

ESTTA Tracking number: **ESTTA729650**

Filing date: **02/26/2016**

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	EXELTIS USA, Inc.
Granted to Date of previous extension	04/13/2016
Address	One Main Street Suite 203 CHATHAM, NJ 07928 UNITED STATES

Attorney information	Augusto Perera, Esq. Albert Bordas, P.A. 5975 Sunset Drive, Suite 705 Miami, FL 33143 UNITED STATES tm@bordasiplaw.com Phone:(305) 669-9848
----------------------	--

**Applicant Information**

Application No	86698847	Publication date	12/15/2015
Opposition Filing Date	02/26/2016	Opposition Period Ends	04/13/2016
Applicant	Primus Pharmaceuticals, Inc. 7373 N. Scottsdale Road, Suite B-200 Scottsdale, AZ 85253 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 005. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Topical hormone preparations
---

**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
No use of mark in commerce before application was filed	Trademark Act section 1(a)
Applicant not rightful owner of mark for identified goods or services	Trademark Act section 1

**Mark Cited by Opposer as Basis for Opposition**

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	ESTRASORB		

Goods/Services	pharmaceuticals, namely topical hormone preparations
----------------	--

Attachments	160226.Notice of Opposition.ESTRASORB.pdf(262395 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	/ap/
Name	Augusto Perera, Esq.
Date	02/26/2016

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

In the matter of Application Serial No. 86698847

For the mark: ESTRASORB

Filing Date: July 20, 2015

EXELTIS USA, Inc. )  
Opposer, )  
v. )  
Primus Pharmaceuticals, Inc. )  
Applicant. )  
\_\_\_\_\_ )

Opposition No. \_\_\_\_\_

**NOTICE OF OPPOSITION**

EXELTIS USA, Inc., ("Opposer"), a corporation organized under the laws of New Jersey, with offices located at One Main Street Suite 203, CHATHAM NJ 07928, believes it will be damaged by the issuance of a registration to Primus Pharmaceuticals, Inc., A Delaware Corporation, having an address at 7373 N. Scottsdale Road, Suite B-200 Scottsdale, ARIZONA UNITED STATES 85253 ("Applicant"), upon its Application Serial No. 86698847 for the mark "ESTRASORB" covering "Topical hormone preparations" ("the Application" or "Applicant's Mark"), and having been previously granted an extension of time to oppose, hereby opposes the Application on the following grounds:

1. On information and belief on July 20, 2015, Applicant filed the Application based on intent-to-use the mark in commerce.
2. Opposer, EXELTIS USA, Inc., through its predecessors in interest and title, and through its related companies, divisions and/or licensees (hereinafter individually and/or collectively referred to as "Opposer"), has been engaged in the manufacture and sale of pharmaceuticals, including topical hormone preparations for over 15 years.
3. Since at least as early as 2003, Opposer has used the ESTRASORB mark in connection with the sale of pharmaceuticals, including topical hormone preparations. Opposer, through its predecessors in interest and title was the owner of a federal registration US Registration Number 2784534 having registration date of November 18, 2003. See enclosed Exhibit A.
4. Registration Number 2784534 became incontestable on November 25, 2009 as evidenced by the NOTICE OF ACCEPTANCE AND ACKNOWLEDGEMENT OF §8 & 15 DECLARATION issued by the United States Patent and Trademark Office on that day. See enclosed Exhibit B. Registration Number 2784534 was cancelled because registrant at that time, MEDICIS PHARMACEUTICAL CORPORATION, inadvertently did not file an acceptable declaration under Section 8.
5. Opposer acquired the rights over this mark on October 2015 without realizing that this registration was, at that time, already cancelled.
6. In no time, neither Opposer nor their predecessors in interest and title stopped using the mark in commerce nor they had the intention of abandoning the mark. The mark was never abandoned and was sold continuously since 2003 to the present. See enclosed Exhibits B and D evidence of use of the mark in commerce.

