

ESTTA Tracking number: **ESTTA853011**

Filing date: **10/18/2017**

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	Takeda Pharmaceuticals U.S.A., Inc.		
Entity	Corporation	Citizenship	Delaware
Address	One Takeda Parkway Deerfield, IL 60015 UNITED STATES		

Attorney information	Mark I. Peroff WILSON KEADJIAN BROWNDORF LLP 114 W. 47th Street - 18th Floor New York, NY 10036 UNITED STATES Email: Docketing@wkbllp.com, mark.peroff@wkbllp.com Phone: 212-913-0398		
----------------------	---	--	--

Applicant Information

Application No	87440551	Publication date	09/19/2017
Opposition Filing Date	10/18/2017	Opposition Period Ends	10/19/2017
Applicant	Great Lakes Pharmaceuticals, Inc. 1140 us hwy 287, suite 400 1140 us hwy 287, suite 400 broomfield, CO 80020 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: Saline solution for medical purposes; Mixed antibiotic preparations
--

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
Dilution by tarnishment	Trademark Act Sections 2 and 43(c)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	1685731	Application Date	08/23/1990
Registration Date	05/05/1992	Foreign Priority Date	NONE
Word Mark	PREVACID		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 005. First use: First Use: 1991/10/02 First Use In Commerce: 1991/10/02 pharmaceutical preparation; namely, an anti-ulcer preparation

Attachments	PREVACID Opposition - Final.pdf(93226 bytes)
-------------	---

Signature	/Mark I. Peroff/
Name	Mark I. Peroff
Date	10/18/2017

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

Takeda Pharmaceuticals U.S.A., Inc.,)	U.S. Trademark Application Serial No. 87/440,551
)	
Opposer,)	Mark: PREVACEPT
)	
v.)	Opposition No.: _____
)	
Great Lakes Pharmaceuticals, Inc.,)	
)	
Applicant.)	
)	

NOTICE OF OPPOSITION

Takeda Pharmaceuticals U.S.A., Inc., a Delaware corporation, having a principal place of business at One Takeda Parkway, Deerfield, Illinois 60015 ("Opposer"), believes it will be damaged by the registration of the mark "PrevaCept" that is the subject of U.S. Trademark Application Serial No. 87/440,551 (the "Application") and hereby opposes registration of same under Section 13 of the Trademark Act, 15 U.S.C. §1063. In support of its opposition, Opposer states the following:

1. Opposer is the U.S. subsidiary of a worldwide leader in the development, manufacture, marketing, and distribution of pharmaceuticals.
2. Opposer is the registered owner of all right, title, and interest in and to the trademark PREVACID used in conjunction with pharmaceutical preparations, namely, an antiulcer preparation.
3. Opposer has used its PREVACID mark in conjunction with pharmaceutical preparations, namely, an anti-ulcer preparation, in the United States since at least as early as, 1991.
4. Opposer has devoted significant amounts of time and resources to the marketing and sale of its goods bearing the PREVACID mark.
5. Opposer has made extensive and continuous sales of its goods bearing the PREVACID mark since the date of first use
6. The purchasing public has come to exclusively associate the term PREVACID with Opposer as a result of its marketing efforts and long-standing use of the PREVACID mark in conjunction with pharmaceutical preparations, namely, an anti-ulcer preparation.

7. Opposer has developed exceedingly valuable goodwill in PREVACID as a mark in the pharmaceutical field as a result of its marketing efforts and long-standing use of the PREVACID mark in conjunction with pharmaceutical preparations, namely, an anti-ulcer preparation.

8. Opposer is the owner of all right, title, and interest in and to U.S. Trademark Registration No. 1,685,731, for the mark PREVACID registered on May 5, 1992 (the "Registration") covering pharmaceutical preparations, namely, an anti-ulcer preparation.

9. The Registration is incontestable pursuant to Section 15 of the Lanham Act, 15 U.S.C. §1065 and constitutes conclusive evidence of the validity of the registered mark, of Opposer's ownership of the mark, and of Opposer's exclusive right to use the mark in commerce on or in connection with the goods specified in the Registration.

10. There is no issue as to priority of use because of Opposer's ownership of U.S. registration no. 1,685,731 which is incontestable.

11. Applicant's mark PrevaCept is so similar in sound and appearance to Opposer's PREVACID mark as to be likely to cause confusion, mistake, or deception as applied to parties's goods.

12. The goods covered in the application being opposed are closely related to the goods sold Opposer's under its PREVACID mark.

13. Upon information and belief, the goods covered by the Applicant in the opposed application and Opposer's goods sold under the PREVACID mark travel through the same channels of trade to the same end users.

14. Opposer will be damaged by registration of the PrevaCept mark because such use would be likely to cause confusion or mistake or to deceive as to the affiliation, connection, or association of Applicant with Opposer and as to the origin, sponsorship, and approval of Applicant's Goods by Opposer.

15. Such confusion is likely to cause irreparable harm to Opposer in that any defects or fault found with Applicant's Goods would erroneously be attributed to Opposer, thereby harming Opposer's reputation and damaging its substantial goodwill in the PREVACID mark.

15. Opposer's PREVACID mark is famous within the meaning of Section 43(c)(2)(A) of the Trademark Act, 15 U.S.C. § 1125(c)(2)(A).

16. Opposer's PREVACID mark was famous prior to Applicant's filing of the Application.

17. Applicant's registration and use of the PrevaCept mark in connection with Applicant's Goods is likely to cause dilution of Opposer's famous PREVACID mark, by blurring or tarnishing within the meaning of the Trademark Act.

For all the foregoing reasons, Opposer will be damaged by the registration of the mark PREVACEPT sought to be registered by Applicant.

WHEREFORE, Opposer respectfully requests that the TTAB deny registration of Applicant's PREVACEPT mark sought through the Application.

Respectfully submitted,

 /Mark I. Peroff/
Mark I. Peroff
Michael A. Peroff
WILSON KEADJIAN BROWNDORF LLP
114 W. 47th Street
Suite 1810
New York, New York 10036
Telephone: (212) 913-0398
Email: mark.peroff@wkbllp.com
Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing "Notice of Opposition" has been served on Applicant, Great Lakes Pharmaceuticals, Inc., via first class mail, today October 17, 2017.

/Mark I. Peroff/
Mark I. Peroff