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

Proceeding	91189629
Party	Plaintiff Borghese Trademarks Inc.
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Date	07/22/2009
Attachments	Opposers Reply Brief in Support of Motion to Strike.pdf (5 pages)(204094 bytes)

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

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Borghese Trademarks, Inc.
Opposer,

v.

Multi Media Exposure, Inc.,
Applicant.

----------X

Opposition No.: 91189629

Mark: PRINCE LORENZO BORGHESE'S LA DOLCE VITA

Application No. 77/435,171

OPPOSER'S REPLY BRIEF IN SUPPORT OF ITS MOTION TO STRIKE APPLICANT'S AFFIRMATIVE DEFENSES

Opposer, Borghese Trademarks, Inc. ("Opposer") respectfully moves this Honorable Board for leave to file a reply brief in support of its motion to strike Applicant's Affirmative Defenses as contained in its Answer to the Notice of Opposition.

Applicant's Paragraph 20 of Affirmative Defenses should be Stricken as It does not demonstrate that Opposer's mark is weak but rather is a collateral attack on Opposer's registrations thinly veiled as an Affirmative Defense.

In its response, Applicant attempts to deflect attention away from the fact that its paragraph 20 of its affirmative defenses is a thinly veiled collateral attack on the validity of Opposer's registrations based on allegations that Opposer has not policed its marks. The claim that Opposer has not opposed registration of third party marks containing the name "Borghese" amounts to an accusation of abandonment based on a failure to police its marks. As such, it should be stricken, because collateral attacks must be brought by way of a counterclaim to cancel the registration(s) in question. Applicant, in its response, is arguing the wording of paragraphs

18 and 19 of its affirmative defenses—that Opposer's marks are not 'strong' marks or a 'family of marks'--which paragraphs Opposer has not moved to strike. Applicant is entirely wrong in its assertion that paragraph 20 "helps to demonstrate the narrow scope of use of Opposer's mark." Not only is Paragraph 20 a collateral attack on Opposer's registrations, it is simply an entirely false statement. Opposer respectfully requests that this defense be stricken.

Applicant further claims in footnote 2 that Opposer misquoted paragraph 20. However, each of paragraphs 18 through 23 come under the heading "AS AND FOR A FIRST AFFIRMATIVE DEFENSE" and as such Opposer does not believe it was incorrect in including this wording.

Applicant's Paragraph 30 of Applicant's Fourth Affirmative Defense and Paragraph 31 of Applicant's Fifth Affirmative Defense should be Stricken

Section B2 of Applicant's argument in opposition to the Motion to Strike offers no substantive response to Opposer's request that Applicant's Fourth and Fifth Affirmative Defenses be stricken. Applicant simply makes patently false statements to attempt to prove that Opposer's goods and Applicant's goods are marketed to different consumers and travel in different channels of trade. Applicant is using the inappropriate forum of a response to Motion to Strike in which to argue the overall merits of its case.

Applicant claims that Opposer's goods are only cosmetics, which is untrue. Opposer's registrations cover numerous other goods in class 3 including shampoo and conditioner—the same goods identified in Applicant's application.

As Opposer noted in its Motion, it is a well-established rule that where goods are broadly described in an application or registration, without any restriction as to classes of purchasers or trade channels, it creates the legal presumptions that: (1) the description encompasses all goods or types of goods embraced by the broad terminology; (2) the goods move through all of the channels of trade suitable for goods of that type; and (3) they reach all potential users or customers for such goods. See *Warnaco Inc. v. Adventure Knits Inc.*, 210 USPQ 307, 314-315 (TTAB 1981); and *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738, 741 (TTAB 1978). See also, *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009) citing *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992), *Genesco Inc. v. Martz*, 66 USPQ2d 1260 (TTAB 2003) and *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994) and see *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715 (TTAB 2008) citing *Hewlett Packard Co. v. Packard Press Inc.*, 62 USPQ2d 1001 (Fed. Cir. 2002).[1]

Applicant has no use of the mark as yet and so cannot overcome the foregoing presumptions. Furthermore, Applicant's statements that 1) the channels of trade for pet goods are obvious; 2) Opposer's goods are limited to end users who wear cosmetics; 3) legally identical and related or complementary goods are also interchangeable; 4) products designed for people are harmful when used on dogs; and 5) cosmetic products might be purchased for use by pet owner consumers on their pets, used to support its claim that the goods under each of the marks are sold to different consumers and in different channels of trade, are at best simply wrong and at worst downright ludicrous. The fact of the matter is the goods in Applicant's application are broadly described. There is no restriction as to classes of purchasers or trade channels. Therefore, it must be presumed as a matter of law that the description encompasses all goods or

[1] Applicant accused Opposer of citing cases that were over two decades old. Opposer contends that an older case that has not been overturned simply represents good law. However, Opposer hereby cites more recent cases to show the same principles still apply.

types of goods embraced by the broad terminology, that the goods move through all of the channels of trade suitable for goods of that type, and that they reach all potential users or customers for such goods. Applicant's affirmative defenses in paragraphs 30 and 31 regarding different channels of trade and different consumers are not valid as a matter of law, and should be stricken.

Paragraph 39 of Applicant's Eighth Affirmative Defense should be Stricken as it has been conceded by Applicant

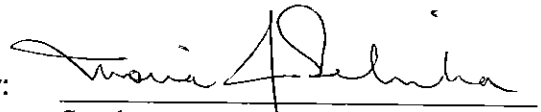
Applicant has conceded that paragraph 39 of its Eighth Affirmative Defense should be stricken. Therefore, Opposer respectfully requests that it be so stricken.

WHEREFORE, Opposer respectfully requests that its Motion to Strike Paragraphs 20, 30, 31 and 39 of Applicant's Affirmative Defenses in its Answer to the Notice of Opposition be granted in all respects.

Respectfully submitted,

Dated: July 22, 2009

BORGHESE TRADEMARKS INC.

By: 

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CERTIFICATE OF SERVICE

I hereby certify a copy of the foregoing Opposer's Reply Brief in Support of Its Motion to Strike Applicant's Affirmative Defenses in re: Borghese Trademarks, Inc. v. Multi Media Exposure, Inc., Opposition No. 91189629 was served on counsel for Applicant, this 22nd day of July, 2009 by sending same via First Class Mail, postage prepaid, to:

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