

ESTTA Tracking number: **ESTTA81988**

Filing date: **05/23/2006**

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	Boehringer Ingelheim Pharma GmbH & Co. KG
Granted to Date of previous extension	06/14/2006
Address	Binger Strasse 173 Ingelheim am Rhein, 55216 GERMANY
Domestic Representative	James A. Thomas Attorney For Opposer Boehringer Parker Poe Adams & Bernstein, LLP 150 Fayetteville Street Mall Suite 1400, P.O. Box 389 Raleigh, NC 27602-0389 UNITED STATES trademarks@parkerpoe.com Phone:(919) 828.0564

**Applicant Information**

Application No	78455596	Publication date	02/14/2006
Opposition Filing Date	05/23/2006	Opposition Period Ends	06/14/2006
Applicant	Sankyo Pharma, Inc. 2 Hilton Court Parsippany, NJ 07054 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 005. All goods and services in the class are opposed, namely: Pharmaceutical preparations for the treatment of diabetes, impaired glucose tolerance, cardiovascular disease, and polycystic ovarian syndrome
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Attachments	Notice of Opposition.pdf ( 6 pages )(22370 bytes )
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Signature	/jat/
Name	James A. Thomas
Date	05/23/2006

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

In the matter of Application Serial Number 78/455596

Published: February 14, 2006

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BOEHRINGER INGELHEIM PHARMA GMBH & CO. KG,	)	
Opposer,	)	
v.	)	Opposition No. _____
SANKYO PHARMA, INC.,	)	
Applicant.	)	

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NOTICE OF OPPOSITION

BOEHRINGER INGELHEIM PHARMA GMBH & CO. KG (hereinafter “Opposer”), a corporation organized and existing under the laws of Germany and having a principal place of business at Binger Strasse 173, 55216 Ingelheim Am Rhein, Federal Republic of Germany, believes that it will be damaged by registration of the mark shown in application Serial No. 78/455596 in International Class 5 and hereby opposes such registration. This opposition is based on 15 U.S.C. § 1063(a), and the grounds for the opposition are as follows:

1. Applicant Sankyo Pharma, Inc. (hereinafter “Applicant”), a Delaware corporation having a principal place of business in Parsippany, New Jersey, seeks to register its PRIVA mark (hereinafter, “Applicant’s Mark”) as a trademark for “pharmaceutical preparations for the treatment of diabetes, impaired glucose tolerance, cardiovascular disease, and polycystic ovarian syndrome” in International Class 5 (hereinafter, “Applicant’s Goods and Services”), as evidenced by publication of Applicant’s Mark in the *Official Gazette* dated February 14, 2006.

2. There is no issue as to priority. Upon information and belief, Applicant acquired no rights in Applicant's Mark in the United States prior to July 23, 2004, the filing date of Applicant's intent-to-use application for Applicant's Mark filed in the U.S. Patent and Trademark Office ("USPTO").

3. On October 22, 1998, prior to the filing date of Applicant's intent-to-use application for Applicant's Mark, and any date of use that Applicant can rely upon, Boehringer Ingelheim Pharma KG filed in the USPTO its application, Serial No. 75/575954, for the mark SPIRIVA as a trademark for "pharmaceutical preparations for the respiratory tract" in International Class 5 ("Opposer's '954 Goods"). The registration for this application was issued on October 12, 1999 under Reg. No. 2,285,506.

4. As a result of a corporate name change, Boehringer Ingelheim Pharma KG later changed its name to Boehringer Ingelheim Pharma GmbH & Co. KG. This name change was recorded against Reg. No. 2,285,506 in the USPTO on July 22, 2003 at Reel 2686, Frame 0390.

5. On December 2, 2003, Opposer filed in the USPTO its application, Serial No. 78/335207, for the mark SPIRIVA and Design as a trademark and service mark for "pharmaceutical preparations for the treatment of respiratory diseases" in International Class 5, "printed materials, namely books, brochures and press releases featuring pharmaceutical preparations for the respiratory tract" in International Class 16, and "arranging and conducting workshops, conferences and seminars on medical-pharmaceutical issues" in International Class 41 ("Opposer's '207 Goods and Services"). The registration for this application was issued on October 4, 2005 under Reg. No. 3,005,009.

6. On March 18, 2004, Opposer filed in the USPTO its application, Serial No. 79/002090, for the mark SPIRIVA as a trademark for "instruments and apparatus for the

inhalation of medicines” in International Class 10 (“Opposer’s ‘090 Goods”). The registration for this application was issued on September 20, 2005 under Reg. No. 2,998,420. (Opposer’s ‘954 Goods, ‘207 Goods and Services, and ‘090 Goods shall hereinafter be referred to collectively as “Opposer’s Goods and Services.”) (Opposer’s SPIRIVA and SPIRIVA and Design marks shall hereinafter be referred to collectively as “Opposer’s Marks.”)

