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

Proceeding	92052897
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Registration Nos. 2985751; and 3394514

Dated: August 16, 2005 & March 11, 2008, Respectively

Thomas Sköld,)	
Petitioner)	
)	
v.)	
)	Cancellation No. 92052897
Galderma Laboratories, Inc.,)	
Registrant)	
)	

PETITIONER SKÖLD'S TRIAL BRIEF

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PUBLIC

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I. PRELIMINARY STATEMENT

When the actions of one party to an agreement strike the conscience as profoundly wrong – those actions will rarely be found to fall within the intent of the agreement. Here, Registrant, in the form of its predecessor Collagenex, negotiated licensing agreements with Sköld to have Sköld be the developmental moving force for commercially developing skin care products pursuant to a technology which he had presented to it as “Restoraderm.” The development deal had been sealed by Sköld providing to Registrant samples of the base formulation labeled “Restoraderm.”

The record demonstrates that in 2001 Sköld consistently and repeatedly used the term “Restoraderm” in discussing his technology with multiple members of the dermatology community long before the Registrant (or its predecessor, Collagenex) filed for a registration. Indeed, in Collagenex’s 12 February 2002 press release, it acknowledged that it was licensing Sköld’s “Restoraderm technology.”

Throughout the relationship between Sköld and Registrant, the technology and the samples thereof were consistently and repeatedly referred to as “Restoraderm.” The history of the relationship, as evidenced below, clearly shows that “Restoraderm” as the label for the licensed skin care technology was something Sköld brought to the table. When Galderma retained that mark after terminating its agreement with Sköld, it was doing what on its face was a profound wrong. Such a wrong was not within the intent of Galderma’s predecessor’s agreements with Sköld.

After the relationship between Sköld and Registrant had soured, Registrant terminated the agreement, and returned some of the “Purchased Assets,” including among other things the “**Restoraderm** Patent Rights.” The “Purchased Assets” in need

of return were defined in the agreement to include “***all goodwill, if any, relating to the foregoing.***” The mark was clearly part of that goodwill that should have been returned at the same time as the patent rights.

Petitioner Sköld will show, against no factual rebuttal, that he had ***priority*** in the use of “Restoraderm.” He will show that he has consistently used the mark in commerce since his priority use. He will show that his use, though disrupted by the conflict with Registrant, has resulted in financially significant licensing arrangements for the Restoraderm technology in the United States.

Registrant will seek to counter these facts with a facially flawed assertion that a 2002 Agreement between Sköld and Registrant’s predecessor ceded the mark to Registrant. However, that argument is not consistent with §8.5(b) of a superceding 2004 Agreement. Moreover, Registrant’s argument cannot be reconciled with Registrant’s return to Sköld of the Restoraderm Patent Rights, as pursuant to the argument these would have been “irrevocably” assigned as well. Further, Sköld will show against no factual rebuttal that the view inside Registrant’s predecessor, the entity that formed the 2004 Agreement, was that “Restoraderm” would revert to Sköld if it opted to cancel the agreement.

Thus, Sköld has priority rights to the mark which he has maintained, and Registrant’s defense of assignment is ineffective. Accordingly, Registrant’s Registrations Nos. 2985751 and 3394514 should be cancelled.

II. DESCRIPTION OF THE RECORD

Petitioner's Evidence

1. Deposition of Thomas Sköld, taken 13 November 2013, Docket Nos. 76 and 77, which deposition introduced the following Exhibits:

T1	Aug. 17-18, 2004 Emails between D. Glazer and Sköld concerning 2004 Agreement.
T2	2002 Agreement between Collagenex and Sköld. Page 3 of the agreement is provided twice, with the second copy showing the text "Exhibit A" which is visible in the original.
T3	2004 Agreement between Collagenex and Sköld.
T6	Aug. 1, 2004 Consulting Agreement between Collagenex and Sköld.
T7	Aug. 28 – Sep. 4, 2001 Emails btwn Sköld and J Fowler discussing promotional activity with Neutrogena (J&J), Medicis and Allergan.
T8	Mode of Action document
T9	A description of the Restoraderm Technology.
T11	Epitan Agreement dated 9 May 2003. The complete document includes SKOLD-001950, found as Ex. T124.
T12	Dec. 9, 2003 Email from R. Ashley (Collagenex) to other Collagenex personnel.
T15	July 19, 2004 Email J. Day (Collagenex) to Sköld.
T27	Jul. 9 – Jul. 15, 2009 Emails btwn Q. Cassady (Galderma) and Sköld.
T58	Jun. 2, 2009 Email from Q. Cassady (Galderma) to Sköld.
T59	Jun. 16 – 17, 2009 Emails btwn Q. Cassady (Galderma) and Sköld.
T61	Sköld list, sent to Galderma, of items to be returned per Section 8.5 of the 2004 Agreement.
T69	Aug. 31 – Sep. 5, 2001 Emails btwn Sköld and J. Day.
T70	Sep. 3, 2001 Email Sköld to BiCoastal Pharma (Ralph Soldo) re teleconference (email mentions Ortho McNeil/Neutrogena).
T71	Sep. 4 – 5, 2001 Emails btwn Sköld and J. Day (email mentions Allergan).
T73	Sep. 6, 2001 Email Sköld to J. Day (email mentions Medicis).
T74	A business plan prepared by Sköld using the mark Restoraderm.
T125	Sköld recollections of companies to whom Skold assisted in promoting the Restoraderm technology during the term of Sköld's collaborative relationship with Collagenex.

T126	Listing of companies Skold recalls promoting the Restoraderm technology to in the period after his collaborative relationship with Collagenex.
T130	U.S. Patent 8,029,810, resulting from the patent Skold filed in collaboration with Collagenex to cover Restoraderm technology.
T132	Listing of Skold's recollections of meetings Skold undertook to promote Restoraderm technology.
T133	Listing of drugs for which Skold recalls having supervised the formulation in Restoraderm technology, with an indication of stability for many.
T143	Fowler et al., a published scientific poster presented at a American Contact Dermatitis Society, 16th Annual Meeting, February 17, 2005 (New Orleans, LA).
T145	Document authentication worksheet.
T146	Declaration of Thomas Sköld dated 14 May 2013.
T147	Letter, 3/3/10, from T. Skold to Galderma enclosing Assignment of Patents.

2. Deposition of Jeffrey Day, taken 14 November 2013, Docket Nos. 76 and 77, which deposition introduced the following Exhibits:

T2	2002 Agreement between Collagenex and Sköld. .
T8	Mode of Action Document.
T74	A business plan prepared by Sköld using the mark Restoraderm.
T143	Fowler et al., a published scientific poster presented at a American Contact Dermatitis Society, 16th Annual Meeting, February 17, 2005 (New Orleans, LA).
T148	Affidavit of Jeffrey S. Day dated 15 May 2013.

3. Deposition of Dr. James G. Marks, taken 14 November 2013, Docket No. 70, which deposition introduced the following Exhibits:

T149	James G. Marks, M.D. Curriculum Vitae
T150	Email, 1/11/02, from Ylva Margereta Skoglosa, and stapled document

4. Deposition of Thomas Sköld, taken 14 January 2014, Docket Nos. 74 and 75, which deposition introduced the following Exhibits:

T4	Nov. 27, 2009 notification of termination from Galderma to Sköld.
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T5	Feb. 22, 2010 Assignment of patent estate from Galderma to Sköld.
T10	Oct. 22, 2002 Email from Sheila Kennedy (Collagenex) to Sköld.
T13	Draft amendments to agreement attached to SKOLD-000036.
T14 T91 ¹	Jul. 10 – 12, 2004 Emails btwn J. Day (Collagenex) and Sköld (Email mentions Therapeutics, Inc./Product Development Co.).
T16	Oct. 4, 2004 Emails btwn Collagenex and Sköld.
T17	Dec. 15, 2005 G. Ford (Collagenex) to Sköld.
T18	Feb. 27, 2006 B. Zerler (Collagenex) to Sköld (with attached data).
T19	Jul. 7, 2006 Wiggin&Dana (Sköld attorneys) ltr to Collagenex.
T20	Jun. 27 – Jul. 27, 2006 Emails btwn G. Ford (Collagenex) and formulator, copying Sköld.
T21	Jul. 27 – Aug. 1, 2007 Emails btwn G. Ford (Collagenex) and Sköld re American Academy of Dermatology (AAD) meeting.
T22	Jan. 29, 2008 Wiggin&Dana (Sköld attorneys) ltr to Collagenex.
T23	Sep. 1, 2008 Emails btwn S Samira (Galderma) and Sköld, attaching memo on technology consultation meeting (“Restoraderm technical Meeting”).
T24	Sep. 3, 2008 Emails btwn S Samira (Galderma) and Sköld.
T25	Sep. 1 – Sep. 4, 2008 Emails btwn S Samira (Galderma), L Fredon (Galderma) and Sköld.
T26	Sep. 8, 2008 Email btwn S Samira (Galderma) and Sköld, attaching revised memo on technology consultation meeting (“Restoraderm technical Meeting”).
T28	Dec. 1, 2009 Email Sköld to C de Bruyne (Galderma).
T29	Jan. 27 – Feb. 8, 2010 Emails btwn J Wallace (Galderma) and Sköld.
T30	May 21 – 29, 2007 Emails btwn Sköld and [REDACTED] email mentions [REDACTED].
T31	24 Jul. 2008 Emails btwn Sköld and [REDACTED].
T32	Aug. 1, 2007, Email [REDACTED] recommending Sköld’s dermatology products to [REDACTED].
T33	Aug. 2-4, 2007 Emails btwn [REDACTED] and Sköld.
T34	Powerpoint on a mucosal form of the Restoraderm technology. Attached to Email of SKOLD-000102-3 (T33), and to Email of SKOLD-000117-18 (T35).

¹ Exhibits T14/T91, T48/T134, T76/T136, T81/T138, T82/T139 and T86/T141 are inadvertent replicate copies.

T35	Aug. 3 – 4, 2007 Emails btwn [REDACTED] and Sköld.
T36	Business plan on a mucosal form of the Restoraderm technology. Attached to Email of SKOLD-000117-18 (Ex. T35).
T37	Spreadsheet attached to Email of SKOLD-000117-18 (Ex. T35).
T38	Jan. 7 – 13, 2008 Emails btwn Sköld, [REDACTED] (Email mentions [REDACTED]).
T39	Jan. 15 – 25, 2008 Emails btwn Sköld, [REDACTED] (Email mentions [REDACTED]).
T40	Mar. 3, 2010 Email (with attachments) to [REDACTED], including an FDA Meeting Report from 2004 on a [REDACTED] Restoraderm product, and the “Restoraderm Development Report” of Feb. 30, 2005.
T41	Feb. 11 – Mar. 17, 2010 Emails btwn Sköld and [REDACTED]
T42	Aug. 19 – 22, 2011 Emails btwn [REDACTED] and Sköld.
T43	Aug. 29, 2011 Emails with btwn Sköld and [REDACTED].
T44	Dec. 13 – 15, 2011 Emails btwn Sköld and [REDACTED].
T45	Nov. 29, 2007 Emails btwn G. Ford (Collagenex) and Sköld.
T46	Feb. 12, 2008 Collagenex response ltr to Wiggin&Dana.
T47	PowerPoint presentation on Restoraderm with Collagenex logo. The presentation was attached to the Email of SKOLD-001790-91 (Ex. T53, below).
T48 T134	Feb. 14, 2002, J. Day (Collagenex) Email to Sköld (Email mentions P&G).
T49	Dec. 5 – 6, 2010 Emails btwn Sköld and [REDACTED]
T50	Jan. 26, 2004 Email J. Day (Collagenex) to Sköld (Email mentions Sci. Advisory Bd).
T51	Statement from Collagenex of agreed term sheet for 2004 Agreement.
T52	Jul. 15, 2004, Email J. Day (Collagenex) to Sköld (Email mentions Abramovitz).
T53	Sep. 3 – 8, 2004, Emails btwn Ranbaxy, Sköld and Collagenex.
T54	Meeting agenda attached to SKOLD-001790 (Ex. T53).
T55	Oct. 26, 2004 Email G. Ford (Collagenex) to Sköld (Email mentions Galderma).
T56	Nov. 3 – 18, 2004 Emails btwn Collagenex parties and Sköld on additional Restoraderm samples from Sköld
T57	Mar. 10 –16, 2009 Email btwn A. Clapp (Galderma) and Sköld.
T60	Jun. 22, 2009 Q. Cassidy (Galderma) to Sköld.
T62	May 31 – Jul. 14, 2010 Emails btwn C de Bruyne (Galderma) to Sköld.

