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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
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MSD OSS B.V.)	
)	
Opposer,)	
)	
v.)	Opposition No. 91205081
)	
DYNAMIC SPORTS NUTRITION, LLC,)	
)	
Applicant.)	

OPPOSER’S BRIEF IN OPPOSITION TO MOTION TO DISMISS

Opposer MSD Oss B.V. (“Opposer”) respectfully submits this brief in opposition to the motion to dismiss for failure to state a claim filed by Applicant Dynamic Sports Nutrition, LLC (“Applicant”).

I. THE STANDARDS GOVERNING MOTIONS TO DISMISS FOR FAILURE TO STATE A CLAIM

Section 503.02 of the Trademark Trial And Appeal Board Manual Of Procedure (TBMP) (3rd Edition, May, 2011) provides in relevant part:

A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint. In order to withstand such a motion, a complaint need only allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought, that is, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for the denying the registration sought.... To survive a motion to dismiss, a complaint must “state a claim to relief that is plausible on its face”

Whenever the sufficiency of any complaint has been challenged by a motion to dismiss, it is the duty of the Board to examine the complaint in its entirety, construing the allegations therein so as to do justice, as required by Fed. R. Civ. P. 8(e), to determine whether it contains any allegations which, if proved, would entitle the plaintiff to the relief sought.

TBMP § 503.02 (footnotes omitted).

It is established, moreover, that “for purposes of determining a Rule 12(b)(6) motion to dismiss, all of plaintiff’s well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to plaintiff.” *Fiat Group Automobiles S.p.A. v. ISM, Inc.*, 94 U.S.P.Q.2d 1111, 1112 (TTAB 2010); *Advanced Cardiovascular Systems, Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 1158 (Fed. Cir. 1993) (same).

As shown below, the Opposition here states claims under Sections 2(a) and 2(e)(1) of the Lanham Act that are more than sufficient under these standards, and Applicant’s motion should be denied accordingly.

II. ARGUMENT

A. Opposer Has Standing To Assert The Claims Alleged.

Applicant’s claim that Opposer does not have standing is frivolous and unsupported by any of the standing cases Applicant cites, in all of which opposers were found to have standing. “To establish standing to oppose, the opposer need only be something more than a gratuitous interloper or a vicarious avenger of someone else’s rights. As the Trademark Board observed: ‘Proof of standing in a Board opposition is a low threshold, intended only to ensure that the plaintiff has a real interest in the matter, and is not a mere intermeddler.’” 3 *McCarthy on Trademarks* § 20:7 at 20-22 (footnotes omitted, quoting *Syngenta Crop Protection, Inc. v. Bio-Chek*, 90 U.S.P.Q.2d 1112, n. 8 (TTAB 2009)). See also *Estate of Biro v. Bic Corp.*, 18 U.S.P.Q.2d 1382, 1385 (TTAB 1991) (“The continuing pronouncements of the Federal Circuit

leaves us with the understanding that there is a low threshold for a plaintiff to go from being a mere intermeddler to one with an interest in the proceeding. The Court has stated that an opposer need only show ‘a personal interest in the outcome of the case beyond that of the general public.’” citing *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 2 U.S.P.Q.2d 2021, 2023 (Fed. Cir. 1987).

