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

Proceeding	92052897
Party	Defendant Galderma Laboratories, Inc.
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Submission	Motion for Summary Judgment
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Attachments	1 - PUBLIC - Motion.pdf (13 pages)(1231239 bytes)

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II. Summary Judgment Standard

Summary judgment shall be granted where “the materials in the record, including . . . affidavits or declarations, . . . admissions, interrogatory answers, or other materials” show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law. Fed. R. Civ. P. 56.

The party moving for summary judgment bears the burden of showing the absence of any genuine issues of material fact, and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a); *Copelands’ Enters., Inc. v. CNV, Inc.*, 945 F.2d 1563, 20 U.S.P.Q. 2d 1295, 1297-98 (Fed. Cir. 1991). Once the moving party meets that burden, the non-moving party may not rest on mere denials or conclusory assertions, but must instead proffer countering evidence showing that there is a genuine factual dispute requiring resolution by trial. *Copelands’ Enters., Inc.*, 20 U.S.P.Q. 2d at 1298. If the non-movant fails to set out specific facts showing a genuine issue for trial, summary judgment should be entered against it. Fed. R. Civ. P. 56(e).

The purpose of summary judgment is judicial economy. Summary judgment is appropriate to save the time and expense of trial where no genuine issues of material fact remain, and where, even if more evidence than is already available might be adduced at trial, it could not reasonably be expected to change the result. *See Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 739 F.2d 624, 222 U.S.P.Q. 741, 743-44 (Fed. Cir. 1984); *Exxon Corp. v. Nat’l Foodline Corp.*, 579 F.2d 1244, 198 U.S.P.Q. 407, 408 (C.C.P.A. 1978). Summary judgment “is to be encouraged in inter partes cases before the Trademark Trial and Appeal Board . . .” *Pure Gold, Inc.*, 222 U.S.P.Q. at 744 n.2.

This proceeding presents the appropriate record for summary judgment to be entered in favor of Registrant on Petitioner’s cause for abandonment because no additional material facts that could be uncovered through trial are necessary to resolve the issue this Motion for Partial Summary Judgment addresses. The necessary material facts are not in dispute, and Registrant is entitled to judgment as a matter of law on the issue presented. Further, summary judgment against Petitioner’s abandonment cause promotes judicial economy in this instance because dispensing with this claim will allow the parties to focus their discovery and case

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presentations on Petitioner's only remaining cause for priority and likelihood of confusion under Section 2(d) of the Lanham Act.

III. Statement of Undisputed Facts

The undisputed facts establish as a matter of law that Registrant has never abandoned its rights in the RESTORADERM mark for use with the goods identified in the Registration, namely, "therapeutic skin care preparations and treatment for skin disorders." If use of a mark is discontinued with intent not to resume use, then a mark is deemed abandoned. 15 U.S.C. § 1127. The challenging party bears the burden of proving abandonment by a preponderance of the evidence. *FirstHealth of the Carolinas Inc. v. CareFirst of Md. Inc.*, 81 U.S.P.Q.2d 1919, 1922 (Fed. Cir. 2007).

In this case, the facts and evidence detailed below establish that there is no issue of material fact that (1) CollaGenex had a bona fide intention to use the mark in 2002 in connection with the goods identified in the Registration, as supported by the filing of the application leading to the Registration; (2) CollaGenex worked to develop a product to be marketed under the mark until actual use of the mark on the goods commenced in 2005; (3) CollaGenex continued to develop products to be marketed under the mark until Registrant acquired CollaGenex's rights and interest in and to the mark, the registrations and application therefor, and goodwill related thereto in 2008; (4) Registrant thereafter continued working toward developing skin care products that are therapeutic skin care preparations and treatment for skin disorders; and (5) Registrant currently uses the mark in U.S. commerce on multiple goods identified in the Registration and has done so continuously since at least as early as January 2010. Taken together, these facts preclude a finding at trial that Registrant has abandoned its rights in the Registration.

