

ESTTA Tracking number: **ESTTA880246**

Filing date: **02/28/2018**

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	Shire International Licensing BV
Granted to Date of previous extension	02/28/2018
Address	Strawinskylaan 659 Amsterdam, 1077 XX NETHERLANDS

Attorney information	Karl M. Zielaznicki, Esq. Troutman Sanders LLP 875 Third Avenue New York, NY 10022 UNITED STATES Email: IPServicesNYC@troutmansanders.com, eliza.cen@troutmansanders.com, karl.zielaznicki@troutmansanders.com Phone: 2127046125
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Applicant Information

Application No	87500669	Publication date	10/31/2017
Opposition Filing Date	02/28/2018	Opposition Period Ends	02/28/2018
Applicant	Sabinsa Corporation Sabinsa Corporation 20 Lake Drive EAST WINDSOR, NJ 08520 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: Dietary and nutritional supplements; Dietary and nutritional supplements used for weight loss; Dietary food supplements; Dietary supplements; Dietary supplements for human consumption; Dietary supplements for humans and animals; Natural dietary supplements; Nutraceuticals for use as a dietary supplement

Grounds for Opposition


Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols, or brings them into contempt, or disrepute	Trademark Act Section 2(a)

Deceptiveness	Trademark Act Section 2(a)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2687871	Application Date	08/28/2000
Registration Date	02/18/2003	Foreign Priority Date	04/03/2000
Word Mark	FOSRENOL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 0 First Use In Commerce: 0 PHARMACEUTICAL PREPARATIONS AND SUBSTANCES FOR THE TREATMENT OF HYPERPHOSPHATAEMIA, KIDNEY DISEASE AND DISORDERS [AND OSTEOPOROSIS]		

U.S. Registration No.	2978995	Application Date	07/03/2003
Registration Date	07/26/2005	Foreign Priority Date	NONE
Word Mark	F FOSRENOL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 2004/12/16 First Use In Commerce: 2004/12/16 Pharmaceutical preparations and substances for the treatment of hyperphosphataemia, kidney disease and disorders, [andosteoporosis]		

U.S. Registration No.	3686093	Application Date	05/15/2009
Registration Date	09/22/2009	Foreign Priority Date	NONE
Word Mark	F FOSRENOL		
Design Mark			
Description of	The mark consists of the word "FOSRENOL", which appears to the right of a		

Mark	fanciful letter "f" which is presented in a shaded oval.
Goods/Services	Class 005. First use: First Use: 2004/12/16 First Use In Commerce: 2004/12/16 Pharmaceutical preparations and substances for the treatment of hyperphosphataemia, kidney disease and disorders

Attachments	76118066#TMSN.png(bytes) 78270561#TMSN.png(bytes) 77738155#TMSN.png(bytes) NOPFORCINOLDocument_02282018_144255.pdf(143043 bytes)
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Signature	/kmz/
Name	Karl M. Zielaznicki, Esq.
Date	02/28/2018

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

SHIRE INTERNATIONAL LICENSING BV,	X	
	:	
Opposer,	:	Opposition No.
	:	
SABINSA CORPORATION,	:	Serial No. 87500669
	:	
Applicant.	:	Filing Date: June 22, 2017
	X	

NOTICE OF OPPOSITION

Opposer, Shire International Licensing BV ("Opposer" or "Shire"), a Netherlands corporation, having a business address at Strawinskylaan 659, Amsterdam, 1077 XX, Netherlands believes that it will be damaged by the registration of Application Serial No. 87500669 filed on June 22, 2017 seeking registration of the mark FORCINOL-G for "Dietary and nutritional supplements; Dietary and nutritional supplements used for weight loss; Dietary food supplements; Dietary supplements; Dietary supplements for human consumption; Dietary supplements for humans and animals; Natural dietary supplements; Nutraceuticals for use as a dietary supplement" in Class 5 ("Applicant's Goods") and having been previously granted an extension of time to oppose, hereby opposes the foregoing application.

As grounds for opposition, it is alleged:

1. Shire is the owner of the following US Trademark Registrations for its FOSRENOL marks (the “FOSRENOL Marks”):

MARK	REGISTRATION NO.	REGISTRATION DATE
FOSRENOL	2687871	February 16, 2003
F FOSRENOL and design	2978995	July 26, 2005
F FOSRENOL and design	3686093	September 22, 2009

2. These registrations constitute *prima facie* evidence of the validity of the registered marks, the registration of the marks, the registrant's ownership of the marks and the registrant's exclusive right to use the registered mark in commerce in connection with the goods claimed in each of the registrations including, without limitation, pharmaceutical preparations and substances for the treatment of hyperphosphatemia, kidney disease and disorders in Class 5. 15 USC § 1057. In addition, Registration Nos. 2687871; 2978995 and 3686093 are incontestable. 15 USC § 1065.

3. Opposer’s registrations set forth in Paragraph 1 herein are valid and subsisting, uncancelled and unrevoked and are *prima facie* evidence of Opposer’s exclusive right to use the mark claimed therein in commerce on the goods claimed in the registrations.

