

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

In the Matter of Application Serial No. 76/388,804
Published: October 8, 2002 at TM 333
Mark: PRIMAGRA

02-07-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #30

-----X
Pfizer Inc,

Opposition NO.

Opposer,

v.

HerbalCreations, Inc.,

Applicant.
-----X

Assistant Commissioner for Trademarks
Attn: BOX TTAB
2900 Crystal Drive
Arlington, VA 22202-3513
FEE

CERTIFICATE OF EXPRESS MAIL UNDER 37 CFR 1.10

"Express Mail" mailing number EL 733182092 US

Date of Deposit February 5, 2003

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to Assistant Commissioner of Patents and Trademarks, 2900 Crystal Drive, Attn: Box TTAB Fee, Arlington, VA 22202.

Name: Jessica Berman

Signature: Jessica Berman

NOTICE OF OPPOSITION

Opposer, Pfizer Inc ("Opposer"), believes that it will be damaged by the registration of the mark PRIMAGRA as shown in the above-referenced trademark application and hereby opposes the same. As grounds for opposition, Opposer alleges that:

1. Opposer is a Delaware corporation located and doing business at 235 East 42nd Street, New York, New York 10017 and is engaged in developing and marketing pharmaceutical products worldwide.

2. Opposer has adopted and is using the trademark VIAGRA® for a pharmaceutical preparation for the treatment of erectile dysfunction.

3. Opposer has used its VIAGRA® mark on pharmaceutical preparations continuously since at least April 1998.

4. Opposer is the owner of U.S. Trademark Registration No. 2,162,548 on the Principal Register for the trademark VIAGRA covering a "compound for treating erectile dysfunction" in International Class 5. (A copy of Registration Number 2,162,548 is attached hereto as Exhibit A.)

5. Said registration is valid and subsisting and Opposer hereby gives notice in accordance with Trademark Rule of Practice 2.122(d)(2) that it will rely thereon as evidence in this proceeding, and a status copy thereof showing present title will be introduced into evidence on its behalf during Opposer's testimony period.

6. Applicant HerbalCreations, Inc. ("Applicant") seeks to register the mark PRIMAGRA in International Class 5 for goods described as "Herbal Supplements, Vitamins, Dietary Supplements, Herbal Food Supplements" based on use in commerce.

7. Applicant's mark was published for opposition on October 8, 2002. Opposer filed a First Request for an Extension of Time to Oppose to January 6, 2003. (A copy of this Extension is attached as Exhibit B.)

8. Despite having received the Extension, (a copy of the return postcard is attached hereto as Exhibit C), the Trademark Trial and Appeal Board never recorded the Extension, and the Patent and Trademark Office registered the PRIMAGRA mark on December 31, 2002.

9. Because Opposer believes that the Registration was issued in error, Opposer filed a Second Extension of Time to Oppose through and including February 5, 2003. (A copy of this Extension is attached hereto as Exhibit D.)

10. Opposer's VIAGRA mark has priority over Applicant's mark because the filing date of Opposer's trademark application is April 12, 1996, and Opposer's date of first use is April 6, 1998, whereas the filing date of Applicant's use-based application is March 28, 2002, and Applicant's first use is in 2002.

11. Opposer has sold and continues to sell substantial quantities of VIAGRA® (sildenafil citrate) in the United States and has spent substantial time, effort and money promoting the sale of such product under the mark. In addition, since at least April 1998 and earlier, Opposer and its VIAGRA® trademark and product have received and continue to receive widespread media attention.

12. Opposer's VIAGRA® trademark is inherently distinctive; it is a fanciful and coined term, with no generic, descriptive or denotative meaning.

13. Opposer's VIAGRA® mark and Applicant's PRIMAGRA mark are substantially similar in sound, appearance and overall commercial impression.

14. Applicant's trademark PRIMAGRA, if used in conjunction with "Herbal Supplements, Vitamins, Dietary Supplements, Herbal Food Supplements", is likely to cause confusion, mistake or deception with consequent injury to Opposer and the public. Use of such mark will likely lead to the mistaken belief that Applicant's product originates with, is affiliated with, or is sponsored or approved by Opposer.

