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

Proceeding	91205081
Party	Plaintiff Merck Sharp & Dohme B.V.
Correspondence Address	MARIE A LAVALLEYE COVINGTON & BURLING LLP 1201 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004 UNITED STATES trademarks@cov.com
Submission	Other Motions/Papers
Filer's Name	Marie A. Lavalleye
Filer's e-mail	trademarks@cov.com
Signature	/mariealavalleye/
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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
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MERCK SHARP & DOHME B.V. (as)	
successor in interest to MSD OSS B.V.),)	
)	
Opposer,)	
)	
v.)	Opposition No. 91205081
)	
DYNAMIC SPORTS NUTRITION, LLC,)	
)	
Applicant.)	
)	
)	

**OPPOSER’S BRIEF IN REPLY TO APPLICANT’S RESPONSE TO
OPPOSER’S CROSS-MOTION FOR SUMMARY JUDGMENT**

Merck Sharp & Dohme B.V. (“Opposer”) files this brief in further support of Opposer’s Cross-Motion for Summary Judgment (“Opp. Br.” or “Opposer’s Cross-Motion”), filed June 13, 2013, and in reply to Dynamic Sports Nutrition, LLC’s (“Applicant”) Response to Opposer’s Cross-Motion for Summary Judgment (“App. Resp.” or “Applicant’s Response”), filed August 1, 2013.

INTRODUCTION

In addition to presenting no valid legal arguments in response to Opposer’s Section 2(a) and 2(e)(i) claims (*see pp. 3-10 infra*), Applicant’s Response is also fatally defective on evidentiary grounds, for two reasons.

First, Applicant’s Response fails to properly dispute any of the facts set forth in the Counter-Statement of Undisputed Facts in Opposer’s Cross-Motion (*see Opp. Br. at pp. 5–10*) as required by Fed. R. Civ. P. 56(c). Specifically, Applicant has not cited “to particular parts of

materials in the record, including . . . affidavits or declarations” that create a genuine dispute regarding the facts asserted by Opposer, nor has it “show[n] that the materials cited [by Opposer] do not establish the absence . . . of a genuine dispute.” Fed. R. Civ. P. 56(c)(1); *see also Barmag Barmer Maschinenfabrik AG v. Murata Machinery, Ltd.*, 731 F.2d 831, 836 (Fed. Cir. 1984) (“The party opposing the motion [for summary judgment] must point to an evidentiary conflict created on the record at least by a counter statement of a fact or facts set forth in detail in an affidavit by a knowledgeable affiant.”).

As a result, Opposer’s Counter-Statement of Undisputed Facts, which are all supported by sworn declarations, should be deemed admitted as true for purposes of deciding Applicant’s Motion and Opposer’s Cross-Motion. *See* Fed. R. Civ. P. 56(e)(2), which provides that “if a party . . . fails to properly address another party’s assertion of fact . . . the court may . . . consider the fact undisputed for purposes of the motion.” These undisputed facts establish all of the elements of Opposer’s Section 2(a) and 2(e)(1) claims, including the following facts disputed only by the unsupported arguments of Applicant’s counsel: (1) that consumers in the United States closely identify and associate DECA-DURABOLIN with Opposer and its predecessors, (2) that Opposer’s identity is of sufficient fame or reputation that, when Applicant’s mark is used in connection with its goods, a connection with Opposer would be presumed, and (3) that DECA-DURABOLIN is descriptive of an anabolic steroid product. *See* Opp. Br. at pp. 5–10.

Second, as Opposer described in significant detail in its Cross-Motion, Applicant operates a business scheme pursuant to which it sells dietary nutritional supplements on several websites associated with domain names including the term steroids (*e.g.*, BUYSTEROIDS.COM and ORALSTEROIDS.COM) in an effort to mislead consumers into believing that Applicant’s products, including DECA-DURABOLIN, *are* steroid products, when, in fact, they *are not*. *See*

Opp. Br. at pp. 1–4. Applicant does not dispute Opposer’s description of its business but argues that the Board should not consider evidence concerning Applicant’s business scheme and should base its analysis only on the goods cited in Applicant’s trademark application. App. Resp. at p. 3.

