

TTAB

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

Lab21, Inc.

v.

Orlane S.A.



04-22-2002

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #58

Opposition No. 91151134
Serial No. 76/291260

Mark: B21

Express Mail Label No.	ET 474581856 US
Date of Deposit:	April 22, 2002
I hereby certify that this paper and/or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated above and addressed to BOX TTAB NO FEE, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.	
Signature	Michael Schwarz Name

TRADEMARK TRIAL AND APPEAL BOARD
02 APR 25 AM 3:40

ANSWER

Applicant, Orlane S.A. ("Orlane"), files this, its Answer to the Notice of Opposition filed against the application to register B21.

1. Orlane is without knowledge or information sufficient to form a belief as to the truth of the averments of numbered paragraph 1 of the Notice of Opposition. On information and belief Opposer does not manufacture any cosmetics or skin care products.
2. Orlane is without knowledge or information sufficient to form a belief as to the truth of the averments of numbered paragraph 2 of the Notice of Opposition. Opposer has not defined the term "the LAB21 mark". Nor has it stated what its "skin care products and cosmetics" are.
3. Orlane is without knowledge or information sufficient to form a belief as to the truth of the averments of numbered paragraph 3 of the Notice of Opposition.

Handwritten mark

4. Orlane is without knowledge or information sufficient to form a belief as to the truth of the averments of numbered paragraph 4 of the Notice of Opposition.
5. Orlane denies that it sent a letter to Opposer on May 31, 2001. Orlane admits that it sent a letter to the attorney of record of the applications to register LAB21 and LAB21.COM, which at that time were on information and belief owned by the Collaborative Group Ltd. Orlane received a reply to that letter from Mr. Charles Ryan, General Counsel of the Collaborative Group Ltd. and not from Opposer.
6. Orlane admits that as alleged in numbered paragraph 6 of the Notice of Opposition, Orlane filed suit against Opposer in the Southern District of New York.
7. Orlane admits that it claims such exclusive rights in the mark B21 as are accorded by its use of the mark B21 in commerce and its application to register that mark and that it will claim such exclusive rights as are accorded by a federal registration on the Principal Register when the mark is registered. Orlane denies all other allegations contained in numbered paragraph 7 of the Notice of Opposition.
8. Orlane denies the allegations in numbered paragraph 8 of the Notice of Opposition.
9. Orlane denies the allegations in numbered paragraph 9 of the Notice of Opposition.
10. Orlane admits the allegation in numbered paragraph 10 of the Notice of Opposition to the extent that a federal registration of the B21 mark will confer certain well recognized rights on Orlane and that such rights will benefit Orlane procedurally to the detriment of Opposer, who infringes the B21 mark.

AFFIRMATIVE DEFENSES

11. The Notice of Opposition fails to state any claims upon which relief can be granted.
12. Orlane and its subsidiary, Orlane, Inc. have filed suit against Opposer in the United States

District Court for the Southern District of New York, under docket number 01 Civ. 8496 (VM).

13. On information and belief, Opposer's filing of this opposition was in retaliation against the lawsuit Orlane brought against Opposer and is entirely lacking in legal or factual support.
14. Not one of the goods listed in the opening paragraph of the Notice of Opposition is identified in the application which is the subject of this Opposition.
15. The B21 mark is inherently distinctive.
16. Orlane has used the B21 mark in commerce for over 30 years in connection with the goods identified in the application.
17. Even if the B21 mark were not inherently distinctive, it has acquired distinctiveness and secondary meaning in connection with the goods identified in the application.
18. The Notice of Opposition fails to identify any legal or factual basis for denial of registration.
19. On information and belief, the Notice of Opposition was filed for the sole purposes of harassment, unnecessary delay and increasing the cost of litigation, in particular the litigation pending against Opposer in the Southern District of New York.
20. The claims and other legal contentions set forth in the Notice of Opposition are not warranted by existing law or a nonfrivolous argument for the extension, modification or reversal of existing law or the establishment of new law.

COUNTERCLAIM

21. The Notice of Opposition identifies two pending trademark applications - Serial No.

75/878866 (LAB21) and Serial No. 75/878868 (LAB21.COM). On information and belief, those applications have not yet matured to registration. Orlane is currently unable to counterclaim to cancel the LAB21 and LAB21.COM registrations because such a counterclaim is not yet ripe. Orlane however reserves its right to amend its pleadings to state a counterclaim for cancellation of those marks.

WHEREFORE, Orlane prays that the opposition be dismissed and that it be permitted to register B21 as a trademark for the goods specified in its application Serial No. 76/291260.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "M. Schwarz". The signature is fluid and cursive, with a large, stylized "S" at the end.

Michael Schwarz
Attorney for Applicant Thomas C. Ford
The Ruchelman Law Firm
625 Madison Avenue
12th Floor
New York, NY 10022
Phone (212) 755-7662
Fax (212) 755-5234

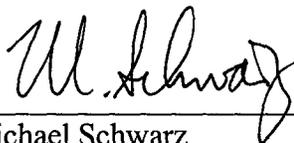
April 22, 2002

CERTIFICATE OF SERVICE

I hereby certify that the following was served by First Class Mail, postage prepaid on counsel for Opposer Lab21, Inc. on April 22, 2002 at the following address:

Eric Prager, Esq.
Darby & Darby P.C.
805 Third Avenue
New York, NY 10022

- Orlane SA's Answer to Notice of Opposition



Michael Schwarz
The Ruchelman Law Firm
625 Madison Avenue
12th Floor
New York, NY 10022
Phone (212) 755 7662
Fax (212) 755 5898

April 22, 2002