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April 27, 2012

Commissioner for Trademarks
Trademark Trial and Appeal Board
U. S. Patent and Trademark Office
Madison East, concourse Level, room C 55
600 Dulany Street
Arlington, VA 22314

Re: Ouidad v. John Paul Mitchell Systems
Response to Notice of Opposition
Mark: SUN SHIELD CONDITIONING SPRAY

Dear Trademark Trial and Appeal Board:

Enclosed please find the following:

1. Answer Notice of Opposition

Thank you for your anticipated help and cooperation in this matter.

Very truly yours,



Michaeline A. Ré

MAR:md
enclosures



04-30-2012

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

In the matter of trademark application Serial No. 85413546
For the mark: **SUN SHIELD CONDITIONING SPRAY**
Published in the Official Gazette on 02/21/2012

Ouidad Licensing, LLC

v.

John Paul Mitchell Systems Corporation

ANSWER

John Paul Mitchell Systems, (“JPMS”) is a California corporation located at 20705 Center Pointe Parkway, Santa Clarita, California, erroneously named herein as John Paul Mitchell System Corporation.

JPMS responds to the Notice of Opposition by Ouidad as follows:

1. JPMS lacks sufficient information or belief upon which to either admit or deny the allegations in paragraphs 1, 2 and 3 of the notice of opposition and based thereupon denies each and every allegation thereof.

2. JPMS denies the allegations in paragraph 4 of the notice of opposition that Ouidad has used the mark in commerce “exclusively” and alleges that at least two other competitors use the words “SUN SHIELD” in connection with the sale of similar goods, see Exhibit “1” for copies of the Topix Sun Shield Spray and Oscar Blandi Capri sun-Shield Spray advertisements. JPMS lacks sufficient information or belief upon which to either admit or deny the remaining allegations in paragraphs 4 of the notice of opposition and based thereupon denies each and every allegation thereof.

3. JPMS admits the allegations in paragraphs 5, 6 and 7 except that JPMS denies that Sun Shield is Ouidad’s trademark.

4. JPMS admits that it filed its application as a Section 1(b), intent to use, but alleges that it will amend its application since the product has been used in commerce since January 31, 2012 having sold 22,576 4.2 oz units and with orders for an additional 1,400 units.

5. JPMS lacks sufficient information or belief upon which to either admit or deny the allegations in paragraphs 9,10, 11, 12, 13 and 14 of the notice of opposition and based thereupon denies each and every allegation thereof, and specifically denies that Ouidad is the exclusive user of Sun Shield, see Exhibit “1.”

6. JPMS denies Ouidad's assertion that the JPMS mark is so similar that it will cause consumer confusion. The products are easily distinguished, the names of the products are not identical, sun shield describes a function of the products, and the products are not using the same marketing channels as set forth in Exhibit "1."

7. JPMS denies the allegations in paragraphs 16 and 17 of the notice of opposition.

8. JPMS lacks sufficient information or belief upon which to either admit or deny the allegations in paragraph 18 of the notice of opposition and based thereupon denies each and every allegation thereof.

9. JPMS admits the allegations in paragraph 19 of the notice of opposition.

10. JPMS admits it is in the business of selling hair care products but denies each and every other allegation in paragraph 20 of the notice of opposition.

AFFIRMATIVE DEFENSES

FIRST AFFIRMATIVE DEFENSE

(Failure to State a Claim)

1. The Notice of opposition, and each purported claim for relief alleged therein, fails to allege facts sufficient to constitute claims upon which relief can be granted.

SECOND AFFIRMATIVE DEFENSE

(Abandonment, 15USC§ 1115(b)(2))

2. Respondent alleges that plaintiff, and their assignors, predecessors-in-interest, and their licensees, abandoned its trademark, by allowing others to use the alleged mark for the sale of similar goods.

THIRD AFFIRMATIVE DEFENSE

(Misrepresentation of Source of Goods, 15 USC § 1115(b)(3))

3. Plaintiff has misrepresented the source of the goods in connection with which the trademark is used.

FOURTH AFFIRMATIVE DEFENSE

(Fair Use, 15 USC § 1115(b)(4))

4. Respondent alleges that its use of the term "sun shield" is a use as other than a trade mark in that the term "sun shield" is descriptive of, and is used by Respondent fairly and in good faith only to describe the use of its goods to its users.

