

ESTTA Tracking number: **ESTTA606190**

Filing date: **05/25/2014**

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	SIGMA-TAU PHARMA LIMITED
Granted to Date of previous extension	05/25/2014
Address	21 Holborn Viaduct London, EC1A 2DY UNITED KINGDOM
Party who filed Extension of time to oppose	SIGMA-TAU RARE DISEASES, S.A.
Relationship to party who filed Extension of time to oppose	Opposer is the successor in interest of Sigma-Tau Rare Diseases, S.A. a corporation formerly organized under the laws of Portugal, and having address at Rua Dos Ferreiros, 260, Funchal # Madeira. In particular, Sigma-Tau Rare Diseases, S.A. has been incorporated and merged into Sigma-Tau Pharma Limited, Sigma-Tau Pharma Limited being the surviving entity and the successor in all interest regarding the Mark claimed in the current proceeding. This change has been recorded with WIPO, and the USPTO has recently reflected this change on the U.S. portion of the international registration.

Attorney information	Paolo A. Strino Lucas and Mercanti LLP 30 Broad Street New York, NY 10004 UNITED STATES info@lmiplaw.com Phone:2126618000
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Applicant Information

Application No	85338411	Publication date	11/26/2013
Opposition Filing Date	05/25/2014	Opposition Period Ends	05/25/2014
Applicant	Moderna Therapeutics, Inc. 7th Floor Cambridge, MA 02142 UNITED STATES		

Goods/Services Affected by Opposition

Class 005. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: A full line of pharmaceuticals, medicines, biologics, biotherapeutics, biosimilars and therapeutics, namely, nucleic acid therapeutics and polypeptide therapeutics for the treatment of disorders of the nervous system, the immune system, the cardio-vascular system, the metabolic system, the respiratory system, the musculo-skeletal system, the genitourinary system, inflammatory disorders, gastroenterological disorders, ocular disorders or

diseases, bacteria-based diseases, diabetes, cancer, for use in oncology, for the treatment of immunoregulatory disorders, infectious diseases, reproductive disorders, cardiovascular disorders, for use in dermatology, oncology, nephrology, hematology and ophthalmology, anti-infective preparations, antiviral preparations, antibiotics, antifungal preparations and pharmaceutical preparations for use in tissue and organ transplantation


Class 042. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Scientific research, scientific research in the fields of pharmaceuticals, medicine, biologics, biotherapeutics, biosimilars and therapeutics

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Lack of good faith intent to use

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	4130233	Application Date	02/09/2011
Registration Date	04/24/2012	Foreign Priority Date	10/12/2010
Word Mark	NAVRYTE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 0 First Use In Commerce: 0 Pharmaceutical preparations, namely, chemotherapeutic agents		

Attachments	79094894#TMSN.jpeg(bytes) 65-TM-OPP Notice of Opposition for Filing.pdf(146621 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	/PAS/
Name	Paolo A. Strino
Date	05/25/2014

merged into Sigma-Tau Pharma Limited, Sigma-Tau Pharma Limited being the surviving entity and the successor in all interest regarding the Mark claimed in the current proceeding.

The grounds for opposition are as follows:

1. Applicant, Moderna Therapeutics, Inc., a corporation organized under the laws of Delaware, and having address at 7th Floor 1 Memorial Drive Cambridge, MA 02142

(“Applicant”), filed an application on June 6, 2011, seeking to register the trademark NATIVE, for:

- A full line of pharmaceuticals, medicines, biologics, biotherapeutics, biosimilars and therapeutics, namely, nucleic acid therapeutics and polypeptide therapeutics for the treatment of disorders of the nervous system, the immune system, the cardio-vascular system, the metabolic system, the respiratory system, the musculo-skeletal system, the genitourinary system, inflammatory disorders, gastroenterological disorders, ocular disorders or diseases, bacteria-based diseases, diabetes, cancer, for use in oncology, for the treatment of immunoregulatory disorders, infectious diseases, reproductive disorders, cardiovascular disorders, for use in dermatology, oncology, nephrology, hematology and ophthalmology, anti-infective preparations, antiviral preparations, antibiotics, antifungal preparations and pharmaceutical preparations for use in tissue and organ transplantation in International Class 5; and
- Scientific research, scientific research in the fields of pharmaceuticals, medicine, biologics, biotherapeutics, biosimilars and therapeutics in International Class 42,

as evidenced by the publication of said mark in the Official Gazette on November 26, 2013. The application was based on intent to use under Section 1(b) of the Trademark Act and has yet to file a Statement of Use.

