**UNITED STATES PATENT AND TRADEMARK OFFICE**
**Trademark Trial and Appeal Board**
**P.O. Box 1451**
**Alexandria, VA 22313-1451**
General Contact Number: 571-272-8500

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Mailed: February 1, 2018

Cancellation No. 92065406

*Plaza Izalco, Inc.*

*v.*

*Pharmadel LLC*

**Before Kuhlke, Bergsman, and Goodman,**
**Administrative Trademark Judges.**

By the Board:

Petitioner seeks to cancel Respondent's registration[1] for the mark KOFAL for the following goods:

> Adhesive bandages; Adhesive bands for medical purposes; Analgesic and muscle relaxant pharmaceutical preparations; Analgesic balm; Anti-inflammatory gels; Anti-inflammatory salves; Anti-inflammatory sprays; Balms for medical purposes; Balms for pharmaceutical purposes; Curare for use as a muscle relaxant; Herbal topical creams, gels, salves, sprays, powder, balms, liniment and ointments for the relief of aches and pain; Medicaments for promoting recovery from tendon and muscle injuries and disorders and sports related injuries; Multipurpose medicated antibiotic cream, analgesic balm and mentholated salve; Muscle relaxants; Sports cream for relief of pain; Therapeutic spray to sooth and relax the muscles in International Class 5; and

[1] Registration No. 4581604, issued August 5, 2014, claiming June 21, 2013 as the date of first use and first use in commerce

> Drug delivery patches sold without medication; Elastic bandages in International Class 10.

As grounds for cancellation, Petitioner alleges that the mark KOFAL is primarily merely a surname under Section 2(e)(4) of the Trademark Act and alleges likelihood of confusion under Section 2(d) of the Trademark Act. Petitioner pleads ownership of prior common law rights in the mark COFAL for "Analgesic and muscle relaxant pharmaceutical preparations; Analgesic balm; Analgesic preparations; Curare for use as a muscle relaxant; Medicaments for promoting recovery from tendon and muscle injuries and disorders and sports related injuries; Multipurpose medicated antibiotic cream, analgesic balm and mentholated salve; Muscle relaxants." Petitioner further asserts that it is the owner of application Serial No. 86029611 for the COFAL[2] mark for these same goods and that this pending application was refused registration under Section 2(d) on the basis of Respondent's subject registration.

Respondent, in its answer, asserts numerous defenses, including the prior registration doctrine or "*Morehouse*"[3] defense, namely, that because Respondent already owns an unchallenged registration, for the mark KOFAL-T[4], for "the same or similar mark …on the same or similar goods" of the involved registration,

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[2] Filed August 6, 2013, based on an allegation of use under Trademark Act Section 1(a), 15 U.S.C. 1051(a), alleging February 2006 as the date of first use and first use in commerce.
[3] *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 56 C.C.P.A. 946, 160 USPQ 715 (CCPA 1969).
[4] U.S. Reg. No. 3540972, issued December 2, 2008, in connection with "analgesic balm." Sections 8 & 15 affidavit accepted and acknowledged on January 6, 2018.

Petitioner will not be further damaged by the subject registration (Answer, Aff. Def. No. 4).

This case now comes up for consideration of Respondent's motion (filed September 27, 2017) for summary judgment on its asserted *Morehouse* defense. A copy of Respondent's prior registration certificate and a recent printout from the USPTO TSDR database regarding its status is attached to Respondent's motion as an exhibit. The motion is fully briefed.

Summary judgment is appropriate only when there is no genuine dispute as to any material fact and the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). The Board may not resolve issues of material fact; it may only ascertain whether a genuine dispute regarding a material fact exists. *See Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc.*, 22 USPQ2d at 1544. The non-moving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine dispute of material fact for trial. In general, to establish the existence of disputed facts requiring trial, the non-moving party "must point to an evidentiary conflict created on the record at least by a

counterstatement of facts set forth in detail in an affidavit by a knowledgeable affiant." *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1786 (Fed. Cir. 1990) (citing *Barmag Barmer Maschinenfabrik AG v. Murata Machinery, Ltd.*, 731 F.2d 831, 221 USPQ 561, 564 (Fed. Cir. 1984)).

To prevail on its motion for summary judgment on the *Morehouse* defense, Respondent must show that Petitioner cannot be further damaged by the registration of the mark in the involved registration because there already exists a registration for essentially the same mark for essentially the same goods that are the subject of the involved application. *See Morehouse Mfg. Corp.*, 160 USPQ at 717; *O-M Bread Inc. v. United States Olympic Comm.*, 65 F.3d 933, 36 USPQ2d 1041, 1045 (Fed. Cir. 1995); and *Green Spot (Thailand) Ltd. v. Vitasoy Int'l Holding Ltd.*, 86 USPQ2d 1283, 1285 (TTAB 2008). Here, there is no dispute that Respondent owns U.S. Reg. No. 3540972 for the mark KOFAL-T for "analgesic balm." Whether the *Morehouse* defense is available, however, depends upon whether the mark in the registration at issue is substantially the same as the previously registered mark and whether the goods in both are substantially the same. *Id.*

Respondent contends that the pre-existing registration for KOFAL-T renders the instant case futile; that Petitioner cannot be harmed as a matter of law because of its pre-existing registration; that the marks KOFAL and KOFAL-T are substantially identical because they share the same commercial impression and the differences between them are insignificant; and the goods listed in the subject registration for KOFAL are substantially identical and related to those listed in the

prior registration for KOFAL-T so as to prevent Petitioner's mark for COFAL to register.

Petitioner responds contending that the KOFAL-T and KOFAL marks are not the same and are not the legal equivalents; that the subject registration for KOFAL is devoid of nearly thirty-percent of the characters of the KOFAL-T mark because of the missing dash and the capital letter "T" and the commercial impression is different; and that the additional scope of goods in the subject registration, KOFAL, precludes Respondent from asserting the *Morehouse* defense because it has multiple different goods in two separate classes, whereas Respondent's prior registration for KOFAL-T contains just one product, namely, "analgesic balm."

Respondent filed a reply, which we have considered, in which it argues that Petitioner has cited no authority that undermines or prevents entry of summary judgment in this action.

In comparing Respondent's KOFAL-T mark with the mark in the subject registration for KOFAL, we find that there is a genuine dispute as to whether the marks are "substantially identical" and if the marks evoke the same, continuing commercial impression. The question is whether the marks in their entireties are substantially identical. *See O-M Bread*, 36 USPQ2d at 1045.[5] Even though the addition of a hyphen and a letter "T" may seem insignificant when added to the

[5] Note that the *Morehouse* standard is not the same as that used when comparing marks for purposes of a likelihood of confusion analysis. While the latter test requires balancing of a variety of factors, *see In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (Fed. Cir. 1973), it is clear that a likelihood of confusion may be found even when the marks at issue are not "essentially the same."

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