FIFTH AFFIRMATIVE DEFENSE

(Prior Use, 15 USC 1115(b)(5))

5. Respondent used the descriptive term “sun shield” on packaging to describe its goods to its users and others used the term prior to plaintiff’s use of the mark and without knowledge of plaintiff’s prior claim and plaintiff’s use thereof.

SIXTH AFFIRMATIVE DEFENSE

(Use of Plaintiff Mark Violates Federal Antitrust Laws, 15 USC § 1115(b)(7))

6. Respondent alleges that plaintiff have used its trademark to violate the antitrust laws of the United States.

SEVENTH AFFIRMATIVE DEFENSE

(Laches, Estoppel, Acquiescence, 15 USC § 1115(b)(8))

7. Respondent alleges that plaintiff consented to Respondent and others use of the trademark during the period 2008 to the present, and therefore plaintiff’ action is barred by the equitable principles of laches, estoppel and acquiescence.

EIGHTH AFFIRMATIVE DEFENSE

(Estoppel)

8. Respondent alleges that plaintiff delayed in enforcing their rights, if any, during which time the alleged mark passed into usage as a generic name.

NINTH AFFIRMATIVE DEFENSE

(Estoppel)

9. Respondent alleges that plaintiff and their predecessors-in-interest delayed in enforcing their rights, if any, and plaintiff have only dubious title to the mark.

TENTH AFFIRMATIVE DEFENSE

(Estoppel)

10. Respondent alleges that plaintiff and any predecessors-in-interest delayed in enforcing their rights, if any, such that there is dubious likelihood of confusion between the marks as used.

ELEVENTH AFFIRMATIVE DEFENSE

(Unclean Hands, Estoppel)

11. Respondent alleges that plaintiff and any predecessors-in-interest delayed in enforcing their rights, if any, against this Respondent and/or many other users of the mark, including those registering the mark as part of another mark, misleading the public as to the

existence of any trademark rights.

TWELFTH AFFIRMATIVE DEFENSE
(Any Damage is the Result of Acts of Others)

12. While JPMS denies that Plaintiff have been damaged in any way, if it should be determined that Plaintiff have been damaged, then JPMS alleges that such damage was not caused by JPMS, but resulted from the conduct of Plaintiff or others who were either not employed by JPMS or acted outside the course and scope of employment, without the consent or ratification of JPMS.

THIRTEENTH AFFIRMATIVE DEFENSE
(Fraud)

13. Respondent is informed and believes and thereupon alleges that the notice of opposition is false and was fraudulently filed in that neither plaintiff nor any predecessor-in-interest disclosed the use in commerce of the alleged mark by others.

FOURTEENTH AFFIRMATIVE DEFENSE
(Fraud, Sherman Act §2)

14. Respondent is informed and believes and thereupon alleges that the notice of opposition is false and was fraudulently filed and is an attempt to monopolize the relevant market in violation of 15 USC §2.

FIFTEENTH AFFIRMATIVE DEFENSE
(Free Speech)

15. Respondent alleges that plaintiff is attempting to prohibit its rights protected by the United States Constitution to free speech.

SIXTEENTH AFFIRMATIVE DEFENSE
(Cancellation)

16. Respondent is informed and believes and thereupon alleges that the notice of opposition should be denied and the attempt to register SUN SHIELD should be canceled in that the mark has become generic pursuant to 15 USC § 1064(3).

SEVENTEENTH AFFIRMATIVE DEFENSE
(Cancellation)

17. Respondent is informed and believes and thereupon alleges that the notice of opposition should be denied and the attempt to register SUN SHIELD should be canceled in that the mark has become abandoned pursuant to 15 USC § 1064(3).

EIGHTEENTH AFFIRMATIVE DEFENSE
(Other Defenses)

18. Respondent alleges that it may have other separate and additional defenses of which they are currently not aware, and hereby reserves the right to assert them by amendment to this Answer as discovery continues.

WHEREFORE, Respondent JPMS prays that judgment be entered against Plaintiff as follows:

1. That Plaintiff take nothing by virtue of their Notice of opposition;
2. That the Notice of opposition be dismissed with prejudice;
3. For costs of suit incurred herein, including reasonable attorneys' fees; and;
4. For such other and further relief as the Court deems just and proper.

