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OF THE TTAB.

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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Alexandria, VA 22313-1451  
General Contact Number: 571-272-8500

alv

Mailed: July 21, 2015

Opposition No. 91184047

*Farmaco-Logica B.V.*

*v.*

*The TriZetto Group, Inc.*

**Before Bucher, Cataldo, and Masiello,  
Administrative Trademark Judges.**

The TriZetto Group, Inc. (“Applicant”) seeks to register the mark FACETS<sup>1</sup> for “computer software for health care plan management and administration; computer software for claims and benefits administration for Medicare and Medicaid managed care” in International Class 9.

Farmaco-Logica B.V. (“Opposer”) has opposed registration of Applicant’s mark based on its claims of likelihood of confusion and fraudulent misuse of the registration symbol by Applicant prior to registration of its mark. In its notice of opposition, Opposer alleges common law use of the mark PHACET in the United States since “at least as early as November 2005” for devices for the reproduction, storage, and archiving of data, computers, peripheral computer devices and

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<sup>1</sup> Application Serial No. 77029672, filed October 26, 2006, alleging July 12, 1993 as a date of first use and date of first use in commerce.

computer software in the field of health care. Opposer further alleged ownership of a registered mark that has been cancelled.<sup>2</sup>

This case now comes up for consideration of Applicant's motion (filed March 27, 2015) for summary judgment in its favor on the grounds that Opposer lacks standing in this proceeding and lacks the priority necessary to allege likelihood of confusion and on the ground of misuse of the statutory registration symbol by Applicant. The motion is fully briefed.<sup>3</sup>

As an initial matter, we find, despite Opposer's contention to the contrary, that the motion for summary judgment is timely filed, having been filed on March 27, 2015, before the opening of the first testimony period (as last reset). See Trademark Rule 2.127(e)(1).

In support of its motion, Applicant argues that Opposer lacks standing because Opposer's "sole basis for standing is alleged injury caused by likelihood of confusion" and that based on the undisputed facts Opposer "lacks priority." Specifically, Applicant asserts that it is undisputed that its application filing date precedes Opposer's proven common law first use date; that by Opposer's own admission, it

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<sup>2</sup> Specifically, Opposer alleged ownership of Registration No. 3395039 for the mark PHACET for, *inter alia*, "central processing units and data processors for the reproduction, storage and archiving of data in the health care field; computers, computer peripherals, and computer software for recording patient health data, in the health care field." However, such registration was ordered cancelled by the United States District Court for the Eastern District of Virginia on May 12, 2014 when it granted Applicant's motion for summary judgment on its cancellation claim for abandonment. See TTAB Entry #77. On October 17, 2014, the Office cancelled such registration because of Opposer's failure to file an acceptable affidavit under Section 71.

<sup>3</sup> The Board notes that the April 30, 2015 withdrawal of Opposer's first motion for sanctions. Opposer's second motion for sanctions, filed on June 3, 2015, was filed in contravention of the Board's April 16, 2015 suspension order and will not be considered

did not commence use of the PHACET mark until December 2011, more than five years after Applicant's application priority date of October 26, 2006; that it "is legally impossible" for Opposer to demonstrate a likelihood of confusion based on prior common law rights"; and that Opposer lacks standing to oppose registration of the FACETS mark. Applicant also asserts that Opposer cannot identify a factual dispute sufficient to allow a reasonable trier of fact to sustain its opposition based on fraudulent misuse of the statutory registration symbol; that the undisputed evidence shows that Applicant's use of the registration symbol was "inadvertent and excusable"; and that because there is no evidence that Applicant misused the registration symbol "with the intent to deceive the purchasing public or others in the trade into believing that the mark is registered" and because Applicant's use was excusable, Applicant is entitled to summary judgment dismissing Opposer's opposition.

As evidentiary support, Applicant has submitted the following: (1) Opposer's July 29, 2011 responses to Applicant's Requests for Admissions wherein Opposer admits in its response to Request for Admission No. 3 that Opposer has not used its PHACET trademark in commerce in the United States, and (2) the November 22, 2011 declaration of Mr. Paul Kuks, the principal of Opposer, wherein Mr. Kuks states that on September 29, 2011 Opposer applied for rental of exhibition space for the Midyear Clinical Meeting of the American Society of Health-System Pharmacists to be held in December 2011 (which Applicant alleges indicates that

Opposer had not used its PHACET mark in the United States until December 2011).

