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| <i>Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc.</i> , 530 F.2d 1396, 1399, 189 USPQ 138 (CCPA 1976). | 3 |
| <i>In re Belgrade Shoe Co.</i> , 411 F.2d 1352, 162 USPQ 227 (CCPA 1969). | 3 |
| <i>In re E.I. Dupont DeNemours & Co.</i> , 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). | 2, 3, 4 |
| <i>Jeanne-Marc, Inc. v. Cluett, Peabody & Co., Inc.</i> , 221 USPQ 58, 61 (TTAB 1984). | 4 |
| <i>Schering Corp. v. Thompson Medical Co.</i> , 209 USPQ 72, (S.D. N.Y. 1979). | 3 |
| <i>Yamaha International Corp. v. Hoshino Gakki Co.</i> , 840 F.2d 1572, 1579-1580, 6 USPQ 2d 1001 (Fed. Cir. 1988). | 2 |

Statutes and Rules

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| 37 C.F.R. § 2.122(e) | 1 |
| 37 C.F.R. § 2.123(l) | 1 |

Treatises

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| J.T. McCarthy, <u>McCarthy on Trademarks and Unfair Competition</u> § 23.31 (4 th Ed. 2000). | 2 |
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Statement of the Case

Opposer's Statement of the Case is substantially correct.

The Record Before the Board

Opposer's Evidence

Opposer's evidence consists entirely of its two registrations for the marks INNOLET and INNOVO, respectively, and certain of Applicant's responses to Opposer's first set of interrogatories. Opposer did not depose Applicant's representatives, nor did Opposer take testimony. Opposer sets out a lengthy excuse for this paucity of evidence in its Statement of the Case, but this does not improve the quantity or quality of Opposer's evidence.

Objection to Opposer's Evidence

Opposer submits with its brief as Exhibit A copies of dictionary definitions and asks to Board to take judicial notice of same. Applicant objects to the admission or consideration of Exhibit A. Opposer's Notices of Reliance did not list such evidence and its admission is improper. 37 C.F.R. § 2.122(e). Evidence not obtained and filed in compliance with the rules of practice governing proceedings before the Board will not be considered. 37 C.F.R. § 2.123(l).

Applicant's Evidence

Applicant has offered no evidence, and is not required to do so to prevail in this proceeding. An opposer alleging likelihood of confusion under Section 2(d) has the burden of proof to establish that applicant does not have the right to register its mark. In fact, an opposer alleging likelihood of confusion "bears the burden of proof which encompasses not only the ultimate burden of persuasion, but also the obligation of going forward with sufficient proof of the material allegations of the Notice of Opposition, which, if not countered, negates the applicant's right to a registration. *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1579-1580 (Fed. Cir. 1988)

Issue Presented

The issue presented is whether Applicant's INNOJECT mark for "medical syringes" is likely to cause confusion under Section 2(d) with Opposer's marks INNOLET and INNOVO for "medical disposable hypodermic syringes" and "syringes for injecting insulin," respectively.

Argument

Opposer argues there is a likelihood of confusion between Opposer's marks and Applicant's marks. Opposer's arguments are almost entirely based on the analysis set forth in *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973), and the scanty facts Opposer has presented. Legal precedent is not controlling as to the result, because each case must rest on the totality of its own facts as to likelihood of confusion. See, J.T. McCarthy, McCarthy on Trademarks and Unfair

Competition § 23.31 (4th Ed. 2000). Indeed the CCPA has stated: “[P]rior decisions on other marks for other goods are of very little help one way or the other in cases of this type. Each case must be decided on its own facts and the differences are often subtle ones.” *Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc.*, 530 F.2d 1396, 1399, 189 USPQ 138 (CCPA 1976). At best, the *DuPont* factors only offer guidance; they cannot substitute for evidence.

Opposer has set forth its arguments on this basis as follows:

Issue of Similarity of Appearance, Sound, Connotation and Overall Commercial Impression

Opposer argues that in cases involving pharmaceuticals and medical devices, a stricter standard of likelihood of confusion should apply. However, this is not the universal rule. *See, e.g., Schering Corp. v. Thompson Medical Co.*, 209 USPQ 72, (S.D. N.Y. 1979). Indeed, it would be logical not to apply a higher standard of care in the case of medical devices, since confusion about particular devices would likely result only in an inoperative device for the condition at hand, rather than a possible dangerous drug.