The Opposition here alleges, *inter alia*, that Opposer has used the marks DURABOLIN and DECA-DURABOLIN for prescription injectable anabolic steroid products for over 50 years, including nearly 50 years in the United States (§§ 2, 3, 6); that Opposer has sold, and continues to sell, such products under its DURABOLIN and DECA-DURABOLIN marks in more than 50 countries worldwide (§ 4); that Opposer owns over 100 trademark registrations for its DURABOLIN and DECA-DURABOLIN marks in at least 85 countries (§ 5); that, as a result of such extensive use, the DURABOLIN and DECA-DURABOLIN marks are closely associated with Opposer and its prescription anabolic steroid products (§§ 6, 14, 22); that the mark which Applicant seeks to register for dietary and nutritional supplements -- DECA-DURABOLIN -- is identical to Opposer’s DECA-DURABOLIN mark (§§ 7, 21); that, upon information and belief, Applicant selected the DECA-DURABOLIN mark with the intent to deceive consumers and that the mark is likely to deceive consumers by causing them to believe, erroneously, (i) that a connection exists between its DECA-DURABOLIN products and Opposer and/or Opposer’s DURABOLIN and DECA-DURABOLIN anabolic steroid products, and (ii) that the character, quality, function, composition and/or use of applicant’s DECA-DURABOLIN product is the same as, or comparable to, that of Opposer’s DURABOLIN and DECA-DURABOLIN anabolic steroid products (§§ 19, 20, 21); that Opposer will be damaged by the registration sought by Applicant (§ 23); that registration should be refused under Section 2(a) on

the ground that Applicant's DECA-DURABOLIN mark consists of or comprises deceptive matter (§ 24); that registration should also be refused under Section 2(a) on the ground that Applicant's DECA-DURABOLIN mark consists of or comprises matter that falsely suggests a connection with Opposer (§ 25); and that registration should be refused under Section 2(e)(i) on the ground that Applicant's DECA-DURABOLIN mark is deceptively misdescriptive (§ 26).

These allegations and others in the Opposition are clearly more than sufficient under the "low threshold" for standing recognized in the above decisions. Many opposers with far less of a "real interest" in the proceeding have been held to have standing in Lanham Act opposition proceedings. *See, e.g., Ritchie v. Simpson*, 170 F.3d 1092, 1097 (Fed. Cir. 1999) (upholding standing to oppose registration of the marks O.J. SIMPSON, O.J., and THE JUICE by an individual whose only interest in the proceeding was his claim that he would be damaged by registration of the marks because they "disparage his values, especially those values relating to his family," and that he was "a member of a group that could be potentially damaged by marks that allegedly are synonymous with wife-beater and wife-murderer"); *Bromberg v. Carmel Self Service, Inc.*, 198 U.S.P.Q. 176 (TTAB 1978) (upholding standing to oppose registration of the mark ONLY A BREAST IN THE MOUTH IS BETTER THAN A LEG IN THE HAND by two women whose only interest in the proceeding was their claim that the mark disparaged women as a class and that they believed they would be damaged and defamed by its registration).

Applicant's only argument here in support of its claim that Opposer lacks standing is that Opposer has no proprietary rights in its DURABOLIN and DECA-DURABOLIN marks in the United States, because Opposer has admitted that it "has abandoned rights in the U.S." Motion at 2-3. However, while the Opposition does admit (§ 4) that Opposer is not currently using the marks in the United States, it does not admit that Opposer has abandoned its

marks in the United States or that Opposer has no intent to resume use of the marks in the United States. Furthermore, even if Opposer had admitted abandonment and that it, therefore, has no proprietary rights in the marks in the United States, that would not deprive Opposer of standing. To the contrary, it is well established that “standing, in the context of a Section 2(a) claim, does not rise or fall on the basis of plaintiff’s proprietary rights in a term.” *Estate of Biro v. Bic Corp.*, 18 U.S.P.Q.2d 1382, 1385 (TTAB 1991); *see also Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 491 (Fed. Cir. 1987) (vacating and remanding Board holding that “an opposition cannot be sustained unless an opposer has a proprietary right in the mark which is the basis for the opposition”); *Universal Oil Products Co. v. Rexall Drug and Chemical Co.*, 463 F.2d 1122, 1124 (C.C.P.A. 1972); (“Control over the mark or name relied upon is not determinative of standing to oppose”).

B. The Opposition States Both A Claim That Applicant’s Mark Is Deceptive Under Section 2(a) And A Claim That It Is Deceptively Misdescriptive Under Section 2(e)(1).

