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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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Attachments	Registrant's Motion for Summary Judgment.pdf (10 pages)(848755 bytes)

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

Thomas Sköld Petitioner, v. **Galderma Laboratories, Inc.** Registrant.	§ § § § § § § §	Cancellation No.: 92052897 Mark: RESTORADERM Reg. Nos.: 2,985,751 and 3,394,514

REGISTRANT'S MOTION FOR SUMMARY JUDGMENT

Pursuant to Fed. R. Civ. P. 56, 37 C.F.R. § 2.127, and T.B.M.P. § 528, Registrant, Galderma Laboratories, Inc., hereby moves the Trademark Trial and Appeal Board (the "Board") for summary judgment against Petitioner's only remaining ground at issue in this Cancellation, namely, priority and likelihood of confusion against Registrant's U.S. Reg. Nos. 2,985,751 and 3,394,514.

I. Introduction

Resolution of the instant motion does not require complex legal analysis, credibility determinations, or any material factual disputes. Rather, because Petitioner has the burden of persuasion in this Cancellation and has yet to come forward with evidence supporting prior rights, the undisputed facts show that Registrant is entitled to judgment as a matter of law dismissing Petitioner's only remaining ground for cancellation of priority and likelihood of confusion.

Importantly, Registrant is entitled to a priority date of at least as early as February 28, 2002, with respect to its RESTORADERM mark. Logically, then, in order for Petitioner to successfully challenge Registrant's registrations on his asserted grounds, he would have to produce at least some evidence of proprietary rights arising prior to February 28, 2002. Yet, despite ample opportunity and a myriad of discovery requests aimed at eliciting such information, Petitioner has failed to produce ***any*** evidence that would support his claim of prior use sufficient to establish the elements necessary for creating proprietary rights under any standard. Without any evidence whatsoever to support of Petitioner's priority claim,

judgment in favor of Registrant must be granted as a matter of law, and the Board should dismiss this Petition for Cancellation in its entirety.

II. Summary Judgment Standard

Summary judgment is proper if the record indicates that there is no genuine issue of material fact and the moving party is entitled to judgment as a matter of law. Fed. R. Civ. Proc. 56(c). The question of whether a material fact "creates a genuine issue [for trial] must be evaluated in light of the substantive standard of proof that would apply at the trial on the merits." *United States v. Leak*, 123 F.3d 787, 793 (4th Cir. 1997). *See also Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986) (holding that a summary judgment motion must be considered in light of the evidentiary burden the substantive law places on the non-moving party). It is well-settled that "the burden of persuasion in a cancellation proceeding rests on the party seeking to cancel the registration" because "[a] mark registered on the Principal Register is presumed to be valid." *Cold War Museum Inc. v. Cold War Air Museum Inc.*, 586 F.3d 1352, 92 U.S.P.Q.2d 1626, 1628 (Fed. Cir. 2009).

Accordingly, as the moving party without the evidentiary burden in this cancellation proceeding, Registrant "**need show only that [Petitioner] cannot sustain his burden at trial**" in order for summary judgment to be granted in its favor. *See Calderone v. United States*, 799 F.2d 254, 259 (6th Cir. 1986) (emphasis added); *Database Excelleration Sys. Inc. v. Imperial Tech.*, 1999 WL 296277, 50 U.S.P.Q.2d 1527, 1529 (N.D. Cal. 1999) (citing *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986)) ("Rule 56(c) mandates the entry of summary judgment against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case and on which that party will bear the burden of proof at trial.").

Additionally, "[a] mere scintilla of evidence is not sufficient to oppose a motion for summary judgment, nor is a metaphysical doubt as to the material facts." *WMH Tool Group Inc. v. Woodstock Int'l Inc.*, 2009 WL 6825247, 93 U.S.P.Q.2d 1570, 1576 (N.D. Ill. 2009) (citing *Robin v. Espy Eng. Corp.*, 200

F.3d 1081, 1088 (7th Cir. 2000)). Rather, the evidence must be such "that a reasonable jury could return a verdict for the nonmoving party." *Id.* (quoting *Anderson*, 477 U.S. at 248).

This proceeding presents the appropriate record for entry of summary judgment in favor of Registrant on Petitioner's only remaining alleged ground for cancellation, namely, priority and likelihood of confusion under Section 2(d) of the Lanham Act. No additional material facts that could be uncovered through trial are necessary to resolve the issue this Motion for Summary Judgment addresses. The necessary material facts are not in dispute, and Registrant, therefore, is entitled to judgment as a matter of law on the issue presented.