7. Opposer's use of its "ESTRASORB" trademark has been extensively and continuously offered to the public having a prescription through pharmacies. Opposer has also extensively advertised its products on the radio and in newspaper under the "ESTRASORB" trademark throughout the United States. Opposer has spent considerably sums of money every year for the past 15 years promoting the "ESTRASORB" mark. By reason of such advertising and wide distribution of Opposer's products bearing its trademark, the public has come to recognize "ESTRASORB" as signifying Opposer and its products, and Opposer has built up extensive good will in connection with the promotion of its products under the "ESTRASORB" trademark.
8. Notwithstanding Opposer's long prior rights in and to the "ESTRASORB" trademark, a mark well known to Applicant, Applicant on information and belief on July 20, 2015 filed an application for registration of the trademark "ESTRASORB" for "Topical hormone preparations". The application was given Serial No. 86698847, and the mark was published for opposition on December 15, 2015.
9. Applicant's trademark "ESTRASORB" is confusingly similar to Opposer's "ESTRASORB" trademark, and its registration by Applicant for "Topical hormone preparations" is likely to cause confusion, deception, and mistake. The channels of trade - pharmacies, supermarkets and health food stores - are identical for both products. Applicant's use of the "ESTRASORB" interferes with Opposer's use of its "ESTRASORB" trademark, and registration of its mark by applicant will seriously damage Opposer.
10. Opposer has prior use over Applicant because its first date of use precedes the filing date of the Applicant's Application.

11. Registration of the Application, which is the subject of this opposition, is barred by the provisions of Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d) because said mark consists of or comprises a mark which so resembles a mark previously registered in the United States Patent and Trademark Office and continuously used in the United States by Opposer and not abandoned, as to be likely, when used in connection with the claimed goods of the Applicant to cause confusion, mistake or deception.
12. Applicant's Mark and Opposer's Marks are similar in sight, sound, meaning and overall commercial impression. These similarities are enhanced in view of prior use and registration of Opposer's Mark such that, on information and belief, consumers are likely to perceive Applicant's Application as a similar or related play off of Opposer's Mark.
13. Accordingly, Applicant's Mark consists of and comprises a designation that it is identical to Opposer's Mark, as to be likely when used on or in connection with the goods of the Applicant, to cause confusion, to cause mistake or to deceive. The likelihood of confusion, mistake or deception that would also arise from concurrent use and registration of the applied for mark with Opposer's use of its ESTRASORB Marks is that (a) persons are likely to believe that Applicant's products have their source in Opposer, or (b) that Applicant's goods are in some way legitimately connected or affiliated with, sponsored, approved, endorsed or licensed by Opposer when, in fact, they are not. Accordingly, registration of Applicant's Mark is barred by the provisions of Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §§ 1052(d), 1063.
14. Opposer's goods and the Applicant's goods travel in the same channels of trade and are viewed by the same customers including those who need pharmaceuticals, including topical hormone preparations.

15. Applicant's Mark which is the subject of this opposition, so resembles Opposer's previously used Mark, as to be likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection or association of Applicant with Opposer or to constitute a false representation that Applicant's goods are approved or sponsored by Opposer thereby deceiving the public, causing confusion or mistake and causing damage to Opposer within the meaning of 15 U.S.C. § 1125(a).
16. Opposer's ESTRASORB Mark is inherently distinctive and became famous long prior to the filing date of Applicant's application-in-opposition and/or any eventual claimed date of first use by Applicant. Registration and use of Applicant's Mark would likely dilute the distinctiveness of Opposer's famous and highly distinctive ESTRASORB Mark in violation of 15 U.S.C. § I 125(c). Accordingly, Applicant's Mark is not entitled to registration and will damage Opposer's rights under 15 U.S.C. §§ 1052(1), 1063 and 1125(c).
17. Opposer will be damaged by the registration sought by Applicant within the meaning of 15 U.S.C. §1063 because such a registration would support and assist Applicant in the confusing, misleading and/or dilutive use of Opposer's Mark, and would give color of exclusive statutory rights to Applicant in violation and derogation of the prior and superior rights of Opposer.
18. In view of the foregoing, issuance of a registration to Applicant for its claimed ESTRASORB Mark, which is the subject of the Application would, therefore, be damaging to Opposer's common law marks within the meaning of the Lanham Act, 15 U.S.C. §§ 1052, 1063, 1114, 1125.

WHEREFORE, Opposer prays that this Opposition be sustained, that registration be denied to Applicant on its Application Serial No. 86698847 and that the Board grant all further relief favorable to Opposer that is necessary and just in these circumstances.