While pointing out the similarities of the marks in question, Opposer asserts without evidence that the marks have a substantially similar pronunciation and cadence. There is no evidence of record as to how the marks would be pronounced, particularly with respect to primary accent. As Opposer states, citing *In re Belgrade Shoe Co.*, 411 F.2d 1352, 162 USPQ 227 (CCPA 1969), there is no “correct pronunciation” of a trademark.

Opposer also asserts that the marks convey the same connotation. Applicant stated during discovery that the INNO prefix was chosen to illustrate an innovative product. There is no evidence in the record as to what the connotation of Opposer's marks is. Therefore, Opposer cannot now impermissibly draw the conclusion that the connotations are the same.

The Strength and Distinctiveness of the Marks

Opposer points out that both Opposer's marks and Applicant's marks are coined terms, and distinctive. Both are distinctive, but this does not sway this *DuPont* factor in Opposer's favor. Indeed, it renders this factor in the analysis neutral.

The Goods and the Channels of Trade and the Class of Purchasers

Although the respective goods of the parties, as described in the registrations and the application are similar, Opposer overlooks the significance of the factor of channels of trade. The significance of trade channels is whether at the end, the same classes of persons are exposed to the marks in issue under circumstances likely to result in confusion. *Jeanne-Marc, Inc. v. Cluett, Peabody & Co., Inc.*, 221 USPQ 58, 61 (TTAB 1984). Applicant correctly states the general rule that the scope of the goods in question is defined by the identifications of those goods in the registrations and applications. But here, the only evidence of actual use of the goods is that in Applicant's discovery responses cited in Opposer's notice of reliance. Applicant's answers to Interrogatories 5, 6, and 7 therein show the class of customers to be those persons requiring self-administered automatic injection of particular drugs. Opposer has presented no evidence

of the class of persons who are its customers, so this factor is at least neutral in the analysis.

Actual Confusion

Neither party has presented any evidence bearing on the issue of actual confusion. Opposer argues that an absence of evidence on this point is expected, since Applicant filed an intent-to-use application. However, in the Applicant's answers to interrogatories 8, 10, and 16(c) submitted with Opposer's notice of reliance, Applicant testified that there has been no actual confusion, notwithstanding that Applicant has entered into a collaboration agreement with a pharmaceutical company, and that Applicant operates a web site. Thus, there is some basis for actual confusion to exist, yet Opposer has submitted no evidence thereof. This factor weighs in favor of Applicant.

Applicant's Duty to Avoid Confusion

Applicant does have, as Opposer states, a duty to select a mark not likely to cause confusion with any established mark. While true, this factor is not relevant in an opposition proceeding, since the purpose of such a proceeding in the first place is to inquire into the likelihood of confusion.

Resolving Doubts in Favor of Registrant

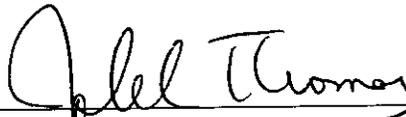
Opposer cites *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 878, 23 USPQ 2d 1698 (Fed. Cir. 1992), for the proposition that doubts in close cases should be resolved in favor to a registrant or senior user. In *Century 21*, the court

cases should be resolved in favor to a registrant or senior user. In *Century 21*, the court stated explicitly that such a rule should apply where the case "is difficult to resolve." Given the state of evidence in this case, Applicant urges that the present case is not difficult to resolve. There is no evidence of likely confusion, and thus Opposer is not entitled to prevail.

Conclusion

For the reasons set forth, Applicant submits that the most relevant factors weigh in Applicant's favor. Accordingly, Applicant respectfully requests that the Board dismiss this opposition.

Respectfully Submitted,



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Certificate of Mailing

I hereby certify that on October 21, 2003, a true and correct copy of the foregoing BRIEF FOR APPLICANT was service by United States First Class Mail, postage prepaid to Opposer at the following address:

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Re: Opposition 125,203; Serial No. 78/059,125
Novo Nordisk A/S v. Innoject, Inc.

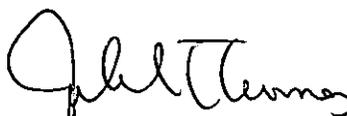
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Dear Sirs:

Enclosed for filing are three copies of Applicant's Brief.

Also enclosed is a stamped, self-addressed postcard which I would appreciate you date-stamping and returning to me upon receipt.

Yours truly,


John A. Thomas

JAT/cmw
Enclosures

cc: Innoject, Inc. (w/enclosure)
Linda K. McLeod (w/enclosure)