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

Proceeding	91218833
Party	Defendant Fuenmayor, Ricardo A.
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Submission	Motion to Amend Application
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Date	11/18/2014
Attachments	Motion to Amend Registration.pdf(1847107 bytes) BRIEF to Amend Mark Registration.pdf(268183 bytes)

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

Application No. 86157681/ **THORUS** mark

Publication date 09/16/2014

Opposition Period Ends 10/16/2014

Applicant: Fuenmayor, Ricardo A.

6318 23 Ave.

Brooklyn, NY 11204

Motion to Amend Mark Registration

In view of the fact that the registration of the mark *Thorus* is involved in an inter partes proceeding before the Trademark Trial and Appeal Board (Opposition No. 91218833, Serial No. 86157681, introduced by *Horus Pharma* on 10/15/2014), and considering that one of the ways of reaching a settlement between parties prior to trial would be to limit the scope of goods, the applicant would like to kindly request the Board to consider the amending of the identification of goods of the mark *Thorus* in its application and requesting the consent to judgment on the question of likelihood of confusion between the parties' marks and the narrower identification of goods. The applicant is making such a request since such an amendment to identification may be permitted if made before trial, since it serves to limit the scope of goods. Thus, pursuant of Trademark Act § 7(e), the applicant would like to kindly request the Director, that for good cause, may permit this application to be amended, in view of the fact that the amendment does not alter materially the character of the mark. Likewise, the registration as amended still contains registrable matter, and the mark as amended is still registrable as a whole.

Next is a submission of the current description of Goods and Services as filled in the application, followed by the proposed amendment showing the proposed changes using ~~strikethrough~~ or cross-out text, and finally a clean copy of the proposed amendment in *italic style* text.

Current Description of Goods and Services

Class 010. First Use: 0 First Use In Commerce: 0

Beautifying devices, namely, surgical and medical implant devices comprised of artificial materials for use in cosmetic surgery for the stretching of the user's face, skin, thus minimizing his/her wrinkles, for the specific purpose of obtaining a younger look; medical devices, namely, surgical implant devices comprised primarily of artificial materials for use in plastic surgery as cosmetic devices for improving appearance.

Proposed Amendment of Goods ~~and Services~~

Class 010. First Use: 0 First Use In Commerce: 0

~~Beautifying devices, namely,~~ surgical and medical implant devices comprised of artificial materials for use in cosmetic surgery for the stretching of the user face's ~~,~~ skin, ~~thus minimizing his/her wrinkles,~~ for the specific purpose of obtaining a younger look; ~~medical devices, namely, surgical implant devices comprised primarily of artificial materials for use in plastic surgery as cosmetic devices for improving appearance~~

Clean copy of the proposed amended goods, limiting the goods to avoid a likelihood of confusion

Class 010. First Use: 0 First Use In Commerce:

Surgical and medical implant devices comprised of artificial materials for use in cosmetic surgery for the stretching of the user face's skin for the specific purpose of obtaining a younger look.

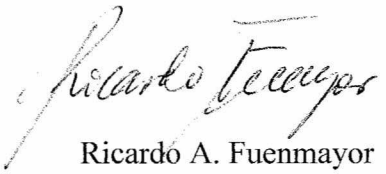
Pursuant of 37 CFR § 2.71 (a), the applicant is requesting to amend the application to clarify or limit the identification of goods. The proposed amendment only limits the identification of the goods of the mark *Thorus,* the purpose of such amendment being to overcome a likelihood of confusion with the goods or services offered by the registered mark *Horus Pharma.* The proposed changes in the *Thorus* application, thus producing a narrower mark definition of goods, are the result of the intention of promoting a non-judicial settlement of the current dispute, and as an offer of compromise, by modifying the goods by using a strategic, narrow, and precise goods description for the mark *Thorus,* that should overcome a likelihood of confusion as to source. Applicant is aware that, as per 514.01, the requested amendment of this application, being the subject of an inter partes proceeding before the Board, is governed by 37 CFR § 2.133, and as a result, may not be amended in substance.

Ricardo A. Fuenmayor
Defendant/Applicant

Declaration

in lieu of oath, as per § 2.20

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.



