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

Proceeding	91224462
Party	Plaintiff FNC Medical Corporation
Correspondence Address	JEFFREY L VAN HOOSEAR KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET, 14TH FLOOR IRVINE, CA 92614 UNITED STATES efiling@knobbe.com
Submission	Opposition/Response to Motion
Filer's Name	JEFFREY L. VAN HOOSEAR
Filer's e-mail	efiling@knobbe.com
Signature	/JVH/
Date	03/10/2017
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

FNC Medical Corporation, Opposer, v. Genomma Lab Internacional, S.A.B. de C.V., Applicant.	Opposition No. 91224462 Mark: DiabetTX Serial No. 86/521,466

RESPONSE TO APPLICANT'S MOTION TO DISMISS

On February 21, 2017, Applicant filed a motion to dismiss Opposer FNC Medical Corporation's Notice of Opposition pursuant to Fed. R. Civ. P. 12(b). Pursuant to Fed. R. Civ. P. 15(a) and T.B.M.P. §§ 503.03 and 507.02, Opposer responds to Applicant's motion by opposing such motion and by filing an Amended Notice of Opposition filed herewith.

While Opposer has filed an Amended Notice of Opposition to expedite resolution of this issue, Opposer notes that its original Notice of Opposition clearly alleges sufficient facts to state a claim for relief.

I. Legal Standard

"To survive a motion to dismiss, a complaint must contain sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its face.'" *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009). Specifically, in the context of an opposition "to withstand a motion to dismiss, petitioner need only allege such facts which, if proved, would establish that petitioner is

entitled to the relief sought; that is, (1) petitioner has standing to bring the proceeding, and (2) a valid statutory ground exists for [denying] the registration." *Corporacion Habanos, S.A. v. Rodriguez*, 99 U.S.P.Q.2d 1873, 2011 T.T.A.B. LEXIS 258, at *3 (T.T.A.B. Aug. 1, 2011); T.B.M.P. § 503.02. This standard is satisfied when the petitioner alleges enough factual matter to suggest its claim is plausible and raises a right to relief above the speculative level. *Corporacion Habanos*, 2011 T.T.A.B. LEXIS 258, at *3-4 (citing *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 555-556 (2007)). In addressing a motion to dismiss for failure to state a claim, all of the petitioner's well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to the petitioner. *Id.*

a. The Notice of Opposition Sufficiently Pleads Opposer's Standing

To satisfy standing, Opposer need only plead sufficient facts to show a "real interest: and a "reasonable basis" for its belief that it would suffer damages if the mark is registered. *Ritchie v. Simpson,* 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). The standard for determining standing before the Board is § 13 of the Lanham Act, which provides:

> Any person who believes that he would be damaged by the registration of a mark upon the principal register may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office. . .

Id. Accordingly, "[s]tanding requires only that the petitioner have a 'real interest' in the cancellation [or opposition] proceeding." *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1161 (Fed. Cir. 2002).

Applicant cannot dispute that the Notice of Opposition meets this standard. Opposer's federal registrations for its DIABET-X mark are *prima facie* evidence of Opposer's exclusive right to use the mark in commerce in connection with the goods identified in the registration. Lanham Act §33(a), 33(b), 15 U.S.C.A. §§1115a, 1115b. Moreover, Opposer's Notice of

Opposition alleges that Opposer has used its DIABET-X mark on personal care products, including "anti-microbial body cream for diabetic patients; anti-fungal cream for diabetic patients" and "medicated personal hygiene and health care products for diabetic patients, namely, hand cream, shampoo, hair rinse, hair conditioners and body wash" since at least as early as 1997. Notice of Opposition at 2. The Notice of Opposition alleges that the Applicant seeks registration for the mark 

for "body creams and lotions." Notice of Opposition at 1. Opposer's Notice of Opposition alleges that Opposer's mark and Applicant's mark are similar. Notice of Opposition at 3. Thus, Opposer reasonably alleges that Applicant's registration of a similar mark is likely to cause confusion with Opposer's mark. *See Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 U.S.P.Q. 2d (BNA)1066, 2011 WL 810221, at *6 (Trademark Tr. & App. Bd. Feb. 25, 2011) (holding opposer established its standing in the proceeding through its pleaded registrations, for several marks that include a term also included in applicant's mark). Accordingly, Opposer's Notice of Opposition properly alleges that Opposer has a real interest in this proceeding, and therefore, Opposer has standing to bring this Opposition.