III. Statement of Undisputed Facts

On February 28, 2002, Registrant's predecessor in interest, CollaGenex Pharmaceuticals, Inc. ("CollaGenex"), filed the U.S. trademark application to register the mark RESTORADERM maturing into U.S. Reg. No. 2,985,751. That registration, covering "therapeutic skin care preparations and treatment for skin disorders," is valid and subsisting. Registrant, therefore, is entitled to a priority date with respect to the mark of February 28, 2002 (the "Priority Date").

CollaGenex filed a subsequent U.S. trademark application to register the mark RESTORADERM on July 6, 2007, which matured into U.S. Reg. No. 3,394,514. That registration, covering "non-medicated skin care preparations," is valid and subsisting.

Petitioner does not own any U.S. federal registrations that pre-date Registrant's Priority Date, and, during the course of discovery, Petitioner has produced no admissible evidence sufficient to establish his priority claim.

IV. Petitioner cannot produce any admissible evidence to establish priority in the RESTORADERM mark.

Petitioner's only remaining ground for cancellation in this proceeding is priority and likelihood of confusion under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d). Petitioner's allegations of priority of use are based on his use of the identical mark RESTORADERM. *See* Amended Petition ¶¶ 43-48. Petitioner has had ample opportunity to produce evidence during the course of discovery supporting his

claim of priority of use, and he has failed to do so. Petitioner can produce no admissible evidence to establish that Petitioner used RESTORADERM prior to the Priority Date in any manner sufficient to vest Petitioner with proprietary rights in the mark.

To establish priority and likelihood of confusion under Section 2(d) of the Lanham Act, Petitioner must show proprietary rights in the mark that arose prior to the Priority Date and that produce a likelihood of confusion. *See* 15 U.S.C. § 1052(d); *Herbko Int'l, Inc. v. Kappa Bookes, Inc.*, 308 F.3d 1156, 1162, 64 U.S.P.Q.2d 1375, 1378 (Fed. Cir. 2002) (citing *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 1320, 209 U.S.P.Q. 40, 43 (CCPA 1981)). Priority of use can arise through prior federal registration of a mark; actual trademark use; or other use sufficient to establish proprietary rights in the mark. *See* 15 U.S.C. § 1052(d); *Herbko Int'l, Inc.*, 64 U.S.P.Q.2d at 1378; *Weatherford/Lamb, Inc. v. C&J Energy Servs., Inc.*, 96 U.S.P.Q.2d 1834, 1838 (T.T.A.B. 2010).

Because it is undisputed that Petitioner lacks any prior U.S. federal registrations, he can establish prior rights in the RESTORADERM mark only through a showing of prior actual trademark use in the United States or other use sufficient to establish proprietary rights in the United States arising prior to the Priority Date. *See Herbko Int'l, Inc.*, 64 U.S.P.Q.2d at 1378 (citing *Otto Roth*, 209 U.S.P.Q. at 43)).[1]

Petitioner can produce no admissible evidence giving rise to any prior rights whatsoever, regardless of the lens through which Petitioner's alleged "use" is viewed. Petitioner, therefore, cannot establish at trial that he has any prior proprietary rights in the RESTORADERM mark, and summary judgment denying his cause for priority and likelihood of confusion under Section 2(d) is proper.

A. Petitioner has no evidence of actual use of RESTORADERM as a trademark in the U.S. before the Priority Date.

Petitioner has no evidence of actual use of RESTORADERM as a trademark for any good or service in the United States sufficient to establish rights in the mark prior to the Priority Date. Priority of ownership may be established as of the "first actual use of a mark in a genuine commercial transaction" in

[1] Because Petitioner cannot establish priority, Registrant need not address the issue of likelihood of confusion. *See Otto Roth*, 209 U.S.P.Q. at 43 (An "opposer must prove he has proprietary rights in the term he relies upon to demonstrate likelihood of confusion as to source . . . .").

the marketplace in the United States. *Allard Enters., Inc. v. Adv. Programming Res., Inc.*, 146 F.3d 350, 358, 46 U.S.P.Q.2d 1865, 1870 (6th Cir. 1998). Commercial transactions that are sporadic or minimal will not support use sufficient to create trademark rights. *Aktieselskabet AF 21. November 2001 v. Fame Jeans Inc.*, 86 U.S.P.Q.2d 1527, 1536 (D.C. Cir. 2008); *Zazu Designs v. L'Oreal, S.A.*, 979 F.2d 499, 503, 24 U.S.P.Q.2d 1828, 1831 (7th Cir. 1992) ("A few bottles sold over the counter . . . and a few more mailed to friends" are not sufficient use.).

