

TTAB

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



THE IMMUNE RESPONSE CORPORATION  
Opposer

11-01-2001

U.S. Patent & TMO/TM Mail Rcpt Dt. #11

v.

Opposition No. 91150037

ZLB BIOPLASMA AG  
Applicant

MOTION TO DISMISS

Applicant, ZLB BIOPLASMA AG, hereby moves to dismiss the subject Opposition on the ground that, as a matter of law, Opposer, THE IMMUNE RESPONSE CORPORATION, cannot be damaged by Applicant's registration of the mark REDIMUNE for "pharmaceutical preparations to be administered intravenously to support the function of the human immune system.

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FACTS

On September 11, 2000, Applicant, ZLB BIOPLASMA AG, filed an application to register the mark REDIMUNE for "pharmaceutical preparations to be administered intravenously to support the function of the human immune system." This application was published for opposition on May 29, 2001 and was opposed by THE IMMUNE RESPONSE CORPORATION on August 10, 2001 on the basis of its registration for the mark REMUNE, Reg. No., 2,464,045, for "pharmaceutical preparations for use in the treatment of HIV." Applicant filed its answer to

the Notice of Opposition on September 17, 2001.

## ISSUE

Can Opposer be Damaged by Applicant's Registration of the Mark REDIMUNE

## ARGUMENT

For the following reasons Applicant submits that as a matter of law Opposer cannot be damaged by registration of the mark REDIMUNE for the applied for goods, and, accordingly, requests that the Opposition be dismissed with prejudice.

Applicant is the owner of a registration, Reg. No. 2,131,877 for the mark REDIMUN for "pharmaceutical preparations to be administered intravenously to support the function of the human immune system." Applicant submits that since the marks REDIMUN and REDIMUNE are virtually identical and the goods covered thereby are identical that Opposer cannot be damaged by registration of the mark REDIMUNE. The leading case in this area is Moorhouse Manufacturing Corporation v. J. Strickland and Company, 407 F. 2d 881 (CCPA, 1969). In that case the Court held:

"...as a matter of law, the opposer cannot be damaged, within the meaning of Section 13 of the statute, by the issuance to the applicant of a second registration where applicant already has an existing registration for the same mark for the same goods. ...As to the existing registration being for the same mark, while there are trifling differences it takes careful inspection to detect them."

The facts in this case seem to fall squarely within the ruling in Moorhouse. Here we have the

virtually identical marks REDIMUN and REDIMUNE which cover the identical products.

Under the circumstances, Opposer cannot be damaged by Applicant's registration of the mark REDIMUNE for the applied for goods. See also Carl Karcher Enterprises, Inc. v. Gold Star Chili, Inc., 222 USPQ 727 (TTAB 1983) where the Board stated:

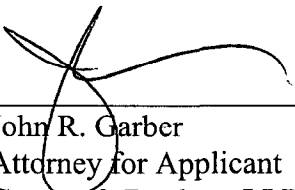
“...the plaintiff should be precluded from challenging a new application if the defendant owns a registration for a substantially similar mark for substantially similar goods. No added damage results to opposer from the second registration.”

Other cases which uphold the foregoing proposition are Artichoke Industries, Inc. v. Regina Grape Products Co., 138 USPQ 687 (TTAB 1963); Standard Motors Products, Inc. v. Standardized Products Company 107 USPQ 147 (Comm. of Patents 1955); and Scudder Food Products, Inc., et al. v. Southern Fruit Distributors, Inc., 119 USPQ 450 (TTAB 1958).

In view of the above, as a matter of law, Opposer cannot be damaged by Applicant's registration of the mark REDIMUNE for the applied for goods. Accordingly, it is respectfully requested that the subject Opposition be dismissed, with prejudice.

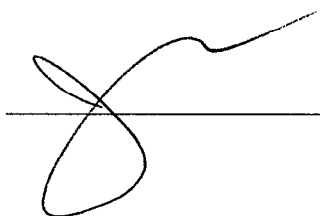
Dated: October 29, 2001

Respectfully submitted,

  
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CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing MOTION TO DISMISS has been served on Opposer's attorneys Mr. Richard L. Kirkpatrick and Mr. Michael S. Christian of Pillsbury Winthrop LLP, 50 Fremont Street, P.O. Box 7880, San Francisco, California 94120-7880 by first class mail, postage prepaid this 29<sup>th</sup> day of October, 2001.

A handwritten signature in black ink, consisting of a large, stylized loop that crosses itself, followed by a horizontal line extending to the right.