

ESTTA Tracking number: **ESTTA859249**

Filing date: **11/17/2017**

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

Proceeding	91237171
Party	Defendant AstraZeneca AB
Correspondence Address	WM. CHARLES SAUNDERS ASTRAZENECA PHARMACEUTICALS LP 1800 CONCORD PIKE FOP3-318 WILMINGTON, DE 19850-5437 Email: trademarks@astrazeneca.com, chuck.saunders@astrazeneca.com, paula.wright@astrazeneca.com
Submission	Answer and Counterclaim
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Signature	/David M. Kelly/
Date	11/17/2017
Attachments	Answer and Counterclaim - FASENRA.pdf(76259 bytes)

Registration Subject to the filing

Registration No.	2902272	Registration date	11/09/2004
Registrant	JAZZ PHARMACEUTICALS INTERNATIONAL III LIMITED 2 CHURCH STREET CLARENDON HOUSE HAMILTON, HM11 BERMUDA		

Goods/Services Subject to the filing

Class 005. First Use: 2004/07/21 First Use In Commerce: 2004/07/21
All goods and services in the class are requested, namely: Pharmaceutical preparations

Grounds for Cancellation

Abandonment	Trademark Act Section 14(3)
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respect to the numbered Paragraphs in the Notice of Opposition, Applicant answers as follows:

ANSWER

1. Applicant admits that on August 5, 2016, it filed Application No. 87128498 under Sections 1(b) and 44(d) of the Lanham Act for the FASENRA Mark for “pharmaceutical preparations and substances” in Class 5. Applicant further admits that in response to the Examining Attorney’s November 17, 2016 office action, Applicant amended the identification of goods and services in Application No. 87128498 to “Pharmaceutical preparations and substances for use in oncology; Pharmaceutical preparations and substances for the treatment of cardiovascular diseases and disorders, metabolic diseases and disorders, respiratory diseases and disorders, gastrointestinal diseases and disorders, nervous system diseases and disorders, infection and inflammation” in Class 5. Applicant denies the remaining allegations in Paragraph 1.

2. Applicant admits that it filed a post-publication amendment to Application No. 87128498 on October 3, 2017 to amend the identification of goods and services to “pharmaceutical preparations and substances for use in the treatment of respiratory diseases and disorders” in Class 5. Applicant denies, and does not adopt, Opposer’s defined term “Applicant’s Proposed FASENRA Mark.”

3. Applicant denies, and does not adopt, Opposer’s defined term “Applicant’s Proposed FASENRA Mark.” Applicant admits the remaining allegations in Paragraph 3 with respect to the FASENRA mark.

4. Applicant lacks sufficient information to form a belief as to the truth of the allegations in Paragraph 4 of the Notice of Opposition, and therefore denies them.

5. Applicant admits that it seeks to register the FASENRA Mark for “pharmaceutical preparations and substances for use in the treatment of respiratory diseases and disorders” in Class 5. Applicant denies the remaining allegations in Paragraph 5.

6. Applicant lacks sufficient information to form a belief as to the truth of the allegations in Paragraph 6 of the Notice of Opposition, and therefore denies them.

7. Applicant denies the allegations in Paragraph 7.

8. Applicant admits that according to the USPTO’s online records U.S. Registration No. 2902272 issued on November 9, 2004, with a claimed date of first use of July 21, 2004. Applicant denies the remaining allegations in Paragraph 8.

9. Applicant admits that according to the USPTO’s online records U.S. Registration No. 3146363 issued on September 19, 2006, with a claimed date of first use of July 31, 2004. Applicant denies the remaining allegations in Paragraph 9.

10. Applicant admits that what appear to be copies of Registration Nos. 2902272 and 3146363, which speak for themselves, are attached to the Notice of Opposition as Exhibit A. Applicant denies that Opposer is the owner of Registration Nos. 2902272 and 3146363.

11. Applicant lacks sufficient information to form a belief as to the truth of the allegations in Paragraph 11 of the Notice of Opposition, and therefore denies them.

12. Applicant lacks sufficient information to form a belief as to the truth of the allegations in Paragraph 12 of the Notice of Opposition, and therefore denies them.

13. Applicant lacks sufficient information to form a belief as to the truth of the allegations in Paragraph 13 of the Notice of Opposition, and therefore denies them.

14. Applicant denies the allegations in Paragraph 14.

15. Applicant denies the allegations in Paragraph 15.

16. Applicant admits that the letters “FA” are the first two letters in FASENRA and FAZACLO. Applicant denies the remaining allegations in Paragraph 16.