1. Petitioner did not use RESTORADERM as a trademark in connection with goods in trade.

Petitioner's claim of priority is based on his alleged use of RESTORADERM before the Priority Date in connection with the following goods: "a dermatology product" (*see* Amended Petition ¶ 44) and "a technology. . . for delivering pharmaceutically active substances into or through the dermis of a patient" (*see* Amended Petition ¶ 9). Petitioner cannot establish that he used the mark in connection with the alleged goods in a commercial transaction prior to the Priority Date. Specifically, he has produced no evidence that goods bearing the mark in any manner were sold or transported in the United States prior to the Priority Date. *See* 15 U.S.C. § 1127.[2] Because Petitioner cannot establish that he sold or transported goods in the United States under the RESTORADERM mark, he cannot establish actual of RESTORADERM for purposes of priority.

a. Petitioner had no goods with which to use the mark before the Priority Date.

Petitioner's activities prior to the Priority Date, as alleged in the Amended Petition, clearly relate to his efforts to enter into a relationship with a dermatology company for purposes of ***developing*** a product. *See, e.g.*, Amended Petition ¶¶ 1, 9, 17, 19, 44. In his Amended Petition, Petitioner identified no product with which he could have developed prior rights, and he has produced no evidence of anything

[2] Reference is made to 15 U.S.C. § 1127 as an articulation of the manner of usage and types of commercial activities traditionally governing the establishment of trademark rights in an unregistered mark. *See Allard Enters., Inc.*, 46 U.S.P.Q.2d at 1871; *Weatherford/Lamb Inc.*, 96 U.S.P.Q.2d at 1838.

other than a vague concept of what the final goods would be following his intended collaboration with a product developer.

It is axiomatic that in order to place a mark into actual use with goods, the goods to which the mark relates must be in existence, and not merely in a developmental stage. *Richardson-Vicks Inc. v. Franklin Mint Corp.*, 1982 WL 52049, 216 U.S.P.Q. 989, 991 (T.T.A.B. 1982) (finding that the goods to be identified by the mark must be in existence for commercial use of the mark to commence); *see Gay Toys, Inc. v. McDonald's Corp.*, 585 F.2d 1067, 199 U.S.P.Q. 722, 723 (C.C.P.A. 1978) (finding a plaster mockup of a toy did not constitute the goods of "toys"). For example, in *Richardson-Vicks Inc.*, the Board, in finding the applicant did not establish use of the mark for skin cream, noted that "[a]t the time the shipment of [skin] cream [upon which the applicant alleged first use] took place, there was no specific product or products contemplated to be sold under said mark, applicant only having a somewhat vague concept that women's skin care products would be sold" and that the "applicant's skin care products [were] drawing board items" at that time. 216 U.S.P.Q. at 991-92.

b. Petitioner can offer no evidence of a sale of goods.

It is clear that Petitioner never sold any goods in the U.S. bearing the RESTORADERM mark prior to the Priority Date. During the course of discovery, Petitioner was unable to identify even a single qualifying sale.

c. Petitioner can offer no evidence goods were transported.

It is also clear that Petitioner never commercially transported any goods in the U.S. that bore the RESTORADERM mark prior to the Priority Date. Transportation of branded goods sufficient to constitute actual use of a mark requires that such transportation be in the U.S. and public in nature. *Simmons v. Western Publ'g Co.*, 834 F. Supp. 393, 397, 31 U.S.P.Q.2d 1143, 1146 (N.D. Ga. 1993); *Walt Disney Prods. v. Kusan, Inc.*, 1979 WL 25051, 204 U.S.P.Q. 284, 287 (C.D. Cal. 1979). The limited delivery of material to a small number of potential business partners for purposes of developing or manufacturing a product is not sufficiently public to constitute transportation of the goods giving rise to

proprietary rights. *Simmons*, 31 U.S.P.Q.2d at 1146 ("[S]hipment to a potential manufacturer . . . does not constitute the kind of public use necessary to establish ownership of a mark."); *Walt Disney Prods.*, 204 U.S.P.Q. at 287 (shipment of a prototype game between inventor and manufacturer not a public use for trademark purposes).

Petitioner has produced no evidence during discovery supporting an allegation that RESTORADERM-branded goods were transported in the U.S. prior to the Priority Date.

