

ESTTA Tracking number: **ESTTA551815**

Filing date: **08/01/2013**

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

Proceeding	91205081
Party	Defendant Dynamic Sports Nutrition, LLC
Correspondence Address	JOHN S EGBERT EGBERT LAW OFFICES PLLC 1314 TEXAS AVENUE, 21ST FLOOR HOUSTON, TX 77002-1897 UNITED STATES mail@egbertlawoffices.com
Submission	Opposition/Response to Motion
Filer's Name	John S. Egbert
Filer's e-mail	mail@egbertlawoffices.com
Signature	/2259-36/
Date	08/01/2013
Attachments	2259-36 Applicant's Response to Opposers MSJ.pdf(54085 bytes)

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

In the Matter of Trademark Application No. 85/340,058
Published in the Official Gazette on January 10, 2012

Merck Sharp & Dohme B.V. (as successor	§	
in interest to MSD OSS B.V.),	§	
	§	
Opposer,	§	
	§	
v.	§	Opposition No. 91205081
	§	
Dynamic Sports Nutrition, LLC,	§	
	§	
Applicant.	§	

**APPLICANT'S RESPONSE TO OPPOSER'S MOTION FOR SUMMARY JUDGMENT
AND MEMORANDUM OF LAW IN SUPPORT THEREOF**

Pursuant to Trademark Rule 2.127 and Rule 56 of the Federal Rules of Civil Procedure, Dynamic Sports Nutrition, LLC ("Applicant") by its attorneys, hereby submits the following Response to Merck Sharp & Dohme B.V.'s (as successor-in-interest to MSD OSS B.V.) ("Opposer") Motion for Summary Judgment. As demonstrated below, Applicant's Motion for Summary Judgment should be granted, Opposer's Motion for Summary Judgment should be denied, and U.S. Trademark Application No. 85/340,058 should proceed to registration.

I. **FACTS**

1. On April 17, 2013 Applicant filed its Motion for Summary Judgment. On June 13, 2013, Opposer filed its Brief in Opposition to Applicant's Motion for Summary Judgment and Cross-Motion for Summary Judgment.

2. On July 3, 2013 Applicant filed its Reply in Support of its Motion for Summary Judgment. Applicant is now filing the present Response to Opposer's Cross-Motion for Summary Judgment. Applicant respectfully requests that the Board grant Applicant's Motion for Summary

Judgment and deny Opposer's Motion for Summary Judgment with respect to the issues of deceptiveness, deceptive misdescriptiveness, and false suggestion of a connection that were alleged in the Opposer's May 9, 2012 Notice of Opposition.

II. ARGUMENT

3. Fundamentally, this is a case in which the Opposer abandoned its use of the "DECA-DURABOLIN" trademark, allowed its "DECA-DURABOLIN" trademarks to lapse, and now improperly seeks to shoehorn the facts of this case within the legal framework of the following three causes of action: deceptiveness, deceptive misdescriptiveness, and false suggestion of a connection. However, the proper course of action by which Opposer should protect its trademarks is to simply not abandon use of those marks. *See* [Applicant's Motion for Summary Judgment, Wilson Decl. Ex. E] (standing for the proposition that Organon notified the FDA in a letter dated May 21, 2002 that it was discontinuing use of its product sold under the mark "DECA-DURABOLIN" in the U.S.); *see also* Opposer's Cross Motion for Summary Judgment, pg. 6 ((stating that "Opposer and its affiliated companies do not currently use the DURABOLIN or DECA-DURABOLIN marks Whether Opposer, or an affiliated company, or a successor to the business, [sic] will resume use in the United States in the future is unknown at this time) (citing Knox Dec. ¶ 9)). If Opposer was truly using the mark, Opposer should have and likely would have simply renewed its trademark registrations. In the event that Opposer desired to retain its trademark registration without using its mark, Opposer may have simply filed a §8 Declaration of Excusable Nonuse, if Opposer met the requirements for such a Declaration.

4. Public policy dictates that the trademark register exists to protect marks and provide notice of the marks on the register. Since the "DECA-DURABOLIN" trademark was abandoned

over a decade ago, and the trademark registrations for the mark were allowed to lapse, the mark should now be available for use by other entities.

