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

Proceeding	91220096
Party	Plaintiff SmithKline Beecham Limited
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Date	09/22/2015
Attachments	Motion to Amend Notice of Opp - SANADOL.pdf(16123 bytes) Exhibit A to Motion.pdf(20279 bytes)

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

SMITHKLINE BEECHAM LIMITED,[1] Opposer, v. LUIS R. MORALES CARO, Applicant.	Opposition No. 91220096 Mark: SANADOL Serial No: 86244742

MOTION AND INCORPORATED MEMORANDUM OF LAW
IN SUPPORT OF MOTION TO AMEND NOTICE OF OPPOSITION

Pursuant to Rules 15(a), Fed. R. Civ. P., Trademark Rule 2.107, and Trademark Board Manual of Procedure §§ 507.02, Opposer moves to amend its notice of opposition to add as an additional ground for opposition that Applicant, at the time it filed its application, did not have a bona fide intent to use the mark SANADOL in interstate commerce, as reflected in the signed copy of the proposed amended notice of opposition attached as Exhibit A hereto. Opposer has requested that Applicant consent to this proposed amendment, but Applicant has declined to do so.

In addition to substituting the new owner of Opposer's marks for the initial Opposer (see footnote 1 below), the proposed First Amended Notice of Opposition adds one ground for relief, as follows:

[1] On September 21, 2015, Opposer filed a motion on consent to substitute GlaxoSmithKline Consumer Healthcare (UK) IP Limited ("GSK CH") for the original Opposer, SmithKline Beecham Limited. That motion to substitute remains pending. GSK CH joins in the relief requested in the instant motion, and the proposed First Amended Notice of Opposition substitutes GSK CH for SmithKline Beecham Limited.

19. On information and belief, at the time that Applicant filed the Subject Application, Applicant did not have a *bona fide* intent to use the applied-for mark SANADOL in United States commerce within the meaning of 15 U.S.C. § 1051(b). To Opposer's knowledge, Applicant has made, and at the time the Subject Application was filed had made, no preparations or arrangements to use the mark in commerce. Accordingly, the Subject Application is void *ab initio*.

ARGUMENT

It is settled that leave to amend pleadings in Board proceedings "shall be freely given when justice requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties." TBMP § 507.02; *see Fioravanti v. Fioravanti Corrado S.R.L.*, 230 U.S.P.Q. 36, 39 (T.T.A.B. 1986) ("We have interpreted this rule liberally to permit amendments which plead claims other than those stated in the original opposition...."); *Montblanc-Simplo GmbH v. United Brands Int'l, Inc.*, No. 91185637 (T.T.A.B. 2009) (non-precedential) (granting motion to amend to add an additional ground for opposition that applicant lacked a bona fide intent to use the mark MONT BLANC in commerce for the described goods); *Diageo North Am., Inc. v. Captain Russell Corp.*, No. 91203745 (T.T.A.B. 2013) (non-precedential) (granting motion to amend to add assertion of a lack of bona fide intent).

Here, there is no reason to deny Opposer's motion to amend. First, it cannot be disputed that ground for opposition added to the notice of opposition – that Applicant did not have a *bona fide* intent to use the applied-for mark at the time that his application was filed – states a claim for relief. *See, e.g., M.Z. Berger & Co., Inc. v. Swatch AG*, No. 14-1219, slip op. at 11 (Fed. Cir. June 4, 2015), affirming *Swatch AG v. M.Z. Berger & Co.*, 108 U.S.P.Q. 2d 1463 (T.T.A.B.

2013); *Research In Motion Ltd. v. NBOR Corp.*, 92 U.S.P.Q. 2d 1926, 1931 (T.T.A.B. 2009) (application void *ab initio* when an applicant files an intent-to-use application without a *bona fide* intent to use the mark in commerce on the goods or with the services set forth in the application as of the filing date).

Second, Opposer's motion is timely: It is made during the course of discovery, as it has become apparent that Applicant has no documents reflecting preparations to use the applied-for mark.