T63	Sep. 14, 2010 Press Release from Galderma on Cetaphil Restoraderm.
T64	Mar. 11 – 22, 2010 Emails introducing Sköld to [REDACTED] and btwn Sköld and [REDACTED].
T65	Jun. 1 – 2, 2010 Emails btwn Sköld and [REDACTED]
T66	Oct. 4 – 5, 2010, Emails btwn Sköld and [REDACTED]
T67	Feb. 10 – 21, 2011 Emails btwn Sköld and [REDACTED]).
T68	Jun. 30, 2011 Email Sköld to [REDACTED] re meeting.
T72	Sep. 4, 2001 Email J. Day to Sköld on meeting Collagenex, Neutrogena/Ortho, Medicis and Allergan .
T75	Feb. 17 – 18, 2002 Emails btwn J. Day (Collagenex) and Sköld (Email mentions Connectics).
T76 T136	Mar. 21 – May 1, 2002 Emails btwn Collagenex and Sköld (Email mentions ATS (Advanced Tissue) and Atrix (Steve Garrett)).
T77	Apr. 29 – May 3, 2002 Emails btwn R. Ashley (Collagenex) and Sköld.
T78	May 7, 2002 Email J. Day (Collagenex) to Sköld re presentation to Board.
T79	Apr. 12 – Jun. 26, 2002 Emails btwn R. Ashley (Collagenex), Epitan and Sköld.
T80	May 27 (Sweden) – May 26 (AU), 2005 Emails btwn Sköld and Epitan.
T81 T138	Oct. 4 – 9, 2002 Emails btwn Collagenex and Sköld (Email mentions Fujisawa (Hean Rumsfield), Ortho, Watson).
T82 T139	Mar. 7 – 10, 2003 Emails btwn Collagenex and Sköld (Email mentions Ortho).
T83	Mar. 13 – 14 Emails btwn J. Day (Collagenex), Sköld and others re AAD meeting, with attached agenda.
T84	May 12 – 16, 2003 Emails btwn J. Day (Collagenex), Sköld and R Ghadially.
T85	Jul.21, 2003 J. Day (Collagenex) to D. Goostree of Skin Medica, Inc.
T86 T141	Oct. 2 – 4, 2003 Emails btwn Collagenex and Sköld (Email mentions Cardinal).
T87	Oct. 23 – 24, 2003 Emails btwn J. Day (Collagenex) and Sköld. ²
T88	Oct 25 – Nov. 7, 2003 Emails btwn J. Day (Collagenex) and Sköld.
T89	Jun. 30 – Jul. 8, 2004 Emails btwn J. Day (Collagenex), Sköld and others.

² On review, this Ex. T87 is found to be an incomplete copy of the email. A complete copy is found in Exhibit T142.

T90	Feb. 27 – Sep 27, 2004 Emails btwn J. Day (Collagenex), Galderma and Sköld (Email mentions Galderma).
T92	Feb. 20 – Aug. 9, 2004 Emails btwn J. Day (Collagenex), Sköld and others (Email mentions TexasDerm).
T93	Aug. 16 – 17, 2004 Emails btwn J. Day (Collagenex), Sköld, others (Email mentions Ranbaxy).
T94	Sep. 10, 2004 Email BZ (Collagenex) to Sköld (Email mentions Ranbaxy), attaching an initial outline.
T95	Mar. 2 – Mar. 4, 2005 Emails btwn G. Ford (Collagenex), Sköld.
T96	Sept. 28, 2004 Email InyX-Pharma to G. Ford (Collagenex), Sköld, others.
T97	Jun. 14, 2005 Email G. Ford (Collagenex) to Sköld.
T98	Jan. 22, 2007 Email G. Ford (Collagenex) to Sköld (Email mentions Pfizer and J&J).
T99	Aug. 3 – 9, 2007 Emails btwn Sköld and Stiefel.
T100	Nov. 17 – Dec. 10, 2007 Emails btwn Sköld and [REDACTED] on introduction to [REDACTED]
T101	Jan. 30 –31, 2008 Emails btwn Sköld and [REDACTED].
T102	Jan. 30, 2010 Emails btwn Sköld and [REDACTED]
T103	Jan. 28 – Feb 10, 2010 Emails btwn Sköld and [REDACTED] (Email mentions [REDACTED]).
T104	May 18, 2010 Emails btwn Sköld and [REDACTED]
T105	Feb. 18 – 23, 2010 Emails btwn Sköld and [REDACTED] on a teleconference.
T106	Sep. 8, 2010 Email [REDACTED] to Sköld confirming recent meeting.
T107	Oct. 26, 2010 Email [REDACTED] to Sköld. (Translation attached; Email attachment with questions attached).
T108	Nov. 15 – 19, 2010 Emails btwn Sköld and [REDACTED]
T109	Nov. 27 – 30, 2010 Emails btwn Sköld and [REDACTED].
T110	Nov. 29, 2010 Email Sköld to [REDACTED] et al. ([REDACTED]) on signed CDA.
T111	Nov. 2 – 4, 2011 Emails btwn [REDACTED] and Sköld.
T112	Feb. 11 – May 17, 2010 Emails btwn [REDACTED] and Sköld.
T113	Jul. 8 – 26, 2011 Emails btwn Sköld and [REDACTED]
T114	Jun. 7 – 30, 2011 Emails btwn [REDACTED] and Sköld.
T115	Sep. 8 – 9, 2011 Emails btwn Sköld, [REDACTED] r (CDA).

T116	Jan. 5 – 7 Emails between Sköld and [REDACTED]).
T117	Jan. 20, 2012 Emails between [REDACTED] and Sköld.
T118	Apr. 10 –11, 2012 Emails btwn [REDACTED] and Sköld.
T119	Oct. 12, 2011 Email from Sköld to [REDACTED]
T120	Feb. 1, 2013 Email J. Day to Sköld.
T121	May 6 – 10, 2006 Emails btwn G. Ford (Collagenex) and Sköld.
T122	May 11, 2006 Emails btwn G. Ford (Collagenex) and Sköld.
T123	Feb. 6, 2008 Email [REDACTED] to Sköld.
T124	Page from Epitan Agreement. This is the page missing from Ex. T11.
T127	Apr. 9 – 15, 2010 Emails btwn Sköld and [REDACTED].
T128	Oct. 10 – 11, 2010 Emails btwn Sköld and [REDACTED].
T129	Collagenex Form 10-K for the fiscal year ended December 31, 2001.
T131	Feb. 12, 2002 Press Release from Collagenex on “Restoraderm drug delivery technology” as published by Business Wire.
T135	Feb. 18, 2002 Emails btwn J. Day and Sköld regarding promotion (Optime).
T137	Apr. 29 – May 3, 2002 Emails btwn Collagenex and Sköld (Email mentions Antares Pharma (Dario Carraras)).
T142	Sep. 18 – Oct 24, 2003 Emails btwn Collagenex and Sköld (Email mentions Novartis (Katrin Kriwet)).
T144	pp. 1-3, 5-6 and 10 of the meeting program of the American Contact Dermatitis Society, 16th Annual Meeting, February 17, 2005 (New Orleans, LA).

5. Sköld Notice of Reliance, 6 December 2013, Docket No. 63:

T63	Sep. 14, 2010 Press Release from Galderma on Cetaphil Restoraderm.
T129	Collagenex Form 10-K for the fiscal year ended December 31, 2001, p. 17 (from www.sec.gov/Archives/edgar/data/1012270/000090310002000094/form10k_123101.txt)
T130	U.S. Patent 8,029,810, resulting from the patent Petitioner filed in collaboration with Collagenex to cover Restoraderm technology.
T131	Feb. 12, 2002 Press Release from Collagenex on “Restoraderm drug delivery technology” as published by Business Wire.
T144	Pp. 1-3, 5-6 and 10 of the meeting program of the American Contact Dermatitis Society, 16th Annual Meeting, February 17, 2005.

T151	A web page obtained at http://business.highbeam.com/industry-reports/equipment/electron-tubes on 10 May 2013.
T152	A web page obtained at http://en.wikipedia.org/wiki/Tube_sound .
T153	A web page obtained at http://hometheater.about.com/od/vacuumtubeaudio/a/vacuumtubeaudio.htm .
T154	Registrant's Supplemental Response to Petitioner Sköld's First Request for Admissions.
T155	Registrant's Supplemental Response to Petitioner Sköld's First and Second Sets of Interrogatories and Requests for Production of Documents and Things.
T156	Exhibit B to Declaration of Cindy Kee, filed with Registrant's Motion for Partial Summary Judgment of April 27, 2012.

5. Sköld Responsive Notice of Reliance, 14 May 2014, Docket No. 68:

T157	Petitioner's Response to Registrant's Second Request for Admissions (portion).
T158	Petitioner's Supplemental Response to Registrant's Second Request for Admissions.
T159	Petitioner Sköld's Supplemental Response to Registrant's First Set of Interrogatories

Registrant's Evidence

1. Cross-examination of Thomas Sköld, taken 13 November 2013, Docket Nos. 76 and 77, which examination introduced the following Exhibits:

A	Email chain, 1/13/08, from ██████s to T. Skold, subject: RE: Derm delivery system SKOLD-000164 – 000166
B	Letter, 12/12/01, from R. Ashley 112 to T. Skold, Letter of Intent GAL-000005 - 000006
C	Email chain, 5/1/02, from R. Ashley to T. Skold, subject: RE: Visit to ATS SKOLD-001850 – 001851.
D	Water-Based Topical Delivery System.
E	Asset Purchase and Product Development Agreement by and between Collagenex Pharmaceuticals Inc. and Thomas Skold, dated as of August 19, 2004.
F	DRAFT Collagenex Pharmaceuticals Inc. and Thomas Skold, SKOLD-000241 – 000775.
G	Email, 2/1/13, from J. Day to T. Skold, subject: Possible Development Deal (Restoraderm) SKOLD-002042.

2. Cross-examination of Jeff Day, taken 14 November 2013, Docket Nos. 76 and 77, which examination introduced:

H	Email, 9/4/01, from J. Day to T. Sköld SKOLD-001841.
I	Email string, 2/17/02, from T. Skold to J. Day SKOLD-001847.
J	Email string, 3/10/03, from T. Skold to J. Day SKOLD-001860 – 001861.
K	Emails, 9/28/10, between J. Day and T. Sköld SKOLD-002135.
L	Email, 2/1/13, from J. Day to T. Sköld SKOLD-001945.
M	Screenshot from Quinnova.com from 11/9/2013.

