

ESTTA Tracking number: **ESTTA302598**

Filing date: **08/24/2009**

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

Proceeding	91169571
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Attachments	opposer's reply brief aug 24 09.pdf (16 pages)(64800 bytes)

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I. INTRODUCTION

Applicant's opposition brief does nothing more than attempt to deflect attention from the merits of this opposition by focusing on incorrect and flawed arguments concerning hypertechnical issues. Applicant first takes issue with the manner in which Opposer introduced its own registrations, even though Opposer did so correctly. Then, in a further effort to distract from the merits of this case, Applicant draws attention to a mere typographical error in Opposer's Notice of Reliance filed on September 11, 2007. Additionally, throughout its argument, Applicant focuses on date of priority issues that, even if correct, would still leave Applicant decades short of Opposer's priority date.

As an initial matter, even though this opposition is directed to all nine classes of Applicant's application, Opposer recognizes that it focused its opening brief on Class 5 goods. This is because, after asking Applicant interrogatories addressing use, Applicant only identified a single product, Sativex, which is a pharmaceutical product within Class 5. With respect to Class 5, it is undisputed that Applicant has conceded this argument as evidenced by Applicant's cancellation of Class 5 at the time it filed its opposition brief. This is an admission that a likelihood of confusion exists between Opposer's marks and that of Applicant. Accordingly, Opposer respectfully requests the Board to enter judgment against Applicant as to Class 5.

Given the concessions by Applicant, it is surprising that Applicant's opposition brief attempts to refute whether Opposer has priority and that a likelihood of confusion does not result with the other remaining classes. The evidence of record proves Opposer's entitlement to, at the very least, its October 3, 2000 filing date for the applications that matured into Registration Nos. 2,577,687 and 2,606,786 asserted in this proceeding. Even more surprising is that Applicant attempts to argue that Opposer is precluded from presenting arguments directed

towards any class of goods other than Class 5 because those classes were not addressed in Opposer's opening brief. Applicant, however, provides no support for its position related to this issue. Accordingly, after all considerations, Opposer respectfully submits that the Board should refuse registration of Application No. 78/354,188.

II. ARGUMENT

A. Opposer's Submission Of Its Registrations Is Proper Under The Rules

As an initial matter, it appears that Applicant takes issue with Opposer's submission of uncertified copies of the certificates of registration for Opposer's Registration Nos. 2,577,687 and 2,606,786, which were submitted in Opposer's Notice of Reliance filed on September 10, 2009.

First, Opposer's Registrations were introduced as Exhibit 1 and 2 during Mr. Greene's deposition. (Greene Dep. 15-20.) During that testimony, Mr. Greene testified as to his knowledge, status, and title of the registration. *Id.* Second, a notice of reliance was filed on September 10, 2007 with photocopies of the registrations as prepared and issued by the Patent and Trademark Office, showing the current status and title to the registrations. Certified copies are simply not required under the rules. 37 C.F.R. § 2.122(e). Lastly, Applicant, the adverse party in this proceeding, has treated the registrations as being of record in its brief and Amended Answer. (See Am. Answer ¶¶ 14-16.) Thus, according to the *Trademark Trial and Appeal Board Manual of Procedure* ("T.B.M.P.") § 704.03(b)(1), these are all acceptable methods to introduce Opposer's registrations, and as such, Opposer submits that its two registrations have been properly made of record.

B. Opposer Is Permitted To Address All Of Applicants' Arguments Presented In Its Opposition Brief

Applicant alleges that because Opposer only addressed the goods and services in Class 5, it is precluded from presenting arguments with respect to the other eight classes in Applicant's application, even though Opposer is opposing the registration of Applicant's mark with respect to all nine International Classes listed in the application. As a result, Applicant argues that Opposer has conceded its case with regards to the goods and services in the remaining eight classes in the application.

However, in making this spurious argument, Applicant makes nothing more than conclusory statements in reliance on 37 C.F.R. § 2.128(a)(3) and T.B.M.P. § 536, which states:

When a party in the position of plaintiff fails to file a main brief, an order may be issued allowing plaintiff until a set time, not less than fifteen days, in which to show cause why the Board should not treat such failure as a concession of the case. If plaintiff fails to file a response to the order, or files a response indicating that he has lost interest in the case, judgment may be entered against plaintiff.

