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

Proceeding	88660605
Applicant	Alembic Pharmaceuticals, Inc.
Applied for Mark	ALEMBIC PHARMACEUTICALS
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Submission	Appeal Brief
Attachments	Alembic - Appeal for PHARMACEUTICALS.pdf(225679 bytes) Craig Salmon Declaration.pdf(70736 bytes)
Appealed class	Class 005. First Use: 1907/01/01 First Use In Commerce: 1907/01/01 All goods and services in the class are appealed, namely: Generic prescription drugs, approved by the U.S. Food and Drug Administration, namely, prescription drugs in the nature of pills, tablets, capsules, caplets, liquid drops, sachets and pharmaceutical preparations, for the treatment of or fitting the description of the following: allergic conjunctivitis, alzheimer's, antianxiety, antibacterial, antibiotic, antidepressant, antiepileptic, anti-infection, anti-inflammatory and antipruritic agents, anti-ulcer, bacterial conjunctivitis, bipolar 1 disorder, bronchodilator, erectile dysfunction, fungal infection, glaucoma, herpes, hypercholesterolemia, hypertension, hyperuricemia, hypoparathyroidism, influenza A or Parkinson's disease/syndrome, influenza A and B, insomnia, intraocular pressure, local anesthesia, lowering high cholesterol, management of neuropathic pain, NSAID, ocular infections, overactive bladder, postoperative inflammation and reduction of ocular pain, relief of cough, relief of the inflammatory and pruritic manifestations, rheumatoid arthritis, seizure, panic disorder, sleep disorder, transfusional iron overload, and treatment of moderate to severe scalp psoriasis; prescribed by a licensed medical doctor with the prescriptions filled by a retail pharmacy licensed to sell prescription drugs
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Date	03/25/2021

**IN THE UNITED STATE PATENT AND TRADEMARK OFFICE
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In re Application of:)	
Alembic Pharmaceuticals, Inc.)	
Serial No.: 88660605)	Trademark Attorney:
Filed: October 18, 2019)	Chioma (Bata) Oputa
Trademark: ALEMBIC)	
PHARMACEUTICALS)	
)	
)	
)	

ARGUMENT IN SUPPORT OF APPEAL

In accordance with the provisions of 37 C.F.R. §§ 2.141 and 2.142, this argument is submitted in support of this Appeal (the “Appeal”) in response to the Final Office Action of the United States Patent and Trademark Office (“USPTO”) dated January 6, 2021, rejecting U.S. Application Serial No. 88660605 for "ALEMBIC PHARMACEUTICALS" (the “Application”) filed by Alembic Pharmaceuticals, Inc. (the “Applicant” or “Alembic”). The Application was refused, on the ground that there is a likelihood of confusion, pursuant to Trademark Act Section 2(d), 15 U.S.C. §1052(d), with the mark in U.S. Registration No. 5683081 for ALEMBIC HERBALS (the “Registered Mark”) held by Purapharm International (H.K.) Limited (the “Registrant”) and because of an improper specimen.¹ Because

¹ The final reason for rejection was because of improper identification of goods. Applicant has complied with the Trademark Examiner’s guidance to amend the identification of goods.

there is no likelihood of confusion between the Registered Mark and Alembic's applied-for mark, and because the specimen submitted complied with the Trademark Examiner's guidance to submit a photograph of a prescription bottle bearing the Applicant's mark that contained its generic prescription drugs, this Appeal should be granted.

STATEMENT OF FACTS

Applicant's mark is classified as follows:

International Class 5: Class 5: Generic prescription drugs, approved by the U.S. Food and Drug Administration, namely, prescription drugs in the nature of pills, tablets, capsules, caplets, liquid drops, sachets and pharmaceutical preparations, for the treatment of: allergic conjunctivitis, Alzheimer's disease, anxiety, bacterial infections, depression, epilepsy, infection, inflammation and allergies, ulcers, bacterial conjunctivitis, bipolar disorder, bronchoconstriction, erectile dysfunction, fungal infection, glaucoma, herpes, hypercholesterolemia, hypertension, hyperuricemia, hypoparathyroidism, influenza A and B, Parkinson's disease/syndrome, insomnia, intraocular pressure, paralysis, amnesia, unconsciousness, high cholesterol, neuropathic pain, arthritic pain and inflammation, ocular infections, overactive bladder, postoperative inflammation, ocular pain, cough, inflammatory and pruritic manifestations, rheumatoid arthritis, seizure, panic disorder, sleep disorder, transfusional iron overload, and moderate to severe scalp psoriasis; all of the foregoing prescribed by a licensed medical doctor with the prescriptions filled by a retail pharmacy licensed to sell prescription drugs.

In addition to a "retail and wholesale store services" in International Class 35,

Registrant's Mark, ALEMBIC HERBALS, is classified as follows:

International Class 5: medicines for human purposes for strengthening the immune system and restoring normal human bodily functions, the

treatment, mitigation and prevention of diseases and disorders, namely, digestive diseases and disorders, central nervous system diseases and disorders, namely, brain diseases, movement disorders ocular motility, respiratory diseases and disorders, excretory diseases and disorders, cardiovascular diseases and disorders, reproductive diseases and disorders, endocrinal diseases and disorders, immunological diseases and disorders, namely, autoimmune diseases, immunologic deficiency syndromes, hepatitis, dermatological diseases and disorders, skeletal diseases and disorders, namely, bone diseases, back pain, muscular diseases and disorders, namely, muscular dystrophy, inflammatory muscle diseases, sensory diseases and disorders, namely, blindness.

DESCRIPTION OF THE RECORD

Applicant filed the present application requesting registration of the mark for goods based on prior use in commerce on October 18, 2019. On January 27, 2020, the trademark examining attorney (the “Examining Attorney”) refused registration of the Applicant’s mark. On March 27, 2020, Alembic amended its Application and presented argument in support of registration of its applied-for mark. On April 21, 2020, a Final Office Action refusing registration of Applicant’s applied-for mark was entered by the USPTO.

Applicant filed a request for reconsideration seeking registration in Class 5 and deleting its request for registration for Class 35 on July 1, 2020. Applicant simultaneously appealed the refusal to register the mark. On the same day, Applicant also submitted its specimen: a photograph of a prescription bottle bearing its mark that contained generic prescription drugs manufactured by Alembic that had been used in commerce. Then, on December 1, 2020, Applicant amended its

identification of goods for Class 5 and submitted an additional specimen. The USPTO issued a Final Office Action on January 6, 2021 rejecting the request for consideration (the “Refusal”). The Refusal was based on three grounds—(1) Section 2(d) “likelihood of confusion” between the Applicant’s mark and the Registrant’s mark; (2) improper specimen; and (3) identification of goods and/or services. Finally, the USPTO resumed the appeal on January 26, 2021.

STATEMENT OF THE ISSUES

Whether the Refusal is correct in alleging that a likelihood of confusion pursuant to Section 2(d) of the Trademark Act exists between the mark in the subject application and the mark cited in Registration No. 5683081.

Whether the Refusal is correct in finding that Applicant submitted an improper specimen.

Applicant has complied with the Trademark Examiner’s edits to the identification of goods, so this issue is moot, and not subject to appeal.

ARGUMENT

Applicant submits that the Examining Attorney's refusal to register Applicant's mark ALEMBIC PHARMACEUTICALS based on the Registrant's ALEMBIC HERBALS mark is not well founded. Section 2(d) of the Trademark Act is intended to provide protection from confusion on the consumer level. The goal of the Act, as stated by the U.S Court of Custom and Patent Appeals is “the

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