3. Registrant's Notice of Reliance, 7 February 2014, Docket No. 67:

1	United Kingdom Trademark Reg. No. 2290042 for RESTORADERM, filed January 14, 2002.
2	European Union Trademark Reg. No. 002537074 for RESTORADERM, filed January 14, 2002.
3	Switzerland Trademark Reg. No. 498975 for RESTORADERM, filed January 15, 2002, along with a copy of a certified translation thereof.
4	Norway Trademark Reg. No. 216494 for RESTORADERM, filed January 15, 2002, along with a copy of a certified translation thereof.
5	Israel Trademark Reg. No. 154752 for RESTORADERM, filed January 24, 2002, which includes a parallel certified translation thereof.
6	Press Release from Business Wire, published on February 12, 2002, entitled "CollaGenex Licenses Novel Dermal Delivery Platform."
7	Portions of Petitioner's Responses to Registrant's First Request for Admissions, served by Petitioner on Registrant on January 30, 2012.
8	Portions of Petitioner's Responses to Registrant's Second Request for Admissions, served by Petitioner on Registrant on January 2, 2013.
9	Portions of Petitioner's Responses to Registrant's First Set of Interrogatories, served by Petitioner on Registrant on January 30, 2012.
10	Portions of Petitioner's Responses to Registrant's Second Set of Interrogatories, served by Petitioner on Registrant on January 2, 2013.

III. STATEMENT OF THE ISSUES

- ◆ Did Petitioner have priority in the use in trade in the United States of Restoraderm for topical formulations and/or services in developing such topical formulations? (Priority of use)
- ◆ Did Petitioner continue the mark in trade? (Continuance of Use)
- ◆ Is Registrant's mark confusingly similar to Petitioner's mark? (Marketplace; Similarity of Goods/Services)
- ◆ Was the Restoraderm mark part of "all goodwill" relating to the Purchase Assets of a certain 2004 Agreement, which should have been returned to Petitioner? (Restoraderm Goodwill)
- ◆ Do certain 2002 and 2004 Agreements between Petitioner and Registrant trump Petitioner's priority use and assign the mark to Registrant? (Sköld's Priority Use Not Trumped by Assignment)

IV. RECITATION OF THE FACTS

1. Registrant has admitted that it did not use the term Restoraderm in commerce in connection with any product prior to February 28, 2002. Ex. T154 (Admission No. 1).³ On 28 February 2002, the application that became Reg. No. 2985751 was filed.⁴
2. Petitioner, Sköld, met with Registrant's predecessor in interest, Collagenex Pharmaceuticals, in September, 2001, near the time of the tragic events of Sept. 11, 2001, and presented his Restoraderm technology.⁵ Collagenex was located in Newtown, PA,⁶ and the meeting occurred at Collagenex.⁷ Sköld presented to

³ Petitioner's Exhibits are identified in the format "T #"; Those of Registrant are identified by simple number or letter. As such the Exhibit identifiers are distinct, such that for simplicity "Ex. T154" can be and is used in place of "Petitioner's Ex. T154."

⁴ PTO File Record, Ser. No. 76376659.

⁵ Sköld Dep. 15:17 – 16:23; Day Dep. 6:23 – 7:21.

⁶ Sköld Dep. 67:4-12; Exhibit T2 at 1.

⁷ Sköld Dep. 74:11-21; 76:24 – 77:6.

Collagenex his services in developing formulations of the Restoraderm technology, including formulations with specific drugs.⁸ At the meeting Sköld utilized documents substantially the same as Exhibits T8 and T9, which documents use the phrase “Restoraderm technology.”⁹ At the meeting, Sköld orally used the phrase “Restoraderm technology.”¹⁰

3. In that time frame, he had scheduled a meeting to present his Restoraderm technology to Johnson & Johnson (including its Ortho, McNeil and Neutrogena units), Medicis and Allergan.¹¹ The meeting with Johnson & Johnson occurred face-to-face, on September 11, 2001.¹² At the meeting, Sköld used the substantial equivalents of Exhibits T8 and T9,¹³ and used the term “Restoraderm,” both in documents and orally.¹⁴ The meeting lasted about an hour or a hour and a half, short of its scheduled completion time, with numerous interruptions by announcements about the terrorist attack over speakers.¹⁵

4. Because flights were canceled on September 11, 2001, the meeting with Medicis took place by teleconference, with Sköld again presenting the technology as

⁸ Sköld Dep. 16:7-23.

⁹ Sköld Dep. 17:3-9; 36:14 – 37:11; and 89:20-23.

¹⁰ Sköld Dep. 19:3-5.

¹¹ Sköld Dep. 18:6 – 18; Day Dep.20:12 – 22:20. The Board can and should take Judicial Notice that Johnson & Johnson is the parent corporation for Ortho-McNeil, since the fact is generally well known in the United States, and readily determinable from sources whose accuracy cannot reasonably be questioned. See, e.g., www.sec.gov/edgar/searchedgar/companysearch.html, searching ticker symbol “JNJ”. See also Sköld Dep. 21:16-19.

¹² Sköld Dep. 18:6-18; 36:14 – 37:2; 107:11-16.

¹³ Sköld Dep. 36:14-22; 107:11-16.

¹⁴ Sköld Dep. 19:9-12.

¹⁵ Sköld Dep. 102:18 – 107:16.

“Restoraderm” technology.¹⁶ The scheduled meeting with Allergan did not occur because of these travel issues, and Sköld’s focus on finalizing an Agreement with Collagenex.¹⁷ Sköld did however present the phrase “Restoraderm technology” to Allergan.¹⁸ During the Fall of 2001, Sköld also marketed the Restoraderm technology to Bicoastal Pharma, through Ralph Soldo of Bicoastal Pharma.¹⁹

5. Sköld began development work on a technology that came to be known as Restoraderm in Summer 2001.²⁰ Sköld first manufactured a Restoraderm product in “its real form” in about October 2001.²¹ Sköld delivered samples labeled “Restoraderm” of material for topical application to Collagenex in November and December 2001, and to Collagenex representatives at the January 2002 Caribbean Derm meeting.²²

6. Dr. James G. Marks, Chair of the Department of Dermatology at Pennsylvania State Univ. College of Medicine (from 2002 to 2013²³), found in his files a copy of an email dated 11 January 2002, and a paper stapled thereto with the “original” staple²⁴, which papers have been labeled Ex. T150.²⁵ Though not a named recipient of the email, Marks testified that he was sent Ex. T150 “in preparation for a meeting at the Caribbean

¹⁶ Sköld Dep. 20:3-23.

¹⁷ Sköld Dep. 20:25 – 21:18.

¹⁸ Sköld Dep. 21:13-18; 35:5 – 36:22; Planning for meetings with Johnson & Johnson, Collagenex, Medicis and Allergan collaborated at Ex. T7, T69 – T73.

¹⁹ Sköld Dep. 35:20 – 36:6 (regarding 3 Sep. 2001 email of Ex. T70 to Ralph Soldo).

²⁰ Sköld Dep. 12:23 – 13:14.

²¹ Sköld Dep. 13:16-21.

²² Sköld Dep. 21:20 – 24:7.

²³ Exhibit T149 (Curriculum vitae).

²⁴ Marks Dep. 6:2-14.

²⁵ Marks Dep. 6:1 – 8:14.

Derm to discuss Restoraderm.”²⁶ The attached paper is related to the first page of Exhibit T150 by the original staple, and Dr. Marks testimony on the source and purpose of Exhibit T150. The attached paper is titled “Restoraderm A Product and a dermal delivery technology,” and shares strong similarities with Exhibit T9. The Caribbean Derm meeting began 18 Jan. 2002, and continued for about a week.²⁷

7. A Letter of Intent was formed between Sköld and Collagenex in December, 2001.²⁸ On 11 February 2002, a Co-Operation, Development and Licensing Agreement was signed between Collagenex and Sköld (“2002 Agreement”).²⁹ That agreement would not have been reached had Sköld not delivered product sample to Collagenex prior to execution of the agreement.³⁰ The 2002 Agreement was premised on Sköld continuing to develop the “Technology”³¹ (which among other things is a topical drug delivery system³²).

8. During the time frame for Sköld’s 2001/2002 activity promoting Restoraderm technology to Collagenex, Johnson & Johnson, Medicis, Allergan and Bicoastal Pharma, there were in the United States about ten or a “little bit” more companies that were credible developing dermatology products or most appropriate for marketing a new dermatology development, and these companies included Johnson & Johnson, Novartis

²⁶ Marks Dep. 7:5-21.

²⁷ Sköld Dep. 23:11-17.

²⁸ Sköld Dep. 25:17 – 26:5; Ex. B.

²⁹ Ex. T2.

³⁰ Sköld Dep. 29:9-13; Day Dep. 13:6-21 (“look, feel, smell and how they’re applied to the skin” very important to making establishing such a license agreement).

³¹ Ex. T2 at p. 1.

³² Ex. T2 at §1.10.

Pharmaceuticals, Medicis, Allergan, Galderma, Fujisawa, Ferndale Laboratories, Stiefel and Connetics.³³ In marketing a technology, one cannot offer the technology to too many companies, or you lose value with the loss of exclusivity.³⁴

9. For accounting purposes, Collagenex sought to restructure the 2002 Agreement, resulting in an Asset Purchase and Product Development Agreement dated 19 August 2004 (“2004 Agreement”, Ex. T3).³⁵ As the 2002 Agreement was a license that was reformulated for accounting reasons, and because among other things the 2004 Agreement had an asset reversion provision,³⁶ the substance to the 2004 Agreement remained a licensing agreement. As can be discerned from Ex. T1, the 2004 Agreement was drafted by the law firm of Morgan Lewis, which represented Collagenex/Registrant.³⁷ Earlier that same month, Collagenex and Sköld signed a Consulting Agreement whereby Sköld shall provide “technical consulting and development services with respect to the **Restoraderm Technology** in such manner as shall be requested by the Company from time to time (the ‘Services’).”³⁸ “**Restoraderm Technology** means the topical drug delivery technology developed by Skold and covered in Provisional application filed on March 13, 2002 (Application Serial No. 60/365,059), U.S. Application Serial No. 10/388,371 filed on March 13, 2003 and

³³ Sköld Dep. 29:17 – 30:11; Day Dep. 14:3 – 16:4.

³⁴ Day Dep. 12:3-23.

³⁵ Ex. T12; Sköld Dep. 30:19 – 32:11; Sköld 2nd Dep. 70:14 – 71:25 regarding Ex. T51 (agreed terms).

³⁶ Ex. T3 at Article 8, particularly §8.5(b).

³⁷ Sköld Dep. 137:14 – 138:12.

³⁸ Ex. T6 at §1.

International application Serial No. PCT/US03/07752 filed on March 13, 2003.”³⁹ The Restoraderm technology definition in the Consulting Agreement is coextensive with that of the 2004 Agreement.⁴⁰

10. The 2004 Agreement formalized Sköld’s control of the Restoraderm development via Article 4 and particularly the Joint Steering Committee of §3.1.⁴¹

11. Section 9.12 of the 2004 Agreement “cancels and supersedes any and all prior negotiations...agreements (including the Original [2002] Agreement)... respecting the subject matter hereof and thereof.”⁴²

12. In the course of negotiating the 2004 Agreement, there was an exchange of emails (Ex. T1) between Sköld and Registrant’s attorneys for which Sköld’s response email is out-of-context, as the Sköld response answers a discussion in an interceding teleconference.⁴³ In the teleconference, Registrant’s attorney confirmed that the Restoraderm trademark was part of the asset of the 2004 Agreement.⁴⁴

13. Pursuant to these agreements between Sköld and Collagenex (2002 and 2004), Sköld was paid about [REDACTED], with about [REDACTED] of that being in milestone or milestone-like payments.⁴⁵

14. During the period prior to the acquisition of Collagenex by Galderma, the term “Restoraderm” was exclusively used by Collagenex to refer to Sköld’s technology and

³⁹ Ex. T6 at §1 (emphasis added).

