ESTTA Tracking number: **ESTTA371608**
Filing date: **10/04/2010**

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

Proceeding	91196237
Party	Defendant Franco Tricoci Enterprises
Correspondence Address	NICO TRICOCI FRANCO TRICOCI ENTERPRISES 1026 W DEVON AVE ELK GROVE, IL 60007-7226 UNITED STATES francotricoci@sbcglobal.net
Submission	Answer
Filer's Name	Mitchell J. Edlund
Filer's e-mail	mitch.edlund@mbtlaw.com
Signature	/s/ Mitchell J. Edlund
Date	10/04/2010
Attachments	anspto001.PDF (11 pages)(395984 bytes)

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

MARIO TRICOCI HAIR SALONS AND DAY SPAS, INC.,	)	
Opposer,	)	Opposition No.: 91196237
v.	)	Serial No. 77/933,627 Filed: February 11, 2010
FRANCO TRICOCI ENTERPRISES, LLC,	)	
Applicant.	)	**ANSWER TO NOTICE OF OPPOSITION AND AFFIRMATIVE DEFENSES**

Applicant, Franco Tricoci Enterprises, LLC ("Franco Tricoci"), Answers Opposer, Mario Tricoci Hair Salons and Day Spas, Inc.'s ("Opposer"), Notice of Opposition and submits its Affirmative Defenses as follows:

1. Mr. Mario Tricoci, who is still affiliated with and a minority owner of Mario Tricoci, is an internationally renowned hair stylist and innovator in the salon world. Mr. Tricoci has devoted over 30 years to building the MARIO TRICOCI brand into a name synonymous with outstanding quality, style and service. Over ten years ago, Mario Tricoci recognized the value of the MARIO TRICOCI brand and acquired the business and the trademarks protecting the brand.

ANSWER: Franco Tricoci is without knowledge or information sufficient to form a belief as to the truth of whether Mr. Mario Tricoci is still affiliated with and is a minority owner of Mario Tricoci Hair Salons and Day Spas, Inc. Further answering, Franco Tricoci denies the remaining allegations contained in paragraph 1. Franco Tricoci affirmatively states that Mr. Franco Tricoci ("Franco") has used the "Tricoci" name for nearly 50 years and the FT (stylized) mark over 30 years to promote his salons, hair design schools and beauty products. Franco

Tricoci further states that at the time Opposer's parent company, Elizabeth Arden, purchased the various Mario Tricoci salons in May 2000, it knew or had knowledge of Franco's use of the "Tricoci" name and the FT mark in the beauty businesses. Although it had knowledge of Franco's use of the "Tricoci" name and the FT mark, Opposer raised no objection until sometime before the filing of the federal lawsuit, styled *Mario Tricoci Hair Salons and Day Spas, Inc. v. Franco Tricoci Salon and Spa Schaumburg, LLC, et al.,* Case No. 10 C 2268, currently pending in the United States District Court for the Northern District of Illinois.

2. Mario Tricoci now owns a family of federally registered MARIO TRICOCI marks, including the mark MT (Stylized), all of which are listed below:

Mark	**Registration No.**	**Registration Date**	**Goods**
MARIO TRICOCI	2,882,038	September 7, 2004	Hair and skin care preparations and services
MARIO TRICOCI TOO	2,882,037	September 7, 2004	Hair and skin care preparations and services
MARIO TRICOCI HAIR SALONS AND DAY SPAS	2,911,345	December 14, 2004	Hair and skin care preparations and services
MARIO TRICOCI HAIR SALONS AND DAY SPAS	2,911,575	December 14, 2004	Hair and skin care preparations and services
MT (stylized)	2,919,223	January 18, 2005	Hair and skin care preparations and services

(collectively the "MARIO TRICOCI Marks").

ANSWER: Franco Tricoci is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 2.