A three-part test is applied to determine whether a mark is deceptive within the meaning of Section 2(a):

- “(1) Is the term misdescriptive of the character, quality, function, composition or use of the goods?
- (2) If so, are prospective purchasers likely to believe that the misdescription actually describes the goods?
- (3) If so, is the misdescription likely to affect the decision to purchase?”

In re Budge Manufacturing Co., Inc., 857 F.2d 773, 775 (Fed. Cir. 1988).

If a mark meets the first two requirements of this test but not the third (the materiality requirement), it is deemed deceptively misdescriptive under Section 2(e)(1). *Bureau National Interprofessional Du Cognac v. International Better Drinks Corp.*, 6 U.S.P.Q.2d 1610,

1615 (TTAB 1988) (“If the mark misdescribes the goods, and purchasers are likely to believe the misrepresentation, but the misrepresentation is not material to the purchasing decision, then the mark is deceptively misdescriptive”). “The key difference between ‘deceptively misdescriptive’ marks under § 2(e)(1) and ‘deceptive’ marks absolutely barred under § 2(a) is that a ‘deceptive’ mark is one in which the mis-description or falsity is ‘material’ in that it is likely to significantly induce a purchaser’s decision to buy.” 2 J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* § 11:55 at 11-166 (4th ed. 2012) (hereinafter “McCarthy on Trademarks”).

The Opposition here includes allegations that meet all three of the governing tests set forth above, and it thus states claims that Applicant’s mark is both deceptive under Section 2(a) and deceptively misdescriptive under Section 2(e)(1). The Opposition alleges, for example:

- that Opposer has used the mark Applicant seeks to register, DECA-DURABOLIN, as well as the mark DURABOLIN, for prescription injectable anabolic steroid products for over 50 years in over 50 countries worldwide, including the United States for nearly 50 years (though not currently) (¶¶ 2-6);
- that, as a result of such use, the DECA-DURABOLIN and DURABOLIN marks are closely identified with Opposer’s prescription anabolic steroid products and are known in the United States among body builders, athletes and other relevant purchasers as marks associated with Opposer’s prescription anabolic steroid products (¶¶ 6, 14).
- that Applicant seeks to register the mark DECA-DURABOLIN, not for prescription anabolic steroid products, but for “dietary and nutritional supplements” (¶ 7);

- that Applicant’s website states that all of its products “are powerful alternatives to Anabolic Steroids that are designed to produce similar results in an altered time frame” (¶ 10);
- that “upon information and belief, Applicant selected the DECA-DURABOLIN mark in order to benefit from the goodwill associated with Opposer’s [DECA-DURABOLIN] marks and with the intent to deceive, mislead and confuse consumers by causing them to believe, erroneously, that 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” (¶ 19);
- that “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” (¶ 20);
- that “applicant’s use and registration of the mark DECA-DURABOLIN for ‘dietary and nutritional supplements’ likely will lead consumers to purchase Applicant’s product in the mistaken belief that Applicant’s 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, and/or (v) will offer the same or comparable benefits as Opposer's DURABOLIN and DECA-DURABOLIN prescription anabolic steroid products" (§ 21);
- that "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, and will likely cause consumers to be deceived as to the origin, sponsorship, approval, affiliation, character, quality, function, composition and/or use of Applicant's intended goods, all to the damage of Opposer and the public" (§ 24);
 - that "registration also 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 origin, sponsorship, approval, affiliation, character, quality, function, composition and/or use of goods that Applicant intends to offer under the mark, all to the damage of Opposer and the public" (§ 26).