5. Opposer seeks to obfuscate issues germane to this proceeding by introducing extrinsic evidence regarding the use of Applicant's Mark. *See, e.g.*, Opposer's Cross-Motion for Summary Judgment at pg. 2-3 and Exhibits 2-4 (introducing extrinsic evidence related to Applicant's use of its "DECA-DURABOLIN" mark). However, it is well-settled, hornbook law that "the scope of the registration applicant seeks is defined by the identification of services in its application and not by its actual use." *In re Tropicana Las Vegas, Inc.*, Serial No. 85450247 (TTAB 2013) (quoting *Octocom Syst. Inc. v. Houston Computers Svcs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)). Similarly, in considering the scope of the registration, the TTAB will look to the registration itself and not to extrinsic evidence about the registrant's services. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981) (citing *Kalart Co., Inc. v. Camera-Mart, Inc.*, 119 USPQ 139 (CCPA 1958)). As such, it is important to bear in mind that all analysis of Applicant's "DECA-DURABOLIN" mark applies only to the goods cited in Applicant's relevant trademark application, namely, "dietary and nutritional supplements." *See* Applicant's trademark application.

A. Applicant's Mark Does Not Falsely Suggest a Connection With Opposer.

6. In order to prevail on a claim of false suggestion of a connection, Trademark Act Section 2(a) enumerates the statutory requirements. One of the requirements is that the plaintiff's name or identity be of sufficient fame or reputation that, when applicant's mark is used on its goods or services, a connection with Opposer would be presumed by someone considering purchasing the goods or services. *See University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372 (Fed. Cir. 1983). In the present case, the Opposer has provided no evidence whatsoever of fame. *See* Opposer's Cross Motion for Summary Judgment. Applicant cannot

comprehend how Opposer can, in good faith, allege that its name or identity is of sufficient fame in the United States when the Opposer has abandoned the mark and Opposer does not use the phrase "DECA-DURABOLIN" in the United States. See [Applicant's Motion for Summary Judgment, Wilson Decl. Ex. E] (standing for the proposition that Organon notified the FDA in a letter dated May 21, 2002 that it was discontinuing use of its product sold under the mark "DECA-DURABOLIN" in the U.S.); see also Opposer's Cross Motion for Summary Judgment, pg. 6 ((stating that "Opposer and its affiliated companies do not currently use the DURABOLIN or DECA-DURABOLIN marks Whether Opposer, or an affiliated company, or a successor to the business, will resume use in the United States in the future is unknown at this time) (citing Knox Dec. ¶ 9)).

7. In addition to the statutory requirements, There is also an additional common law requirement that the Opposer must establish proprietary rights in its name or identity which are allegedly prior to the applicant's proprietary rights. See, e.g., *In re MC MCS.r.l.*, 88 USPQ2d 1378, 1379 (TTAB 2008) (espousing that "[i]n view of the significant doubt remaining as to whether anyone currently possesses rights in the name 'Maria Callas' . . . we find that the examining attorney has not met her burden in establishing the false suggestion of a connection refusal under Section 2(a)"). It is important to bear in mind throughout this analysis that Section 2(a) anticipated protection for a specific class of persons. Perhaps most poignantly, Section 2(a) was "not designed primarily to protect the public, but to protect persons and institutions from exploitation of their persona." *In re MC MCS.r.l.*, 88 USPQ2d 1378, n.5 (quoting *Bridgestone/Firestone Research, Inc. v. Automobile Club De L'Quest De La France*, 245 F.3d 1359 (Fed. Cir. 2001)). In the factually analogous case of *In re MC MCS.r.l.*, it was acknowledged that the public may recognize the name Maria Callas as a famous opera singer. See *In re MC MCS.r.l.*, 88 USPQ2d 1378 (TTAB 2008).

