

ESTTA Tracking number: **ESTTA141736**

Filing date: **05/21/2007**

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

Proceeding	91172018
Party	Defendant ESTABLECIMIENTOS ANCALMO S.A. DE C.V. ESTABLECIMIENTOS ANCALMO S.A. DE C.V. Blvd. Walter Deininger SVX Antiguo Cuscatlan,
Correspondence Address	RICHARD J. WARD, JR. CHRISTIE, PARKER & HALE, LLP PO BOX 7068 PASADENA, CA 91109-7068 UNITED STATES pto@cph.com
Submission	Opposition/Response to Motion
Filer's Name	Gary J. Nelson
Filer's e-mail	pto@cph.com
Signature	/Gary J. Nelson/
Date	05/21/2007
Attachments	A825.pdf ( 8 pages )(291905 bytes )

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

MENPER DISTRIBUTORS, INC.

Opposer,

v.

ESTABLECIMIENTOS ANCALMO S.A. DE  
C.V.

Applicant.

ESTABLECIMIENTOS ANCALMO S.A. DE  
C.V.

Petitioner,

v.

MENPER DISTRIBUTORS, INC.,

Respondent

Opposition No. 91172018

**Mark:** SUERO ORAL ANCALMO  
**Serial No.:** 76/605,405  
**Filed:** August 2, 2004

Counterclaim for Cancellation

**PETITIONER'S OPPOSITION TO  
RESPONDENT'S COUNTER MOTION  
FOR SUMMARY JUDGMENT**

**Mark:** SUERO ORAL  
**Reg. No.:** 2,932,141  
**Filed:** November 25, 2003

**I. INTRODUCTION**

Menper's mark "SUERO ORAL" is a generic Spanish term for oral electrolytes, as Ancalmo has demonstrated with undisputed, voluminous evidence in its Motion for Summary Judgment and supporting Reply brief. As such, there is little left to say about Menper's Counter-Motion for Summary Judgment, which appears to be mostly an afterthought tacked on to the end of its Opposition brief. For the same reasons that the Board should grant Ancalmo's motion for summary judgment, the Board should also deny Menper's counter-motion.

**II. MENPER'S MARK IS INCAPABLE OF FUNCTIONING AS A TRADEMARK**

First of all, it is not entirely clear from Menper's motion on what issue Menper is moving for summary judgment. Menper's brief discusses Ancalmo's evidence of the genericness of "suero oral" (Opposer's Opposition and Counter-Motion ("Opp.") p. 5-19), acknowledges

evidence that "suero oral" is widely used as a generic term outside the U.S. (Opp. p. 1, 9-19), concedes that it is used this way inside the U.S. (Opp. p. 16), and admits that its mark may be considered merely descriptive (Opp. p. 22). Very little of Menper's brief actually concerns its counter-motion.

Despite conceding that its mark may be merely descriptive, Menper offers no evidence that "suero oral" is capable of functioning as a trademark, or that the public recognizes it as an indicator of source. Meanwhile, Ancalmo has submitted extensive evidence showing that suero oral is generic and therefore incapable of operating as a trademark. Thus, if Menper is moving for summary judgment that its mark is capable of functioning as a trademark, the facts clearly prevent such a motion from prevailing.

**III. MENPER CONCEDES THAT "SUERO ORAL" TRANSLATES AS "ORAL SERUM"**

Menper argues repeatedly in its motion that "suero oral" translates to "oral serum." Opp. p. 2, 4, 15, 16, 17, 19, 25. In fact, the parties agree that this is the literal translation. However, if Menper is moving for summary judgment that "oral serum" can function as a trademark, the parties disagree.