In view of the foregoing allegations of the Opposition, among others, it is clear that the Opposition meets both of the requirements for stating a Section 2(e)(1) claim of deceptive misdescriptiveness and all three of the requirements for stating a Section 2(a) claim of deceptiveness. Applicant's only argument as to why the requirements are not met is its unsupported contention that, in order for an applicant's mark to be deceptive under Section 2(a)

or deceptively misdescriptive under 2(e)(1), it must be a descriptive mark, which DECA-DURABOLIN is not. As Applicant put it:

“Applicant’s non-geographic mark can not be deceptive if it is not descriptive.” (Motion at 3)

and

“It is axiomatic that in order for a mark to be deceptively misdescriptive, the mark must first be descriptive.” (Motion at 7)

In addition to being unsupported by citation to any authority, these statements are refuted by applicable authority, including two cases cited for other purposes by Applicant’s motion to dismiss. Thus, in *In re Quady Winery, Inc.*, 221 U.S.P.Q. 1213 (TTAB 1984), the applicant had applied to register the mark ESSENSIA for wines, specifically, applicant’s “California Orange Muscat sweet dessert wine.” The Examining Attorney had refused registration under Section 2(e)(1) on the ground that ESSENSIA is deceptively misdescriptive as applied to wines, because “ESSENSIA refers to a rare type of Hungarian Tokay wine.” *Id.*

Although ESSENSIA, like DECA-DURABOLIN, is *not* a descriptive term, the Board agreed with the Examining Attorney that it is deceptively misdescriptive under Section 2(e)(1) and therefore not registrable. Indeed, the Board’s findings that ESSENSIA misdescribes the applicant’s product and that purchasers are likely to believe the misdescription are very similar to the allegations in the Opposition here that DECA-DURABOLIN misdescribes Applicant’s dietary supplement product and that purchasers such as body-builders are likely to believe the misdescription.

In *Quady Winery*, for example, this Board stated:

When we ask whether “ESSENSIA” misdescribes applicant’s wine we must answer in the affirmative. The mass-produced California Orange Muscat sweet dessert wine is certainly not the rare nectar from Eastern Europe. There can be no serious dispute on this

issue. Use of “ESSENSIA” on wine that is not essensia is a misrepresentation. *Id.* at 1214.

As to whether purchasers were likely to believe the misrepresentation, this Board stated:

The fact that there may be a relatively small number of prospective purchasers who are knowledgeable of the original essensia is not determinative. Even if the group would not be large, it is still the proper universe for our consideration. Anyone in this group who knows about the Hungarian product would reasonably expect a product sold here and labeled “ESSENSIA” to either be or contain the Hungarian spirits. The more knowledgeable they are, the more likely they are to believe the misrepresentation, since the more they know about essensia, the more they are likely to view it as a desirable commodity. Even if they were to assume that applicant’s product was not 100% essensia, because applicant’s wine is sold for less than they would expect to pay for the wine from Hungary, they would probably assume either that applicant’s wine contains a small amount of essensia for flavoring, as does the Hungarian aszu wine, or that applicant’s wine represents a domestic attempt to duplicate the foreign product. *Id.*

Similarly, in *Bureau National Interprofessional Du Cognac v. International Better Drinks Corp.*, 6 U.S.P.Q.2d 1610 (TTAB 1988), this Board held that the applicant’s mark, COLAGNAC, which also is *not* a descriptive term, is nevertheless deceptive and unregistrable under Section 2(a). Once again, moreover, the rationale for the Board’s decision closely parallels the Opposition’s allegations here concerning DECA-DURABOLIN:

[W]e conclude that purchasers who encounter applicant’s cola liqueur bearing the mark “COLAGNAC” are likely to believe that the mark is a misspelling of “COGNAC” or a combination of the terms “Cola” and “COGNAC” and hence that applicant’s product contains “COGNAC” brandy, i.e., brandy made from wines produced from grapes grown in the Cognac region of France in accordance with French law and regulations, when in fact applicant’s product contains not “COGNAC” brandy but rather a Spanish brandy. In view thereof, and since there can be no doubt (because of the renown of “COGNAC” brandy) as to the materiality of the deception to the purchasing decision, we are of the opinion that applicant’s mark, as applied to its goods, is

deceptive within the meaning of Section 2(a) of the Act. Id. at 1616 (footnote omitted).

