

ESTTA Tracking number: **ESTTA992308**

Filing date: **08/02/2019**

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	Allergan, Inc.
Granted to Date of previous extension	08/04/2019
Address	2525 Dupont Drive Irvine, CA 92612 UNITED STATES

Correspondence information	SUSAN J. HINCHEY ALLERGAN, INC. 2525 DUPONT DRIVE IRVINE, CA 92612 UNITED STATES susan.hinchey@allergan.com, matthew.brady@allergan.com 714-246-5507
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**Applicant Information**

Application No	87922747	Publication date	02/05/2019
Opposition Filing Date	08/02/2019	Opposition Period Ends	08/04/2019
Applicant	Cielo Rodríguez, Hector Avda Salvador 95 Oficina 811 Providencia Santiago CHILE		

**Goods/Services Affected by Opposition**

Class 044. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Providing medical aesthetic procedures, namely, treating the skin with dermal fillers and botulinum toxin; Skin treatment, namely, the injection of dermal fillers to reduce the appearance of facial fine lines; Skin treatments, namely, the injection of dermal filling agents and neuromuscular blocking agents to reduce the appearance of facial lines and wrinkles
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**Grounds for Opposition**


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

**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration	1692384	Application Date	12/21/1990
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No.			
Registration Date	06/09/1992	Foreign Priority Date	NONE
Word Mark	BOTOX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 1990/09/00 First Use In Commerce: 1992/01/22 pharmaceutical preparations; namely, ophthalmic muscle relaxants		

U.S. Registration No.	1709160	Application Date	02/06/1991
Registration Date	08/18/1992	Foreign Priority Date	NONE
Word Mark	BOTOX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 1990/09/00 First Use In Commerce: 1992/01/22 pharmaceutical preparations for the treatment of neurologic disorders		

U.S. Registration No.	2510675	Application Date	01/03/2001
Registration Date	11/20/2001	Foreign Priority Date	NONE
Word Mark	BOTOX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 1990/09/30 First Use In Commerce: 1992/01/22 Pharmaceutical preparations for the treatment of neurological disorders, muscledystonias, smooth muscle disorders, autonomic nerve disorders, headaches, wrinkles, hyperhydrosis, sports injuries, cerebral palsy, spasms, tremors and pain		

Attachments	78041618#TMSN.png( bytes ) Opposition to TM App_ No_ 87922747 BEETOX _ Design.pdf(217810 bytes )
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Signature	/SUSAN J. HINCHEY/
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Name	SUSAN J. HINCHEY
Date	08/02/2019

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

In the Matter of Application Serial No. 87922747  
Published in the Official Gazette of February 5, 2019

_____	)	
ALLERGAN, INC.,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No.
	)	
Hector Cielo Rodriguez	)	
	)	
Applicant.	)	
_____	)	

NOTICE OF OPPOSITION

Opposer Allergan, Inc. ("Opposer") believes that it will be damaged by registration of the mark shown in Application Serial No. 87922747, and hereby opposes the same. As grounds for opposition, Opposer alleges as follows:

1. Opposer is a corporation organized and existing under the laws of the State of Delaware, with a principal place of business at 2525 Dupont Drive, Irvine, California 92612. Opposer is, and has been for many years, engaged in the manufacture, development, sale and advertising of an extensive array of pharmaceutical, ophthalmic and dermatological products. Beginning in or before 1990, Opposer has continuously marketed a pharmaceutical product for the therapeutic treatment of a variety of diseases and disorders under the trademark BOTOX® (the BOTOX® Mark") in the United States and globally (the BOTOX® Product).
2. In or before 1999, Opposer began clinical trials of the BOTOX® Product for a cosmetic indication and shipped the BOTOX® Product under the BOTOX® Mark during those trials. In 2002, following approval by the United States Food and Drug Administration of the BOTOX® Product for the temporary improvement in the appearance of moderate to severe glabellar lines, Opposer started promoting and marketing its BOTOX® Product under the BOTOX® Mark for that indication.

3. Opposer owns all right, title and interest in and to the BOTOX® Mark, as well as the following United States registrations on the Principal Register:
  - a. Registration No. 1,692,384 granted June 9, 1992, for BOTOX in International Class 5;
  - b. Registration No. 1,709,160 granted August 18, 1992, for BOTOX in International Class 5, and
  - c. Registration No. 2,510,675 granted November 20, 2001, for BOTOX in International Class 5.

All of these registrations are valid and subsisting and all have become incontestable. Copies of current printouts of information from the electronic database records of the USPTO showing the current status and title of these registrations are attached hereto as Exhibit 1 and are incorporated by reference herein as if set forth in full.

