

ESTTA Tracking number: **ESTTA106915**

Filing date: **10/30/2006**

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                                  | Barr Laboratories, Inc.  |
| Granted to Date of previous extension | 10/29/2006   |
| Address                               | 400 Chestnut Ridge Road<br>Woodcliff Lake, NJ 07677<br>UNITED STATES |

|                      |  |
|----------------------|--|
| Attorney information | Tracy-Gene G. Durkin<br>Sterne, Kessler, Goldstein & Fox PLLC<br>1100 New York Avenue, NW<br>Washington, DC 20005<br>UNITED STATES<br>tdurkin@skgf.com,jshirk@skgf.com, Phone:(202) 371-2600 |
|----------------------|--|

### Applicant Information

|                        |  |                        |            |
|------------------------|--|------------------------|------------|
| Application No         | 78256902   | Publication date       | 05/02/2006 |
| Opposition Filing Date | 10/30/2006   | Opposition Period Ends | 10/29/2006 |
| Applicant              | W.M. Barr & Company, Inc.<br>2105 Channel Avenue<br>Memphis, TN 38113<br>UNITED STATES |                        |            |

### Goods/Services Affected by Opposition

|   |
|---|
| Class 005.<br>All goods and services in the class are opposed, namely: house mark for fungicides, herbicides, disinfectants; insecticides; pesticides |
|---|

|             |  |
|-------------|--|
| Attachments | 1710756OPT0.pdf ( 8 pages )(148485 bytes ) |
|-------------|--|

|           |                        |
|-----------|------------------------|
| Signature | /Tracy-Gene G. Durkin/ |
| Name      | Tracy-Gene G. Durkin   |
| Date      | 10/30/2006             |

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

In re Trademark Application No.: 78/256,902

Filed: June 2, 2003

Mark: 

Published in the Official Gazette: May 2, 2006  
Classes Opposed: International Class 5

Barr Laboratories, Inc.,  
*Opposer,*

v.

W.M. Barr & Company, Inc.,  
*Applicant.*


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

Atty Docket: 1710.756OPT0/TGD/JDS





NOTICE OF OPPOSITION

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451


Madam:

Opposer, Barr Laboratories, Inc. (hereinafter "Opposer"), a Delaware Corporation, having its principal place of business at 400 Chestnut Ridge Road, Woodcliff Lake, New Jersey 07677, believes it will be damaged by registration of U.S. Application No. 78/256,902 for the mark  to W.M. Barr & Company, Inc. (hereinafter "Applicant"), as filed for goods in International Class 5, and hereby opposes the same.



The grounds for opposition are:



1. Opposer is a Delaware corporation having a principal place of business at 400 Chestnut Ridge Road, Woodcliff Lake, New Jersey 07677.
2. Opposer is a specialty pharmaceutical company engaged in researching, developing, manufacturing and marketing generic and proprietary pharmaceuticals.
3. Applicant is a Tennessee corporation having a principal place of business at 2105 Channel Avenue, Memphis, Tennessee 38133.
4. Applicant seeks to register the mark  for, *inter alia*, "house mark for fungicides, herbicides, disinfectants, insecticides, pesticides" in International Class 5. Applicant's application for the mark , for goods in International Class 5, is based on a *bona fide* intent to use the mark, under Section 1(b) of the Trademark Act.
5. Opposer is the owner of, has used, and continues to use the marks BARR and  with goods classified in International Class 5, including a full line of pharmaceuticals and pharmaceutical preparations. Opposer first used its BARR mark with such goods at least as early as November 1971, and first used its  mark with such goods at least as early as January 1982.



6. Opposer is the owner of the registrations shown in the chart below:



| Mark  | Reg. No.  | Reg. Date  | Goods  |
|---|-----------|------------|--|
| BARR  | 2,534,124 | 01/29/2002 | House mark for a full line of pharmaceuticals and pharmaceutical preparations. |
|  | 1,566,713 | 11/21/1989 | House mark for a full line of pharmaceutical preparations.                     |


Copies of the registrations listed above are attached hereto as Exhibit A.