Nonetheless, the pertinent inquiry was not whether the public would recognize the name, but rather whether "any successor in interest [was] entitled to assert rights, as contemplated under Section 2(a), to the Maria Callas name or persona." *See id.*

8. In the present case, the Opposer asserts that the "DURABOLIN and DECA-DURABOLIN marks are closely identified with Opposer or its predecessor and related companies, and are known in the United States . . ." *See* Opposer's Cross-Motion for Summary Judgment at pg. 6. But, Opposer fails to mention whether or not it possesses the requisite proprietary rights in the term "DECA-DURABOLIN". *See id.* Opposer even emphasizes that it does not derive any proprietary rights to the term "DECA-DURABOLIN" by virtue of the New Drug Application (NDA) 011891 to sell an injectable anabolic steroid in the United States with the active ingredient of Nandrolone Phenpropionate. *See* Opposer's Cross-Motion for Summary Judgment at pg. 16. Opposer contends that a single secondary authority, namely, Professor McCarthy, is critical of the Board's *In re MC MCS.r.l.* decision stating that "under Section 2(a), 'the person or institution need not have IP rights in its name.'" *See id.* at pg. 12 (quoting 3 *McCarthy on Trademarks* § 19:76 at 19-240). Although Opposer has cited a single secondary authority that is critical of the Board's *In re MC MCS.r.l.* decision, Opposer has not provided any evidence that the law cited by Applicant is no longer good law. *See* Opposer's Cross-Motion for Summary Judgment at pg. 12.

9. Although Opposer contends that the requirement that the party asserting a Section 2(a) claim must establish proprietary rights in its name or identity "is an incorrect statement of law," Opposer fails to provide any authority indicating that the common law requirement has been abolished. *See* Opposer's Cross-Motion for Summary Judgment at pg. 11, n. 6 (postulating that Applicant has cited incorrect law but failing to include any citation to indicate that *In re MC MCS.r.l.* has been overruled). The TTAB's relatively recent 2008 case of *In re MC MCS.r.l.* relied

on the common law proprietary right requirement in reaching its holding, and such reasoning is applicable again in the current case. *See In re MC MCS.r.l.*, 88 USPQ2d 1378 (TTAB 2008).

10. In addition to Merck Sharp & Dohme B.V. (as successor-in-interest to MSD OSS B.V.) failing to establish a proprietary right in its name or identity, it is not clear how the term "DECA-DURABOLIN" points uniquely and unmistakably to Opposer Merck Sharp & Dohme B.V. (as successor-in-interest to MSD OSS B.V.). Opposer posits that an opposer may prevail on a Section 2(a) claim "even if the name claimed to be appropriated has never been commercially exploited by the opposer in a trademark or trademark analogous manner." *See* Opposer's Cross-Motion for Summary Judgment at pg. 14 (quoting *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428, 429 (TTAB 1985)). In the *Buffett* case, the TTAB ruled that summary judgment was not appropriate to dismiss Jimmy Buffett's Section 2(a) claim, because "Buffet has attempted, through his commercial licensing program, publicity, and entertainment services, to associate the term 'MARGARITAVILLE' with the public persona of Jimmy Buffett." *Id.* at 430. In addition, the court went on to say that "MARGARITAVILLE" is "so closely associated with opposer [Jimmy Buffett] as to be considered 'synonymous with', and 'almost a nickname of' Jimmy Buffett." *Id.*

11. The *Buffett* case is not factually analogous to the present case. Jimmy Buffett recorded the song "Margaritaville" in 1977 and actively sought to associate the term with his public persona through 1985, when the opposition was brought before the TTAB. *See id.* at 429-430. Conversely, in the current case, Opposer has abandoned the mark. *See* [Applicant's Motion for Summary Judgment, Wilson Decl. Ex. E] (standing for the proposition that Organon notified the FDA in a letter dated May 21, 2002 that it was discontinuing use of its product sold under the mark "DECA-DURABOLIN" in the U.S.). Moreover, there is no reason to believe that MSD OSS B.V. or its public persona is in any way associated with the term "DECA-DURABOLIN". As such, the

relevant public would not consider the phrase "DECA-DURABOLIN" to be considered "synonymous with", and "almost a nickname of" MSD OSS B.V. *See Buffett*, 226 USPQ at 430 (TTAB 1985). The facts of *Buffett* are readily distinguished from the present case, particularly with respect to Jimmy Buffett's active attempts to associate his public persona with "MARGARITAVILLE" and MSD OSS B.V.'s obvious lack of association with "DECA-DURABOLIN". *See id.*

