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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
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Skoro

Mailed: July 16, 2007

Opposition Nos. **91156416**
91158025

SmithKline Beecham Corporation

v.

Jarrow Formulas, Inc.

Before Hohein, Holtzman, and Kuhlke,
Administrative Trademark Judges.

By the Board:

This case now comes up on opposer's motion, filed August 18, 2006,[1] for partial summary judgment in its favor on the counterclaim for cancellation of opposer's pleaded registrations.

By way of background, opposer, SmithKline Beecham Corporation (hereinafter "SKB") owns Reg. Nos. 1783808 and 1807004,[2] issued on the Principal Register for the marks CALCITUMS and CALCITUMS and Design for, in each instance, an "antacid preparation" in Class 5.

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[1] The delay in addressing this motion was the result of the granting of a motion for a 56(f) deposition by applicant.

[2] Reg. No. 1783808 issued on July 27, 1993 and was renewed on November 7, 2003. Reg. No. 1807004 issued on November 30, 1993 and was renewed on January 24, 2004.

On March 8, 2004, applicant, Jarrow Formulas, Inc. (hereinafter "Jarrow"), answered the notice of opposition and filed a counterclaim[3] to cancel SKB's pleaded registrations claiming SKB has abandoned the marks.

SKB in its answer denied all of the salient allegations of the counterclaim.

In support of its motion for summary judgment on the counterclaim, SKB has provided the declaration of Mark Prus, Director of Marketing for Gastrointestinal, Calcium and Dermatological Products for SKB, together with various exhibits. The exhibits are representative examples of use of the registered marks in various promotions, advertisements, coupons, and in-store displays. Further, Mr. Prus' declaration states that use of each of the marks has "never, since its introduction into the market in 1992, been discontinued.". (Decl. at ¶ 6).

Jarrow, in response, contends that SKB has "failed to use CALCITUMS on its antacid preparations, on the bottles containing its antacid preparations, on the tags or labels affixed to the bottles, or on any associated point of purchase displays for at least the past three years". (Br.

[3] Applicant originally filed two counterclaims against SKB. The first was for claimed priority of use as to a likelihood of confusion, and the second was the abandonment claim now before us. On June 3, 2004, the priority/likelihood of confusion claim was stricken as not a valid ground for cancellation under 15 U.S.C. § 1114, having been filed more than five years after registration and the marks were incontestable.

at 1). Jarrow further contends that "SKB does not intend to use CALCITUMS as a trademark, but rather only intends to use it sporadically to advertise that its TUMS products contain calcium." (Br. at 1). In support of these arguments, Jarrow submitted Mr. Prus' 30(b)(6) deposition and exhibits thereto.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. Fed. R. Civ. P. 56(c). The party moving for summary judgment has the initial burden of demonstrating the absence of any genuine issue of material fact and that it is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). The evidence of record and any inferences, which may be drawn from the underlying undisputed facts, must be viewed in the light most favorable to the nonmoving party. *See Olde Tyme Foods Inc. v. Roundy's Inc., 9*61 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). In considering the propriety of summary judgment, the Board may not resolve issues of material fact against the non-moving party; it may only ascertain whether such issues are present. *See Opryland USA, Inc. v. Great American Music Show, Inc.,* 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1993); and *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993).

Section 45 of the Trademark Act, 15 U.S.C. § 1127, defines abandonment of a mark as being when the use of a mark "has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for three consecutive years shall be prima facie evidence of abandonment" 15 U.S.C. § 1127(1). "Use" is defined as "use of a mark in the ordinary course of trade" and a mark is deemed to be in use on the goods when "it is placed in any manner on the goods or their containers **or the displays associated therewith** …" 15 U.S.C. § 1127 (emphasis added).

In this case, SKB has moved for summary judgment on the ground that it has not abandoned its marks and that it has no intention to do so. In support of its motion, SKB submitted the declaration of Mr. Prus, with exhibits; its responses to Jarrow's interrogatories; and the specimens in support of its renewal applications, which were accepted by the Office.[4]

In response, Jarrow also submitted the testimony of Mr. Prus, together with exhibits, through its 30(b)(6) deposition.[5] Jarrow's challenge is to SKB's use of the

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[4] Reg. No. 1783808 was renewed on November 7, 2003, and Reg. No. 1807004 was renewed on January 24, 2004. The same specimen was submitted for each renewal application.

