ESTTA Tracking number: **ESTTA203747**

Filing date: **04/09/2008**

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	Merck KGaA
Granted to Date of previous extension	04/09/2008
Address	Frankfurter Strasse 250 64293 Darmstadt, GERMANY

Attorney information	William C. Wright Epstein Drangel Bazerman & James, LLP 60 East 42nd Street, Suite 820 New York, NY 10165 UNITED STATES mail@ipcounselors.com

Applicant Information

Application No	77196079	Publication date	12/11/2007
Opposition Filing Date	04/09/2008	Opposition Period Ends	04/09/2008
International Registration No.	NONE	International Registration Date	NONE
Applicant	Santhera Pharmaceuticals (Schweiz) AG Hammerstrasse 47 Liestal, 4410 SWITZERLAND		

Goods/Services Affected by Opposition

Class 001. All goods and services in the class are opposed, namely: Chemicals for use in industry and science; reagents for scientific and medical research use
Class 005. All goods and services in the class are opposed, namely: Pharmaceutical preparations for the treatment of central nervous system-related conditions, neurological and muscular diseases, neuro-muscular diseases, muscular dystrophies, ataxias, amyotrophia, atrophy, ophthalmological diseases; muscle wasting, cardiomyopathies, optic nerve degradation, neurological indications, memory loss, Lou Gehrig's disease, Parkinson's disease, Huntington's disease, spinal muscular atrophies, polyneuropathies, fibromyalgia, mononeuropathies, neuromuscular junction disorders, myotonia and myopathies; reagents for medical use
Class 042. All goods and services in the class are opposed, namely: Medical research; science research; medical and scientific research, namely conducting clinical trials; computer programming for others for medical and science research purposes; scientific research for testing cell cultures and

developing cellular test systems for evaluating new drugs and antibodies; developing test systems for detecting pharmacologically active compounds; animal model testing and research for neuro-muscular and ophthalmological diseases

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	1827978	Application Date	12/22/1992
Registration Date	03/29/1994	Foreign Priority Date	NONE
Word Mark	EXTRAN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1974/00/00 First Use In Commerce: 1974/00/00 cleaning agents for use in laboratories and industries		

Attachments	oxi.pdf (11 pages)(209481 bytes)

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/William C. Wright/
Name	William C. Wright
Date	04/09/2008

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

In the Matter of the Trademark Application for OXITRAN,
Ser. No. 77/196,079, in the name of Santhera Pharmaceuticals (Schweiz) AG

MERCK KGAA, Opposer, v. SANTHERA PHARMACEUTICALS (SCHWEIZ) AG, Applicant.	Opp. No. _____

NOTICE OF OPPOSITION

In the Matter of Application Ser. No. 77/196,079, published in the Official Gazette on December 11, 2007, Merck KGaA, a partnership limited by shares, organized and existing under the laws of Germany, having a principal place of business at Frankfurter Strasse 250, D-64293 Darmstadt, Germany (herinafter "Opposer"), believes that it is or will be damaged by registration of the trademark OXITRAN, as reflected in application Ser. No. 77/196,079, and hereby opposes same.

As grounds therefor, it is alleged that:

1. On June 1, 2007, Santhera Pharmaceuticals (Schweiz) AG (hereinafter "Applicant") filed a Intention to Use application to register the alleged trademark OXITRAN, Ser. No. 77/196,079, for Chemicals for use in industry and science; reagents for scientific and medical research use, in Class 1; Pharmaceutical preparations for the treatment of central nervous system-related conditions, neurological and muscular diseases, neuro-muscular diseases, muscular dystrophies, ataxias, amyotrophia, atrophy, ophthalmological diseases; muscle wasting, cardiomyopathies, optic nerve degradation, neurological indications, memory loss, Lou Gehrig's disease, Parkinson's disease, Huntington's disease, spinal muscular atrophies, polyneuropathies, fibromyalgia, mononeuropathies, neuromuscular junction disorders, myotonia and myopathies; reagents for medical use, in Class 5; Medical research; science research; medical and scientific research, namely conducting clinical trials; computer programming for others for medical and science research purposes; scientific research for testing cell cultures and developing cellular test systems for evaluating new drugs and antibodies; developing test systems for detecting pharmacologically active compounds; animal model testing and research for neuro-muscular and ophthalmological diseases, in Class 42, with the United States Patent and Trademark Office (hereinafter "U.S. PTO").
2. Upon information and belief, Applicant has not used its alleged trademark OXITRAN anywhere in the United States of America, or in commerce, prior to the filing date of the aforementioned application for registration.