12. Opposer also cites the Board's decision in *Bridgestone/Firestone Research, Inc. v. Automobile Club De L'Ouest De La France*, 199 WL 556473 (TTAB 1999) (not precedential), *rev'd on other grounds*, 245 F.3d 1359 (Fed. Cir. 2001) as a case in which a phrase was found to point uniquely to the plaintiff even though the plaintiff never used the term as its name. *See* Opposer's Cross Motion for Summary Judgment, at pg. 15. In *Automobile Club*, the plaintiff Automobile Club de l'Ouest (ACO) never used the term LE MANS as its name, but the term was nevertheless found to point uniquely and unmistakably to the Automobile Club, because the LE MANS race was ACO's identity. *See Bridgestone/Firestone Research, Inc. v. Automobile Club De L'Ouest De La France*, 199 WL 556473 (TTAB 1999). Ultimately, the Federal Circuit overruled the TTAB's decision based on laches, but the TTAB's reasoning for finding a false suggestion of a connection in the *Automobile Club* case is still readily distinguished from the current case, based on the diametrically opposed fact patterns present within the two cases. *See Bridgestone/Firestone Research, Inc. v. Automobile Club De L'Ouest De La France*, 245 F.3d 1359 (Fed. Cir. 2001).

13. In *Automobile Club*, ACO was the organizational entity behind the Le Mans 24 Hours, the Petit Le Mans, and the American Le Mans Series. *See* [Ex. A, Wikipedia article about the 24 Hours of Le Mans]. The Le Mans 24 Hours race is an annual race that has been held nearly every year since May 26, 1923. *Automobile Club*, at *4; *see also* [Ex. A, Wikipedia article about

the 24 Hours of Le Mans]. Thus, the Board was able to find that "the record sufficiently establishes that in the United States, the term LE MANS pointed uniquely and unmistakably to the Automobile Club." *Automobile Club*, at *4 (emphasis added). Since the phrase LE MANS was in use in the United States at the time of the TTAB decision, and the phrase even continues to be used to this day, *Automobile Club* is readily distinguished from the current case, in which Opposer abandoned the "DECA-DURABOLIN" mark in the United States. See [Applicant's Motion for Summary Judgment, Wilson Decl. Ex. E] (standing for the proposition that Organon notified the FDA in a letter dated May 21, 2002 that it was discontinuing use of its product sold under the mark "DECA-DURABOLIN" in the U.S.). If ACO abandoned its LE MANS identity by discontinuing the race for an extended period of time, similar to the actions taken by Opposer in the current case, it is extremely unlikely that the TTAB would have reached the same conclusion that it did in *Automobile Club*.

14. Since ACO organized the Le Mans race throughout the more than ninety year period that the race has been running, the current case contrasts starkly with the *Automobile Club* case. See [Ex. A, Wikipedia article about the 24 Hours of Le Mans]. Merck Sharp & Dohme B.V. has never used the term "DECA-DURABOLIN" in the United States, Opposer is twice removed from the predecessor in interest who did use the mark, and the mark was abandoned more than a decade ago. See [Applicant's Motion for Summary Judgment, Wilson Decl. Ex. E] (standing for the proposition that Organon notified the FDA in a letter dated May 21, 2002 that it was discontinuing use of its product sold under the mark "DECA-DURABOLIN" in the U.S.); *see also* Opposer's Cross Motion for Summary Judgment, pg. 6 ((stating that "Opposer and its affiliated companies do not currently use the DURABOLIN or DECA-DURABOLIN marks Whether Opposer, or an affiliated company, or a successor to the business, will resume use in the United States in the future

is unknown at this time) (citing Knox Dec. ¶ 9)). Furthermore, unlike Opposer, ACO maintained a registration for the phrase "LE MANS" and continues to maintain this registration to the current day. *See* [Exhibit B, Title and Status of Trademark Registration No. 1,393,543 for the mark "LE MANS"].

