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Trademark Trial and Appeal Board
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Alexandria, VA 22313-1451
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JK

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Cancellation No. 92054171

Valeritas, Inc.

v.

VGO Communications, Inc.

**Before Quinn, Ritchie and Masiello.
Administrative Trademark Judges.**

By the Board:

VGO Communications, Inc. (“Respondent”) owns a registration on the Principal Register¹ for the mark **VGO** (standard characters) for the following International Class 9 goods:

robotic video and audio communication hardware; computer software for use in connection with audio and video communication systems.²

Valeritas, Inc. (“Petitioner”) filed a petition to cancel the registration on the ground of priority and likelihood of confusion pursuant to Trademark Act § 2(d). Petitioner asserts ownership of two applications filed June 4, 2009

¹ In its petition to cancel, Petitioner indicates that the subject registration is on the Supplemental Register. (pet. to canc., para. 11) This is erroneous, and the Board disregards it.

² Registration No. 3895432, issued December 21, 2010, from an application filed March 2, 2010, and asserting a date of first use anywhere, and date of first use in commerce, of July 29, 2010.

based on § 1(b), for “medical apparatus, namely, infusion and injection devices for administering drugs” in International Class 10, for:

- 1) the mark **V-GO** (standard characters); and
- 2) the mark shown below (DISPOSABLE INSULIN DELIVERY disclaimed; includes the color claim “The colors dark green, medium green, light green, lime green, and white are claimed as a feature of the mark.”).³



Subsequent to the institution of this proceeding, Petitioner’s two applications registered, on April 10, 2012 and February 28, 2012, respectively. In both registrations, Petitioner alleges a date of first use anywhere and date of first use in commerce of January 3, 2012.

In its answer, Respondent denied the salient allegations in the petition to cancel.

Petitioner filed a motion for summary judgment with respect to priority and likelihood of confusion. The motion is fully briefed.

ANALYSIS

Summary judgment is appropriate where the movant shows that there is no genuine dispute as to any material fact and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). A party asserting that a fact cannot be true or is genuinely disputed must support its assertion by either 1) citing to particular parts of materials in the record, or 2) showing

that the materials cited do not establish the absence or presence of a genuine dispute, or that an adverse party cannot produce admissible evidence to support the fact. *See* Fed. R. Civ. P. 56(c). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *See Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

The evidence on summary judgment must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA*, 23 USPQ2d at 1472. The Board may not resolve genuine disputes as to material facts; it may only ascertain whether genuine disputes as to material facts exist. *See Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1544. *See also* TBMP § 528.01 (2014), and cases cited therein.

Standing⁴

To prove standing, Petitioner must establish that it has a “real interest,” *i.e.*, a direct and personal stake, in the outcome of the proceeding, as well as a “reasonable basis” for its belief of damage. *See Ritchie v.*

³ Application Serial No. 77752694 issued as Registration No. 4125819, and Application Serial No. 77752697 issued as Registration No. 4105936, respectively.

⁴ Petitioner's standing is not contested on summary judgment. Nevertheless, we address standing for completeness.

Simpson, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). The Court of Appeals for the Federal Circuit has enunciated a liberal threshold for determining standing. *See Ritchie v. Simpson, supra* at 1030. *See also Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988).

Petitioner has pleaded allegations which, if proven, would establish its standing, *i.e.*, Petitioner's allegation that it owns registrations for the above-identified two marks. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Indus., Inc. v. Ralston Purina Co.* at 189. However, Petitioner did not make its pleaded registrations of record pursuant to Trademark Rule 2.122(d)(2), which would prove its ownership of and status of the registrations, thereby establishing its standing. Petitioner submitted copies of the certificates of registration that were issued on the date of registration; however, a copy of the original certificate of registration is not competent evidence to show "the current status of and current title to the registration," as required by Trademark Rule 2.122(d)(2). *See Syngenta Crop. Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1116-17 (TTAB 2009).

Accordingly, there remains a genuine issue as to Petitioner's standing.

Ground for Cancellation - Priority and Likelihood of Confusion

To prevail on summary judgment, Petitioner must demonstrate that there is no genuine dispute that 1) it has priority, and 2) the

contemporaneous use of the parties' respective marks on their respective goods is likely to cause confusion, mistake or to deceive consumers regarding the source of the goods. *See Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001).

Priority

In this cancellation proceeding, Petitioner must, in the first instance, establish prior rights in the same or a similar mark; Respondent can in turn establish that it has rights in its mark that are superior to those of Petitioner. *See Brewski Beer Co. v. Brewski Bros. Inc.*, 47 USPQ2d 1281, 1284 (TTAB 1998). Accordingly, to prevail on summary judgment, Petitioner must prove that there is no genuine dispute that it has prior use of the mark.

Petitioner filed the applications underlying its pleaded registrations on June 4, 2009, prior to the date on which Respondent filed the application underlying its registration, and asserts that date as its constructive use date (motion, p. 10). In its brief, Respondent does not address priority, and does not include priority in its "Statement of Disputed Factual Issue" (sic) (brief, p. 3).

