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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**

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

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

**APPLICANT'S REPLY TO OPPOSER'S RESPONSE TO APPLICANT'S MOTION TO
DISMISS FOR FAILURE TO STATE A CLAIM**

Pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure and TBMP §503, Applicant DYNAMIC SPORTS NUTRITION, LLC ("Applicant") filed, through its undersigned attorneys, a Motion to Dismiss the Notice of Opposition filed by Opposer MSD OSS B.V. ("Opposer") for failure to state a claim upon which relief can be granted as to all three of Opposer's claims. At this time, Applicant submits its Reply to Opposer's Response to the Motion to Dismiss for Failure to State a Claim.

In support of this Motion, Applicant states as follows:

I. **BACKGROUND**

On June 28, 2012, Opposer filed its Brief in Opposition to Applicant's Motion to Dismiss Opposer's Notice of Opposition. *See* [Opposer's Brief]. As discussed further below, a valid ground for denying the registration sought by Applicant has not been established. For these reasons, the Board should grant Applicant's Motion to Dismiss for Failure to State a Claim and dismiss with prejudice the present Opposition proceeding in due course.

II. ARGUMENTS

A. Opposer Has Failed to State a Claim of Deceptiveness Under Section 2(a) and a Claim of Deceptive Misdescriptiveness Under Section 2(e)(1).

In the present case, Opposer has not established, 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 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). The term "DECA-DURABOLIN" is a fanciful word that in no way describes the character, quality, function, composition, or use of the goods "dietary and nutritional supplements." Opposer even concedes that "DECA-DURABOLIN[] is *not* a descriptive term . . ." See [Opposer's Brief at 9] (emphasis in original). Opposer then unsuccessfully attempts to justify its inability to fulfill the descriptive requirement by citing two cases as evidence that the common law interpretation of the Lanham Act does not actually require a deceptive or deceptively misdescriptive mark to be descriptive in order to be misdescriptive of the character, quality, function, composition, or use of the goods. See [Opposer's Brief at 9-11].

Opposer incorrectly cites *In re Quady Winery* as evidence that a deceptively misdescriptive mark need not be descriptive. See [Opposer's Brief at 9-10]; see also *In re Quady Winery, Inc.*, 221 USPQ 1213 (TTAB 1984). In the *In re Quady Winery* case, the TTAB issued a two page ruling affirming the Examining Attorney's refusal to register the mark "ESSENSIA" for wine under Section

2(e)(1) of the Lanham Act. *Id.* Without any additional reasoning, Opposer then concludes that "ESSENSIA, like DECA-DURABOLIN, is *not* a descriptive term . . ." *See* [Opposer's Brief at 9] (emphasis in original). Opposer fails to cite any authority for this proposition because *In re Quady Winery* is wholly devoid of any conclusion that "ESSENSIA" (also spelled "ESSENCIA") is not descriptive. At first glance, Opposer's conclusion is disingenuous merely because the case appears silent on the issue of whether "ESSENSIA" is a descriptive term. Upon further examination, however, one may note that the Examining Attorney implicitly determined that "ESSENSIA" is a descriptive term by making "record of five references from wine information books that ma[d]e it clear that 'ESSENSIA' refers to a rare type of Hungarian Tokay wine." *In re Quady Winery, Inc.*, 221 USPQ at 1213. Thus, Opposer dramatically overstates the importance of *In re Quady Winery* and incorrectly cites the case as eliminating the descriptive element requirement that a mark be "misdescriptive of the character, quality, function, composition, or use of the goods." *See* Lanham Act § 2(e)(1); *see, e.g., In re Quady Winery*, 221 USPQ 1213 (emphasis added).

Opposer also incorrectly cites *Better Drinks Corp.* as evidence that a deceptively misdescriptive mark need not be descriptive. *See* [Opposer's Brief at 10-11]; *see also Bureau National Interprofessional Du Cognac v. International Better Drinks Corp.*, 6 USPQ2d 1610 (TTAB 1988). In that case, the mark "COLAGNAC" was refused registration for use on "liqueur." *Id.* In the United States, "the designation 'COGNAC brandy' may be used only on brandy entitled to bear the designation under French law". *See id.* at 1612 (espousing that brandy may only be called "COGNAC" "if it comes from certain defined geographic areas surrounding the French town of Cognac, and only if it meets certain other requirements . . ."). Opposer is correct in noting that the mark "COLAGNAC" is not technically a descriptive mark. However, Opposer fails to recognize that

in the *Better Drinks Corp.* case, the TTAB framed the issue by quoting the Commissioner from a previous opposition involving the term "CALOGNAC" as follows:

It seems to me the only question requiring determination is whether it appears reasonably likely that people seeing the name "Cognac" on brandy will believe the brandy to be cognac; in other words whether "Cognac" will be reasonably likely to impress purchasers and the public as merely a corruption or a mere misspelling of the word "cognac" and to mean nothing else but cognac either descriptively or geographically or both; . . .

