



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

ALLERGAN, INC. )

Opposer, )

v. )

TACTICA INTERNATIONAL, INC. )

Applicant. )

Opposition No. 91159959



06-21-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

Attorney Ref. No.: 29114-202786

**APPLICANT'S OBJECTION TO OPPOSER'S RULE 56(f) REQUEST FOR  
DISCOVERY**

Applicant respectfully objects to Opposer's Rule 56(f) Request for Discovery to Respond to Applicant's Motion for Summary Judgment.

Opposer has stated that it should be allowed the opportunity to conduct discovery regarding Applicant's intent in adopting the mark at issue so as to enable Opposer to present a full and complete opposition to Applicant's Motion for Summary Judgment.

Applicant respectfully submits that its intent in adopting the mark at issue is irrelevant to the matter at hand, and would have no bearing on the outcome of the pending Motion for Summary Judgment.

First, for purposes of the Motion for Summary Judgment, Applicant has stipulated to the following statement of uncontested facts.

1. Applicant admits the allegations in Paragraphs 1-5 of the Notice of Opposition.
2. Opposer's use and registrations of the mark BOTOX are prior to any date of first use in the U.S. of the mark FIRMA TOX that may be relied upon by applicant.

3. The goods covered by Opposer's mark BOTOX and the goods covered in Opposer's pleaded registrations for the mark BOTOX are related to the goods covered in the subject application to register the mark FIRMA TOX in the U.S.

The sole issue left to be determined on Summary Judgment is whether the marks of the parties' are confusingly similar. The Applicant's intent in selecting and adopting the mark at issue is not relevant to whether the marks themselves are so similar to each other that confusion between them is likely.

Specifically, in *Steak N Shake, Inc. v. Steak & Ale, Inc.*, 171 USPQ 175 (TTAB 1971), the Board stated

Applicant's alleged knowledge of opposer's mark prior to the adoption of its own mark is not a controlling factor in this proceeding since if confusion or mistake is not likely to result from the use of the marks, the motive of the applicant cannot affect its right to the registration sought. *See: Shoe Corporation of America v. The Juvenile Shoe Corporation of America*, 121 USPQ 510 (CCPA, 1950); *Kramer Trenton Co., Walcutt*, 161 USPQ 228 (CCPA 1969) and *Lever Brothers Company v. Riodela Chemical Co.*, 5 USPQ 152 (CCPA 1930).

In the present case, it is the Applicant's position that the marks are so different, that "confusion or mistake is not likely to result from the use of the marks" no matter whether the Applicant was aware of the Opposer's mark at the time Applicant adopted its mark, and no matter the Applicant's intent.

Even if the Board were to infer that Applicant's intent was to somehow trade off of the reputation of the Opposer's mark, it is Applicant's position that the marks, when considered in their entireties, are not confusingly similar. As stated in *Steak N Shake, Inc. v. Steak & Ale, Inc.*, *supra*, and affirmed by the Board in *Electronic Water Conditioners, Inc. v. Turbomag Corporation*, 221 USPQ 162,165 (TTAB 1984), "where there is no likelihood of confusion, the motive of the later applicant in adopting its mark cannot affect its right to registration."

The Board has stated that "this rule is based on the well established doctrine that an intent to do wrong cannot transmute a lawful into an unlawful act." *Electronic Water Conditioners, Inc. v. Turbomag Corporation, supra.*

It is the Applicant's contention that the "catch-all thirteenth *DuPont* factor, the intent of the Applicant in choosing its mark" is NOT relevant to the likelihood of confusion determination if the marks are so dissimilar that there can be no likelihood of confusion.

The "bottom line" here is that the Applicant's intent in adopting the mark at issue is irrelevant because the Board can determine, based upon a comparison of the marks in their entireties, that they are sufficiently dissimilar such that confusion is not likely regardless as to the Applicant's intent.

Finally, Applicant notes that the Notice of Opposition contains no allegations relating to the Applicant's intent in adopting the mark at issue. And, in any event, to the extent that any of the allegations in the Notice of Opposition may be construed as relating to Applicant's intent in adopting the mark at issue, the Applicant has conceded such allegations for the purpose of its Motion for Summary Judgment.

The Opposer's Rule 56(f) Request should therefore be denied.

Respectfully submitted,



Dated: June 21, 2004

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**CERTIFICATE OF SERVICE**

The undersigned, attorney for Applicant, hereby certifies that he served, by first class mail, postage prepaid, a copy of each of the foregoing

**APPLICANT'S OBJECTION TO OPPOSER'S RULE 56(f)  
REQUEST FOR DISCOVERY**

upon

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this 21<sup>st</sup> day of June, 2004.



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**Mark B. Harrison**