

ESTTA Tracking number: **ESTTA501620**

Filing date: **10/23/2012**

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	Wyeth LLC
Granted to Date of previous extension	10/24/2012
Address	5 Giralda Farms Madison, NJ 07940 UNITED STATES

Attorney information	Paul C. Llewellyn Kaye Scholer LLP 425 Park Avenue New York, NY 10022 UNITED STATES pllewellyn@kayescholer.com, jeischeid@kayescholer.com
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**Applicant Information**

Application No	85531255	Publication date	06/26/2012
Opposition Filing Date	10/23/2012	Opposition Period Ends	10/24/2012
Applicant	Metagenics, Inc. 25 Enterprise, Suite 200 Metagenics, Inc Aliso Viejo, CA 92656 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 005. All goods and services in the class are opposed, namely: dietary supplements
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**Grounds for Opposition**

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

**Mark Cited by Opposer as Basis for Opposition**

U.S. Registration No.	397925	Application Date	05/09/1942
Registration Date	09/29/1942	Foreign Priority Date	NONE
Word Mark	PREMARIN		
Design Mark			

Description of Mark	NONE
Goods/Services	Class U018 (International Class 005). First use: First Use: 1942/02/24 First Use In Commerce: 1942/02/24 Pharmaceutical Preparations for the Treatment of Ovarian Deficiencies

Attachments	85531255 Notice of Opposition.pdf ( 5 pages )(89178 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 Overnight Courier on this date.

Signature	/paul c llewellyn/
Name	Paul C. Llewellyn
Date	10/23/2012

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

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WYETH LLC,	:
Opposer,	:
v.	:
METAGENICS, INC.,	:
Applicant.	:
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**NOTICE OF OPPOSITION**

Applicant Serial No:	85/531,255
Filed:	February 1, 2012
Published for Opposition:	June 26, 2012
Mark:	PREMAGEN

Commissioner for Trademarks  
 Trademark Trial and Appeal Board  
 P.O. Box 1451  
 Alexandria, VA 22313-1451

Opposer, Wyeth LLC (“Opposer” or “Wyeth”), a Delaware limited liability company with a place of business at Five Giralda Farms, Madison, New Jersey 07940, believes it will be damaged by the registration of the mark PREMAGEN shown in Application Serial No. 85/531,255, and hereby opposes the same.

As grounds for opposition, Opposer, by and through its undersigned counsel, alleges that:

1. Wyeth is a direct subsidiary of Pfizer Inc., research-based biomedical and pharmaceutical company in the business of discovering, developing, manufacturing and delivering medicines for people and animals, as well as consumer healthcare products and nutritional products.

2. Wyeth and its predecessors in interest have used the mark PREMARIN mark on pharmaceutical products relating to female health since at least 1942.

3. Wyeth is the owner of U.S. Trademark Registration No. 397,925 on the Principal Register for the trademark PREMARIN covering “Pharmaceutical Preparations for the Treatment of Ovarian Deficiencies” in International Class 005.

4. The registration for the PREMARIN Word Mark is valid, subsisting, and incontestable, and Wyeth hereby gives notice in accordance with Trademark Rule of Practice 2.122(d)(2) that it will rely thereon as evidence in this proceeding, and a status copy thereof showing present title will be introduced into evidence on its behalf during Wyeth’s testimony period.

5. The term PREMARIN is an arbitrary, inherently distinctive mark as applied to the goods covered by Wyeth’s PREMARIN registration.

6. Since introducing its PREMARIN product in 1942, Wyeth and its predecessors have spent substantial time, effort and money to promote the sale of the product in the United States under the PREMARIN mark.

7. Wyeth has sold and continues to sell substantial quantities of PREMARIN products in the United States and has spent substantial time, effort and money promoting the sale of such products under the mark.

8. By virtue of Wyeth’s substantial use, advertising and promotion of the PREMARIN mark and sales of products bearing the PREMARIN mark throughout the United States and abroad, the PREMARIN mark has become well-known marks and has become distinctive of Wyeth’s product.

