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

Proceeding	91220096
Party	Defendant Morales Caro, Luis R.
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Attachments	ANSWER TO OPPOSITION 91220096.pdf(108476 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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<p>SmithKline Beecham Limited,</p> <p style="text-align: center;">Opposer,</p> <p style="text-align: center;">v.</p> <p>Morales Caro, Luis R.,</p> <p style="text-align: center;">Applicant.</p>	<p>Mark: SANADOL</p> <p>Serial No.: 86/244,742</p> <p>Opposition No.: 91220096</p>
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ANSWER TO “NOTICE OF OPPOSITION”

TO THE HONORABLE TRADEMARK TRIAL AND APPEAL BOARD:

COMES NOW Applicant, Luis R. Morales Caro (hereinafter “Applicant”), through its undersigned attorney and respectfully states and prays the following regarding the SmithKline Beecham Limited’s (hereinafter “Opposer” and “SKB”) Notice of Opposition:

In response to the opening un-numbered paragraph of the Opposition, Applicant admits upon information supplied by Opposer and belief, that SmithKline Beecham Limited is a company organized under the laws of England and Wales with offices located at 980 Great West Road, Brentford, Middlesex TW8 9GS, United Kingdom. Applicant denies that SKB is or will be damaged by the registration of the mark SANADOL shown in U.S. Application Serial No. 86/244,742, filed on April 7, 2014 in International Class 005 for Topical analgesic preparations for the treatment of muscular aches and pains (hereinafter “Applicant’s Mark”).

In response to the numbered paragraphs of the Opposition, Applicant states as follows:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 1 of the Opposition and therefore, cannot deny or admit the same. To the extent a response is needed, Applicant denies the allegations made in paragraph 1.

2. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the remaining allegations set forth in Paragraph 2 of the Opposition, and therefore cannot deny or admit the same. To the extent a response is needed, Applicant denies the allegations made in paragraph 2.

3. Applicant denies the allegations in Paragraph 3 of the Opposition as drafted. Applicant admits that SKB appears in the U.S. Patent and Trademark Office database as the last listed owner of record for some registrations for marks incorporating the term "PANADOL".

4. The allegations made in paragraph 4 of the Opposition are legal conclusions and therefore, do not require a response from Applicant. To the extent a response is needed, Applicant denies the allegations made in paragraph 4.

5. Applicant denies that PANADOL is an inherently distinctive mark. In addition, Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of whether PANADOL is a term that has no meaning, and thus, that it is a fanciful and coined term, and therefore cannot deny or admit said allegations in paragraph 5. To the extent a response is needed, Applicant denies the same.

6. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 6 of the Notice of Opposition,

and therefore cannot deny or admit the same. To the extent a response is needed, Applicant denies the allegations made in paragraph 6.

7. Applicant denies that PANADOL is an inherently distinctive mark. As to the remaining allegations, Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations regarding the use, sales, advertising and promotion of the PANADOL mark by Opposer, its predecessors-in-interest and/or affiliated companies, and therefore cannot admit or deny the same. To the extent a response is needed, Applicant denies the allegations made in paragraph 7.

8. Applicant denies the allegations in Paragraph 8 of the Notice of Opposition as drafted. Applicant admits that Luis Morales Caro has applied to register the mark SANADOL for “Topical analgesic preparations for the treatment of muscular aches and pains” in International Class 005, as set forth in application serial no. 86244742 and denies the rest. Applicant denies the rest of the allegations in paragraph 8 of the Notice of Opposition.

9. Applicant denies the allegations in Paragraph 9 of the Notice of Opposition.

10. Applicant denies the allegations in Paragraph 10 of the Notice of Opposition. Applicant further avers that SANADOL has a different commercial impression, sound and appearance than PANADOL.

11. Applicant denies the allegations in Paragraph 11 of the Notice of Opposition.

12. Applicant denies the allegations in Paragraph 12 of the Notice of Opposition. Applicant further avers that the marks are **not** similar; that no likelihood of confusion exists between them; that consumers and patients will readily distinguish the marks from one another; and that that consumers and patients are **not** likely to think that the goods offered under the different marks are sponsored by, authorized by, licensed by, affiliated

with, or related to the PANADOL marks, goods sold under the PANADOL marks, or any person or company that may sell or offer goods under said marks.

13. Applicant denies the allegations in Paragraph 13 of the Notice of Opposition. Applicant further avers that the SANADOL mark will **not** cause any kind of confusion, mistake or deception as to the origin, source, sponsorship or affiliation of Applicant's goods.

14. Applicant denies the allegations in Paragraph 14 of the Notice of Opposition. Applicant further avers that the SANADOL mark does **not** resemble the PANADOL marks, and that it will **not** cause any kind of confusion, mistake or deception with PANADOL.

15. Applicant denies the allegations in Paragraph 15 of the Notice of Opposition as drafted.

16. The Applicant denies the allegations in Paragraph 16 of the Notice of Opposition as drafted. Applicant admits that Puerto Rico is one of the territories where it intends to use the applied-for mark and that in Puerto Rico a substantial number of consumers speak Spanish.