Ricardo A. Fuenmayor
Defendant/Applicant

Certificate of Service

I hereby certify that a true and complete copy of the foregoing *Motion to Amend Mark Registration* has been served on Opposer's Legal Representative: G MATHEW LOMBARD (LOMBARD & GELIEBTER LLP, 1115 BROADWAY12 FL NEW YORK, NY 10010, UNITED STATES, mlombard@lgtrademark.com), by e-mailing said copy on November 18, 2014, via electronic mail to: mlombard@lgtrademark.com

/Ricardo Fuenmayor/

Ricardo A. Fuenmayor
Defendant / Applicant

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

Application No. 86157681/ **THORUS** mark

Publication date 09/16/2014

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6318 23 Ave.

Brooklyn, NY 11204

BRIEF

in Support of

a

Motion to Amend Mark Registration

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DESCRIPTION of RECORD

On January 5, 2014, Applicant filed Application Serial No. 86157681, for registration on the Principal Register of the trademark ***Thorus***, based on § 1(b) intent-to-use.

Applicant: FUENMAYOR, RICARDO A. (6318 23RD AVE BROOKLYN, NY 11204-3305) fuenmayor.ricardo@gmail.com

The goods covered by Application Serial No. 86157681 currently are: *beautifying devices, namely, surgical and medical implant devices comprised of artificial materials for use in cosmetic surgery for the stretching of the user's face skin, thus minimizing his/her wrinkles, for the specific purpose of obtaining a younger look; medical devices, namely, surgical implant devices comprised primarily of artificial materials for use in plastic surgery as cosmetic devices for improving appearance* in Class 10.

A notice of opposition was filed on 10/15/2014, by *Horus Pharma*. Opposer believes that it will be damaged by registration of the mark *Thorus*. The opposition can be seen at http://ttabvue.uspto.gov/ttabvue/v?qs=91218833. Opposer is the owner of the U.S. trademark Application Serial No. 79128753 for the mark *Horus Pharma* for:

> *Soaps for personal use; essential oils; cosmetics; hair lotions; dentifrices* in Class 3;
>
> *Pharmaceutical and veterinary products and preparations for the treatment of ophthalmological and dermatological diseases; pharmaceutical and veterinary products and preparations for the treatment of allergies, glaucoma, inflammation, infections, viral diseases and conditions, keratoconjunctivitis sicca, dry eyes, and dermatological diseases and conditions; pharmaceutical and veterinary products and preparations for the promotion of ocular wound healing; chemical preparations for medical or*

pharmaceutical use, namely, chemical preparations for treatment of diseases, disorders and conditions of the eye and the skin; ophthalmic substances for medical use; food for babies; food and nutritional supplements for humans and animals for medical use; ophthalmic food, namely, dietary and nutritional supplements for eye and skin health and nutritional supplements for medical use; medical plasters, materials for dressings, namely, medical dressing; disinfectants, namely, all-purpose disinfectants; fungicides; solutions for contact lens care; eye drops for lubricating and moisturizing compositions and substances intended to relieve dryness and mild irritations of the eye; eye solutions for medical use, namely, irrigating, lubricating, rewetting and antibiotic solutions for eye care; eye washes; sanitary products for use in medicine, namely, sanitary preparations for medical use; sanitary preparations for medical ophthalmic use; creams, gels and lotions for ophthalmic use for medical use; cleansing medicinal creams, gels and lotions for soothing and decongesting the eyes and eye contours for medical use; eye solutions for medical use, namely, irrigating, lubricating, rewetting and antibiotic solutions for eye care; compresses for medical use, namely, surgical and medicated compresses; cotton for medical use; medicated bath preparations in Class 5;

Contact lenses; pupillometers for measuring pupillary distance and eye position in the spectacle frame by digital capture of corneal reflections and for measuring lens/eye distance not for medical use; video pupillometers for measuring papillary distance and eye position in the spectacle frame by digital capture of corneal reflections and for measuring lens/eye distance not for medical use in Class 9; and

