

EXHIBIT I

(Application Serial No. 87015660)

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: November 8, 2012

Cancellation No. 92052897

Thomas Sköld

v.

Galderma Laboratories, Inc.

**Before Bucher, Zervas and Bergsman,
Administrative Trademark Judges.**

By the Board:

Thomas Sköld ("petitioner") seeks to cancel two registrations of Galderma Laboratories, Inc. ("respondent") for the mark RESTORADERM for, "therapeutic skin care preparations and treatment for skin disorders" in Class 5 (hereinafter "'751 registration");¹ and "non-medicated skin care preparations" in Class 3 (hereinafter "'514 registration").² The amended petition to cancel is based on allegations of likelihood of confusion, priority of use and abandonment. As clarified by the Board's order of October 13, 2011, the claim of abandonment is raised solely as to the '751 registration, while the claim

¹ Registration No. 2985751, registered Aug. 16, 2005, claiming dates of first use and first use in commerce of May 27, 2005. Section 8 affidavit/declaration filed Mar. 28, 2012.

of priority and likelihood of confusion is raised as to both registrations. By its answer, respondent has denied the salient allegations of the complaint.

This case now comes up for consideration of respondent's motion, filed April 27, 2012, for partial summary judgment on the ground that it has not abandoned use of its RESTORADERM mark as to goods in Class 5 of the '751 registration. In its motion for partial summary judgment, respondent argues that it has never abandoned, or intended to abandon its mark; that respondent and its predecessor CollaGenex, have actively and continuously developed RESTORADERM-branded products, culminating in the nationwide sale of its current products; that respondent currently uses the mark on the goods identified in the registration, and respondent or CollaGenex have never ceased using the mark with intent not to resume use since the filing of the application through to the present. In support of its motion, respondent submitted the declarations of Lisa N. Congleton, attorney for respondent; Cindy Kee, Group Product Director of Galderma Laboratories, L.P.; Art Clapp, Director of Business Development of Galderma Laboratories, L.P.; and Maud Robert, Trademark Counsel and Trademark & Copyright Manager of Galderma, S.A.; as well as numerous exhibits, including dictionary definitions for the term "therapeutic," such as "of or relating to the treatment of disease or disorders by

² Registration No. 3394514, registered Mar. 11, 2008, claiming

remedial agents or methods;"³ or "administered or applied for reasons of health; a therapeutic shampoo."⁴

In response, petitioner argues that there is no evidence supporting use as a "medicated" skin lotion, or that respondent's use is not in lawful use in commerce under the Food, Drug and Cosmetic Act, 21 U.S.C. § 321, because respondent has not sought regulatory approval for its product as a "drug." In essence, petitioner argues, a "therapeutic" skin lotion is necessarily a "medicated" one, and respondent cannot sell the same product as both a "therapeutic" one in Class 5, and a "cosmetic" one in Class 3. Thus, petitioner argues, respondent has abandoned its registration for goods in Class 5, because it cannot show use of the mark for a "medicine."

Petitioner also requests that to the extent the Board "does not accept" petitioner's contention that respondent has not supported an assertion of use for Class 5 goods, then the issue of abandonment is "still in dispute," and petitioner seeks discovery relating to respondent's motion for partial summary judgment.

dates of first use and first use in commerce of Jun. 21, 2007.

³ Exhibit A to Declaration of Lisa N. Congleton, *Free Merriam-Webster Dictionary* at www.merriam-webster.com/dictionary/therapeutic accessed Apr. 23, 2012.

⁴ Exhibit B to Declaration of Lisa N. Congleton, *Oxford Dictionaries Online (U.S. English)* at www.oxforddictionaries.com/definition/therapeutic accessed Apr. 23, 2012.

In reply, respondent argues that petitioner has not challenged respondent's evidence that it is using the mark in commerce for skin care products for use by people suffering with atopic dermatitis or eczema, or that its use of the mark has been continuous, but rather that the mark is not "medicated." Respondent argues that the Office has consistently found that a non-medicated product can be a "therapy" or a "treatment" classified in Class 5, and that a product may have "dual uses," causing it to be classified in both Class 3 and Class 5.

Motion for Rule 56(d) Discovery Denied

To the extent petitioner argues that it cannot respond to respondent's motion for partial summary judgment absent further discovery, the motion is denied. See Trademark Rule 2.127(e)(1) and TBMP § 528.06 (3d ed. rev. 2012).

