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

Proceeding	91205081
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD**

Application Serial No. 85340058

Mark: DECA-DURABOLIN

Published in Official Gazette on January 10, 2012

Merck Sharp & Dohme B.V. (as successor in interest to MSD OSS B.V.))
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Opposer,)
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v.)
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DYNAMIC SPORTS NUTRITION, LLC,)
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Applicant.)
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AMENDED NOTICE OF OPPOSITION

Opposer Merck Sharp & Dohme B.V. (as successor in interest to MSD Oss B.V., the original party that filed the Notice of Opposition)¹ ("Opposer") believes that it will be damaged by the registration of the mark DECA-DURABOLIN, which is the subject of the above-referenced trademark application, and hereby opposes the same. As grounds for its opposition, Opposer alleges that:

1. Opposer is a private limited liability company formed under the laws of the Netherlands, is located and doing business at Waarderweg 39, 2031 BN Haarlem, the Netherlands, and is engaged in developing and marketing pharmaceutical and consumer products worldwide.

¹ On January 1, 2013, MSD Oss B.V. merged with and into Organon BioSciences Nederland B.V., a private limited liability company formed under the laws of the Netherlands, with Organon BioSciences Nederland B.V. as the surviving company. Shortly thereafter, on January 2, 2013, Organon BioSciences Nederland B.V. merged with and into Merck Sharp & Dohme B.V., a private limited liability company formed under the laws of the Netherlands, with Merck Sharp & Dohme B.V. as the surviving company.

2. Opposer is the successor in interest to MSD Oss B.V., the original opposer, which is the successor in interest to N.V. Organon, a Netherlands company.

3. One of Opposer's related companies, Organon USA, Inc., holds the rights in the New Drug Application (NDA) 011891, which was approved by the Food and Drug Administration (FDA) on October 30, 1959, and which granted Organon USA, Inc. the right to sell an injectable anabolic steroid in the United States with the active ingredient of Nandrolone Phenpropionate, in 25MG/ML or 50 MG/ML strengths, under the brand name DURABOLIN. Opposer's related company, Organon USA, Inc., also holds the rights in NDA 013132, which was approved by the FDA on October 5, 1962, and which granted Organon USA, Inc. the right to sell an injectable anabolic steroid in the United States with the active ingredient of Nandrolone Decanoate, in 50MG/ML, 1000MG/ML and 200MG/ML strengths, under the brand name DECA-DURABOLIN.

4. Upon information and belief, Opposer's predecessor company, N.V. Organon, first adopted and used the marks DURABOLIN and DECA-DURABOLIN in connection with prescription injectable anabolic steroid products approved by the FDA and sold in the United States beginning in the late 1950s / early 1960s.

5. Since such time, Opposer and/or its predecessor companies, including N.V. Organon and MSD Oss, B.V., and/or its related company, Organon USA, Inc., have used, directly or through affiliated companies, and continue to use, the marks DURABOLIN and DECA-DURABOLIN as brand names for two prescription injectable anabolic steroid products sold in numerous countries throughout the world.

6. Although Opposer and its affiliated companies do not currently sell prescription injectable anabolic steroid products under the DURABOLIN and DECA-DURABOLIN marks in the United States, Opposer, either directly or through affiliated companies, has sold for many years, and continues to sell, prescription injectable anabolic steroid products under the DURABOLIN and DECA-DURABOLIN marks in more than 50 countries worldwide.

7. Moreover, Opposer owns over 100 trademark registrations in International Class 5 for its DURABOLIN and DECA-DURABOLIN marks in many countries throughout the world, including Albania, Algeria, Argentina, Aruba, Australia, Austria, Bangladesh, Barbados, Benelux, Brazil, Bulgaria, Cambodia, Canada, Caribbean Netherlands, Chile, Colombia, Costa Rica, Cuba, Curacao, Cyprus, Czech Republic, Dominican Republic, Ecuador, Egypt, El Salvador, Finland, Germany, Great Britain, Greece, Guatemala, Hong Kong, India, Indonesia, Iraq, Ireland, Israel, Italy, Jamaica, Japan, Jordan, Kenya, Korea (South), Kuwait, Lebanon, Macedonia, Malaya, Malaysia, Mexico, Montenegro, Morocco, Myanmar, New Zealand, Nicaragua, Norway, Oman, Pakistan, Panama, Peru, Poland, Portugal, Qatar, Romania, Russian Federation, Saudi Arabia, Serbia, Singapore, Sint Maarten, Slovak Republic, South Africa, Spain, Sri Lanka, Sudan, Suriname, Sweden, Switzerland, Syria, Taiwan, Thailand, Trinidad, United Arab Emirates, Uruguay, Venezuela, and Vietnam. These registrations are valid and subsisting and Opposer will rely upon them as evidence in this proceeding.