15. Opposer will also be damaged by registration of Applicant's PRIMAGRA trademark because such registration will support confusing and misleading use of the PRIMAGRA mark, and will give color of exclusive statutory right to Applicant in violation and derogation of the prior and superior rights of Opposer.

16. Registration should, therefore, be refused pursuant to Section 2(d) of the Lanham Act as amended (15 U.S.C. § 1052(d)) on the grounds that Applicant's PRIMAGRA mark so resembles Opposer's prior VIAGRA® mark as to cause confusion, mistake or deception, all to the damage of Opposer.

17. As a result of Opposer's VIAGRA® trademark and product receiving widespread media coverage, Opposer's VIAGRA® trademark has become a famous mark within the meaning of Section 43(c) of the Lanham Act as amended (15 U.S.C. § 1125(c)).

18. As an innovative treatment for erectile dysfunction, Opposer's VIAGRA trademark became famous nearly instantaneously upon the product's launch in April 1998, and thus long before March 28, 2002, the filing date of Applicant's PRIMAGRA application.

19. Opposer's VIAGRA® trademark is inherently distinctive; it is a fanciful and coined term, with no generic, descriptive or denotative meaning.

20. Opposer's VIAGRA® trademark also has substantial acquired distinctiveness and is universally recognized and relied upon as identifying Pfizer as the sole source of sildenafil citrate.

21. Opposer's VIAGRA® mark and Applicant's PRIMAGRA mark are substantially similar.

22. Applicant's trademark PRIMAGRA, if used in conjunction with "Herbal Supplements, Vitamins, Dietary Supplements, Herbal Food Supplements" will dilute the distinctiveness of Opposer's famous VIAGRA® trademark.

23. Opposer will be damaged by registration of Applicant's PRIMAGRA trademark because such registration will support Applicant's dilution of Opposer's VIAGRA® trademark,

and will give color of exclusive statutory right to Applicant in violation and derogation of the prior and superior rights of Opposer.

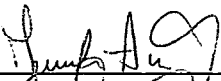
24. Registration should, therefore, be refused pursuant to Section 43(c) of the Lanham Act as amended (15 U.S.C. § 1125(c)) on the grounds that Applicant's PRIMAGRA mark will cause dilution of the fame and distinctiveness of Opposer's famous VIAGRA® trademark.

WHEREFORE, Opposer respectfully requests that this opposition be sustained and that the application for registration of the PRIMAGRA mark be denied.

This Notice of Opposition is filed in triplicate as required by the Trademark Rules of Practice. The Commissioner is hereby authorized to charge the filing fee for this Notice of Opposition and any additional fees to our Deposit Account No. 08-0219.