2. Opposer is and has been engaged, by itself, its predecessors and affiliated companies, in the manufacture, sale and/or distribution of a wide range of pharmaceutical products and is part of the Sigma-Tau Group, an international pharmaceutical group engaged in the research, development and manufacturing of prescription and over the counter medications, as well as dietary supplements adapted for medical use.

3. Opposer owns the following U.S. trademark registration and application:

<u>Mark</u>	<u>Serial No.</u>	<u>Goods/Services</u>
NAVRYTE	4,130,233	Pharmaceutical preparations, namely, chemotherapeutic agents in International Class 5

The mentioned registration is valid and subsisting. A copy of the pertinent information from the USPTO database about such registration and application is attached as Exhibit A. Opposer has invested substantial time, money and efforts in the activities related to the adoption of pharmaceutical preparations under the trademark NAVRYTE. This registration bears filing date of February 9, 2011, thus priority is not at issue.

4. Applicant is seeking registration for the trademark NATIVE in the same class as Opposer's mark NAVRYTE, and in connection with substantially similar and related goods and services, i.e. a full line of pharmaceuticals, medicines, biologics, biotherapeutics, biosimilars and therapeutics, etc. as well as related Class 42 services. In addition, Applicant's recitation of goods and services is broad, and contains some products such as oncology preparations which essentially overlap Opposer's listed chemotherapeutic agents.

5. It is clear that the persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some association, connection, sponsorship, endorsement between their sources. Applicant's proposed mark and

Opposer's trademark are similar in sound, appearance, meaning, and commercial impression. The word NATIVE and NAVRYTE are confusingly similar and, when considered in their entirety, the consuming public is likely to view them in the same way, as they project a similar commercial impression. For these reasons, when applied to Applicant's goods, the NATIVE trademark is likely to cause confusion, to cause mistake, and to deceive the trade and public, who are likely to believe that Opposer is the source of Applicant's goods or that such goods are approved, endorsed, sponsored, produced under license, or somehow associated with Opposer. This is especially problematic considering the greater care required for pharmaceutical products and the potential risk of harm to the public from trademark confusion. In view of the foregoing, the Board should find that there is likelihood of confusion under Section 2(d) between Applicant's trademark and Opposer's Marks.

6. Any defect, objection to, or fault found with Applicant's products sold under the NATIVE mark would necessarily reflect on and seriously injure the reputation that Opposer has established for its goods and business.

7. Additionally, in view of Applicant's overbroad recitation of goods and services, Applicant appears to be merely attempting to reserve a general right in his NATIVE mark when it filed its intent-to-use application.

8. Applicant has listed a wide range of pharmaceuticals and medicines, biologics, biotherapeutics, biosimilars, therapeutics, etc. Upon information and belief, Opposer alleges that Applicant lacks the requisite *bona fide* intention to use the proposed mark for the products and/or services listed in its Application, thus registration shall be denied on this basis as well.

9. If Applicant is granted a registration for the mark herein opposed, it would obtain thereby at least a *prima facie* exclusive right to use the mark for the goods identified in the registration. Such registration would be a source of damage and injury to Opposer.

WHEREFORE, Opposer prays that registration of the NATIVE mark in Application Serial No. 85/338,411 be refused and that this opposition be sustained.

A fee in the amount of \$300 as required by 37 CFR §2.6(a)(17) has been submitted electronically, for each class in the opposed registration. The Commissioner is authorized to draw on the Deposit Account of Lucas & Mercanti LLP, Account No. 02/2275, with reference to file CON-TM-65-OPP, if the accompanying fee is insufficient or inadvertently omitted.