4. From a time long prior to the filing of the Application at issue, the BOTOX® Mark has been used in commerce in the United States for which the mark has become famous. Moreover, by virtue of the excellence of the product sold under the BOTOX® Mark, the mark has a valuable reputation.
5. Notwithstanding Opposer's long prior rights in and to the BOTOX® Mark, Applicant, on information and belief, on May 15, 2018, filed an application for registration of the trademark "*BEETOX & DESIGN*" (the "*BEETOX* Mark") for "Providing medical aesthetic procedures, namely, treating the skin with dermal fillers and botulinum toxin; Skin treatment, namely, the injection of dermal fillers to reduce the appearance of facial fine lines; Skin treatments, namely, the injection of dermal filling agents and neuromuscular blocking agents to reduce the appearance of facial lines and wrinkles" in International Class 44. The mark was published for opposition in the Trademark Official Gazette of February 5, 2019 (the "Opposed Application").

#### FIRST CLAIM FOR RELIEF

(Likelihood of Confusion with Registered Mark)

6. Opposer repeats and realleges the allegations in preceding paragraphs 1 through 5, inclusive, as if fully set forth herein.
7. The *BEETOX* Mark shown in the Opposed Application so resembles Opposer's registered BOTOX® Mark as to be likely, when used on or in connection with the goods and services in the Opposed Application, to cause confusion, to cause mistake, or to deceive, and Applicant's

mark is thus unregistrable under Section 2(d) of the United States Trademark Act, 15 U.S.C. 1052(d).

8. Opposer will be damaged by registration of the mark shown in the Opposed Application because registration will give Applicant *prima facie* evidence of its ownership of, and its exclusive nationwide right to use, a mark that is confusingly similar to Opposer's BOTOX® Mark.

#### SECOND CLAIM FOR RELIEF

(Likelihood of Confusion with Previously-Used Trademark)

9. Opposer repeats and realleges the allegations in preceding paragraphs 1 through 8, inclusive, as if fully set forth herein.
10. The *BEETOX* Mark shown in the Opposed Application so resembles Opposer's previously used and not abandoned BOTOX® Mark as to be likely, when used on or in connection with the goods and services identified in the Opposed Application, to cause confusion, to cause mistake, or to deceive, and Applicant's mark is thus unregistrable under Section 2(d) of the United States Trademark Act, 15 U.S.C. 1052(d).
11. Opposer will be damaged by registration of the mark shown in the Opposed Application because registration will give Applicant *prima facie* evidence of its ownership of, and its exclusive nationwide right to use, a mark that is confusingly similar to Opposer's previously used and not abandoned BOTOX® Mark.

#### THIRD CLAIM FOR RELIEF

(Likelihood of Dilution with Previously Registered and Used Trademark)

12. Opposer repeats and realleges the allegations in preceding paragraphs 1 through 11, inclusive, as if fully set forth herein.
13. Opposer's BOTOX® Mark is distinctive and famous and was determined by the Board to be famous at last as early as August 20, 2007.
14. Opposer's BOTOX® Mark was famous long prior to the date of filing of the Opposed Application.
15. The *BEETOX* Mark shown in the Opposed Application so resembles Opposer's previously used, registered and not abandoned BOTOX® Mark as to be likely to blur the distinctiveness of Opposer's famous BOTOX® Mark and Applicant's mark is thus unregistrable under Section 43(c) of the United States Trademark Act, 15 U.S.C. 1125(c).

16. Opposer will be damaged by registration of the mark shown in the Opposed Application because registration will give Applicant *prima facie* evidence of its ownership of, and its exclusive nationwide right to use, a mark that is likely to impair the distinctiveness of Opposer's famous BOTOX® Mark.

WHEREFORE, Opposer prays for judgment sustaining this opposition and refusing registration to Applicant of the mark shown in the Opposed Application.

Please charge any deficiency or credit any overpayment related to this Opposition to Deposit Account No. 01-0885, and direct all correspondence in connection with this opposition to the undersigned and, in addition, to:

Susan J. Hinchey  
Corporate Trademark Manager  
ALLERGAN, INC.  
2525 Dupont Drive  
Irvine, California 92612  
E-mail: [susan.hinchey@allergan.com](mailto:susan.hinchey@allergan.com)

Respectfully submitted,  
ALLERGAN, INC.

Date: August 2, 2019

By: s/ MATTHEW O. BRADY

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Matthew O. Brady  
Vice President  
2525 Dupont Drive  
Irvine, CA 92612  
714-246-4788  
E-mail: [matthew.brady@allergan.com](mailto:matthew.brady@allergan.com)

# EXHIBIT A



**BULK DATA:** The TSDR Application Programming Interface (API) will be unavailable starting May 7 at 12 a.m. ET for at least two weeks. Bulk data customers who rely on the TSDR API can use [alternative methods](#) to receive bulk data from TSDR. If you are a bulk data customer who has questions or needs additional information, please [email us](#).