15. Moreover, despite the plethora of evidence submitted by Opposer in its Response to Applicant's Motion for Summary Judgment and Cross Motion for Summary Judgment, no evidence exists to support the contention that Merck Sharp & Dohme B.V.'s "DECA-DURABOLIN" name or identity is of sufficient fame or reputation that, in the United States, a connection with the Opposer would be presumed. *See* Opposer's Cross-Motion for Summary Judgment. In fact, no evidence at all exists to connect Merck Sharp & Dohme B.V. to the term "DECA-DURABOLIN". *See id.* It appears that the entities Organon Inc. and N.V. Organon used the "DECA-DURABOLIN" mark many years ago. *See id.* at 5. However, Opposer has not identified any relationship between the term "DECA-DURABOLIN" and Merck Sharp & Dohme B.V. other than to allege that "Opposer is the successor in interest to MSD OSS B.V., a Netherlands company, which is the successor in interest to N.V. Organon, a Netherlands company". *See id.* at 5. It is unclear how the term "DECA-DURABOLIN" points uniquely and unmistakably to Merck Sharp & Dohme B.V., as the successor in interest to MSD OSS B.V., as successor in interest to N.V. Organon when Merck Sharp & Dohme B.V. has never even used the mark in the United States and is twice removed from the entity that did use the mark.

16. Opposer's Motion for Summary Judgment should not be granted, because Opposer has not established proprietary rights in its alleged identity. Opposer has also failed to elucidate how the term "DECA-DURABOLIN" points uniquely and unmistakably to Opposer Merck Sharp & Dohme B.V. (as successor-in-interest to MSD OSS B.V.) when Merck Sharp & Dohme B.V. never

used the mark in the United States, Merck Sharp & Dohme B.V. is twice removed from the entity that did use the mark, and the mark was abandoned more than a decade ago. In this same vein, Opposer's name or identity is inherently not of sufficient fame in the United States to prove false suggestion of a connection, because the mark was abandoned more than a decade ago and Opposer does not use the phrase "DECA-DURABOLIN" in the United States. The purpose of the trademark register is to provide notice of trademarks. If a mark is abandoned for an extended period of time and the registration for the mark is not renewed, that mark should be available for use by other entities. False suggestion of a connection is simply not applicable.

B. Applicant's Mark is Not Deceptive or Deceptively Misdescriptive.

17. In the case at bar, Opposer cannot establish, at the very least, the element common to both prongs of the test for a deceptively misdescriptive mark and all three prongs of the test for a deceptive mark, namely that the mark "DECA-DURABOLIN" is a descriptive term. Applicant's non-geographic mark cannot be deceptive or deceptively misdescriptive if it is not "misdescriptive of the character, quality, function, composition, or use of the goods." *See* Lanham Act § 2(a); *see, e.g., Hoover Co. v. Royal Applicant Mfg. Co.*, 238 F.3d 1357, 1361, 57 USPQ2d 1720, 1723 (Fed. Cir. 2001); *see also* Lanham Act § 2(e)(1); *see, e.g., In re Quady Winery, Inc.*, 221 USPQ 1213, 1214 (TTAB 1984) (emphasis added). In the present case, the Board has already held "that in order for a term to misdescribe goods or services, the term must be merely descriptive, rather than suggestive, of a significant aspect of the goods or services which the goods or services plausibly possess but in fact do not." [December 27, 2012 Board's Order] (quoting *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1051 (TTAB 2002)). A descriptive term "immediately tells something about the goods or services". *See* TMEP § 1209.01(a) (citing *In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985)).

18. In the present case, the term "DECA-DURABOLIN" is not a descriptive term. Therefore, as a matter of law, "DECA-DURABOLIN" cannot misdescribe the goods, namely, "dietary and nutritional supplements," and it cannot misdescribe any significant aspect of the goods, namely, "dietary and nutritional supplements." *See* Lanham Act § 2(a). In reality, the "DECA-DURABOLIN" mark is a fanciful mark. However, even adopting the position most favorable to the Opposer, the mark evokes features of the goods in a manner that requires the use of the consumer's imagination, thought or perception without merely describing the goods. *In re Atavio Inc.*, 25 USPQ2d 1361, 1362 (TTAB 1992) (explaining that a mark "which is only suggestive requires some imagination, thought or perception to determine its meaning in relation to the goods."); *In re WSI Corporation*, 1 USPQ2d 1570, 1572 (TTAB 1986) ("Where such imagination or forethought is required to reach a conclusion as to the nature of a key characteristic of goods or services, a mark must be determined to be suggestive and not descriptive."); *The Institut National Des Appellations D'Origine v. Vintners International Co. Inc.*, 22 USPQ 1190 (Fed Cir 1992).