Please recognize as attorneys for Opposer in this proceeding, Paolo A. Strino and Michael N. Mercanti of LUCAS & MERCANTI LLP, 30 Broad Street, New York, New York, 10004.

Respectfully Submitted,

Dated: May 25, 2014

By:



Paolo A. Strino
Michael N. Mercanti
LUCAS & MERCANTI LLP
30 Broad Street
New York, NY 10004
(212) 661-8000
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ATTORNEYS FOR OPPOSER

CERTIFICATE OF SERVICE AND FILING

I hereby certify that a true and complete copy of the foregoing NOTICE OF OPPOSITION, including any exhibits thereof, has been served on Applicant, by mailing said copy on May 25, 2014, via First Class Mail, postage prepaid to Applicant's attorney of record, Donna T. Ward of DT WARD PC at Groton, MASSACHUSETTS 01450.

The undersigned further certifies that this correspondence is being transmitted electronically to the Commissioner for Trademarks on May 25, 2014, by filing the same electronically at <http://estta.uspto.gov/filing-type.jsp>

By



Paolo A. Strino
LUCAS & MERCANTI LLP
30 Broad Street
New York, NY 10004
Tel: (212) 661-8000
Email: info@lmiplaw.com

EXHIBIT A

Generated on: This page was generated by TSDR on 2014-05-25 04:16:14 EDT

Mark: NAVRYTE

NAVRYTE

US Serial Number: 79094894

Application Filing Date: Feb. 09, 2011

US Registration Number: 4130233

Registration Date: Apr. 24, 2012

Register: Principal

Mark Type: Trademark

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Apr. 24, 2012

Publication Date: Feb. 07, 2012

Mark Information

Mark Literal Elements: NAVRYTE

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Translation: The word(s) "NAVRYTE" has no meaning in a foreign language.

Related Properties Information

International Registration Number: 1070550

International Registration Date: Feb. 09, 2011

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *...* identify additional (new) wording in the goods/services.

For: Pharmaceutical preparations, namely, chemotherapeutic agents

International Class(es): 005 - Primary Class

U.S Class(es): 006, 018, 044, 046, 051, 052

Class Status: ACTIVE

Basis: 66(a)

Basis Information (Case Level)

Filed Use: No

Currently Use: No

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: Yes

Currently 66A: Yes

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: SIGMA-TAU PHARMA LIMITED

Owner Address: 21 Holborn Viaduct
London EC1A 2DY
UNITED KINGDOM

Legal Entity Type: UNKNOWN

State or Country Where Organized: No Place Where Organized Found

Attorney/Correspondence Information

Attorney of Record

Docket Number: CON-TM-29

Correspondent

Correspondent Name/Address: Paolo A. Strino
 LUCAS & MERCANTI, LLP
 30 BROAD STREET, 21st FLOOR
 NEW YORK, NEW YORK 10004
 UNITED STATES

