ESTTA Tracking number: **ESTTA678900**

Filing date: **06/18/2015**

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 | Aventisub LLC | | |
| Entity | Corporation | Citizenship | Pennsylvania |
| Address | 3711 Kennett Pike Suite 200<br>Greenville, DE 19807<br>UNITED STATES | | |

| | |
|---|---|
| Attorney information | Susan Upton Douglass<br>Fross Zelnick Lehrman & Zissu, P.C.<br>866 United Nations Plaza<br>New York, NY 10017<br>UNITED STATES<br>sdouglass@frosszelnick.com Phone:212-813-5900 |

## Applicant Information

| | | | |
|---|---|---|---|
| Application No | 86448813 | Publication date | 05/26/2015 |
| Opposition Filing Date | 06/18/2015 | Opposition Period Ends | 06/25/2015 |
| Applicant | Tran, Dat Quoc<br>5706 N Braeswood<br>Houston, TX 77096<br>UNITED STATES | | |

## Goods/Services Affected by Opposition

| |
|---|
| Class 005. First Use: 0 First Use In Commerce: 0<br>All goods and services in the class are opposed, namely: Pharmaceutical preparations for the treatment of allergy and allergic conditions |

## Grounds for Opposition

| | |
|---|---|
| Priority and likelihood of confusion | Trademark Act section 2(d) |
| Dilution | Trademark Act section 43(c) |

## Mark Cited by Opposer as Basis for Opposition

| | | | |
|---|---|---|---|
| U.S. Registration No. | 2067728 | Application Date | 06/02/1995 |
| Registration Date | 06/03/1997 | Foreign Priority Date | NONE |
| Word Mark | ALLEGRA | | |
| Design Mark | | | |
| Description of | NONE | | |

| | |
|---|---|
| Mark | |
| Goods/Services | Class 005. First use: First Use: 1996/08/01 First Use In Commerce: 1996/08/01 pharmaceutical preparations, namely antihistamines |

| | |
|---|---|
| Attachments | ALLEREG Notice of Opposition (F1713801x96B9E).pdf(330615 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 First Class Mail on this date.

| | |
|---|---|
| Signature | /sud/ |
| Name | Susan Upton Douglass |
| Date | 06/18/2015 |

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

Opposer's Ref: AVSB 1504234

In the Matter of Application Serial No. 86/448,813
Mark: ALLEREG

| | | |
|---|---|---|
| **Aventisub LLC** | : | |
| | : | |
| Opposer, | : | |
| | : | Opposition No. _____ |
| - against - | : | |
| | : | |
| **Dat Quoc Tran** | : | |
| | : | |
| Applicant. | : | |
| | : | |

Box TTAB
FEE

## NOTICE OF OPPOSITION

Opposer, Aventisub LLC (formerly known as Aventisub II Inc.), a Delaware corporation located and doing business at 3711 Kennett Pike, Suite 200, Greenville, Delaware 19807, believes that it would be damaged by the issuance of a registration for the trademark ALLEREG as applied for in Application Serial No. 86/448,813, and therefore opposes the same. As grounds for its opposition, Opposer, by its attorneys Fross Zelnick Lehrman & Zissu, P.C., alleges as follows:

1. Since at least as early as 1996, and prior to any date upon which Applicant can rely, Opposer has used the mark ALLEGRA for pharmaceutical preparations, namely antihistamines, in commerce the United States, and is continuing to do so. Opposer has invested a substantial amount of time, effort and money in promoting the ALLEGRA mark. As a result, the mark has

become distinctive of Opposer's goods and has come to represent enormous goodwill for Opposer.

2. Opposer owns U.S. Registration No. 2,067,728, issued June 3, 1997 for the mark ALLEGRA for pharmaceutical preparations, namely, antihistamines in International Class 5. The registration shows a date of first use of August 1, 1996, long prior to any date on which Applicant relies. Opposer's registration is valid, subsisting, and in full force and effect. In addition, this registration has become incontestable under Section 15 of the Trademark Act. As such, this registration serves as conclusive evidence of Opposer's exclusive rights to use the mark. A copy of the foregoing registration particulars is attached as Exhibit A.

3. As a result of Opposer's reputation, use, sales success, and significant investment in advertising, Opposer's ALLEGRA mark has become a strong trademark exclusively identifying Opposer's antihistamine products. As such, Opposer's ALLEGRA mark has garnered enormous goodwill and is an extremely valuable asset to Opposer.

4. As a result of Opposer's reputation, use, substantial sales success, and significant investment in advertising, Opposer's ALLEGRA mark has become a famous trademark, and it became famous prior to any date upon which Applicant can rely.