Dated: February 25, 2016

Albert Bordas, P.A.  
Attorneys for Opposer  
5975 Sunset Drive Suite 705  
Miami, Florida 33143  
Telephone: (305) 669-9848  
Facsimile: (305) 669-9851

By: /Augusto Perera/  
Augusto Perera, Esq.  
FL Bar No: 117890  
[tm@bordasiplaw.com](mailto:tm@bordasiplaw.com)

By: /Albert Bordas/  
Albert Bordas, Esq.  
FL Bar No: 330220  
[albert@bordasiplaw.com](mailto:albert@bordasiplaw.com)

**CERTIFICATE OF ONLINE SUBMISSION**

I certify that a true and correct copy of the foregoing was filed online with the Trademark Trial and Appeal Board using ESTTA, this February 26, 2016.

By: /Augusto Perera/  
Augusto Perera, Esq.

**CERTIFICATE OF SERVICE**

I certify that a true and accurate copy of the foregoing NOTICE OF OPPOSITION was served by: first class mail, postage prepaid, and fax on February 26, 2016 upon Registrant:

Primus Pharmaceuticals, Inc.  
Frost Brown Todd Llc  
301 E 4th St  
Cincinnati, OH 45202-4245

And;

MONICA L. DIAS  
Attorney of Record  
Frost Brown Todd Llc  
301 E 4th St  
Cincinnati, OHIO UNITED STATES 45202-4245  
Phone: 513.651.6800 Fax: 513.651.6981  
E-mail: [trademarks@fbtlaw.com](mailto:trademarks@fbtlaw.com)  
[mdias@fbtlaw.com](mailto:mdias@fbtlaw.com)  
[rdarapel@fbtlaw.com](mailto:rdarapel@fbtlaw.com)

By: /Augusto Perera/  
Augusto Perera, Esq.

**Int. Cl.: 5**

**Prior U.S. Cls.: 6, 18, 44, 46, 51, and 52**

**Reg. No. 2,784,534**

**United States Patent and Trademark Office**

Registered Nov. 18, 2003

**TRADEMARK  
PRINCIPAL REGISTER**

**ESTRASORB**

NOVAVAX, INC. (DELAWARE CORPORATION)  
12111 PARKLAWN DRIVE  
ROCKVILLE, MD 20852

FIRST USE 3-3-2003; IN COMMERCE 3-3-2003.

SN 75-833,622, FILED 10-27-1999.

FOR: PHARMACEUTICALS, NAMELY TOPICAL  
HORMONE PREPARATIONS, IN CLASS 5 (U.S. CLS.  
6, 18, 44, 46, 51 AND 52).

BARNEY CHARLON, EXAMINING ATTORNEY

**EXHIBIT A**

Side - 1



**NOTICE OF ACCEPTANCE AND  
ACKNOWLEDGEMENT OF §§8 & 15  
DECLARATION  
MAILING DATE: Nov 25, 2009**

The combined declaration of use and incontestability filed in connection with the registration identified below meets the requirements of Sections 8 and 15 of the Trademark Act, 15 U.S.C. §1058 and 1065. The combined declaration is accepted and acknowledged. The registration remains in force.

For further information about this notice, visit our website at: <http://www.uspto.gov>. To review information regarding the referenced registration, go to <http://tarr.uspto.gov>.

**REG NUMBER: 2784534**  
**MARK: ESTRASORB**  
**OWNER: GRACEWAY PHARMACEUTICALS, LLC**

Side - 2

UNITED STATES PATENT AND TRADEMARK OFFICE  
COMMISSIONER FOR TRADEMARKS  
P.O. BOX 1451  
ALEXANDRIA, VA 22313-1451

FIRST-CLASS  
MAIL  
U.S POSTAGE  
PAID

Andrea J. Mealey  
Edwards Angell Palmer & Dodge LLP  
FDR Station, P.O. Box 130  
New York, NY 10150

**EXHIBIT B**



EXHIBIT C

NDC 29336-325-05

*Estrasorb*  
Estradiol topical emulsion

**Rx Only**

4 cartons  
14 foil packets/carton  
1.74 grams/packet  
Contains 2.5 mg of  
estradiol per gram

NDC 29336-325-05

*Estrasorb*  
Estradiol topical emulsion

**Rx Only**

4 cartons  
14 foil packets/carton  
1.74 grams/packet  
Contains 2.5 mg of  
estradiol per gram

EXHIBIT D