A. Registrant currently uses the mark on the goods identified in the Registration.

The allegedly abandoned Registration identifies the goods of "therapeutic skin care preparations and treatment for skin disorders." Registrant currently provides, markets, and sells two products under the RESTORADERM mark that are therapeutic skin care preparations and treatment for skin disorders as identified in the Registration. The common understanding of a product that is "therapeutic" or a "treatment"

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held by the average consumer includes a product that is applied for reasons of health, that has a good effect on physical or mental health, or that is restorative or otherwise beneficial to health. As detailed below, Registrant's RESTORADERM products fall squarely within this understanding. The evidence further shows that this understanding is reinforced in the minds of consumers through Registrant's substantial marketing activities of the RESTORADERM products, which emphasize the products' skin barrier restoration and skin barrier maintenance and hydration properties, and highlights the advanced, clinically-tested technologies utilized in the products.

1. Meaning of "Therapeutic" and "Treatment" Generally

The Trademark Office instructs that the common understanding of words in an identification should be used to determine the scope and nature of the goods identified. T.M.E.P. 1402.03. "A basic and widely available dictionary should be consulted to determine the definition or understanding of a commonly used word," T.M.E.P. 1402.03, rather than a specialized, highly technical definition, *see* T.M.E.P. 1402.01 ("The language used to describe goods and/or services should be understandable to the average person and should not require an in-depth knowledge of the relevant field."); *see also In re Paper Doll Promotions Inc.*, 84 U.S.P.Q.2d 1660, 1666 (T.T.A.B.) (approving of an identification of goods, in part, because "one would not require technical knowledge to understand it").

Merriam-Webster defines the adjective "therapeutic" as: "of or relating to the treatment of disease or disorders by remedial agents or methods <*a therapeutic rather than a diagnostic specialty*>." Declaration of Lisa N. Congleton ("Congleton Decl.") ¶ 5, Exh. A. Merriam-Webster identifies "curative," "healing," "officinal," "remedial," "restorative," and "medicinal" as synonyms for "therapeutic." Congleton Decl. ¶ 5, Exh. A.

The Oxford English Dictionary defines the adjective "therapeutic" as:

- (i) administered or applied for reasons of health: *a therapeutic shampoo*
- (ii) having a good effect on the body or mind; contributing to a sense of well-being: *a therapeutic silence*

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Congleton Decl. ¶ 5, Exh. B. Other synonyms include: “ameliorative,” “beneficial,” “corrective,” “remedial,” and “restorative.” Congleton Decl. ¶ 5, Exh. C.

2. Eczema (or Atopic Dermatitis) is a Skin Disorder

Eczema is a skin disorder, Congleton Decl. ¶ 8, Exh. O, characterized by a very dry, often itchy, rash, which may appear thick and/or scaly, Congleton Decl. ¶ 5, Exh. D. Because the most common form of eczema is atopic dermatitis, sometimes these terms are used interchangeably. Congleton Decl. ¶¶ 5-6, Exhs. E, I.

3. Treatment/Therapy for Eczema

There are a number of treatments and therapies for eczema. “Restoring skin barrier function and providing superior hydration are two fundamental elements in the proper management of [atopic dermatitis].” Declaration of Cindy Kee (“Kee Decl.”) ¶ 19, Exh. L. “The goal of treatment for eczema is to relieve and prevent itching, which can lead to infection. Since the disease makes skin dry and itchy, lotions and creams are recommended to keep the skin moist.” Congleton Decl. ¶ 5, Exh. D; *see also* Congleton ¶ 6, Exh. I (“Treatments for atopic dermatitis (eczema) aim to reduce inflammation, relieve itching and prevent future flare-ups.”). While there are several medications available to treat eczema, “[u]sing moisturizers is the best and safest treatment to prevent dry skin.” Congleton Decl. ¶ 5, Exh. F; *see also* Congleton Decl. ¶ 5, Exh. E (“Keeping the skin well hydrated through the application of creams or ointments (with a low water and high oil content) as well as avoiding over-bathing . . . is an important step in treatment.”). Alternative therapies, such as, among others, herbal and homeopathic remedies, hypnosis, and acupuncture have been touted as treating eczema. Congleton Decl. ¶ 5, Exh. G; Congleton Decl. ¶ 6, Exh. I.