3. Pursuant to Section 7(b) of the Lanham Act, 15 U.S.C. § 1057(b), Mario Tricoci's federal registration certificates are prima facie evidence of the validity of these marks as well as Mario Tricoci's ownership and exclusive right to use these marks in connection with the identified goods and services. In fact, Mario Tricoci's exclusive right to use the marks for the goods and services recited in Registration Nos. 2,882,037 and 2,882,038 has achieved incontestable status under 15 U.S.C. § 1065.

ANSWER: Franco Tricoci makes no response to the allegations relating to sections of the Lanham Act, as the Lanham Act speaks for itself. Further answering, Franco Tricoci denies the remaining allegations contained in paragraph 3.

4. Mario Tricoci has expended millions of dollars to advertise and enhance the quality of its services and products symbolized by the MARIO TRICOCI Marks. As a result of the efforts of Mario Tricoci and its predecessor(s) in interest over more than three decades, the MARIO TRICOCI Marks have become, through widespread and favorable public acceptance and recognition, an asset of incalculable value as a symbol of Mario Tricoci, its quality services and products and its goodwill. Indeed, Mario Tricoci is acclaimed as the leading salon and spa in the Chicago area and as one of the leading salons in the country.

ANSWER: Franco Tricoci denies that Opposer's marks have achieved widespread public recognition. Further answering, Franco Tricoci is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in paragraph 4.

5. Long after Mario Tricoci's adoption and use of the MARIO TRICOCI Marks and after the MARIO TRICOCI Marks had become well known, Franco Tricoci set up new hair salons and spas under the confusingly similar mark FRANCO TRICOCI and filed Application Serial No. 77/933,627 to register the FT (stylized) mark for "beauty salon services; health spa

services, namely cosmetic body care services" in International Class 044. Franco Tricoci's conduct in promoting these new salons under their FRANCO TRICOCI and FT (stylized) marks reveals his intentions to exploit and take advantage of the tremendous goodwill associated with the MARIO TRICOCI Marks.

ANSWER: Franco Tricoci admits that it established two salons under the name Franco Tricoci and that it filed Application Serial No. 77/933,627 to register the FT (stylized) mark for beauty salon services, health spa services, namely cosmetic body care services in International Class 044. Franco Tricoci denies the remaining allegations contained in paragraph 5, including that it recently began operating hair salons under the Tricoci name. Franco Tricoci affirmatively states that the "Tricoci" name has consistently been used by Franco in connection with his salon ownership since 1963 and his "Tricoci" hair design schools since 1968, and since 1977 has used and promoted hair and beauty products under "Franco Tricoci," including the use of the FT (stylized) mark on products and advertisements.

6. Franco Tricoci had constructive knowledge of the MARIO TRICOCI Marks before filing Application Serial No. 77/933,627. Upon information and belief, Franco Tricoci had actual knowledge of the MARIO TRICOCI Marks before filing Application Serial No. 77/933,627.

ANSWER: Franco Tricoci admits that Mr. Mario Tricoci owned and operated various salons in the Chicago area under the Mario Tricoci name, but denies the remaining allegations contained in paragraph 6. Franco Tricoci affirmatively states that Franco has used the "Tricoci" name for nearly 50 years and the FT (stylized) mark over 30 years to promote his salons, hair design schools and beauty products.

7. Franco Tricoci's FT (stylized) mark is confusingly similar in sight, sound, and commercial impression to the MARIO TRICOCI Marks.

ANSWER: Franco Tricoci denies the allegations contained in paragraph 7. Franco Tricoci affirmatively states that Franco has used the "Tricoci" name for nearly 50 years and the FT (stylized) mark over 30 years to promote his salons, hair design schools and beauty products.

8. The services identified in Franco Tricoci's FT (stylized) application are highly related to those goods and services offered by Mario Tricoci under the MARIO TRICOCI Marks.

ANSWER: Franco Tricoci admits that it offers similar services as those offered by Opposer, but denies the remaining allegations contained in paragraph 8. Franco Tricoci affirmatively states that Franco has used the "Tricoci" name for nearly 50 years and the FT (stylized) mark over 30 years to promote his salons, hair design schools and beauty products.

