

**This decision is not a
precedent of the Trademark
Trial and Appeal Board.**

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451**

Baxley

Mailed: November 16, 2007

Opposition No. **91172018**

Menper Distributors Inc.

v.

Establecimientos Ancalmo S.A.
de C.V.

Before Hairston, Drost, and Wellington,
Administrative Trademark Judges

By the Board:

Establecimientos Ancalmo S.A. de C.V. ("Ancalmo"), an El Salvador corporation, seeks to register the mark SUERO ORAL ANCALMO for "pharmaceutical preparations, namely oral serums in powder form for gelatins, in liquid form, and in granular form for the treatment of symptoms due to diarrhea, and/or vomiting" in International Class 5.¹

Menper Distributors Inc. ("Menper") opposes registration of Ancalmo's mark on the ground of likelihood of confusion with its previously used mark SUERO ORAL for

¹ Application Serial No. 76605405, filed August 2, 2004, based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. Section 1051(b), and under Trademark Act Section 44(e), 15 U.S.C. Section 1126(e), based on El Salvador Registration No. 00012, Book 00013, Folios 025-026, which was issued on May 7, 2004. The application includes a statement that "[t]he English translation of the words SUERO ORAL in the mark is ORAL SERUM" and a disclaimer of SUERO ORAL.

"oral electrolytes [in] liquid and concentrated powder [form]" in International Class 5, which is registered on the Supplemental Register.² Ancalmo, in its answer, denied the salient allegations of the notice of opposition and included a counterclaim to cancel Menper's pleaded registration on the ground of genericness. Menper, in its answer, denied the salient allegations of the counterclaim.

This case now comes up for consideration of: 1) Ancalmo's motion (filed February 9, 2007) for summary judgment in its favor on the counterclaim on its pleaded claim of genericness; and 2) Menper's cross-motion (filed for summary judgment in its favor on the counterclaim. The motions have been fully briefed.

A determination of whether a term is generic "involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term ... understood by the relevant public primarily to refer to that genus of goods or services?" See *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). The genus of goods at issue in the counterclaim is defined by the identification of goods in Menper's pleaded registration, namely, "oral electrolytes [in] liquid

² Registration No. 2932141, issued March 8, 2005 and alleging November 1, 1999 as the date of first use anywhere and the date of first use in commerce. The registration includes a statement that "[t]he foreign wording in the mark translates into English as ORAL SERUM" and a disclaimer of SUERO.

and concentrated powder [form]." *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) ("[A] proper genericness inquiry focuses on the description of [goods] set forth in the [application or] certificate of registration.").

Under the doctrine of foreign equivalents, foreign words may be translated into English to determine genericness. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1377, 73 USPQ2d 1689 (Fed. Cir. 2005). However, this doctrine is not absolute and is applied only when it is likely that the ordinary American consumer would "stop and translate" the foreign term into its English equivalent. See *id.*

After reviewing the parties' arguments and evidence, we find that disposition of the counterclaim by summary judgment is inappropriate. We find that there are, at minimum, genuine issues of material fact as to whether the term SUERO ORAL is perceived by the relevant public in the United States as the foreign equivalent of "oral electrolyte solution" or "oral electrolytes," and as to whether the term SUERO ORAL is understood by the relevant public in the United States primarily to refer to oral electrolytes.³

³ The fact that we have identified only two genuine issues of material fact as sufficient bases for denying the motions for summary judgment should not be construed as a finding that these are necessarily the only issues which remain for trial.

In view thereof, Ancalmo's motion for summary judgment and Menpar's cross-motion for summary judgment are both denied.⁴ Fed. R. Civ. P. 56. Proceedings herein are resumed.⁵ Discovery and testimony periods are reset as follows:

DISCOVERY PERIOD TO CLOSE: **February 15, 2008**

Plaintiff's 30-day testimony period to close: **May 15, 2008**

Defendant's 30-day testimony period to close: **July 14, 2008**

Plaintiff's 15-day rebuttal testimony period to close: **August 28, 2008**

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served

⁴ The parties should note that the evidence submitted in connection with the motion for summary judgment is of record only for consideration of that motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. See *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).

⁵ Menpar's contention in its briefs that its pleaded SUERO ORAL mark is somehow suggestive is incorrect. When Menpar amended the underlying application for the pleaded registration for that mark to the Supplemental Register, Menpar conceded that such mark is not inherently distinctive. *In re Consolidated Foods Corp.*, 200 USPQ 477, 478 n.2 (TTAB 1978) ("Registration of the same mark on the Supplemental register is not prima facie evidence of distinctiveness; in fact, such a registration is an admission of descriptiveness"). See also *Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972) ("We also agree with the observation of the board that, when appellant sought registration of SUPER BLEND on the Supplemental Register, it admitted that the term was merely descriptive of its goods...").

Opposition No. **91172018**

on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.