ESTTA Tracking number: **ESTTA531177**

Filing date: **04/09/2013**

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

Proceeding	91173963
Party	Plaintiff Mini Melts, Inc.
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Date	04/09/2013
Attachments	Motion to Compel Reply.pdf (10 pages)(97810 bytes)

UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

Mini Melts, Inc., Opposer,	§	
v.	§	Opposition No. 91/173,963
Reckitt Benckiser LLC, Applicant.	§	

OPPOSER'S REPLY TO APPLICANT'S RESPONSE TO MOTION TO COMPEL ANSWERS TO INTERROGATORIES AND PRODUCTION OF DOCUMENTS RESPONSIVE TO REQUESTS FOR PRODUCTION

Opposer Mini Melts, Inc. replies to Applicant Reckitt Benckiser LLC's response to Opposer's motion to compel answers to interrogatories and documents responsive to requests for production, respectfully showing as follows:

1. Before Opposer Mini Melts, Inc. begins a point-by-point reply to Applicant Reckitt Benckiser's response, Mini Melts would like to mention three preliminary matters. First, in its response, Reckitt does not challenge or object to any of Mini Melts' factual assertions - including the assertion that this case presents the only known situation in the United States where a drug company named a "use only as directed" medicine the same name as the federally registered trademark of a popular children's novelty treat. Second, Reckitt does not respond to Mini Melts' central argument for why the subject discovery should be compelled by this Board. Mini Melts anticipated that Reckitt would make the flawed argument that the safety principle contained in this Board's pharmaceutical case law should only apply when two pharmaceuticals are involved. And in anticipation of such an argument, Mini Melts on pages 16-18 of its motion offered four reasons why such an argument is incorrect. Reckitt fails to refute or respond to these four reasons. Finally, Reckitt's counsel continues its unprofessional habit of describing Mini Melts

argument as "bizarre" and accusing Mini Melts of trying to "distract and prejudice the judiciary." Mini Melts will resist the temptation to respond in kind, will reply professionally, and will note that this type of language and argument typically is used by a party with documents or information to hide and no persuasive argument to keep them hidden.

2. Reckitt begins its response by arguing that the controversy in this opposition already has been determined in prior federal court litigation. That is incorrect. As this Board noted in its order denying Reckitt's motion to dismiss, "it is well-settled that a claim for trademark infringement is based on different transactional facts than those upon which an opposition to registration of a mark is based." (Board Order dated July 20, 2012, page 9). And since Reckitt defended the claims in the civil action by arguing that it uses the phrases "Mucinex Mini Melts" and "Children's Mucinex Mini-Melts" in the marketplace (and not simply the marks Mini-Melts and MiniMelts), the civil action and this opposition are not based on the same transactional facts. Therefore, as this Board previously has ruled, the civil action did not determine this opposition.

3. Reckitt next argues that the safety information was excluded from the civil action. As explained in footnote four of Mini Melts' motion "[t]he federal court trial occurred in a district court located in the Fifth Circuit. Unlike the Third Circuit, Second Circuit and the Trademark Trial and Appeal Board, the Fifth Circuit has not yet recognized the relevancy of safety considerations in the likelihood of confusion analysis (no case has yet addressed it), and the trial court did not permit a jury instruction on the issue of safety considerations." But it also should be noted that even with no Fifth Circuit precedent to support consideration of safety factors, the voluntary mention of safety considerations by the prospective jury panel members made an impression on the trial judge that safety considerations were at least something to talk about in

the case. Following Voir Dire, the following exchange occurred at the bench between the Court and defense counsel: (Tr. 19:67, 68).

> MR. SIEBMAN: The only two we were concerned about is Number Three and Number Four. They voluntarily got into the safety issue, which also I think is an issue that's off limits.
>
> THE COURT: Well, I'm not sure it is off limits now, the more I hear about it. I think it might be -- it's something to talk about, but we can't represent to them that that's irrelevant in this case. All right. Which ones do you think --

4. Reckitt next argues, as mentioned above, that all the pharmaceutical safety cases cited by Mini Melts are distinguishable and irrelevant because they are set in a context where both of the at-issue products were pharmaceuticals dispensed by a pharmacist and Mini Melts cold medicine is sold, marketed, and administered in a different context than Mini Melts ice cream. Reckitt is correct that Mini Melts has not cited a case involving a drug and a food product. But Reckitt cannot cite to another single instance where a drug company has attempted to federally register a drug trademark that is virtually identical to the name of a well-known children's novelty food treat - so apparently no case such as this has ever presented itself for determination.

More importantly, Reckitt cannot refute the reasoning by which the rationale and principles of this Board's pharmaceutical safety cases should be applied to this opposition. Reckitt states that "[a]lthough, [sic] Mini Melts cough and cold medicine is a pharmaceutical preparation, it is sold, marketed, and administered in completely different contexts than Opposer's *ice cream*." (emphasis in original) (Reckitt Response, page 4). This is Reckitt's sole argument for why this Board's pharmaceutical safety cases are supposedly irrelevant. As an initial matter, Reckitt's argument is based upon the false assumption that an adult always will administer the Mini Melts drug to a child and that children will never have unsupervised access to the Mini Melts drug at home. Reckitt's own internal documents prove that this assumption is

absolutely and dangerously false.[1]

But further, Reckitt's argument does not address the important four reasons set forth in Mini Melts' motion to compel for why this Board's pharmaceutical safety cases are relevant. The first reason is that the Lanham Act is broad enough to cover confusion between products and not just confusion as to source. The second reasons is that the danger is created not simply because the two products are pharmaceutical products, but because the two products are (i) consumable products that (ii) have identical or similar names, but (iii) dangerously different purposes and results, and (iv) it is foreseeable that both products can be in the same environment. To be specific, both products are named Mini Melts (Mini-Melts), and both products are small, flavorful, colorful, free-flowing particles that are consumed primarily by children. Many children are very familiar with "Mini Melts" as the name of something that can be eaten as a treat. And the evidence is that children are gaining unsupervised access to the Mini-Melts drug at home and eating it. There is likelihood for dangerous confusion in the mind of a child, which Reckitt neither addresses nor refutes.

Reckitt also does not address the third and fourth reasons, which are that when the purchasers and users of the products include professionals and non-professionals, the standard of care considered is that which would be exercised by the least sophisticated purchaser or user -

[1] MEDWATCH Reports produced by Applicant in the federal court litigation indicate Reckitt is aware that children are gaining access to Mini Melts medicine, taking it without parental supervision, and are taking too much. (Ex. P47). These reports state “Father reported that the five year-old child took 2 packets of Mucinex Mini-Melts (100 mg guaifenesin) granules unsupervised and the patient’s previous dose of Mini-Melts was given by the parent 10 hours prior to the accidental ingestion” (p.6); “Father reports his 4 year old son ingested 8 packets of Mucinex (100 mg guaifenesin) granules at the same time because they tasted good” (p.3); “Mother reported patient took seven packets of Junior Strength Mucinex (100 mg guaifenesin) Mini-Melts at one time” (p.4); “Mother states her 3 y.o. daughter accidentally ingested about 3 packets of Mucinex® Mini-Melts™ (100 mg guaifenesin)” (p.5); “Mother reported that her four year-old child accidentally took approximately 4 packets of Mucinex Mini-Melts (100 mg guaifenesin) granules at once” (p.7).

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