Ancalmo has submitted evidence that "oral serum" is widely used as a generic term for oral electrolyte solutions. Declaration of Oscar Ancalmo ("Ancalmo Decl.") Att. 8A (an article describing the use of oral serum for oral rehydration in children with diarrhea); Att. 8C (describing a clinic where a woman was taught to prepare oral serum for her children with diarrhea); Att. 8D (another article describing the use of oral serum for diarrhea); Att. 8E (an article posted on the website of the Wisconsin/Nicaragua Partners of the Americas describing volunteer efforts to supply oral serum for rehydration); Att. 8F (another article describing the use of suero oral, or oral serum); Att. 8G (yet another article discussing suero oral and oral serum for rehydration); Att. 8H (an article from Brownsville, Texas advocating that "in case there is

dehydration, they should administer (serums) or Pedialite"); Att. 8I (a webpage referring to oral serum for treating diarrhea).

The USPTO agrees. The USPTO refused to register Menper's recent application for "SUERO ORAL" because "the proposed mark appears to be generic as applied to the goods and, therefore, incapable of identifying the applicant's goods and distinguishing them from those of others." Declaration of Tiffany Parcher ("Parcher Decl.") Att. 3. Menper argues that in fact the USPTO refused registration because the mark was merely descriptive, not generic. Opp. p. 24. But whenever a mark is generic, the USPTO refuses it for being merely descriptive. TMEP § 1209.02 ("if the designation appears to be a generic name for the goods or services, the examining attorney should provide an advisory statement that the subject matter appears to be a generic name for the goods or services, in conjunction with the refusal on the ground that the matter is merely descriptive.").

The USPTO also found Menper's current registration to be generic when it allowed Ancalmo's application to publish. Parcher Decl. Att. 5.

Thus, if Menper is moving for summary judgment that "oral serum" is capable of functioning as a trademark, Ancalmo respectfully requests that the Board deny Menper's motion and affirm the USPTO's position on this issue for the third time.

#### **IV. MENPER IMPROPERLY FOCUSES ON THE MEANING OF "SUERO" ALONE**

Much of Menper's expert testimony focuses on the meaning of "suero" alone. Declaration of Antonio Palomo ("Palomo Decl.") ¶¶ 10, 15, 19; Declaration of Dolores Prida ("Prida Decl.") ¶ 11; Declaration of Benidecto Fernandez ("Fernandez Decl.") ¶ 9. Menper argues that "suero" means a serum injected through an IV, and that Spanish-speakers in the United States use "suero" alone to refer to an IV injection. Palomo Decl. ¶ 10; Fernandez Decl. ¶ 9. Menper also argues that "suero" has many different meanings in different contexts. Prida

Decl. ¶ 11.

Yet Menper acknowledges that "where the mark is a phrase, it is not sufficient to cite definitions and generic uses of the individual components of the mark; evidence must be provided of the meaning of the composite mark as a whole." Opp. p. 21. And Menper's own expert explains that the meaning of "suero" changes depending on the modifier used with it. Prida Decl. ¶ 11.

Accordingly, Menper's evidence about the many meanings of "suero" alone are not helpful. "Suero" may have many meanings, but "suero oral" has just one. While Menper's experts and opposition brief focus on the meaning of "suero," Ancalmo's evidence shows the meaning of "suero oral" and shows its widespread generic usage. See Applicant's Motion for Summary Judgment and Reply Brief.