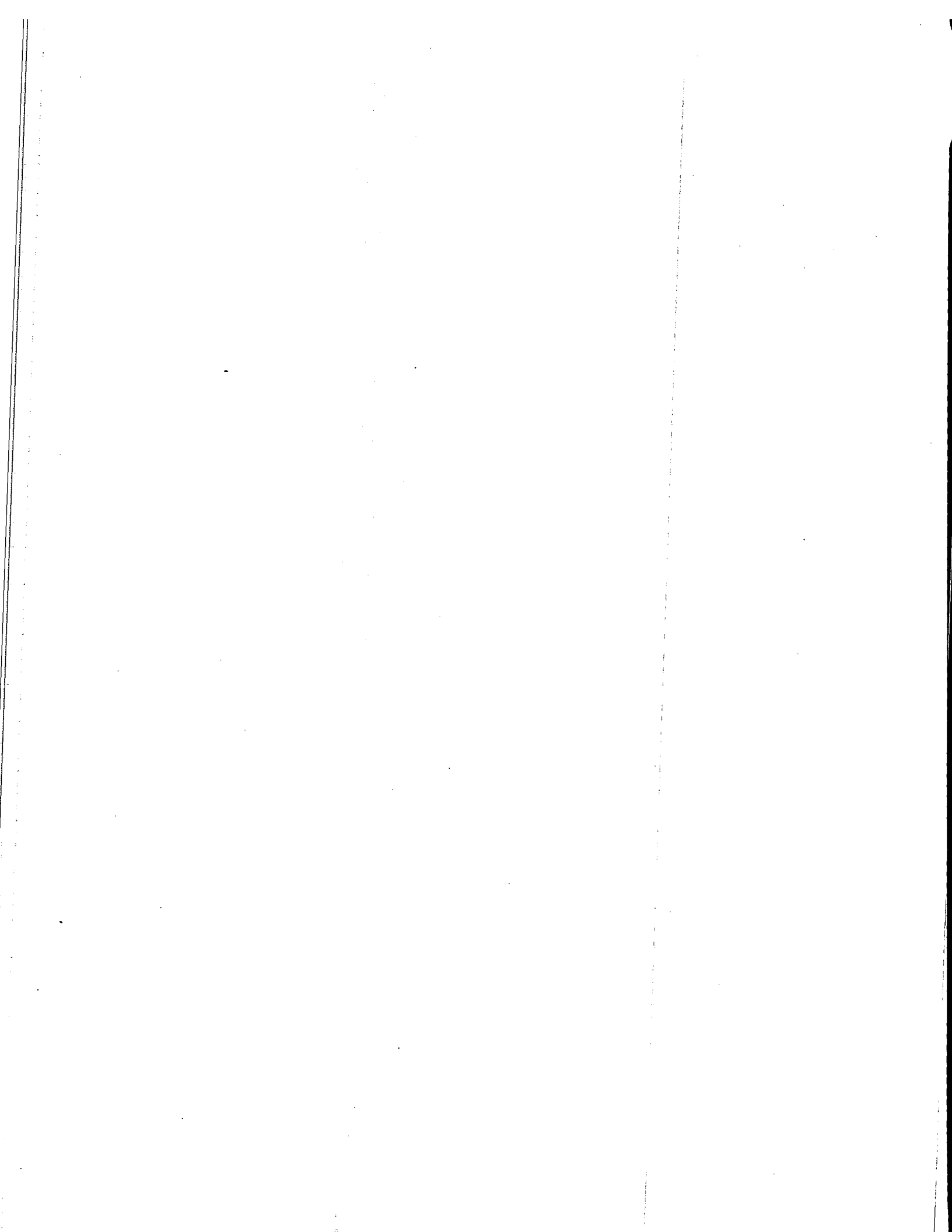
Opposer appoints as its attorney in this proceeding Nels T. Lippert, Dyan Finguerra-DuCharme and Jennifer Gaeta of the firm Hale and Dorr LLP, 300 Park Avenue, New York, New York 10022, to whom all correspondence in this proceeding should be addressed.

Respectfully submitted,

By: 
Jennifer Ann Gaeta
Hale and Dorr LLP
300 Park Avenue
New York, New York 10022
(212) 937-7200

Attorneys for Opposer Pfizer Inc

DATED: February 5, 2003



The United States of America



CERTIFICATE OF REGISTRATION PRINCIPAL REGISTER

The Mark shown in this certificate has been registered in the United States Patent and Trademark Office to the named registrant.

The records of the United States Patent and Trademark Office show that an application for registration of the Mark shown in this Certificate was filed in the Office, that the application was examined and determined to be in compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks, and that the Applicant is entitled to registration of the Mark under the Trademark Act of 1946, as Amended.

A copy of the Mark and pertinent data from the application are a part of this certificate.

This registration shall remain in force for TEN (10) years, unless terminated earlier as provided by law, and subject to compliance with the provisions of Section 8 of the Trademark Act of 1946, as Amended.



Bence Lehman

Commissioner of Patents and Trademarks

Int. Cl.: 5

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

Reg. No. 2,162,548

United States Patent and Trademark Office

Registered June 2, 1998

TRADEMARK
PRINCIPAL REGISTER

VIAGRA

PFIZER INC. (DELAWARE CORPORATION)
235 EAST 42ND STREET
NEW YORK, NY 10017

FIRST USE 4-6-1998: IN COMMERCE
4-6-1998.

