

ESTTA Tracking number: **ESTTA402837**

Filing date: **04/08/2011**

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

Proceeding	91199117
Party	Defendant Sergeant's Pet Care Products, Inc.
Correspondence Address	Matthew J. Smith Polsinelli Shughart PC Suite 1000 100 S. Fourth St. St. Louis, MO 63102 uspt@polsinelli.com
Submission	Answer
Filer's Name	Keith J. Grady
Filer's e-mail	kgrady@polsinelli.com,jchallis@polsinelli.com,jmills@polsinelli.com,msmith@polsinelli.com
Signature	/Keith J. Grady/
Date	04/08/2011
Attachments	2011-04-08 Sergeant's Ans & Aff Def.pdf (8 pages)(23636 bytes)

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

In the Matter of United States Trademark Application:

Mark: PRONYL OTC
Registrant: SERGEANT'S PET CARE PRODUCTS, INC.
Application No.: 85/120,994
Class No.: 005
Published: November 23, 2010

MERIAL,

Opposer,

v.

**SERGEANT'S PET CARE
PRODUCTS, INC.,**

Applicant.

OPPOSITION NO.: 91199117

**ANSWER AND AFFIRMATIVE DEFENSES
TO OPPOSER'S NOTICE OF OPPOSITION**

Applicant Sergeant's Pet Care Products, Inc. ("Applicant"), by and through its undersigned counsel, pursuant to 37 C.F.R. 2.106 and Trademark Trial and Appeal Board Manual of Procedure ("TBMP") Rules 310 and 311, hereby submits its Answer and Affirmative Defenses to Opposer Merial's ("Opposer") Notice of Opposition related to United States Trademark Application No. 85/120,994 (the "'994 Application") for PRONYL OTC.

ANSWER TO NOTICE OF OPPOSITION

1. Applicant admits that it filed the '994 Application which seeks registration of the mark PRONYL OTC for "[f]lea and tick control products, namely, antiparasitic collars, sprays, shampoos, medicated powders and topical ointments for pets not for sale to or through licensed

veterinarians.” Applicant admits that the ‘994 Application was filed on September 1, 2010, and is based on Applicant’s bona fide intention to use the mark evidenced by the ‘994 Application in commerce in connection with said goods. Applicant denies that the mark is merely “alleged” or that Applicant’s intent to use the mark is merely “alleged.” Applicant denies any allegations not specifically admitted.

2. Applicant objects to this allegation pursuant to Fed. R. Civ. P. 10(b) and TBMP § 309.03(a)(2) in that this paragraph is not as limited as practicable to a single set of circumstances. Applicant admits, upon information and belief, that Opposer has sold certain flea and tick control products in the veterinary class of trade under the name FRONTLINE, FRONTLINE PLUS and/or FRONTLINE TOP SPOT. Applicant states that Opposer’s allegations related to the generic chemical name fipronil are improper and should be stricken pursuant to Fed. R. Civ. 12(f) and TBMP § 506. Opposer has no rights in the generic chemical name fipronil. Fipronil is the active ingredient in, among other things, Opposer’s FRONTLINE products and is characterized as a “common name” by the Environmental Protection Agency (“EPA”). Fipronil is also sold for use by other companies as an active ingredient in termiticide products. In Pesticide Registration Notice 97-5, entitled *Use of Common Names for Active Ingredients on Pesticide Labeling*, the EPA provides that certain names are “‘common names’ and are widely used in lieu of chemical names on a day-to-day basis.” Fipronil is on this list of common chemical names. The EPA also includes fipronil on a list of “common/chemical names” in the Code of Federal Regulations. *See* 40 C.F.R. § 180.517 (2010). As such, the EPA clearly recognizes fipronil as a common chemical name. Fipronil is also listed as a chemical name in the *Merck Index* and on the www.drugs.com dictionary. In one of Opposer’s patents, specifically U.S. Patent No. 6,716,442, Opposer itself lists the full chemical compound of

fipronil and then states “whose non-proprietary name is fipronil.” In another one of its patents, specifically U.S. Patent No. 6,096,329, Opposer consistently states that the “common name” of this chemical is fipronil and also refers to fipronil as a compound. As such, fipronil is a common and generic chemical name in which Opposer has no rights. Additionally, there are at least two (2) Unites States Trademark Registrations that have already issued using part of the word fipronil, including FIPROTEK, Reg. No. 3,875,947 and EFFIPRO, Reg. No. 3,587,487. There are also other pending trademark application using portions of the generic word fipronil. To the extent Opposer intends to rely on any allegations related to this generic chemical name, those allegations should be stricken because Opposer does not and cannot have any such rights. Applicant denies any allegations not specifically admitted.

3. Applicant admits, upon information and belief, that Opposer has certain trademark registrations and states that those registrations speak for themselves and denies any allegations inconsistent therewith. Applicant denies that Opposer has any enforceable rights in any of its referenced marks or that those marks can prevent the Application. Applicant states that certain of the allegations of paragraph 3 contain legal conclusions to which no response is required. Applicant denies any allegations not specifically admitted.

4. Applicant objects to this allegation pursuant to Fed. R. Civ. P. 10(b) and TBMP § 309.03(a)(2) in that this paragraph is not as limited as practicable to a single set of circumstances. Applicant admits, upon information and belief, that Opposer has sold certain flea and tick control products under the name FRONTLINE. Applicant denies that Opposer has any right to prevent Applicant or others from using the generic word “fipronil” or a derivative of such word as part of a registration. *See supra*, ¶ 2. Applicant denies any allegations not specifically admitted.