DATED: April 27, 2012

LAW OFFICES OF MICHAELINE A. RE

By: *Michaeline A. Re*

Michaeline A. Re

Attorneys for Respondent

JOHN PAUL MITCHELL SYSTEMS

Member of the California State Bar No. 77853

100 E. Corson Street, Third Floor

Pasadena, CA 91103

Tel. 626 396-9230

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

In the matter of trademark application Serial No. 85413546
For the mark: **SUN SHIELD CONDITIONING SPRAY**
Published in the Official Gazette on 02/21/2012

Ouidad Licensing, LLC

v.

John Paul Mitchell Systems

DECLARATION OF NIKOLA CLINE

I, Nikola Cline, declare as follows:

1. I am employed by John Paul Mitchell Systems as Senior Director of Marketing and have been involved in the development and marketing of the product SUN SHIELD CONDITIONING SPRAY. If called as a witness I could and would competently testify to the following from my own personal knowledge and experience.

2. I have been involved in the sales and marketing of hair care products since 1997 working with the Nexxus and Sebastian brands as well as Proctor and Gamble's professional hair care line prior to my employment with John Paul Mitchell Systems.

3. The product which is the subject of this opposition is part of a three product package of hair care products to protect and repair damage to hair by the sun. The products are all marketed under the PAUL MITCHELL® brand and prominently feature the brand name on the packaging. The three products currently being sold in this line are as follows:

- a. Sun Recovery Hydrating Shampoo, application Serial No. 85413527;
- b. Sun Shield Conditioning Spray, application Serial No. 85413527;
- c. After-Sun Replenishing Masque, application Serial No. 8613554.

Photographs of these products are attached hereto and incorporated herein by this reference as Exhibit "A."

4. The packaging containing these products are a distinctive in both packaging design and color. Each package is a bronze color with bright turquoise accent color. The PAUL MITCHELL® mark runs vertically on the front panel of each package in the largest type font.

5. John Paul Mitchell Systems has continuously marketed products under the PAUL MITCHELL® brand since 1980, or for more than thirty-two (32) years. It is a famous brand and the marketing strategy and channel of distribution is the professional salon market. The

company does not sell directly to mass retailers although some of its products are diverted to that channel by others. All of the marketing is directed toward the salon customer. The company does not sell directly to the public nor to mass retailers.

6. I am familiar with the Ouidad brand. This product line is linked to curly hair and its founder is a hairdresser with salons that feature cutting and styling curly hair as their specialty. The products are primarily sold through Sephora outlets, a mass retailer of cosmetic products. The products are available directly from Ouidad via their website and are sold in Ouidad salons and other salon retailers. They are not marketed as a salon only product.

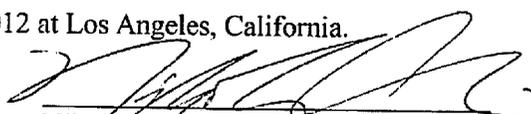
7. I have examined the packaging of Ouidad products, including the ones using SUN SHIELD on the packaging. The Ouidad brand name is prominently featured at the top horizontally across and in a large font. The pack color is silver-creamy color, large black type and a design with curls taking up more than fifty (50%) percent of the front panel.

8. Comparing the two packages shows that they are very different and it is my opinion that no consumer would be confused as to the identity of the source of the goods. It is my opinion that someone buying the PAUL MITCHELL® product would not buy it thinking it was an Ouidad product. There would be no lost sales, no confusion and no damages.

9. I did an Internet search and found two other brands selling similar products which incorporate the SUN SHIELD words in the product name. Oscar Blandi sells Capri Sun Shield Spray and Topix Sun Shield Spray also known as Derma Topix Sun Shield Spray. Each of the packaging for these other two brands are far more similar to Ouidad's products. Attached hereto and incorporated herein by this reference as Exhibit "B" is a copy of the Internet pages advertising the two other products.

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct.

Executed this 27th day of April 2012 at Los Angeles, California.


Nikola Cline



SUN RECOVERY HYDRATING SHAMPOO™

8.5 oz./250 ml

- Sulfate-free lather nourishes sun-struck strands and helps lock in hair color
- Leaves parched hair soft and silky
- Features SolarVeil™ Complex

Salon Price **\$8.50 ea.**
Suggested Retail \$16.99 ea.