b. <u>The Notice of Opposition sufficiently pleads a claim for dilution</u>

To plead dilution Opposer must show that 1) Opposer owns a famous mark; 2) the Applicant's use of its mark began after Opposer's mark became famous; and 3) the Applicant's use of its mark is likely to cause dilution. *Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1723–24 (Fed. Cir. 2012). Applicant contends that Opposer has failed to meet this standard because "the words 'fame' and 'famous'" are not included in the

original Notice of Opposition. Motion to Dismiss at 4. However, Opposer's Notice of Opposition, sufficiently pleads facts to support a claim of dilution.

Opposer's Notice of Opposition alleges that Opposer is the owner of two incontestable registrations for the mark DIABET-X, that Opposer has used the mark since at least as early as 1997 – for 20 years – and that through substantial advertising, promotion, and sales, Opposer's mark has acquired extensive goodwill and consumer recognition prior to the filing of Applicant's Application, and that Applicant's use is likely to cause dilution. Notice of Opposition at 2-3. Through Opposer's allegations of long standing (20 years) and widespread use that predates Applicant's Application, and the extensive consumer recognition of Opposer's mark, Opposer's Notice of Opposition sufficiently alleges the fame of Opposer's mark.

Applicant contends that very few trademarks meet the "rigorous standard" of fame. Motion to Dismiss at 4. However, Opposer does not need to prove its claim at the notice stage, but only allege facts sufficient to state said claim, and therefore Applicant's Motion should be denied. *See* T.B.M.P. § 503.02 ("Whether a plaintiff can actually prove its allegations is a matter to be determined not upon motion to dismiss, but rather at a final hearing or upon summary judgment, after the parties have had an opportunity to submit evidence in support of their respective positions.").

c. <u>The Notice of Opposition Sufficiently Pleads Likelihood of Confusion</u>

There are two elements to a claim of likelihood of confusion under Section 2(d) of the Trademark Act: priority and likelihood of confusion. *See Baseball Am., Inc. v. Powerplay Sports Ltd.*, 71 U.S.P.Q.2d 1844, 1848 (T.T.A.B. 2004) (identifying priority and likelihood of confusion as the two elements of a Section 2(d) ground for opposition). As set forth in the Notice of Opposition, and Opposer's asserted federal registrations, Opposer has used its DIABET-X Mark

since at least as early as 1997. Applicant has filed an intent-to-use application for the disputed  mark and does not allege priority of use. Thus, Opposer has satisfied the priority element.

Opposer's Notice of Opposition also sets forth plausible facts to satisfy the issue of likelihood of confusion, namely that Applicant's mark so resembles Opposer's previously used and registered Mark as to be likely to cause confusion under Trademark Act Section 2(d), 15. U.S.C. § 1052(d). Notice of Opposition at 1-3. Particularly, the Notice of Opposition alleges that Applicant seeks registration of Applicant's Mark for "body creams and lotions," that Opposer's registrations cover "anti-microbial body cream," and that since at least as early as 1997 Opposer has been using the DIABET-X mark in connection with various personal care products in Class 5. Notice of Opposition at 2. Applicant argues that Opposer must draw a comparison between Applicant's goods and the goods recited in Opposer's mark. Motion to Dismiss at 5. However, as stated above, Opposer does not need to prove its claim in its notice, but merely allege facts sufficient in its notice to state a claim. Opposer's Notice of Opposition alleges that the two marks are similar, and alleges Opposer's prior rights to the mark DIABET-X for personal care products. Notice of Opposition at 2 and 3. Opposer does not need to prove the goods are related to state a valid claim for relief. *See* T.B.M.P. § 503.02. Accordingly, Opposer has properly pled its claim for likelihood of confusion.

II. Opposer's Amended Notice of Opposition

While Opposer's Notice of Opposition properly pleads Opposer's claims for dilution and likelihood of confusion, pursuant to Fed. R. Civ. P. 15(a) and T.B.M.P. §§ 503.03 and 507.02, Opposer further responds to Applicant's motion by filing an Amended Notice of Opposition.

