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

LEO PHARMA A/S
Opposer,

v.

LEV PHARMACEUTICALS, INC.
Applicant.

Opposition No. 91171694
Serial No. 76/636,322

03-17-2008

U.S. Patent & TMOfc/TM Mail Rcpt Dt

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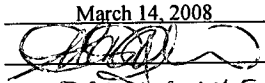
Signature: 

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APPLICANT'S RESPONSE TO OPPOSER'S MOTION FOR SUMMARY JUDGMENT

Applicant Lev Pharmaceuticals, Inc. ("Applicant") respectfully submits this memorandum in opposition to Opposer's Motion for Summary Judgment ("Opposer's Motion") filed by LEO Pharma A/S ("Opposer" or "LEO"). Opposer's Motion is unsupported by any allegation in the Notice of Opposition, and contravenes TBMP § 528.07 and Fed. R. Civ. P. 56. Opposer's Motion is therefore untenable, and warrants denial.

I. PRELIMINARY STATEMENT

There are multiple substantive reasons why the Board should deny Opposer's Motion on the merits. As a threshold matter, however, denial of Opposer's Motion is compelled because Opposer's Motion focuses solely on new issues not heretofore properly introduced by Opposer.

II. SUMMARY

Opposer's Motion violates the requirement of the Federal Rules of Civil Procedure and the Board's Manual of Procedure that a summary judgment motion *be based on issues that have previously been pleaded.* Because all of the issues raised in Opposer's Motion were first introduced by the Motion itself, summary judgment is not appropriate.

In this regard, there is no mention in the Notice of Opposition of any of the three contentions upon which Opposer's Motion is based, namely: (1) Applicant does not and has not provided to others the services identified in its application; (2) the specimen submitted in the application does not evidence service mark use; and (3) Applicant has committed fraud on the PTO by alleging service mark use since March 19, 2003. A copy of the Notice is annexed as Exhibit A; its allegations are summarized as follows:

Para.1	Application for LEV PHARMA.
Para.2	Opposer's marks.
Para.3	Opposer's marks.
Para.4	Description of Opposer.
Para.5	Applicant's date of first use.
Para.6	Opposer's priority of use before filing date of LEV PHARMA.
Para.7	Opposer's priority of use before Applicant's date of first use.
Para.8	Opposer's goodwill in its marks.
Para.9	Opposer's claim of priority under §44.
Para.10	Opposer's claim of priority under §44.
Para.11	Nature of Opposer's use of its marks.
Para.12	Opposer's goodwill in its registered marks.
Para.13	Similarity of parties' marks; likelihood of confusion.
Para.14	Likelihood of confusion; potential harm to Opposer.
Para.15	Benefit to Applicant due to similarity of parties' marks.
Para.16	Similarity of parties' marks/goods/services; likelihood of confusion.
Para.17	Damage to Opposer.

As can be seen, not one of the allegations addresses the issues raised in Opposer's Motion.

Indeed, Applicant only became aware that Opposer was taking the positions argued in Opposer's Motion upon its first reading of same. Lodged by Opposer on the brink of the close of discovery – as Applicant waited in vain (for over two months) to receive supplemental discovery responses which Opposer had been directed to furnish by the Board[1] – Opposer's Motion was prepared and sprung under cover of the pretense that Opposer had "back-burnered" the Board-prescribed discovery so that its efforts could be devoted to advancing settlement considerations. (*See* Exhibits B1–B3, detailing exchange between the parties.) From all that appears, this was not the case, as Opposer was in actuality instead working on the Motion.

Opposer's Motion epitomizes the sort of ambush tactics which the Federal Rules were meant to counteract, and can only be seen as yet another attempt by Opposer to frustrate orderly progress of the opposition proceeding that Opposer itself has initiated. Because Opposer's Motion is procedurally defective, it cannot be sustained.[2]

III. ARGUMENT

A. Procedural Grounds for Denial

Opposer's Motion, which is based entirely on unpleaded issues, is impermissible and may not be argued or ruled upon. The law is clear that a party may not obtain summary judgment on an issue that has not been pleaded. TBMP § 528.07(a) (citing Fed. R. Civ. P. 56(a) and 56(b)); *S. Indus. Inc. v. Lamb-Weston Inc.*, 45 U.S.P.Q.2d 1293, 1297 (TTAB 1997) (denying petitioner's motion for summary judgment on unpleaded claim); *Greenhouse Sys. Inc. v. Carson*,

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[1] The Board's direction to such effect appeared in the Order issued December 4, 2007, stating "Now that the Board's standard protective order is in place, it is expected that opposer will provide more complete responses to applicant's written discovery requests."

