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

Proceeding	91173963
Party	Defendant Reckitt Benckiser LLC
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

MINI MELTS, INC.

Opposer,

Opposition No.: 91173963.

v.

Application Serial No. 78/814,088

RECKITT BENCKISER LLC

Application Serial No. 78/814,106

Reckitt.

**RECKITT'S RESPONSE IN OPPOSITION
TO OPPOSER'S MOTION TO COMPEL**

Applicant, Reckitt Benckiser, LLC ("Reckitt"), by and through its undersigned counsel, hereby files its Response in Opposition to Opposer's Motion to Compel.

BACKGROUND

On November 15, 2006, Opposer initiated an Opposition Proceeding in the United States Patent and Trademark Office against both of Reckitt's pending trademark applications for the mark MINI MELTS and MINI-MELTS (Serial Nos. 78/814,088 and 78/814,106). On May 31, 2007, Opposer sued Reckitt in federal court for trademark infringement and trademark dilution under Texas state law concerning Reckitt's use of the subject mark "Mini Melts." *Mini Melts, Inc. v. Adams Respiratory Operations, Inc. d/b/a Adams Respiratory Therapeutics, et al.*, Civil Action No. 4:07cv271. A stay to this Opposition Proceeding was granted pending the outcome of the federal litigation. A jury trial on the trademark infringement issue was held from June 19, 2009, through June 25, 2009, in the Eastern District of Texas. Simultaneously, the district court conducted a bench trial on the equitable issue of trademark dilution by tarnishment. The jury instructions on trademark infringement clearly asked the jury whether Reckitt used Opposer's

trademark without consent and in a manner likely to cause confusion, mistake or deceit. The jury found that Opposer had not proven that Reckitt had used the Mini Melts trademark in a manner likely to cause confusion, mistake, or deceit within the meaning of Section 2(d) of the Lanham Act. Further, the district court ruled in Reckitt's favor finding no dilution by tarnishment.

On January 10, 2010, Opposer filed a Notice of Appeal in the Fifth Circuit Court of Appeals. Oral Argument was held on March 1, 2011. The Appellate Court entered final judgment in favor of Reckitt on March 11, 2011. Opposer's Petition for Rehearing *En Banc* was denied and a Mandate issued April 19, 2011. On July 8, 2011, Opposer filed a Petition for Writ of Certiorari in the U.S. Supreme Court. On October 3, 2011, it was denied.

After five years of litigation, there has been a final determination of Civil Action No. 4:07cv271—a jury in the Eastern District of Texas, the Fifth Circuit Court of Appeals, and the United States Supreme Court have held there is no likelihood of confusion between Opposer's trademark MINI MELTS and Reckitt's use of the trademark MINI MELTS. Despite this overwhelming determination, Opposer now seeks to resume its attempt to oppose Reckitt's pending trademark applications.

Currently before the Board is Opposer's Motion to Compel Answer to Interrogatories and Production of Documents, which requests seek information related to hypothetical harmful results of Mucinex Mini Melts cough and cold medicine. Notably, throughout the years of litigation in federal court and now during this opposition proceeding, Opposer has continued to attempt to distract and prejudice the judiciary by its focus on a hypothetical, public danger argument. Not surprisingly, Opposer again attempts to argue that these hypothetical, public dangers are relevant to likelihood of confusion. However, this argument is without merit, and

this precise information was excluded from the trial in Civil Action No. 4:07cv271. Because all the requested discovery is completely irrelevant to the issues in this case, any discovery related to the safety of Mini Melts cough and cold medicine is objectionable and the Board should deny Opposer's Motion to Compel.

MEMORANDUM OF LAW

As set forth in its own Motion, Opposer Mini Melts, Inc., manufacturers a food product that is sold at various locations, including, for example: leisure areas, parks, family entertainment centers, and fairs. Reckitt's Mini Melts, on the other hand, is a pharmaceutical product sold in a controlled environment—not in leisure areas—and can only be purchased by adults. Opposer and Reckitt advertise their products in different venues. Opposer's Mini Melts ice cream can be purchased directly by children, while Reckitt's Mini Melts cough and cold medicine are only administered under adult supervision with extensive warnings and controls. Despite these vast differences, Opposer is attempting to obtain information regarding consumer complaints and incident reports that allegedly demonstrate that Reckitt's product creates a danger or presents a safety issue to the public. However, any such information is irrelevant to Opposer's claims, is inappropriate, and is highly prejudicial.

1. Information regarding any potential or hypothetical harm of Mucinex Mini Melts is completely irrelevant to the opposition proceedings.

The safety of Reckitt's Mini Melts cough and cold medicine is irrelevant to the the elements of a trademark infringement in an opposition proceeding. In the extensive trademark infringement litigation involving the exact same trademarks at issue in this opposition proceeding, this precise argument was argued by Opposer, heard, and rejected. The federal courts found the information irrelevant and highly prejudicial.

Additionally, the cases cited by Opposer in support of this proposition are all distinguishable and therefore inapplicable. All of the cases cited by Opposer are set in a context where both of the at-issue products were pharmaceuticals dispensed by a pharmacist, which is entirely inapposite to the case at hand. Although, Mini Melts cough and cold medicine is a pharmaceutical preparation, it is sold, marketed, and administered in completely different contexts than Opposer's ice cream. Therefore, the cases are not relevant to the current proceeding.

Mini Melts cough and cold medicine is an exceptionally safe product. Specifically, Mini Melts cough and cold preparation can only be purchased from the medicine aisle of a drug store by adults. (Ex. D-1238). It is intended to be administered by the adult to the child. Its packaging includes specific warnings to keep out of the reach of children. (Tr 5:89 – 90). Mini Melts cough and cold medicine includes specific warnings to keep out of the reach of children and are very clearly intended to be administered by an adult. Furthermore, even if the adult carelessly allowed the child to have access to Mini Melts cough and cold medicine, the individual packets are very difficult for a child to open (without a pair of scissors, which the child shouldn't have access to either). (Tr 5:93). Opposer's Mini Melts ice cream contains no similar warnings and is sold directly to children from freezers, carts, and vending machines at amusement parks, leisure areas, fairs, and other entertainment venues. Nonetheless, Opposer impermissibly seeks to transform a case about branding into a case about the safety of Reckitt's Mini Melts product.

The active ingredient, guaifenesin, has been monographed by the Food and Drug Administration ("FDA") to be generally recognized as safe and effective such that its sale according to published standards is automatically authorized by the FDA as well as the

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