19. The terms "DURABOLIN" and "DECA-DURABOLIN" do not appear in the dictionary. *See* [Applicant's Motion for Summary Judgment, Wilson Decl. Ex. C]. Applicant recognizes that whether a term "is not found in a dictionary is not controlling on the question of registrability if the examining attorney can show that the term has a *well understood and recognized meaning*." *See* TMEP § 1209.03(b) (emphasis added) (citing *In re Orleans Wines, Ltd.*, 196 USPQ 516 (TTAB 1977)). However, the fact that a term is not in the dictionary does erode some confidence in how well understood and recognized the meaning of the word is for the consuming public.

20. In addition, a theme throughout the Trademark Manual of Examining Procedure with regard to merely descriptive marks is that those marks be readily recognized and understood by the

consuming public. *Cf.* TMEP § 1209.03(h) ((indicating that initialism cannot be considered descriptive unless the wording it stands for is merely descriptive of the goods or services, and the acronym or initialism is *readily understood by relevant purchasers to be "substantially synonymous" with the merely descriptive wording it represents* (emphasis added)) (citing *Modern Optics Inc. v. The Univis Lens Co.*, 234 F. 2d 504, 506, 110 USPQ 293, 295 (C.C.P.A. 1956))). This theme is further underscored by the doctrine of foreign equivalents, which allows that a foreign word (from *a language familiar to an appreciable segment of American consumers*) and the English equivalent may be held to be confusingly similar. *See* TMEP § 1207.01(b)(vi) (emphasis added) (citing *In re Thomas*, 79 USPQ2d 1021 (TTAB 2006)).

21. Opposer has gone to great lengths in an attempt to make the fanciful term "DECA-DURABOLIN" appear descriptive. Opposer has sought the declaration of an esteemed Professor Emeritus of English and Cultural Anthropology at Duke University to engage in a deconstructive linguistic analysis of the term "DECA-DURABOLIN". *See* Opposer's Cross-Motion for Summary Judgment, Exhibit 2. Interestingly, the fact that such a prestigious individual, at the forefront of linguistic research and the pinnacle of his career, was necessary to provide insight into the matter undermines the Opposer's claim that "DECA-DURABOLIN" or any aspect of the phrase has a well understood meaning or would be readily understood by the general public seeking "dietary and nutritional supplements."

22. When reviewing the affidavit made by Professor Butters, who has not professed any knowledge of trademark law, it should be noted that Professor Butters has broken down the mark "DECA-DURABOLIN" into very small fragments of words. *See* Opposer's Cross-Motion for Summary Judgment, Exhibit 2. From a public policy perspective, Applicant stands in disbelief that Opposer seems to advocate that Trademark Examiners should break down every mark into very

small components in an effort to discover any descriptive elements of the mark. Applicant firmly believes that the term "DECA" is either arbitrary or suggestive and the term "DURABOLIN" is fanciful. Nonetheless, Applicant is compelled to address the claims made by Professor Butters in order to prove that those arguments are without merit.

23. First, Professor Butters elucidates that the term "DECA" means "ten." *See* Opposer's Cross-Motion for Summary Judgment, Exhibit 2, pg. 3. This term is the only part of the mark "DECA-DURABOLIN" that the general public will plausibly recognize. *A fortiori*, the terms "DECA" and "ten" have no descriptive relationship to anabolic steroids or the goods sold by Opposer more than ten years ago. In addition, the terms "DECA" and "ten" do not misdescribe the Applicant's goods, namely, "dietary and nutritional supplements." *See* Applicant's trademark application. The terms "DECA" and "ten" would be considered arbitrary within Applicant's mark or at least suggestive of the strength that the user will be able to achieve by using Applicant's dietary and nutritional supplements.