3. Merck KGaA is the oldest pharmaceutical and chemical company in the world and is a leading producer and distributor of high-quality pharmaceutical products.

4. Opposer owns a registration of the trademark EXTRAN, Reg. No. 1,827,978, for "cleaning agents for use in laboratories and industries", dated March 29, 1994. Said registration is incontestable and valid and subsisting on the Principal Register. Opposer hereby gives notice that it will rely on said registration in this proceeding. Attached to this Notice of Opposition is a print-out from the "TARR" database, showing status and title of the aforementioned trademark registration.

5. There is no issue of priority as the filing date of Applicant's trademark application for OXITRAN is subsequent to Opposer's filing and registration dates of Opposer's trademark registration of EXTRAN.

6. Opposer's trademark EXTRAN possesses a high degree of inherent distinctiveness and represents an extremely valuable asset and symbol of goodwill of Opposer's business by identifying goods which have their source of origin exclusively with Opposer, and by distinguishing such goods from those of others.

7. Applicant's alleged trademark OXITRAN is so similar to Opposer's pleaded trademark EXTRAN in sound, appearance, meaning, and/or commercial impression as to be likely to cause confusion, mistake, or deception as to the source of origin or sponsorship of the goods for which the marks are used or are intended to be used.

8. The respective goods/services are the same or similar and travel, will travel through the same channels of trade for sale to or use by the same class of purchasers, and will be sold or distributed by the same types of consumers.

9. Applicant's alleged trademark OXITRAN is likely to cause confusion, and/or cause mistake, and/or to deceive with respect to Opposer's pleaded trademark EXTRAN.

10. Applicant's alleged trademark OXITRAN is confusingly similar with Opposer's trademark EXTRAN and is likely to cause confusion, to cause mistake and to deceive potential purchasers as to the source of Applicant's goods, with consequent injury to Opposer, the public, and the trade, and/or to cause the mistaken belief that Applicant's goods originate with, are sponsored by, and/or are otherwise affiliated with Opposer.

11. Applicant's alleged trademark OXITRAN is calculated or likely to cause irreparable loss, injury and damage to Opposer's business and to the extensive goodwill as symbolized by its pleaded trademark.

12. Applicant's alleged trademark OXITRAN is a colorable imitation or misappropriation of Opposer's pleaded trademark, and will enable Applicant to reap where it has not sown by trading on the goodwill of Opposer's business as symbolized by its trademark EXTRAN.

WHEREFORE, Opposer requests that this opposition against the trademark application for OXITRAN, Ser. No. 77/196,079, be sustained and that the Trademark Trial and Appeal Board grant any and all further relief to Opposer that the Board finds to be necessary and just in the circumstances.

Respectfully submitted,

EPSTEIN DRANGEL BAZERMAN & JAMES, LLP
Attorneys for Opposer

Dated: April 9, 2008

BY: _____

William C. Wright
Jason M. Drangel
The Lincoln Building
60 East 42nd Street, Suite 820
New York, New York 10165
Tel. No.: (212) 292 5390
Fax. No.: (212) 292-5391

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the NOTICE OF OPPOSITION was served by First Class Mail, with sufficient postage prepaid, on this 9th day of April, 2008, upon Applicant's counsel:

Linda G. Henry, Esq.
Fenwick & West LLP
801 California Street
Silicon Valley Center
Mountain View, CA 94041

By: _____
William C. Wright

Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Wed Apr 9 04:10:56 EDT 2008

Typed Drawing

Word Mark	**EXTRAN**
Goods and Services	IC 003. US 052. G & S: cleaning agents for use in laboratories and industries. FIRST USE: 19740000. FIRST USE IN COMMERCE: 19740000
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	74342178
Filing Date	December 22, 1992
Current Filing Basis	1A;44E
Original Filing Basis	1A;44E
Published for Opposition	January 4, 1994
Registration Number	1827978
Registration Date	March 29, 1994
Owner	(REGISTRANT) E. Merck offene Handelsgesellschaft (o.H.G.) OPEN CO-PARTNERSHIP FED REP GERMANY Frankfurter Strasse 250 6100 Darmstadt 1 FED REP GERMANY (LAST LISTED OWNER) MERCK KGAA LIMITED PARTNERSHIP BY ASSIGNMENT FED REP GERMANY FRANKFURTER STRASSE 250 64293 DARMSTADT, DE FED REP GERMANY
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	STEPHEN J KUNST
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20040511.