7. Applicant's mark  and Opposer's BARR and  marks are identical in sound.



8. Applicant's mark  and Opposer's BARR and  marks are highly similar in appearance.


9. Applicant's mark  and Opposer's BARR and  marks have highly similar connotations.

10. The overall commercial impressions of Applicant's mark  and Opposer's BARR and  marks are highly similar.

11. The goods in International Class 5 of Applicant's application are encompassed by, and are similar, if not identical, to the goods with which Opposer uses and has registered its BARR and  marks.

12. In view of the similarities in sound, appearance, connotation and overall commercial impression between Applicant's mark  and Opposer's BARR and  marks, and the similar, if not identical, nature of the parties goods, confusion between Applicant's mark and Opposer's marks is likely, and consumers are likely to mistakenly believe that Applicant's goods are somehow associated with, or sponsored, endorsed or approved by, Opposer in violation of Section 2(d) of the Trademark Act.

13. Registration of Applicant's mark , in International Class 5, would cause serious and irreparable harm to Opposer and to the goodwill of the business symbolized by Opposer's BARR and  marks.

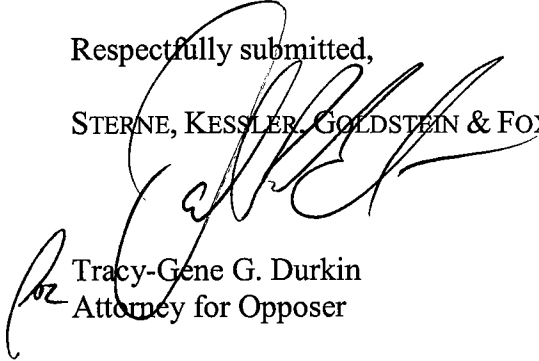
WHEREFORE, Opposer respectfully requests that this Opposition be sustained and that registration of the mark  of U.S. Application No. 78/256,902, in International Class 5, be refused.

Appl. No. 78/256,902  
Applicant: W.M. Barr & Company, Inc.  
Opposer: Barr Laboratories, Inc.

Opposer submits herewith the statutory fee of \$300.00 for one (1) class of goods at \$300.00 per class, as set forth under 37 C.F.R. § 2.6(a)(17).

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Tracy-Gene G. Durkin  
Attorney for Opposer

Date: October 30, 2006

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Washington, DC 20005  
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Facsimile: (202) 371-2540

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**EXHIBIT A**

**Notice of Opposition**

*Barr Laboratories, Inc.*

*v.*

*W.M. Barr & Company, Inc.*

**U.S. Appl. No. 78/256,902**

**Int. Cl.: 5**

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

**United States Patent and Trademark Office**

**Reg. No. 2,534,124**

**Registered Jan. 29, 2002**

**TRADEMARK  
PRINCIPAL REGISTER**

**BARR**

**BARR LABORATORIES, INC. (NEW YORK COR-  
PORATION)  
2 QUAKER ROAD  
P.O. BOX 2900  
POMONA, NY 10970**

**FOR: HOUSE MARK FOR A FULL LINE OF  
PHARMACEUTICALS AND PHARMACEUTICAL  
PREPARATIONS, IN CLASS 5 (U.S. CLS. 6, 18, 44,  
46, 51 AND 52).**

**FIRST USE 11-0-1971; IN COMMERCE 11-0-1971.**

**OWNER OF U.S. REG. NO. 1,566,713.**

**SEC. 2(F).**

**SER. NO. 76-211,082, FILED 2-16-2001.**

**JOHN E. MICHOS, EXAMINING ATTORNEY**



**Int. Cl.: 5**

**Prior U.S. Cl.: 18**

**United States Patent and Trademark Office**

**Reg. No. 1,566,713**

**Registered Nov. 21, 1989**

**TRADEMARK  
PRINCIPAL REGISTER**



**BARR LABORATORIES, INC. (NEW YORK  
CORPORATION)  
2 QUAKER ROAD  
POMONA, NY 10970**

**FOR: HOUSEMARK FOR A FULL LINE OF  
PHARMACEUTICAL PREPARATIONS, IN  
CLASS 5 (U.S. CL. 18).**

**FIRST USE 1-0-1982; IN COMMERCE  
1-0-1982.  
OWNER OF U.S. REG. NO. 1,313,019.  
SEC. 2(F).**

**SER. NO. 735,421, FILED 6-20-1988.**

**KRISTEN S. BYERS, EXAMINING ATTORNEY**