

THIS DECISION IS
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TTAB PRECEDENT

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

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Mailed: December 14, 2010

Opposition No. 91192781

Bayer HealthCare LLC

v.

Biogen Idec MA Inc.

**Before Walters, Walsh, and Ritchie,
Administrative Trademark Judges.**

By the Board:

Biogen Idec MA Inc. ("applicant") seeks to register the mark LIXALEV in standard character format for "pharmaceutical preparations for the treatment of cardiovascular disorders" in International Class 5.¹

On November 23, 2009, Bayer HealthCare LLC ("opposer") filed a notice of opposition to registration of applicant's LIXALEV mark. As grounds for opposition, opposer alleges that applicant's mark, when used on the identified goods, so

¹Application Serial No. 77701134, filed on March 27, 2009, based on an allegation of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. Section 1051(b).

resembles opposer's previously used and registered ALEVE mark for "anti-inflammatory, analgesic, and antipyretic pharmaceutical preparations" in International Class 5,² and "pharmaceutical antitussive-cold preparations, preparations for treating colds" also in International Class 5,³ as to be likely to cause confusion, mistake or to deceive.

Additionally, opposer has asserted a claim of dilution.

Applicant, in its answer, has denied the salient allegations of the notice of opposition.

This case now comes up for consideration of applicant's motion for summary judgment (filed October 15, 2010) solely in regard to opposer's asserted claim of priority and likelihood of confusion. The motion is fully briefed.

For purposes of this order, we presume the parties' familiarity with the pleadings, the history of the proceeding and the arguments and evidence submitted with respect to opposer's motion.

A party is entitled to summary judgment when it has demonstrated that there are no genuine issues as to any material facts, and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). The evidence must be

² Registration No. 1536042, issued April 25, 1989, claiming dates of first use anywhere and first use in commerce since April 25, 1988.

³ Registration No. 3287780, issued September 4, 2007, claiming dates of first use anywhere and first use in commerce since July 31, 2000.

viewed in a light favorable to the nonmoving party, and all justifiable inferences are to be drawn in the nonmovant's favor. *Opryland USA Inc. v. The Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

Upon careful consideration of the arguments and evidence presented by the parties, and drawing all inferences with respect to the motion in favor of the opposer as the nonmoving party, we find that applicant has not demonstrated the absence of a genuine issue of material fact for trial in regard to opposer's claim of priority and likelihood of confusion.

Specifically, genuine issues of material fact exist, at a minimum, as to the similarities between the parties' respective marks, as well as to the relatedness of the goods at issue.

In view thereof, applicant's motion for summary judgment is denied.⁴

As a final matter, the Board notes that, on October 7, 2010, applicant filed a proposed amendment to its application Serial No. 77701134, without providing opposer's

⁴The parties should note that the evidence submitted in connection with a motion for summary judgment or opposition thereto is of record only for consideration of that motion. Any such evidence to be considered at final hearing must be properly introduced in evidence during the appropriate trial period. See *Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); and *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983). Additionally, the issues for trial are not limited to those identified by the Board in explaining the denial of this motion for summary judgment.

consent. By the proposed amendment, applicant sought to amend the identification of goods from "pharmaceutical preparations for the treatment of cardiovascular disorders" to "prescription pharmaceutical preparations for the treatment of cardiovascular disorders."

By order dated October 15, 2010, the Board, while finding that applicant's proposed amendment is clearly limiting in nature and, therefore, would be deemed acceptable, nonetheless deferred consideration of the unconsented amendment until final judgment or until the case was decided upon summary judgment.

Inasmuch as we herein have denied applicant's motion for summary judgment and have not decided the case on the merits, applicant's proposed amendment will remain deferred until final decision. Even if we were to grant applicant's proposed amendment of its identification of goods at this juncture in the case, we would still find that a genuine issue of material fact exists as to the relatedness of the parties' goods.

Proceedings are resumed. The parties are allowed until THIRTY DAYS from the mailing date of this order to serve responses to any outstanding discovery requests.⁵

⁵ This allowance of time should not be construed as compelling responses to outstanding discovery, but merely functions as a scheduling order.

Discovery remains open. Trial dates, beginning with the deadline for expert disclosures, are reset as follows:

Expert Disclosures Due	1/20/2011
Discovery Closes	2/19/2011
Plaintiff's Pretrial Disclosures	4/5/2011
Plaintiff's 30-day Trial Period Ends	5/20/2011
Defendant's Pretrial Disclosures	6/4/2011
Defendant's 30-day Trial Period Ends	7/19/2011
Plaintiff's Rebuttal Disclosures	8/3/2011
Plaintiff's 15-day Rebuttal Period Ends	9/2/2011

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 Rule 2.128(a) and (b).

An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.