In view of this Board's decisions with respect to the non-descriptive ESSENSIA and COLAGNAC marks, Applicant's contention that a non-descriptive mark can not be deceptive under Section 2(a), or deceptively misdescriptive under Section 2(e)(1), is clearly without merit.¹

C. The Opposition States A Claim That Applicant's Mark Falsely Suggests A Connection Under Section 2(a).

As the Board stated in *Buffett v. Chi-Chi's, Inc.*, 226 U.S.P.Q. 428, 429 (TTAB 1985), a plaintiff asserting a false connection claim under Section 2(a) must demonstrate:

- “(i) that the defendant's mark is the same or a close approximation of plaintiff's previously used name or identity;
- (ii) that the mark would be recognized as such;
- (iii) that the plaintiff is not connected with the activities performed by the defendant under the mark; and
- (iv) that the plaintiff's name or identity is of sufficient fame or reputation that when the defendant's mark is used on its goods or services, a connection with the plaintiff would be presumed.”

The Opposition here includes allegations that meet all four of these requirements, including the allegations:

- that, as a result of Opposer's use of the marks DECA-DURABOLIN and DURABOLIN for prescription injectable anabolic steroid products for 50 years in over 50 countries worldwide, including the United States for nearly 50 years, “the DURABOLIN and

¹ It bears noting that, although both of these marks had geographic connotations, in neither case was the refusal to register based on a claim that the mark was a “geographical indication” under Section 2(a) or was “primarily geographically deceptively misdescriptive” under Section 2(e)(3). Rather, as noted above, ESSENSIA was refused registration on the ground that it is “deceptively misdescriptive” under Section 2(e)(1), and COLAGNAC was refused registration on the ground that it is “deceptive” under Section 2(a).

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” (§ 2-6);

- that “the DURABOLIN and DECA-DURABOLIN marks are closely identified with Opposer” (§ 14);
- that, “upon information and belief, Applicant selected the DECA-DURABOLIN mark in order to benefit from the goodwill associated with Opposer’s [DECA-DURABOLIN and DURABOLIN] marks and with the intent to deceive, mislead and confuse consumers by causing them to believe, erroneously, that ... a connection exists between its DECA-DURABOLIN products and Opposer” (§ 19);
- that “Applicant’s DECA-DURABOLIN trademark, if registered and used in conjunction with ‘dietary and nutritional supplements,’ is likely to deceive consumers ... into believing, erroneously, that a connection exists between Applicant’s goods and Opposer” (§ 20);
- that “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 an anabolic dietary and nutritional supplement 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 (§ 22);

- that any belief that Opposer is in any way connected with Applicant's DECA-DURABOLIN product is "erroneous" and "mistaken" (¶¶ 19, 20, 22); and
- that 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 matter that falsely suggests a connection with Opposer" (¶ 25).

Applicant's motion contends that these allegations are not sufficient for several reasons, none of which has merit. First, applicant contends that they are insufficient because there is no allegation that Opposer has ever used DECA-DURABOLIN as its name and no allegation that DECA-DURABOLIN points uniquely to Opposer. Applicant argues that the first and second prongs of the false connection test therefore have not been met. Motion at 5-6.

The first prong is satisfied, however, if Applicant's DECA-DURABOLIN mark "is the same as or a close approximation of [Opposer's] previously used name *or identity*," and the second prong is met if it "would be recognized as such." *Buffett*, 226 U.S.P.Q. at 429 (Emphasis added). The Opposition repeatedly alleges that, as a result of Opposer's worldwide use of DECA-DURABOLIN, including use in the United States for nearly 50 years, the DECA-DURABOLIN mark is "closely identified with" Opposer (¶¶ 6, 14, 22) and that Applicant's registration and use of DECA-DURABOLIN therefore will cause consumers to believe, erroneously, that Applicant's goods are connected with Opposer (¶¶ 19, 20, 22, 25).