Petitioner responded to the motion on the merits, rather than moving for discovery under Fed. R. Civ. P. 56(d), and the Board finds the request for further discovery at this juncture pointless.⁵ See *Ron Cauldwell Jewelry, Inc. v.*

⁵ To the extent petitioner seeks to test the sufficiency of respondent's responses to requests for admission, or to compel further discovery, the Board notes that petitioner did not file such motions prior to the filing of the motion for partial summary judgment. Petitioner should note that generally, if there is an admission or a denial to a request for admission, the Board will not find the response to be insufficient. Cf. comments to Fed. R. Civ. P. 36(a)(4 - 6) regarding improper responses which may be considered effective admissions. Further, if a party that served a request for discovery receives a response thereto which it believes to be inadequate, but fails to file a motion to challenge the sufficiency of the response, it

Clothestime Clothes, Inc., 63 USPQ2d 2009, 2012 n.8 (TTAB 2002) (motion for Rule 56 discovery denied where nonmovant filed a response to the motion for summary judgment on the merits).

Partial Summary Judgment

A party is entitled to summary judgment when it has demonstrated that there is no genuine dispute as to any material fact and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). In reviewing a motion for summary judgment, the evidentiary record and all reasonable inferences to be drawn from the undisputed facts must be viewed in the light most favorable to the nonmoving party. *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

A mark is deemed abandoned when its use has been discontinued without intent to resume use. Nonuse in the United States for a period of three consecutive years establishes a prima facie case of abandonment. See 15 U.S.C. § 1127. A petitioner for cancellation of a registration on the ground of abandonment bears the burden of proving such abandonment by a preponderance of evidence. *Cerverceria Centroamericana S.A. v. Cerverceria India Inc.*, 892 F.2d 1021,

may not thereafter be heard to complain about the sufficiency thereof. *Time Warner Ent. Co. v. Jones*, 65 USPQ2d 1650, 1656 (TTAB 2002) (having failed to file motion to compel, defendant will not later be heard to complain that interrogatory responses were inadequate).

13 USPQ2d 1307 (Fed. Cir. 1989). Conversely, respondent, as the party moving for summary judgment dismissing the claim of abandonment, must establish continuous use of its mark for all of the goods named in the registration, or that it has not ceased use without an intent to resume use.

According to respondent, and as supported with documents supplied by *petitioner* with its initial disclosures, respondent was using the mark in the '751 registration on a product used in at least one clinical study at the time of the filing of CollaGenex's Statement of Use in 2005; and CollaGenex continued to seek ways to further develop that product until its acquisition by respondent on April 10, 2008. CollaGenex also registered the mark for goods in Class 3, claiming dates of first use and first use in commerce of June 21, 2007, for which the Office issued the '514 registration. Petitioner notes that respondent appears to have been using the mark in connection with clinical testing of a moisturizer in June 2009.⁶ By the declaration of Cindy Kee, Group Product Director of respondent's wholly-owned subsidiary Galderma Laboratories, L.P., respondent asserts that it currently offers two RESTORADERM-branded products, a moisturizer and a bodywash, for sale in retail stores nationwide, and that these products were formulated to aid those with atopic dermatitis and/or eczema-

⁶ Petitioner's brief in opposition to motion for partial summary judgment at 8, referring to the "Clapp declaration."

prone skin. Respondent also presents a listing from the National Eczema Association website of those products, including respondent's RESTORADERM body wash and moisturizer, which have received the organization's "seal of acceptance."⁷

Petitioner argues that by this evidence, respondent has "near to conceded that it has abandoned its Class 5 registration."⁸ Petitioner relies on TMEP § 1402.03(5) which explains that,

Many goods are commonly understood to move in a particular channel of trade or have particular attributes. ... For example, "skin lotion" usually refers to a cosmetic product - one that is not medicated. For that reason, it can be classified in Class 3 without further specification.

However, a skin lotion that is medicated should be classified in Class 5, and the identification should indicate that the product is medicated in order to justify its classification in Class 5 rather than in the more commonly understood and assigned Class 3.

TMEP § 1401.03(5) (rev. Oct. 2012). Petitioner recognizes that the issue is one of "definition" for the term "therapeutic," but would also make the leap that a "therapeutic" item is necessarily a "medicated" one, and thus classifiable only in Class 5.⁹

⁷ Exhibit H to the Declaration of Lisa N. Congleton, respondent's counsel. *Seal of Acceptance Product Directory*, www.nationaleczema.org/seal-acceptance/product-directory-personal-care accessed Apr. 23, 2012.