9. Franco Tricoci's FT (stylized) mark so closely resembles MARIO TRICOCI Marks that, if used in connection with the applied-for services, it would be likely to cause confusion, mistake or deception of the relevant trade and public.

ANSWER: Franco Tricoci denies the allegations contained in paragraph 9. Franco Tricoci affirmatively states that Franco has used the "Tricoci" name for nearly 50 years and the FT (stylized) mark over 30 years to promote his salons, hair design schools and beauty products.

10. By reason of the foregoing, Mario Tricoci believes that it will be damaged by Franco Tricoci's registration of the FT (stylized) mark.

ANSWER: Franco Tricoci denies the allegations contained in paragraph 10.

WHEREFORE, Applicant, Franco Tricoci Enterprises, LLC, believes that Opposer will not be damaged by the registration of Franco Tricoci's FT (stylized) mark, particularly since the

"Tricoci" name and the FT mark have been used in the salon and beauty industry for well over 50 years and 30 years respectively before the Opposition was filed, and prays that Application Serial No. 77/933,627 be allowed.

GROUNDS FOR AVOIDANCE AND/OR AFFIRMATIVE DEFENSES

Applicant, Franco Tricoci Enterprises, LLC (collectively, "Franco Tricoci"), without waiving any of the denials contained in the foregoing Answer to Opposer's Notice of Opposition, assert the following defenses to the Opposition, without assuming the burden of proof related to these grounds or defenses, affirmative or otherwise, for matters for which the burden is not normally upon the responding party:

First Defense

The use by Franco Tricoci of the Tricoci name and the FT (stylized) mark is not likely to cause confusion.

Second Defense

The claims contained in Opposer's opposition are barred by the doctrine of unclean hands.

Third Defense

1. Opposer's claims are barred or limited by the doctrines of acquiescence and/or waiver based upon Opposer's parent company, Elizabeth Arden, expressly acknowledging that, at the time Opposer purchased the various Mario Tricoci salons in May 2000, the "Tricoci" name was already being used in association with numerous salon and beauty businesses owned and operated by Mr. Franco Tricoci ("Franco"), brother of Mr. Mario Tricoci ("Mario").

2. In May 2000, Opposer knew that Mario Tricoci was not (and is not) the only Tricoci-related beauty business and has never been used solely by Mario, as the "Tricoci" name

has consistently been used by Franco in connection with his salon ownership since 1963 and his hair design schools since 1968.

3. Similarly, at the time Opposer's parent company, Elizabeth Arden, purchased the various Mario Tricoci salons in May 2000, Opposer was aware that the FT mark had been used by Franco in the beauty industry for 30 years. It was on Tricoci School of Hair Design Inc.'s private label beauty products at the time Opposer's parent company, Elizabeth Arden, purchased the Mario Tricoci salons, and had been on such products since 1977.

4. Neither Mario Tricoci nor Elizabeth Arden ever made any efforts to stop Franco or the school/salon from using the "Tricoci" name or the FT mark on its beauty products. Subsequently, Opposer raised no objection until sometime before the filing of the federal lawsuit.

5. Additionally, in 2003, James Tricoci (Mario's former business partner and Franco's son) opened the James Tricoci Salon, less than eight miles from a Mario Tricoci salon, but upon information and belief, Opposer has never asked the James Tricoci Salon to stop using the Tricoci name.

6. Opposer's parent company, Elizabeth Arden, is also currently allowing Mario to use the "Tricoci" name in connection with Tricoci University of Beauty Culture ("Tricoci University"), which Mario operates and has an ownership interest in.

Fourth Defense

1. Opposer's claims are barred or limited by the doctrines of laches in that Mario has known for almost 50 years that Franco has continuously used the "Tricoci" name in the salon and beauty industry.