Pursuant to Fed. R. Civ. P. 15(a), a party may amend its pleading once as a matter of course at any time within 21 days after the responsive pleading is served, or 21 days after service of a motion under Rule 12(b), whichever is earlier. Fed. R. Civ. P. 15(a) and T.B.M.P. § 507.02. Applicant's answer was due on February 21, 2017. In lieu of submitting an answer, Applicant filed a Motion to Dismiss. Therefore, Opposer's amendment is timely under the rules.

III. Conclusion

Accordingly, Opposer's originally filed Notice of Opposition sufficiently stated a claim upon which the requested relief could be granted. Nevertheless, Opposer has submitted an Amended Notice of Opposition, which Opposer submits moots Applicant's motion. *See* T.B.M.P. § 503.03.

Respectfully submitted,
KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: March 10, 2017

By: _____

Jeffrey L. Van Hoosear
2040 Main Street
Fourteenth Floor
Irvine, CA 92614
(949) 760-0404
Attorneys for Opposer,
FNC Medical Corporation

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

FNC Medical Corporation, Opposer, v. Genomma Lab Internacional, S.A.B. de C.V., Applicant.	Opposition No. 91224462 Mark: DiabetTX Serial No. 86/521,466

AMENDED NOTICE OF OPPOSITION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Sir or Madam: Opposer, FNC Medical Corporation, a California corporation, located and doing business at 6000 Leland Street, Ventura, California 93003 (hereinafter referred to as "Opposer"), believes that it will be damaged by the registration of the mark shown in Application No. 86/521,466 ("Applicant's Mark"), filed February 2, 2015 by Genomma Lab Internacional, S.A.B. de C.V., (hereinafter referred to as "Applicant"), for "body creams and lotions" in International Class 3 ("Applicant's Goods"), and hereby opposes the same.

A description of Applicant's application is as follows:

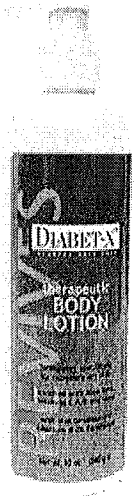
Mark:	DIABETTX and Design
Serial No.:	86/521,466
Filing Date	February 2, 2015
Publication Date:	June 23, 2015
Class:	3
Goods:	Body creams and lotions

As grounds for opposition, it is alleged that:

1. Since at least as early as 1997, Opposer has been using the DIABET-X mark ("Opposer's Mark") in connection with various personal care products, which include body creams and lotions, for diabetic patients in Class 5. Said use of the DIABET-X mark has been valid and continuous, and has not been abandoned.

2. Through a substantial amount of advertising, promotion and sales, Opposer's Mark has acquired extensive goodwill and consumer recognition prior to the February 2, 2015 filing date of Applicant's Application No. 86/521,466. Prior to Applicant's filing date, the purchasing public has come to associate Opposer's Mark with Opposer.

3. Since at least as early as 1997, Opposer has and continues to promote its DIABET-X mark in the industry and to consumers. Opposer displays the DIABET-X mark extensively on personal care products, including, creams, lotions, body washes and shampoos and on the internet. As such, Opposer's 20 years use of its Mark has become a famous identifier of Opposer's goods. A representation of Opposer's goods is as follows:



4. Through Opposer's continuous and extensive use of Opposer's DIABET-X mark for 20 years, Opposer has developed strong common law rights in Opposer's Mark. These rights pre-date Applicant's filing date of the Application.

5. Opposer is the owner of U.S. Trademark Registration No. 2,470,802, which registered on July 24, 2001, for the mark DIABET-X for "anti-microbial body cream for diabetic patients; anti-fungal cream for diabetic patients" in International Class 5 with a date of first use of August 15, 1997. This registration is incontestable. A copy of this registration is attached hereto.

6. Opposer is the owner of U.S. Trademark Registration No. 2,610,009, which registered on August 20, 2002, for the mark DIABET-X for "medicated personal hygiene and health care products for diabetic patients, namely, hand cream, shampoo, hair rinse, hair conditioners, and body wash" in International Class 5 with a date first use of August 1997. This registration is incontestable. A copy of this registration is attached hereto.

