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05-31-2007

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

11 In re the matter of Trademark Application No. 78/116,976
12 For the mark **OXIUM**
13 Published: February 3, 2004

14 Therox, Inc.,) Opposition No. 91160810
15 Applicant,)
16 v.)
17 The Mentholatum Company,) **APPLICANT'S SUPPLEMENTAL**
18 Opposer.) **BRIEF**

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1 **I. T.T.A.B. PRECEDENT.** Since the filing of its opposition, Applicant found that on
2 **April 3, 2007** in *The Mentholatum Company Substituted for SmithKline Beecham*
3 *Corp., v. Skin Products, Inc.*, Opposition No. 91160694, the **Trademark Trial and**
4 **Appeal Board** decided that Mentholatum's mark "**OXY**" is not a famous mark.¹
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6 The same general evidence was provided to the TTAB in the present proceeding
7 with applicant, namely a brand awareness study discussed by Mr. Brown in his
8 testimony deposition, that the Board previously found "difficult to evaluate the
9 reliability of the study or the significance of the results." In fact, through the
10 testimony of Opposer's brand manager, Mr. Todd Cantrell, it appears that the OXY
11 brand has slipped further in its market share of the acne medication market, to 5.6%.
12 (Cantrell Depo., p. 48, lns. 2-7.) As such, in the present opposition, the applicant
13 requests that the same finding be made, namely, the mark OXY is not famous, or in
14 the alternative, while the OXY mark has some degree of recognition, it is **limited**
15 **solely to acne medication.**²
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26 ¹ Cited for its persuasive value pursuant to Citation of Opinions to the Trademark Trial and Appeal Board,
Official Gazette Notice dated January 27, 2007.

27 ² Applicant notes that the goods at issue in Opposition No.: 91160694 were identical, namely acne
28 medications. In the present case, the goods are not the same.

1 II. “NATURAL ZONE OF EXPANSION”. Opposer argues that its filing of
2 Application Serial No. 78/774055 on December 15, 2005 (during the discovery
3 period of this proceeding) evidences its “natural zone of expansion” into other
4 skincare products. However, this alleged “natural zone” did not exist prior to the
5 filing of Applicant’s application, March 22, 2002, as Opposer used its mark
6 *exclusively* on “acne medication” for over thirty years. It is the burden of Opposer to
7 show, by a preponderance of the evidence, that it was selling or going to sell
8 products branded with the OXY mark other than acne medications at the time that
9 Applicant applied for its mark for “oxygenated skin care preparations, namely,
10 creams, masks, gels and lotions for the face, hands, feet and body, not including
11 acne preparations.” *Boomerang.com, Inc. v. Market Tools, Inc.*, Opposition No.:
12 91150250, citing *Sealy, Inc. v. Simmons Co.*, 121 USPQ 456, 458 (CCPA 1959).
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16 (priority to goods/services established at the time of applicant’s filing)
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1 This opposition was filed June 1, 2004, and the mark had been used by Glaxo-
2 Smithkline, Opposer's predecessor, **on nothing other than acne medications for over**
3 **thirty years.** Applicant filed its application for oxygenated skincare preparations, not acne
4 medications. While Opposer could have used its mark on goods other than acne
5 medications at any time during its period of use,³ the fact remains that it did not. Opposer
6 is not entitled to sell its brand to another company, well after Applicant's filing date, and
7 then propose to use the mark on goods other than acne medications, to the detriment of
8 Applicant. *M2 Software, Inc. v. Madacy Entertainment*, 76 USPQ2d 1161 (9th Cir. 2005)
9 (senior user's nominal use on other products over a decade of time proved there was little
10 likelihood of expansion). Opposer apparently wants to make a diversification argument in
11 that consumers of its acne medication would assume that the mark OXY would be found
12 on other, non-competitive skincare products. However, this argument must be rejected,
13 where Opposer uses many different brand names for various products, rather than one
14 mark used on a wide range of unrelated and non-competitive products. (See, *Brown*
15 *Deposition*, p. 10-lns. 4-25, p. 11, lns. 1-25.) Here, as well, the marks are quite different in
16 appearance (OXY versus OXIUM), and are not used on competitive goods. In any
17 likelihood of confusion analysis, the two key considerations are the similarities between
18 the marks and the relatedness of the goods/services. *In re Dixie Restaurants, Inc.*, 41
19 USPQ2d 1531 (Fed. Cir 1997). While the relatedness of the goods is but one factor in the
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26 ³ It is irrelevant that third parties have sold broader product lines under third party brand names than
27 Opposer. Opposer has simply never expanded its OXY product outside of acne medication for
28 over 3 decades. As aptly put by Applicant's personnel, "OXY screams acne medication," but
nothing else.