However, this section has no relevance to the situation here. This section simply does not apply in this instance. First, Opposer filed a main brief in this case and has not shown any loss of interest in this opposition proceeding. Second, according to Section 536, the "purpose of 37 C.F.R. § 2.128(a)(3) is to save the Board the burden of determining a case on the merits where the parties have settled, but neglected to notify the Board thereof, or where the plaintiff has lost interest in the case." *See* T.B.M.P. § 536. Lastly, when a plaintiff does not file a main brief the Board normally issues an order, *sua sponte*, to show cause why the failure to file a brief should not be treated as a concession. *Id.*

As demonstrated, Applicant's reliance is misplaced, and Opposer is not precluded from addressing the remaining classes in the application. Opposer filed a main brief in this case and has not shown a loss of interest in these proceedings. Quite to the contrary, Opposer is moving

forward with the proceedings. Next, the Board did not issue an order to show cause why Opposer's brief should not be treated as a concession with regard to the remaining classes as normally happens if Opposer fails to file a main brief. Instead, Opposer's main brief concentrated on Class 5, which was persuasive as evidenced by Applicant's cancellation of Class 5, but Opposer's overall opposition proceeding pertains to all nine classes in the Application. Most importantly, however, is that because Applicant chose to cancel Class 5, its opposition brief is entirely directed toward the other eight classes listed in its application, which means Applicant was fully aware that this opposition involved all nine classes. (Opp'n Br. 9-17.) Thus, Opposer is entitled to a chance to be heard and rebut the defendants' allegations made in its main brief with respect to the other eight remaining classes in Application No. 78/354,188.

C. Opposer Has Met Its Burden And Established Its Priority To The Mark

Applicant has not established priority over Opposer's mark since the evidence in the record establishes that G&W marks were used prior to Applicant's priority date. Applicant's priority date, at best, is the date of its application, January 20, 2004, which claims priority to a United Kingdom Application No. 2338252 filed on July 21, 2003. Even though Opposer mistakenly did not account for Applicant's claim of priority to its United Kingdom Application, a mere six-month difference, Applicant still fails to prove that it has priority over Opposer. In fact, the evidence submitted by Opposer establishes that it still predates Applicant's earliest possible priority date by decades.

Opposer put forth testimony of Mr. Greene, who has been employed by Opposer since August 1993. Contrary to Applicant's allegations, the scope of Mr. Greene's personal knowledge of the use of Opposer's marks dates back before 1993. First, Mr. Greene is intimately involved in Opposer's business as its general counsel, and is generally familiar with all of Opposer's

activities. (Greene Dep. 9.) As general counsel, he has access to Opposer's records and history and is capable of furnishing first-hand knowledge about the use of Opposer's marks prior to 1993. Second, prior to becoming Opposer's general counsel, Mr. Greene was Opposer's outside counsel since the early 1980's. (*Id.* at 18.) Mr. Greene even knew the man that created Opposer's logo and has seen the use of its logo since that time. (*Id.*) Thus, first-hand testimony by Mr. Greene is strong evidence of record that establishes Opposer's use of its design mark since 1981.

Furthermore, Opposer presented testimony by Mr. Greene establishing the use of the G&W Mark and Design since at least 1970 for the remaining eight classes of this opposition via a plethora of evidence on the record. (Greene Dep. Exhs. 5-30.) Those exhibits detail the use of Opposer's marks on various products and catalogues up through at least 2007, when the last Notice of Reliance was filed in this case. Those exhibits show the use of G&W's marks on drug dispensing devices, and packaging of its pharmaceutical products, which pertain to items within International Classes 9, 10, 16, and 20. (*Id.*) Furthermore, Mr. Greene testified that Opposer provides educational and instructive services under the G&W marks which are also described in International Classes 16 and 41. (Greene Dep. 71-73.) Those services provide responses to requests for information from pharmacies, nursing associations, health club providers, and conferences on the advantages of various products offered by Opposer. (*Id.*) Moreover, Opposer has used its Marks in connection with educational materials found under Applicant's Classes 16 and 41 since at least 1998, well before Applicant's priority date. (*Id.* at 74.) Lastly, Mr. Greene testified that Opposer's marks have been used since 1946 in connection with research services, which fall under Applicant's International Class 42 and 44 claims. (*Id.* at 74-75.)

Accordingly, the evidence of record demonstrates Opposer's strong entitlement to priority of its marks.

Applicant has not shown use of its mark prior to, or even after, its filing date. In fact, Applicant has only identified one product that it intends to sell under its mark in its Application, which is Sativex. (Not. of Reliance Resp. to Suppl. Interrogs. 2, 7, 8, Sept. 11, 2007.) Applicant has not provided any indication of use or intended use of products covered under the remaining classes of goods in its Application. Accordingly, Opposer has priority in the marks subject to this proceeding.

D. Opposer Has Met Its Burden And Established Likelihood Of Confusion For All Classes Of Goods In The Application

Through the evidence of record, Opposer demonstrated that a likelihood of confusion exists relative to all Classes of goods and services in Application No. 78/354,188. Opposer's main brief concentrated on Class 5 goods, but all classes listed in the Application, which are subject to this opposition, are likely to cause confusion.