⁴⁰ Ex. T3 at §1.23.

⁴¹ Id.

⁴² Id.

⁴³ Sköld Dep. 57:3 – 58:24.

⁴⁴ Id.

⁴⁵ Sköld Dep. 28:6 – 29:6; Ex. T46 at p. 2 (admission of Powell, General Counsel).

the products thereof.⁴⁶ This use is clear from a wealth of documentary evidence, as indicated below (emphasis added):

Document:	Statement Attributable to:
2004 Agreement (Ex. T3) and Consulting Agreement (Ex. T6), as discussed above	Registrant
Ex. T10 at 1 (“conference call with me and the advertising agency to explain the Restoraderm delivery system”)(22 Oct. 2002)	Sheila Kennedy, Dir. Prod. Marketing Collagenex. See Sköld 2 nd Dep. 27:16-21.
3-Way Agreement. between Epitan Limited, Collagenex and Sköld, Ex. T11 at ¶1.1 (9 May 2003)(“Epitan Agreement”)	Registrant
Ex. T12 at 1 (“Skold is the inventor and developer of Restoraderm ”)(9 Dec. 2003)	Rob Ashley, director of commercial development and #2 in command at Collagenex. See Sköld Dep. 41:25 – 42:5.
Ex. T14 at 1 (“ Restoraderm based products”)(10 Jul. 2004)	Jeff Day, VP Dermatology at Collagenex. See Sköld Dep. 24:22 – 25:2; Day Dep. 6:11-22.
Ex. T15 at 1 (“PH Level range for Restoraderm ?”)(19 Jul. 2004)	Jeff Day, VP Dermatology at Collagenex.
Ex. T16 at 1 (“Our plan is to select a name for the product and refer to it as a ‘PROOUCT NAME, based on the Restoraderm foam technology”)(4 Oct. 2004)	Sheila Kennedy, Dir. Prod. Marketing Collagenex.
Ex. T17 at 1 (“meeting with 20 companies in promoting Restoraderm ”; asking Sköld for more information on “ Restoraderm technology”)(15 Dec. 2005)	Greg Ford, head of business development at Collagenex. See Sköld Dep. 42:9-13.
Ex. T45 at 1 (“difficult decision not to develop a Restoraderm product... decided to divest Restoraderm ”)(29 Nov. 2007)	Greg Ford, head of business development at Collagenex.
Ex. T46 at 1 (“CollaGenex will not return the Restoraderm business”), at 2 (“fulfilled its obligation to develop Restoraderm ”; “did not cease development of Restoraderm products”), at 3 (“CollaGenex procured a trademark... for Restoraderm”)	Andrew Powell, Chief Legal Counsel at Collagenex. See Sköld Dep. 42:14-17.

⁴⁶ Sköld Dep. 38:17-23; 65:4 – 71:8 concerning Ex. T3, T6, T11, T12 and T15; Day Dep. 17:12 – 18:3; Marks Dep. 10:13-18 (see also Marks Dep. 10:3-12, concerning Marks serving on Collagenex’s scientific advisory board).

Document:	Statement Attributable to:
Ex. T47: PowerPoint "Overview of Restoraderm Technology", on Collagenex letterhead (2003)	Registrant. See Sköld 2nd Dep. 66:4 – 67:6.
Ex. T48 at 1 ("Do you believe that a peptide can be delivered into the skin in Restoraderm ")(14 Feb. 2002)	Jeff Day, VP Dermatology at Collagenex.
Ex. T50 at 1 (Sköld asked to explain to Scientific Advisory Bd. "What is Restoraderm ?")(26 Jan. 2004)	Jeff Day, VP Dermatology at Collagenex.
Ex. T52 at 1 (Concerning discussing with expert "in depth about Restoraderm ")(15 Jul. 2004)	Jeff Day, VP Dermatology at Collagenex.
Ex. T55 at 1 (Concerning Collagenex meeting with Galderma and needing "small samples of Restoraderm foam" to give to Galderma)(26 Oct. 2004)	Greg Ford, head of business development at Collagenex.
Ex. T56 at 1 (re " restoraderm /cetphil" and seeking more sample for Galderma)(18 Nov. 2004)	Greg Ford, head of business development at Collagenex.
Ex. T76 at 1 (" Restoraderm the stability testing of the base formulations is progressing well")(1 May 2002)	Rob Ashley, director of commercial development and #2 in command at Collagenex.
Ex. T77 at 1 ("in favor of any and all deals on Restoraderm ")(3 May 2002)	Rob Ashley, director of commercial development and #2 in command at Collagenex..
Ex. T78 at 1 (asking for input on "Synergies with Restoraderm ")(7 May 2002)	Jeff Day, VP Dermatology at Collagenex.
Ex. T79 at 1 (R. Ashley responding to query about " Restoraderm with [REDACTED]")(26 Jun. 2002)	Rob Ashley, director of commercial development and #2 in command at Collagenex.
Ex. T81 at 1 ("Ortho-Neutrogena called... about Restoraderm ")(9 Oct. 2002)	Jeff Day, VP Dermatology at Collagenex.
Ex. T82 at 2 ("new Restoraderm foam") (7 Mar. 2003)	Jeff Day, VP Dermatology at Collagenex.
Ex. T85 at 1 (J. Day responding to questions about " Restoraderm Technology")(21 Jun. 2003)	Jeff Day, VP Dermatology at Collagenex.
Ex. T88 at 1 ("did she use the Restoraderm cream on the first studies")(7 Nov. 2003)	Jeff Day, VP Dermatology at Collagenex.

Document:	Statement Attributable to:
Ex. T89 at 1 (J. Day responding to T Sköld on setting up a " Restoraderm meeting" at the Cayman meeting)(7 Jul. 2004)	Jeff Day, VP Dermatology at Collagenex.
Ex. T90 at 1 (on educating Galderma on Restoraderm)(27 Sept. 2004)	Jeff Day, VP Dermatology at Collagenex.
Ex. T92 at 1 ("will have our Restoraderm inventor contact you")(6 Aug. 2004)	Jeff Day, VP Dermatology at Collagenex
Ex. T94 at 1 (" Restoraderm + Testosterone Project" for Ranbaxy)(10 Sept. 2004)	Brad Zerler, R&D project manager for Collagenex. See Sköld Dep. 42:22-24. Listed in Ex.T94 email as VP Research.
Ex. T95 at 1 (regarding "revised formulation of Restoraderm " for Ranbaxy)(2 Mar. 2005)	Greg Ford, head of business development at Collagenex.
Ex. T97 at 1 (seeking assistance on Restoraderm)(14 Jun. 2005)	Greg Ford, head of business development at Collagenex.
Ex. T121 at 1 ("our commitment to Restoraderm ")(10 May 2006)	Greg Ford, head of business development at Collagenex.
Ex. T123 at 1 ("threatens to diminish the value of the Restoraderm asset")(6 Feb. 2008)	Andrew Powell, Chief Legal Counsel at Collagenex.

15. As shown above in Exhibits T46 and T123, Collagenex's **chief legal counsel** equated "Restoraderm" to Sköld's technology.

16. Illustrative of how "Restoraderm" and the licensed technology from Sköld were one and the same, on 9 May 2003, Collagenex entered a three way agreement with Epitan Limited and Sköld ("Epitan Agreement") for a feasibility study "on a drug delivery mechanism for [REDACTED]... using the Restoraderm."⁴⁷ **Restoraderm** "means the water-based lipid topical drug delivery and skin barrier restoration technology (lipoid technology) that is the subject of the Sköld Licensing Agreement [2002 Agreement]."⁴⁸ In §15, the agreement specifies that if "the exclusive licence granted to CollaGenex by

⁴⁷ Ex. T11 at 2 (missing agreement page 12 at Ex. T124). ([REDACTED] is a synthetic analog of the [REDACTED]. See Ex. 11 at 5 (§1.1).)

⁴⁸ *Id.* at 5 (§1.1).

Sköld under the [2002 Agreement] is terminated, for any reason, **Sköld agrees to grant** EpiTan a licence to **the Restoraderm** for the purpose of EpiTan continuing the Feasibility Study and developing a Product.”⁴⁹

17. The fundamental equivalency of the mark with the technology is affirmed in the public statements that are expressly those of the company Collagenex. For example, in the 12 Feb. 2002 press release announcing its agreement with Sköld, Collagenex stated that

it has licensed a novel dermal and transdermal drug delivery technology from its inventor. The technology, **named Restoraderm(TM)**, is designed to enhance the dermal delivery of a variety of active ingredients and will form the basis for a novel, proprietary and differentiated portfolio of topical dermatological pharmaceuticals.⁵⁰

Also,

“The licensing of the **Restoraderm drug delivery technology** is an important element of our strategy...”⁵¹

18. Collagenex’s Form 10-k for the fiscal year ending 31 Dec. 2001 is to the same effect.⁵²

19. The mark was well recognized in the dermatology community as equating with Sköld’s technology.⁵³ Those involved in the scientific evaluation of the technology so

⁴⁹ *Id.* at §15 (emphasis added).

⁵⁰ Ex. T131 at 1 (emphasis added).

⁵¹ *Id.* (emphasis added).

⁵² Ex. T129 at 1.

⁵³ Day Dep. 24:22 – 27:13

equated the term.⁵⁴ The term was used as equating to Sköld’s technology in scientific publications such as that of Ex. 143 and 144.⁵⁵

20. In about March, 2008, Galderma acquired Collagenex.⁵⁶ When Galderma acquired Collagenex, that clear understanding that “Restoraderm” equated to the Sköld technology was maintained, as testified by Sköld.⁵⁷ Shortly after the acquisition occurred, Art Clapp, business development leader at Galderma,⁵⁸ told Sköld that unfortunately **Restoraderm** technology was not part of their acquisition due diligence,⁵⁹ further confirming the equation of the term. This equation of the term is indicated by the following documentary evidence (emphasis added):

Document:	Statement Attributable to:
Ex. T23 at 2 (attached draft minutes of meeting with Sköld “to clarify some technical aspect of the restoraderm technology”)(2 Sep. 2008)	Shamira Shaimi, project manager at Galderma’s R&D facility in France. ⁶⁰
Ex .T24 at 1 (“what was done to stabilize the BPO in Restoraderm? ”)(3 Sep. 2008)	Shamira Shaimi, project manager at Galderma’s R&D facility in France.
Ex. T26 at 4 (in final minutes: “Assessment as to using Restoraderm technology... is still on going”)(8 Sep. 2008)	Shamira Shaimi, project manager at Galderma’s R&D facility in France.
Ex. T27 at 1-2 (in responding to Sköld seeking clearance to use the Restoraderm technology for oral, nasal or intravenous, Q Cassidy acknowledges that this is free of the 2004 Agreement)(15 Jul. 2009)	Quintin Cassidy, Galderma legal counsel. ⁶¹

⁵⁴ Marks Dep. 9:7-18.

⁵⁵ Day Dep. 24:22 – 27:13.

⁵⁶ Sköld Dep. 39:4-14.