5. On November 7, 2014, Applicant, Dat Quoc Tran, filed the application at issue to register the mark ALLEREG for pharmaceutical preparations for the treatment of allergy and allergic conditions, in International Class 5, on the basis of intent to use

6. On information and belief, Applicant made no use of this mark prior to its filing date, November 7, 2014, and thus Opposer has priority.

First Ground for the Opposition

7. Opposer repeats and incorporates paragraphs 1 – 6 as is fully set forth herein.

8. The mark that Applicant seeks to register, ALLEREG, is similar in appearance, sound, meaning and commercial impression to Opposer's ALLEGRA mark, and will be used on goods that are closely related to the goods on which Opposer uses its registered mark. Based on the similarities of the marks and goods, the public is likely to associate the goods sold by Applicant under the mark ALLEREG with Opposer or with Opposer's goods, or to believe that Applicant's goods are sponsored, endorsed or licensed by Opposer, or that there is some relationship between Applicant and Opposer.

9. For the above reasons, any use of the mark ALLEREG by Applicant is likely to cause confusion, cause mistake or deceive the public, and cause the public to believe that the goods sold under the ALLEREG mark emanate from or are otherwise sponsored by or endorsed by Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

Second Ground for the Opposition

10. Opposer repeats and incorporates paragraphs 1 – 9 as is fully set forth herein.

11. Because the ALLEGRA mark has become famous with respect to pharmaceutical preparations, namely, antihistamines, Applicant's registration of the mark ALLEREG for pharmaceutical preparations for the treatment of allergy and allergic conditions will damage Opposer by trading on the enormous goodwill associated with the ALLEGRA mark and diluting its distinctiveness.

12. Applicant's registration of ALLEREG in connection with the goods identified in its application is likely to cause dilution of Opposer's famous ALLEGRA mark by blurring, in violation of Sections 13(a) and 43(c) of the Lanham Act, 15 U.S.C. §§1063 and 1125(c). By

reason of the foregoing, Opposer will be damaged by the registration of the mark ALLEREG to Applicant.

By reason of the foregoing, Opposer will be damaged by the registration of the mark ALLEREG to Applicant.

WHEREFORE, it is respectfully requested that this opposition be sustained and that the registration sought by Application Serial No. 86/448,813 be denied.

Dated: New York, New York
June 18, 2015

Respectfully submitted,

FROSS ZELNICK LEHRMAN
& ZISSU, P.C.

By: _____
Susan Upton Douglass
Attorneys for Opposer
866 United Nations Plaza
New York, New York 10017
(212) 813-5900

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing was served by prepaid, first-class mail upon Applicant's correspondent, Dat Quoc Tran at 5706 N. Braeswood Blvd. Houston, Texas 77096, this 18th day of June 2015.

_____
Susan Upton Douglass

# EXHIBIT A

**Generated on:** This page was generated by TSDR on 2015-06-18 14:15:01 EDT

**Mark:** ALLEGRA

**US Serial Number:** 74683534 **Application Filing Date:** Jun. 02, 1995

**US Registration Number:** 2067728 **Registration Date:** Jun. 03, 1997

**Register:** Principal

**Mark Type:** Trademark

**Status:** The registration has been renewed.

**Status Date:** Jul. 03, 2007

**Publication Date:** Jan. 16, 1996 **Notice of Allowance Date:** Jul. 23, 1996

## Mark Information

**Mark Literal Elements:** ALLEGRA

**Standard Character Claim:** No

**Mark Drawing Type:** 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

## 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 antihistamines

**International Class(es):** 005 - Primary Class **U.S Class(es):** 006, 018, 044, 046, 051, 052

**Class Status:** ACTIVE

**Basis:** 1(a)

**First Use:** Aug. 01, 1996 **Use in Commerce:** Aug. 01, 1996

## Basis Information (Case Level)

| | | |
|---|---|---|
| **Filed Use:** No | **Currently Use:** Yes | **Amended Use:** No |
| **Filed ITU:** Yes | **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:** No | **Currently 66A:** No | |
| **Filed No Basis:** No | **Currently No Basis:** No | |

## Current Owner(s) Information

**Owner Name:** AVENTISUB II INC.

**Owner Address:** 3711 KENNETT PIKE
SUITE 200
GREENVILLE, DELAWARE 19807
UNITED STATES

**Legal Entity Type:** CORPORATION **State or Country Where Organized:** DELAWARE

## Attorney/Correspondence Information

**Attorney of Record**

**Attorney Name:** Susan Upton Douglass **Docket Number:** AVEN-0509160

**Correspondent**

**Correspondent Name/Address:** G MATHEW LOMBARD
LOMBARD & GELIEBTER LLP
305 BROADWAY
FL 7
NEW YORK, NEW YORK 10007
UNITED STATES