FOR: COMPOUND FOR TREATING ERECTILE
DYSFUNCTION, IN CLASS 5 (U.S. CLS. 6,
18, 44, 46, 51 AND 52).

SN 75-089,201, FILED 4-12-1996.

BALDEV SARAI, EXAMINING ATTORNEY



HALE AND DORR LLP
C O U N S E L L O R S A T L A W

www.haledorr.com

300 PARK AVENUE • NEW YORK, NY 10022
212-937-7200 • FAX 212-937-7300

October 23, 2002

By Express Mail # EV 091147785 US

EV091147785US

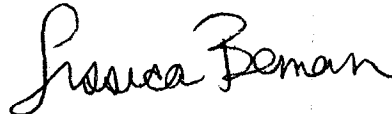
Assistant Commissioner of Trademarks
Box TTAB
NO FEE
2900 Crystal Drive
Arlington, VA 22202-3513

Re: Pfizer Inc's Extension of Time to Oppose Application Serial No. 76/388,804
for Registration of **PRIMAGRA** Published for Opposition October 8, 2002

Dear Assistant Commissioner:

Enclosed, in triplicate, is a First Request for Extension of Time to Oppose the above application for sixty (60) days, from November 7, 2002 through and including January 6, 2002. Please acknowledge receipt on the enclosed postcard and return to us.

Very truly yours,



Jessica Berman
Litigation Assistant

Enclosure

cc: Tiffany Trunko, Esq.
Teresa M. Iannone

Pfizer's Reference: PHR/USA/VIAGRA – PRIMAGRA (HerbalCreations, Inc.)

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

APPLICANT: HerbalCreations, Inc.
SERIAL NUMBER: 76/388,804
FILED: March 28, 2002
MARK: PRIMAGRA
PUBLISHED: October 8, 2002

First Request for Extension of Time to File Notice of Opposition

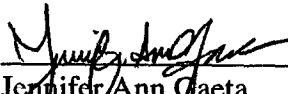
Assistant Commissioner:

Pfizer Inc, a Delaware corporation, having its principal place of business at 235 East 42nd Street, New York, New York 10017, by and through its attorneys, hereby requests that the Board grant a sixty (60) day extension of time to file a Notice of Opposition in the above identified matter through and including January 6, 2002.

This additional time is necessary in order to allow Pfizer Inc time to investigate and evaluate the necessity of filing a Notice of Opposition.

This request is being submitted in triplicate, as required by 37 C.F.R. § 2.102(d).

Respectfully submitted,


Jennifer Ann Gaeta
Hale and Dorn LLP
300 Park Avenue
New York, NY 10022
(212) 937-7200

