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

Proceeding	92065406
Party	Defendant Pharmadel LLC
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Submission	Motion for Summary Judgment Yes , the Filer previously made its initial disclosures pursuant to Trademark Rule 2.120(a); OR the motion for summary judgment is based on claim or issue preclusion, or lack of jurisdiction. The deadline for pretrial disclosures for the first testimony period as originally set or reset: 02/18/2018
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Date	09/27/2017
Attachments	Pharmadel RENEWED MSJ 9.27.2017.pdf(257228 bytes)

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

In the Matter of:

Registration No.: 4,581,604
Registered: August 5, 2014
Trademark: KOFAL

Plaza Izalco, Inc.,)	
)	
Petitioner,)	Cancellation No. 92065406
)	
v.)	
)	
Pharmadel, LLC,)	
)	
Registrant.)	
)	

REGISTRANT’S RENEWED¹ MOTION FOR SUMMARY JUDGMENT

Registrant, Pharmadel, LLC (“Registrant”), by and through undersigned counsel and pursuant to Fed. R. Civ. P. 56 and TBMP 528, hereby moves for entry of summary judgment against Petitioner Plaza Izalco, Inc. (“Petitioner”), and in support states as follows:

I. INTRODUCTION AND BACKGROUND.

On December 2, 2008, Registrant was granted Registration Ser. No. 3540972 for the Mark KOFAL-T in International Class 005 for *analgesic balm*. On July 10, 2013, Registrant filed an application for the Mark KOFAL in International Class 005 on the basis of Lanham Act § 1(a). The associated goods for Registrant’s KOFAL Mark are *Adhesive bandages; Adhesive bands for medical purposes; Analgesic and muscle relaxant pharmaceutical preparations; Analgesic balm; Anti-inflammatory gels; Anti-inflammatory salves; Anti-inflammatory sprays; Balms for medical*

¹ The instant Motion is filed as a “Renewed” Motion for Summary Judgment because the Motion was previously filed during the suspension of this proceeding, and an Order was entered on May 11, 2017 stating that because the Motion and its corresponding Notice of Reliance were filed during suspension, they would not be considered by the Board.

purposes; Balms for pharmaceutical purposes; Curare for use as a muscle relaxant; Herbal topical creams, gels, salves, sprays, powder, balms, liniment and ointments for the relief of aches and pain; Medicaments for promoting recovery from tendon and muscle injuries and disorders and sports related injuries; Multipurpose medicated antibiotic cream, analgesic balm and mentholated salve; Muscle relaxants; Sports cream for relief of pain; Therapeutic spray to soothe and relax the muscles. KOFAL matured to registration on August 4, 2014.

On August 6, 2013, Applicant filed Application Ser. No. 86029611 for the Mark COFAL in International Class 005 on the basis of Lanham Act § 1(a). The associated goods for the COFAL Mark were described as *analgesic and muscle relaxant pharmaceutical preparations; Analgesic balm; Analgesic preparations; Curare for use as a muscle relaxant; Medicaments for promoting recovery from tendon and muscle injuries and disorders and sports related injuries; Multipurpose medicated antibiotic cream, analgesic balm and mentholated salve; Muscle relaxants.* On November 25, 2013, the Examiner issued an Office action refusing registration on the grounds that COFAL creates a likelihood of confusion with Registrant's Mark KOFAL-T, and the Examiner also advised of Registrant's pending application for KOFAL, which preceded Applicant's application. On April 10, 2014, the Examiner issued a suspension notice due to the pending KOFAL application and an Opposition Action initiated by Applicant (Opposition No. 91214315) regarding Application Ser. No. 85821526 (which was abandoned). Ultimately, the Examiner issued a final Office action on January 30, 2016, refusing registration on the grounds that Applicant's Mark COFAL is confusingly similar to Registrant's KOFAL-T and KOFAL. Applicant appealed, ultimately moving for suspension of said proceeding upon filing of the instant cancellation action on February 9, 2017.

In the instant case, Applicant argues that KOFAL should be cancelled because it creates a likelihood of confusion with COFAL, arguing also that KOFAL is primarily merely a surname. Applicant's cancellation action is wholly silent with regard to KOFAL-T, likely because TBMP 307 and Lanham Act § 14 (15 U.S.C. § 1064) prevent cancellation of said mark on the grounds alleged by Applicant against KOFAL. For the reasons discussed *infra*, summary judgment should be entered on behalf of Registrant because the pre-existing registration for KOFAL-T renders the instant case futile, and Applicant cannot be harmed as a matter of law because of the pre-existing registration of KOFAL-T.

II. LEGAL STANDARD FOR SUMMARY JUDGMENT.

“37 CFR§ 2.116(a), provides that “[e]xcept as otherwise provided, and wherever applicable and appropriate, procedure and practice in *inter partes* proceedings shall be governed by the Federal Rules of Civil Procedure.” TBMP 502.01. Section 14 of the Lanham Act (15 U.S.C. § 1064) sets forth the requirements with respect to the standing of a petitioner seeking to cancel a registration of a mark. “For a petitioner to prevail in a cancellation proceeding, it is incumbent upon that party to show (1) that it possesses standing to challenge the continued presence on the register of the subject registration and (2) that there is a valid ground why the registrant is not entitled under law to maintain the registration.” *See A.V. Brands, Inc. v. Spirits International, B.V.*, 2009 TTAB LEXIS 199 (TTAB 2009) (citing *Lipton Industries, Inc. v. Ralston Purina Company*, 670 Fed.2d 1024, 213 USPQ 185, 187 (CCPA 1982). *See also*, TBMP 503.02. “Summary judgment is appropriate ‘if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law.’” Fed. R. Civ. P. 56(c). *See also*, TBMP 528. “The motion for summary judgment is a pretrial device to

dispose of cases in which ‘the pleadings, the discovery and disclosure materials on file, and any affidavits show that there is no genuine issue as to any material fact and that the movant is entitled to judgment as a matter of law.’” TBMP 528.01. “The purpose of the motion is judicial economy, that is, to avoid an unnecessary trial where there is no genuine issue of material fact and more evidence than is already available in connection with the summary judgment motion could not reasonably be expected to change the result in the case.” *Id.* “The burden of the moving party may be met by showing “that there is an absence of evidence to support the nonmoving party’s case.” *Id.* “A party moving for summary judgment should specify, in its brief in support of the motion, the material facts that are undisputed.” *Id.*

A. Statement of Undisputed Facts.

1. On December 2, 2008, Registrant was granted Registration Ser. No. 3540972 for the Mark KOFAL-T in International Class 005 for *analgesic balm*.
2. On July 10, 2013, Registrant filed an application for the Mark KOFAL in International Class 005 on the basis of Lanham Act § 1(a).
3. The associated goods for Registrant’s KOFAL Mark are *Adhesive bandages; Adhesive bands for medical purposes; Analgesic and muscle relaxant pharmaceutical preparations; Analgesic balm; Anti-inflammatory gels; Anti-inflammatory salves; Anti-inflammatory sprays; Balms for medical purposes; Balms for pharmaceutical purposes; Curare for use as a muscle relaxant; Herbal topical creams, gels, salves, sprays, powder, balms, liniment and ointments for the relief of aches and pain; Medicaments for promoting recovery from tendon and muscle injuries and disorders and sports related injuries; Multipurpose medicated antibiotic cream, analgesic balm and mentholated salve; Muscle relaxants; Sports cream for relief of pain; Therapeutic spray to sooth and relax the muscles.*

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