

ESTTA Tracking number: **ESTTA264414**

Filing date: **02/04/2009**

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	MERZ PHARMA GmbH & CO. KGaA
Granted to Date of previous extension	02/04/2009
Address	Eckenheimer Landstrasse 100 Frankfurt am Main, 60318 GERMANY
Attorney information	Lile H. Deinard, Esq. Dorsey & Whitney LLP 250 Park Avenue, 15th Floor New York, NY 10177 UNITED STATES ny.trademark@dorsey.com, deinard.lile@dorsey.com, robertson.sarah@dorsey.com Phone:(212) 415-9200

Applicant Information

Application No	78846866	Publication date	10/07/2008
Opposition Filing Date	02/04/2009	Opposition Period Ends	02/04/2009
Applicant	Barr Laboratories, Inc. 225 Summit Avenue Montvale, NJ 07645 UNITED STATES		

Goods/Services Affected by Opposition

Class 005. First Use: 2006/09/00 First Use In Commerce: 2006/09/00 All goods and services in the class are opposed, namely: oral contraceptives
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Grounds for Opposition

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

U.S. Registration No.	3251058	Application Date	02/13/2006
Registration Date	06/12/2007	Foreign Priority Date	12/20/2005
Word Mark	JOLESSE		

Design Mark	<h1>JOLESSE</h1>
Description of Mark	NONE
Goods/Services	Class 005. First use: Pharmaceutical preparations namely for the treatment of Frown lines, glabellar lines, crow's feet or laugh lines, platysma, Schizophrenia, Alzheimer's disease, Tinnitus, Multiple Sclerosis

Attachments	78813175#TMSN.jpeg (1 page)(bytes) 78846866 Notice of Opposition.pdf (5 pages)(124365 bytes)
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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	/lhd/
Name	Lile H. Deinard, Esq.
Date	02/04/2009

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

In the Matter of Application Serial No. 78/846,866
Published on October 7, 2008

MERZ PHARMA GMBH & CO. KGAA,

Opposer,

v.

BARR LABORATORIES, INC.,

Applicant.

Opposition No.

NOTICE OF OPPOSITION

Merz Pharma GmbH & Co. KGaA, (“Opposer”), a Kommanditgesellschaft Auf Aktien existing under the laws of the State of Germany, with its principal place of business at Eckenheimer Landstrasse, 100, Frankfurt am Main, Germany, 60318, believes it will be damaged by registration of the mark JOLESSA for “oral contraceptives,” in International Class 5 sought to be registered in U.S. Application Serial No. 78/846,866 by Barr Laboratories, Inc. (“Applicant”), and having been granted an extension of time to oppose until February 4, 2009 by Order of the Trademark Trial and Appeal Board mailed on October 31, 2008, hereby opposes same.

As grounds for opposition, it is alleged that:

1. By the application herein opposed, Applicant seeks to register the mark JOLESSA for “oral contraceptives,” in International Class 5, Application Serial No. 78/846,866 (the “Application”). The Application was filed on March 27, 2006, on an intent-to-use basis.

2. Since well before the filing date of the Application, Opposer has been a worldwide leader in the development, manufacture, distribution and sale of pharmaceutical preparations sold under various marks. By reason of the extensive sales and high quality of Opposer's pharmaceutical preparations, and the worldwide reputation of Opposer, Opposer and its marks enjoys valuable goodwill.

3. Opposer owns U.S. Registration No. 3,251,058 for the trademark JOLESSE[®], which issued on June 12, 2007 for "pharmaceutical preparations, namely for the treatments of frown lines, glabellar lines, crow's feet or laugh lines, platysma, schizophrenia, Alzheimer's disease, tinnitus, multiple sclerosis," in International Class 5 ("Opposer's Registration").

4. Opposer's Registration is in all respects valid, subsisting and owned by Opposer. Further, both the filing date and the priority filing date claimed in Opposer's Registration precede the filing date of the Application, and the first use dates claimed therein.

5. The JOLESSA mark sought to be registered by Applicant is highly similar in appearance, sound and commercial impression to Opposer's JOLESSE[®] mark. Further, the goods covered by the Application, namely, oral contraceptives, are closely related to Opposer's pharmaceutical preparations covered by Opposer's JOLESSE[®] mark.

6. As a result of the foregoing, the purchasing public familiar with Opposer's products and JOLESSE[®] mark is likely to be confused, misled or deceived into thinking that the products of Applicant are products of Opposer, or are in some way sponsored by or connected with Opposer, to Opposer's irreparable damage and injury in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), and will give color of statutory rights to Applicant in violation and derogation of the long standing prior and superior statutory rights of Opposer in its JOLESSE[®] mark.

WHEREFORE Opposer believes that it will be damaged by registration of Applicant's mark and prays that this opposition be sustained, and that Application Serial No. 78/846,866 be denied.

Please recognize as attorneys for Opposer in this proceeding Lile H. Deinard and Sarah Robertson, members of the Bar of the State of New York, whose address is Dorsey & Whitney LLP, 250 Park Avenue, New York, New York 10177, telephone number (212) 415-9200.

Please address all correspondence to Lile H. Deinard at the above address.

DORSEY & WHITNEY LLP

Dated: February 4, 2009

By: _____/LHD/_____
Lile H. Deinard
Sarah Robertson
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New York, New York 10177
(212) 415-9200

Attorneys for Opposer
Merz Pharma GmbH & Co. KGaA

THE FIRM OF HUESCHEN AND SAGE

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MERZ PHARMA GMBH & CO. KGAA,

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BARR LABORATORIES, INC.,

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Opposition No.

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CERTIFICATE OF SERVICE

I hereby certify that the foregoing Notice of Opposition is being served upon the
“Attorneys of Record” for Applicant by mailing a true copy thereof by First Class Mail, postage
prepaid, addressed to:

Tracy-Gene G. Durkin
Sterne, Kessler, Goldstein & Fox PLLC
1100 New York Avenue NW, Suite 600W
Washington, DC 20005-6125

on February 4, 2009.

/TCR/

Tania C. Ramos
Trademark Paralegal