Third, there is no basis for Applicant to claim prejudice as a result of the proposed amendment: The new ground for opposition relates solely to evidence within the control of Applicant (an individual), discovery is ongoing, and, in all events, Applicant would not need to conduct additional discovery regarding the added ground. *See Metromedia Steakhouses Inc. v. Pondco II Inc.*, 28 U.S.P.Q. 2d 1205, 1207-08 (T.T.A.B. 1993) (no prejudice where non-moving party would not need to conduct additional discovery); *Diageo North Am.*, No. 91203745, at 4 (granting motion to amend to add assertion of a lack of bona fide intent; non-moving party was in possession of the relevant evidence). Indeed, in refusing to consent to the instant motion, counsel for Applicant did not identify any prejudice at all that Applicant would suffer as a result of the proposed amendment.

CONCLUSION

In view of the foregoing, Opposer respectfully requests that the Board grant it leave to amend the Notice of Opposition, in the form attached as Exhibit A hereto, to allege that the subject application is void *ab initio* because Applicant did not have a bona fide intent to use the applied-for marks in commerce on the goods claimed in the applications as of the application's filing date.

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CERTIFICATE OF SERVICE

This is to certify that on this 22nd day of September, I caused a copy of the foregoing MOTION AND INCORPORATED MEMORANDUM OF LAW IN SUPPORT OF MOTION TO AMEND NOTICE OF OPPOSITION to be served by first-class mail, postage prepaid, on the attorneys of record for Applicant, namely:

Samuel F. Pamias, Esq.
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San Juan, Puerto Rico 00918

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

GLAXOSMITHKLINE CONSUMER HEALTHCARE (UK) IP LIMITED, Opposer, v. LUIS R. MORALES CARO, Applicant.	Opposition No. 91220096 Mark: SANADOL Serial No: 86244742 Filed: April 7, 2014 Published: July 15, 2014

FIRST AMENDED NOTICE OF OPPOSITION

Opposer GlaxoSmithKline Consumer Healthcare (UK) IP Limited ("GSK" or "Opposer"), a private limited company organized under the laws of England and Wales with offices located and doing business at 980 Great West Road, Brentford, Middlesex TW8 9GS, United Kingdom, believes that it will be damaged by the registration of the mark SANADOL set forth in Application Serial No. 86244742, and hereby opposes the same.

As grounds for opposition, GSK alleges that:

1. GSK is a member of the GlaxoSmithKline group of companies, a global group of healthcare companies that researches, develops, manufactures and sells a broad range of pharmaceutical, vaccine and consumer healthcare products.

2. GSK is the owner of the PANADOL mark, and it and its predecessors-in-interest and affiliated companies have used the mark in commerce on analgesic pharmaceutical preparations continuously since at least May 6, 1976.

3. GSK is the owner of U.S. Trademark Registration No. 1,060,597 on the Principal Register for the PANADOL mark covering "analgesic preparation" in International Class 5, as

well as three other U.S. trademark registrations (Nos. 4,408,281; 2,125,323; and 2,123,421) that comprise the term PANADOL and that cover analgesic preparations (all of the foregoing GSK registrations, collectively, the "PANADOL Registrations").

4. The PANADOL Registrations are valid and subsisting and GSK hereby gives notice in accordance with Trademark Rule of Practice 2.122(d)(2) that it will rely thereon as evidence in this proceeding, and status copies thereof showing present title will be introduced into evidence on its behalf during GSK's testimony period.

5. The PANADOL mark is inherently distinctive; it is a fanciful and coined term with no meaning other than to identify GSK's products.

6. Since PANADOL products were introduced in 1976, GSK and its predecessors-in-interest and affiliated companies have spent substantial time, effort and money to promote the sale of the products in commerce under the PANADOL mark.

7. By virtue of the substantial use, sales, advertising, and promotion of the PANADOL mark in commerce by GSK and its predecessors-in-interest and affiliated companies, and the inherently distinctive nature of the mark, the PANADOL mark has become a well-known mark and has become distinctive of GSK's products.

8. Despite GSK's long prior common law and statutory rights in the PANADOL mark, and long after GSK and its predecessors-in-interest established rights in and to the PANADOL mark, and with at least constructive notice of GSK's federal trademark registrations, Luis R. Morales Caro ("Applicant") has applied to register the mark SANADOL for "[t]opical analgesic preparations for the treatment of muscular aches and pains" in International Class 5, as set forth in Application Serial No. 86244742 (the "Subject Application").

