This is not a Precedent of the TTAB.

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

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Mailed: October 30, 2013

Opposition No. **91205081**

Merck Sharp & Dohme B.V.

v.

Dynamic Sports Nutrition, LLC

Before Bucher, Lykos, and Gorowitz,
Administrative Trademark Judges.

By the Board:

Dynamic Sports Nutrition ("applicant") seeks to register the mark DECA-DURABOLIN for "dietary and nutritional supplements" in International Class 5.[1]

Merck Sharp & Dohme B.V. ("opposer") has opposed registration on the grounds of false suggestion of a connection under Section 2(a), deceptiveness under Section 2(a), and deceptively misdescriptiveness under Section 2(e)(1). In the notice of opposition, opposer has alleged ownership of "over 100 trademark registrations…for its DURABOLIN and DECA-DURABOLIN marks in many countries throughout the world," "long and continuous use of the DURABOLIN and DECA-DURABOLIN marks in numerous countries worldwide, including extensive use…in the United States for

[1] Application Serial No. 85340058, filed June 7, 2011, based on an allegation of an intent to use in commerce under Trademark Act Section 1(b), 15 U.S.C. § 1051(b).

nearly 50 years," and that the marks are "closely identified with" and "associated with" opposer.[2]

Applicant, in its answer, denied the salient allegations of the notice of opposition.

The case now comes up for consideration of applicant's motion (filed April 19, 2013) for summary judgment in its favor on all the pleaded grounds and opposer's cross-motion for summary judgment on all the pleaded grounds. Both motions are fully briefed.

Summary judgment is only appropriate when there is no genuine dispute as to any material fact and the moving party is entitled to judgment as a matter of law. *See* Fed. R. Civ. P. 56(a). The Board may not resolve issues of material fact; it may only ascertain whether a genuine dispute regarding a material fact exists. *See Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 766 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Old Tyme Foods, Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1542. "A genuine dispute is shown to exist if sufficient evidence is presented such that a reasonable fact finder could decide the question in favor of the non-moving party". *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc.*,

[2] The amended notice of opposition and answer are accepted into the record.

22 USPQ2d at 1544. Moreover, the Board may only ascertain whether a material fact is genuinely disputed, and may not resolve factual disputes. *Opryland USA*, 23 USPQ at 1472.

After reviewing the arguments and supporting evidence, we find that neither party has met its burden on summary judgment. With regard to the ground of a false suggestion of a connection, we conclude that genuine disputes of material fact exist as to whether the terms DURABOLIN and DECA-DURABOLIN point uniquely and unmistakably to opposer and whether such terms are of sufficient fame or reputation that when applicant uses its mark a connection with opposer would be presumed. As regards the parties' motions for summary judgment on the issues of whether applicant's mark is deceptively misdescriptive or deceptive, we find that there are genuine disputes of material fact as to whether the term DECA-DURABOLIN misdescribes the goods identified in the involved application; whether purchasers are likely to believe the misdescription; and whether the misdescription would materially affect their decision to purchase the goods.[3]

[3] The fact that we have identified and discussed only a few genuine disputes of material fact as a sufficient basis for denying the motion for summary judgment should not be construed as a finding that these are necessarily the only issues which remain for trial.

In view thereof, applicant's motion for summary judgment and opposer's cross-motion for summary judgment are hereby denied.[4]

Proceedings herein are resumed. Dates are reset as follows:

Expert Disclosures Due	**2/27/2014**
Discovery Closes	**3/29/2014**
Plaintiff's Pretrial Disclosures	**5/13/2014**
Plaintiff's 30-day Trial Period Ends	**6/27/2014**
Defendant's Pretrial Disclosures	**7/12/2014**
Defendant's 30-day Trial Period Ends	**8/26/2014**
Plaintiff's Rebuttal Disclosures	**9/10/2014**
Plaintiff's 15-day Rebuttal Period Ends	**10/10/2014**

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.l25.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.

[4] The parties should note that the evidence submitted in connection with the motion for summary judgment is of record only for consideration of the 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). Opposer should note that pleaded registrations may be made of record by attaching "a current printout of information from the electronic database records of the UPTO showing the current status and title of the registration." Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1).