

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



07-20-2004
U.S. Patent & TMO/TM Mail Rcpt Dt. #78

In the matter of Application)
Serial No. 78/116,976)
)
For the mark:)
OXIUM)
)
Published in the Official Gazette)
(Trademarks))
)
Smithkline Beecham Corporation,)
)
Opposer,)
)
v.)
)
TherOx, Inc.,)
)
Applicant.)

Opposition No.: 91160810

ANSWER TO NOTICE OF OPPOSITION

BOX TTAB NO FEE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, VA 22202-3513

Dear Sir or Madam:

Applicant TherOx, Inc., ("Applicant") of the trademark application
identified above, by and through its attorneys of record, answers each allegation in the

notice of opposition ("Notice") filed by Smithkline Beecham Corporation ("Opposer") as follows:

1. Applicant is without sufficient information to admit or deny the allegations contained in paragraph one of the Notice. Therefore, on that basis, the allegations are denied.

2. Applicant is without sufficient information to admit or deny the allegations contained in paragraph two of the Notice. Therefore, on that basis, the allegations are denied.

3. Applicant is without sufficient information to admit or deny the allegations contained in paragraph three of the Notice. Therefore, on that basis, the allegations are denied.

4. Applicant admits that the marks noted are registered with the United States Patent and Trademark Office ("USPTO") as they appear on the federal TESS database. Otherwise, as to all other allegations, Applicant is without sufficient information to admit or deny the additional allegations contained in paragraph four of the Notice. Therefore, on that basis, the additional allegations are denied.

5. Applicant admits that it filed an intent-to-use application to register the mark OXIUM for "Oxygenated skin care preparations, namely creams, masks, gels and lotions for the face, hands, feet and body, not including acne preparations" which was assigned Serial Number 78/116,976 and was published for opposition on February 3, 2004. Therefore, on that basis, the allegations contained in paragraph five of the Notice are admitted.

6. Applicant denies that Applicant's mark resembles any mark owned by Opposer and further denies that Applicant's mark is likely to cause confusion, mistake or deception under Section 2(d) of the Lanham Act, or damages Opposer in any way. On these bases, the allegations contained in paragraph six of the Notice are denied.

AFFIRMATIVE DEFENSES

Failure to State Grounds for Opposition

1. Applicant is informed and believes, and thereon alleges, that the facts set forth in the Notice are insufficient to justify denial of its application

No Priority or Likelihood of Confusion

2. Opposer has not previously used a mark which is likely to be confused with the Applicant's mark, and specifically as an alternative affirmative defense to a claim of seniority, nor is there any likelihood of confusion, mistake or deception because Applicant's mark and the pleaded mark of Opposer are not confusingly similar.

Estoppel, Waiver, Acquiescence and Laches

3. Opposer is estopped from asserting any exclusive rights to a trademark for OXIUM and Opposer's claims against Applicant are barred under the doctrines of waiver, acquiescence and laches.

No Exclusive Right

4. Opposer does not have any exclusive right to the use of the letters "OXY" alone or in combination with any other letters, terms or words to form a trademark.

Unclean Hands

5. Opposer has engaged in acts constituting unclean hands in filing its application and in the conduct of this opposition proceeding and should therefore be precluded from asserting any rights against Applicant.

Lack of Distinctiveness

6. Applicant is informed and believes, and thereupon alleges, that there is no likelihood of confusion, mistake or deception because Applicant is informed and believes that Opposer's mark is not distinctive or has not acquired distinctiveness, nor do purchasers associate the mark with Opposer alone.

Failure to Function as Trademark

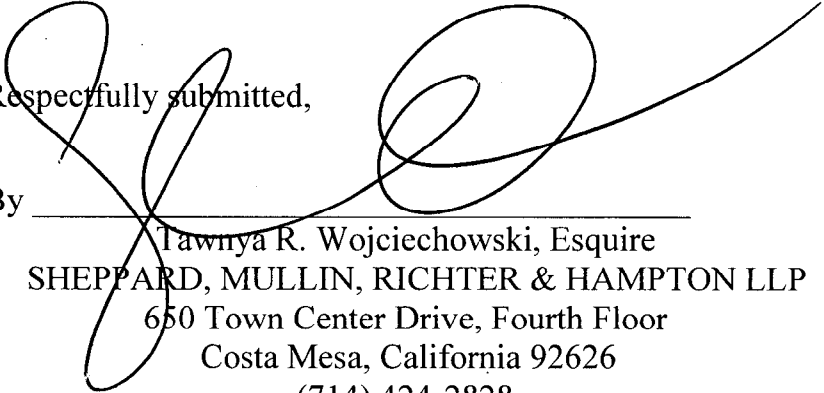
7. Applicant is informed and believes, and thereupon alleges, that there is no likelihood of confusion, mistake or deception because Applicant is informed and believes that the letters "OXY" contained in Opposer's mark does not function as a trademark such that purchasers of goods do not exclusively identify Opposer with the mark.

THEREFORE, Applicant requests that this Notice and opposition proceeding be dismissed with prejudice and Applicant's application be allowed to issue as a registration. Please charge any additional fees, or credit any overpayment, associated with the Applicant's application or this opposition to deposit account No. 500209. A duplicate answer to the notice of opposition is filed for this purpose. Service has been made on Opposer's counsel as shown in the attached certificate of service.

Dated: July 11, 2004

Respectfully submitted,

By



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THEROX, INC.

CERTIFICATE OF MAILING BY EXPRESS MAIL

"Express Mail" mailing label number: **EV012964421US**

I hereby certify that this **ANSWER TO NOTICE OF OPPOSITION** is addressed to BOX TTAB NO FEE, Trademark Trial and Appeal Board, 2900 Crystal Drive, Arlington, Virginia 22202-3513, and is being deposited with the United States Postal Service Express Mail for pick up on:

July 19, 2004

(Date of Deposit)

Traci Barnes

(Printed name of person mailing the paper or fee)

Traci Barnes

(Signature of the person mailing the paper or fee)

July 19, 2004

(Date of Signature)

Tawnya Wojciechowski
714-424-2828
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July 19, 2004

Our File Number: 02JH-103871

VIA EXPRESS MAIL

BOX TTAB/NO FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

TTAB

Re: Answer to Notice of Opposition
Serial No.: 78/116,976
Applicant: TherOx, Inc.
Opposer: Smithkline Beecham Corporation

07-20-2004

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #78

Dear Sir or Madam:

Enclosed for filing are the following papers regarding the above referenced trademark registration:

1. An Answer to Notice of Opposition, in triplicate;
2. A certificate of mailing;
3. A stamped, self addressed postcard to acknowledge receipt.

Please charge Deposit Account No. 500209 for any additional fees which may be required. Thank you for your assistance.

Very truly yours,



Tawnya Wojciechowski
for SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

Enclosures
W02-OC:NTW41364737.1