As is shown by the *Buffett* case itself, such allegations are more than sufficient to satisfy the first, second, and also the fourth prong of the test. In that case, singer Jimmy Buffett opposed a restaurant's application to register the mark MARGARITAVILLE on the ground that it suggested a false connection with him under Section 2(a), based on his having written and

recorded the song entitled MARGARITAVILLE. Buffett, of course, did not claim that he had ever used MARAGARITAVILLE as his name. Rather, in response to the restaurant's motion for summary judgment as to the Section 2(a) claim, he submitted evidence purporting to show that he is so "closely associated" with the song MARGARITAVILLE that it has become a part of his identity. Because of this evidence, the Board rejected the restaurant's motion for summary judgment, finding that:

Such evidence is sufficient to raise a genuine issue of material fact as to whether the term "MARGARITAVILLE" is so uniquely and unmistakably associated with opposer as to constitute opposer's name or identity such that when applicant's mark is used in connection with its services, a connection with opposer would be assumed.

Id. at 430.

Surely, if evidence purporting to show that Buffett is "closely associated" with the name MARGARITAVILLE is sufficient to defeat a motion for summary judgment claiming that it does not constitute his identity, then it follows *à fortiori* that, at the pleadings stage, repeated allegations that the mark DECA-DURABOLIN is "closely identified with Opposer" are sufficient to defeat a motion to dismiss, particularly since the Opposition also alleges (¶ 19) that "Applicant selected the DECA-DURABOLIN mark ... *with the intent* to deceive, mislead and confuse consumers by causing them to believe, erroneously, that ... a connection exists between its DECA-DURABOLIN products and Opposer." (Emphasis added). As the Federal Circuit pointed out in *The University of Notre Dame v. J.C. Food Imports*, 703 F.2d 1372, 217 U.S.P.Q. 505 (Fed. Cir. 1983), "evidence of such intent would be highly persuasive that the public will make the intended false association." 217 U.S.P.Q. at 509.²

² Like its decision in *Buffett*, the Board's decision in *Bridgestone/Firestone Research, Inc. v. Automobile Club De L'Ouest De La France*, 1999 WL 556573 (TTAB 1999), *rev'd on other* (continued...)

Applicant's second argument -- that the Opposition does not allege that its DECA-DURABOLIN identity is of sufficient fame or reputation to satisfy the fourth prong of the test (Motion at 6) -- also fails. As the Board stated in *In re White*, 73 U.S.P.Q.2d 1713, 1720 (TTAB 2004), "the inquiry here is not focused on determining whether the ... name would qualify as famous under traditional likelihood of confusion analysis or as famous under evolving dilution analysis. Indeed, the *Notre Dame* case does not explicitly state that a name must be famous to be protected under Section 2(a)." *See also Association pour la Defense et la Promotion de L'Oeuvre de Marc Chagall dite Comite Marc Chagall v. Bondarchuk*, 82 U.S.P.Q.2d 1838, 1843 (TTAB 2007) ("In fact, the requirement which applies here is one of 'a fame or reputation' (emphasis in the original) rather than a strict fame requirement which may apply with respect to other grounds for opposition or cancellation").

Contrary to Applicant's sarcastic contention that the Opposition's allegations of widespread use and registrations of DECA-DURABOLIN in more than 50 foreign countries for over 50 years are irrelevant (Motion at 2-3, 5), it is established that "evidence of fame or reputation in other countries may have relevance to the extent that consumers in the United States would be aware of [opposer] as a result of these activities". *Hornby v. TJJX Companies Inc.*, 87 U.S.P.Q.2d 1411, 1416 (TTAB 2008).

grounds, 245 F.3d 1359 (Fed. Cir. 2001), also shows that, although a term has never been used by a plaintiff as its name, it may be so closely identified with the plaintiff, as is alleged with respect to DECA-DURABOLIN here, that it points uniquely to the plaintiff for purposes of a false suggestion of connection claim under Section 2(a). In that case the Board found that, although the plaintiff Automobile Club had never used the term LE MANS as its name, the evidence showed that "the term LE MANS pointed uniquely and unmistakably to the Automobile Club" (1999 WL at *8), and the Board therefore cancelled Bridgestone's registration of LEMANS for tires on the ground that it falsely suggests a connection with the Automobile Club, in violation of Section 2(a).