Attorneys for Potential Opposer Pfizer Inc

CERTIFICATE OF EXPRESS MAIL UNDER 37 CFR 1.10

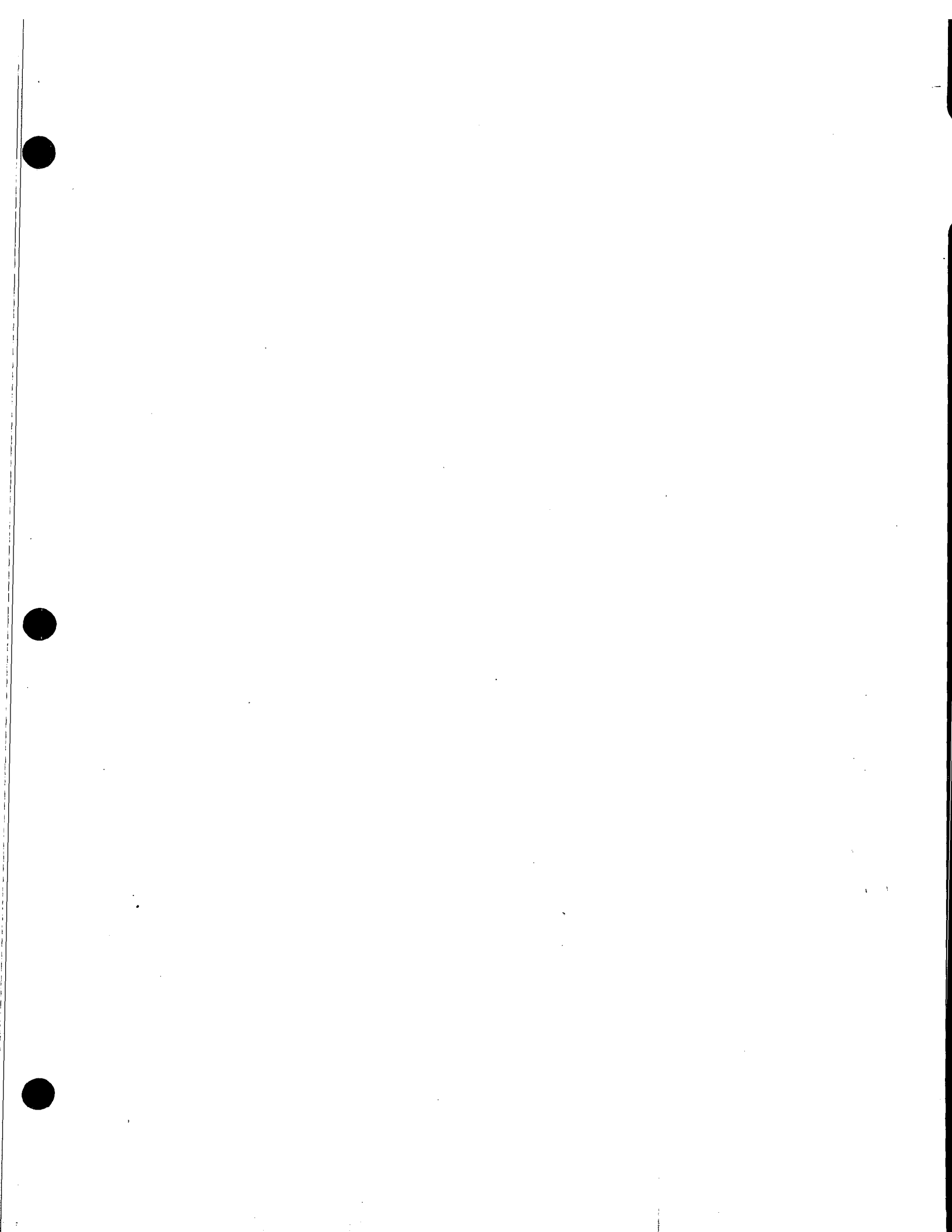
"Express Mail" mailing number: EY 091147785 US

Date of Deposit: October 23, 2002

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to Assistant Commissioner of Patents and Trademarks, 2900 Crystal Drive, Ann Box TTAB No Fee, Arlington, VA, 22202.

Name: Jessica Berman

Signature: 



Applicant/Registrant/Parties Herbal Creations, Inc.

No. (Application) Registration, Opposition, Cancellation 76/388,804

Mark PRIMAGRA

In the above matter, the following have been received by the US Patent and Trademark Office on the date stamped hereon.

- Express Mail Label No. EVO
- Trademark Application w/Draw
- Response to Office Action No. _____
- Assignment and Cover Sheet
- Amendment to Allege Use
- Statement of Use
- Req. for Extension to Time to l
- Req. for Connection: _____

U.S. Patent & TM Office
10-24-2002
Mail Rept ID #77

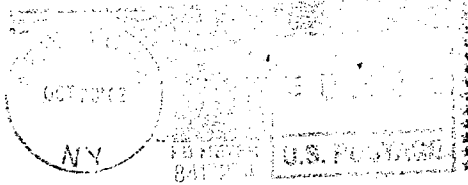


- Specimen(s) (# _____)
- Section 8 / Section 15 Declaration
- Section 9 (Renewal Application)
- Opposition; Cancellation
- Req. for 30 days Ext. of Time to Oppose
- Transmittal Letter
- Check for \$ _____; check # _____
- Deposit Account Authorization \$ _____