⁵⁷ Id.

⁵⁸ Sköld Dep. 42:18-19.

⁵⁹ Sköld Dep. 45:16 – 46:10.

⁶⁰ Sköld Dep. 39:23 – 40:2.

⁶¹ Sköld Dep. 40:21-25.

Document:	Statement Attributable to:
Ex. T29 at 1 (Restoraderm Lotion and Restoraderm Crème identified for return to Sköld)(8 Feb. 2010)	Jim Wallace, signing “Galderma Labs”
Ex. T58 at 1 (by " RESTORADERM project", I am referring to the topical dermal technology known as RESTORADERM as now owned by Galderma [pursuant to 2004 Agreement])(2 Jun. 2009)	Quintin Cassady, Galderma legal counsel.
Ex. T59 at 1-2 (Q Cassady gives no indication of treating " Restoraderm " as separate from the technology, despite being directly asked if this was Galderma’s intention. His use of the term (“regarding Restoraderm”) indicates equivalence)(16-17 Jun. 2009)	Quintin Cassady, Galderma legal counsel.

21. As shown above in Exhibits T58 and T59, Galderma’s **legal counsel** used the term “Restoraderm” as equivalent to Sköld’s technology.

22. Even when, unknown to Sköld, Galderma had decided to divest the technology but retain the name, the head of business development for Galderma’s European group recognized that the name Restoraderm and the technology were the same.⁶²

23. On 27 Nov. 2009, Galderma terminated its 2004 Agreement with Sköld, and promised to return “applicable materials” pursuant to Section 8.5(b) of the agreement.⁶³ By assignment, Galderma returned the patent applications relevant to the Sköld technology on 22 Feb. 2010.⁶⁴ That Galderma opted to treat the mark “Restoraderm” as separate from the technology became fully clear in Sept. 2010 when it issued the press release of Ex. T63 (“Launches Cetaphil® Restoraderm®”).

⁶² Day Dep. 22:21 – 24:17.

⁶³ Ex. T4 at 1.

⁶⁴ Ex. T5 at 1.

24. During the period of a contractual relationship between Registrant and Sköld, Sköld made in numerous efforts to out-license the technology.⁶⁵ Sköld had the right under the 2002 Agreement to independently market out-licensing rights for particular products that Collagenex declined,⁶⁶ and to independently use the mark.⁶⁷ Sköld did and was encouraged by Registrant to seek out-licensing opportunities.⁶⁸ Citations to collaborative emails follow:

Document:	Collaborating Promotion To:	Registrant Party to Email:
Ex. T48 at 1 (14 Feb. 2002)	Proctor & Gamble	Jeff Day, VP Dermatology at Collagenex.
Ex. T135 at 1 (18 Feb. 2002)	John Kinzell, former Pres. of Optime ⁶⁹	Jeff Day.
Ex. T76 at 1 (1 May 2002)	ATS	Rob Ashley, director of commercial development and #2 in command at Collagenex.
Ex. T137 at 1 (29 Apr. 2002)	Antares	Rob Ashley.
Ex. T79 at 1 (26 Jun. 2002); Epitan Agreement, Ex. T11 and T124 at e.g. §2.1	Epitan	Rob Ashley.
T81 at 1 (8-9 Oct. 2002);	Fujisawa	Jeff Day, VP Dermatology at Collagenex.
Ex. T82 at 1 (10 March 2003); Ex. T83 at 1, 4 (14 Mar. 2003); Ex. T81 at 1 (9 Oct. 2002)	Ortho-Neutragena (= Johnson & Johnson, see Sköld Dep. 102:13-17)	Jeff Day.
Ex. T81 at 1 (9 Oct. 2002)	Watson	Jeff Day.

⁶⁵ Sköld Dep. 10:3-18, regarding the listings in Ex. T125; Day Dep. 18:24 – 19:25..

⁶⁶ Ex. 2 at §2.5.

⁶⁷ Ex. 2 at §4.2.2.

⁶⁸ Ex. T77 at 1 (admission of No. 2 principle of Collagenex).

⁶⁹ The reference to Optime in Ex. T125 is in error, as it should have referenced marketing to a former President of Optime.

Document:	Collaborating Promotion To:	Registrant Party to Email:
Ex. T83 at 1 (14 Mar. 2003)	Pathfinder	Jeff Day.
Ex. T85 at 1 (21 Jul. 2003)	Skin Medica ⁷⁰	Jeff Day.
Ex. T86 (3 Oct. 2003)	Cardinal	Jeff. Day.
Ex. T142 at 1 (24 Oct. 2003)	Novartis	Jeff Day.
Ex. T55 at 1 (26 Oct. 2004); Ex. T56 at 1 (18 Nov. 2004)	Galderma	Greg Ford, head of business development at Collagenex.
Ex. T14 at 1 (10-12 Jul. 2004)	Therapeutics, Inc.	Jeff Day.
Ex. T92 at 1 (6-9 Aug. 2004). See also Sköld 2 nd Dep. 72:4 – 73:1	William Abramovitz and TexasDerm	Jeff Day.
Ex. T53 at 1 (3-8 Sept. 2004); Ex. T54 attachment to Ex. T53 (see Sköld 2 nd Dep. 73:8 – 75:1); Ex. T93 (16-17 Aug. 2004); Ex. T94 at 1 (10 Sep. 2004); Ex. T95 at 1 (2-4 Mar. 2005)	Ranbaxy	Jeff Day; Brad Zerler, R&D project manager for Collagenex; Greg Ford.
Ex. T96 at 1 (28 Sep. 2004)	INyX-Pharma	Greg Ford, Brad Zerler.
Ex. T98 at 1 (22 Jan. 2007)	Pfizer	Greg Ford.
Ex. T98 at 1 (22 Jan. 2007)	Johnson & Johnson	Greg Ford.
Ex. 75 at 1 (18 Feb. 2002)	Connetics	Jeff Day.
Ex. T97 at 1 (14 Jun. 2005)	Un-named companies	Greg Ford.
Ex. T10 at 1 (22 Oct. 2002)	General Promotion	Sheila Kennedy, Collagenex (see Sköld 2 nd Dep. 27:16 – 28:4).
Ex. T17 at 1 (15 Dec. 2005)	20 Un-named companies	Greg Ford.

25. Ex. T132 is listing of Skold recollections of meetings Skold undertook to promote Restoraderm technology,⁷¹ and is complementary to Ex. T125 (Companies to whom

⁷⁰ Sköld only indirectly received the email of Ex. T85.

Skold assisted in promoting the Restoraderm technology during Skold's collaborative relationship with Collagenex)⁷² for the period of cooperation with Collagenex (up to about mid 2006, as detailed below).

26. Sköld's efforts after the Galderma acquisition to help Galderma decide what to do with the technology were promotional efforts directed to Galderma.⁷³

27. During the period of a contractual relationship between Registrant and Sköld, Sköld was consulted by Registrant on the production of Restoraderm products, and other technical aspects.⁷⁴ Under consulting agreements, Sköld was paid [REDACTED] dollars.⁷⁵ The Restoraderm samples that Sköld provided to Collagenex in 2001 and January 2002 were formulated in Sweden under Sköld's direction.⁷⁶ Through 2004 or 2005, Restoraderm samples were manufactured in Sweden under Sköld's direction and supervision.⁷⁷ In collaborative efforts between Sköld and Collagenex to market the technology, Sköld was presented⁷⁸ by Collagenex to the parties being promoted to as the inventor and technical resource on Restoraderm technology (Day Dep. – "he was involved [in efforts to promote to outside partners] as the expert in describing the technology and everything else").⁷⁸ These consulting activities are corroborated by the following:

⁷¹ Sköld Dep. 12:4-13; 49:10 – 51:11.

⁷² Sköld Dep. 10:3-18.

⁷³ Sköld Dep. 45:16 – 47:16; see also Ex. 23-24 and 26.

⁷⁴ Sköld Dep. 25:21 – 29:6; 16:3-23; Day Dep. 19: 6-17; 20:2-6.

⁷⁵ Sköld Dep. 28:16-22, referencing Ex. T146, p. 4, l. 3.

⁷⁶ Sköld Dep. 23:18 – 24:7.

⁷⁷ Sköld Dep. 34: 3-17.

⁷⁸ Sköld Dep. 41:13-18; Day Dep. 19:6-21.

Document:
Ex. T48 at 1 (14 Feb. 2002)(Day seeking technical feedback from Sköld on peptides in Restoraderm)
Ex. T76 at 1 (1 May 2002)(Sköld informing Ashley on production of a neutral form of Restoraderm)
Ex. T81 at 1 (9 Oct. 2002)(Day seeking Restoraderm samples from Sköld)
Ex. T83 at 1 (14 Mar. 2003)(Sköld informing Day of upcoming Restoraderm deliveries)
Ex. T84 at 1, 3 (13 May 2003)(Sköld informing Day on the practicality of an aerosol form of Restoraderm)
Ex. T142 at 1 (23 Oct. 2003)(Day asks Sköld to review our technical data on Restoraderm as a potential delivery carrier for Novartis' Ellidel)
Ex. T88 at 1 (7 Nov. 2003)(Sköld advising Day to use an Restoraderm aerosol formulation for study)
Ex. T50 at 1 (26 Jan. 2004)(Day reminding Sköld on technical issues he needs to present to the Collagenex Scientific Advisory Board)
Ex. T89 at 2 (6 July 2004)(Sköld advising Day on production status)
Ex. T15 at (19 Jul. 2004)(Day asking Sköld the pH of Restoraderm)
Ex. T92 at 1 (9 Aug. 2004)(Day asking Sköld to provide to an expert ⁷⁹ information and data)
Ex. T53 at 1, with attached agenda, Ex. T54 (3 Sep. 2004)(Ranbaxy setting up teleconference with Collagenex, and noting Sköld's availability for discussions about the Restoraderm platform)
Ex. T94 at 1 (10 Sep. 2004)(Zerler asking Sköld to prepare a project plan for Ranbaxy)
Ex. T90 at 1 (27 Sep. 2004)(Sköld asked by Day to be prepared to educate Art Clapp on Restoraderm)
Ex. T55 at 1 (26 Oct. 2004)(Ford requesting Restoraderm samples from Sköld)
Ex. T56 at 1 (18 Nov. 2004)(Ford requesting Restoraderm samples from Sköld)
Ex. T97 at 1 (14 Jun. 2005)(Ford asking Sköld for a technical presentation on Restoraderm)
Ex. T18 at 1 (27 Feb. 2006)(Zerler consulting Sköld on formulation stability data)
Ex. T20 at 1, 2 (17 Jul. 2006)(Sköld and Ford being informed on microbe tests for Restoraderm batches)

28. The relationship between Sköld and Collagenex was actively collaborative until mid 2006.⁸⁰ After this period, Sköld continued to promote Restoraderm to at least 15

⁷⁹ Sköld 2nd Dep. 72:4-15; Ex. T52 (re expertise of Abramovitz).

⁸⁰ Sköld Dep. 17:22 – 18:4.

