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

Proceeding	91211515
Party	Defendant Despharma Kft.
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Date	09/19/2013
Attachments	Answer to DERMARAL opposition.pdf(1063529 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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INSIGHT PHARMACEUTICALS, LLC,	:
	:
Opposer,	:
	:
v.	: Opposition No. 91211515
	:
DESPHARMA KFT.,	: Serial No. 85/527,113
	:
Applicant.	:

ANSWER TO NOTICE OF OPPOSITION

Applicant, Despharma Kft., by its attorneys, hereby submits its Answer to the Notice of Opposition filed by Insight Pharmaceuticals, LLC in opposition to Application Serial No. 85/527,113, for the trademark DERMARAL, as follows:

1. Opposer is the owner of U.S. Trademark Registration No. 3,626,182 and 4,261,139 for DERMAREST for "non-medicated skin care preparations, namely moisturizing scar removing lotions and stretch mark repair" in Class 03 and "medicated hair care preparations, namely medicated shampoo, medicated hair conditioners; medicated skin care preparations, namely medicated skin moisturizers, medicated scalp moisturizers, and medicated body lotions, all for the treatment of eczema or psoriasis; dermatological preparations for balancing skin tones and reducing the redness associated with rosacea in International Class 05" with a first use in commerce date of January 31, 2000 (the "'182 and "'139" Registrations").

ANSWER: Applicant is without sufficient knowledge to admit or deny the allegations of paragraph 1, and therefore denies the same.

2. The '182 and '139 Registrations are valid and subsisting and remain in full force and effect as evidence of the validity of Opposer's exclusive right to own and use the mark at issue in connection with the goods specified in the Registrations.

ANSWER: Applicant is without sufficient knowledge to admit or deny the allegations of paragraph 2, and therefore denies the same.

3. Since at least as early as January 31, 2000, Opposer and its predecessor in interest have used the DERMAREST trademark in connection with products, sales of products, and advertising and promotion of products throughout the United States. These products include non-medicated skin care preparations and medicated hair, skin care, dermatological and body lotion preparations, including preparations for the treatment of eczema or psoriasis.

ANSWER: Applicant is without sufficient knowledge to admit or deny the allegations of paragraph 3, and therefore denies the same.

4. As a result of the investment of significant resources and effort over time, Opposer's DERMAREST trademark has become distinctive. Consumers have come to know, rely on, and recognize it as an indication of a high-quality pharmaceutical product. Thus, Opposer enjoys valuable good will in the DERMAREST mark.

ANSWER: Applicant is without sufficient knowledge to admit or deny the allegations of paragraph 4, and therefore denies the same.

5. Opposer's DERMAREST trademark has become famous pursuant to 15 U.S.C. §1125.

ANSWER: Applicant denies the allegations of paragraph 5.

6. Applicant's application for registration of DERMARAL, Serial No. 85/627,113[sic], includes "cosmetics" in International Class 003, "pharmaceutical preparations for skin disorders; veterinary preparations for skin disorders; sanitary preparations for medical purposes; plasters for medical purposes, disinfectants for sanitary purposes, namely, disinfectants for skin infections and wound disinfection" in International Class 05, and "skin care medical devices, namely, medical devices acting by biophysical, mechanical and thermal means

for treating skin disorders" in International Class 10.

ANSWER: Applicant admits that the DERMARAL application, Serial No. 85/527,113, covers "Cosmetics" in International Class 3, "Pharmaceutical preparations for skin disorders; veterinary preparations for skin disorders; sanitary preparations for medical purposes; plasters for medical purposes, disinfectants for sanitary purposes, namely, disinfectants for skin infections and wound disinfection" in International Class 05, and "Skin care medical devices, namely, medical devices acting by biophysical, mechanical and thermal means for treating skin disorders" in International Class 10. Except as specifically admitted, Applicant denies each and every remaining allegation of paragraph 6.

7. Applicant's Mark is very similar to Opposer's DERMAREST trademark in appearance and commercial impression, in that it contains the word "DERMA-" followed by a single syllable beginning with the letter "R". Both marks cover goods in International Classes 03 and 05.

ANSWER: Applicant denies the allegations of paragraph 7.

8. Opposer asserts that Applicant's use of DERMARAL will likely cause confusion, mistake, or deception in the minds of consumers as to the source or origin of goods sold under either the DERMAREST or DERMARAL marks, in violation of Section 2(d) of the Lanham Act. Persons familiar with Opposer's DERMAREST trademark would be likely to purchase Applicant's goods believing them to be new forms of the well-known products of Opposer. This assertion is reinforced by the fact that Applicant's goods are being advertised for use in treatment of skin disorder. Although the application does not specify a specific skin disorder, Opposer has reason to believe ingredients found in DERMARAL "preparations for skin disorders" are sometimes used to treat the "eczema or psoriasis" skin disorders specified in its DERMAREST registrations.

ANSWER: Applicant denies the allegations of paragraph 8.

10.[sic] If Applicant is permitted to register the DERMARAL mark, any defect or deficiency found with Applicant's goods marketed under Applicant's mark would reflect negatively upon and seriously injure the reputation of Opposer's goods.

ANSWER: Applicant denies the allegations of paragraph 10.

11.[sic] Applicant's use of DERMARAL is also likely to dilute the distinctive quality of Opposer's DERMAREST trademark.

ANSWER: Applicant denies the allegations of paragraph 11.

12.[sic] If Applicant is granted the registration for DERMARAL herein opposed, it would thereby obtain a *prima facie* exclusive right to the use of its mark. Such registration would be a source of considerable damage and injury to Opposer.

ANSWER: Applicant denies the allegations of paragraph 12.

AFFIRMATIVE DEFENSES

1. Applicant's mark, DERMARAL, is not similar in appearance, sound, connotation, or commercial impression when compared in its entirety to Opposer's pleaded marks.

2. The goods covered by Application Serial No. 85/527,113 are not competitive with Opposer's pleaded goods.

3. Applicant's goods and Opposer's pleaded goods are sold to different classes of consumers.

4. Applicant's goods and Opposer's pleaded goods are marketed through different channels of trade.

5. Applicant's DERMARAL mark is not likely to be confused with Opposer's

pleaded marks.

6. Third parties have used marks similar to Opposer's pleaded marks for similar goods.

7. Opposer's pleaded DERMAREST marks are not famous as that term is defined in Section 43(c)(2) of the Lanham Act, as amended.

8. Opposer has not adequately pleaded a claim for dilution under Section 43 of the Lanham Act, as amended, and its claim for dilution should be stricken.

WHEREFORE, Applicant denies that Opposer is entitled to the relief to which it prays for in the Notice of Opposition. Applicant respectfully requests that the Notice of Opposition be dismissed with prejudice.

Respectfully submitted,

DESPHARMA KFT.

Date: September 19, 2013

By: Kathryn Garipay

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **ANSWER TO NOTICE OF OPPOSITION** was served by mailing a copy of the same by First Class Mail, postage prepaid to:

Micheline Kelly Johnson
BAKER, DONELSON, BEARMAN, CALDWELL
& BERKOWITZ, P.C.
1800 Republic Centre
633 Chestnut Street
Chattanooga, Tennessee 37450

on this 19th day of September, 2013.

Kathryn E. Garipay