But Applicant’s argument and the authority that it cites miss the mark. The cases cited by Applicant concern whether an applicant can introduce evidence concerning its use of a mark beyond the scope of the goods listed in its registration in connection with a likelihood of confusion analysis. Here, Opposer offers evidence of Applicant’s business to demonstrate that Applicant’s *intent* in registering the DECA-DURABOLIN mark in connection with its dietary and nutritional supplements is to further its business scheme by causing purchasers to associate Applicant’s dietary and nutritional supplements with Opposer and its well-known steroid DECA-DURABOLIN. Opp. Br. at pp. 2–3. Evidence of such intent is highly probative and is properly considered by the Board in its analysis. *See University of Notre Dame Du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 U.S.P.Q. 505 (Fed. Cir. 1983) (“[E]vidence of such intent would be highly persuasive that the public will make the intended false association.”).

ARGUMENT

I. Applicant’s Mark Falsely Suggests A Connection With Opposer In Violation of Section 2(a) Of The Lanham Act.

In order to prevail on a false connection claim under Section 2(a), Opposer must demonstrate four elements: (i) that Applicant’s mark is the same or a close approximation of Opposer’s previous name or identity; (ii) that the mark would be recognized as such; (iii) that Opposer is not connected with Applicant’s activities performed under the mark; and (iv) that Opposer’s name or identity is of sufficient fame or reputation that when Applicant’s mark is used

in connection with its goods or services, a connection with Opposer would be presumed. *Buffett v. Chi-Chi's, Inc.*, 226 U.S.P.Q. 428, 429 (TTAB 1985).

The undisputed facts plainly establish that Opposer satisfies these four elements. First, Applicant's DECA-DURABOLIN mark is identical to Opposer's DECA-DURABOLIN mark and nearly identical to Opposer's DURABOLIN mark. Second, the DECA-DURABOLIN and DURABOLIN marks are closely associated with Opposer. Declaration of Alan M. Knox ("Knox Dec.") ¶ 10. Third, Opposer is admittedly in no way connected to Applicant's goods under the DECA-DURABOLIN and DURABOLIN marks. Fourth, and finally, Opposer's DECA-DURABOLIN and DURABOLIN marks have acquired significant fame and reputation among the relevant class of purchasers (*e.g.*, body builders, weight lifters, and other users of anabolic steroids) such that consumers who encounter Applicant's use of DECA-DURABOLIN or DURABOLIN in connection with dietary and nutritional supplements will presume a connection with Opposer. Knox Dec. ¶ 10.

Applicant's Response maintains, incorrectly, that Section 2(a) includes an additional "common law" element requiring Opposer to "establish proprietary rights in its name or identity which are allegedly prior to Applicant's proprietary rights." App. Resp. at p. 4. At the risk of repeating itself, Opposer must again point out that Applicant's position is an incorrect statement of the law. *See 3 McCarthy on Trademarks* § 19:76 at 19-240 ("Proof of proprietary rights...in a name is not necessary... Even if a celebrity's trademark rights in her name were abandoned by non-use as a trademark for goods, that person can still prevail under 2(a)..."); *The Board of Trustees of the University of Alabama and Paul W. Bryant, Jr. v. William Pitts, Jr. and Christopher Blackburn*, Opposition No. 91187103 (TTAB July 23, 2013) ("An opposer may prevail on the false suggestion of a connection ground . . . even if the name claimed to be

appropriated was never commercially exploited by the opposer as a trademark or in a manner analogous to trademark use.”)