17. Applicant admits that FASENRA and FAZACLO both have three syllables and that both have the letter sequence “consonant, vowel, consonant, vowel, consonant, consonant, and vowel,” but denies that that is determinative or relevant to the issues in this proceeding. Applicant denies the remaining allegations in Paragraph 17.

18. Applicant denies the allegations in Paragraph 18.

19. Applicant denies the allegations in Paragraph 19.

20. Applicant admits that medication errors can pose serious risks, but Applicant denies that there is a likelihood of confusion or actual consumer confusion between FASENRA and FAZACLO and therefore denies the remaining allegations in Paragraph 20.

21. Applicant denies the allegations in Paragraph 21.

22. Applicant denies the allegations in Paragraph 22.

23. Applicant denies all allegations contained in Opposer’s request for relief and further denies that Opposer is entitled to any of the relief requested.

AFFIRMATIVE ALLEGATIONS, AMPLIFICATION OF DENIALS, & COUNTERCLAIM

24. On November 14, 2017, the U.S. Food and Drug Administration (“FDA”) granted Applicant approval to market FASENRA (benralizumab), a medicine for the treatment of respiratory diseases and disorders, namely, add-on maintenance treatment of patients with severe asthma aged 12 years and older, and with an eosinophilic phenotype.

25. The pleaded marks comprised of or containing FAZACLO coexist with various third-party FAS-formative and FAZ-formative marks that are on the Register and/or have been allowed in connection with pharmaceutical products including, but not limited to, the marks shown below. These coexisting marks include Applicant’s own prior-used and prior-registered mark FASLODEX (Reg. Nos. 1749766 and 2303455) for pharmaceutical preparations and substances for the treatment of cancer.

Mark	Reg. No./App. No. Reg. Date/Filing Date First Use/Allowance Date First Use in Commerce	Goods and Services
FASLODEX	2303455 12-28-1999 (44E Basis)	Pharmaceutical preparations for the treatment of cancer in Class 5
FASLODEX	1749766 02-02-1993 (44E Basis)	Human pharmaceutical preparations and substances for treatment of cancer
FASINSULIN	4491921 03-04-2014 07-10-2013 07-12-2013	Pharmaceutical products for treating and preventing endothelial dysfunction using insulin in powder, tablet or rapid dissolving tablet in Class 5
FASCILIREN	86685528 07-07-2015 01-19-2016	Pharmaceutical preparations for the treatment of cardiovascular, central nervous system, endocrine, gastrointestinal, genetic, immunological, infectious, inflammatory, menopausal, metabolic, autoimmune, musculoskeletal, neurological,

Mark	Reg. No./App. No. Reg. Date/Filing Date First Use/Allowance Date First Use in Commerce	Goods and Services
		ophthalmological, psychiatric, respiratory, urogenital, urological and viral diseases and disorders; pharmaceutical preparations for the treatment of erectile dysfunction, sexual dysfunction, cancer, pain and diabetes; pharmaceutical preparations for use in hematology; pharmaceutical preparations, namely, antifungal preparations, dermatological preparations, smoking cessation preparations, and tissue repair preparations; vaccines for human use in Class 5
FASONSIA	5144041 02-21-2017 (66A Basis)	Pharmaceutical preparations for the treatment of diabetes in Class 5
FASILITO	4277864 01-22-2013 (66A Basis)	Pharmaceutical preparations, namely, pharmaceutical preparations for the treatment of diseases and disorders of the alimentary tract and metabolism, and blood and blood forming organs; pharmaceutical preparations for the treatment of diseases and disorders of the cardiovascular system, musculoskeletal system, central nervous system, peripheral nervous system, genitourinary system and respiratory system; and pharmaceutical preparations for the treatment of dermatological, hormonal, infectious, viral and oncological diseases and disorders in Class 5
FAZETA	87153451 08-29-2016 02-28-2017	Human pharmaceutical preparations for the prevention and treatment of viral diseases, auto-immune and inflammatory diseases, cardiovascular diseases, central nervous system diseases, pain, dermatologic diseases, gastro-intestinal diseases, infectious-related diseases, metabolic diseases, oncologic diseases, ophthalmic

Mark	Reg. No./App. No. Reg. Date/Filing Date First Use/Allowance Date First Use in Commerce	Goods and Services
		diseases, and respiratory diseases in Class 5
FAZRIO	86517054 01-28-2015 08-18-2015	Pharmaceutical preparations for the treatment of migraine
FAZINATE	4047889 11-01-2011 (44E Basis)	Pharmaceutical preparations for the treatment of facial volume deficits, wrinkles, aging signs and scars in Class 5
FAZITRIM	4242855 11-13-2012 08-01-2012 08-01-2012	Dietary and nutritional supplements in the form of capsules, patches, oils, creams, and gels for weight loss purposes in Class 5

26. Applicant's FASENRA Mark and Opposer's FAZACLO marks are used in connection with different pharmaceutical preparations and substances, namely, the treatment of respiratory diseases and disorders on the one hand, and the treatment of schizophrenia on the other.