Surgical apparatus and instruments; medical and veterinary apparatus and instruments for use in eye surgery, ophthalmic surgery; medical and veterinary apparatus and

instruments, namely, pupillometers; apparatus and instruments for ophthalmology, namely, surgical apparatus and instruments for use in ophthalmic surgery, instruments for measuring the diameter of ophthalmic lenses, instruments for measuring the optical density of the macular pigment, instruments for measuring, recording and monitoring intraocular pressure, instruments for measuring and recording pupillary reactivity and pupillary distance, and instruments for dyeing and removing vitreous bodies and epiretinal membranes during vitrectomies; artificial limbs and eyes; ocular implants made from artificial materials; orthopedic articles, namely, ocular implants made of artificial materials, ocular and ophthalmic inserts for medical or surgical use, namely, intraocular implants made of artificial materials, inserts for ocular and intraocular use, namely, intraocular implants made of artificial materials; suture materials in Class 10.

Goods/Services Affected by Opposition

Class 010. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Beautifying devices, namely, surgical and medical implant devices comprised of artificial materials for use in cosmetic surgery for the stretching of the user's face skin, thus minimizing his/her wrinkles, for the specific purpose of obtaining a younger look; medical devices, namely, surgical implant devices comprised primarily of artificial materials for use in plastic surgery as cosmetic devices for improving appearance.

Grounds for Opposition

Priority and likelihood of confusion. Trademark Act section 2(d).

Word Mark: *Horus Pharma*

Design Mark:

Description of Mark: The mark consists of a blue circle under a curved orange line, against a black horizontal line below which is a thick vertical orange line level with the circle and a black curved line; to the right is the word "HORUS" over the word "PHARMA" all in black; the color white represents background, shading, and/or outlining and is not claimed as a feature of the mark.

STATEMENT of the ISSUES

Next is an extensive list of a number of misconceptions and erroneous beliefs, listed in the opposition, derived, the applicant believes, from an inappropriate interpretation of *Thorus'* goods (italicized text is meant to highlight the issues surrounding the goods):

1. Opposer states that "based on information and belief, Applicant's *products*, as identified in Application Serial No. 86157681 are *identical to, substantially identical to, related to, or similar* to Opposer's goods, namely, products in Classes 3, 5 and/or 10" (Point 15), and since opposer markets and sells corticosteroid products; eye compresses for treatment of skin surrounding the eye; creams and lotions to treat atopic dermatitis, blepharitis and similar conditions; and eye compresses for eye hygiene and eye surgery (Point 16), they believe that "Applicant's application covers *devices for dermatological use, for use **on** user's faces and skin*" (Point 17); the Opposer also concludes that "there is significant market overlap and interface between Opposer and Applicant"; such misinterpretation of *Thorus'* definition of goods is reiterated in Point 24 when they affirm that "Applicant's applied-for *goods* in Class 10 are *identical, similar and/or closely related*", and once again, in Point 25, arguing that "Opposer's pleaded goods in Classes 3, 5 and 10, and Applicant's applied-for *goods* in Class 10 would target the same class of purchasers".
2. Opposer continues emphasizing the *similarities of goods* by stating in Point 26 that "Applicant's appropriation of Opposer's mark for Class 10 *goods* would cause confusion, mistake or deception among the relevant consumers", and in Point 27, arguing that since "Opposer's pleaded goods in Classes 3, 5 and 10, and Applicant's applied-for *goods* in

Class 10 are *closely related* and would be sold and/or promoted through the same channels of trade to the same class(es) of purchasers and users".

3. In Point 32, the Opposer affirms that "the use by Applicant of its mark for the applied-for *goods* is likely to create the erroneous impression that Applicant's *goods* originate with, are sponsored or promoted by, come from, or are otherwise associated with Opposer or Opposer's goods provided under its *Horus Pharma* mark or that *Applicant's goods* are endorsed, sponsored, or in some way connected with Opposer"; this belief is re-affirmed in Point 33, where the Opposer states that "any use of Applicant's mark by the Applicant is, therefore, likely to cause confusion, cause mistake or to deceive the public into the belief that the *products* offered under Applicant's mark come from or are otherwise authorized or sponsored by Opposer in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d)."