**Phone:** 917.779.9967 **Fax:** 646.349.5567

**Correspondent e-mail:** mlombard@lombardIP.com dgeliebter@LombardIP.com ipdocket@LombardIP.com **Correspondent e-mail Authorized:** Yes

**Domestic Representative - Not Found**

## Prosecution History

| Date | Description | Proceeding Number |
|---|---|---|
| Dec. 29, 2014 | TEAS CHANGE OF CORRESPONDENCE RECEIVED | |
| Dec. 23, 2010 | TEAS CHANGE OF CORRESPONDENCE RECEIVED | |
| Jul. 15, 2009 | AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP | |
| Jul. 03, 2007 | REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS) | 66607 |
| Jul. 03, 2007 | REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED | |
| Jul. 03, 2007 | ASSIGNED TO PARALEGAL | 66607 |
| Jun. 01, 2007 | REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED | |
| Jun. 01, 2007 | TEAS SECTION 8 & 9 RECEIVED | |
| Dec. 07, 2006 | CASE FILE IN TICRS | |
| Aug. 23, 2006 | AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP | |
| Aug. 18, 2005 | TEAS CHANGE OF CORRESPONDENCE RECEIVED | |
| Feb. 01, 2005 | TEAS CHANGE OF OWNER ADDRESS RECEIVED | |
| Dec. 12, 2002 | REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK. | |
| Nov. 01, 2002 | REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED | |
| Nov. 01, 2002 | TEAS SECTION 8 & 15 RECEIVED | |
| Sep. 26, 2002 | TEAS CHANGE OF CORRESPONDENCE RECEIVED | |
| Jun. 03, 1997 | REGISTERED-PRINCIPAL REGISTER | |
| Mar. 15, 1997 | ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED | |
| Mar. 06, 1997 | ASSIGNED TO EXAMINER | 72503 |
| Feb. 27, 1997 | STATEMENT OF USE PROCESSING COMPLETE | |
| Sep. 23, 1996 | USE AMENDMENT FILED | |
| Jul. 23, 1996 | NOA MAILED - SOU REQUIRED FROM APPLICANT | |
| May 23, 1996 | NOTICE OF ALLOWANCE CANCELLED | |
| Apr. 09, 1996 | NOA MAILED - SOU REQUIRED FROM APPLICANT | |
| Jan. 16, 1996 | PUBLISHED FOR OPPOSITION | |
| Dec. 15, 1995 | NOTICE OF PUBLICATION | |
| Nov. 28, 1995 | ASSIGNED TO EXAMINER | 72503 |
| Nov. 15, 1995 | APPROVED FOR PUB - PRINCIPAL REGISTER | |
| Nov. 11, 1995 | EXAMINER'S AMENDMENT MAILED | |
| Nov. 03, 1995 | ASSIGNED TO EXAMINER | 72503 |