27. Applicant's FASENRA Mark is dissimilar in overall sound, appearance, connotation, and commercial impression to Opposer's FAZACLO marks.

28. For the reasons noted above, among others, confusion is unlikely.

**COUNTERCLAIM FOR PARTIAL CANCELLATION AND RESTRICTION
OF PLEADED REGISTRATION NO. 2902272
UNDER SECTION 18, 15 U.S.C. § 1068**

29. Applicant repeats and realleges each and every denial and allegation set forth above.

30. As alleged above, Applicant denies that Opposer is the owner of pleaded Registration No. 2902272 (the "272 Registration"). However, to the extent Opposer did

own the '272 Registration at the time this Opposition was filed, Applicant asserts this counterclaim for partial cancellation of the '272 Registration for the mark FAZACLO in Class 5, under Trademark Act Section 18, 15 U.S.C. § 1068.

31. As alleged above, Applicant asserts that there is no likelihood of confusion, mistake, or deception between the FASENRA and FAZACLO marks. However, Applicant submits that any alleged likelihood of confusion (which Applicant denies) will be avoided if the '272 Registration for the mark FAZACLO for “pharmaceutical preparations” in Class 5 is restricted and narrowed under Trademark Act Section 18, 15 U.S.C. § 1068 as set forth below.

32. The identification of goods in the '272 Registration for the mark FAZACLO reads: “pharmaceutical preparations” in Class 5. This identification of goods is overbroad and is no longer permitted by the USPTO.

33. On February 10, 2004, the FDA granted Alamo Pharmaceuticals, LLC (which, on information and belief, is a predecessor-in-interest or related company of Opposer) approval to market FAZACLO, a medicine for the management of severely ill schizophrenic patients who fail to respond adequately to standard drug treatment for schizophrenia.

34. Opposer does not now and has never used the FAZACLO mark in commerce in connection with *all* types of “pharmaceutical preparations” in Class 5. Rather, Opposer’s use of the FAZACLO mark in connection with pharmaceutical preparations is limited to Opposer’s atypical antipsychotic prescription medicine for treatment-resistant schizophrenia and reducing suicidal behavior in patients with schizophrenia or schizophrenia disorder.

35. Consistent with this limited use of the FAZACLO mark for the treatment of schizophrenia, the pleaded registration for the FAZACLO (CLOZAPINE, USP) ORALLY DISINTEGRATING TABLETS & Design mark (Reg. No. 3146363) (the “FAZACLO Design Mark”) covers only “Pharmaceutical preparations for the treatment of schizophrenia” in Class 5. On April 30, 2004 (after publication and allowance of the FAZACLO word mark), Opposer’s predecessor and/or related company applied to register the FAZACLO Design Mark for “pharmaceutical preparations” in Class 5. On November 29, 2004, the Examining Attorney issued an office action refusing registration of the FAZACLO Design Mark on the grounds that the identification of goods and services needed clarification because “it fails to indicate the application of the pharmaceutical preparations or the condition(s) they are intended to treat.” The Examining Attorney stated that “Applicant may adopt the following identification of goods, if accurate: Class 5: ‘Pharmaceutical preparations for the treatment of <specify>.’” On May 19, 2005, Opposer’s predecessor and/or related company responded to that office action and amended the identification of goods to “pharmaceutical preparations for the treatment of schizophrenia.”

36. Accordingly, the ‘272 Registration for the mark FAZACLO should be cancelled in part in the nature of an amendment and restriction to the identification of goods in Class 5 to read: “Pharmaceutical preparations **for the treatment of schizophrenia.**”

37. Applicant submits that entry of the above amendment and restriction will avoid any alleged likelihood of confusion (which Applicant denies) between the FASENRA and FAZACLO marks.

WHEREFORE, Applicant prays that this opposition be dismissed with prejudice, and that Applicant's counterclaim be granted.

The filing fee for Applicant's Counterclaim should be charged to Deposit Account No. 506154.

Respectfully submitted,

Dated: November 17, 2017

By: /s/ David M. Kelly

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CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing APPLICANT'S ANSWER AND COUNTERCLAIM was served by e-mail this 17th day of November, 2017, upon counsel for Applicant at the following:

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