9. Despite Wyeth's long prior common law and statutory rights in the PREMARIN mark, Applicant, Metagenics, Inc. ("Applicant"), with both constructive and actual notice of Wyeth's federal registrations, and long after Wyeth established rights in and to the PREMARIN mark, adopted and filed an intent-to-use application for registration of the mark PREMAGEN for "dietary supplements" in International Class 005, as set forth in the Notice of Publication.

10. Applicant's mark was published for opposition on June 26, 2012. Wyeth filed for an Extension of Time to Oppose on July 20, 2012.

11. The Trademark Trial and Appeal Board granted an extension until October 24, 2012.

12. Wyeth's PREMARIN mark has priority over Applicant's mark because the filing date of Wyeth's trademark application for the PREMARIN Word Mark is May 9, 1942, and Wyeth's date of first use is February 24, 1942, well prior to the February 1, 2012 filing date of Applicant's intent-to-use trademark application.

13. Applicant's PREMAGEN mark is substantially or highly similar to the mark PREMARIN in sound, appearance and commercial impression.

14. The goods set forth in the subject application are related to the products for which Wyeth's PREMARIN mark is registered and used, in that the "dietary supplements" set forth in the subject application could encompass products intended, advertised or sold for use in connection with female health, menopause, reproductive health or similar purposes, such that many consumers who encounter Applicant's PREMAGEN mark in connection with such products are likely to think that Applicant or Applicant's PREMAGEN products are authorized by, sponsored by, licensed by, affiliated with, or related to the company that offers Wyeth's PREMARIN products.

15. As a result, Applicant's applied-for mark PREMAGEN, if used in conjunction with

the goods set forth in the subject application, is likely to cause confusion, mistake, or to deceive as to the origin, source, sponsorship or affiliation of Applicant's goods.

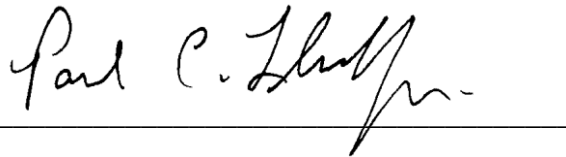
16. Applicant's applied-for mark PREMAGEN so resembles Opposer's previously used and registered PREMARIN mark, as to be likely, when applied to the goods set forth in Applicant's application, to cause confusion, mistake or deception within the meaning of 15 U.S.C. § 1052(d).

17. Applicant's applied-for mark PREMAGEN so resembles Opposer's previously used and registered PREMARIN mark, as to be likely, when applied to the goods set forth in Applicant's application, to falsely suggest a connection with the Opposer within the meaning of 15 U.S.C. § 1052(a).

WHEREFORE, Opposer respectfully prays that this Opposition be sustained and that registration to Applicant be refused.

The Patent and Trademark Office and Trademark Trial and Appeal Board are hereby authorized to collect any fees necessitated by this Notice of Opposition from the deposit account of Opposer's attorneys, Kaye Scholer LLP, Deposit Account No. 11-0228.

Dated: October 23, 2012



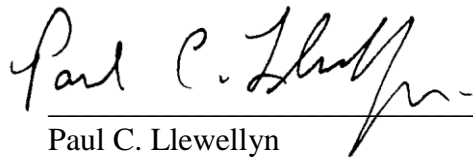
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Attorneys for Opposer Wyeth LLC

**CERTIFICATE OF SERVICE**

I hereby certify that on this 23<sup>rd</sup> day of October, 2012, I caused a true and correct copy of the foregoing Notice of Opposition to be served by Federal Express overnight delivery upon the following domestic representative / correspondent of record:

Ms. Jennifer Pence  
METAGENICS, INC.  
25 Enterprise, Suite 200  
Aliso Viejo, CALIFORNIA 92656  
UNITED STATES

  
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Paul C. Llewellyn