1 Du Pont analysis, in combination with the clear and obvious distinctions between the
2 marks themselves, both of these factors should weigh heavily in Applicant's favor.
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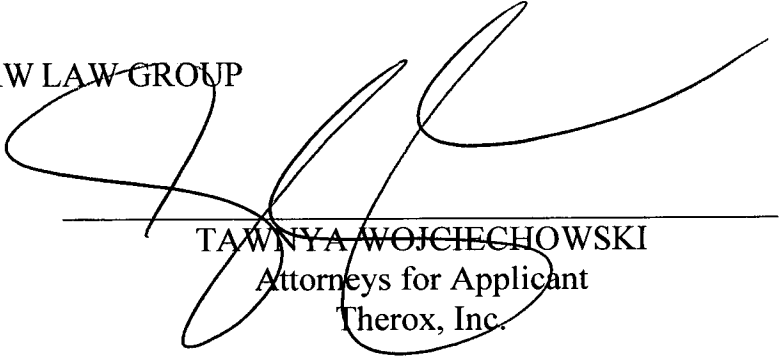
4 **III. CONCLUSION**

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6 Opposer has not made a showing that its mark is famous, and as such, the breadth of
7 protection accorded to it must be narrowly construed to acne medications. Applicant's
8 filing date of its present application controls for determining whether Opposer may claim a
9 "natural zone of expansion" for a general, non-acne-related skincare product line despite
10 more than 30 years of use solely in connection with acne medications. Applicant believes
11 that Opposer does not have such right and as such, may not claim that it owns the right to
12 expand its acne medication line to a general skincare product line (which apparently will
13 still be directed primarily to the teenage and young adult market for reducing acne
14 problems) in the face of Applicant's prior application covering oxygenated skincare
15 products. (Cantrell Deposition, Confidential Portion, p. 50, Ins. 1-15 and p. 51, Ins. 1-18, p.
16 52, Ins. 8-19).
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20 DATED: May 20, 2007

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22 TRW LAW GROUP

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24 By


25 TAWNIA WOJCIECHOWSKI
26 Attorneys for Applicant
27 Therox, Inc.
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EXPRESS MAIL CERTIFICATE

I hereby certify that an original of the following document:

Applicant's Supplemental Brief

is being deposited with the United States Postal Service as Express Mail under Express Mail Number:

EV 691426551

marked Post Office to Addressee in an envelope addressed to:

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, VA 22313-1451 on the date shown below:

Diane Magaletta-Barnes

(Typed or Printed Name of Person Signing Certificate)

Diane Magaletta Barnes

(Signature)

May 31, 2007

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PROOF OF SERVICE

I am employed in the County of Orange; I am over the age of eighteen years and not a party to the within entitled action; my business address is TRW Law Group, 19900 MacArthur Boulevard, Suite 1150, Irvine, California 92612-8433.

On May 31, 2007, I served the following document(s) described as **Applicant's Supplemental Brief** to the interested party in this action by placing a true and correct copy thereof enclosed in a sealed envelope addressed as follows:

Leigh Ann Lindquist
Gary D. Krugman
Attorneys for Opposer
SUGHRUE MION, PLLC
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- BY MAIL:** I am "readily familiar" with the firm's practice of collection and processing correspondence for mailing. Under that practice it would be deposited with the U.S. postal service on that same day with postage thereon fully prepaid at Costa Mesa, California in the ordinary course of business. I am aware that on motion of the party served, service is presumed invalid if postal cancellation date or postage meter date is more than one day after date of deposit for mailing in affidavit.
- BY OVERNIGHT DELIVERY:** I served such envelope or package to be delivered on the same day to an authorized courier or driver authorized by the overnight service carrier to receive documents, in an envelope or package designated by the overnight service carrier.
- BY HAND DELIVERY:** I caused such envelope(s) to be delivered by hand to the office of the addressee(s).
- STATE:** I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct.
- FEDERAL:** I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed on May 31, 2007, at Irvine, California.



Diane Magaletta-Barnes