9. GSK's mark has priority over Applicant's mark because the filing date of GSK's first trademark application covering PANADOL was July 22, 1976, and the date of first use in commerce was May 6, 1976, many years prior to the priority date of the Subject Application.

10. Applicant's SANADOL mark is substantially or highly similar to the PANADOL mark in sound, appearance and commercial impression.

11. The goods set forth in the Subject Application are legally identical to the goods for which GSK's PANADOL mark is registered and used. On information and belief, the goods covered by the Subject Application would be sold and distributed through the same channels of trade and in the same geographic areas.

12. As a result, if Applicant begins using the mark SANADOL in commerce in conjunction with the goods set forth in the Subject Application, in light of the similarity of the SANADOL and PANADOL marks and the identical nature of the parties' respective goods, channels of trade and target patient populations (among other reasons), many consumers, patients and others who encounter Applicant's mark are likely to think that the goods offered under the SANADOL mark, or the company that offers Applicant's products, is authorized by, sponsored by, licensed by, affiliated with, related to or the same as the company that offers GSK's PANADOL products, or that the SANADOL and PANADOL products are the same or are otherwise related.

13. Accordingly, Applicant's SANADOL mark, if used in conjunction with the goods set forth in the Subject Application, is likely to cause confusion, mistake, or to deceive as to the origin, source, sponsorship or affiliation of Applicant's goods.

14. Applicant's SANADOL mark so resembles GSK's previously used and registered PANADOL mark as to be likely, when applied to the goods set forth in the Subject Application, to cause confusion, mistake or deception within the meaning of 15 U.S.C. § 1052(d).

15. GSK previously has used in commerce, in connection with analgesic preparations, the trademark PANADOL, such that PANADOL became a name or identity of substantial reputation that is closely identified with GSK. Applicant's applied-for mark SANADOL is a close approximation of GSK's previously used and registered PANADOL mark, so as to be likely, when applied to the goods set forth in the Subject Application, to point uniquely to GSK and to falsely suggest a connection with the GSK within the meaning of 15 U.S.C. § 1052(a).

16. Applicant has asserted that it intends to use its proposed SANADOL mark in Puerto Rico, where a substantial number of consumers speak Spanish.

17. On further information and belief, the term SANADOL is virtually equivalent in some Spanish pronunciations to the term "sanador," which is a Spanish word that means, *inter alia,* "sanatory, therapeutic, having curative properties, promoting healing," and which is a word that GSK or its affiliated companies may wish to use in the future in connection with the promotion and marketing of pharmaceutical or related products.

18. Given the equivalence of SANADOL to "sanador," and in light of the meaning of the Spanish term "sanador," Applicant's proposed mark, when used on or in connection with the goods identified in the Subject Application, would be merely descriptive of such goods. Accordingly, the Subject Application should be denied pursuant to 15 U.S.C. §1052(e).

19. On information and belief, at the time that Applicant filed the Subject Application, Applicant did not have a *bona fide* intent to use the applied-for mark SANADOL in United States commerce within the meaning of 15 U.S.C. § 1051(b). To Opposer's knowledge,

Applicant has made, and at the time the Subject Application was filed had made, no preparations or arrangements to use the mark in commerce. Accordingly, the Subject Application is void *ab initio*.

WHEREFORE, for all of the foregoing reasons and for such other reasons as the Board determines are appropriate, Opposer respectfully prays that this Opposition be sustained and that the Subject Application be refused.

The Patent and Trademark Office and Trademark Trial and Appeal Board are hereby authorized to collect any fees necessitated by this Notice of Opposition from the deposit account of Opposer's attorneys, Kaye Scholer LLP, Deposit Account No. 11-0228.

Dated: September 22, 2015

Respectfully submitted,

/Paul C. Llewellyn/

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Attorneys for Opposer
GlaxoSmithKline Consumer Healthcare (UK) IP Limited

CERTIFICATE OF SERVICE

I certify that the foregoing First Amended Notice of Opposition is being electronically filed with the United States Patent and Trademark Office on September 22, 2015, and that I caused a true and correct copy of the foregoing to be served by email and by first-class mail, postage prepaid, on the attorneys of record for Applicant, namely:

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