

ESTTA Tracking number: **ESTTA752435**

Filing date: **06/15/2016**

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	Fresenius Kabi AG
Granted to Date of previous extension	06/15/2016
Address	Else-Kroener-Strasse 1 Bad Homburg, 61352 GERMANY

Domestic Representative	Scott D. Woldow Smith, Gambrell, Russell, LLP 1055 Thomas Jefferson St. NW, Suite 400 Washington, DC 20007 UNITED STATES swoldow@sgrlaw.com Phone:2022634300
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Applicant Information

Application No	86543079	Publication date	02/16/2016
Opposition Filing Date	06/15/2016	Opposition Period Ends	06/15/2016
Applicant	Actavis, Inc Morris Corporate Center III Parsippany, NJ 07054 UNITED STATES		

Goods/Services Affected by Opposition


<p>Class 005. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Oral, transdermal, injectable and intravaginal contraceptive preparations; intravaginal contraceptive sponge; Hormone replacement therapy preparations; Pharmaceutical preparations for the prevention of preterm birth or pregnancy; Pharmaceutical preparations for the treatment and prevention of urinary incontinence and overactive bladder; Pharmaceutical preparations for the treatment and prevention of iron deficiency and anemia; Pharmaceutical preparations for the treatment and prevention of osteoporosis; Pharmaceutical preparations for the treatment and prevention of endometriosis; Pharmaceutical preparations for the treatment and prevention of symptoms associated with uterine fibroids; Iron chelating pharmaceutical preparations; Fertility enhancing preparations; Pharmaceuticals and medicines for the treatment and prevention of sexual dysfunction; Pharmaceuticals and medicines for the sensory organs; Pharmaceuticals and medicines for the central nervous system; Pharmaceuticals and medicines for the urogenital organs; Pharmaceuticals and medicines for the circulatory systems; Pharmaceuticals and medicines for the treatment of cardiovascular and blood pressure; Pharmaceutical preparations for the treatment and prevention of digestive tract, gastrointestinal and dermatological diseases and disorders; Pharmaceuticals and medicines for the treatment and prevention of irritable bowel syndrome; Pharmaceutical preparations that support, encourage or promote bone strength or bone health or which are used in the treatment of bone disorders or bone diseases; Antibiotics; Antimicrobial preparations for inhibiting</p>
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microbiological decomposition in pharmaceuticals; Pharmaceutical preparations for the prevention and treatment of bacterial infections; Pharmaceutical preparations for the prevention and treatment of diabetes and diabetic neuropathy; Pharmaceutical preparations for the prevention and treatment of pain and neuropathic pain; Pharmaceutical preparations for the prevention and treatment of respiratory system diseases and disorders; Pharmaceutical preparations for the prevention and treatment of neurological diseases and disorders; Pharmaceutical preparations for the prevention and treatment of neurodegenerative diseases and disorders; Pharmaceutical preparations for the prevention and treatment of peripheral nervous system diseases and disorders; Pharmaceutical preparations for the prevention and treatment of hypertension; Pharmaceutical preparations for the prevention and treatment of Alzheimer's disease, dementia, AIDS-related dementia, CNS, neurological disorders, neurodegenerative disorders, and depression, Pharmaceutical preparations, namely, neuroprotective agents for treating and preserving brain function and structure; antidepressants; antipsychotics; coronary vasodilating agents; Pharmaceutical preparations for the treatment of hypothyroidism

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.	4792495	Application Date	06/23/2014
Registration Date	08/18/2015	Foreign Priority Date	NONE
Word Mark	PRONEO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 010. First use: First Use: 0 First Use In Commerce: 0 Medical devices for the administration of enteral nutrition, liquids and medications, namely, feeding tubes, extension tubes and accessories, namely, enteral syringes and adapters to connect enteral syringes, enteral cannulas and sampling straws, adapters for milk and baby bottles, and medication bottles		

Attachments	79152803#TMSN.png(bytes) TM1.PDF(202614 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	/SW/
Name	Scott D. Woldow
Date	06/15/2016

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

In the Matter of Trademark Application Serial No. 86/543079
Published: February 16, 2016

Fresenius Kabi AG)	
)	
)	
Opposer,)	
)	
v.)	Opposition No. _____
)	
)	
Actavis, Inc)	
)	
Applicant.)	

