

ESTTA Tracking number: **ESTTA170158**

Filing date: **10/22/2007**

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	Schering Corporation
Granted to Date of previous extension	12/12/2007
Address	2000 Galloping Hill Road K-6-1 M1030 Kenilworth, NJ 07033 UNITED STATES

Attorney information	David J. Kera Oblon, Spivak, McClelland, Maier, & Neustadt, P.C. 1940 Duke Street Alexandria, VA 22314 UNITED STATES tmdocket@oblon.com, dkera@oblon.com, obarrett@oblon.com Phone:703-413-3000
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Applicant Information

Application No	77070074	Publication date	08/14/2007
Opposition Filing Date	10/22/2007	Opposition Period Ends	12/12/2007
Applicant	IDEA AG FRANKFURTER RING 193a MUNICH, 80807 GERMANY		

Goods/Services Affected by Opposition

Class 005. All goods and services in the class are opposed, namely: PHARMACEUTICAL PREPARATIONS FOR MEDICAL AND THERAPEUTIC USE NAMELY, THE PREVENTION AND TREATMENT OF PAIN; PHARMACEUTICAL PREPARATIONS FOR DERMAL ADMINISTRATION, TO TREAT PAIN AND INFLAMMATION
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	780553	Application Date	11/07/1963
Registration Date	11/24/1964	Foreign Priority Date	NONE

Word Mark	TINACTIN
Design Mark	
Description of Mark	NONE
Goods/Services	Class U018 (International Class 005). First use: First Use: 1963/09/19 First Use In Commerce: 1963/09/19 Fungicidal Preparation

U.S. Registration No.	2291218	Application Date	10/13/1998
Registration Date	11/09/1999	Foreign Priority Date	NONE
Word Mark	TOUGH ACTIN'		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 1998/03/27 First Use In Commerce: 1998/03/27 Pharmaceutical preparation, namely, antifungal preparations		

U.S. Registration No.	1965765	Application Date	05/30/1995
Registration Date	04/02/1996	Foreign Priority Date	NONE
Word Mark	TOUGH ACTIN' TINACTIN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 1993/01/25 First Use In Commerce: 1993/01/25 pharmaceutical preparations, namely antifungal preparations		

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Signature	/David J. Kera/ojb/
Name	David J. Kera
Date	10/22/2007

Attorney Docket No.: 314399US-21

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

In re:

Trademark: DIRACTIN

Appln. Serial No.: 77/070,074

Filing Date: December 22, 2006

Applicant: IDEA AG

Publication Date: August 14, 2007,
O.G. Vol. 1321, No. 2, Page TM 515

_____)
Schering Corporation,)
)
Opposer)
)
v.)
)
IDEA AG,)
)
Applicant)
_____)

Opposition No.:
U. S. Appln. Serial No.: 77/070,074
Mark: DIRACTIN

Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

Schering Corporation, a corporation of the State of New Jersey, located at 2000 Galloping Hill, Kenilworth, New Jersey 07033, (“Opposer”) believes it will be damaged

by the registration of the trademark DIRACTIN identified above, and hereby opposes the registration of the mark. As grounds for opposition, Schering alleges:

1. Opposer, since prior to the earliest date that could be asserted by IDEA AG (“Applicant”), has been using the trademark TINACTIN for pharmaceutical preparations to treat fungal infections, burning and itching of the skin, and chaffing and cracking of the skin.
2. Opposer, since prior to the earliest date that could be asserted by Applicant, has been using the trademark TOUGH ACTIN’ for pharmaceutical preparations to treat fungal infections, burning and itching of the skin, and chaffing and cracking of the skin.
3. Opposer, since prior to the earliest date that could be asserted by Applicant, has been using TOUGH ACTIN’ TINACTIN for pharmaceutical preparations to treat fungal infections, burning and itching of the skin, and chafing and cracking of the skin.
4. Opposer owns the following Registrations in the U.S. Patent and Trademark Office:
 - a. TINACTIN Registration No. 780,553, issued November 24, 1964 for fungicidal preparation.
 - b. TOUGH ACTIN’ Registration No. 2,291,218, issued November 9, 1999 for pharmaceutical preparation, namely, antifungal preparations.
 - c. TOUGH ACTIN’ TINACTIN Registration No. 1,965,765, issued April 2, 1996 for pharmaceutical preparations, namely antifungal preparations.

5. Applicant filed Application Serial No. 77/070,074 on December 22, 2006 to register DIRACTIN for pharmaceutical preparations for medical and therapeutic use namely, the prevention and treatment of pain; pharmaceutical preparations for dermal administration, to treat pain and inflammation. The Application was filed on the basis of 15 U.S.C. §1051(b), and Applicant has not filed an Amendment to Allege Use of the mark.
6. The word DIRACTIN is confusingly similar in appearance, sound, and commercial impression to Opposer's trademarks TINACTIN, TOUGH ACTIN', and TOUGH ACTIN' TINACTIN.
7. The goods for which Opposer has used and registered TINACTIN, TOUGH ACTIN', and TOUGH ACTIN' TINACTIN, since prior to the earliest date that could be asserted by Applicant for DIRACTIN, are identical or closely related to the goods identified in Application Serial No. 77/070,074.
8. By virtue of its earlier use and existing registrations, Opposer's rights in TINACTIN, TOUGH ACTIN', and TOUGH ACTIN' TINACTIN are earlier than, and superior to, any right that could be asserted by Applicant in its trademark DIRACTIN.
9. The registration and use of DIRACTIN would be likely to cause confusion, mistake, or deception because of the confusing similarity of the marks and the relationship of the goods as alleged above. The purchasing public is likely to believe DIRACTIN identifies another product produced by Opposer or identifies a product approved by Opposer or for which the use of DIRACTIN was licensed or authorized by Opposer.

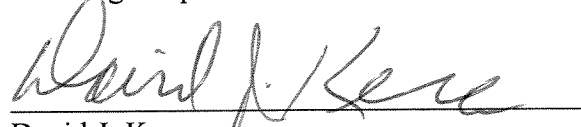
10. The registration of DIRACTIN would be in derogation of Opposer's rights and in violation of 15 U.S.C. §1052(d).

Wherefore, Opposer requests that this opposition be sustained and that registration be refused on Application Serial No. 77/070,074.

Respectfully submitted,

Schering Corporation

By:



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Date: October 22, 2007

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