17. Applicant denies the allegations made in paragraph 17 of the Opposition. Applicant further avers that the term SANADOL is **not** equivalent to the Spanish term "sanador". Moreover, the term SANADOL does **not** exist in the English or Spanish dictionary. It is a fanciful term exclusively conceived and coined by Applicant for the identification of its products. The term SANADOL is an invented term that resulted from the combination of two words and thus, cannot be, in any way, a descriptive term. Applicant further avers that since the term does not exist in the English or Spanish language, Opposer does not need, and will never need said term in connection with the

promotion, advertisement and/or marketing of its goods or business.

18. Applicant denies the allegations in Paragraph 18 of the Notice of Opposition. Applicant further avers that the term SANADOL is **not** equivalent to the Spanish word “sanador”. Applicant denies that SANADOL is merely descriptive of the goods identified with the mark. As previously stated, SANADOL is a coined and fanciful term that does not exist in the English or Spanish dictionary; thus, Applicant’s SANADOL is an inherently distinctive trademark and is in no way descriptive of Applicant’s goods.

AFFIRMATIVE DEFENSES

In further answer to Opposer’s Notice of Opposition, Applicant asserts the following affirmative defenses:

1. The Opposition fails to state a claim upon which relief can be granted, and in particular, fails to state legally sufficient grounds for sustaining the Opposition.
2. Applicant’s mark is inherently distinctive and thus, registrable and protectable under Trademark Law.
3. Applicant’s mark when applied to the goods identified in U.S. Application Serial Nos. 86/244,742 is **not** likely to cause any confusion, mistake or deception with the PANADOL marks.
4. Applicant’s mark in U.S. Application Serial No. 86/244,742 creates different overall commercial impressions including different sound and appearance than the PANADOL marks.
5. Applicant’s mark in U.S. Application Serial No. 86/244,742; is for different prospective customers than the PANADOL marks.
6. The consuming public will not make any association between Applicant’s mark and the PANADOL marks.

7. Applicant's mark in U.S. Application Serial No. 86/244,742 will be marketed through different channels of trade than those of the PANADOL marks.
8. Applicant's mark in U.S. Application Serial No. 86/244,742 and the PANADOL marks are for different goods.
9. Applicant's mark in U.S. Application Serial No. 86/244,742 has no relationship with the PANADOL marks advertisement.
10. Upon information and belief, Opposer obtained its interest in the PANADOL marks by way of an invalid transfer among predecessors in interest; or such assignments were assignments in gross.
11. Applicant's mark, when analyzed as a whole, is sufficiently distinctively different from the PANADOL marks as to avoid confusion, deception or mistake as to the source of sponsorship of, or association with the PANADOL marks and goods.
12. No likelihood of confusion exists between Applicant's mark and the PANADOL marks.
13. There is no likelihood of confusion, mistake or deception because Applicant's mark is not confusingly similar to any of the pleaded PANADOL marks.
14. Applicant's use of its mark will not mistakenly be thought by the public to derive from the same source as Opposer's goods, nor will such use be thought by the public to be a use by Opposer or with Opposer's authorization, sponsorship or approval.
15. The Trademark Examining Attorney assigned to *Applicant's* trademark application concluded that there were no similar registered or pending marks, including the PANADOL marks, that would bar registration of *Applicant's* mark. Accordingly, Opposer has failed to establish that likelihood of confusion exists

between the parties' marks and that *Applicant's* mark is likely to cause confusion, mistake, or to deceive the public as to an association with the PANADOL marks.

16. The trademarks at issue contain different literal elements.

17. The trademarks at issue contain different designs.

18. Opposer is not entitled to maintain its Opposition by reason of estoppel.

19. The Opposition is barred by the equitable doctrine of waiver.

20. There is no evidence of actual confusion between the PANADOL marks and Applicant's mark.

21. Opposer maliciously filed the instant action in an attempt to monopolize or restrain trade and in order to harass a legitimate competitor.

Applicant reserves the right to amend or include additional affirmative defenses as the proceedings in this case, particularly as the discovery of evidence, progress.

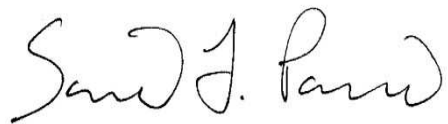
WHEREFORE, in light of the foregoing, Applicant contends that this Opposition is groundless and baseless in fact; that Opposer has not shown wherein it will be, or is likely to be, damaged by the registration of Applicant's trademark; that Applicant's trademark is manifestly distinct from any alleged mark of the Opposer or any designation of the Opposer; and Applicant prays that this Opposition be dismissed with prejudice and that Applicant be granted registration of its trademark **SANADOL**, U.S. Application Serial No. 86/244,742.

RESPECTFULLY SUBMITTED

On this 16th day of March 2015.

IT IS HEREBY CERTIFIED THAT on this date a true and correct copy of this “Applicant’s Answer to Notice of Opposition” was served by first class mail, postage prepaid, upon the Opposer’s representative: Paul C. Llewellyn, Kaye Scholer LLP 250 West 55th Street New York, NY 10019-9710 and to the emails: paul.llewellyn@kayescholer.com, tmcketing@kayescholer.com, and john.rynkiewicz@kayescholer.com.

On this 16th day of March 2015.



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