Moreover, Applicant’s assertion is not supported by the only case on which it so heavily relies, *In re MC MC S.r.l.*, 88 U.S.P.Q.2d 1378 (TTAB 2008).¹ As the Board’s decision in that case makes clear, the “requirement” to which Applicant refers was part of the Board’s analysis of the first element of a Section 2(a) claim, *not* an additional “common law” requirement. *See Id.* at 1380 (“Therefore we must determine as a threshold matter *in element one* whether the ‘other person’ exists.”). The Board continued, “Specifically, we must find whether or not there is someone . . . with rights in the name ‘Maria Callas.’ FN 5.” *Id.* The Board’s reference to “rights” in the name, however, is *not*, as Applicant contends, “proprietary rights in the name.” Footnote 5 makes this abundantly clear: “Again, for sake of clarity, the ‘rights’ to which the Board references in this decision are those contemplated by Section 2(a).” *Id.* at 1381, n. 5. Although the Board ultimately concluded that there were no living heirs or successors with a valid interest in Maria Callas’ rights under Section 2(a) (*see id.* at 1381), that is not the case here. Indeed, as has been established, Opposer is the successor in interest to the Section 2(a) rights of MSD OSS B.V. and N.V. Organon. Knox Dec. ¶ 4.

Applicant’s further contention that “no evidence exists to support the contention that Merck Sharp & Dohme B.V.’s ‘DECA-DURABOLIN’ name or identity is of sufficient fame or

¹ Contrary to Applicant’s claim otherwise (*see* App. Resp. p. 5), Opposer did not discuss *In re MC MC S.r.l.* in its Cross-Motion because Applicant *did not* cite it in support of this proposition in its Motion for Summary Judgment. In fact, the two cases that Applicant did cite to support this proposition, *In re Kayser-Roth Corp.*, 29 U.S.P.Q.2d 1379 (TTAB 1993) and *Kardex Systems, Inc. v. Sistemco N.V.*, 221 U.S.P.Q. 149 (TTAB), are not mentioned in Applicant’s Response. It appears that, after Opposer’s Cross-Motion exposed Applicant’s flawed reliance on those cases (*see* Opp. Br. at p. 11, n. 6), Applicant discarded those cases and has attempted instead to read the proposition into yet another case where it does not exist.

reputation that, in the United States, a connection with opposer would be presumed” (App. Resp. at p. 9) is also unquestionably false, as it ignores the undisputed facts and the law. First, Opposer and its affiliated companies sold injectable anabolic steroid products in the United States under the marks DURABOLIN and DECA-DURABOLIN for decades, establishing the fame and reputation of the marks. *See* Knox. Dec. ¶ 5. Second, Opposer owns over 100 valid trademark registrations for the DURABOLIN and DECA-DURABOLIN marks around the world and sells injectable steroid products under those marks in more than 50 countries. Knox. Dec. ¶¶ 6–8. The law is clear that “evidence of fame or reputation in other countries may have relevance [to a false connection claim] to the extent that consumers in the United States would be aware of [opposer] as a result of these activities.” *Hornby v. TJX Companies, Inc.*, 87 U.S.P.Q.2d 1411, 1416 (TTAB 2008). In the case of DECA-DURABOLIN, it is undisputed that relevant purchasers in the United States closely identify and associate DURABOLIN and DECA-DURABOLIN with Opposer and its anabolic steroid products.² Knox Dec. ¶ 10.

Similarly, Applicant’s assertion that “it is not clear how the term ‘DECA-DURABOLIN’ points uniquely and unmistakably to Opposer” (App. Resp. at 6) is also misplaced. As described above, Opposer owns over 100 trademarks around the world for the DURABOLIN and DECA-DURABOLIN marks and continues to sell injectable steroids under those marks such that purchasers closely identify and associate Opposer with the marks. In fact, although Opposer has never used DECA-DURABOLIN as its name, the DECA-DURABOLIN mark is so closely associated with Opposer that the mark points uniquely and unmistakably to Opposer, as required

² It bears mention that Applicant’s own website STEROID.COM and third-party steroid websites aimed at consumers in the United States uniquely identify DECA-DURABOLIN with Opposer and its predecessor companies. *See* Declaration of Patrick M. Phelan (“Phelan Dec.”) ¶ 4, Ex. 3; Phelan Dec. ¶ 8, Ex. 6.

to sustain a false suggestion of connection claim under Section 2(a). *Bridgestone/Firestone Research, Inc. v. Automobile Club De L'Quest De La France*, 1999 WL 556472 (TTAB 1999), *rev'd on other grounds*, 245 F.3d 1359 (Fed. Cir. 2001).³ Moreover, as noted above, to the extent that DECA-DURABOLIN “points uniquely and unmistakably” to MSD OSS B.V. or N.V. Organon, Opposer is the true successor in interest to their Section 2(a) rights. Knox Dec. ¶ 4.

