

HERRERA & REGALADO-HERRERA, P.A.  
*Real and Intellectual Property*

TTAB

12 N.E. 3<sup>RD</sup> STREET • MIAMI, FLORIDA 33132  
TELEPHONE: (305) 860-8910 • FACSIMILE: (305) 860-8944

fh@hr-h.com

October 2, 2006

**VIA US EXPRESS MAIL**  
EQ 903783669US

United States Patent and Trademark Office  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

Re: Trademark Opposition No. 91172492–  
**“Proline Sistemas Ltda. V. The Nunez/Martinez Partnership”**  
Our ref.: 4.031.06

To Whom It May Concern:

Please find enclosed Applicant's Answer to the Notice of Opposition No. 91172492 between Proline Sistemas Ltda. and The Nunez/Martinez Partnership. Also, please find enclosed check No. 1672 in the amount of \$300.00 for Applicant's Counterclaim.

If you have any questions or concerns do not hesitate to contact us.

Cordially,

  
Frank Herrera

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Enclosures

www.hr-h.com

  
10-02-2006

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

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

In the matter of: Application Serial No. 78/574867  
For the mark: EMAGRECE SIM  
Published in the Official Gazette on April 25, 2006

PROLINE SISTEMAS, LTDA.,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. 91172492
	)	
THE NUNEZ/MARTINEZ	)	
PARTNERSHIP	)	
	)	
Applicant.	)	
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**APPLICANT’S ANSWER AND AFFIRMATIVE DEFENSES**

COMES NOW Applicant, The Nunez/Martinez Partnership (“Applicant” or “Nunez/Martinez”) by and through its undersigned counsel, and hereby responds to Opposer, Proline Sistemas, Ltda.’s (“Opposer” or “Proline”) Notice of Opposition and sets forth the following:

1. Applicant admits the allegations contained in paragraph 1 of the Notice of Opposition.
2. Applicant admits the allegations contained in paragraph 2 of the Notice of Opposition.
3. Applicant admits the allegations contained in paragraph 3 of the Notice of Opposition, but denies any implication that it has not used the mark in commerce.
4. Applicant is without sufficient knowledge to formulate a belief as to the allegations contained in paragraph 4 of the Notice of Opposition and therefore denies the same. Upon information and belief, Opposer’s incorporated Brazilian entity is Proline Sistemas e Servicos Ltda.
5. Applicant is without sufficient knowledge to formulate a belief as to the allegations contained in paragraph 5 of the Notice of Opposition and therefore denies

same. To the extent that Applicant has any knowledge, Applicant points out that Opposer's does not currently own a registration for the mark "EMAGRECESIM" in Brazil. Furthermore, Opposer's pending application is not used in conjunction with dietary supplements. Rather, upon information and belief, Opposer's pending trademark application is for NCL(8)(35) for importing and exporting products. Moreover, Opposer's alleges a priority date and not a registration date of October 7, 2004, not 7/10/2004 as alleged.

6. Applicant is without sufficient knowledge to formulate a belief as to the allegations contained in paragraph 6 of the Notice of Opposition and therefore denies the same.

7. Applicant is without sufficient knowledge to formulate a belief as to the allegations contained in paragraph 7 of the Notice of Opposition and therefore denies the same.

8. Applicant is without sufficient knowledge to formulate a belief as to the allegations contained in paragraph 8 of the Notice of Opposition and therefore denies the same.

9. Applicant admits the allegations contained in paragraph 9 of the Notice of Opposition, but denies any implication that such similarities and confusion support Opposer's position. Rather, Opposer is the junior user of the mark in United States commerce. Any alleged rights gained by Opposer in a foreign country are entirely without import in this matter since trademark rights are territorial. Further, any alleged rights gained by Opposer in a foreign country and to be implied in the United States based upon the outdated "Famous Marks Doctrine" is without import since the doctrine has been specifically rejected as applying to marks under the Lanham Act. See Almacenes Exito S.A., v. El Gallo Meat Market, Inc., et.al., 381 F.Supp. 2d 324 (S.D.N.Y. 2005).

10. Applicant denies the allegations set forth in paragraph 10 of the Notice of Opposition.

11. Paragraph 11 of the Notice of Opposition is simply a statement of attorney opinion which requires no admission or denial from Applicant. In an abundance of caution, Applicant denies paragraph 11.

12. Applicant denies the allegations (or conclusions) set forth in paragraph 12 of the Notice of Opposition. Again, Opposer is the junior user of the mark in United States commerce. Any alleged rights gained by Opposer in a foreign country are entirely without import in this matter since trademark rights are territorial. Further, any alleged rights gained by Opposer in a foreign country and to be implied in the United States based upon the outdated "Famous Marks Doctrine" is without import since the doctrine has been specifically rejected as applying to marks under the Lanham Act. See Almacenes Exito S.A., v. El Gallo Meat Market, Inc., et.al., 381 F.Supp. 2d 324 (S.D.N.Y. 2005).

13. Applicant denies the allegations set forth in paragraph 13 of the Notice of Opposition. To the extent that Paragraph 13 contains conclusions of law, such allegations require no answer. See also Applicant's response to paragraph No. 12 above.

14. Applicant denies the allegations set forth in paragraph 14 of the Notice of Opposition. To the extent that Paragraph 14 contains conclusions of law, such allegations require no answer. See also Applicant's response to paragraph No. 12 above.

15. Applicant denies the allegations set forth in paragraph 15 of the Notice of Opposition. To the extent that that Paragraph 15 contains conclusions of law, such allegations require no answer.

