

TTAB

OFGS File No. 7/3975-65

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

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Boehringer Ingelheim Pharma KG  
Opposer,

-vs-

Braintree Laboratories, Inc.  
Applicant

Serial No.: 75/622,252



12-20-2002

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #77

-----X  
BOX TTAB - NO FEE  
Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

**NOTICE OF OPPOSITION**

SIR:

In the matter of pending application Serial No. 75/622,252 filed January 15, 1999 by Braintree Laboratories, Inc. of Braintree, Massachusetts for the mark MIRALAX published in the Official Gazette of August 20, 2002 at page TM 318, Boehringer Ingelheim Pharma KG, located at Binger Strasse 173, Ingelheim am Rhein, 55216 Germany believes that it will be damaged by the registration of the above mark and hereby gives notice of its intention to oppose the above application for registration, its grounds for opposition being as follows:

1. Opposer is a German Company located and doing business at Binger Strasse 173, 55216 Ingelheim am Rhein, Germany.
2. Opposer and its predecessor, the Upjohn Company, have used the mark MIRAPEX since January 1997 in connection with a pharmaceutical preparation for treatment of central nervous system disorders.

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3. By reason of extensive use and promotion of the mark **MIRAPEX** in connection with opposer's goods this mark has acquired substantial distinctiveness, secondary meaning and goodwill inuring to the benefit of opposer in connection with its goods.
4. Opposer is the owner of U.S. Registration No. 2,062,274 issued May 13, 1997 for the mark **MIRAPEX** for pharmaceutical preparations for treatment of central nervous system disorders, which registration is valid and subsisting and in full force and effect, and it is incontestible.
5. Annexed hereto and made apart hereof and marked opposer's exhibit I is a copy of Registration No. 2,062,274 for the mark **MIRAPEX**.
6. Applicant seeks registration for the mark **MIRALAX** for a prescription laxative.
7. Applicant's goods and opposer's goods are both pharmaceutical preparations available only on prescription and accordingly are dispensed and made available through the same channels of trade.
8. The use and registration of prescription laxatives and a pharmaceutical preparation for treatment of central nervous system disorders which is also available only on prescription is likely to create confusion, mistake and deception of the trade and purchasing public if the respective products are sold under the same or confusingly similar marks.
9. **MIRALAX** is confusingly and deceptively similar to **MIRAPEX** by virtue of an identity of the first two syllables of each mark and a similarity in the third syllable of each mark thereby creating a totality of confusing similarity between the marks.
10. The use and registration of **MIRALAX** for prescription laxatives will create confusion, mistake and deception of the trade and public into believing that applicant's goods originate with or otherwise authorized, licensed, or sponsored by opposer, the owner of the mark **MIRAPEX**.

- 11. The use and registration of MIRALAX for prescription laxatives to applicant will dilute the distinctiveness of opposer's mark MIRAPEX for its goods.
- 12. By reason of all of the foregoing opposer will be gravely damaged by the use and registration of MIRALAX to applicant.

WHEREFORE, opposer respectfully requests that the Notice of Opposition be sustained and that registration of MIRALAX to applicant be refused.

**POWER OF ATTORNEY**

Please recognize Martin J. Beran and Ostrolenk, Faber, Gerb & Soffen, LLP as attorneys to prosecute this opposition proceeding. The undersigned hereby appoints customer no. 2352, OSTROLENK, FABER, GERB & SOFFEN, LLP and the members of the firm: Samuel H. Weiner, Robert C. Faber, Max Moskowitz, James A. Finder, William O. Gray, III, Louis C. Dujmich, Charles P. LaPolla, Douglas A. Miro, and Marc A. Lieberstein, and of counsel Martin J. Beran, all members of the Bar of the State of New York, with offices at 1180 Avenue of the Americas, New York, New York 10036-8403, (212) 382-0700, its attorneys to prosecute this opposition with full power of substitution and revocation and to transact all business in the Patent and Trademark Office in connection therewith. Said attorneys are hereby designated its agent upon whom notices or process may be served in proceedings affecting the above-entitled mark. Please address all correspondence to:

Martin J. Beran, Esq.  
OSTROLENK, FABER, GERB & SOFFEN, LLP  
1180 Avenue of the Americas  
New York, New York 10036-8403  
Customer No. 2352

17. December 2002  
[Date]

Boehringer Ingelheim Pharma KG  
ppa  
By [Signature]  
Name: ppa Jürgen Röhild  
Title: Prokurist

17 December 2002  
[Date]

Boehringer Ingelheim Pharma KG  
ppa  
By [Signature]  
Name: ppa Claudia Jesse  
Title: Prokurist

**Int. Cl.: 5**

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

**Reg. No. 2,062,274**

**United States Patent and Trademark Office**

**Registered May 13, 1997**

**TRADEMARK  
PRINCIPAL REGISTER**

**MIRAPEX**

**UPJOHN COMPANY, THE (DELAWARE COR-  
PORATION)  
KALAMAZOO, MI 49001**

**FIRST USE 1-2-1997; IN COMMERCE  
1-2-1997.**

**FOR: PHARMACEUTICAL PREPARATION  
FOR TREATMENT OF CENTRAL NERVOUS  
SYSTEM DISORDERS, IN CLASS 5 (U.S. CLS. 6,  
18, 44, 46, 51 AND 52).**

**SN 75-027,783, FILED 12-4-1995.**

**KELLEY WELLS, EXAMINING ATTORNEY**

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# OSTROLENK, FABER, GERB & SOFFEN, LLP

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December 17, 2002

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ATTN: **BOX TTAB FEE**



12-20-2002

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #77

Re: OFGS File No. 7/3975-65  
U.S. Trademark/Service Mark Appln. No. 75/622,252  
Applicant: Braintree Laboratories, Inc.  
Mark: MIRALAX

S I R:

Enclosed for filing is a Notice of Opposition on behalf of: Boehringer Ingelheim Pharma KG against the above-noted trademark/service mark, including:

- Notice of Opposition, in duplicate with one exhibit;
- OFGS Check No. 14565 in the amount of \$300.00 in payment of the Government Filing Fee;
- Return-Addressed Post Card.

In the event the actual fee is greater than the payment submitted or is inadvertently not enclosed or if any additional fee due during the pendency of this application is not paid, the P.T. O. is authorized to charge the underpayment to Deposit Account No. 15-0700.

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Asst. Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 on December 17, 2002

Martin J. Beran

Name of applicant, assignee or Registered Representative

Signature  
December 17, 2002

Date of Signature

Respectfully submitted,

Martin J. Beran, Esq.  
Attorneys for Opposer  
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MJB:nb