NOTICE OF OPPOSITION

In the matter of the application of Actavis, Inc., for registration of the mark PRONEO, filed on February 23, 2015, application Serial No. 86/543079, published in the Official Gazette on February 16, 2016, Fresenius Kabi AG believes that it will be damaged by registration of the mark identified by trademark application Serial No. 86/543079, and hereby opposes registration.

Fresenius Kabi AG (hereinafter "Registrant" or "Opposer"), an Aktiengesellschaft of the Federal Republic of Germany, having offices located at Else-Kroener-Strasse 1, Bad Homburg,

D-61352, Germany, believes that it will be damaged by registration of the PRONEO trademark identified by Application Serial No. 86/543079 and hereby opposes the same.

The grounds for opposition are as follows:

1. Opposer is now and has been engaged in the health care industry.
2. Opposer offers health care products and services.
3. Opposer manufactures medical devices, nutrition products, dialysis devices and pharmaceutical preparations.
4. Opposer filed a PRONEO trademark application on June 23, 2014.
5. The PRONEO trademark application matured into United States Registration No. 4,792,495, and registered on August 18, 2015, in association with “medical devices for the administration of enteral nutrition, liquids and medications, namely, feeding tubes, extension tubes and accessories, namely, enteral syringes and adapters to connect enteral syringes, enteral cannulas and sampling straws, adapters for milk and baby bottles, and medication bottles,” in International Class 5.
6. Opposer’s ownership of United States Trademark Registration No. 4,792,495, has been valid and continuous and has not been abandoned.
7. Opposer’s mark is symbolic of extensive goodwill and consumer recognition.
8. On February 23, 2015, Applicant filed a United States trademark application for the mark PRONEO in Standard Characters.
9. The aforesaid trademark application was assigned United States Application Serial No. 86/543079.

10. United States Application Serial No. 86/543079 was approved for publication in association with:

Oral, transdermal, injectable and intravaginal contraceptive preparations; intravaginal contraceptive sponge; Hormone replacement therapy preparations; Pharmaceutical preparations for the prevention of preterm birth or pregnancy; Pharmaceutical preparations for the treatment and prevention of urinary incontinence and overactive bladder; Pharmaceutical preparations for the treatment and prevention of iron deficiency and anemia; Pharmaceutical preparations for the treatment and prevention of osteoporosis; Pharmaceutical preparations for the treatment and prevention of endometriosis; Pharmaceutical preparations for the treatment and prevention of symptoms associated with uterine fibroids; Iron chelating pharmaceutical preparations; Fertility enhancing preparations; Pharmaceuticals and medicines for the treatment and prevention of sexual dysfunction; Pharmaceuticals and medicines for the sensory organs; Pharmaceuticals and medicines for the central nervous system; Pharmaceuticals and medicines for the urogenital organs; Pharmaceuticals and medicines for the circulatory systems; Pharmaceuticals and medicines for the treatment of cardiovascular and blood pressure; Pharmaceutical preparations for the treatment and prevention of digestive tract, gastrointestinal and dermatological diseases and disorders; Pharmaceuticals and medicines for the treatment and prevention of irritable bowel syndrome; Pharmaceutical preparations that support, encourage or promote bone strength or bone health or which are used in the treatment of bone disorders or bone diseases; Antibiotics; Antimicrobial preparations for inhibiting

microbiological decomposition in pharmaceuticals; Pharmaceutical preparations for the prevention and treatment of bacterial infections; Pharmaceutical preparations for the prevention and treatment of diabetes and diabetic neuropathy; Pharmaceutical preparations for the prevention and treatment of pain and neuropathic pain; Pharmaceutical preparations for the prevention and treatment of respiratory system diseases and disorders; Pharmaceutical preparations for the prevention and treatment of neurological diseases and disorders; Pharmaceutical preparations for the prevention and treatment of neurodegenerative diseases and disorders; Pharmaceutical preparations for the prevention and treatment of peripheral nervous system diseases and disorders; Pharmaceutical preparations for the prevention and treatment of hypertension; Pharmaceutical preparations for the prevention and treatment of Alzheimer's disease, dementia, AIDS-related dementia, CNS, neurological disorders, neurodegenerative disorders, and depression, Pharmaceutical preparations, namely, neuroprotective agents for treating and preserving brain function and structure; antidepressants; antipsychotics; coronary vasodilating agents; Pharmaceutical preparations for the treatment of hypothyroidism.