16. Applicant denies the allegations set forth in paragraph 16 of the Notice of Opposition. To the extent that Paragraph 16 contains a statement of attorney opinion or conclusions of law, such allegations require no answer.

17. Applicant denies all allegations set forth in Paragraph 17 that Opposer should be entitled to any relief.

### **AFFIRMATIVE DEFENSES**

#### **First Affirmative Defense**

The Notice of Opposition fails to state a claim upon which relief can be granted. Opposer's reliance on its Brazilian pending application (Serial No. 826729185) and/or alleged use of the mark in international commerce is irrelevant for this Opposition.

#### **Second Affirmative Defense**

Opposer lacks standing to bring this opposition.

**Third Affirmative Defense**

Applicant's filing date for application Serial No. 78/574867 predates that of Opposer's Application Serial No. 78/739312 and provides Applicant superior rights in the EMAGRACE SIM mark and priority.

**Fourth Affirmative Defense**

Upon information and belief, Opposer or its affiliates has not used and/or does not use the EMAGRECESIM mark in commerce in the United States and is not entitled to a trademark registration therefore or grant of this opposition.

**Fifth Affirmative Defense**

At the time of filing and execution of Application Serial No. 78/739312, Opposer had no bona fide intent to use the mark in lawful commerce in the United States.

**Sixth Affirmative Defense**

Upon information and belief, Opposer has not obtained a foreign registration from its country of origin, and therefore cannot apply for U.S. trademark registration under its 44(e) filing basis. Upon information and belief, Opposition proceedings are pending in Brazil between Opposer and another entity, namely Phytotherm SIM USA<sup>1</sup> concerning registration of the mark "EMAGRECESIM" and "EMAGRESE SIM" in Brazil.

**Seventh Affirmative Defense**

Applicant reserves the right to counterclaim for opposition to or cancellation for any registration that may issue or is issued on Opposer's 44(e) trademark application Serial No. 78/739312.

**COUNTERCLAIM**

1. Applicant hereby counterclaims for cancellation for any registration that **may issue** on Opposer's Trademark Application Serial No. 78/739312 for the mark "EMAGRECESIM" in International Class No. 5 filed on October 24, 2005.
2. Applicant hereby realleges each and every allegation admitted or denied in

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<sup>1</sup> Applicant's pending application is also currently being opposed by Phytotherm SIM USA in Opposition No. 91172645.

conjunction with paragraphs 1-17 of the Notice of Opposition which are incorporated herein by reference.

3. Applicant's Intent to Use Application Serial No. 78/574867 was filed prior to Opposer's Section 44(e) Application serial No. 78/739312.

4. At the exact time of Opposer's filing of Application Serial No. 78/739312, Opposer has not made any use of its mark in the United States or interstate commerce.

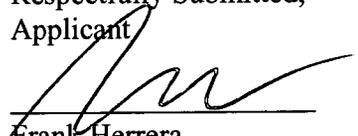
5. In filing Application Serial No. 78/739312, Opposer committed fraud on the United States Patent and Trademark Office, so much as it (1) does not own a foreign Brazilian registration and (2) did not nor does not have a bona fide intent to use the mark in United States commerce.

6. Herewith, Applicant encloses a fee of \$350.00 for the filing of this instant counterclaim.

WHEREFORE, Applicant denies that Opposer is entitled to the relief requested in its Notice of Opposition and requests: (a) that the Notice of Opposition be dismissed with prejudice; (b) that any registration which may issue on trademark Application Serial No. 78/739312 be cancelled; and (c) that registration for "EMAGRECE SIM" be issued to Applicant.

Respectfully Submitted,  
Applicant

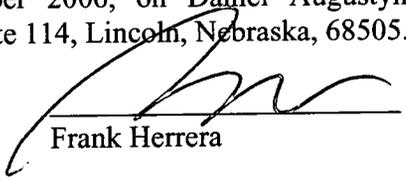
By:

  
Frank Herrera  
Florida Bar No. 494801  
Robert Ingham  
Florida Bar No. 21721  
HERRERA &  
REGALADO-HERRERA, P.A.  
12 N.E. 3<sup>rd</sup> Street  
The Federal Center Building  
Miami, Florida 33132  
Telephone (305) 860-8910  
Facsimile (305) 860-8944  
Email: [fh@hr-h.com](mailto:fh@hr-h.com)

October 2, 2006

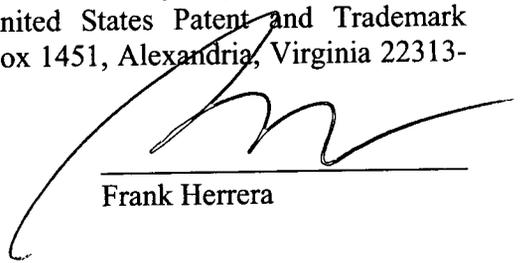
**CERTIFICATE OF SERVICE**

I HEREBY CERTIFY that a true and correct copy was served via United States mail, postage pre-paid this 2<sup>nd</sup> day of October 2006, on Daniel Augustyn, AUGUSTYN LAW OFFICE, 770 N. Cotner Blvd. Suite 114, Lincoln, Nebraska, 68505.

  
Frank Herrera

**CERTIFICATE OF EXPRESS MAIL**

I HEREBY CERTIFY that the foregoing was filed by express mail LABEL NO. EQ 903783669 US to the United States Patent and Trademark Office, Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, Virginia 22313-1451 this 2<sup>nd</sup> day of October 2006.

  
Frank Herrera