In response to the motion, Opposer merely asserts that it relies on its common law rights in its PHACET mark; that it has used its PHACET mark in the United States “on several occasions”; and that it has pleaded it is a competitor of Applicant; and that therefor “if Opposer is able to prove these allegations at trial, then it will have established its standing in this proceeding.” Opposer further states that “Applicant has misused the statutory registration symbol during so many years, on such a scale, and even after having been notified of this fact, that a more extensive explanation than just inadvertence is warranted.”

In evidentiary support of its position, Opposer submits the April 13, 2015 declaration of its principal Mr. Kuks with attached exhibits, including examples of Opposer’s use of its mark in the United States.

In reply, Applicant contends that Opposer has failed to present any evidence to support its standing to oppose; that Opposer offers no evidence contrary to Applicant’s argument that Opposer did not commence use of the PHACET mark until December 2011, more than five years after Applicant’s application priority date of October 26, 2006; that it is undisputed that Opposer lacks any common law rights on which it could support its allegation of harm based on likelihood of confusion; and that Opposer does not even address the lack of evidence to support its Section 2(d) claim so this ground has been conceded. Applicant further argues

that Opposer has failed to establish a genuine dispute of material fact on its claim of fraudulent misuse of the registration symbol.

Summary judgment is appropriate only when there is no genuine dispute as to any material fact and the moving party is entitled to judgment as a matter of law. *See* Fed. R. Civ. P. 56(a). The Board may not resolve issues of material fact; it may only ascertain whether a genuine dispute regarding a material fact exists. *See Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc.*, 22 USPQ2d at 1544. The non-moving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine dispute of material fact for trial. In general, to establish the existence of disputed facts requiring trial, the non-moving party “must point to an evidentiary conflict created on the record at least by a counterstatement of facts set forth in detail in an affidavit by a knowledgeable affiant.” *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1786 (Fed. Cir. 1990), *citing Barmag Barmer Maschinenfabrik AG v. Murata Machinery, Ltd.*, 731 F.2d 831, 221 USPQ 561, 564 (Fed. Cir. 1984).

The Board must consider an opposer's standing as a threshold issue in every case. In *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed Cir. 1999), the Federal Circuit enunciated a liberal threshold for determining standing, i.e., whether one's belief that one will be damaged by the registration is reasonable and reflects a real interest in the case. *See also Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987). In the notice of opposition Opposer adequately asserted its standing by claiming prior common law rights in the PHACET mark. The issue now to be determined is whether a genuine dispute of material fact exists as to whether Opposer has proven its standing.

In his April 13, 2015 declaration of Mr. Paul Kuks, Opposer's managing director, states that "potential purchasers in the United States are exposed to Farmaco-Logica B.V.'s PHACET mark via the buyer's guide of the American Society of Hospital Pharmacy..." and that "Farmaco-Logica has used the PHACET mark for computer software in the United States during a trade show...held on May 31- June 4, 2014 in Las Vegas." As such Opposer has introduced sufficient evidence of its standing to bring this proceeding. *See Geirsch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009)(common law use sufficient to establish standing). There is no genuine dispute of material fact on this issue.

To establish priority on a likelihood of confusion claim brought under Trademark Act § 2(d), a party must prove that, vis-a-vis the other party, it owns "a mark or trade name previously used in the United States ... and not abandoned ... ."

Trademark Act Section 2, 15 U.S.C. § 1052. A party may establish its own prior proprietary rights in a mark through ownership of a prior registration, actual use or through use analogous to trademark use which creates a public awareness of the designation as a trademark identifying the party as a source. See Trademark Act §§ 2(d) and 45, 15 U.S.C. §§ 1052(d) and 1127. *See also T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996), *vacating PacTel Teletrac v. T.A.B. Systems*, 32 USPQ2d 1668 (TTAB 1994).

In this case, Opposer may not rely upon its cancelled registration to support its claim of priority. Opposer must therefore demonstrate by competent evidence that it has made use of the mark PHACET in the United States prior to the earliest date upon which Applicant may rely for purposes of priority. Applicant filed its involved application on October 26, 2006. Inasmuch as Applicant has not introduced evidence of use of its mark in connection with its goods prior to the filing date of its application, the earliest date upon which Applicant may rely for priority purposes is October 26, 2006. *See Levi Strauss & Co. v. R. Josephs Sportwear Inc.*, 36 USPQ2d 1328, 1332 (TTAB 1998), *quoting Alliance Manufacturing Co. v. ABH Diversified Products, Inc.*, 226 USPQ 348, 351 (TTAB 1985) (“an applicant is entitled to rely upon the filing date of its application as a presumption of use of the mark subject of the application as of that date”). Thus, in order to raise a genuine dispute as to Applicant’s claim that Opposer has failed to establish its priority, Opposer must show that it used its mark PHACET prior to October 26, 2006.