24. Next, Professor Butters professes that the term "DURA" means "hard-wearing." *See* Opposer's Cross-Motion for Summary Judgment, Exhibit 2, pg. 3. Applicant must emphasize that the term following "DECA" in Applicant's Mark is "DURABOLIN", not "DURA", "ABOL", "IN". Nonetheless, in addressing Professor Butters' suppositions, Applicant notes that "DURA" and "hard-wearing" have no descriptive relationship to anabolic steroids or the goods sold by Opposer more than ten years ago. In addition, the terms "DURA" and "hard-wearing" do not misdescribe the Applicant's goods, namely, "dietary and nutritional supplements." The terms "DURA" and "hard-wearing" would again be considered arbitrary or at least suggestive of the strength that the user will be able to achieve by using Applicant's dietary and nutritional supplements.

25. The crux of Professor Butters' argument appears then to be that the term "ABOL" means "promoting change in structure." *See* Opposer's Cross-Motion for Summary Judgment, Exhibit 2, pg. 3-12. Professor Butters then postulates that "[s]peakers of English who will employ the basic elements and terminology of biological processes will understand the meaning of DECA-DURABOLIN as a laudatory, linguistically descriptive term for a type of anabolic steroid." *See id.* at 3-4. This argument is disingenuous for a myriad of reasons.

26. First, this argument presupposes that the general public and relevant consumers will actually have the desire and ability to employ the complex linguistic dissection Professor Butters describes. Applicant is highly skeptical that the average purchaser of the goods will be motivated or possess the ability to conduct such a complex linguistic dissection, particularly when making an impulse decision. Second, this argument requires telescoping the terms "DURA" and "ABOL" to arrive at the dissection described by Professor Butters, which requires precisely the imagination, thought, or perception that differentiates a suggestive mark from a merely descriptive mark. Third, the terms "ABOL" or "promoting change in structure" have no descriptive relationship to anabolic steroids or the goods sold by Opposer more than ten years ago. In addition, the terms "ABOL" or "promoting change in structure" do not misdescribe the Applicant's goods, namely, "dietary and nutritional supplements." Fourth, the term "ABOL" is not unique to anabolic steroids. The terms metabolism, anabolism, and catabolism all contain the "ABOL" root and are in no way associated with steroids. *See* [Ex. C, Wikipedia article explaining the processes of metabolism, anabolism, and catabolism]. It is completely arbitrary for Professor Butters to suggest that the term "ABOL" would refer to anabolic steroids rather than any of these other terms. *See id.*

27. Finally, Professor Butters indicates that "IN" means "organic compound." *See* Opposer's Cross-Motion for Summary Judgment, Exhibit 2, pg. 3. Professor Butters fails to

indicate how the terms "IN" or "organic compound" would be considered to have a descriptive relationship to anabolic steroids or the goods sold by Opposer more than ten years ago. In addition, the terms "DURA" and "hard-wearing" do not misdescribe the Applicant's goods, namely, "dietary and nutritional supplements." Even if that were the case, it is highly unlikely that consumers or the general public will interpret the last two letters of a fanciful term "DECA-DURABOLIN" as meaning "organic compound." Applicant believes it is much more likely that an individual endeavoring to perform a complex linguistic analysis of the "DECA-DURABOLIN" trademark would interpret "IN" as meaning "within."

28. Professor Butters' argument may best be summarized by his statement that the "ABOL" term appearing in Applicant's "DECA-DURABOLIN" mark "refers to *change leading to growth*, and thus to an anabolic steroid." See Opposer's Cross-Motion for Summary Judgment, Exhibit 2, pg. 8 (emphasis added). This wholly conclusory statement is factually incorrect. Proper eating habits, proper exercise, and proper nutritional supplements all promote "change leading to growth" and are in no way associated with anabolic steroids. Metabolism, anabolism, and catabolism all promote "change leading to growth," and those processes do not refer to anabolic steroids. See [Ex. C, Wikipedia article explaining the processes of metabolism, anabolism, and catabolism]. Applicant's goods are "dietary and nutritional supplements." See Applicant's trademark application. Applicant hopes that its goods sold under the "DECA-DURABOLIN" mark do result in change leading to muscle growth. That does not mean that the trademark "DECA-DURABOLIN" is descriptive of a steroid or misdescriptive of dietary and nutritional supplements.

