

ESTTA Tracking number: **ESTTA234265**

Filing date: **09/03/2008**

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		
Entity	a partnership limited by shares	Citizenship	Germany
Address	Frankfurter Straße 250 D-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 Phone:212-292-5390		
----------------------	---	--	--

Applicant Information

Application No	77371916	Publication date	08/05/2008
Opposition Filing Date	09/03/2008	Opposition Period Ends	09/04/2008
Applicant	VAT "FARMAK" Vul. Frunze 63 Kyiv, 04080 UKRAINE		

Goods/Services Affected by Opposition

Class 005. First Use: 2006/08/31 First Use In Commerce: 2006/08/31 All goods and services in the class are opposed, namely: Decongestants
--

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Other	unlawful use

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3147658	Application Date	02/08/2005
Registration Date	09/26/2006	Foreign Priority Date	NONE
Word Mark	NASIVIN		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 005. First use: Pharmaceutical preparations to be used in the treatment of acute rhinitis, inflammation of the paranasal sinuses, syringitis and otitis media

Related Proceedings	91185704
---------------------	----------

Attachments	78563153#TMSN.jpeg (1 page)(bytes) napht.pdf (13 pages)(240834 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 Overnight Courier on this date.

Signature	/William C. Wright/
Name	William C. Wright
Date	09/03/2008

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

In the Matter of the Trademark Application for NAPHTIZIN (in Cyrillic letters),
Ser. No. 77/371,916, in the name of VAT "FARMAK"

_____)
MERCK KGAA,)
)
Opposer,) Opp. No. _____
)
)
v.)
)
)
VAT "FARMAK",)
)
)
Applicant.)
_____)

NOTICE OF OPPOSITION

In the Matter of Application Ser. No. 77/371,916, published in the Official Gazette on August 5, 2008, 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 (hereinafter "Opposer" or "Merck KGaA"), believes that it is or will be damaged by registration of the trademark NAPHTIZIN (in Cyrillic letters), as reflected in application Ser. No. 77/371,916, and hereby opposes same.

As grounds therefor, it is alleged that:

1. Merck KGaA is the oldest pharmaceutical and chemical company in the world and is a leading producer and distributor of high-quality pharmaceutical products.
2. Opposer is the owner of the trademark NASIVIN in respect of a complete range of decongestant sprays.
3. Opposer, its related companies and/or licensees have sold, and offered for sale, goods bearing the trademark NASIVIN in a trading area of broad geographical scope, including in over sixty (60) countries around the world.
4. Opposer's use of the NASIVIN mark around the world, Opposer's advertising and publicity of goods with the NASIVIN mark over the years, and use by the media of said mark, have contributed to the powerful consumer association between the trademark NASIVIN and Opposer, and have made the trademark NASIVIN famous.
5. Opposer's trademark NASIVIN 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.
6. On February 8, 2005, Opposer filed with the United States Patent and Trademark Office an application to register the trademark NASIVIN, Ser. No. 78/563,153, for "Pharmaceutical preparations to be used in the treatment of acute rhinitis, inflammation of the paranasal sinuses, syringitis and otitis media", and the aforementioned application issued to registration, Reg. No. 3,147,658, on September 26, 2006. Attached to this Notice of Opposition is a print-out from the

“TARR” database, showing status and ownership of the aforementioned trademark registration.

7. On January 15, 2008, VAT "FARMAK" (hereinafter “Applicant”) filed an Intention to Use application to register the alleged trademark NAPHTIZIN (in Cyrillic letters), for “Decongestants”, with the United States Patent and Trademark Office.

COUNTS I & II

LIKELIHOOD OF CONFUSION & FALSE SUGGESTION OF CONNECTION

8. Opposer repeats and realleges each and every allegation contained in paragraphs 1 through 7 herein.
9. Upon information and belief, there is no issue of priority as Opposer has a constructive date of first use of its trademark NASIVIN that predates Applicant’s constructive date and/or actual date of first use in commerce of its alleged trademark NAPHTIZIN (in Cyrillic letters) in respect of decongestants.
10. Under the doctrine of foreign equivalents, Applicant’s alleged trademark NAPHTIZIN (in Cyrillic letters) is so similar to Opposer’s pleaded trademark NASIVIN 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.
11. The respective goods are the same or similar and travel or will travel through the same channels of trade for sale to or use by the same class of purchasers, and will be sold or dispensed by the same types of outlets.

