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# **Belmora LLC. V. Bayer Consumer Care AG 84 F. Supp. 3d 490 (E.D. Va. 2015)**

WILLIAM STUART\*

## **BACKGROUND**

Belmora is a United States based seller of over-the-counter pharmaceuticals, including a pain relief product called FLANAX. Belmora applied for trademark protection for FLANAX in 2003, and in 2004 the application was published to allow others to oppose the registration of the FLANAX mark. Belmora had priority over the registration of the FLANAX mark in the U.S. because it was the first to use it in interstate commerce, starting on March 1, 2004.

Bayer is a multinational pharmaceutical company originating in Switzerland, incorporated in Delaware. Bayer has been selling its own pain relief medication under the Mexican-registered trademark FLANAX since the 1970s, but never tried to sell FLANAX in the U.S. until 2004. When Bayer attempted to register the FLANAX trademark in the U.S., Bayer had its application denied because Belmora was already in the process of applying for trademark protection of the same mark. Belmora originally sold its FLANAX product in packaging that was very similar to what Bayer used for its own FLANAX product in Mexico. Belmora targeted its advertising of FLANAX to the Latino community in the U.S., and the public had a perception that the FLANAX sold in the U.S. was somehow related to the FLANAX sold in Mexico by Bayer.

Belmora was granted trademark protection for FLANAX by the Trademark Trial and Appeal Board (TTAB) in 2005. Bayer responded by filing to have Belmora's trademark canceled because the TTAB agreed with Bayer's claims that consumer's were deceived into thinking that Belmora's FLANAX was the same pain relief medicine as Bayer's FLANAX that had been sold in Mexico for decades.

## **PROCEDURAL HISTORY**

In 2014, Bayer was successful in petitioning the TTAB to cancel Belmora's trademark. Belmora then appealed. and Bayer sued Belmora in the U.S. District Court for the Eastern District of Virginia.<sup>1</sup> Belmora filed a motion to dismiss Bayer's complaint in the district court. Belmora also

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<sup>1</sup> Belmora LLC v. Bayer Consumer Care AG, 84 F. Supp. 3d 490 (E.D. Va. 2015).

filed a motion to dismiss Bayer's counterclaim, which asserted that the TTAB dismissed claims under the Paris Convention article 6bis claim incorrectly, arguing that the TTAB should honor the Paris Convention and cancel any trademark that imitates a mark registered in another country if there is a likelihood of causing confusion about the origin of the product. Finally, Belmora filed a motion for judgment on the pleadings already made in the case due to Bayer's failure to state a sufficient claim, to overturn the TTAB decision canceling Belmora's trademark for FLANAX.

### ISSUE

The issue is whether or not Bayer has standing to argue any right to trademark protection in the U.S. for a product that Bayer sold and received trademark protection for in Mexico. In order to show that Bayer is entitled to trademark priority, they must convince the court that the Lanham Act intended to include the provision of the Paris Convention against trademarks that imitate trademarks in another nation in a confusing manner.

### DECISION

The district court granted Belmora's motions and reinstated its trademark registration. The court decided that Bayer, as a matter of law, did not have the required standing to state a claim against Belmora for false designation of origin or false advertising. Additionally, the court held that Belmora's marketing and sale of FLANAX was not a proximate cause of harm, economic or otherwise, to Bayer; because allegations alone were not enough to demonstrate Bayer had suffered a distinguishable loss. Similarly, the court found that Bayer lacked standing for the false advertising claim and misrepresentation of source claims. It also found that the protections discussed in the Paris Convention were not intended to be adopted in the Lanham Act.

### REASONING

Supreme Court precedent established in *Lexmark Int'l, Inc. v. Static Control Components, Inc.*<sup>2</sup> held that a claim for protection under the Lanham Act requires a showing of (1) proximate cause and (2) that the interest in the unregistered trademark fit into the intended "zone of interests" of the act.<sup>3</sup> In *Lexmark*, the court found no standing to sue under § 1125(a) of the Lanham Act because the plaintiff failed to state an adequate claim for damages relating to alleged false advertising. The standard requires that some damage to reputation of economic nature must be shown. Not only does Bayer's case fail to satisfy the first element of the test, since this issue is international as opposed to national in nature; but Bayer's attempt to show proximate cause of demonstrated economic

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2 *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 134 S. Ct. 1377 (U.S. 2014).

3 *Id.*

damages was overly speculative. Furthermore, Bayer was unable to show anything beyond mere confusion, far short of what is needed to show reputational injury. Bayer could show that Belmora advertised to the Latino community in the U.S. which arguably cashed in on Bayer's goodwill in the FLANAX mark. Bayer was unable to show standing for its claims under the Lanham Act of false designation of origin and false advertising. Even if they had successfully done so, they failed to establish damages to be remedied.

Regarding Bayer's claims that the Paris Convention provided standing for their claims, the court did not agree that their decision was bound by the Paris Convention. The agreements made in the Paris Convention did not, in and of themselves, become law in the U.S. since they were a treaty. Some of these agreements were enacted in Section 44 of the Lanham Act when it was adopted, but the court found that the Paris Convention was not adopted in its entirety, and did not include broad protections or new, independent causes of action for international trademarks not registered or marketed in the U.S.

The court found that precedent has consistently required that the trademark seeking protection have a history of use in the U.S. Since Bayer failed to show prior use, the court granted all motions in favor of Belmora despite packaging and marketing that knowingly confused U.S. purchasers.