1. The Marks Are Similar In Their Entireties As To Appearance, Sound, Connotation, And Commercial Impression

Applicant primarily relies upon *In re Hearst Corp.*, 982 F.2d 493, 494, 25 U.S.P.Q.2d 1238, 1239 (Fed. Cir. 1992) for its argument that Applicant's mark is different from Opposer's registrations. However, *Hearst, et al.* stressed that "the weight given to the respective words is not entirely free of subjectivity" and that any determination based upon similarity, appearance, sound and commercial impression is fact-dependent. *Id.*

In this particular case, G&W is pronounced very similar to GW, especially if not specifically listening for or articulating the ampersand. Further, the addition of the word "pharmaceuticals" does not eliminate this similarity, as there is a strong chance that Applicant's Mark and goods and services will be referred to by the shorter GW name and without the named

pharmaceuticals. This is especially true given that both marks are to be primarily used in connection with pharmaceutical products. Thus, with the facts of this case and appropriate weight given to the various aspects of Applicant's mark, the marks are to be considered essentially identical and a likelihood of confusion will result.

**2. The Goods And Services Described In The Application Are
Similar To The Goods And Services Of Opposer's Registration And Use**

Contrary to Applicant's allegations, there is substantial evidence on the record that supports a finding of confusion with the goods in Classes 9, 10, 16, 20, 31, 41, 42, and 44 — all of the classes listed in Applicant's application. Opposer already presented a substantial amount of evidence in its main brief directed towards Class 5. Much of that evidence overlaps with the other classes of Applicant's application. Overall, the goods and services in the remaining classes of Applicant's application all involve pharmaceutical products or services in some manner, and are related to the goods and services sold under Opposer's registrations. As already discussed, Applicant only identified one pharmaceutical product that it intends to sell under its mark, which falls under the now cancelled Class 5. Applicant has not identified any services that it intends to sell under its mark.

Opposer, however, identified various products and services sold under its marks that pertain to the remaining classes of Applicant's application. For example, during Mr. Greene's deposition, the following goods and services were identified:

- Data management in the pharmaceutical and health care industry, including inventory and dealing with EDI (Electronic Data Interchange) (Greene Dep. 104-105.);
- Opposer's products are dispensed directly to patients from a tube or tablet, which display the G&W mark (Greene Dep. Exh. 21);
- Opposer's pharmaceutical products are packaged into containers, such as tubes and plastic medicine containers that display Opposer's G&W mark (*Id.* Exh. 16.);
- Opposer offers educational services;

- Opposer provides instructional publications and informational leaflets to its customers (Greene Dep. 71, 72, 107.);
- Research services are also provided by Opposer (*Id.* at 74.);
- Opposer's products contain or may contain horticultural products for medical services. (*Id.* at 94-95.)

Thus, the pharmaceutical goods and services in Applicant's Classes 9, 10, 16, 20, 31, 41, 42, and 44 will result in a likelihood of confusion with Opposer's marks.

3. The Trade Channels And Customers For Opposer's Goods and Services are Similar to Applicant's

For the goods and services in remaining Classes 9, 10, 16, 20, 31, 41, 42, and 44, distribution occurs through overlapping trade channels and to overlapping classes of customers, much in the same way as alleged in Opposer's main brief with respect to Class 5. Opposer established that its products are generally marketed to wholesalers, distributors, buyers at GPOs, and managed care organizations. (Greene Dep. 37.) Its products are marketed in trade magazines and to pharmacists and health care professionals. (*Id.* at 30, 50.)

The common denominator throughout the remaining classes of goods is that they all involve the pharmaceutical industry. For example, Class 9 involves computer programs for managing data in the pharmaceutical, health care, and medical fields, which is something Opposer currently does for its clients. (*Id.* at 104.) The drug dispensing devices in Class 10 would also likely be sold to pharmacists and pharmacies and then eventually to the general public as well as directly to doctors. It is undisputed by the evidence of record that Opposer distributes instructional pharmaceutical products and printed publications. (*Id.* at 71-73.) In addition, its pharmaceutical products are packaged in materials specific for pharmaceutical packaging and sold together with the packaging, which all fall under Class 16, 20, or 41. (Greene Dep. Exhs. 9-16.) Opposer's pharmaceuticals have horticultural and agricultural products within them and are distributed through the same channels as traditional

pharmaceuticals, such as pharmacies and doctors. (Greene Dep. 94-95.) Lastly, Opposer provides research and medical analysis services under Class 42 and 44 for formulation of medication and the manufacturing process and the validity of reproducibility of results. (*Id.* at 74.)

As demonstrated, all of Opposer's goods and services fall under the genre of pharmaceuticals, which are distributed through the same channels of trade as those of the goods and services of Classes 9, 10, 16, 20, 31, 41, and 42 in Applicant's application. Thus, a likelihood of confusion will result unless Applicant's mark is refused registration.

