

ESTTA Tracking number: **ESTTA649209**

Filing date: **01/09/2015**

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	SmithKline Beecham Limited
Granted to Date of previous extension	01/11/2015
Address	980 Great West Road Brentford, Middlesex, TW8 9GS UNITED KINGDOM

Attorney information	Paul C. Llewellyn Kaye Scholer LLP 250 West 55th Street New York, NY 10019-9710 UNITED STATES paul.llewellyn@kayescholer.com, tmdocketing@kayescholer.com, john.rynkiewicz@kayescholer.com Phone:212-836-7828
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Applicant Information

Application No	86244742	Publication date	07/15/2014
Opposition Filing Date	01/09/2015	Opposition Period Ends	01/11/2015
Applicant	Morales Caro, Luis R. Urb. Paraiso de Mayagüez Mayagüez, 00681 PR		

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: Topical analgesic preparations for the treatment of muscular aches and pains

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
The mark is merely descriptive	Trademark Act section 2(e)(1)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1060597	Application Date	07/22/1976
Registration Date	03/08/1977	Foreign Priority Date	NONE

Word Mark	PANADOL
Design Mark	
Description of Mark	NONE
Goods/Services	Class 005. First use: First Use: 1976/05/06 First Use In Commerce: 1976/05/06 ANALGESIC PREPARATION

U.S. Registration No.	4408281	Application Date	07/17/2012
Registration Date	09/24/2013	Foreign Priority Date	NONE

Word Mark	PANADOL
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Description of Mark	The mark consists of a panda bear on a skateboard with word mark "PANADOL" on front of shirt.
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Goods/Services	Class 005. First use: First Use: 2012/12/12 First Use In Commerce: 2012/12/12 Analgesics
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U.S. Registration No.	2125323	Application Date	11/08/1996
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Registration Date	12/30/1997	Foreign Priority Date	NONE
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Word Mark	CHILDREN'S PANADOL
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Design Mark	
Description of Mark	NONE
Goods/Services	Class 005. First use: First Use: 1988/11/00 First Use In Commerce: 1988/11/00 pharmaceutical preparations, namely, analgesics

U.S. Registration No.	2123421	Application Date	11/08/1996
Registration Date	12/23/1997	Foreign Priority Date	NONE

Word Mark	CHILDREN'S PANADOL		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 005. First use: First Use: 1988/11/00 First Use In Commerce: 1988/11/00 pharmaceutical preparations, namely, analgesics
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Attachments	85678959#TMSN.png(bytes) 75194952#TMSN.png(bytes) 75195973#TMSN.png(bytes) SANADOL Opposition.pdf(2551417 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 Facsimile or email (by agreement only) on this date.

Signature	/paul c. llewellyn/
Name	Paul C. Llewellyn
Date	01/09/2015

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

SMITHKLINE BEECHAM LIMITED,

Opposer,

v.

LUIS R. MORALES CARO,

Applicant.

Opposition No. _____

Mark: SANADOL
Serial No: 86244742
Filed: April 7, 2014
Published: July 15, 2014

NOTICE OF OPPOSITION

Opposer SmithKline Beecham Limited (“SKB” or “Opposer”), a company organized under the laws of England and Wales with offices located and doing business at 980 Great West Road, Brentford, Middlesex TW8 9GS, United Kingdom, believes that it will be damaged by the registration of the mark SANADOL set forth in Application Serial No. 86244742, and hereby opposes the same.

As grounds for opposition, SKB alleges that:

1. SKB is a member of the GlaxoSmithKline group of companies, a global group of healthcare companies that researches, develops, manufactures and sells a broad range of pharmaceutical, vaccine and consumer healthcare products.

2. SKB is the owner of the PANADOL mark, and it and its predecessors-in-interest and affiliated companies have used the mark in commerce on analgesic pharmaceutical preparations continuously since at least May 6, 1976.

3. SKB is the owner of U.S. Trademark Registration No. 1,060,597 on the Principal Register for the PANADOL mark covering “analgesic preparation” in International Class 5, as well as three other U.S. trademark registrations (Nos. 4,408,281; 2,125,323; and 2,123,421) that

comprise the term PANADOL and that cover analgesic preparations (all of the foregoing SKM registrations, collectively, the “PANADOL Registrations”).

4. The PANADOL Registrations are valid and subsisting and SKB 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 status copies thereof showing present title will be introduced into evidence on its behalf during SKB’s testimony period.