AFTER-SUN REPLENISHING MASQUE™

8.5 oz./250 ml

- Helps guard locks from UV rays and prevent color fade
- Use it as an indulgent treat before, during and after a day in the sun
- Features SolarVeil™ Complex

Salon Price **\$9.50 ea.**
Suggested Retail \$18.99 ea.

SUN SHIELD CONDITIONING SPRAY™

4.2 oz./125 ml

- This poolside companion provides UV protection for fragile strands
- Spritz throughout the day to instantly soften hair, add brilliance and maintain vibrant, shiny hair color
- Features SolarVeil™ Complex

Salon Price **\$9.00 ea.**
Suggested Retail \$17.99 ea.

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Home : Brands : Topix : Topix Sun Shield Spray SPF 30

Topix

- Citrix
- Gly Sal
- Glycolix
- Replenix
- Resurfix
- Solvere
- SRS
- Urix

- Cleansers
- Exfoliators
- Eye Products
- Foot Care
- In Sun
- Moisturizers
- Regimens
- Sets And Kits
- Toners/Clarifiers
- Treatments

Topix



SKU# TP055

Topix Sun Shield Spray SPF 30

Be the first to rate this product | 4oz

\$24.60

Availability: In Stock

CHAT NOW »

SAVE WITH MY REFILLS

ADD TO MY FAVORITES

share with others

Like

SHARE

save 20% storewide
use code LUVMOM

Details

Description

description for Topix Sun Shield Spray SPF 30

Reviews

Sun Shield Spray SPF 30 is a convenient sunscreen that makes it easy to cover large areas of your body. This formulation also contains antioxidants to give skin additional protection against damaging free radicals.

Product Talk

Benefits:

May We Recommend

- Provides SPF 30 protection.
- Contains antioxidants to help protect skin.
- Provides anti-aging benefits.
- Lightweight texture.
- Great for all skin types.

Directions For Use

Directions For Use:

Adults and children 6 months of age and over, apply liberally before sun exposure. Reapply after swimming, excessive perspiring or anytime after towel drying.

Ingredients

Shipping Information

Additional Information

Please Note:

This item must be shipped via ground in accordance with federal law.

Smart Shopping beauty center

Get inspired

key ingredient

Shop our latest catalog

hypoallergenic firming eye cream

FREE Gift (\$17 Value) with \$100 Perricone MD purchase.

Shop Perricone MD

Offer available while supplies last.



SALE

while they last

Anti-aging Monthly Skin Regimen
Was \$55 | Now \$39.99 – One Week Only!

(Get started with NIA24)

free gifts with purchase

or little something extra

Sign up for SkinStore email Enter your email

SIGN ME UP

Newsletters | View the catalog

1 PROOF OF SERVICE

2 STATE OF CALIFORNIA)
3 COUNTY OF LOS ANGELES) ss

4 I am a resident of the State of California, over the age of 18 years, and not a party to the within
5 action. My business address is: Law Offices of Michaeline A. Ré, 100 E. Corson Street, Third Floor,
Pasadena, CA 91103. On April 27, 2012 I served the within documents:

6 ANSWER TO NOTICE OF OPPOSITION

7 - Facsimile Service: I sent such document from facsimile machine 626 396-9430 on 12-3-08. I
8 certify that said transmission was completed and that all pages were received and that a report
9 was generated by facsimile machine 626 396-9430 which confirms said transmission and receipt.
I, thereafter, mailed a copy to the interested party(ies) in this action by placing a true copy thereof
10 enclosed in sealed envelope(s), postage fully prepaid, addressed to the parties listed below and
deposited it in the U.S. mail at 100 E. Corson Street, Third Floor, Pasadena, CA 91103

11 x by placing the document(s) listed above in a sealed envelope with postage thereon fully prepaid,
in the U.S. mail at 100 E. Corson Street, Third Floor, Pasadena, CA 91103 as set forth below.

12 — by personally delivering the document(s) listed above to the person(s) at the addresses set forth
13 bellow.

14 Richard M. Hunter, Esq.
15 LUBOJA & THAU, LLP
16 10 East Fortieth Street
New York, NY 10016
Facsimile 212 252-0457

17 I declare under penalty of perjury under the laws of the State of California that the foregoing is
18 true and correct.

19 Executed on 27th day of April 2012, at Pasadena, California.

20 
21 Michaeline A. Ré