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**Mark:** BOTOX

No image exists for this case.

**US Serial Number:** 74126661

**Application Filing Date:** Dec. 21, 1990

**US Registration Number:** 1692384

**Registration Date:** Jun. 09, 1992

**Register:** Principal

**Mark Type:** Trademark

**TM5 Common Status Descriptor:**



LIVE/REGISTRATION Issued and Active

The trademark application has been registered with the Office.

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

**Status Date:** Feb. 25, 2012

**Publication Date:** Jul. 02, 1991

**Notice of Allowance Date:** Sep. 24, 1991

## Mark Information

## 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, ophthalmic muscle relaxants

**International Class(es):** 005 - Primary Class

**U.S. Class(es):** 018

**Class Status:** ACTIVE

**Basis:** 1(a)

**First Use:** Sep. 1990

**Use in Commerce:** Jan. 22, 1992

## Basis Information (Case Level)

## Current Owner(s) Information

**Owner Name:** ALLERGAN, INC.

**Owner Address:** 2525 DUPONT DRIVE  
IRVINE, CALIFORNIA UNITED STATES 92612

**Legal Entity Type:** CORPORATION

**State or Country Where** DELAWARE

**Organized:**

## Attorney/Correspondence Information

## Prosecution History

## TM Staff and Location Information

## Assignment Abstract Of Title Information - Click to Load

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**BULK DATA:** The TSDR Application Programming Interface (API) will be unavailable starting May 7 at 12 a.m. ET for at least two weeks. Bulk data customers who rely on the TSDR API can use [alternative methods](#) to receive bulk data from TSDR. If you are a bulk data customer who has questions or needs additional information, please [email us](#).

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**Mark:** BOTOX

No image exists for this case.

**US Serial Number:** 74136930

**Application Filing Date:** Feb. 06, 1991

**US Registration Number:** 1709160

**Registration Date:** Aug. 18, 1992

**Register:** Principal

**Mark Type:** Trademark

**TM5 Common Status Descriptor:**



LIVE/REGISTRATION/issued and Active

The trademark application has been registered with the Office.

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

**Status Date:** Feb. 27, 2012

**Publication Date:** Nov. 12, 1991

**Notice of Allowance Date:** Feb. 04, 1992

## Mark Information

## 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 for the treatment of neurologic disorders

**International Class(es):** 005 - Primary Class

**U.S. Class(es):** 018

**Class Status:** ACTIVE

**Basis:** 1(a)

**First Use:** Sep. 1990

**Use in Commerce:** Jan. 22, 1992

## Basis Information (Case Level)

## Current Owner(s) Information

**Owner Name:** ALLERGAN, INC.

**Owner Address:** 2525 DUPONT DRIVE  
IRVINE, CALIFORNIA UNITED STATES 92612

**Legal Entity Type:** CORPORATION

**State or Country Where Organized:** DELAWARE

## Attorney/Correspondence Information

## Prosecution History

## TM Staff and Location Information

## Assignment Abstract Of Title Information - Click to Load

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**BULK DATA:** The TSDR Application Programming Interface (API) will be unavailable starting May 7 at 12 a.m. ET for at least two weeks. Bulk data customers who rely on the TSDR API can use [alternative methods](#) to receive bulk data from TSDR. If you are a bulk data customer who has questions or needs additional information, please [email us](#).

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**Mark:** BOTOX

BOTOX

**US Serial Number:** 78041618

**Application Filing Date:** Jan. 03, 2001

**US Registration Number:** 2510675

**Registration Date:** Nov. 20, 2001

**Register:** Principal

**Mark Type:** Trademark

**TM5 Common Status Descriptor:**



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

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

**Status Date:** Jan. 24, 2011

**Publication Date:** Aug. 28, 2001

## Mark Information

## Related Properties Information

## 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 for the treatment of neurological disorders, muscle dystonias, smooth muscle disorders, autonomic nerve disorders, headaches, wrinkles, hyperhidrosis, sports injuries, cerebral palsy, spasms, tremors and pain

**International Class(es):** 005 - Primary Class

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

**Class Status:** ACTIVE

**Basis:** 1(a)

**First Use:** Sep. 30, 1990

**Use in Commerce:** Jan. 22, 1992

## Basis Information (Case Level)

## Current Owner(s) Information

**Owner Name:** Allergan, Inc.

**Owner Address:** 2525 Dupont Drive  
Irvine, CALIFORNIA UNITED STATES 92612

**Legal Entity Type:** CORPORATION

**State or Country Where Organized:** DELAWARE

## Attorney/Correspondence Information

## Prosecution History

## TM Staff and Location Information

## Assignment Abstract Of Title Information - Click to Load

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