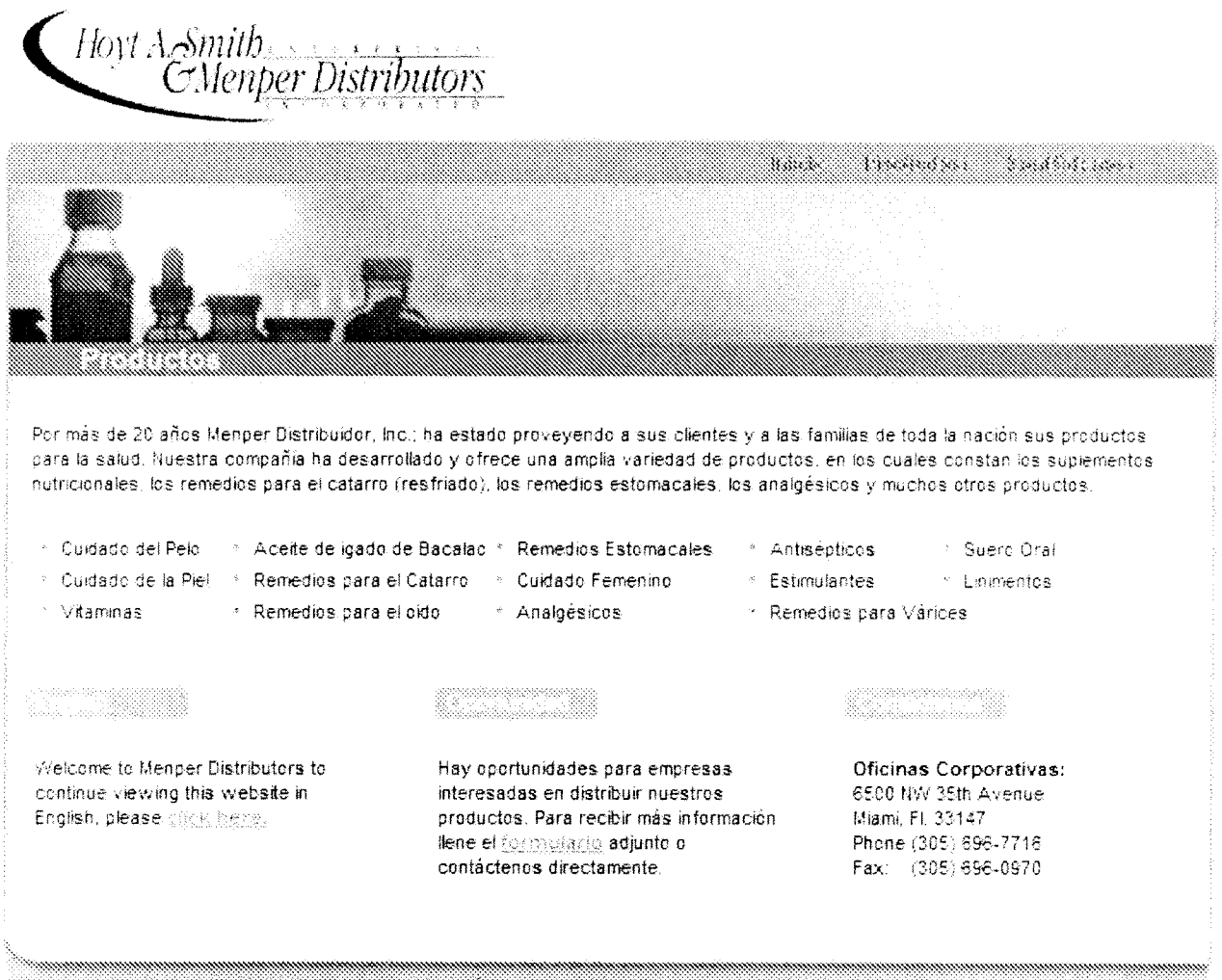
Essentially, Menper has argued that "suero" means many things, including an IV solution, and therefore "suero oral" cannot be generic. This is like arguing that "spring" has many meanings, so "spring water" cannot be generic. If Menper is moving for summary judgment that "suero oral" is not generic, Ancalmo submits that the undisputed evidence of genericness presented in Ancalmo's motion and reply brief preclude Menper's motion.

**V. CONSUMERS ARE LIKELY TO TRANSLATE SUERO ORAL AND UNDERSTAND ITS MEANING**

Perhaps knowing that translation of "suero oral" into either "oral serum" or "oral electrolyte solution" would dampen its chances of success on the genericness issue, Menper argues that consumers are unlikely to translate the term, and that the term should therefore be considered in its Spanish form. Menper then makes the strained argument that "suero oral" is imaginative and incongruous.