II. Applicant’s Mark Is Deceptive And Deceptively Misdescriptive In Violation Of Sections 2(a) and 2(e)(1) Of The Lanham Act.

It is well settled that Opposer must satisfy three elements to prevail on its claim that Applicant’s mark is deceptive under Section 2(a), namely that: (1) the term is misdescriptive of the character, quality, function, composition or use of the goods; (2) prospective purchasers are likely to believe that the misdescription actually describes the goods; and (3) the misdescription is likely to affect the decision to purchase. *In re Budge Mfg. Co., Inc.*, 857 F.2d 773, 775 (Fed. Cir. 1988). If Opposer satisfies the first two requirements of the three part test, but not the third, it will sustain its claim that the Applicant’s mark is deceptively misdescriptive under Section 2(e)(1). *Bureau Nat’l Interprofessionnal Du Cognac v. Int’l Better Drinks Corp.*, 6 U.S.P.Q.2d 1610, 1615 (TTAB 1988).

As this Board recognized in its December 27, 2012 decision regarding Applicant’s motion to dismiss at p. 7, the standard for establishing misdescriptiveness under the first element of the test is: “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

³ Applicant’s Response attempts to distinguish *Bridgestone* on the basis that the LE MANS mark in that case was registered and well known in the United States whereas Opposer has abandoned all use of DECA-DURABOLIN in this country. App. Resp. at p. 7–8. Even putting aside the fact that Opposer has *not* abandoned its trademark for DECA-DURABOLIN (*see* Opp. Br. at 5-6, 13-14), the record is clear that relevant purchasers in the United States closely associate and identify the mark DECA-DURABOLIN with Opposer. Knox Dec. ¶ 10.

goods or services plausibly possess but in fact do not.” *In re Phillips-Van Heusen Corp.*, 63 U.S.P.Q.2d 1047, 1051 (TTAB 2002).

Opposer has established that the mark DECA-DURABOLIN is misdescriptive of Applicant’s dietary and nutritional supplements that it intends to sell under the mark. In support of its Cross-Motion, Opposer submitted the sworn Declaration of Professor Ronald R. Butters (“Butters Dec.”), an expert in linguistics, lexicology, and lexicography. Professor Butters concluded, *inter alia*, that the relevant purchasers of Applicant’s product (*e.g.*, body-builders, weight-lifters, athletes, and others who are familiar with anabolic steroids) will interpret the term DECA-DURABOLIN as referring to or describing an anabolic steroid. *See* Butters Dec. ¶¶ 6, 12. In light of Professor Butters’ conclusions, and the fact that Applicant has conceded that its dietary and nutritional supplements *do not* contain anabolic steroids,⁴ Opposer has established that the mark DECA-DURABOLIN is misdescriptive of Applicant’s dietary and nutritional supplements in that the mark is descriptive of a significant aspect of Applicant’s goods, which the goods may plausibly possess, but in fact, do not.

Applicant’s arguments in support of its contention that DECA-DURABOLIN is not descriptive of anabolic steroids (App. Resp. at p. 11)⁵ fail to discredit the validity of Professor Butter’s conclusions or the bases on which he reached them .

As an initial matter, Applicant’s contention that acquiring an opinion from an expert somehow undermines the claim that ordinary consumers will consider the term DECA-

⁴ *See* Amended Notice of Opposition ¶ 38 and Answer to Amended Notice of Opposition ¶ 39.