4. Both Careful And Impulse Purchases Will Result In A Likelihood Of Confusion

When it comes to purchasing pharmaceutical products, purchasers are typically not impulse buyers. However, in this particular case, when the marks are so close and are being used in the same market areas for similar goods and services, confusion can still result. Opposer's Notice of Reliance indicates that Applicant only has one product it intends to sell under its name, which is Sativex. (Not. of Reliance Resp. to Supp. Interrogs. 2, 5, 7, 8, Sept. 11, 2007.) So far Applicant has not shown any use. However, the product that Applicant is hoping to sell under its mark is made using marijuana, which has received a great deal of negative publicity and association from the public. Customers who typically purchase pharmaceuticals sparingly and not on a regular basis, may choose to stay away from Opposer's products in an effort to avoid any type of confusion and have any chance of using or supporting a marijuana-based product.

Furthermore, Opposer's research and educational services reputation might also be affected in a substantial way. If Applicant's mark is allowed, the public, pharmacists, and doctors might be confused between Opposer's mark and Applicant's mark and stop using Opposer's products or relying on Opposer's educational material because of the association with

a marijuana-based product. Customers may also cease to use Opposer's services for research formulation and analytic methods.

5. Opposer's Marks Are Well Known In The Industry

Opposer has presented uncontroverted facts that its marks are strong and well known in the pharmaceutical industry. Opposer's revenue has increased each year for 2005-2007, which indicates growth of its business. Because the goods and services in the remaining classes all relate to pharmaceuticals, and operate in the same marketplace, this Board should refuse registration of remaining Classes 9, 10, 16, 20, 31, 41, 42, and 44 of the application.

6. Opposer Has Shown Evidence Of Actual Confusion

Applicant alleges that with respect to Opposer showing actual confusion through a job seeker, there is no evidence to show whether the job seeker is a purchaser or potential purchaser of either party's goods. In presenting this argument, Applicant attempts to point out that the job seeker might have been confused, or merely inattentive or careless. However, Applicant fails to take into account that individuals applying for a job, especially those in the pharmaceutical industry, are anything but careless or inattentive. When applying for jobs, candidates are usually extra cautious, and have done research on the various companies from which they seek employment. Individuals rarely send résumés to companies they have not researched. After all, employment is the cornerstone of an individual's ability to provide for themselves and their family. Thus, if a job seeker was confused between the marks of Opposer and that of Applicant, a purchaser of Opposer's goods or services would also likely be easily confused and mistakenly associate the goods or services of Applicant with those of Opposer. Considering that Applicant intends to sell a single pharmaceutical product associated with marijuana, confusion should be found considering the potential profound impact on Opposer's goods and services and overall business.

7. Opposer Uses Its Mark On Pharmaceutical Goods And Services Similar To Applicant's Intention

Despite the allegations by Applicant that there is no evidence of record that demonstrates use of the mark on anything other than pharmaceuticals, it too has only demonstrated its intention to use its product and services in the pharmaceutical arena. For the last 90 years, Opposer has used its marks on pharmaceutical goods as well as other goods and services, some of which are identified in Classes 9, 10, 16, 20, 31, 41, 42, and 44 of Applicant's application. For instance, Mr. Greene testified that Opposer offers educational services, conducts conferences, publishes papers, and provides research services under its marks. (Greene Dep. 71-74.) These goods and services are in the context of the pharmaceutical industry, which is the same industry that Applicant intends to market its marijuana-based pharmaceuticals and services under Classes 9, 10, 16, 20, 31, 41, 42, and 44. Most of these classes of goods and services pertain to pharmaceutical products in some manner and will likely cause confusion. Accordingly, the record demonstrates strong evidence that Applicant's mark should be denied registration in the remaining eight classes based upon a likelihood of confusion.

8. Other Established Facts Probative Of The Effect Of Use Favor A Finding Of Likelihood Of Confusion

At the same time Applicant filed its main brief in opposition, it also abandoned Class 5 of Application No. 78/354,188. This amounts to an admission that a likelihood of confusion exists between Opposer's marks and Applicant's mark. Opposer demonstrated in its opening brief that a likelihood of confusion will certainly result between the marks. Despite this strong evidence of record, Applicant now attempts to address the remaining classes in great detail and give the appearance that Opposer never addressed them in the first instance. Accordingly, because Applicant admitted that a likelihood of confusion will result between its mark and Opposer's

marks by abandoning the main class in its registration, the Application for registration on the principal register should be refused.

III. CONCLUSION

For the foregoing reasons, Opposer respectfully submits that it has established priority to its G&W Mark and Design and that a likelihood of confusion will result if Application No. 78/354,188 is granted allowance. Opposer requests this Board to refuse the application in its entirety and sustain this Opposition.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the within OPPOSER'S REPLY BRIEF was served upon the following counsel of record this 24th day of August, 2009, as follows:

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G&W 10.20-027
Opposition No. 91169571