Petitioner relies on the fact that the June 4, 2009 filing date of the applications underlying its pleaded registrations predates the March 2, 2010 filing date of Respondent's subject registration. However, as noted, Petitioner did not make its pleaded registrations of record pursuant to Trademark Rule 2.122(d)(2) to establish its claim of priority on summary

judgment, and its copies of the certificates of registration are not competent evidence to show “the current status of and current title to the registration.” *See Syngenta Crop. Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d at 1116-17. Moreover, on summary judgment Petitioner has not submitted any evidence to establish prior rights in the mark.

Accordingly, there remains a genuine dispute as to priority.⁵

Likelihood of confusion

With respect to likelihood of confusion, in the context of summary judgment motions, we apply an analysis of all probative facts in evidence that are relevant to the thirteen factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont* factors”). *See also, M2 Software Inc. v. M2 Communications Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1946 (Fed. Cir. 2006); *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We look to whether there are genuine disputes with respect to any of these factors which would be material to a decision on the merits. Two key factors are the degree of

⁵ At final hearing, either party may rely on the filing date of the applications underlying the registrations at issue, and if neither party submits proof of its use prior to its respective application filing date, priority belongs to the party with the earlier filing date. *See Dan Foam ApS v. Sleep Innovations Inc.*, 106 USPQ2d 1939, 1945 (TTAB 2013), *citing Hilson Research Inc. v. Society for Human Resource Mgmt.*, 27 USPQ2d 1423, 1428-29 n.13 (TTAB 1993) and *Brewski Beer Co. v. Brewski Bros. Inc.*, *supra*.

similarity of the parties' marks, and the degree to which their respective goods are related. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012).

The Marks - Respondent's VGO mark v. Petitioner's V-GO mark

Petitioner argues that, because the hyphen in its mark does not significantly alter its mark, the parties' marks are "virtually identical" (motion, p.7). Respondent does not set forth arguments contesting this point (brief, p. 3).

We find on this record that there is no genuine dispute that the respective standard character marks, VGO and V-GO are virtually identical.

The Marks - Respondent's VGO mark v. Petitioner's  mark

Petitioner compares its mark, side-by-side, not to Respondent's standard character mark, but to how Respondent's mark appears on the specimen submitted with the underlying application (motion, p. 8, Exh. C). Petitioner concludes that the parties' "design marks are substantially similar" (motion, p. 9, 11). Respondent, referring to the same side-by-side presentation, argues that the marks create disparate overall appearances due to specific differences such as Respondent's "wheel symbol comprised of two arcs," and Petitioner's hyphen intended to represent a finger prick or needle button (brief, p. 4-5).

When comparing marks, the test is not whether they can be distinguished in a side-by-side comparison, but rather whether they are

sufficiently similar in their commercial impressions that confusion as to the source of the goods and services offered under the marks is likely. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). Furthermore, our comparison of the marks must center on Respondent's mark as it appears in its registration, that is, the standard character mark VGO. *See B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1508 (TTAB 2007); *Jockey Int'l. Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233, 1236 (TTAB 1992); *Blue Cross and Blue Shield Assoc. v. Harvard Community Health Plan Inc.*, 17 USPQ2d 1075, 1077 (TTAB 1990). As a registered standard character mark, Respondent's VGO mark may be displayed in any lettering style because its rights reside in the literal element, not in any particular display or rendition. Trademark Rule 2.52(a). *See also In re Viterra Inc.*, 101 USPQ2d at 1909; *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010). Although illustrations of the mark as actually used may assist the Board (*see Citigroup Inc. v. Capital City Bank Group Inc.*, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011)), in determining whether there is a genuine dispute as to this *du Pont* factor, we consider the fact that Respondent may use its mark in any stylization, including in manners that are different from how the mark is displayed on its specimen.

On the record before us, the parties' marks include differences that are sufficient to preclude a finding that, as a matter of law, the marks create in the minds of consumers the same overall commercial impressions when used on the respective goods. In particular, Petitioner's inclusions of numerous design elements, as well as the additional albeit disclaimed wording DISPOSABLE INSULIN DELIVERY, raise a genuine dispute, and thus preclude a finding that the marks are so similar in their entireties as to create the same overall commercial impression, or a finding that they create the same visual appearance or sound.

The Goods

Petitioner asserts that both parties' goods "are used in healthcare and patient management" (motion, p. 9). Specifically, it asserts that its product is "an insulin delivery device" (motion, p. 5), and that Respondent's product is used "in the healthcare industry, including in the field of diabetes care and management" (motion, p. 5), from which it concludes that both parties' goods "are used in the field of diabetes care and management" (motion, p. 12). It submits, *inter alia*,⁶ the Fed. R. Civ. P. 30(b)(6) deposition wherein Respondent's designee stated that a third of Respondent's market consists of

⁶ Petitioner did not include with its motion an affidavit or declaration to authenticate Exhibits D (advertisement), E and F (articles) and K (product demo), which are not self-authenticating either as printed publications or official records under Trademark Rule 2.122(e), or as materials obtained from the Internet which identify both the date of publication or access, and the source (*e.g.*, the URL) (*see Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010)). The materials are of unknown print, publication or online origin, and the authenticity of

the healthcare industry (motion p. 6, Exh. G, Ryden depo., p. 42, 49); it also submits pages from Respondent's website (motion p. 6, Exh. I).⁷ Petitioner further argues that channels of trade, and whether the parties are competitors, should be given little weight because the standard character marks are identical and the design marks are similar (motion, p. 11).