12. Under the “doctrine of greater care”, Applicant has a duty to adopt a trademark for its aforementioned decongestants which is clearly distinguishable from Opposer’s pleaded trademark for the same or similar goods.
13. Under the doctrine of “greater care”, Applicant’s alleged trademark NAPHTIZIN (in Cyrillic letters) is likely to cause confusion, and/or cause mistake, and/or to deceive with respect to Opposer’s pleaded trademark, with potentially harmful consequences to users of Applicant’s and/or Opposer’s goods.
14. Applicant’s alleged trademark NAPHTIZIN (in Cyrillic letters) is confusingly similar with Opposer’s trademark NASIVIN 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.
15. Applicant’s alleged trademark 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 aforementioned trademark.

COUNTS III AND IV

NO LAWFUL USE AND FRAUD

16. Opposer repeats and realleges each and every allegation contained in paragraphs 1 through 7 herein.

17. On January 22, 2008, Applicant's counsel executed an Amendment to Allege Use, declaring under oath that the alleged trademark NAPHTIZIN (in Cyrillic letters) in respect of decongestants "was first used in commerce at least as early as August 31, 2006, and is now in use in such commerce."
18. Upon information and belief, Applicant was not lawfully using in commerce the goods bearing the alleged trademark NAPHTIZIN (in Cyrillic letters) at least as early as August 31, 2006 or on January 22, 2008.
19. Upon information and belief, on or before January 22, 2008 - the date of Applicant's Amendment to Allege Use - Applicant was improperly utilizing an NDC number on its product labels, and was marketing and selling in commerce, and still appears to be marketing and selling in commerce, .1% Naphazoline nitrate as a nasal decongestant. Upon information and belief, Naphazoline nitrate should be considered an unapproved new drug, since it has not been federally approved in the United States for such use.
20. Upon information and belief, on or before January 22, 2008 - the date of Applicant's Amendment to Allege Use - Applicant was and is currently using a foreign language term on its label without utilizing the same foreign language for all of the other words, statements, and other information that are required to be placed on said label.
21. Given that on January 22, 2008 the goods bearing the alleged mark NAPHTIZIN (in Cyrillic letters) were not in lawful use in commerce and improperly labeled, as indicated above, Applicant has committed fraud on the Patent and Trademark Office by alleging under oath that the alleged trademark NAPHTIZIN (in Cyrillic

letters) “was first used in commerce at least as early as August 31, 2006, and is now in use in such commerce.”

DAMAGE TO OPPOSER

22. As set forth in the allegations above, Applicant’s alleged trademark is calculated or likely to cause irreparable loss, injury and damage to Opposer’s business and to the extensive goodwill as symbolized by Opposer’s aforementioned trademark.

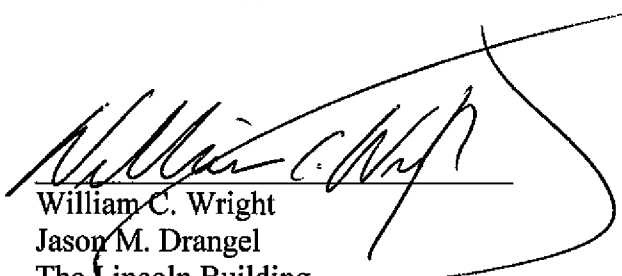
WHEREFORE, Opposer requests that this opposition against the trademark application for NAPHTIZIN (in Cyrillic letters), Ser. No. 77/371,916, be sustained and that the Trademark Trial and Appeal Board grant any and all further relief to Opposer that the Board finds to be necessary and just in the circumstances.

Respectfully submitted,

**EPSTEIN DRANGEL
BAZERMAN & JAMES, LLP**
Attorneys for Opposer

Dated: September 3, 2008

BY:



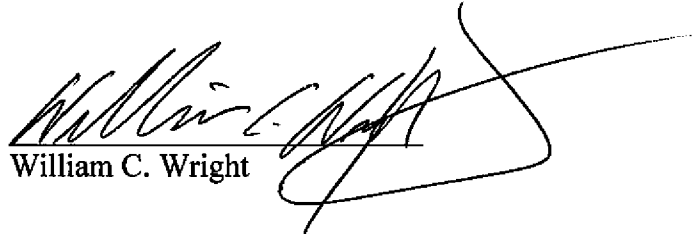
William C. Wright
Jason M. Drangel
The Lincoln Building
60 East 42nd Street, Suite 820
New York, New York 10165
Tel. No.: (212) 292 5390
Fax. No.: (212) 292-5391

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Notice of Opposition was served by Federal Express, with sufficient postage prepaid, on this 3rd day of September, 2008, upon Applicant's attorney of record:

Maria Eliseeva
Houston Eliseeva LLP
4 Militia Dr., Ste. 4
Lexington, MA 02421-4705

