ESTTA Tracking number: **ESTTA212101**

Filing date: **05/16/2008**

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

Proceeding	91183461
Party	Defendant Santhera Pharmaceuticals (Schweiz) AG
Correspondence Address	LINDA G. HENRY, ESQ. FENWICK & WEST LLP 801 CALIFORNIA STREET SILICON VALLEY CENTER MOUNTAIN VIEW, CA 94041 trademarks@fenwick.com
Submission	Answer
Filer's Name	Linda G. Henry
Filer's e-mail	trademark@fenwick.com
Signature	/lgh/
Date	05/16/2008
Attachments	OXITRAN_Answer_to_Notice_of_Opposition.pdf (6 pages)(61074 bytes)

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

In the matter of Trademark Application No. 77/196,079
Mark: OXITRAN
Publication Date: December 11, 2007

Merck KGaA Opposer,	)	
vs.	)	Opposition No. 91183461
Santhera Pharmaceuticals (Schweiz) AG Applicant.	)	

Box TTAB NO FEE
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

ANSWER TO NOTICE OF OPPOSITION

Applicant, Santhera Pharmaceuticals (Schweiz) AG, by and through its attorneys, denies that Opposer, Merck KgaA, is and/or will be damaged by the registration of the mark OXITRAN as set forth in U.S. Trademark Application Serial No. 77/196,079, and hereby answers the Notice of Opposition, and admits, denies and alleges as follows:

1. Applicant admits that on June 1, 2007 it filed an application to register the trademark OXITRAN, Application Serial No. 77/196,079, and that such application covers "Chemicals for use in industry and science; reagents for scientific and medical research use", in International 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 International Class 5; and "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 International Class 42. However, Application Serial No. 77/196,079 is based not only on Section 1(b) of the Lanham Act, but also on Section 44(e) of the Lanham Act.

2. Applicant admits that Application Serial No. 77/196,079 was filed under Section 1(b) and Section 44(e) of the Lanham Act. Other allegations contained in Paragraph 2 are conclusions of law to which no answer is required. To the extent that an answer to any of these allegations is required, Applicant denies the allegations contained in Paragraph 2.

3. Applicant lacks sufficient information to admit or deny the factual allegations contained in Paragraph 3. To the extent that an answer to any of these

allegations is required, Applicant denies each and every allegation contained in Paragraph 3.

4. Applicant lacks sufficient information to admit or deny the factual allegations contained in Paragraph 4. Any records of the United States Patent and Trademark Office made evidence herein are to be as determined in conjunction with the rules of practice before the Trademark Trial and Appeal Board. Other allegations contained in Paragraph 4 are conclusions of law to which no answer is required. To the extent that an answer to any of these allegations is required, Applicant denies the allegations contained in Paragraph 4.

5. Applicant lacks sufficient information to admit or deny the factual allegations contained in Paragraph 5. Any records of the United States Patent and Trademark Office made evidence herein are to be as determined in conjunction with the rules of practice before the Trademark Trial and Appeal Board. Other allegations contained in Paragraph 5 are conclusions of law to which no answer is required. To the extent that an answer to any of these allegations is required, Applicant denies the allegations contained in Paragraph 5.

6. Applicant denies each and every allegation contained in Paragraph 6.

7. Applicant denies each and every allegation contained in Paragraph 7.

8. Applicant denies each and every allegation contained in Paragraph 8.

9. Applicant denies each and every allegation contained in Paragraph 9.

10. Applicant denies each and every allegation contained in Paragraph 10.

11. Applicant denies each and every allegation contained in Paragraph 11.

12. Applicant denies each and every allegation contained in Paragraph 12.

AFFIRMATIVE DEFENSES

FIRST AFFIRMATIVE DEFENSE

The Notice of Opposition fails to state a claim upon which relief can be granted.

SECOND AFFIRMATIVE DEFENSE

The Opposer's claims are barred, in whole or in part, by the lack of sufficient secondary meaning in the Opposer's mark in question in this matter.

THIRD AFFIRMATIVE DEFENSE

The Opposer's claims are barred, in whole or in part, by the abandonment of the mark in question in this matter.

FOURTH AFFIRMATIVE DEFENSE

The Opposer's claims are barred, in whole or in part, by the Opposer's failure to maintain the trademark significance/secondary meaning for the mark in question in this matter.

FIFTH AFFIRMATIVE DEFENSE

The Opposer's claims are barred, in whole or in part, as there is no likelihood of confusion between the Applicant's mark and the Opposer's mark in question in this matter.

SIXTH AFFIRMATIVE DEFENSE

Applicant reserves the right to assert any and all other affirmative defenses of which it becomes aware during the pendency of this matter.

WHEREFORE, Applicant prays that Opposer's Notice of Opposition be dismissed and that judgment be entered in favor of Applicant, Santhera Pharmaceuticals (Schweiz) AG.

Dated: May ____, 2008

By: _____

Sally M. Abel, Esq.
Linda G. Henry, Esq.
FENWICK & WEST LLP
Silicon Valley Center
801 California Street
Mountain View, California 94041
(650) 988-8500

Attorneys for Applicant
Santhera Pharmaceuticals (Schweiz) AG

PROOF OF SERVICE BY MAIL

I declare that:

I am employed in the County of Santa Clara, California.

I am over the age of eighteen years and not a party to the within cause; my business address is Fenwick & West LLP, Silicon Valley Center, 801 California Street, Mountain View, CA 94041. On May ___, 2008, I served the within ANSWER TO NOTICE OF OPPOSITION on the interested parties in said cause, by placing a true copy thereof enclosed in a sealed envelope with postage thereon fully prepaid, in the United States mail at Mountain View, California, addressed as follows:

William C. Wright
Jason M. Drangel
Epstein Drangel Bazerman & James, LLP
The Lincoln Building
60 East 42nd Street, Suite 820
New York, NY 10165

I declare under penalty of perjury that the foregoing is true and correct, and that this declaration was executed at Mountain View, California, this ___ day of May, 2008.

_____
Linda G. Henry