[2] It is Applicant's understanding that this proceeding is suspended and that consequently no discovery motions are proper at this time. At the appropriate time, and as suggested by the Board's Order, Applicant intends to file a Cross Motion under Rule 37 to compel the discovery ordered of Opposer by the Board. Applicant further reserves the right to amend its affirmative defenses or take other action as appropriate in the event that information is learned from Opposer's documents (if ever produced) which would support additional claims.

37 U.S.P.Q.2d 1748, 1750 n.5, 1751 (TTAB 1995) (issues which were not pleaded by opposer as grounds of opposition may not serve as bases for summary judgment); *Consol. Foods Corp. v. Berkshire Handkerchief Co., Inc.*, 229 U.S.P.Q. 619, 621 (TTAB 1986) (denying opposer's "fatally defective" summary judgment motion because the only ground alleged therein, i.e., fraud of the applicant, had not previously been pleaded in the opposition); *Drive Trademark Holdings LP v. Inofin*, 83 U.S.P.Q.2d 1433, 1437 (TTAB 2007) (refusing to consider registrations that were not pleaded in notice of opposition and were asserted for the first time in opposer's motion for summary judgment); *Fishking Processors Inc. v. Fisher King Seafoods Ltd.*, 83 U.S.P.Q.2d 1762, 1764, n.3 (TTAB 2007) (noting that unpleaded issues are not a basis for entering summary judgment).

The prohibition against basing a summary judgment motion on unpleaded issues is especially significant where the asserted ground for summary judgment is fraud, since in pleading fraud, "the circumstances … shall be stated with particularity." *Consol. Foods*, 229 U.S.P.Q. at 621 (citing Fed. R. Civ. P. 9(b)).

Here, Opposer should be precluded from obtaining summary judgment on each of the three new issues raised in its Motion. None of these issues has ever before been pleaded in this proceeding. Indeed, Opposer has failed to allege in its Notice of Opposition a single fact in support of any of these claims, including its fraud claim, much less pleaded such allegations with sufficient particularity to satisfy the Federal Rules requirements.

Throughout the pleading and discovery phases of this proceeding, the ***only*** claim which Opposer has asserted against registration of Applicant's application is alleged likelihood of confusion. The obligation to provide Applicant with fair notice of the new claims cannot be

dispensed with by Opposer at its sole discretion. Opposer should be precluded from obtaining summary judgment on each of the issues raised in Opposer's Motion.

B. The Equities

Opposer's exploitation of the instant proceedings, via Opposer's Motion, transcends mere tactical gamesmanship. Rather, it extends to a fundamental subversion of the opposition process, whereby Opposer – having "stonewalled" Applicant's attempts at discovery, to the point of disregarding a Board Order that such discovery be furnished – now files for summary judgment on grounds never before pleaded, in another effort to obstruct the proper progress of this proceeding and shield its case from scrutiny.[3]

If Opposer's Motion is entertained, Opposer will have succeeded in boldly manipulating the Rules to enjoy the privileges of having initiated this Opposition, but evade the responsibilities of good faith participation therein. Applicant, on the other hand, will be prejudiced with defending itself against Opposer's new "stealth" (yet meritless) allegations, premised on information purportedly learned (ironically) from documents *diligently produced by Applicant* over one year ago. Opposer's Motion therefore also warrants denial on grounds of fairness. Opposer should further be compelled to comply with the Board's Order by supplementing its responses to Applicant's discovery requests.

C. Substantive Treatment Deferred

There are several reasons that support denial of Opposer's Motion on the merits. However, according to TBMP § 528.07(a):

> [I]f the parties, in briefing summary judgment motion, have treated an unpleaded issue on its merits, and the nonmoving party has not objected to Opposer's Motion on the ground that it is based on an

[3] For example, Opposer has refused to provide discovery to establish use of its registered trademark in commerce in the United States (which is, after all, Opposer's ostensible basis for opposition).

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