Document:
Ex. T39 at 1-3 (15-25 Jan. 2008)(Emails between Thomas Sköld, ██████████ on Sköld meeting with ██████████. Sköld 2 nd Dep. 56:5-11)
Ex. T101 at 1 (30-31 Jan. 2008)(Emails between Thomas Sköld, ██████████ on promotion to the ██████████. Sköld 2 nd Dep. 112:1-8)
Ex. T102 at 1 (30 Jan. 2010)(Emails between Sköld and ██████████ on promotion of Restoraderm technology. Sköld 2 nd Dep. 112:21 – 113:3)
Ex. T103 at 1-2 (29 Jan. – 10 Feb. 2010)(Emails between Sköld and ██████████ indicating promotional activity with ██████████ (via mention of ██████████), ██████████ (via mention of ██████████) and ██████████. Sköld 2 nd Dep. 114:3-10)
Ex. T105 at 1 (19-23 Feb. 2010)(Emails between Sköld and ██████████ on a teleconference for promotion of Restoraderm technology. Sköld 2 nd Dep. 115:18 – 116:1)
Ex. T40 at 1, 2, 7 (3 Mar. 2010)(Email sending attached promotional material to ██████████ an FDA Meeting Report from 2004 on a ██████████ Restoraderm product, and the “Restoraderm Development Report” of Feb. 30, 2005. Sköld 2 nd Dep. 56:25 – 58:2)
Ex. T41 at 1 (16 Feb. – 17 Mar. 2010)(Emails between Sköld and ██████████ promoting Restoraderm technology. Sköld 2 nd Dep. 59:15 – 60:2)
Ex. T64 at 1-2 (11 Mar. – 22 Mar. 2010)(Emails introducing Sköld to ██████████ between Sköld and ██████████ on promotion. Restoraderm referenced on p. 2. Sköld 2 nd Dep. 81:17 – 82:8)
Ex. T127 at 1-2 (9-15 Apr. 2010)(Emails between Sköld and ██████████ on promotion of Restoraderm technology. Sköld 2 nd Dep. 138:6-14)
Ex. T104 at 1 (18 May 2010)(Emails between Sköld and ██████████) on promotion of Restoraderm technology. Sköld 2 nd Dep. 114:24 – 115:11)
Ex. T112 at 1 (4-17 May 2011)(Emails between ██████████ Sköld on promotion. Restoraderm referenced on p. 3. Sköld 2 nd Dep. 125:16 – 126:5)
Ex. T65 at 1 (1-2 Jun. 2010)(Emails between Sköld and ██████████ on promotion of Restoraderm technology. Sköld 2 nd Dep. 82:16-21)
Ex. T106 at 1 (8 Sep. 2010)(Email from ██████████ to Sköld confirming recent meeting on promotion of Restoraderm technology. Sköld 2 nd Dep. 116:18-24)
Ex. T66 at 1 (5 Oct. 2010)(Emails between Sköld and ██████████ discussing promotion efforts for Restoraderm technology. Sköld 2 nd Dep. 83:11 – 84:2)
Ex. T107 at 1 (26 Oct. 2010)(Email ██████████ to Sköld discussing initiating a feasibility study on Restoraderm. Sköld 2 nd Dep. 117:19-118:25)
Ex. T128 at 1-2 (10-11 Oct. 2010)(Emails between Sköld and ██████████ on promotion of Restoraderm technology. Sköld 2 nd Dep. 139:10-16)

Document:
Ex. T108 at 1-2 (15-19 Nov. 2010)(Emails between Sköld and [REDACTED]) on promotion of Restoraderm technology. Sköld 2 nd Dep. 119:23 – 120:7)
Ex. T109 at 1 (29-30 Nov. 2010)(Emails between Sköld and [REDACTED] on stability data and promotion of Restoraderm technology. Sköld 2 nd Dep. 121:8 – 122:7)
Ex. T110 at 1 (29 Nov. 2010)(Email Sköld to [REDACTED]) on signed CDA. Sköld 2 nd Dep. 122:18 – 123:21)
Ex. T49 at 1 (6 Dec. 2010)(Emails between Sköld and [REDACTED] on promotion. Sköld 2 nd Dep. 68:7-25)
Ex. T67 at 1-2 (10-21 Feb. 2011)(Emails between Sköld and [REDACTED] on promotion. Reference to Restoraderm technology clear from discussion of “situation with Galderma.” Sköld 2 nd Dep. 84:8-16)
Ex. T68 at 1 (30 Jun. 2011)(Email Sköld to [REDACTED] re meeting for promotion of Restoraderm technology. Sköld 2 nd Dep. 85:5-13)
Ex. T114 at 1-2 (7-30 Jun.. 2011)(Emails between [REDACTED]) and Sköld on promotion. Reference to Restoraderm technology clear from reference to patent information at p. 2. Sköld 2 nd Dep. 127:10-22)
Ex. T113 at 1-2 (25-26 Jul. 2011)(Emails between Sköld and [REDACTED] of [REDACTED] and [REDACTED]) on promotion of Restoraderm technology. Sköld 2 nd Dep. 126:12-21)
Ex. T42 at 1 (19-22 Aug.. 2011)(Emails between [REDACTED] and Sköld on promotion [REDACTED] . Sköld 2 nd Dep. 60:16 – 61:15)
Ex. T43 at 1-2 (29 Aug. 2011)(Emails with between Sköld and [REDACTED] on promotion. Sköld 2 nd Dep. 61:22 – 62:14)
Ex. T115 at 1 (8-9 Sep. 2011)(Emails between Sköld, [REDACTED] [REDACTED] r on promotion and a Confidential Disclosure Agreement. Sköld 2 nd Dep. 128:11 – 129:2)
Ex. T111 at 1 (2-4 Nov. 2011)(Emails between [REDACTED] and Sköld on Restoraderm promotion to [REDACTED] . Sköld 2 nd Dep. 124:12-24)
Ex. T44 at 1 (13-15 Dec. 2011)(Emails between Sköld and [REDACTED] on promotion. Sköld 2 nd Dep. 62:21 – 63:8)
Ex. T116 at 1 (5-7 Jan. 2012)(Emails between Sköld and [REDACTED] on promotion of Restoraderm technology. Sköld 2 nd Dep. 129:19 – 130:22)
Ex. T117 at 1 (30 Jan. 2012)(Emails between [REDACTED]) and Sköld on promotion of Restoraderm technology. Sköld 2 nd Dep. 131:4-10)
Ex. T118 at 1 (10-11 Apr. 2012)(Emails between [REDACTED] and Sköld on promotion of Restoraderm technology. Sköld 2 nd Dep. 131:24 – 132:5)

Document:

Ex. T119 at 1 (12 Oct. 2012)(Email from Sköld to [REDACTED] on signed CDA and meeting. Sköld 2nd Dep. 132:19 – 133:1)

Ex. T120 at 1 (1 Feb. 2013)(Email Jeff Day to Sköld on prospective promotion lead for Restoraderm technology. Sköld 2nd Dep. 133:23 – 134:5)

29. In the summer of 2013, Sköld signed an agreement with a U.S.-based company (one of those listed above as being one of the more credible companies for developing dermatology product) for the development of 3 products based on Restoraderm technology, which agreement was amended just prior to 13 Nov. 2013 to add 3 more such products.⁸⁴ That company will pay a royalty in the range of [REDACTED] of net sales.⁸⁵ In November, 2013, contracts were in draft for further development of products based on Restoraderm technology.⁸⁶ Sköld will supervise formulation work for the products of these agreements, and will conduct initial formulations in his laboratory and with Swedish Apoteket.⁸⁷

30. During the course of Sköld's development work with Restoraderm technology, he worked on 7 formulations with Collagenex, 6 of which had satisfactory stability, he worked on 10 additional formulations for which there was stability data, of which 8 had satisfactory stability, and he worked on 3 further formulations for which there was not

⁸⁴ Sköld Dep. 52:22 – 53:17.

⁸⁵ Sköld Dep. 55:7-10.

⁸⁶ Sköld Dep. 53:18 – 54:13.

⁸⁷ Sköld Dep. 54:17 – 55:3.

stability data.⁸⁸ The general formulation, in substantially its early form, was shown to be effective in delivering substances to the skin.⁸⁹

31. The fraught relationship that developed between Registrant – in its Collagenex persona – and Sköld can be seen in the exhibits of record. Ex. T121 and 122, regarding a teleconference on commercially reasonable efforts being made, show the beginnings of a frayed relationship in May, 2006.⁹⁰ In July 2006, in Ex. T19 Sköld’s attorneys wrote to Collagenex concerning a meeting that was held about resuming a amiable relationship. The letter arose from Sköld’s frustration that Registrant could not make up its mind about what it wanted to do with the technology and what kind of products to develop.⁹¹ In November 2007, in Ex. T45, Collagenex announced that it would not develop a Restoraderm product, and had decided to divest “**Restoraderm**.”⁹² In January 2008, in Ex. T22, Sköld’s attorneys asserted that Collagenex had either voluntarily terminated the 2004 Agreement, or were in material breach.⁹³ In February 2008, in Ex. T123, Collagenex’s general counsel replies to deny this assertion.⁹⁴

32. Sköld traces the difficulty to management shifts occurring before 2006,⁹⁵ where afterwards Collagenex “stonewalled from one period or year to another where they

⁸⁸ Ex. T133; Sköld Dep. 12:14-22.

⁸⁹ Sköld Dep. 146:12 – 148:12, discussing among other things of Ex. 143, a scientific poster by J.F. Fowler et al. of the Univ. of Louisville. The poster was presented at the Feb. 2005 meeting of the American Contact Dermatitis Society, as shown by Ex. 144.

⁹⁰ Sköld 2nd Dep. 134:19 – 135:20.

⁹¹ Sköld 2nd Dep. 35:2-9.

⁹² Sköld 2nd Dep. 63:22 – 64:8.

⁹³ Sköld 2nd Dep. 38:3 – 39:7.

⁹⁴ Sköld 2nd Dep. 136:9-16.

⁹⁵ Sköld Dep. 42:25 – 44:2.

shifted gears numerous times.”⁹⁶ In August 2007, Greg Ford of Collagenex conveyed to Sköld, “reading between the lines,” that Collagenex was discontinuing development.⁹⁷ In October, Ford directly informed Sköld of this by telephone.⁹⁸ In November 2007, Collagenex formally informed Sköld in the email of Ex. 45.

33. After the early 2008 acquisition of Collagenex by Galderma, Art Clapp of Galderma informed Sköld that Restoraderm was not part of Galderma’s due diligence, and it would need three to six months to decide whether to keep the Restoraderm technology or return the asset to Sköld.⁹⁹ About 5 months later, in August, September, Galderma organized a meeting at an R&D facility in France to review the technology.¹⁰⁰ After that, “only words and email that went back and forth. They couldn’t make up their mind, according to the emails at least.”¹⁰¹

34. As is self-evident, the unsettled nature of the relationship between Sköld and Registrant created problems with marketing Restoraderm technology and Sköld’s services in connection thereto. In August 2007, in Ex. T35, correspondence with Stiefel Laboratories reflected the business problem, with Stiefel seeking clarity “on a way forward with Collagenex.”¹⁰² In July 2008, Ex. T31 corroborates Sköld’s perception of a business block imposed by Galderma. In December 2010, Ex. T49 indicates the concern among potential licensees raised by the conflicting mark used by Registrant.

⁹⁶ Sköld Dep. 43:13-15.

⁹⁷ Sköld Dep. 43:20 – 44:2.

⁹⁸ Sköld Dep. 44:6-25.

⁹⁹ Sköld Dep. 46:4-10.

¹⁰⁰ Sköld Dep. 46:14-18.

¹⁰¹ Sköld Dep. 46:19-22.

¹⁰² Sköld 2nd Dep. 52:7-17.