29. Opposer contends that the extrinsic evidence that it has submitted regarding "Applicant's own websites make it clear that the targeted market for all of its products consist of body-builders, weight-lifters, athletes, and others who use, or are interested in using, anabolic steroid

products." *See* Opposer's Cross-Motion for Summary Judgment, Exhibit at pg. 20. However, since the goods are unrestricted, they are presumed to travel through all normal channels of trade and to all normal classes of purchasers. *See Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987).

30. Thus, the true consumers of Applicant's goods are any consumers seeking "dietary and nutritional supplements." *See* Applicant's trademark application. The class of consumers seeking "dietary and nutritional supplements" are not sophisticated users, and those consumers are likely subject to impulse decision making when purchasing the relevant goods. Subsequently, it is unlikely that they will carefully dissect the mark in the same painstaking manner as Professor Emeritus Butters. *See* Opposer's Cross-Motion for Summary Judgment, Exhibit 2. Moreover, despite the voluminous evidence submitted by Opposer regarding the use of Applicant's mark, it is well-settled, hornbook law that "the scope of the registration applicant seeks is defined by the identification of services in its application and not by its actual use." *In re Tropicana Las Vegas, Inc.*, Serial No. 85450247 (TTAB 2013) (quoting *Octocom Syst. Inc. v. Houston Computers Svcs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)). As such, it is important to bear in mind that all analysis of Applicant's "DECA-DURABOLIN" mark applies to the goods cited in Applicant's relevant trademark application, namely, "dietary and nutritional supplements." *See id.*; *see also* Applicant's trademark application. In short, there is no connection to anabolic steroids. *See id.*

31. Applicant is incredulous that the mark "DECA-DURABOLIN" was registered on the Principal Register by Organon Inc. for "hormone preparations" in International Class 5 for a period of more than sixty years without a claim of acquired distinctiveness, if the mark was truly descriptive. *See* [Ex. D, Title and Status of Trademark Registration Nos. 735,928 and 2,932,737].

Furthermore, the mental gymnastics required to interpret the mark "DECA-DURABOLIN" in the fashion laboriously outlined by Professor Butters is something that might be expected from a Professor Emeritus of English and Cultural Anthropology at Duke University but certainly not the general public or the relevant purchasers of Applicant's goods. Opposer is not entitled to summary judgment, because Applicant's "DECA-DURABOLIN" mark fails all three prongs of the test to determine whether a mark is deceptive and both prongs of the test to determine whether a mark is deceptively misdescriptive.

III. CONCLUSION

For the foregoing reasons, Applicant's Motion for Summary Judgment should be granted, Opposer's Motion for Summary Judgment should be denied, and U.S. Trademark Application No. 85/340,058 should proceed to registration. Applicant is entitled to summary judgment on all three of the counts raised in the Opposer's Notice of Opposition. Opposer's Motion for Summary Judgment fails with regard to all three claims of deceptiveness, deceptive misdescriptiveness, and false suggestion of a connection.

Respectfully submitted,

August 1, 2013
Date

/2259-36/
John S. Egbert
Reg. No. 30,627
Kevin S. Wilson
Michael F. Swartz

EGBERT LAW OFFICES, PLLC
1314 Texas, 21st Floor
Houston, Texas 77002
Tel: (713) 224-8080
Fax: (713) 223-4873

ATTORNEYS FOR APPLICANT
Dynamic Sports Nutrition, LLC

CERTIFICATE OF SERVICE

I hereby certify that Applicant's Reply in Support of its Motion for Summary Judgment is being sent by first class mail on August 1, 2013, to the correspondence of record for Opposer at the following address:

Marie Lavalley
Bingham Leverich
Patrick M. Phelan
Covington & Burling LLP
1201 Pennsylvania Avenue, NW
Washington, DC 20004

ATTORNEYS FOR OPPOSER

Merck Sharp & Dohme B.V. (as successor in interest to MSD OSS B.V.)

/2259-36/

John S. Egbert
Reg. No. 30,627
Kevin S. Wilson
Michael F. Swartz

Egbert Law Offices, PLLC
1314 Texas, 21st Floor
Houston, Texas 77002
(713)224-8080
(713)223-4873 (Fax)

ATTORNEYS FOR APPLICANT
Dynamic Sports Nutrition, LLC

JSE:mfs
Our File: 2259-36