4. Opposer intends to rely on the registrations set forth in Paragraph 1 in this proceeding and, accordingly, will order status and title copies of these registrations from the US Trademark Office for later submission to the Board together with a Notice of Reliance pursuant to TMBP § 2.122(d).

5. The FOSRENOL Marks are distinctive and identified exclusively with the goods claimed in Opposer’s US Trademark Registrations asserted herein (“FOSRENOL Goods”).

6. Through continuous use of Opposer’s FOSRENOL Marks since at least as early as 2004 and through advertising and sales, Opposer’s FOSRENOL Marks are well-known and have developed valuable goodwill.

7. Priority is not an issue since Opposer's filing dates and/or first use dates claimed in its incontestable US Trademark Registration Nos. 2687871; 2978995 and 3686093 precede the filing date of Application Serial No. 87500669.

8. On June 22, 2017, Sabinsa Corporation ("Applicant") filed US Intent to Use Trademark Application Serial No. 87500669 in the United States Patent and Trademark Office seeking registration of the mark FORCINOL-G in International Class 5 for Applicant's Products.

9. In view of the similarity of the marks at hand and the closely similar, relatedness or complementary nature of the parties' related goods, Opposer believes and alleges that FORCINOL-G Mark so resembles Opposer's previously used and registered FOSRENOL Marks as to be likely to cause confusion, or mistake or deception of purchasers, under Section 2(d) of the Lanham Act as amended, 15 USC § 1052(d).

10. The likelihood of confusion, mistake or deception that would arise from concurrent use and registration of the Applicant's mark FORCINOL-G and Opposer's use and registration of its incontestable FOSRENOL Marks includes, without limitation, (a) persons are likely to believe that Applicant's Goods have their source in Opposer, or (b) that Applicant Goods under the mark FORCINOL-G are a non-prescription version of Opposer's FOSRENOL Goods or are in some way legitimately connected or affiliated with, sponsored, approved, endorsed or licensed by Opposer.

11. Opposer further believes and alleges that the use and registration of Applicant's FORCINOL-G mark as claimed in Application Serial No. 87500669 is likely to cause confusion, or mistake or deception in the minds of prospective purchasers as to the origin or source of Opposer's Goods and is likely to deceive and/or mislead prospective purchasers into believing that Applicant is the source of Opposer's FOSRENOL Goods and/or that Opposer's FOSRENOL Goods are sponsored, licensed, approved or endorsed by Applicant.

12. Applicant's use and registration of its FORCINOL-G mark as set forth in Application Serial No. 87500669 is calculated or likely to cause irreparable loss, injury and damage to Opposer's reputation and would permit Applicant to trade on Opposer's valuable

rights, reputation and goodwill in its FOSRENOL Marks in violation of Section 2 of the Trademark Act of 1946, as amended, 15 USC § 1052, resulting in irreparable harm and injury to Opposer.

13. Applicant's mark FORCINOL-G as set forth in Application Serial No. 87500669 is a misappropriation of Opposer's prior rights in its FOSRENOL Marks and any use and registration of the same by Applicant will disparage and falsely suggest a connection with Opposer in violation of Section 2(a) of the Trademark Act of 1946, as amended, 15 USC § 1052(a), resulting in irreparable harm and injury to Opposer.

14. Applicant's use and registration of the mark FORCINOL-G for Applicant's Products identified in Application Serial No. 87500669 is likely to dilute, blur and erode the distinctive quality, recognition and reputation of Opposer's well-known FOSRENOL Marks in violation of Section 43(c) of the Trademark Act of 1946, as amended, 15 USC § 1125(c), and cause damage to Opposer and the goodwill embodied in the Marks.

15. Opposer will be damaged by the issuance of a registration sought by Applicant within the meaning of Section 13(a) of the Lanham Act, 15 USC §1063 because such registration would support and assist Applicant in the confusing, misleading, deceptive and/or dilutive use of FORCINOL-G, and would give color of exclusive statutory rights to Applicant in violation and derogation of the prior and superior rights of Opposer in the coined term FOSRENOL.

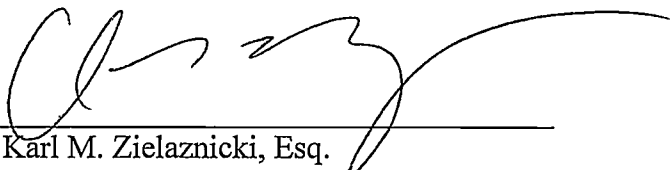
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WHEREFORE, Opposer respectfully requests that the proposed registration of the mark shown in Application Serial No. 87500669 for the mark FORCINOL-G in Class 5 be refused registration and this Opposition be sustained in favor of Opposer.

Respectfully submitted,

Dated: February 28, 2018

By:


Karl M. Zielaznicki, Esq.

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CERTIFICATE OF SERVICE

I hereby certify that on February 28, 2018, I caused a true and correct copy of the enclosed electronically filed NOTICE OF OPPOSITION to be served by First Class mail, postage prepaid, on Applicant as follows:

Sabinsa Corporation
20 Lake Drive
East Windsor, NJ 08520



Karl M. Zielaznicki, Esq.