5. Applicant admits that it intends to use the mark “PRONYL OTC” in connection with flea and tick control products that contain fipronil and that those products are intended to be sold over the counter. Applicant denies that its product is “intended to be Applicant’s version of Opposer’s ‘FRONTLINE’” product. Applicant admits that, pursuant to EPA regulations, it identifies fipronil as the active ingredient in its products sold under the mark PRONYL OTC. Applicant denies that Opposer has any right to prevent Applicant or others from using the generic word “fipronil” or a derivative of such word as part of a registration. *See supra*, ¶ 2. Applicant denies any allegations not specifically admitted.

6. Applicant admits it seeks registration of F-PRONIL (Serial No. 85/021,258), and that its application for F-PRONIL is currently being opposed by Opposer (Opposition No. 91197053). Applicant states that certain of the allegations of paragraph 6 contain legal conclusions to which no response is required. Applicant denies that Opposer has any right to prevent Applicant or others from using the generic word “fipronil” or a derivative of such word as part of a registration. *See supra*, ¶ 2. Applicant denies all allegations not specifically admitted.

7. Applicant objects to this allegation pursuant to Fed. R. Civ. P. 10(b) and TBMP § 309.03(a)(2) in that this paragraph is not as limited as practicable to a single set of circumstances. Applicant denies that Opposer has any right to prevent Applicant or others from using the generic word “fipronil” or a derivative of such word as part of a registration. *See supra*, ¶ 2. Applicant denies each and every allegation of this paragraph.

8. Applicant objects to this allegation pursuant to Fed. R. Civ. P. 10(b) and TBMP § 309.03(a)(2) in that this paragraph is not as limited as practicable to a single set of circumstances. Applicant denies that Opposer has any right to prevent Applicant or others from

using the generic word “fipronil” or a derivative of such word as part of a registration. *See supra*, ¶ 2. Applicant denies each and every allegation of this paragraph.

9. Applicant objects to this allegation pursuant to Fed. R. Civ. P. 10(b) and TBMP § 309.03(a)(2) in that this paragraph is not as limited as practicable to a single set of circumstances. Applicant states that certain of the allegations of paragraph 9 contain legal conclusions to which no response is required. For the reasons set forth in Applicant’s response to paragraphs 2 through 8, which are incorporated by reference as if fully set forth herein, Applicant denies each and every allegation of this paragraph.

10. Applicant denies each and every allegation of paragraph 10.

11. Applicant respectfully requests that this Board dismiss, with prejudice, Opposer’s Notice of Opposition at Opposer’s cost and for such other and further relief this Board deems just and proper in the premises.

AFFIRMATIVE DEFENSES

In addition to the answers provided above, Applicant asserts the following affirmative defenses in response to Opposer’s Notice of Opposition. In so doing, Applicant incorporates by reference each and every paragraph of its answer as if fully set forth herein.

1. Opposer’s Notice of Opposition fails to state a claim upon which relief can be granted because, *inter alia*, Opposer’s Notice of Opposition does not allege any proper grounds for opposition of Applicant’s Application.

2. Opposer’s Notice of Opposition fails to state a claim upon which relief can be granted because, *inter alia*, Opposer has no rights in the generic word fipronil and all allegations related thereto should be stricken.

3. Opposer's Notice of Opposition fails to state a claim upon which relief can be granted because, *inter alia*, there is no likelihood of confusion between any mark owned by Opposer and the mark set forth in the Application as the mark at issue are not similar in appearance, sound, connotation, or commercial impression.

4. Opposer's Notice of Opposition fails to state a claim upon which relief can be granted because, *inter alia*, the products sold by Opposer under the marks FRONTLINE, FRONTLINE PLUS and FRONTLINE TOP SPOT are marketed and sold exclusively to veterinarians. Applicant has no intention of marketing any flea and tick product under the mark set forth in the Application to veterinarians as is clearly set forth in the description of goods. As such, there can be no likelihood of confusion because the trade channels and proposed consumers are different.

5. Opposer's Notice of Opposition is barred by the doctrines of laches and estoppel in that Opposer has allowed significant numbers of third parties to use all or parts of any marks it may own.

6. Opposer's Notice of Opposition is barred by the doctrine of fair use.

7. Opposer's Notice of Opposition is barred by the doctrine of unclean hands in that Opposer is attempting to appropriate proprietary rights in the generic chemical name fipronil.

8. Applicant reserves the right to supplement or otherwise add to its affirmative defenses of which it may become aware through discovery or otherwise.

PRAYER FOR RELIEF

WHEREFORE, Applicant Sergeant's Pet Care Products, Inc., having fully responded to Opposer Merial's Notice of Opposition and setting forth its affirmative defenses thereto, prays

that the Board enter judgment in favor of Applicant and against Opposer and dismiss Opposer's Notice of Opposition with prejudice at Opposer's cost.

Dated: April 8, 2011

Respectfully submitted,

POLSINELLI SHUGHART PC

By: /Keith J. Grady/

KEITH J. GRADY

JOHN M. CHALLIS

100 South Fourth Street, Suite 1000

St. Louis, Missouri 63102

Phone: (314) 889-8000

Facsimile: (314) 231-1776

E-Mails: kgrady@polsinelli.com

jchallis@polsinelli.com

ATTORNEYS FOR APPLICANT
SERGEANT'S PET PRODUCTS, INC.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above and foregoing pleading was served by United States Mail, postage prepaid, this 8th day of April 2011, to:

BREWSTER TAYLOR, ESQ.
STITES & HARBISON, PLLC
Suite 900
1199 North Fairfax Street
Alexandria, VA 22314

Attorneys for Opposer

/Keith J. Grady/