7. Opposer relies on the registrations set forth herein. Opposer's registrations are valid, subsisting, unrevoked, uncancelled, and not abandoned. As such, these registrations constitute *prima facie* evidence of the validity of the registered marks, Opposer's ownership of the marks shown therein, and Opposer's exclusive right to use the registered marks in commerce in connection with the goods set forth therein, without condition or limitation. Said registrations also constitute notice to Applicant of Opposer's claim of ownership of the marks shown therein, all as provided in Sections 7(b), 22 and 33(a) of the Trademark Act.

8. Opposer also relies on its prior 20 years of common law rights in Opposer's Mark in connection with its various DIABET-X goods. Opposer and its products for diabetics are well-known and Opposer and its products for diabetics have an excellent and highly regarded reputation in the OTC industry.

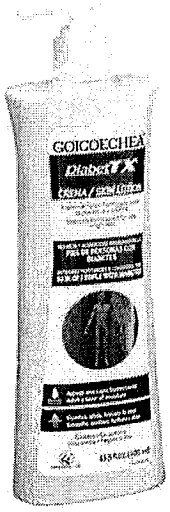
9. Opposer's 1997 dates of first use and the application filing dates of its above referenced registrations substantially precede the filing date of Applicant's Application.

10. Applicant seeks an unrestricted federal registration for the 

mark covering the goods "body creams and lotions" in International

Class 3 set forth in the Application. As such, registration will constitute prima facie evidence of the Applicant's exclusive right to use the registered mark in commerce on or in connection with the listed goods throught the United States.

11. The parties' channels of trade and channels of promotion are related if not the same, and the parties' respective consumers are in fact the same. Applicant's goods and Opposer's goods are or will be sold in the same and/or related channels and via the same methods. For example, Opposer's goods are sold through, among other channels, pharmacies and drug stores. Upon information and belief, pharmacies and drug stores frequently sell both medicated and non-medicated creams, lotions, body washes, shampoos, and ointments. A photo of Opposer's goods as sold on the Walgreen's website is as follows:



12. In addition, the parties' goods are clearly related, if not identical, despite being in different classes. Applicant's goods and Opposer's goods both include body creams and lotions intended for use by those with diabetes. Upon information and belief, medicated and non-medicated body creams and lotions are frequently sold and manufactured by the same company, and under the same mark. Furthermore, medicated creams in International Class 5, and non-medicated creams in International Class 3 are frequently sold side by side, and by the same company, or under the same mark. Finally, medicated creams in International Class 5, and non-

medicated creams in International Class 3, that each intended for those with diabetes would be frequently sold side by side, and by the same company, or under the same mark.

13. In view of the similar nature of Opposer's Mark and Applicant's Mark, Opposer alleges that Applicant's Mark so resembles Opposer's Mark as to be likely to cause confusion, to cause mistake or to deceive under Section 2(d) of the Trademark Act. In view of Opposer's prior statutory and common law rights in its marks, Applicant is not entitled to the registration of Applicant's Mark pursuant to Section 2(d) of the Trademark Act.

14. In addition, Applicant's use and registration of Applicant's Mark causes, and will cause, dilution of the distinctive quality of Opposer's famous DIABET-X mark under Section 43(c) of the Trademark Act, and will lessen the ability of Opposer's Mark to distinguish Opposer's good, to the damage and injury of Opposer.

15. By reason of all the foregoing, Opposer will be gravely damaged by the registration of Applicant's Application, because registration of the mark would be in violation of Opposer's trademark rights.

WHEREFORE, Opposer prays that Application Serial No. 86/521,466 be rejected and stricken, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Opposer.

Respectfully submitted,
KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: March 10, 2017

By: _____

Jeffrey L. Van Hoosear
2040 Main Street
Fourteenth Floor
Irvine, CA 92614
(949) 760-0404
Attorneys for Opposer,
FNC Medical Corporation

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CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing Response to Applicant's Motion to Dismiss and Amended Notice of Opposition upon Applicant's counsel by depositing one copy thereof in the United States Mail, first-class postage prepaid, on March 10, 2017, addressed as follows:

Daniel C. Neustadt
HOLLAND & KNIGHT LLP
800 17th St NW Ste 1100
Washington, District Of Columbia 20006-3962

Betty de la Torre