7. Opposer’s use of Opposer’s Marks is in commerce on or in connection with Opposer’s Goods and Services. Opposer’s use of Opposer’s Marks is current and has been valid and continuous since the date of first use of each mark. Opposer’s Marks are distinctive, famous, and well-known.

8. Opposer may have pre-registration rights in Opposer’s Marks that will be damaged if Applicant is permitted to register to use the PRIVA mark for Applicant’s Goods and Services.

9. Opposer has spent substantial amounts of time, money, and effort in developing, testing, and marketing products and services under Opposer’s Marks in the United States.

10. Applicant’s Mark, PRIVA, and Opposer’s Marks are used in connection with overlapping goods and services. Further, Applicant’s Mark shares with Opposer’s Marks in Reg. Nos. 2,285,506 and 2,998,420 and with the word element of Opposer’s Mark in Reg. No. 3,005,009 a suffix (-RIVA) that is identical phonetically, visually and conceptually, and such marks also all share a dominant “P” in the prefix. In addition, Opposer’s Marks in Reg. Nos. 2,285,506 and 2,998,420 and the word element of Opposer’s Mark in Reg. No. 3,005,009 are composed of 7 letters and Applicant’s Mark, PRIVA, is composed of 5 letters, 4 of which (2 consonants and 2 vowels) are identical and placed in the same place and order as Opposer’s SPIRIVA marks. The rhythmical and stress pattern of Opposer’s Marks in Reg. Nos. 2,285,506

and 2,998,420 and of the word element of Opposer's Mark in Reg. No. 3,005,009 and Applicant's Mark, PRIVA, are the same.

11. On information and belief, Applicant's Goods and Services will be marketed to the same potential purchasers in both the medical community and the general public as the goods and services marketed by Opposer. Additionally, upon information and belief, Applicant's Goods and Services marketed under Applicant's Mark will be distributed through the same channels of distribution and will be ultimately purchased and used by members of the general public and the medical community that overlap with those of Opposer.

12. If Applicant were permitted to register to use Applicant's Mark for Applicant's Goods and Services, confusion among physicians, pharmacists, medical care providers, and members of the general public would result by reason of the following: (a) the substantial visual and phonetic similarity of Applicant's Mark and Opposer's Marks, (b) the overlapping nature of Applicant's Goods and Services and Opposer's Goods and Services marketed and sold under such marks, and (c) the common channels of trade and classes of customers for Applicant's Goods and Services under Applicant's Mark and Opposer's Goods and Services under Opposer's Marks.

13. Physicians, pharmacists, medical care providers, and members of the general public who are familiar with Opposer's Goods and Services sold under Opposer's Marks would believe that Applicant's Goods and Services available under Applicant's Mark were, contrary to fact, associated with, endorsed by, related to, or actually the goods and services of Opposer. Any fault or defect in Applicant's Goods and Services would reflect upon and seriously injure Opposer's reputation. Furthermore, physicians, pharmacists, medical care providers, and members of the general public who are familiar with Opposer's Marks would confuse the same

with Applicant's Mark and might purchase Applicant's Goods and Services in the mistaken belief that they are purchasing the goods and/or services of Opposer. This confusion would damage Opposer's revenue and income. Finally, upon information and belief, there is potential that the confusing similarity of Opposer's Marks and Applicant's Mark could result in a health or safety risk for patients involved.

14. If registration of Applicant's Mark were granted, Applicant would be placed in a position to harass and cause annoyance to the public as the registration would give Applicant *prima facie* exclusive rights to Applicant's Mark and all confusingly similar marks, thereby causing damage and injury to Opposer.

15. As a result of the substantial similarity in appearance between Applicant's Mark and Opposer's Marks, the overlapping nature of the goods and services of Applicant and Opposer, and the fact that such goods and services are or are intended to be sold in common channels of commerce and directed to the same classes of customers, registration of Applicant's Mark would cause damage and injury to Opposer.

16. Applicant's Mark consists of a mark that so resembles the senior marks of Opposer that it is likely, when used in connection with the goods and services of Applicant, to cause confusion, to cause a mistake, or to deceive. Registration of Applicant's Mark is, therefore, barred under 15 U.S.C. § 1052(d).

17. Opposer prays that said Application Serial No. 78/455596 be rejected and that the registration of Applicant's mark be refused and denied.

This Notice of Opposition is herewith submitted together with the filing fee in the amount of \$300.00.

Respectfully submitted this 23<sup>rd</sup> day of May, 2006.

PARKER, POE, ADAMS & BERNSTEIN L.L.P.

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