5. The PANADOL mark is inherently distinctive; it is a fanciful and coined term with no meaning other than to identify SKB’s products.

6. Since PANADOL products were introduced in 1976, SKB and its predecessors-in-interest and affiliated companies have spent substantial time, effort and money to promote the sale of the products in commerce under the PANADOL mark.

7. By virtue of the substantial use, sales, advertising, and promotion of the PANADOL mark in commerce by SKB and its predecessors-in-interest and affiliated companies, and the inherently distinctive nature of the mark, the PANADOL mark has become a well-known mark and has become distinctive of SKB’s products.

8. Despite SKB’s long prior common law and statutory rights in the PANADOL mark, and long after SKB and its predecessors-in-interest established rights in and to the PANADOL mark, and with at least constructive notice of SKB’s federal trademark registrations, Luis R. Morales Caro (“Applicant”) has applied to register the mark SANADOL for “[t]opical analgesic preparations for the treatment of muscular aches and pains” in International Class 5, as set forth in Application Serial No. 86244742 (the “Subject Application”).

9. SKB's mark has priority over Applicant's mark because the filing date of SKB's first trademark application covering PANADOL was July 22, 1976, and the date of first use in commerce was May 6, 1976, many years prior to the priority date of the Subject Application.

10. Applicant's SANADOL mark is substantially or highly similar to the PANADOL mark in sound, appearance and commercial impression.

11. The goods set forth in the Subject Application are legally identical to the goods for which SKB's PANADOL mark is registered and used. On information and belief, the goods will be sold and distributed through the same channels of trade and in the same geographic areas.

12. As a result, if Applicant begins using the mark SANADOL in commerce in conjunction with the goods set forth in the Subject Application, in light of the similarity of the SANADOL and PANADOL marks and the identical nature of the parties' respective goods, channels of trade and target patient populations (among other reasons), many consumers, patients and others who encounter Applicant's mark are likely to think that the goods offered under the SANADOL mark, or the company that offers Applicant's products, is authorized by, sponsored by, licensed by, affiliated with, related to or the same as the company that offers SKB's PANADOL products, or that the SANADOL and PANADOL products are the same or are otherwise related.

13. Accordingly, Applicant's SANADOL mark, 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.

14. Applicant's SANADOL mark so resembles SKB's previously used and registered PANADOL mark as to be likely, when applied to the goods set forth in the Subject Application, to cause confusion, mistake or deception within the meaning of 15 U.S.C. § 1052(d).

15. SKB previously has used in commerce, in connection with analgesic preparations, the trademark PANADOL, such that PANADOL became a name or identity of substantial reputation that is closely identified with SKB. Applicant's applied-for mark SANADOL is a close approximation of SKB's previously used and registered PANADOL mark, so as to be likely, when applied to the goods set forth in the Subject Application, to point uniquely to SKB and to falsely suggest a connection with the SKB within the meaning of 15 U.S.C. § 1052(a).

16. On information and belief, Applicant intends to use its SANADOL mark in Puerto Rico, where a substantial number of consumers speak Spanish.

17. On further information and belief, the term SANADOL is virtually equivalent in some Spanish pronunciations to the term "sanador," which is a Spanish word that means, *inter alia*, "sanatory, therapeutic, having curative properties, promoting healing," and which is a word that SKB or its affiliated companies may wish to use in the future in connection with the promotion and marketing of pharmaceutical or related products.

18. Given the equivalence of SANADOL to "sanador," and in light of the meaning of the Spanish term "sanador," Applicant's proposed mark, when used on or in connection with the goods identified in the Subject Application, would be merely descriptive of such goods. Accordingly, the Subject Application should be denied pursuant to 15 U.S.C. §1052(e).

WHEREFORE, for all of the foregoing reasons and for such other reasons as the Board determines are appropriate, Opposer respectfully prays that this Opposition be sustained and that the Subject Application 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: January 9, 2015

Respectfully submitted,



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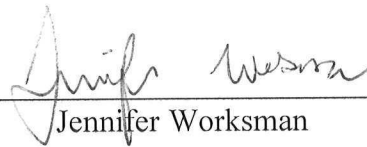
*Attorneys for Opposer
SmithKline Beecham Limited*

CERTIFICATE OF SERVICE

I certify that the foregoing Notice of Opposition is being electronically filed with the United States Patent and Trademark Office on January 9, 2015, and that I caused a true and correct copy of the foregoing to be served by email and by first-class mail, postage prepaid, on the attorneys of record for Applicant, namely:

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