4. The Nature of Registrant’s RESTORADERM-Branded Goods

Registrant currently offers two RESTORADERM-branded products in the United States for sale in retail stores nationwide: RESTORADERM Skin Restoring Body Wash and RESTORADERM Skin Restoring Moisturizer. Kee Decl. ¶ 7, Exhs. A – C. The products were specifically designed to work together as a daily regimen to provide continuous relief for those struggling with atopic dermatitis and/or eczema-prone skin. Kee Decl. ¶ 8, Exhs. A, B.

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Registrant's RESTORADERM products feature clinically proven, advanced skin care technology, including:

- Filaggrin™ Breakdown Products – arginine and sodium-PCA, two ingredients with an affinity for, and ability to, trap water; and
- Patented ceramide technology – proprietary technology which works to trap water in the skin.

Kee Decl. ¶ 9, Exhs. A, B.

Registrant's RESTORADERM Skin Restoring Body Wash is a foaming wash specially formulated to help skin retain moisture and maintain the skin barrier function. Kee Decl. ¶ 10, Exhs. A, B. Registrant's RESTORADERM Skin Restoring Moisturizer is specially formulated to restore moisture to atopic and/or eczema-prone skin and to help replenish, repair, and protect the skin's natural moisture barrier. Kee Decl. ¶ 11, Exhs. A, B. Indeed, it is clinically proven “to increase[] skin hydration and restoration of skin barrier function among children and adults with a history of [atopic dermatitis].” Kee Decl. ¶ 19, Exh. L. It is “suitable for both long-term management and the short-term treatment of atopic dermatitis.” Kee Decl. ¶ 19, Exh. L.

Both products have been awarded the National Eczema Association's Seal of Acceptance, which is awarded to products sold in the United States that have been created or intended for use by persons with eczema or severe sensitive skin conditions and have satisfied certain other NEA Seal of Acceptance Criteria. Kee Decl. ¶ 12, Exh. A – C; Congleton Decl. ¶ 5, Exh. H.

Based on the RESTORADERM products' various properties, technologies, and purposes, they clearly fall within the common understanding of a “therapy” or “treatment” for the skin disorder eczema. Thus, Registrant is currently using the RESTORADERM mark as identified in the Registration.

- B. Registrant and its predecessor in interest, CollaGenex, have actively and continuously developed RESTORADERM-branded products from the Registration's filing date through the present, culminating in the nationwide sales of Registrant's current RESTORADERM products.**

At least as early as February 28, 2002, CollaGenex had a bona fide intent to develop and market therapeutic skin care preparations and treatment for skin disorders under the mark RESTORADERM, as

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evidenced by CollaGenex's declaration under oath in support of its filing of the trademark application resulting in the Registration.

Over the next few years, CollaGenex worked toward developing RESTORADERM products as either a stand-alone treatment for skin barrier disruption or as a mechanism for delivering drugs into the dermis. Petitioner's Initial Disclosure documents alone provide substantial evidence of CollaGenex's continued development efforts leading up to its 2005 first use in commerce of the mark on the goods identified in the Registration. Such documents include:

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By May 27, 2005, CollaGenex began using the mark in U.S. commerce on the goods identified in the Registration, as evidenced by CollaGenex's filing of a Statement of Use declaring under oath that the mark was in use at least as early as May 27, 2005. Also in 2005, as discussed and exhibited in Petitioner's Amended Petition, CollaGenex consultant, Dr. J.F. Fowler, completed a study of a RESTORADERM foam formulation to measure the effectiveness of the product in reducing or eliminating dermatitis. *See* Amended Pet. ¶ 20, and Exh. 9 attached thereto.

CollaGenex's continued product development efforts throughout 2006 are also established by Petitioner's own Initial Disclosure documents. Such documents include:

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CollaGenex's product development activities and intention to establish a RESTORADERM brand for skin care products continued in 2007. On July 6, 2007, CollaGenex filed a trademark application, which resulted in U.S. Reg. No. 3,394,514, to register RESTORADERM for "non-medicated skin care preparations," declaring under oath that the mark was in use in U.S. commerce on such goods. In support, CollaGenex submitted a photograph of a container whose label bore the RESTORADERM mark and identified the contents as a moisturizing foam with skin barrier properties and a unique, patent pending formulation containing ceramides and other skin precursors that helps regenerate damaged skin.