ARGUMENT

As background: the proposed name *Thorus* is a meaningless made-up name (it is not registered in any dictionary, it is not found when the word *Thorus* is searched in Google, and is not found in the TEAS database), meant to be used as a Corporative name whose sole purpose will be the manufacturing, distribution, marketing and selling of an invention of the Applicant, the "Instant Face-Lifter" US Patent 8,282.684, which now possesses a NOA: *Facylift*, Serial No. 86157743, which, in very basic terms, consists of an under-the-scalp silicone implant: looked from the side, it is a crescent moon-shaped round piece of solid medical-grade silicone which when implanted under the scalp, makes a 50 year-old user look younger. It is not a Class 003 nor a Class 005 device, but one belonging to the Class 010, which is a class with a very broad scope of dissimilar devices. It is not the Applicant's intention to selling neither ophthalmological devices or any type of medicines for the eyes, nor *any* of the devices, goods and/or services that *Horus Pharma* describes for its Class 010.

Opposer states that "based on information and belief, Applicant's *products,* as identified in Application Serial No. 86157681 are *identical to, substantially identical to, related to, or similar* to Opposer's goods, namely, products in Classes 3, 5 and/or 10" (Point 15). Not so. The purpose of *Thorus* company will be to produce and sell solely the *Facylift*, a product so unique that it was granted a US patent. Thus, *Thorus'* product (not product**s**) is not either identical, nor related nor similar to *any* of the goods marketed by *Horus Pharma*. The *Facylift* is not a Class 003 nor a Class 005 device, but one belonging to the Class 010, which is a class with a very broad scope of dissimilar devices.

Since Opposer markets and sells corticosteroid products; eye compresses for treatment of skin surrounding the eye; creams and lotions to treat atopic dermatitis, blepharitis and similar conditions; and eye compresses for eye hygiene and eye surgery (Point 16), Opposer believes (-*wrongly*-) that "Applicant's application covers *devices for dermatological use, for use* ***on*** *user's faces and skin*" (Point 17): This is definitely not the case, since *Thorus* is meant to be a corporative name for the manufacturing, distribution, marketing and sale of solely a single product: a patented silicone implant to be used ***under*** the scalp, the *Facylift*. Furthermore, the *Facylift* is not a device for dermatological use, but merely a device to be implanted under the scalp for the purpose of getting a younger look. Applicant has no intentions of selling neither ophthalmological devices nor any type of medicines for the eyes, nor *any* of the devices, goods and/or services described for *Horus Pharma* Class 010.

Opposer also (–*wrongly*-) concludes that "there is significant *market overlap* and *interface* between Opposer and Applicant"; such misinterpretation of *Thorus'* definition of goods is reiterated in Point 24 when they affirm that "Applicant's applied-for *goods* in Class 10 are *identical, similar and/or closely related*", and once again, in Point 25, arguing that "Opposer's pleaded goods in Classes 3, 5 and 10, and Applicant's applied-for *goods* in Class 10 would target the same class of purchasers": Wrong! *Thorus* goods (the *Facylift*) is to be marketed solely to Baby Boomers who want to look younger, being the *Facylift* an alternative to a cosmetic surgery. The *Facylift* is not related in any way (nor conceptually, structurally, by design or by use) to any of *Horus Pharma* goods and services.

Opposer continues emphasizing the *similarities of goods* by stating in Point 26 that "Applicant's appropriation of Opposer's mark for Class 10 *goods* would cause confusion, mistake or deception among the relevant consumers", and in Point 27, arguing that since "Opposer's pleaded goods in Classes 3, 5 and 10, and Applicant's applied-for *goods* in Class 10 are *closely related* and would be sold and/or promoted through the same channels of trade to the same class(es) of purchasers and users": Applicant's sole product, the *Facylift,* is only closely related to other silicone implants: silicone ear implants and silicone chin implants, and belonging to such a specialized niche of the market, it could only be found in plastic surgery clinics and the like. Furthermore, the *Facylift* is not related in any way to *any* of the goods and services marketed or produced by *Horus Pharma*.