For its part, Respondent asserts that its product is "a remote communication robot," is not an infusion and injection device, does not administer drugs or medication, does not deliver insulin or any other drug, does not touch patients, does not treat or diagnose any medical condition, and does not monitor or assess patients (brief, p. 7). It asserts that its product is sold to the health care market, but is also sold to large enterprises, manufacturers, small business consumers, telecommunications companies and the education market. It submits, *inter alia*, its Fed. R. Civ. P. 30(b)(6) deposition (brief p. 10, Exh. F, Ryden depo., p. 42), and a comparison between its own product brochure (brief, p. 7, Exh. G) and an instruction manual for Petitioner's product (brief, p. 7, Exh. H) to show differences between the

the materials is not verifiable on their face. Consequently, we have given these exhibits no consideration.

⁷ The Board has given no consideration to the previously unsubmitted evidence that Petitioner included with its reply brief (an email exchange from 2011 and attachments; a link to an online video). The submission is untimely. Moreover, it is troubling that Petitioner states that it did not submit the materials earlier because it obtained them on November 25, 2015 - "in the middle of Petitioner's Testimony Period." Testimony periods were reset on May 12, 2014, and the filing of Petitioner's November 7, 2014 motion to compel effectively suspended proceedings. See Trademark Rule 2.120(e)(2); TBMP § 523.01 (2014). If the parties did not treat the proceeding as suspended upon the filing of the motion to compel, they should have, at a minimum, treated proceedings as suspended with Petitioner's filing of its

parties' products. Regarding trade channels, it argues that Petitioner's product, unlike its own, requires FDA approval and must be prescribed by a physician, and argues that end users must consult a health care professional in order to obtain Petitioner's product - an insulin-delivery device - from a pharmacy.

The question of likelihood of confusion is determined based on the description of goods in the registration at issue, not on extrinsic evidence of actual use. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1722; *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *McDonald's Corp. v. McSweet*, 112 USPQ2d 1268, 1283-84 (TTAB 2014). Respondent's registration includes no limitation or restriction as to the uses for or intended users of its identified goods, and Petitioner has submitted evidence to show that Respondent markets its products in the healthcare industry. However, the parties' goods are sufficiently different in nature that the fact that they are both sold in the healthcare industry is insufficient to demonstrate a lack of genuine dispute as to whether they are related in such a manner as to give rise to likelihood of confusion as to source. Viewing the evidence in a light most favorable to Respondent as non-movant, as we must do on summary judgment, the record does not support a finding, as a matter of law, that the parties' goods are so similar as to create a likelihood of confusion as to source.

November 8, 2014 motion for summary judgment. In any event, the parties should not have proceeded with testimony.

SUMMARY

Having considered the parties' arguments, and affording the evidence of record its appropriate probative value, viewing the evidence in a light most favorable to Respondent as non-movant, we find that Petitioner has not carried its burden of demonstrating that there is no genuine dispute with respect to standing, priority or likelihood of confusion. In view of these findings, Petitioner's motion for summary judgment is denied.

The evidence submitted in connection with the motion for summary judgment is of record only for consideration of that motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. *See, e.g., Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1438 n.14 (TTAB 2007); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).

The fact that we have identified certain issues that are in dispute should not be construed as a finding that these are necessarily the only issues which remain for trial.

CONTINUATION OF SUSPENSION

The Board references its March 3, 2015 order, footnote 2. Inasmuch as determination of Petitioner's motion for summary judgment does not dispose of this proceeding, 1) proceedings remain suspended under Trademark Rule 2.120(e)(2) pending disposition of petitioner's November 7, 2014 motion to compel discovery, test the sufficiency of responses to requests for admission,

and reopen discovery, and 2) Petitioner is allowed until fifteen (15) days from the mailing date of this order to submit a filing stating whether its motion to compel remains viable in all respects, and specifically which, if any, discovery disputes discussed in its motion have been resolved since the time Petitioner filed its motion. If Petitioner does not submit this filing, Petitioner's motion will be given no consideration and deemed moot, and the Board will resume and reset trial dates.

CONTINUATION OF REQUIREMENT

In the September 25, 2013 and May 12, 2014 orders, the Board stated that any motions to suspend or extend dates for the purpose of settlement would be denied absent a showing of extraordinary circumstances. This requirement is continued. Specifically, any such motion must be accompanied by a detailed progress report that sets forth the extraordinary circumstances upon which the motion is based. At a minimum, the progress report must include each of the following with respect to activities taken during the most recent time period or period of suspension: 1) each date on which settlement was discussed between the parties, 2) each date on which an email was sent or responded to between the parties, 3) each date on which a draft settlement or portion thereof, if any, was sent or was responded to between the parties, and 4) any specific circumstances the parties have encountered and the manner in which said circumstances have prevented the parties from reaching settlement.

Cancellation No. 92054171