section 2(d) of the United States Trademark Act, 15 U.S.C. § 1052(d).

8. Opposer will be damaged by registration of the mark shown in the Opposed Application because registration will give Applicant *prima facie* evidence of its ownership of, and its exclusive nationwide right to use, a mark that is confusingly similar to Opposer's BOTOX<sup>®</sup> Mark.

**SECOND CLAIM FOR RELIEF**  
**(Likelihood of Confusion With Previously-Used Trademark)**

9. Opposer repeats and realleges the allegations in preceding paragraphs 1 through 8, inclusive, as if fully set forth herein.

10. The SLEEPTOX Mark shown in the Opposed Application so resembles Opposer's previously used and not abandoned BOTOX<sup>®</sup> Mark as to be likely, when used on or in connection with the goods and services identified in the Opposed Application, to cause confusion, to cause mistake, or to deceive, and Applicant's mark is thus unregistrable under Section 2(d) of the United States Trademark Act, 15 U.S.C. § 1052(d).

11. Opposer will be damaged by registration of the mark shown in the Opposed Application because registration will give Applicant *prima facie* evidence of its ownership of, and its exclusive nationwide right to use, a mark that is confusingly similar to Opposer's previously used and not abandoned BOTOX<sup>®</sup> Mark.

**THIRD CLAIM FOR RELIEF**  
**(Likelihood of Dilution With Previously Registered And Used Trademark)**

12. Opposer repeats and realleges the allegations in preceding paragraphs 1 through 11, inclusive, as if fully set forth herein.

13. Opposer's BOTOX<sup>®</sup> Mark is distinctive and famous, and was determined by the Board to be famous at least as early as August 20, 2007.

14. Opposer's BOTOX<sup>®</sup> Mark was famous long prior to the date of filing of the Opposed Application.

15. The SLEEPTOX Mark shown in the Opposed Application so resembles Opposer's previously used, registered and not abandoned BOTOX<sup>®</sup> Mark as to be likely to blur the distinctiveness of Opposer's famous BOTOX<sup>®</sup> Mark and Applicant's mark is thus unregistrable under Section 43(c) of the United States Trademark Act, 15 U.S.C. § 1125(c).



# **EXHIBIT 1**

<b>STATUS</b>	<b>DOCUMENTS</b>	<a href="#">Back to Search</a>	 <a href="#">Print</a>
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**Generated on:** This page was generated by TSDR on 2015-06-01 14:12:30 EDT

**Mark:** BOTOX No Image exists for this case.

**US Serial Number:** 74126661 **Application Filing Date:** Dec. 21, 1990

**US Registration Number:** 1692384 **Registration Date:** Jun. 09, 1992

**Register:** Principal

**Mark Type:** Trademark

**Status:** The registration has been renewed.

**Status Date:** Feb. 25, 2012

**Publication Date:** Jul. 02, 1991 **Notice of Allowance Date:** Sep. 24, 1991

**▲ Mark Information**

[▼ Expand All](#)

**▾ 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 incontestability; and
- Asterisks \*.\* identify additional (new) wording in the goods/services.

**For:** pharmaceutical preparations; namely, ophthalmic muscle relaxants

**International Class(es):** 005 - Primary Class **U.S Class(es):** 018

**Class Status:** ACTIVE

**Basis:** 1(a)

**First Use:** Sep. 1990 **Use in Commerce:** Jan. 22, 1992

**▲ Basis Information (Case Level)**

**▾ Current Owner(s) Information**

**Owner Name:** ALLERGAN, INC.

**Owner Address:** 2525 DUPONT DRIVE  
IRVINE, CALIFORNIA 92612  
UNITED STATES

**Legal Entity Type:** CORPORATION

**State or Country Where Organized:** DELAWARE

▲ [Attorney/Correspondence Information](#)

▲ [Prosecution History](#)

▲ [Maintenance Filings or Post Registration Information](#)

▲ [TM Staff and Location Information](#)