Opposer fails to even address the merits of the issue of priority in its brief in opposition to the motion. We further observe that Opposer has failed to introduce any evidence to show that it has used its mark prior to October 26, 2006.

Opposer's evidence consists of a printout from a third-party Internet website (for the American Society of Health-System Pharmacists) dated November 22, 2011 which shows the PHACET mark next to the words "open source software and computer systems for healthcare professionals" and under the term "Exhibitor." The contact information of Mr. Paul Kuks is on the other side of the page and Opposer's domain name is also listed on such page. Opposer has also submitted two pages from a guide handed to visitors at a trade show for the American Society of Health-System Pharmacists held on May 31-June 4, 2014 showing the PHACET mark used in conjunction with a very brief description indicating that it is software for the health care field and providing the booth number of Opposer for the show. Opposer has not introduced any evidence regarding its asserted prior use of the PHACET mark. Such evidence, at best, supports November 22, 2011, as Opposer's earliest date of use.

The record is devoid of any evidence to support Opposer's claim of priority. After a careful review of the record in this case, we find that there is no genuine dispute of material fact on the issue of priority and that Applicant is entitled to judgment as a matter of law with regard to the likelihood of confusion claim.

We turn to the issue of Applicant's improper use of the registration symbol prior to registration.



“The improper use of a registration notice in connection with an unregistered mark, if done with intent to deceive the purchasing public or others in the trade into believing that the mark is registered, is a ground for denying the registration of an otherwise registrable mark.”

*Copelands’ Enterprises Inc. v. CNV Inc.*, 20 USPQ2d 1295, 1298, 945 F.2d 1563 (Fed. Cir. 1991) (citations omitted). The parties agree that Applicant used the federal registration symbol prior to registration. Applicant's motion for summary judgment asserts that Opposer cannot demonstrate that Applicant had the intent to deceive necessary to deny registration.

Upon careful consideration of the arguments and evidence presented by the parties under the summary judgment guidelines set forth above, and drawing all inferences in favor of the nonmoving party, we find that Applicant has not met its burden. In particular, we conclude that genuine issues of material fact exist at least with respect to whether Applicant used the registration notice with the intent to deceive others. As the Federal Circuit remarked in *Copelands’*:

As a general rule, the factual question of intent is particularly unsuited to disposition on summary judgment. *See KangaROOS U.S.A., Inc. v. Caldor, Inc.*, 778 F.2d 1571, 1575, 228 USPQ 32, 34-35 (Fed. Cir. 1985) (citing *Pfizer, Inc. v. International Rectifier Corp.*, 538 F.2d 180, 185, 190 USPQ 273, 277 (8<sup>th</sup> Cir. 1976), cert. denied, 429 U.S. 1040 [192 USPQ 543](1977)(“summary judgment is inappropriate where issues of fact, intent [and] good faith ... predominate”)); *Albert v. Kelex Corp.*, 729 F.2d 757, 762, 221 USPQ 202, 207 (Fed. Cir.) aff’d on reh’g, 741 F.2d 396, 223 USPQ 1 (Fed. Cir. 1984) (“Intent is a factual matter which is rarely

free from dispute. ... Cutting off Albert's right to trial on the issue was improper.") The question of intent to misuse the federal registration notice is no more amenable to summary judgment in this case than it was in *Copelands*'.

Accordingly, Applicant's motion for summary judgment on the issue of standing and on the misuse of the federal registration notice is denied; but because Opposer cannot as a matter of law establish its claim of priority, Applicant's motion for summary judgment on the ground of priority of use and likelihood of confusion is granted.

Proceedings herein are resumed. The proceeding will go forward on the ground of misuse of the registration notice only. Dates are reset as follows:

Plaintiff's Pretrial Disclosures Due	<b>8/28/2015</b>
Plaintiff's 30-day Trial Period Ends	<b>10/12/2015</b>
Defendants Pretrial Disclosures Due	<b>10/27/2015</b>
Defendants 30-day Trial Period Ends	<b>12/11/2015</b>
Plaintiffs Rebuttal Disclosures Due	<b>12/26/2015</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>1/25/2016</b>

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.