8. As a result of Opposer's long and continuous use of the DURABOLIN and DECA-DURABOLIN marks in numerous countries worldwide, including extensive use of these marks in the United States for nearly 50 years, the

DURABOLIN and DECA-DURABOLIN marks are closely identified with, and, upon information and belief, are known in the United States among body builders, athletes and other relevant purchasers as marks associated with, Opposer and its prescription anabolic steroid products.

9. On June 7, 2011, Dynamic Sports Nutrition, LLC (“Applicant”) filed an intent-to-use application seeking to register the mark DECA-DURABOLIN in International Class 5 for goods described as “dietary and nutritional supplements.”

10. Applicant’s application was published for opposition purposes on January 10, 2012. Opposer filed a request for a 90-day extension of time to oppose Applicant’s application, which the Trademark Trial and Appeal Board granted, extending the deadline for Opposer to file its Notice of Opposition until May 9, 2012. Accordingly, this Notice of Opposition is timely filed.

11. According to its website at www.dynamicsportsnutrition.com, Applicant sells “muscle building compounds” and other “anabolic products” and has “over 14 years of dealing with anabolic products.”

12. Applicant also claims on its www.dynamicsportsnutrition.com website that “All [of its products] are powerful alternatives to Anabolic Steroids that are designed to produce similar results in an altered time frame.”²

13. In describing its “Growth Hormone Stack” products, Applicant’s www.dynamicsportsnutrition.com website states:

Growth Hormone Stack

The incredible Pituitary Growth Hormone formula provides all the fantastic benefits of the Human Growth Hormone without the inconvenient, expensive and painful injections!

² http://www.dynamicsportsnutrition.com/help_answer.asp?ID=9#32

Oral PGH possesses the two-pronged effect of greatly improving overall body development and functioning for athletes, and helping to stave off the realities of aging for those experiencing reduced growth hormone production. It's also the cornerstone to the Growth Hormone Stack which boasts a host of other fast-acting anabolic compounds including D-anabol 25's superior mass building, Deca 200's extreme strength development, and Clen's maximum fat-burning properties. This uniquely comprehensive blend is everything you need for complete overall muscular development and well-being! Guys searching for these compounds individually often look for Human Growth Hormone, Growth Hormone, HGH, GH, T3, Thyroid Hormone, Cynomel, Cytomel, or Pituitary Hormone; Dianabol, D-bol, DeBol, or Dbol; Deca-Durabolin, Deca, or Deca-Dura and; Clenbuterol, Clenbuteral, Clenbutorol, T3, Cynomel, or Cytomel.

(emphasis added)³

14. Anabolic steroid products are regulated products that require FDA approval before they can be marketed or sold in commerce in the United States.

15. Upon information and belief, Applicant is not the owner of, nor does it hold any rights in, any FDA-approved NDA or Abbreviated New Drug Application (ANDA) for an anabolic steroid and therefore has no legal right under applicable FDA law to market and/or sell any anabolic steroid under the mark DECA-DURABOLIN and/or DURABOLIN or under any other mark.

COUNT I
False Suggestion of a Connection Under Section 2(a)

16. Opposer repeats and incorporates by reference the allegations set forth in paragraphs 1 through 15.

17. Opposer adopted and used its DURABOLIN and DECA-DURABOLIN marks long before Applicant filed its application for the mark DECA-DURABOLIN, and therefore has priority over Applicant with respect to a DURABOLIN and DECA-DURABOLIN mark.

³ http://www.dynamicsportsnutrition.com/Growth_Hormone_Stack_s/31.htm

18. The DURABOLIN and DECA-DURABOLIN marks are closely identified with Opposer and its prescription injectable anabolic steroid products.

19. Applicant's applied-for DECA-DURABOLIN mark is identical to Opposer's FDA-approved DECA-DURABOLIN anabolic steroid mark and contains the whole of Opposer's FDA-approved DURABOLIN anabolic steroid mark.

20. Upon information and belief, Applicant was aware of Opposer's prior use of, and rights in, the marks DURABOLIN and DECA-DURABOLIN when it applied for registration of the mark DECA-DURABOLIN.