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<b>STATUS</b>	<b>DOCUMENTS</b>	<a href="#">Back to Search</a>	 <a href="#">Print</a>
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<b>Generated on:</b>	This page was generated by TSDR on 2015-06-01 14:15:48 EDT		
<b>Mark:</b>	BOTOX	No Image exists for this case.	
<b>US Serial Number:</b>	74136930	<b>Application Filing Date:</b>	Feb. 06, 1991
<b>US Registration Number:</b>	1709160	<b>Registration Date:</b>	Aug. 18, 1992
<b>Register:</b>	Principal		
<b>Mark Type:</b>	Trademark		
<b>Status:</b>	The registration has been renewed.		
<b>Status Date:</b>	Feb. 27, 2012		
<b>Publication Date:</b>	Nov. 12, 1991	<b>Notice of Allowance Date:</b>	Feb. 04, 1992

**Mark Information** [Expand All](#)

<b>Mark Literal Elements:</b>	BOTOX		
<b>Standard Character Claim:</b>	No		
<b>Mark Drawing Type:</b>	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 incontestability; and
- Asterisks \*.\* identify additional (new) wording in the goods/services.

<b>For:</b>	pharmaceutical preparations for the treatment of neurologic disorders		
<b>International Class(es):</b>	005 - Primary Class	<b>U.S Class(es):</b>	018
<b>Class Status:</b>	ACTIVE		
<b>Basis:</b>	1(a)		
<b>First Use:</b>	Sep. 1990	<b>Use in Commerce:</b>	Jan. 22, 1992

**Basis Information (Case Level)**

**Current Owner(s) Information**

<b>Owner Name:</b>	ALLERGAN, INC.		
<b>Owner Address:</b>	2525 DUPONT DRIVE IRVINE, CALIFORNIA 92612 UNITED STATES		
<b>Legal Entity Type:</b>	CORPORATION	<b>State or Country Where Organized:</b>	DELAWARE

▲ **Attorney/Correspondence Information**

▲ **Prosecution History**

▲ **Maintenance Filings or Post Registration Information**

▲ **TM Staff and Location Information**

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**Mark:** BOTOX



**US Serial Number:** 78041618

**Application Filing Date:** Jan. 03, 2001

**US Registration Number:** 2510675

**Registration Date:** Nov. 20, 2001

**Register:** Principal

**Mark Type:** Trademark

**Status:** The registration has been renewed.

**Status Date:** Jan. 24, 2011

**Publication Date:** Aug. 28, 2001

▲ **Mark Information**

▼ [Expand All](#)

▲ **Related Properties Information**

▾ **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 incontestability; and
- Asterisks \*..\* identify additional (new) wording in the goods/services.

**For:** Pharmaceutical preparations for the treatment of neurological disorders, muscle dystonias, smooth muscle disorders, autonomic nerve disorders, headaches, wrinkles, hyperhidrosis, sports injuries, cerebral palsy, spasms, tremors and pain

**International Class(es):** 005 - Primary Class

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

**Class Status:** ACTIVE

**Basis:** 1(a)

**First Use:** Sep. 30, 1990

**Use in Commerce:** Jan. 22, 1992

▲ **Basis Information (Case Level)**

▾ **Current Owner(s) Information**

**Owner Name:** Allergan, Inc.

**Owner Address:** 2525 Dupont Drive  
Irvine, CALIFORNIA 92612  
UNITED STATES

**Legal Entity Type:** CORPORATION

**State or Country Where Organized:** DELAWARE

▲ **Attorney/Correspondence Information**

▲ **Prosecution History**

▲ **Maintenance Filings or Post Registration Information**

▲ **TM Staff and Location Information**

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

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**CERTIFICATE OF SERVICE**

I hereby certify that on June 1, 2015, I served this Notice of Opposition on the applicant by mailing a copy thereof by First Class Mail, postage prepaid, addressed to applicant's correspondence address of record as follows:

Miriam D. Trudell, Esq.  
SHERIDAN ROSS P.C.  
1560 Broadway, Suite 1200  
Denver, CO 80202-5145

*s/ Eleanor Elko*  
\_\_\_\_\_  
Eleanor Elko