In Point 32, the Opposer affirms that "the use by Applicant of its mark for the applied-for *goods* is likely to create the erroneous impression that Applicant's *goods* originate with, are sponsored or promoted by, come from, or are otherwise associated with Opposer or Opposer's goods provided under its *Horus Pharma* mark or that *Applicant's goods* are endorsed, sponsored, or in some way connected with Opposer"; this belief is re-affirmed in Point 33, where the Opposer states that "any use of Applicant's mark by the Applicant is, therefore, likely to cause confusion, cause mistake or to deceive the public into the belief that the *products* offered under Applicant's mark come from or are otherwise authorized or sponsored by Opposer in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d)." Points 32 and 33, even though they deal with both parties' goods and their alleged similarities, both points also deal with a likelihood of confusion determination, the marks being compared for similarities in their appearance, sound, meaning or connotation and commercial impression.

The alleged *appearance* between the marks *Horus* and *Thorus* is akin to comparing totally dissimilar English words: “hen” from “then”, “his” from “this”, “hat” from “that”, “hank” from “thank”, “hem” from “them”, ”hatch” from “thatch”, “heft” from “theft”, “high” from “thigh”, “horn” from “thorn” and many many more such duets, whereby a “new word” with an altogether new meaning has been manufactured by adding a new vowel or consonant thus enriching the English language since time immemorial.

The *sound* of both words are phonetically different: The “*Tho*…” sound is phonetically different from the one coming from the use of a silent “h”, like in “*Ho*…”. In the *Thorus* case, the tongue is raised and placed behind and under the upper teeth to produce the “*Th*” sound which begins with a hissing sound produced by pushing the air in an explosive manner, followed by the pronunciation of the vowel. In the case of *Horus*, the pronunciation of the word begins with the rounding of the lips to produce the “O” sound (being the “h” silent in this case). Thus, there is no possibility of confusion in this regard.

There is also no likelihood of confusion in their *meaning*: whereas *Horus* represents a deity (the God of Kings in ancient Egypt, and one Egypt’s best known gods, as well as one of the oldest), *Thorus* is a bastardization (to modify, especially by introducing discordant or disparate elements) of the name of the Zodiac sign Taurus (“Toro” in Spanish). Strictly, *Thorus* is a made-up word which does not exist in any present modern language.

Regarding the *commercial impression*, the plaintiff has obtained a trademark which is a unitary phrase ("*Horus Pharma*"), which, as a whole, has "some degree of ingenuity in its phraseology as used in connection with the goods; or [say] something a little different from what might be expected to be said about the product; or [say] an expected thing in an unexpected way." *Ex parte Mooresville Mills, Inc.*, 102 USPQ 440, 441. Thus implying that the emblematic Eye of Horus (ergo, anything related to the "eyes") is related to Pharma (thus becoming "a pharmaceutical company which sells ophthalmological products"). In this regard, the name *Thorus* –a meaningless word- is totally unrelated from the point of view of commercial impression to *Horus Pharma*, a unitary phrase. Even more so, "*Horus Pharma*" is a word and *(eye)* design mark, "*Thorus*" is merely a mark. Furthermore, the fact that the plaintiff's mark is a phrase, each word contained within having a meaning of their own, markedly differentiates it from the applicant's mark: a single meaningless word bearing no mark. The recollection of the average purchaser upon seeing the unitary phrase united to a universally well-known (Egyptian) eye mark, as compared to a word that has no meaning in the English language, would recreate dissimilar overall commercial impressions of each.

SUMMARY

Applicant is requesting the Board to consider the amending of the identification of goods of the mark *Thorus* in its application as well as requesting the consent to judgment on the question of likelihood of confusion between the parties' marks and the narrower identification of goods. This motion is being presented to the Board in order to facilitate a satisfactory settlement prior to trial, in view of the fact that, concluding from the reasoning of the opposition papers, people at *Horus Pharma* were aroused by the scope of *Thorus'* Goods (very likely due to a misinterpretation of the true nature of *Thorus'* sole good, the *Facylift*). The defendant, not recognizing any fault in the scope of the claimed goods, but desirous of facilitating a satisfactory settlement, is willing to amend the identification of goods in the involved application, to a strategic, narrow and precise goods description thus overcoming a likelihood of confusion as to source, as per § 2.173 (a).