21. Applicant's website at www.dynamicsportsnutrition.com also includes the following warning, which makes clear that Applicant is familiar with Opposer and its DECA-DURABOLIN prescription anabolic steroid product: "***Warning: Deca-Durabolan[sic], Dianabol, Winstrol, Clenbuteral, Anavar, and Trenbolone are toxic Anabolic Steroids."

22. Also, a second website, www.oralsteroids.com, which states that it is owned and operated by Dynamic Sports and which offers an array of oral steroid products, includes the following description of Opposer's DECA-DURABOLIN steroid product: "It is known in steroid circles and medical circles as 'deca' and has been used for the treatment of people suffering from the wasting caused by HIV and AIDS among other diseases. It has been used in medical circles to increase good weight among people suffering from such diseases. This means that it is best for building muscle mass, just like all other steroids. This is an anabolic

steroid that has been in the market for close to 30 years now and has been very popular.⁴ (emphasis added)

23. Upon information and belief, Applicant intends to use its applied-for DECA-DURABOLIN mark in connection with a product that will be targeted to body builders and athletes, among other relevant purchasers, and that will be promoted as a “powerful alternative” and a less painful option to injectable anabolic steroids and that will produce “similar results in an altered time frame” to injectable anabolic steroids such as Opposer’s DURABOLIN and DECA-DURABOLIN prescription injectable anabolic steroid products.

24. Upon information and belief, Applicant selected the DECA-DURABOLIN mark in order to benefit from the goodwill associated with Opposer’s marks and with the intent to deceive, mislead and confuse consumers by causing them to believe, erroneously, that (i) a connection exists between its DECA-DURABOLIN products and Opposer and/or Opposer’s DURABOLIN and DECA-DURABOLIN prescription injectable anabolic steroid products, and/or (ii) the character, quality, function, composition and/or use of its DECA-DURABOLIN products is the same as, or comparable to, that of Opposer’s DURABOLIN and/or DECA-DURABOLIN prescription anabolic steroid products.

25. Applicant’s DECA-DURABOLIN trademark, if registered and used in conjunction with “dietary and nutritional supplements,” is likely to deceive consumers regarding the character, quality, function, composition and/or use of Applicant’s goods and/or into believing, erroneously, that a connection exists

⁴ http://www.oralsteroids.com/Deca_Durabolin_a/263.htm

between Applicant's goods and Opposer and/or Opposer's prescription anabolic steroid products.

26. Applicant's use and registration of the mark DECA-DURABOLIN -- a mark that is identical to Opposer's DECA-DURABOLIN mark and that incorporates the entirety of Opposer's DURABOLIN mark --- for "dietary and nutritional supplements" likely will lead consumers to purchase Applicant's product in the mistaken belief that Applicant's product is somehow connected to Opposer and its DURABOLIN and DECA-DURABOLIN prescription anabolic steroid products.

27. Purchasers are likely to purchase Applicant's product in the mistaken belief that Applicant's DECA-DURABOLIN product (i) is an over-the-counter form of Opposer's DURABOLIN and DECA-DURABOLIN prescription anabolic steroid products, (ii) is a non-injectable form of Opposer's DURABOLIN and DECA-DURABOLIN injectable anabolic steroid products, (iii) contains the same or substantially the same active ingredients contained in Opposer's DURABOLIN and DECA-DURABOLIN prescription anabolic steroid products, (iv) will act in the same manner as Opposer's DURABOLIN and DECA-DURABOLIN prescription anabolic steroid products, (v) will offer the same or comparable benefits as Opposer's DURABOLIN and DECA-DURABOLIN prescription anabolic steroid products, and/or (vi) has been approved by the FDA.

28. Because the DURABOLIN and DECA-DURABOLIN marks are closely identified with Opposer and its prescription anabolic steroid product, Applicant's use and registration of the mark DECA-DURABOLIN -- a mark that is identical to Opposer's DECA-DURABOLIN mark and that incorporates the entirety of Opposer's DURABOLIN mark -- for dietary and nutritional supplements likely will

lead consumers to purchase Applicant's DECA-DURABOLIN product in the mistaken belief that Applicant's DECA-DURABOLIN product originates with, is affiliated with, is sponsored or approved by, or is somehow connected to Opposer.

29. Opposer will be damaged by the registration sought by Applicant because such registration will support the deceptive, confusing and misleading use of the DECA-DURABOLIN mark and will give color of exclusive statutory rights to Applicant in violation and derogation of the prior and superior rights of Opposer.

30. Registration therefore should be refused pursuant to Section 2(a) of the Trademark Act of 1946, as amended, 15 U.S.C. § 1052(a), on the ground that Applicant's DECA-DURABOLIN mark consists of or comprises matter that falsely suggests a connection with Opposer and its DECA-DURABOLIN and DURABOLIN prescription anabolic steroid products, all to the damage of Opposer and the public.