2. Since 1963 Franco and his brother Mario together opened their first salon in 1963, when they formed Tricoci Hair Ltd. By 1976, the brothers owned six Tricoci salons in the Chicago suburbs, including one in Schaumburg. In 1977, Franco purchased Mario's interest in the salon partnership with Franco and changed the name of the salons to Franco Tricoci Hair, Ltd.

3. Franco also began promoting the salons by using a stylized "FT" mark on the salons' communications, advertisements and private label beauty products, which he used in his salons and sold to the public. The FT mark has remained in use, with slight variations, for over 30 years. It was not until Mario left the partnership in 1977 and opened the Mario Tricoci Hair Company salon did he start using the Mario Tricoci name.

4. Additionally, in 2003, James Tricoci (Mario's former business partner and Franco's son) opened the James Tricoci Salon, less than eight miles from a Mario Tricoci salon, but upon information and belief, Opposer has never asked the James Tricoci Salon to stop using the Tricoci name.

5. Opposer's parent company, Elizabeth Arden, is also currently allowing Mario to use the "Tricoci" name in connection with Tricoci University, which Mario operates and has an ownership interest in.

Fifth Defense

1. Opposer's claims are barred or limited by the doctrines of laches because since at least by May 2000, Opposer's parent company, Elizabeth Arden, has been aware of Franco's use of the FT (stylized) mark on products and advertisements and of his use of the "Tricoci" name in the beauty businesses owned and operated by Franco. As alleged in the Third and Fourth Defenses above, at the time Opposer's parent company, Elizabeth Arden, purchased the various

Mario Tricoci salons in May 2000, it knew or had knowledge of Franco's use of the "Tricoci" name and the FT mark in the beauty businesses.

2. Although it had knowledge of Franco's use of the "Tricoci" name and the FT mark, it raised no objection until sometime before the filing of the federal lawsuit.

3. Should Opposer be allowed to assert its rights as alleged in its opposition, Franco Tricoci will be unduly prejudiced, especially since Franco was using the "Tricoci" name and FT mark for 30 years before Opposer's parent company, Elizabeth Arden, purchased the Mario Tricoci salons.

Sixth Defense

Opposer's claims are barred or limited by the competitor's privilege because Opposer is a direct competitor of Franco Tricoci, its respective products and services compete directly, and Franco Tricoci is properly competing in the marketplace.

Seventh Defense

Any rights of Opposer in or to the Mario Tricoci marks or the FT (stylized) mark were limited in geographic scope to the area in which Opposer offered its salon services and products.

Eighth Defense

Franco Tricoci reserves its right to allege further Defenses at a later date to conform to the facts of the case developed during discovery of this action and/or the pending federal action.

WHEREFORE, Applicant, Franco Tricoci Enterprises, LLC, believes that Opposer will not be damaged by the registration of Franco Tricoci's FT (stylized) mark, particularly since the "Tricoci" name and the FT mark have been used in the salon and beauty industry for well over 50 years and 30 years respectively before the Opposition was filed, and prays that Application Serial No. 77/933,627 be allowed.

Dated: October 4, 2010

Respectfully submitted,

By: /s/ Mitchell J. Edlund

Mitchell J. Edlund
MECKLER BULGER TILSON
MARICK & PEARSON LLP
123 N. Wacker Drive, Suite 1800
Chicago, IL 60606
Telephone: (312) 474-7900
Facsimile: (312) 474-7898

Attorneys for Franco Tricoci Enterprises, LLC

CERTIFICATE OF SERVICE

I hereby certify that on October 4, 2010, I served a true and correct copy of the foregoing **Answer to Notice of Opposition** on counsel for Opposer by U.S. Mail at the following address:

Thomas G. Pasternak
STEPTOE & JOHNSON LLP
115 South LaSalle Street
Suite 3100
Chicago, IL 60603

By: /s/ Mitchell J. Edlund
One of the Attorneys for Applicant
Franco Tricoci Enterprises, LLC

M:\14197\pleading\USPTO\anspto001me.doc