Renewal	1ST RENEWAL 20040511
Live/Dead Indicator	LIVE

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2008-04-09 15:05:32 ET

Serial Number: 74342178 Assignment Information Trademark Document Retrieval

Registration Number: 1827978

Mark (words only): EXTRAN

Standard Character claim: No

Current Status: This registration has been renewed.

Date of Status: 2004-05-11

Filing Date: 1992-12-22

Transformed into a National Application: No

Registration Date: 1994-03-29

Register: Principal

Law Office Assigned: LAW OFFICE 12

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 40S -Scanning On Demand

Date In Location: 2007-08-24

LAST APPLICANT(S)/OWNER(S) OF RECORD

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1. MERCK KGAA

Address:
MERCK KGAA
FRANKFURTER STRASSE 250
64293 DARMSTADT, DE
Fed Rep Germany
Legal Entity Type: Limited Partnership
State or Country Where Organized: Fed Rep Germany

GOODS AND/OR SERVICES

International Class: 003
Class Status: Active

cleaning agents for use in laboratories and industries
Basis: 1(a), 44(e)
First Use Date: 1974-00-00
First Use in Commerce Date: 1974-00-00

ADDITIONAL INFORMATION

Foreign Registration Number: 1,097,679
Foreign Registration Date: 1986-10-15
Country: Fed Rep Germany
Foreign Expiration Date: 1996-02-06

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2007-08-24 - Case File In TICRS

2004-05-11 - First renewal 10 year

2004-05-11 - Section 8 (10-year) accepted/ Section 9 granted

2004-03-26 - Combined Section 8 (10-year)/Section 9 filed

1999-09-18 - Section 8 (6-year) accepted & Section 15 acknowledged

1999-05-10 - Section 8 (6-year) and Section 15 Filed

1994-03-29 - Registered - Principal Register

1994-01-04 - Published for opposition

1993-12-03 - Notice of publication

1993-10-19 - Approved for Pub - Principal Register (Initial exam)

1993-09-09 - Communication received from applicant

1993-03-16 - Non-final action mailed

1993-03-10 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

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WEST CHESTER, PA 19380-0906

Domestic Representative
STEPHEN J KUNST

Assignments on the Web > Trademark Query

Trademark Assignment Abstract of Title

Total Assignments: 1

Serial #: 74342178 **Filing Dt:** 12/22/1992 **Reg #:** 1827978 **Reg. Dt:** 03/29/1994

Registrant: E. Merck offene Handelsgesellschaft (o.H

Mark: EXTRAN

Assignment: 1

Reel/Frame: 1430/0847 **Received:** 02/12/1996 **Recorded:** 01/02/1996 **Pages:** 7

Conveyance: ASSIGNS THE ENTIRE INTEREST

Assignor: E. MERCK ("OFFENE HANDELSGELLSCHAFT (O.H.G.) **Exec Dt:** 11/30/1995

Entity Type: OPEN CO-PARTNERSHIP

Citizenship: GERMANY

Assignee: MERCK KGAA
FRANKFURTER STRASSE 250
64293 DARMSTADT
GERMANY

Entity Type: LIMITED PARTNERSHIP

Citizenship: GERMANY

Correspondent: GREENBERG TRAURIG HOFFMAN LIPOFF ROSEN
& QUENTEL, P.A.
LILE H. DEINARD, ESQ.
153 EAST 53RD STREET. 35TH FL.
NEW YORK, NY 10022

Search Results as of: 04/09/2008 03:05 PM

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350. v.2.0.1

Web interface last modified: April 20, 2007 v.2.0.1