## Maintenance Filings or Post Registration Information

**Affidavit of Continued Use:** Section 8 - Accepted

**Affidavit of Incontestability:** Section 15 - Accepted

**Renewal Date:** Jun. 03, 2007

## TM Staff and Location Information

**TM Staff Information - None**

**File Location**

**Current Location:** POST REGISTRATION **Date in Location:** Jul. 03, 2007

# Assignment Abstract Of Title Information

**Summary**

**Total Assignments:** 3 **Registrant:** MERRELL PHARMACEUTICALS INC.

## Assignment 1 of 3

**Conveyance:** CHANGE OF NAME

**Reel/Frame:** 1517/0934 **Pages:** 8

**Date Recorded:** Sep. 06, 1996

**Supporting Documents:** No Supporting Documents Available

**Assignor**

**Name:** MERRELL DOW PHARMACEUTICALS, INC. **Execution Date:** Sep. 22, 1995

**Legal Entity Type:** CORPORATION **State or Country Where Organized:** DELAWARE

**Assignee**

**Name:** MERRELL PHARMACEUTICALS INC.

**Legal Entity Type:** CORPORATION **State or Country Where Organized:** DELAWARE

**Address:** 2110 E. GALBRAITH ROAD
CINCINNATI, OHIO 45215

**Correspondent**

**Correspondent Name:** KENNETH C. KOTENBERG

**Correspondent Address:** 2110 E. GALBRAITH ROAD
CINCINNATI, OH 45215

**Domestic Representative - Not Found**

## Assignment 2 of 3

**Conveyance:** MERGER EFFECTIVE 10312005

**Reel/Frame:** 3374/0824 **Pages:** 5

**Date Recorded:** Aug. 22, 2006

**Supporting Documents:** assignment-tm-3374-0824.pdf

**Assignor**

**Name:** MERRELL PHARMACEUTICALS INC. **Execution Date:** Oct. 28, 2005

**Legal Entity Type:** CORPORATION **State or Country Where Organized:** DELAWARE

**Assignee**

**Name:** AVENTIS INC.

**Legal Entity Type:** CORPORATION **State or Country Where Organized:** PENNSYLVANIA

**Address:** 3711 KENNETT PIKE
SUITE 200
GREENVILLE, DELAWARE 19807

**Correspondent**

**Correspondent Name:** MIDGE M. HYMAN

**Correspondent Address:** 1133 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-6799

**Domestic Representative - Not Found**

## Assignment 3 of 3

**Conveyance:** ASSIGNS THE ENTIRE INTEREST

**Reel/Frame:** 4023/0049 **Pages:** 6

**Date Recorded:** Jul. 11, 2009

**Supporting Documents:** assignment-tm-4023-0049.pdf

**Assignor**

**Name:** AVENTIS INC. **Execution Date:** Dec. 31, 2008

**Legal Entity Type:** CORPORATION **State or Country Where Organized:** PENNSYLVANIA

**Assignee**

**Name:** AVENTISUB II INC.

**Legal Entity Type:** CORPORATION

**State or Country Where Organized:** DELAWARE

**Address:** 3711 KENNETT PIKE
SUITE 200
GREENVILLE, DELAWARE 19807

**Correspondent**

**Correspondent Name:** G. MATHEW LOMBARD

**Correspondent Address:** 230 PARK AVENUE
10 FL
NEW YORK, NY 10169

**Domestic Representative - Not Found**

# Proceedings

**Summary**

**Number of Proceedings:** 1

**Type of Proceeding: Opposition**

**Proceeding Number:** 91123016 **Filing Date:** May 22, 2001

**Status:** Terminated **Status Date:** Mar 11, 2003

**Interlocutory Attorney:** ALBERT J ZERVAS

**Defendant**

**Name:** BMC INDUSTRIES, INC.

**Correspondent Address:** MARSHA STOLT
FISH & RICHARDSON
3300 DAIN RAUSCHER PLZ, 60 S SIXTH ST
Minneapolis MN , 55402
UNITED STATES

**Associated marks**

| Mark | Application Status | Serial Number | Registration Number |
|---|---|---|---|
| ALLEGRA | Abandoned - After Inter-Partes Decision | 75806059 | |

**Plaintiff(s)**

**Name:** MERRELL PHARMACEUTICALS INC.

**Correspondent Address:** MIDGE M. HYMAN
COWAN LIEBOWITZ & LATMAN
1133 AVENUE OF THE AMERICAS
New York NY , 10036
UNITED STATES

**Associated marks**

| Mark | Application Status | Serial Number | Registration Number |
|---|---|---|---|
| ALLEGRA | Renewed | 74683534 | 2067728 |

**Prosecution History**

| Entry Number | History Text | Date | Due Date |
|---|---|---|---|
| 1 | FILED AND FEE | May 22, 2001 | |
| 2 | NOTICE AND TRIAL DATES SENT; ANSWER DUE: | May 30, 2001 | Jul 09, 2001 |
| 3 | PENDING, INSTITUTED | May 30, 2001 | |
| 4 | ANSWER | Jul 12, 2001 | |
| 5 | PL'S MOTON ON CONSENT TO EXTEND TRIAL AN D DISCOVERY PERIODS | Dec 17, 2001 | |
| 6 | STIPULATION NOTED AND APPROVED | Feb 13, 2002 | |
| 7 | PL'S MOTION ON CONSENT TO EXT TRIAL AND DISCOVERY PERIODS | Feb 11, 2002 | |
| 8 | P'S MOT FOR EXTEN. OF TIME W/ CONSENT | Apr 15, 2002 | |
| 9 | PL'S MOTION ON CONSENT TO EXT TRIAL AND DISCOVERY PERIODS | Jun 11, 2002 | |
| 10 | SUSPENDED | Aug 13, 2002 | |
| 11 | EXP W/D OF APP | Sep 05, 2002 | |
| 12 | WITHDRAWAL OF APPLICATION | Oct 30, 2002 | |
| 13 | WITHDRAWAL OF APPLICATION | Nov 13, 2002 | |
| 14 | WITHDRAWAL OF APPLICATION WITH CONSENT | Oct 31, 2002 | |

| | | |
|---|---|---|
| 15 | BD'S DECISION: DISMISSED W/O PREJUDICE | Mar 11, 2003 |
| 16 | TERMINATED | Mar 11, 2003 |