35. Registrant's obstruction included either (a) falsely promising in June 2009 that it was conducting studies on manufacturing feasibility, stability and skin barrier recovery (Ex. T58), or (b) failing to provide the resulting data after contract termination as required by Sections 8.5(a)(iii) and 1.3 of the 2004 Agreement.¹⁰³ Moreover, during the long delay between the March 2008 acquisition of Collagenex and its November 2009 termination of the 2004 Agreement, Registrant obstructed Sköld's planning and marketing by hiding a decision it made in early 2009 to drop the Restoraderm technology. At the 2009 American Academy of Dermatology ("AAD") meeting (March, 2009), the head of Galderma's European development group told Jeff Day that Galderma had no interest in the technology, but would keep the name.¹⁰⁴ In June 2009, when confronted in an email with this information, Quintin Cassady responded with the non-answer "I would be curious to know the details about what you heard at the AAD in March regarding Restoraderm. Without the details, it is difficult for me to look into it and comment."¹⁰⁵ In a later telephone call with Sköld, he directly denied Galderma would drop the technology and keep the mark.¹⁰⁶

36. Moreover, about two weeks after Sköld's learning the information from the March 2009 AAD meeting, Art Clapp of Galderma asserted that Galderma was working on a contract proposal to put to Sköld.¹⁰⁷ In Ex. T59, on 17 June 2009, Cassady denies this, indicating that the Clapp assertion was an obstructive ruse.

¹⁰³ Sköld Dep. 61:13 – 64:6.

¹⁰⁴ Day Dep. 22:21 – 23:22; See Sköld Dep. at 46:23 – 47:2 on March 2009 dating.

¹⁰⁵ Ex. T59 at 1.

¹⁰⁶ Sköld Dep. 47:20 – 49:6.

¹⁰⁷ Sköld Dep: 47:11-16.

37. Further marketing problems stemmed from the patent portfolio not being returned until the beginning of 2010, and being a “mess”, such that it was not until 2013 that the last patent application in the portfolio was granted.¹⁰⁸ The U.S. patent in the portfolio granted in October, 2011.¹⁰⁹

38. Since the marks of Registrant and Petitioner are the same, and both directed to topical formulations, or the development of the same, likelihood of confusion is self-evident. Moreover, Sköld’s communications with [REDACTED] of the company [REDACTED] [REDACTED]e directly show the confusion.¹¹⁰ Industry insider’s such as [REDACTED] not steered away from their confusion by Registrant’s promotional material, since it asserts “patented” “ceramide technology”¹¹¹, much like Petitioner’s patented Restoraderm technology¹¹², but never identifies a patent number.¹¹³ (The sister claim of a “patented” Filaggrin technology also lists no patent in Registrant’s English language promotional material, but is possibly weakly supported by a French patent, FR2916351B1, which according to the INPADOC database has no granted counterparts as of 12 June 2014.) Further, [REDACTED] of [REDACTED] further shows confusion in Ex. T66.¹¹⁴

39. Registrant’s “Restoraderm” product is aimed, among other things, at treating dermatitis.¹¹⁵ Ex. T143 and T144 (exhibits regarding 2005 scientific presentation and

¹⁰⁸ Sköld Dep: 52:22 – 53:9.

¹⁰⁹ Ex. T130.

¹¹⁰ Ex. T49; Ex. T67.

¹¹¹ Ex. T156 (Ex. B to Registrant’s Declaration of Kee) at 2.

¹¹² Ex. T130 (Sköld’s U.S. Pat. 8,029,810) at col. 29-30 (e.g., claim 69).

¹¹³ Ex. T156 (all).

¹¹⁴ See correction of [REDACTED] name at Sköld 2nd Dep. 111:2-12.

¹¹⁵ Ex. T156 at 1; Ex. T63 at 1.

publication by FJ Fowler et al., entitled “A Comparator Study of an Adjunctive Dermal Lipid Replacement Foam (Restoraderm™) in the Management of Refractory Hand Contact Dermatitis”¹¹⁶ show that Petitioner’s Restoraderm is aimed, among other things, at also treating dermatitis. This study was became public knowledge in 2004.¹¹⁷

40. In §15 of the Epitan Agreement of Ex. T11, the agreement specifies that if “the exclusive licence [sic] granted to CollaGenex by Sköld under the [2002 Agreement] is terminated, for any reason, **Sköld agrees to grant** EpiTan a licence to **the Restoraderm** for the purpose of EpiTan continuing the Feasibility Study and developing a Product.” This provision conflicts with a theory that Registrant could retain the mark Restoraderm. The cause for replacing the 2002 Agreement with the 2004 Agreement was accounting needs.¹¹⁸ Moreover, the Epitan Agreement was active in August 2004 when the 2004 Agreement was executed.¹¹⁹ Thus, the 2004 Agreement does not modify these expectations.

41. Moreover, the 2004 Agreement is drafted to preserve exactly the right set forth in §15 of the Epitan Agreement. Upon termination, §8.4 recites that each sublicense previously granted by CollaGenex... shall remain in effect and shall become a direct license or sublicense... of such rights by Sköld.”¹²⁰ This provision conflicts with a theory that Registrant could retain the mark Restoraderm, the name by which the technology was promoted to all potential sublicensees.

¹¹⁶ Sköld Dep. 146:12 – 147:15; See, also, Day Dep. 25:9 – 26:16.

¹¹⁷ Sköld Dep. 147:5-6.

¹¹⁸ Ex. T12; Sköld Dep. 30:19 – 32:11.

¹¹⁹ See Ex. T80, 26 May 2005 email from Epitan to Sköld discussing [REDACTED], the subject of the Epitan Agreement.

¹²⁰ Ex. T3 at §8.4.

42. Further, Jeff Day, a high level executive employee of Collagenex in the relevant time frame, and head of dermatology at Collagenex,¹²¹ has testified that the contractual expectation was that the mark would be returned if Collagenex cancelled the agreement.¹²²

43. The 2004 Agreement was framed as a purchase of assets.¹²³ This framing was to provide a more favorable accounting treatment over the 2002 Agreement (an express license). Supra at IV.9. The assets in question included

(a) the Restoraderm Intellectual Property; (b) the Books and Records relating to the Restoraderm Intellectual Property... (d) ***all goodwill, if any, relating to the foregoing.***¹²⁴

The “Restoraderm Intellectual Property” includes Restoraderm Know-How, which

means any and all Know-How owned or Controlled by Sköld... relating to the Restoraderm Technology.¹²⁵

The “Restoraderm Intellectual Property” further includes Restoraderm Patent Rights, which are also tied to the “Restoraderm Technology.”¹²⁶ The “Restoraderm Technology” means

the topical drug delivery technology developed by Skold and covered by the patent applications recited in Schedule 1.22.¹²⁷

Schedule 1.22 is found in Registrant’s Exhibit E (to Sköld Dep. of 13 Nov. 2013), and lists Prov. Appln. 60/365,059, U.S. Appln. 10/388,371 and Int’l Appln. PCT/US03/07752,

¹²¹ Day Dep. 6:11-22.

¹²² Day Dep. 18:11-22.

¹²³ Ex. T3, 2004 Agreement, Article 2.

¹²⁴ Ex. T3 at §2.1 (emphasis added).

¹²⁵ Id. at §§1.20 to 1.22.

¹²⁶ Id. at §1.22.

¹²⁷ Id. at §1.23

just the priority documents listed in Ex. T130 (Sköld's U.S. Pat. 8,029,810). In view of these facts, and the inextricable equivalence of "Restoraderm" with the technology in the mind of Collagenex as set forth in IV.14 – 18, the goodwill relating to the "Restoraderm Technology" clearly includes the mark "Restoraderm."

44. Pursuant to §8.5(b)(iii) of the 2004 Agreement, in the event of a voluntary termination by Registrant, "CollaGenex shall transfer to Skold the Purchased Asset..." Registrant has admitted that §8.5(b) applied to the termination of its agreement with Sköld. Ex. 154 at Response to Interrogatory 27. Such termination occurred on 27 November 2009, pursuant to the notice from Galderma found in Ex. T4.

V. ARGUMENT

A. Priority of Use

Registrant has admitted no evidence of priority of use dated before its earlier trademark application filing on 28 February 2002. Supra at IV.1. In September 2001, Sköld marketed in the United States his product and services, as "Restoraderm," to three of the ten or "a little bit" more most credible U.S. companies for developing a dermatology products (supra at IV.3 and IV. 8), as well as to Collagenex (supra at IV.2). During that Fall, he also marketed to another U.S firm, Biocoastal Pharma. Supra at IV.4. Sköld delivered samples to Collagenex in Pennsylvania in November and December of 2001, and to its representatives at a January 2002 scientific meeting in the Caribbean. Supra at IV.5. Hence, since he was marketing a topical formulation technology and his services in further developing the technology (supra at IV.2; IV.7. (re 2002 Agreement)), he was appropriately marketing to a large part of the market (supra

at IV.8). Sköld's selling activities in 2001 going into 2002 were sufficient to create contracts under which he was paid about 2.5 million dollars. Supra at IV.13.

As stated in New England Duplicating Co. v. Mendes, 190 F.2d 415, 418, 90 USPQ 151, 153 (1st Cir. 1951):

"... the question of use adequate to establish appropriation remains one to be decided on the facts of each case, and that evidence showing, first, adoption, and second, use in a way sufficiently public to identify distinguish the marked goods ***in an appropriate segment of the public mind*** as those of the adopter of the mark, is competent to establish ownership, even without evidence of actual sales."
[Emphasis added]

If we are discussing analogous use, the activities need to "reasonably be expected to have a substantial impact on the purchasing public." Herbko Int'l Inc. v. Kappa Book Inc., 308 F.3d 1156, 1162, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002). Because the meetings occurred on or soon after September 11, 2001, one can deduce that they had a substantial impact.

The appropriate segment of the public mind to Sköld's product and services were in 2001 those about 10 companies of particular credibility for dermatology products, and other U.S. dermatology companies. Sköld marketed "Restoraderm" technology to 3 of the 10 or a bit more most credible companies (about 20 to 30%), and two others. Supra at IV.8. For that marketing, he received substantial consideration. Supra at IV.13. Thus, given no evidence of use by Registrant in the relevant time frame, there is no reasonable argument that Sköld did not have priority use of the mark in commerce. Moreover, it is worth noting, Registrant has presented no evidence that contradicts Sköld's and Day's testimony of priority use. Corroborating this testimony, and in opposition to vague innuendo from Registrant's counsel, we have the testimony and

documentary evidence from the Chairman of the Department of Dermatology at Pennsylvania State Univ. College of Medicine showing use of the mark in January, 2002. Supra at IV.6. We further have the testimony of the only witness with relevant knowledge from Registrant's perspective, namely, Jeff Day. Supra at IV.2.

Accordingly, Sköld is the priority adopter of the mark RESTORADERM.

B. Continuance of Use

When Sköld was in contractual collaboration with Collagenex, he maintained his use of the mark in three ways. First, as the licensee of the mark, all actions of Collagenex, and subsequently Galderma, were the actions of Sköld. Quality Candy Shoppes/Buddy Squirrel of Wis., Inc. v. Grande Foods, 90 U.S.P.Q.2d 1389, Canc. No. 92044407, slip op. at 4 (TTAB 2007). Second, Sköld actively promoted the technology for licensing while being held out as the "inventor and developer," and technical resource for, Restoraderm technology. See Ex. T12 and supra IV.24 and 27. Third, Sköld promoted out-licensing the technology independent of Collagenex. Supra at IV.24.

After the relationship with Registrant became less collaborative, Sköld was still the beneficiary of Registrant's efforts to market the technology. Moreover, Sköld initiated his own efforts to promote Restoraderm technology. Supra at IV.28; see also Ex. T132. Those efforts bore fruit in 2013 with an agreement with a credible U.S. dermatology company for the development of 6 products based on Restoraderm technology at a substantial royalty rate. Supra at IV.29.