[5] Exhibits to Mr. Prus' testimony include use of the marks on packaging in the form of stickers (used in 1999 and 2000); on displays associated with the goods (2004); coupons for the goods

marks, contending it has not made technical trademark use in connection with the goods[6] (App.'s Br. 2); that the displays do not bear the marks prominently or associate them with the goods (*id.* at 2-3); and thus, according to Jarrow, "SKB has failed for at least the past three years to use CALCITUMS on its antacid preparations, on the bottles, on the tags or labels affixed to the bottles, or on any associated point of purchase displays" (*id.* at 3).[7] Jarrow states, however, that "SKB has for at least three years intentionally deemphasized the use of CALCITUMS and Design and only sporadically **used it** to advertise that its TUMS products contain calcium"[8] (emphasis added) (*id.*).

Jarrow's attack on the subject registrations is premised on abandonment in that the marks as used by SKB are

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(2003-2005); pamphlets distributed with samples (2003-2005); and use of the marks on its website (2000-present).

[6] SKB provided copies of stickers that were applied to the caps of the antacid preparations from 1999-2000. The parties agree that this was good, technical trademark use. (Ex. A to Prus dec., Bates No. OPP-00093).

[7] To the extent Jarrow may be alleging no valid trademark use as a claim separate from abandonment, such a claim is not available after five years. See 15 U.S.C. § 1064.

[8] Jarrow also states at p. 6: "SKB has used CALCITUMS sporadically and only in advertising material that is unacceptable to support trademark use. Further, CALCITUMS has been used only to advertise the fact that 'TUMS contains calcium'". (Br. at 10). Thus, according to Jarrow, it has established a prima facie case of abandonment and SKB is unable to rebut the presumption because "SKB does not intend to use CALCITUMS as a trademark, but rather intends to use it only sporadically to advertise that TUMS contains calcium." (*id.* at 12).

not and have not been used as trademarks. However, a review of the exhibits shows use of "off-shelf displays" associated with the goods which demonstrates technical trademark use of the marks under 15 U.S.C. § 1127.[9] Further, because there is no question as to perception of the marks as trademarks by the public,[10] there can be no inference of abandonment. Jarrow admits that SKB uses the marks on displays associated with the goods, but then contends such use is only sporadic. (Br. at 6). SKB has established, however, that the marks have been used continuously, and the display is an example of use during the registration period. *See also In re Dell Inc.*, 71 USPQ2d 1725, 1727 (TTAB 2004) (a website page which displays a product, and provides a means of ordering the product, can constitute a "display associated with the goods").

As the moving party, the burden is on SKB to show the absence of any genuine issue of material fact as to the abandonment of its marks, which it has done. In response, applicant has not raised a genuine issue of material fact to overcome SKB's evidence of continuous technical trademark

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[9] See also Mr. Prus' 30(b)(6) testimony at p.18, lines 9-10: "This off-shelf display would have been used in store to generate sales of TUMS …"

[10] Jarrow's argument that the marks are secondary to SKB's TUMS mark and conveys information that the product contains calcium does not establish abandonment. There is no restriction that an owner of a mark can only use one trademark on or in connection with a product.

use and therefore SKB is entitled to summary judgment as a matter of law. Fed. R. Civ. P. 56(c).

Accordingly, because the Board finds that there is no genuine issue as to any fact that would be material to the issue of abandonment, and because SKB is entitled to judgment on this issue as a matter of law, SKB's motion for summary judgment on the counterclaims is granted. The counterclaims as to abandonment are hereby dismissed with prejudice.

Proceedings are hereby resumed, and trial dates are reset as indicated below.

DISCOVERY PERIOD TO CLOSE:	**August 31, 2007**
30-day testimony period for party in position of plaintiff to close:	**November 29, 2007**
30-day testimony period for party in position of defendant to close:	**January 28, 2008**
15-day rebuttal testimony period to close:	**March 13, 2008**

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.

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