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Shortly thereafter, on April 10, 2008, Registrant acquired CollaGenex, including all of CollaGenex's right, title, and interest in and to the RESTORADERM mark and its trademark registrations and applications. Congleton Decl. ¶ 9, Exh. P. Pursuant to the acquisition, Registrant acquired all of the business assets and technology then associated with the development of RESTORADERM products.

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Disease-specific products, like as the current RESTORADERM products, can take several years to develop, and development of such products typically involves clinical testing and evaluation of several technologies and platforms. Clapp Decl. ¶ 7.

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Four of the studies completed on the

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RESTORADERM formulations during the period formed the basis of an article published in the peer-reviewed publication *Journal of Drugs in Dermatology*. See Decl. ¶ 19, Exh. L.

Following these clinical studies and assessments, Registrant decided upon formulations that achieved Registrant's product goals of offering skin care products for the treatment of atopic dermatitis that both increased skin hydration and restored skin barrier function. See Decl. ¶ 14. These formulations are the basis of the current RESTORADERM products. See Decl. ¶ 14.

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end of July 2010, the RESTORADERM products were available in retail stores across the United States. Kee Decl. ¶ 18, Exh. E, slide no. 26.

Registrant considers the RESTORADERM brand and business to be important and valuable assets.

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Registrant expends substantial resources in protecting and promoting the brand.

To protect the value of Registrant's RESTORADERM brand, Registrant and its predecessor in interest have made over 108 trademark filings in over 57 jurisdictions worldwide. Declaration of Maud Robert ("Robert Decl.") ¶ 9, Exh. A. Of those 108 filings, 101 were filed in 2009 and 2010 in International Classes 3, 5, and/or 10 for various dermatological skin care products and devices. Robert Decl. ¶ 9, Exh. A. Included among these is Registrant's U.S. Application Serial No. 77/805,846, filed August 17, 2009, based on a bona fide intent to use the mark in U.S. commerce, to register RESTORADERM for the following goods:

- "Cosmetics and skin care preparations, namely, face, hand and body soaps, cleansers and moisturizers; hair shampoos and conditioners; sunblocks and sunscreens" in International Class 3;
- "Pharmaceutical and medical preparations, namely, oral and topical drugs for the treatment of inflammatory disorders of the skin, namely, acne, dermatitis, psoriasis, eczema, rosacea, and related disorders" in International 5; and
- "Medical devices, namely, syringes, auto-injectors and needles to be used in the filed of dermatology."

Robert Decl. ¶ 9.

The undisputed facts and evidence, much of which has been provided by Petitioner himself, chronicle Registrant and CollaGenex's use of the mark and their active and continuous development of RESTORADERM-branded products as "therapeutic skin care preparations and treatment for skin disorders" from the filing date of the application leading to the Registration through to the present.

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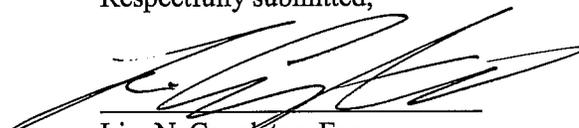
IV. Conclusion

Registrant has not abandoned the mark in the Registration. Rather, it sells multiple RESTORADERM-branded products at retail stores throughout the United States on goods identified in the Registration. At no time since CollaGenex filed the application leading to the Registration through to the present has there been any period in which Registrant or CollaGenex ceased using the mark with intent not to resume use. On the contrary, the detailed facts and evidence submitted herein conclusively establish that Registrant, and CollaGenex before it, at all times actively and continuously developed RESTORADERM-branded products from the Registration's filing date through to the present, culminating in the successful sales of Registrant's current RESTORADERM products.

Accordingly, Registrant has established that there is no genuine issue of material fact that Registrant has not abandoned the mark identified in the Registration and hereby moves the Board for summary judgment against Petitioner's claim of abandonment of the Registration.

Respectfully submitted,

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