⁵ Applicant appears belatedly to acknowledge that the appropriate legal standard is *not* whether DECA-DURABOLIN is descriptive of Applicant’s dietary and nutritional supplements, as it argued in its Motion for Summary Judgment (*see* App. Motion for Summary Judgment at p. 11), but whether DECA-DURABOLIN is descriptive of an anabolic steroid product, and thus misdescriptive of Applicant’s dietary and nutritional supplements.

DURABOLIN to be descriptive (App. Resp. at p. 12) is ridiculous and ignores well settled law that expert opinions are highly relevant and probative evidence of whether the public will consider a term to be descriptive. *See 2 McCarthy on Trademarks* § 11.20 at 11-43 (“The testimony of experts on the meaning of words—lexicographers—is relevant evidence of the probable descriptive or suggestive meaning attached to a mark by the public.”).

In addition, Applicant’s contention that Professor Butters inappropriately reviewed the component parts of DECA-DURABOLIN in determining that it is descriptive of an anabolic steroid product is equally unconvincing. App. Resp. at p. 12. Indeed, “it is entirely acceptable to consider the component parts of a composite mark when divining the likely perception of the composite.” *In re Petroglyph Games, Inc.*, 91 U.S.P.Q.2d 1332, 1337 (TTAB 2009); *see also In re White Jasmine LLC*, 106 U.S.P.Q.2d 1385, 1391 (TTAB 2013) (“It is well established that a mark may be found deceptive on the basis of a single deceptive term that is embedded in a larger mark”)

Moreover, although Applicant argues that the relevant purchasers of its products are “any consumers seeking ‘dietary and nutritional supplements’” (App. Resp. at p. 16), the case that it relies on for that proposition fails to support it. *See Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 U.S.P.Q.2d 1813, 1815 (Fed. Cir. 1987). That case discusses the appropriate test for determining likelihood of confusion, not descriptiveness, and, while it discusses the proper channels of trade that should be considered, it is silent with respect to relevant purchasers. Contrary to Applicant’s contention, moreover, the law is clear that Opposer is correct in asserting that the relevant purchasers for purposes of descriptiveness here are body builders, weight lifters, athletes, and other individuals with knowledge of anabolic steroids:

The proper test of descriptiveness of a word is its meaning to that class of buyers who are prospective purchasers, which may or may not be

synonymous with its popular meaning. If a product is marketed to technically knowledgeable buyers, it is their understanding of the designation that determines whether or not it is descriptive... If corporate users of banking services understand that "First Tier" describes a certain class of bank, then that term is descriptive even if consumers would not so understand the term.

2 *McCarthy on Trademarks* § 11.20 at 11-42 and 11-43. *See also In re Omaha Nat'l Corp.*, 819 F.2d 1117, 1119 (Fed. Cir. 1987) (same).

CONCLUSION

For the foregoing reasons, Opposer respectfully submits that Applicant's motion for summary judgment should be denied and that Opposer's cross-motion for summary judgment should be granted. Accordingly, Applicant's U.S. Trademark Application No. 85/340,058 should be rejected.

August 21, 2013

Respectfully submitted,

By: /Marie Lavalleye/
Marie Lavalleye
Bingham B. Leverich
Patrick M. Phelan
Covington & Burling LLP
1201 Pennsylvania Avenue, NW
Washington, DC 20004
(202) 662-6000
trademarks@cov.com

Attorneys for Opposer
Merck Sharp & Dohme B.V.

CERTIFICATE OF SERVICE

I hereby certify that Opposer's Brief in Reply to Applicant's Response to Opposer's Cross-Motion for Summary Judgment was served by first class mail, postage prepaid, this 21st day of August, 2013 on the following:

John S. Egbert
Kevin S. Wilson
Egbert Law Offices, PLLC
1314 Texas Avenue, 21st Floor
Houston, Texas 77002

Attorneys for Applicant Dynamic Sports Nutrition, LLC

/Patrick M. Phelan/

Patrick M. Phelan
Covington & Burling, LLP
1201 Pennsylvania Avenue, NW
Washington, DC 20004
(202) 662-6000