- Power of Attorney - Revocati
- Other: _____
- Other: _____

ige of Address for Service

Mailing Date: 12/23/02 Docket No. 71369-257 Atty/paralegal/secy: JB



ATTN: Jennifer Gaeta

HALE AND DORR LLP

**300 Park Avenue
New York, NY 10022**

10022+7402





HALE AND DORR LLP
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300 PARK AVENUE • NEW YORK, NY 10022

212-937-7200 • FAX 212-937-7300

January 6, 2003

By Express Mail # EL 746741379 US


Assistant Commissioner of Trademarks
Box TTAB
NO FEE
2900 Crystal Drive
Arlington, VA 22202-3513

Re: Pfizer Inc's Request for Further Extension of Time to Oppose Application
Serial No. 76/388,804 for Registration of **PRIMAGRA** Published for
Opposition October 8, 2002

Dear Assistant Commissioner:

Enclosed, in triplicate, is a Request for Further Extension of Time to Oppose the
above application for thirty (30) days, from January 6, 2003 through and including
February 5, 2003. Please acknowledge receipt on the enclosed postcard and return to us.

Very truly yours,



Jessica Berman
Litigation Assistant

Enclosures

cc: Tiffany Trunko, Esq.
Teresa M. Iannone

Pfizer's Reference: PHR / USA / VIAGRA – PRIMAGRA (HerbalCreations, Inc.)

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

APPLICANT: HerbalCreations, Inc.

SERIAL NUMBER: 76/388,804

FILED: March 28, 2002

MARK: PRIMAGRA

PUBLISHED: October 8, 2002

Request for Further Extension of Time to Oppose

Assistant Commissioner:

Pfizer Inc, a Delaware corporation, having its principal place of business at 235 East 42nd Street, New York, New York 10017-5755, by and through its attorneys, hereby requests that the Board grant a thirty (30) day extension of time to file a Notice of Opposition in the above identified matter from January 6, 2003 through and including February 5, 2003.

This request is made in good faith to afford potential Opposer adequate time to conduct investigations in connection with this matter and to enable potential Opposer to consider fully whether an opposition is warranted. This request is not made for reason of delay.

This request is being submitted in triplicate, as required by 37 C.F.R. § 2.102(d).

Respectfully submitted,


Jennifer Gaeta

Hale and Dorr LLP
300 Park Avenue
New York, NY 10022
(212) 937-7200

Attorneys for Potential Opposer Pfizer Inc

CERTIFICATE OF EXPRESS MAIL UNDER 37 CFR 1.10

"Express Mail" mailing number EL 746741379 US

Date of Deposit January 6, 2003

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to Assistant Commissioner of Patents and Trademarks, 2900 Crystal Drive, Atn. Box TTAB No Fee, Arlington, VA 22202.

Name Jessica Berman

Signature 

TTAB

HALE AND DORR LLP
C O U N S E L L O R S A T L A W

www.haledorr.com

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02-07-2003

U.S. Patent & TMO/ TM Mail Rcpt Dt. #30

February 5, 2003

By Express Mail # EL 733182092 US

Assistant Commissioner of Trademarks
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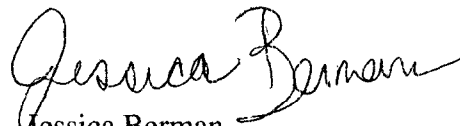
Re: Pfizer Inc's Notice of Opposition to Application Serial No. 76/388,804 for
Registration of **PRIMAGRA** Published for Opposition October 8, 2002

Dear Assistant Commissioner:

Enclosed please find Pfizer Inc's Notice of Opposition in the above-referenced matter. Pfizer's Notice of Opposition is submitted in triplicate as required by the Trademark Rules of Practice. The Commissioner is hereby authorized to charge the filing fee for this Notice of Opposition, and any additional fees, to our Deposit Account No. 08-0219.

Please stamp and return the enclosed postcard to acknowledge receipt for our files.

Respectfully submitted,



Jessica Berman
Litigation Assistant

Enclosures

cc: Tiffany Trunko, Esq.
Teresa M. Iannone

Pfizer's Ref: PHR / USA / VIAGRA – PRIMAGRA (HerbalCreations, Inc.)