11. Applicant's PRONEO mark is identical to Registrant's PRONEO trademark.

12. Applicant's PRONEO mark in connection with the goods set forth in its application, is confusingly similar to Opposer's mark, as set forth and protected by Opposer's above-identified registration.

13. Purchasers of Applicant's goods, and Opposer's goods, are likely to be confused, mistaken or deceived as to the source of the goods. Applicant's mark, in association with the

products identified in the trademark application is likely to cause confusion, mistake or deception when compared to Opposer's mark.

14. The marks are identical in sound and appearance such that when used on highly similar goods there is a likelihood of confusion, mistake or deception.

15. Applicant alleges a bona fide intent to use its mark in commerce in association with a wide variety of goods. Opposer's trademark registration identifies highly similar goods. The nature of the goods accentuates the similarity between the marks and exacerbates the likelihood of confusion regarding the marks and the likelihood of confusion as to sponsorship or affiliation.

16. If Applicant uses and is allowed to register its mark, PRONEO, for the goods specified in the trademark application, there will be confusion in the trade resulting in damage and injury to Opposer.

17. The Opposer's goods and the Applicant's goods are likely to be used in the same hospitals or medical facilities.

18. The Opposer's goods, and the Applicant's goods, are likely to be used by the same professionals in the healthcare field, or by the same consumers seeking healthcare or medical goods and services.

19. The conditions surrounding the marketing of the goods set forth in Registration No. 4,792,495 and Application No. 86/543079 are such that they are likely to be encountered by the same purchasers under the same or similar circumstances that could give rise to the mistaken belief that the goods come from a common source.

20. Persons familiar with the Opposer's mark would be likely to confuse Applicant's goods as products made, sold, or sponsored by Opposer. Any such confusion in the trade would inevitably result in loss of sales to the Opposer.

21. In addition to the harm identified in the preceding paragraphs, any defect, objection or fault found with Applicant's products marketed under the PRONEO mark would necessarily reflect badly upon and significantly injure the reputation which the Opposer has established for its products.

22. Members of the healthcare profession, patient community and general public familiar with Opposer's products, upon encountering Applicant's products, are likely to be confused or mistaken as to whether Applicant's products emanate from the Opposer or from a source connected with the Opposer, potentially resulting in serious injury.

23. United States Patent and Trademark Office electronic database information showing the current status and title of United States Trademark Registration No. 4,792,495 is attached hereto as Exhibit A and is made part of the record.

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's mark, and prays that registration be denied.

A fee is submitted herewith. Please charge Deposit Account No. 02-4300 for any additional fees that may be required.

Respectfully submitted,

SMITH, GAMBRELL & RUSSELL, LLP

/SW/

Scott D. Woldow
Attorney for Opposer

Smith, Gambrell & Russell
1055 Thomas Jefferson St. NW, Suite 400
Washington, DC 20007
Telephone: (202) 263-4300
Facsimile: (202) 263-4329
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Date: June 15, 2016

EXHIBIT A

Generated on: This page was generated by TSDR on 2016-06-14 11:11:57 EDT

Mark: PRONEO

ProNeo

US Serial Number: 79152803

Application Filing Date: Jun. 23, 2014

US Registration Number: 4792495

Registration Date: Aug. 18, 2015

Register: Principal

Mark Type: Trademark

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

Status Date: Aug. 18, 2015

Publication Date: Jun. 02, 2015

Mark Information

Mark Literal Elements: PRONEO

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

Related Properties Information

International Registration Number: 1002860

International Registration Date: Mar. 23, 2009

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: Medical devices for the administration of enteral nutrition, liquids and medications, namely, feeding tubes, extension tubes and accessories, namely, enteral syringes and adapters to connect enteral syringes, enteral cannulas and sampling straws, adapters for milk and baby bottles, and medication bottles

International Class(es): 010 - Primary Class

U.S Class(es): 026, 039, 044

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: Fresenius Kabi AG

Owner Address: Else-Kröner-Str. 1
61352 Bad Homburg
GERMANY

Legal Entity Type: aktiengesellschaft

State or Country GERMANY
Where Organized:

Attorney/Correspondence Information

Attorney of Record - None

Correspondent

Correspondent Name/Address: FRESENIUS SE & CO. KGAA
LEGAL DEPT-TRADEMARKS
ELSE-KRÖNER-STR 1
61352 BAD HOMBURG
GERMANY

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Feb. 20, 2016	FINAL DECISION TRANSACTION PROCESSED BY IB	
Feb. 03, 2016	FINAL DISPOSITION NOTICE SENT TO IB	
Feb. 03, 2016	FINAL DISPOSITION PROCESSED	68359
Nov. 18, 2015	FINAL DISPOSITION NOTICE CREATED, TO BE SENT TO IB	
Aug. 18, 2015	REGISTERED-PRINCIPAL REGISTER	
Jun. 02, 2015	PUBLISHED FOR OPPOSITION	
Jun. 01, 2015	NOTIFICATION PROCESSED BY IB	
May 13, 2015	NOTIFICATION OF POSSIBLE OPPOSITION SENT TO IB	
May 13, 2015	NOTICE OF START OF OPPOSITION PERIOD CREATED, TO BE SENT TO IB	
May 13, 2015	NOTICE OF PUBLICATION	
Apr. 24, 2015	LAW OFFICE PUBLICATION REVIEW COMPLETED	76568
Apr. 21, 2015	APPROVED FOR PUB - PRINCIPAL REGISTER	
Apr. 09, 2015	TEAS/EMAIL CORRESPONDENCE ENTERED	76568
Apr. 09, 2015	CORRESPONDENCE RECEIVED IN LAW OFFICE	76568
Apr. 09, 2015	ASSIGNED TO LIE	76568
Apr. 02, 2015	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Oct. 23, 2014	REFUSAL PROCESSED BY IB	
Oct. 10, 2014	APPLICATION FILING RECEIPT MAILED	
Oct. 09, 2014	NON-FINAL ACTION MAILED - REFUSAL SENT TO IB	
Oct. 09, 2014	REFUSAL PROCESSED BY MPU	72629
Oct. 08, 2014	NON-FINAL ACTION (IB REFUSAL) PREPARED FOR REVIEW	
Oct. 07, 2014	NON-FINAL ACTION WRITTEN	78326
Oct. 06, 2014	ASSIGNED TO EXAMINER	78326
Oct. 06, 2014	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Oct. 02, 2014	SN ASSIGNED FOR SECT 66A SUBSEQ DESIG FROM IB	

International Registration Information (Section 66a)

International Registration Number: 1002860

International Registration Date: Mar. 23, 2009

Intl. Registration Status: REQUEST FOR EXTENSION OF PROTECTION PROCESSED

Date of International Registration Status: Oct. 02, 2014

Notification of Designation Date: Oct. 02, 2014

Date of Automatic Protection: Apr. 02, 2016

International Registration: Mar. 23, 2019

Renewal Date:

First Refusal Flag: Yes

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Aug. 18, 2015



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ProNeo

Word Mark PRONEO

Goods and Services IC 010. US 026 039 044. G & S: Medical devices for the administration of interal nutrition, liquids and medications, namely, feeding tubes, extension tubes and accessories, namely, enteral syringes and adapters to connect enteral syringes, enteral cannulas and sampling straws, adapters for milk and baby bottles, and medication bottles

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 79152803

Filing Date June 23, 2014

Current Basis 66A

Original Filing Basis 66A

Published for Opposition June 2, 2015

Registration Number 4792495

International Registration Number 1002860

Registration Date August 18, 2015

Owner (REGISTRANT) Fresenius Kabi AG aktiengesellschaft FED REP GERMANY Else-Kröner-Str. 1 61352 Bad Homburg FED REP GERMANY

Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead
Indicator LIVE

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Attorney Docket No.
034618.019Opp

TRADEMARK

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

In the Matter of Trademark Application Serial No. 86/543079
Published: February 16, 2016

Fresenius Kabi AG

Opposer,

v.

Actavis, Inc.

Applicant.

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Opposition No. _____

CERTIFICATE OF SERVICE

I, Scott D. Woldow, counsel for Fresenius Kabi AG, hereby certifies that the **Notice of Opposition** was served upon applicant by placing a copy of same in the U.S. mail, postage prepaid, addressed as follows:

Matthew Brady
Actavis Inc
400 Interpace Pkwy
Parsippany, New Jersey 07054-1120

This 15th day of June, 2016



Scott D. Woldow