BY:


William C. Wright



United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [FAQ](#) | [Glossary](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)

Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Wed Sep 3 04:14:51 EDT 2008

[TESS HOME](#) [NEW USER](#) [STRUCTURED](#) [FREE FORM](#) [BROWSE DICT](#) [SEARCH OG](#) [BOTTOM](#) [HELP](#)

[Logout](#)

Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

[TARR Status](#) [ASSIGN Status](#) [TDR](#) [TTAB Status](#) (Use the "Back" button of the Internet Browser to return to TESS)

NASIVIN

Word Mark NASIVIN
Goods and Services IC 005. US 006 018 044 046 051 052. G & S: Pharmaceutical preparations to be used in the treatment of acute rhinitis, inflammation of the paranasal sinuses, syringitis and otitis media
Standard Characters Claimed
Mark Drawing Code (4) STANDARD CHARACTER MARK
Serial Number 78563153
Filing Date February 8, 2005
Current Filing Basis 44E
Original Filing Basis 1B
Published for Opposition July 4, 2006
Registration Number 3147658
Registration Date September 26, 2006
Owner (REGISTRANT) Merck KGaA PARTNERSHIP LIMITED BY SHARES FED REP GERMANY
Frankfurter Strasse 250 D-64293 Darmstadt FED REP GERMANY
Attorney of Record H. John Campaign
Type of Mark TRADEMARK
Register PRINCIPAL
Live/Dead Indicator LIVE

[TESS HOME](#) [NEW USER](#) [STRUCTURED](#) [FREE FORM](#) [BROWSE DICT](#) [SEARCH OG](#) [TOP](#) [HELP](#)

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

This page was generated by the TARR system on 2008-09-03 12:57:26 ET

Serial Number: 78563153 Assignment Information Trademark Document Retrieval

Registration Number: 3147658

Mark

NASIVIN

(words only): NASIVIN

Standard Character claim: Yes

Current Status: Registered.

Date of Status: 2006-09-26

Filing Date: 2005-02-08

Transformed into a National Application: No

Registration Date: 2006-09-26

Register: Principal

Law Office Assigned: LAW OFFICE 101

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: 650 -Publication And Issue Section

Date In Location: 2006-09-26

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

1. Merck KGaA

Address:

Merck KGaA
Frankfurter Strasse 250

D-64293 Darmstadt
Fed Rep Germany
Legal Entity Type: PARTNERSHIP LIMITED BY SHARES
State or Country Where Organized: Fed Rep Germany

GOODS AND/OR SERVICES

International Class: 005

Class Status: Active

Pharmaceutical preparations to be used in the treatment of acute rhinitis, inflammation of the paranasal sinuses, syringitis and otitis media

Basis: 44(e)

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

Foreign Registration Number: 751744

Foreign Registration Date: 1961-05-24

Country: Fed Rep Germany

Foreign Expiration Date: 2011-05-30

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.

2006-09-26 - Registered - Principal Register

2006-07-04 - Published for opposition

2006-06-14 - Notice of publication

2006-05-23 - Amendment/Petition After Approval For Pub Entered

2006-05-23 - 1(B) Basis Deleted; New Basis Requested

2006-05-23 - Notice of Allowance canceled

2006-05-18 - Petition To Director - Change Basis - Granted

2006-04-17 - Petition To Director - Change Basis - Received

2006-04-17 - PAPER RECEIVED

2006-04-11 - Notice of allowance - mailed
2006-03-29 - PAPER RECEIVED
2006-01-17 - Published for opposition
2005-12-28 - Notice of publication
2005-12-01 - Law Office Publication Review Completed
2005-11-25 - Assigned To LIE
2005-11-18 - Approved for Pub - Principal Register (Initial exam)
2005-11-10 - Amendment From Applicant Entered
2005-10-24 - Communication received from applicant
2005-10-24 - PAPER RECEIVED
2005-09-07 - Examiner's Amendment/Priority Action Mailed
2005-09-07 - Examiners Amendment And/Or Priority Action - Completed
2005-09-06 - Assigned To Examiner
2005-02-17 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

H. John Campaign

Correspondent

H. JOHN CAMPAIGN
GRAHAM CAMPAIGN PC
36 W 44TH ST STE 1300
NEW YORK NY 10036-8178
Phone Number: (212) 354-5650
Fax Number: (212) 354-6354



United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)



Assignments on the Web > Trademark Query

No assignment has been recorded at the USPTO

For Serial Number: 78563153

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

[.HOME](#) | [INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [CONTACT US](#) | [PRIVACY STATEMENT](#)