Correspondent e-mail: info@lmiplaw.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Apr. 10, 2014	CHANGE OF OWNER RECEIVED FROM IB	
Mar. 19, 2014	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Jun. 28, 2013	CHANGE OF OWNER RECEIVED FROM IB	
Nov. 14, 2012	NOTIFICATION PROCESSED BY IB	
Oct. 25, 2012	FINAL DECISION TRANSACTION PROCESSED BY IB	
Oct. 01, 2012	FINAL DISPOSITION NOTICE SENT TO IB	
Oct. 01, 2012	FINAL DISPOSITION PROCESSED	67445
Jul. 24, 2012	FINAL DISPOSITION NOTICE CREATED, TO BE SENT TO IB	
Apr. 24, 2012	REGISTERED-PRINCIPAL REGISTER	
Feb. 07, 2012	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Feb. 07, 2012	PUBLISHED FOR OPPOSITION	
Jan. 18, 2012	NOTIFICATION OF POSSIBLE OPPOSITION SENT TO IB	
Jan. 18, 2012	NOTICE OF START OF OPPOSITION PERIOD CREATED, TO BE SENT TO IB	
Jan. 18, 2012	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Jan. 05, 2012	LAW OFFICE PUBLICATION REVIEW COMPLETED	67287
Jan. 03, 2012	APPROVED FOR PUB - PRINCIPAL REGISTER	
Dec. 12, 2011	TEAS/EMAIL CORRESPONDENCE ENTERED	67287
Dec. 12, 2011	CORRESPONDENCE RECEIVED IN LAW OFFICE	67287
Dec. 08, 2011	ASSIGNED TO LIE	67287
Nov. 18, 2011	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Jun. 11, 2011	REFUSAL PROCESSED BY IB	
Jun. 10, 2011	NEW REPRESENTATIVE AT IB RECEIVED	
May 18, 2011	NON-FINAL ACTION MAILED - REFUSAL SENT TO IB	
May 18, 2011	REFUSAL PROCESSED BY MPU	72589
May 18, 2011	NON-FINAL ACTION (IB REFUSAL) PREPARED FOR REVIEW	
May 17, 2011	NON-FINAL ACTION WRITTEN	76508
May 17, 2011	NON-FINAL ACTION (IB REFUSAL) WITHDRAWN FOR REVIEW	67445
May 15, 2011	NON-FINAL ACTION (IB REFUSAL) PREPARED FOR REVIEW	
May 14, 2011	NON-FINAL ACTION WRITTEN	76508
May 10, 2011	ASSIGNED TO EXAMINER	76508
Apr. 12, 2011	APPLICATION FILING RECEIPT MAILED	
Apr. 08, 2011	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Apr. 07, 2011	SN ASSIGNED FOR SECT 66A APPL FROM IB	

International Registration Information (Section 66a)

International Registration Number: 1070550

Priority Claimed Flag: Yes

Intl. Registration Status: REQUEST FOR EXTENSION OF PROTECTION PROCESSED

Notification of Apr. 07, 2011

International Registration Date: Feb. 09, 2011

Date of Section 67 Priority Claim: Oct. 12, 2010

Date of International Registration Status: Apr. 07, 2011

Date of Automatic Oct. 07, 2012

Designation Date:
International Registration Feb. 09, 2021
Renewal Date:
First Refusal Flag: Yes

Protection:

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Apr. 24, 2012

Assignment Abstract Of Title Information

Summary

Total Assignments: 1

Registrant: DEFIANTE FARMACÉUTICA, S.A.

Assignment 1 of 1

Conveyance: ASSIGNS THE ENTIRE INTEREST

Reel/Frame: [5057/0791](#)

Pages: 2

Date Recorded: Jun. 28, 2013

Supporting Documents: [assignment-tm-5057-0791.pdf](#)

Assignor

Name: [DEFIANTE FARMAC?UTICA, S.A.](#)

Execution Date: Mar. 18, 2013

Legal Entity Type: UNKNOWN

State or Country Where Organized: PORTUGAL

Assignee

Name: [SIGMA-TAU RARE DISEASES, S.A.](#)

Legal Entity Type: CORPORATION

State or Country Where Organized: PORTUGAL

Address: RUA DOS FERREIROS, 260
P-9000-082 FUNCHAL - MADEIRA, PORTUGAL

Correspondent

Correspondent Name: SIGMA-TAU RARE DISEASES, S.A.

Correspondent Address: RUA DOS FERREIROS, 260
P-9000-082 FUNCHAL - MADEIRA
PORTUGAL

Domestic Representative - Not Found

NEW HOLDER/REPRESENTATIVE OF AN INTERNATIONAL REGISTRATION

SERIAL NUMBER: 79094894

The table below presents the data as entered.

Input Field	Entered
OVERVIEW	
INTERNATIONAL REGISTRATION NUMBER	1070550
EFFECTIVE DATE OF MODIFICATION	02/17/2014
NOTIFICATION DATE	04/10/2014
HOLDER DETAILS	
CLIENT IDENTIFIER	883691
NOTIFICATION LANGUAGE	ENGLISH
NAME	SIGMA-TAU PHARMA LIMITED
ADDRESS	21 Holborn Viaduct London EC1A 2DY
COUNTRY	United Kingdom
ENTITLEMENT NATIONALITY OF APPLICANT/TRANSFEREE/HOLDER	United Kingdom
LEGAL NATURE	Limited
LEGAL NATURE: PLACE INCORPORATED	United Kingdom
CORRESPONDENCE INDICATOR	YES
REPRESENTATIVE GROUP	
CLIENT IDENTIFIER	175334
NAME	CON LOR SPA
ADDRESS	Via Renato Fucini, 5 I-20133 MILANO
COUNTRY	Italy
PREVIOUS HOLDER DETAILS	