Petitioner submits that the above is more than sufficient evidence that Sköld continued to use the mark in the United States since his priority use. Sköld's

corroborating emails show selling/promotional activity in each of 2001-2005, 2007-2008 and 2010-2013. Supra at IV.24-26 and 28-29. Sköld's testimony relating to Ex. T132 shows activity in all of 2001-2012. Supra at IV.25. To the extent that the Board finds any gap in the continued use of the mark, Petitioner would note that from mid-2006 to today the fraught relationship between Petitioner and Registrant provides more than a reasonable excuse for any non-use.¹²⁸ McCarthy on Trademarks and Unfair Competition, Fourth Ed., 2008, §17.16 (no abandonment from temporary withdrawal due to war, labor strife, litigation, and the like); See also, e.g., Star-Kist Foods, Inc. v. P.J. Rhodes & Co., 769 F.2d 1393, 1396, 227 U.S.P.Q. 44, 46 (9th Cir. 1985).¹²⁹ Even before mid-2006, any non-use is excusable because, as will be more efficiently discussed below, the 2004 Agreement anticipated the mark's return assignment to Sköld under the circumstances that apply here where Registrant elects to terminate the Restoraderm project and hence the failure to return the mark under the 2004 Agreement excuses non-use. McCarthy on Trademarks and Unfair Competition, Fourth Ed., 2008, §17.16.

Accordingly, Petitioner Sköld has continued to use the mark in the United States since his priority use.

¹²⁸ Supra at IV.31-37.

¹²⁹ The evidence of record shows that Petitioner called his topical technology "Restoraderm" all through Fall, 2001 to the present, clearly indicating no intent to abandon.

C. Goods and Services; Marketplace; Similarity of Goods/Services

The goods Sköld was marketing were topical formulations for delivering substances to the skin. Supra at IV.2; See also, Ex. T8, T9 and T150. Perhaps more importantly, he was marketing his services in developing specific formulations for specific substances. Supra at IV.2. Additionally, the Restoraderm vehicle was recognized in 2004-2005 as useful in treating dermatitis. Supra at IV.39.

Registrant's Cetaphil Restoraderm product is a topical formulation useful for treating dermatitis. Supra at IV.39. Consistent therewith, the goods recited in Reg. No. 2985751 are "Therapeutic skin care preparations and treatment for skin disorders." The goods recited in Reg. No. 3394514 are "Non-medicated skin care preparations."

Petitioner's most important marketplace is that of companies that are in the business of developing dermatology products. Supra at IV.2-4 and 8.

"Cases where a defendant uses an identical mark" are hardly ever reported at the appellate level as they are "open and shut." McCarthy on Trademarks and Unfair Competition, Fourth Ed., 2008, §23.20. That of course is the case here.

The goods are the same. Supra at IV.39. Registrants goods are such that one in the marketplace is extremely likely to assume that Registrant is the source or sponsor of Sköld's Restoraderm technology.

In testing for likelihood of confusion under Sec. 2(d), pursuant to In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973), twelve factors should be considered. The Court noted a thirteenth factor, which is an open-ended invitation to consider further relevant factors. These factors, with connection to the current case in italics, are as follows:

(1) The similarity or dissimilarity: *The marks are identical.*

(2) The similarity or dissimilarity and nature of the goods or services: *The goods are identical, and the services are for developing such goods..*

(3) The similarity or dissimilarity of trade channels: *Registrant's goods can be sold in drug stores, or the analogous spaces in grocery or general goods stores. Upon development, the products of Restoraderm technology can be expected to be sold in drug stores.*

(4) Impulse vs. careful, sophisticated purchasing: *The purchasers here are sophisticated, but there is another factor not present in the ordinary consumer-level case of confusion. The Registrant is a multinational company of significance in this marketplace (supra at IV.8, see IV.20 regarding R&D facility in France). As such, confusion includes the intimidation likely to be felt by others in the marketplace as a result of use of the identical mark.*

(5) The fame of the prior mark: *The mark was noted in the dermatology community. Supra at 19*

(6) The number and nature of similar marks in use on similar goods: *Sköld's and Registrant's uses are believed to be the only uses in dermatology.*

(7) The nature and extent of any actual confusion: *Direct confusion by an industry insider is in evidence. Supra at 38.*

(8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion: *Not Applicable.*

(9) The variety of goods on which a mark is or is not used: *Not Applicable.*

(10) The market interface between applicant and the owner of a prior mark: *The products aim at the same marketplace. Supra at 39*

(11) The extent to which applicant has a right to exclude others from use of its mark on its goods: *Not believed to be relevant to a priority contest. Both seek to perfect the right to exclude.*

(12) The extent of potential confusion, i. e., whether de minimis or substantial: *As discussed above, the potential is high.*

Accordingly, Petitioner submits that the likelihood of confusion is high.

D. Restoraderm Goodwill

The revertible assets of the 2004 Agreement included “***all goodwill***” relating to the ***Restoraderm Intellectual Property***, which has an obvious meaning tied to “Restoraderm Technology,” as enumerated supra at IV.43. The words speak for themselves. The goodwill for ***Restoraderm Intellectual Property*** could hardly not include RESTORADERM.

A trademark “has no existence apart from the good will of the product or service it symbolizes. Good will of a business and its symbol, a trademark, are inseparable.” McCarthy on Trademarks and Unfair Competition, Fourth Ed., 2008, §2.15; see also, Marshak v. Green, 746 F.2d 927, 929-30, 223 U.S.P.Q. 1099, 1100 (2nd Cir. 1984); Beech-Nut Packaging Co. v. P. Lorillard Co., 273 U.S. 629, 632 (1927).

The facts laid out above at IV.14 – 22 show that Sköld’s dermal formulation technology and “Restoraderm” were one and the same. This equivalence was recognized by Registrant’s persona Collagenex, the entity that formed the 2004 Agreement, ***and*** its successor-in-interest, Galderma.

Registrant submits that there can be no reasonable question but that the mark RESTORADERM is part of the goodwill relating to the Restoraderm Intellectual Property.

E. Sköld's Priority Use Not Trumped by Assignment

If the mark RESTORADERM is part of the goodwill relating to the Restoraderm Intellectual Property, then §8.5(b) of the 2004 Agreement is quite clear that it must be and has been reverted to Sköld. As Registrant admitted with respect to reverting the patent estate, §8.5(b) applies to the termination of the 2004 Agreement. *Supra* at 44.

The choice of law for the 2004 Agreement, as well as the 2002 Agreement, is Pennsylvania. Under Pennsylvania law, a contract will be found to be ambiguous if, and only if, it is reasonably or fairly susceptible to different constructions, is capable of being understood in more senses than one, is obscure in meaning through indefiniteness of expression, or has a double meaning. Erie Insurance Company/Erie Insurance Exchange v. Flood, 649 A.2d 736, 738 (Pa. Cmwlth. 1994). The right and duty of reversion set forth in the 2004 Agreement, as elucidated in section V.E. below, is not susceptible to different constructions. Thus, there is no need to look beyond this: Registrant had a duty under §8.5(b) of the 2004 Agreement to return the RESTORADERM mark to Sköld.

If we do look to parole evidence, a duty of reversion matches the expectations of a high level executive of Collagenex. *Supra* at 42. Such a duty of reversion is the only way to make sense of §15 of the three-way agreement (Epitan, Collagenex, Sköld), which calls for Sköld to maintain the license grant to Epitan in the event of a termination between Collagenex and Sköld. *Supra* at 40. Such a duty of reversion is the only way to

make sense of §8.4 of the 2004 Agreement, which more generally calls for Sköld to maintain any third party license in the event of a termination between Collagenex and Sköld. Supra at 41.

The course of this litigation indicates that Registrant will put great emphasis on the language of §4.2.1 of the 2002 Agreement, to the effect that “Restoraderm” “shall be in the sole name of CollaGenex and the exclusive property of CollaGenex during the term and thereafter.” The 2004 Agreement is just as emphatic about the transfer of the Purchased Assets as §4.2.1 of the 2002 Agreement is as to trademarks. According to §2.1 of the 2004 Agreement, CollaGenex shall purchase “full, complete *and irrevocable* right, title and interest in and to the assets and right...” So one can clearly deduce that this 2002 language means to define apposite situations wherein there is no voluntary termination by Registrant. Moreover, the 2002 Agreement was clearly and unambiguously superseded by the 2004 Agreement. Supra at IV.11.

Registrant will also seek to put great store parole evidence found the email trail of Ex. T1. But, as discussed above at IV.12, reading this email trail in the context of the teleconference that intervened confirms the unambiguous meaning of the 2004 Agreement that the trademark was part of the asset.

The clear language of the contract also matches the default position in contract law: “[w]hen a license is lawfully canceled the parties are relegated to their status before the granting of the license...” Dow Chemical Co. v. U.S., 32 Fed.Cl. 11, 19 (1994), *aff’d in part, rev’d in part on other grounds*, 226 F.3d 1334 (Fed. Cir. 2000); see also Invengineering, Inc. v. Foregger Co., 293 F.2d 201, 204, 130 U.S.P.Q. 124, 126 (3rd Cir., 1961).

As to this last argument, Registrant will assert that we have an asset purchase agreement, not a license. However, it is well settled that "[w]hether a transfer of a particular right or interest under a patent is an assignment or a license does not depend upon the name by which it calls itself, but upon the legal effect of its provisions." Vaupel Textilmaschinen KG v. Meccanica Euro Italia SPA, 944 F.2d 870, 875, 20 U.S.P.Q.2d 1045, 1049 (Fed. Cir. 1991), *quoting* Waterman v. Mackenzie, 138 U.S. 252, 255 (1891). These cases reflect the truism that one must look at the actual rights conveyed, and the limitations thereon, and not the often loose use of terminology that might sound in licensing or in assignment.

In a given context, a contract might be viewed as an assignment (e.g., whether enough rights have passed to allow grantee to sue without joining the grantor), while in another context it may be viewed as a license. Here, we are interested in whether there is a license-like default relegation to the original status. Relevant to whether there is such relegation, the contract has (1) the license-like feature of paying a royalty (§4.2), (2) the license-like feature of reversion of the assets when the contract is voluntarily terminated by grantee (§8.5(b)), (3) the license-like feature that the grantor is represented on the Joint Steering Committee (Art. 3), (4) and the license-like feature that the grantor can terminate for breach, such as non-payment of royalties (§§8.3, 8.5(a)), (5) the license-like feature that given breach the grantor can reacquire the assets on a country-by-country basis (§8.3), and (6) the license-like feature that the grantor can veto assignment of the contract to non-related parties (§9.2). *See, Conde Nast Publications, Inc. v. U. S.*, 575 F.2d 400, 405, 198 U.S.P.Q. 202, 205 (2nd Cir. 1978)(for tax purposes, retention by the transferor of a substantial right in the

transferred property or the continued participation of the transferor in the transferee's business is the touch-stone of a license). Thus, for the current purposes the 2004 Agreement is a license, where rights revert to grantor.

Accordingly, Sköld's priority use of the mark RESTORADERM is not trumped by the 2002 or 2004 Agreements.

VI. CONCLUSION

Accordingly, Sköld has priority rights to the mark which he has maintained, and Registrant's defense of assignment is ineffective. Therefore, Registrant's Registrations Nos. 2985751 and 3394514 should be cancelled.

Respectfully submitted,

/Arthur E Jackson/

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