The cases Menper cites for this argument are easily distinguished. In the "LA POSADA" case, the Board relied heavily on the fact that the applicant used its mark, "LA POSADA" in a

trademark manner on its front sign and in its brochures, with the generic term "motor hotel" appearing below the mark. *In re Pan Tex Hotel Corp.*, 190 U.S.P.Q. 109, 110 (TTAB 1976). The Board concluded that "because of the setting in which applicant uses 'LA POSADA,' it is not likely that purchasers would stop and translate said notation into its English equivalent." *Id.* Compare that to Menper's use of its mark on its website:



Accordingly, the "La Posada" case actually supports translation of Menper's mark into English, because Menper does not specifically use its mark in a trademark sense. Consumers will clearly translate "suero oral" on Menper's website, as Menper itself does.

Menper also cites another case where a Spanish mark was not translated into English. *In re Tia Maria, Inc.*, 188 U.S.P.Q. 524 (TTAB 1975). However, in that case, the Spanish mark included a woman's name, "TIA MARIA." Consumers recognize "Maria" as a name and do not have to translate it into the English name "Mary" to understand it. Menper's mark is not a person's name. Thus, this case offers Menper no support.

These cases are also more than 30 years old, and do not acknowledge the increasing prevalence of Spanish in the United States. More recent cases apply the doctrine of foreign equivalents to Spanish terms, and translate them into English to consider genericness. *E.g., Enrique Bernat F., S.A. v. Guadalajara, Inc.*, 210 F.3d 439, 445 (5th Cir. 2000).

Moreover, a foreign generic word is simply unregistrable, regardless of whether a Spanish consumer in the U.S. would stop and actively translate the term, word by word, into English. *In re Optica Int'l*, 196 USPQ 775, 777 (TTAB 1977); *Weiss Noodle Co. v. Golden Cracknel & Specialty Co.*, 48 CCPA 1004, 1008 (C.C.P.A. 1961).

## **VI. CONCLUSION**

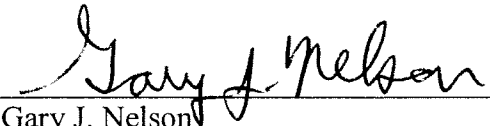
Menper uses "suero oral" in a generic sense on its website. Menper listed "suero oral" in the goods description of its trademark application, and attempted to disclaim the entire term. The USPTO has twice found the mark to be generic and undeserving of protection. Menper concedes that the mark translates to "oral serum" and that it is used in a generic sense in some areas inside and outside of the United States. After all of this evidence, Menper moves for summary judgment in its favor, although on what issue Ancalmo cannot discern.

The evidence submitted by Ancalmo shows no dispute that "suero oral" is generic.

Accordingly, Ancalmo's motion for summary judgment should be granted, and Menper's counter-motion for summary judgment should be denied.

Respectfully submitted,

DATED: May 21, 2007

By   
\_\_\_\_\_  
Gary J. Nelson  
Tiffany Parcher

CHRISTIE, PARKER & HALE, LLP  
350 West Colorado Blvd., Suite 500  
Post Office Box 7068  
Pasadena, California 91109-7068  
Phn: (626) 795-9900

Attorneys for Applicant and Petitioner,  
Establacimientos Ancalmo S.A.

TLL PAS738276.1-\*-05/21/07 11:22 AM



**CERTIFICATE OF TRANSMISSION AND SERVICE**

I certify that on May 21, 2007, the foregoing **PETITIONER'S OPPOSITION TO RESPONDENT'S COUNTER MOTION FOR SUMMARY JUDGMENT** is being electronically filed with:

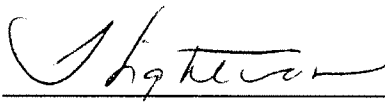
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

It is further certified that on May 21, 2007, the foregoing **PETITIONER'S OPPOSITION TO RESPONDENT'S COUNTER MOTION FOR SUMMARY JUDGMENT** is being served by facsimile and by mailing a copy thereof by first-class mail addressed to:

amaurycruz@yahoo.com

Amaury Cruz, Esq.  
AMAURY CRUZ, P.A.  
1111 Lincoln Road, Suite 400  
Miami Beach, FL 33139

Attorneys for Opposer

By:   
\_\_\_\_\_  
Tammy Lightman  
CHRISTIE, PARKER & HALE, LLP  
PO Box 7068  
Pasadena, CA 91109-7068