Id. at 1615 (quoting 54 USPQ 268, 269 (1942)) (emphasis added). While the Commissioner in the "CALOGNAC" opposition answered this question in the negative, the Court of Customs and Patent Appeals ultimately agreed with the Opposer that "CALOGNAC" is a "mere obvious corruption of 'Cal. Cognac,' and that it is unregisterable as being descriptive or misdescriptive as applied to domestic brandy." *Id.* (emphasis added). Thus, while the mark "COLAGNAC" was not technically descriptive, it was an obvious corruption of the descriptive term "COGNAC", which made the mark descriptive or misdescriptive when applied to the goods at issue. *Id.* In stark contrast, in the present opposition, Opposer has already conceded that the mark "DECA-DURABOLIN" is not descriptive. *See* [Opposer's Brief at 9]. Moreover, the fanciful mark "DECA-DURABOLIN" is not a corruption of any descriptive term, and Opposer has not alleged that "DECA-DURABOLIN" is a corruption of any descriptive term. Therefore, Opposer's citation to *Better Drinks Corp.* as evidence that a deceptively misdescriptive mark need not be descriptive is both incorrect and inapposite to the current case.

Opposer unpersuasively contends that the law does not require a deceptive or deceptively misdescriptive mark to be descriptive in order to be "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*, 221 USPQ 1213 (emphasis added). *A fortiori*, the cases proffered by Opposer as purportedly supporting this proposition are, at best, inapposite and, at worst, wholly unsupported by the record. As a result, the Opposer's allegations of deceptiveness and deceptive misdescriptiveness pled in the Notice of Opposition fail all the prongs of the relevant tests to determine whether a mark is deceptive or deceptively misdescriptive and should, accordingly, be dismissed.

B. Opposer Has Failed to State a Claim of False Suggestion of a Connection.

Opposer's reliance on the *Buffett* case to alter the requirement that "applicant's mark is the same as, or a close approximation of, the opposer's previously used name or identity" is misplaced. *See, e.g., University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372 (Fed. Cir. 1983) (emphasis added). Opposer does not allege that Opposer has ever been identified as "DURABOLIN" or "DECA-DURABOLIN". Opposer then cites *Buffett* as authority for the proposition that the common law standard merely requires that the applicant's mark is "closely identified with Opposer," as opposed to referring to Opposer's name or identity. *See* [Opposer's Brief at 13]. *See also 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.*

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 admitted that the mark has been abandoned. *See* [Notice of Opposition at 2] (explaining that "Opposer does not currently sell prescription injectable steroid products under the DURABOLIN and DECA-DURABOLIN marks in the United States"). Moreover, Opposer has not claimed in the Notice of Opposition that MSD OSS B.V. has sought to associate the term "DECA-DURABOLIN" with its public persona. 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".

Opposer also fails to properly plead the requisite "proprietary rights in its name or identity which are allegedly prior to the applicant's proprietary rights." Jeffery A. Handelman, *Guide to TTAB Practice* at 8-31 (2011 Supplement). Opposer postulates that this requirement is "simply an incorrect statement of the applicable law." *See* [Opposer's Brief at 16]. Applicant respectfully disagrees with Opposer's conclusion, Opposer's insinuation that Applicant simply fabricated this requirement out of whole cloth, and Opposer's interpretation of the law. In reality, *In re MC* illuminates how the TTAB recently utilized the proprietary rights requirement to dismiss the Examiner's false suggestion of a connection refusal issued against the mark "MARIA CALLAS". *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)". In that factually analogous case, 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 remained 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.*

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)). With this in mind, Opposer correctly cites Professor McCarthy for the proposition that under Section 2(a) a "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 a person." *See* [Opposer's Brief at 16] (quoting 3 McCarthy on Trademarks § 19:76 at 19-240). However, Opposer fails to concede that this secondary authority does not eliminate the proprietary rights requirement. Instead of eliminating the proprietary rights requirement, Professor McCarthy simply clarifies that proprietary rights in the name are not limited to only intellectual property rights. Proprietary rights encompass intellectual property rights, but proprietary rights remain a broader set of rights. Opposer is unpersuasive in

asserting that it need not plead its prior proprietary rights in its name or identity in order to prevail on a claim of false suggestion of a connection.

Opposer fails to plead that Applicant's mark is the same as, or a close approximation of, Opposer's previously used name or identity. As such, Opposer's allegation of false suggestion of a connection in the Notice of Opposition fails the first two prongs of the relevant test. In addition, Opposer has not adequately pled its prior proprietary rights in its purported name or identity. Therefore, Opposer has not properly pled the claim of false suggestion of a connection and the claim should be dismissed.

III. CONCLUSION

For the foregoing reasons, it is evident that Opposer has not alleged facts that would, if proved, establish that it is entitled to the relief sought in any of its claims. *See* TMEP §503.02. For these reasons, Applicant respectfully requests that the Board grant Applicant's Motion to Dismiss for Failure to State a Claim, that judgment is entered against Opposer and that this opposition proceeding is dismissed with prejudice.

Respectfully submitted,

July 12, 2012
Date

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CERTIFICATE OF SERVICE

I hereby certify that Applicant's Reply to Opposer's Reseponse to Applicant's Motion to Dismiss for Failure to State a Claim is being sent by first class mail on July 12, 2012 to the attorney of record for Opposer at the following address:

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