COUNT II
Deceptively Misdescriptive Mark Under Section 2(e)(1)

31. Opposer repeats and incorporates by reference the allegations set forth in paragraphs 1 through 30.

32. The mark DECA-DURABOLIN consists of the combination of two terms -- DECA and DURABOLIN.

33. DECA is a term that is derived from the Greek word for the number 10 and is commonly used in the pharmaceutical industry to indicate that a product will act in a tenfold manner or is the higher dose or more concentrated strength of another similar product.

34. DURABOLIN consists of two components: (i) the prefix DUR or DURA and (ii) the suffix ABOLIN or BOLIN.

35. DUR or DURA is a prefix commonly used in the pharmaceutical industry to mean “long lasting.”

36. ABOLIN or BOLIN is an infix that is derivative of the word <anABOLic>, and “anabolic” is a word frequently used to describe a steroid product.

37. The mark DECA-DURABOLIN therefore is descriptive of a strong and long lasting anabolic steroid product.

38. Upon information and belief, the “dietary and nutritional supplements” Applicant intends to market and sell under its DECA-DURABOLIN mark are not anabolic steroid products, much less strong and long lasting anabolic steroid products.

39. Applicant’s DECA-DURABOLIN mark is thus a descriptive mark whose use in connection with Applicant’s “dietary and nutritional supplements” is misdescriptive of the character, quality, function, composition and/or use of such goods, and prospective purchasers are likely to believe that the misdescription actually describes the goods.

40. Prospective consumers of Applicant’s DECA-DURABOLIN “dietary and nutritional supplements” are likely to believe, mistakenly, that Applicant’s products (i) contain anabolic steroids, (ii) contain the same active ingredients contained in anabolic steroids, (iii) will function or act in the same manner as anabolic steroids, (iv) will offer the same or comparable benefits as anabolic steroids, and/or (v) have been approved by the FDA.

41. Opposer will be damaged by the registration sought by Applicant because such registration will support the deceptive, confusing and misleading use

by Applicant of the DECA-DURABOLIN mark and will give color of exclusive statutory rights to Applicant in violation and derogation of the prior and superior rights of Opposer.

42. Registration should be refused pursuant to Section 2(e)(1) of the Trademark Act of 1946, as amended, 15 U.S.C. § 1052(e)(1), on the ground that Applicant's DECA-DURABOLIN mark is deceptively misdescriptive of the character, quality, function, composition and/or use of the goods that Applicant intends to offer under the mark, all to the damage of Opposer and the public.

COUNT III
Deceptive Mark Under Section 2(a)

43. Opposer repeats and incorporates by reference the allegations set forth in paragraphs 1 through 42.

44. The misdescriptive nature of Applicant's DECA-DURABOLIN mark would materially affect consumers' decision to purchase the products sold under said mark.

45. Prospective consumers of Applicant's DECA-DURABOLIN "dietary and nutritional supplements" are likely to believe, and to purchase Applicant's products in the mistaken belief, that Applicant's products (i) contain anabolic steroids, (ii) contain the same active ingredients contained in anabolic steroids, (iii) will function or act in the same manner as anabolic steroids, (iv) will offer the same or comparable benefits as anabolic steroids, and/or (v) have been approved by the FDA.

46. Opposer will be damaged by the registration sought by Applicant because such registration will support the deceptive, confusing and misleading use

by Applicant of the DECA-DURABOLIN mark and will give color of exclusive statutory rights to Applicant in violation and derogation of the prior and superior rights of Opposer.

47. Registration should be refused pursuant to Section 2(a) of the Trademark Act of 1946, as amended, 15 U.S.C. § 1052(a), on the ground that Applicant's DECA-DURABOLIN mark consists of or comprises deceptive matter, will likely cause consumers to be deceived as to the character, quality, function, composition and/or use of Applicant's intended goods, and will materially affect their decision to purchase such goods, all to the damage of Opposer and the public.

WHEREFORE, Opposer, by its undersigned attorneys, requests that its opposition to Application Serial No. 85340058 be sustained and that the Trademark Trial and Appeal Board grant any and all further relief to Opposer that the Board finds to be necessary and just in the circumstances.

Respectfully submitted,

Dated: January 25, 2013

By: 

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CERTIFICATE OF SERVICE

I hereby certify that the attached Amended Notice of Opposition was served by first
class mail, postage prepaid, this 25th day of January, 2013 on the following:

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