The Opposition's allegations of use of DECA-DURABOLIN in the United States for nearly 50 years (§ 6), together with its allegations of use in foreign countries (§§ 5-6), and its repeated allegations that, as a result of such use, DECA-DURABOLIN is "closely identified with Opposer" (§§ 6, 14, 22) are more than sufficient to allege fame or reputation under the above standards applicable to a Section 2(a) claim.

Finally, Applicant's assertion that "Opposer must establish proprietary rights in its name or identity which are allegedly prior to the applicant's proprietary rights" (Motion at 4) is simply an incorrect statement of the applicable law.³ As Professor McCarthy has pointed out, under Section 2(a), "the person or institution need not have IP rights in its name.... Even if a celebrity's trademark rights were abandoned by non-use as a trademark for goods, that person can still prevail under 2(a) if the registered mark falsely suggests a connection with the person."

³ McCarthy on Trademarks § 19:76 at 19-240. *See also Buffett, supra*, 226 U.S.P.Q. at 429 ("Thus, an opposer in a proceeding of this character [under Section 2(a)] may prevail even if the name claimed to be appropriated has never been commercially exploited by the opposer in a trademark or trademark analogous manner").

Further, although the Opposition here does not claim prior *proprietary* rights, it does claim that "Opposer adopted and used its DURABOLIN and DECA-DURABOLIN marks well before Applicant filed its application for the mark DECA-DURABOLIN, and [Opposer]


³ Applicant cites two cases in support of this statement (Motion at 4). The first, *In re Kayser-Roth Corp.*, 29 U.S.P.Q.2d 1379, 1383 (TTAB 1993), does not make any such statement or otherwise support Applicant's assertion. The second, *Kardex Systems, Inc. v. Sistemco N.V.*, 221 U.S.P.Q. 149, 151 (TTAB 1983), relies on the holding in *Morehouse Manufacturing Corp. v. J. Strickland & Co.*, 160 U.S.P.Q. 715 (CCPA 1969), that "in order to prevail under Section 2(a), a plaintiff must show ... the same likelihood of confusion as under Section 2(d)." The *Morehouse* decision was effectively overruled, however, by the Federal Circuit's decision in the *Notre Dame* case. *See* 217 U.S.P.Q. at 508-509. *Morehouse* and *Kardex* are thus no longer good law to the extent that they held that the plaintiff must have proprietary rights in its mark and show a likelihood of confusion in order to prevail under Section 2(a).

therefore has priority over Applicant with respect to a DURABOLIN and DECA-DURABOLIN mark” (¶ 13).

III. CONCLUSION

For the foregoing reasons, Applicant’s Motion To Dismiss For Failure To State A Claim should be denied.⁴

Respectfully submitted,

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⁴ In the unexpected event that the Board should sustain the motion with respect to any of Opposer’s asserted claims, Opposer respectfully requests that the Board grant Opposer leave to file an amended opposition pursuant to TBMP § 503.03 (“If no amended complaint is submitted in response to a motion to dismiss for failure to state a claim upon which relief can be granted, and the Board finds, upon determination of the motion, that the complaint fails to state a claim upon which relief can be granted, the Board generally will allow the plaintiff an opportunity to file an amended pleading.”)

Application Serial No. 85340058
Mark: DECA-DURABOLIN
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MSD OSS B.V.)	
)	
Opposer,)	
)	
v.)	Opposition No. 91205081
)	
DYNAMIC SPORTS NUTRITION, LLC,)	
)	
Applicant.)	

CERTIFICATE OF SERVICE

I hereby certify that the attached Opposer's Brief In Opposition To Motion To Dismiss was served by first class mail, postage prepaid, this 28th day of June, 2012 on the following:

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