CLIENT IDENTIFIER	852642
NAME	SIGMA-TAU RARE DISEASES, S.A.
ADDRESS	Rua Dos Ferreiros, 260 FUNCHAL - MADEIRA
COUNTRY	Portugal

MISCELLANEOUS INFORMATION

IB DOCUMENT ID	794842801
OFFICE REFERENCE	79094894
TRANSACTION TYPE	TRN - TRANSFER

NEW HOLDER/REPRESENTATIVE OF AN INTERNATIONAL REGISTRATION

SERIAL NUMBER: 79094894

The table below presents the data as entered.

Input Field	Entered
OVERVIEW	
INTERNATIONAL REGISTRATION NUMBER	1070550
EFFECTIVE DATE OF MODIFICATION	03/18/2013
NOTIFICATION DATE	06/27/2013
HOLDER DETAILS	
CLIENT IDENTIFIER	852642
NOTIFICATION LANGUAGE	ENGLISH
NAME	SIGMA-TAU RARE DISEASES, S.A.
ADDRESS	Rua Dos Ferreiros, 260 P-9000-082 FUNCHAL - MADEIRA
COUNTRY	Portugal
ENTITLEMENT NATIONALITY OF APPLICANT/TRANSFEREE/HOLDER	Portugal
LEGAL NATURE	Corporation
LEGAL NATURE: PLACE INCORPORATED	Portugal
CORRESPONDENCE INDICATOR	YES
REPRESENTATIVE GROUP	
CLIENT IDENTIFIER	204530
NAME	CON LOR SPA
ADDRESS	Via Renato Fucini, 5 I-20133 MILANO
COUNTRY	Italy
PREVIOUS HOLDER DETAILS	

CLIENT IDENTIFIER	756366
NAME	DEFIANTE FARMACÊUTICA, S.A.
ADDRESS	Rua dos Ferreiros, 260 FUNCHAL - Madeira
COUNTRY	Portugal

MISCELLANEOUS INFORMATION

IB DOCUMENT ID	727777201
OFFICE REFERENCE	79094894
TRANSACTION TYPE	TRN - TRANSFER

United States of America
United States Patent and Trademark Office

NAVRYTE

Reg. No. 4,130,233

Registered Apr. 24, 2012

Int. Cl.: 5

TRADEMARK

PRINCIPAL REGISTER

DEFIANTE FARMACÊUTICA, S.A. (PORTUGAL JOINT STOCK COMPANY)
RUA DOS FERREIROS, 260
P-9000-082 FUNCHAL - MADEIRA, PORTUGAL

FOR: PHARMACEUTICAL PREPARATIONS, NAMELY, CHEMOTHERAPEUTIC AGENTS,
IN CLASS 5 (U.S. CLS. 6, 18, 44, 46, 51 AND 52).

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PAR-
TICULAR FONT, STYLE, SIZE, OR COLOR.

PRIORITY DATE OF 10-12-2010 IS CLAIMED.

OWNER OF INTERNATIONAL REGISTRATION 1070550 DATED 2-9-2011, EXPIRES 2-9-
2021.

THE WORD(S) "NAVRYTE" HAS NO MEANING IN A FOREIGN LANGUAGE.

SER. NO. 79-094,894, FILED 2-9-2011.

GENE MACIOL, EXAMINING ATTORNEY



David J. Kyfos

Director of the United States Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

Requirements in the First Ten Years*
What and When to File:

First Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. *See* 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

Second Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.*
See 15 U.S.C. §1059.

Requirements in Successive Ten-Year Periods*
What and When to File:

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.*

Grace Period Filings*

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or
reminder of these filing requirements.**

***ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. *See* 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. *See* 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.