⁸ Petitioner's brief in opposition at 12.

⁹ Petitioner's citation to *Phillips v. AWH Corp.*, 415 F.3d 1303, 1321, 75 USPQ2d 1321, 1333 (Fed. Cir. 2005) (en banc) regarding the context of dictionary definitions is inapposite. That case involved the definition of an entirely different term, "baffles" in the context of patent claims.

Under petitioner's theory, a product classified as a "cosmetic" could not also be classified as "therapeutic." But, TMEP § 1401.07 recognizes that a product may have a plurality of uses, such that it may be classified in two, or more, classes. *See also, In re International Salt Co.*, 166 USPQ 215, 216 (TTAB 1970) (holding same goods capable of classification in more than one class where specimen of use does not negate other uses).

Further, our primary reviewing court has previously found that a single product may have dual uses as both a cosmetic and a pharmaceutical preparation, where there is testimony to support such use, and the specimens do not contradict the dual classification. *Jean Patou, Inc. v. Theon, Inc.*, 9 F.3d 971, 975 29 USPQ2d 1771, 1774 (Fed. Cir. 1993).

While we must view respondent's motion for partial summary judgment on petitioner's pleaded claim of abandonment in a light most favorable to petitioner as the nonmoving party, petitioner was required to set forth specific facts, by declarations or as otherwise provided in the rule, rebutting respondent's evidence of continuous use and showing that there are genuine disputed facts remaining for trial. *See Fed. R. Civ. P. 56(e)*. *See also Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1298 (Fed. Cir. 1991), and *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1786 (Fed. Cir. 1990). Assuming for

the sake of the summary judgment motion that the goods sold in Class 3 are the same as the goods sold in Class 5, there is nothing showing abandonment of the goods. To the contrary, petitioner concedes that respondent has "well established that Cetaphil Restoraderm Skin Restoring Moisturizer is a good... well, moisturizer,"¹⁰ and does not dispute that the mark is in use as a "cosmetic." Likewise, assuming that the goods sold in Class 5 are somehow different from those sold in Class 3, respondent has presented evidence that the goods in Class 5 are recognized as alleviating symptoms associated with atopic dermatitis and eczema, and there is no evidence of non-use or abandonment. Neither has petitioner established that a "therapeutic" product is necessarily a "medicine" or a "drug," and dictionary definitions do not support that theory.

Accordingly, respondent's motion for partial summary judgment on petitioner's claim of abandonment is granted, and petitioner's claim of abandonment is hereby dismissed with prejudice.¹¹

Dates Reset

Proceedings are resumed. Dates are reset as set out below.¹²

¹⁰ Petitioner's brief in opposition at 1.

¹¹ As the decision on the motion for partial summary judgment is interlocutory in nature, any appeal can be can be raised only after final disposition of this proceeding. See Trademark Rule 2.145(d), and *Procter & Gamble Co. v. Sentry Chem. Co.*, 22 USPQ2d 1589, 1594 n.4 (TTAB 1992). See also *Copelands' Enter. Inc. v. CNV Inc.*, 887 F.2d 1065, 12 USPQ2d 1562, 1564 (Fed. Cir. 1989).

¹² The parties should note that the evidence submitted in connection with the motion for summary judgment is of record only for consideration of that motion. To be considered at final

Expert Disclosures Due	12/3/2012
Discovery Closes	1/2/2013
Plaintiff's Pretrial Disclosures Due	2/16/2013
Plaintiff's 30-day Trial Period Ends	4/2/2013
Defendant's Pretrial Disclosures Due	4/17/2013
Defendant's 30-day Trial Period Ends	6/1/2013
Plaintiff's Rebuttal Disclosures Due	6/16/2013
Plaintiff's 15-day Rebuttal Period Ends	7/16/2013

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. See *Land O' Lakes Inc. v. Hugunin*, 88 USPQ2d 1957, 1960 n.7 (TTAB 2008); *Univ. Games Corp. v. 20Q.net Inc.*, 87 USPQ2d 1465, 1468 n.4 (TTAB 2008); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993) (declaration of witness submitted in connection with summary judgment motion was part of record for trial where witness identified and attested to accuracy of it during applicant's testimony period).