2. Petitioner did not use the mark in connection with services.

Petitioner's claim of priority is also based on his alleged use of RESTORADERM in connection with the following services: "consulting services for a dermatology product." *See* Amended Petition ¶ 19. To establish trademark use for services, Petitioner must show that he used or displayed the mark in the sale or advertising of the services and that the services were actually rendered. *See* 15 U.S.C. § 1127.

Petitioner cannot establish that he used the mark in connection with such services in commercial transactions prior to the Priority Date. Specifically, he has produced no evidence that the services in which he claims to have rights were actually rendered in connection with the mark in the United States prior to the Priority Date. *See* 15 U.S.C. § 1127. Petitioner's activities prior to the Priority Date, as alleged in the Amended Petition, clearly relate to Petitioner's efforts to enter into an agreement to provide such services. *See, e.g.*, Amended Petition ¶¶ 1, 9, 17, 19, 44. No evidence has been produced during the course of discovery that could establish that Petitioner actually rendered the services in the U.S. prior to the Priority Date. Therefore, Petitioner cannot establish that he actually used the mark in the U.S. in connection with services prior to the Priority Date.

B. Petitioner has no evidence he used RESTORADERM in any other manner in the U.S. sufficient to establish proprietary rights before the Priority Date.

Petitioner has no evidence of use other than actual trademark use sufficient to establish proprietary rights prior to the Priority Date. Certain other uses of a trademark that fail to satisfy technical trademark use may support a claim of priority under Section 2(d) if such use is of a "nature and extent as to create public identification of the target term with the opposer's product or service." *T.A.B. Sys. v.*

PacTel Teletrac, 77 F.3d 1372, 1376, 37 U.S.P.Q.2d 1879, 1882 (Fed. Cir. 1996). *See also Herbko Int'l Inc.*, 64 U.S.P.Q.2d at 1378 (finding such usage must create an association in the minds of the purchasing public between the mark and the goods or services).

Such usage must have a "substantial impact on the purchasing public." *Westrex Corp. v. New Sensor Corp.*, 83 U.S.P.Q.2d 1215, 1217 (T.T.A.B. 2007); *T.A.B. Sys.*, 37 U.S.P.Q.2d at 1882 (finding the opposer did not establish substantial impact on the public by showing a slide show presentation to seven potential customers). The number of potential customers reached is a critical factor. *Westrex Corp.*, 83 U.S.P.Q.2d at 1219 (finding that "opposer's efforts to solicit business ha[d] neither . . . any significant impact on the purchasing public as a whole nor involve[d] more than an insubstantial number of potential customers" (internal citations omitted)).

Petitioner has produced no admissible evidence establishing that he engaged in any activities in the U.S. sufficient to create a public identification of RESTORADERM with Petitioner's alleged services, either in nature or extent. Petitioner, therefore, cannot establish that he owns prior rights based on usage of the mark in the U.S. sufficient to establish priority.

V. Conclusion

Petitioner cannot produce any admissible evidence sufficient to establish that he engaged any in trademark usage or other activities in the United States prior to February 28, 2002 (Registrant's filing date) sufficient to vest Petitioner with any prior proprietary rights in the RESTORADERM mark. Accordingly, there is no genuine issue of material fact that Petitioner does not have priority of use with respect to the RESTORADERM mark before February 28, 2002. Petitioner, therefore, cannot establish his ground for cancellation of priority and likelihood of confusion under Section 2(d) of the Lanham Act at trial, and Registrant is entitled to judgment as a matter of law. Thus, Registrant hereby moves the Board for summary judgment dismissing the present cancellation.

Respectfully submitted,

Date: April 30, 2013

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Thomas Sköld Petitioner,	§ § §	Cancellation No.: 92052897
v.	§ § §	Mark: RESTORADERM
Galderma Laboratories, Inc. Registrant.	§ § §	Reg. Nos.: 2,985,751 and 3,394,514

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this 30th day of April, 2013, the foregoing *Registrant's Motion for Summary Judgment* was served on Petitioner's counsel of record, via email to the following:

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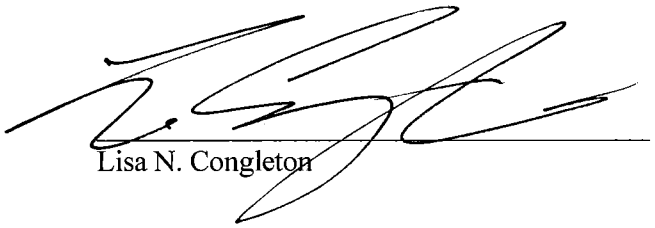

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