

ESTTA Tracking number: **ESTTA574624**

Filing date: **12/04/2013**

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

Proceeding	91212703
Party	Defendant Craig Andrew Delmo as trustee for The IRS Holdings Unit Trust and Margaret Mirsalina Clayton as trustee for the IRS Holdings Unit Trust
Correspondence Address	CRAIG ANDREW DELMO AS TRUSTEE FOR THE IRS ET AL C/- 22 ROCKLEA DRIVE PORT MELBOURNE, AUSTRALIA agoldstein@freeborn.com
Submission	Answer
Filer's Name	David L. Ter Molen
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Signature	/David L. Ter Molen/
Date	12/04/2013
Attachments	Instant Rockstar - Answer and Affirmative Defenses.pdf(498464 bytes)

Opposer's web page, located at <terencerenati.com>, includes "testimonials" in which purported consumers complain about not being able to locate Opposer's products in the United States. (See Exhibit A, hereto.) Accordingly, Applicant denies the allegations in Paragraph 3.

4. Admitted. Further answering, Applicant states that it has been using its INSTANT ROCKSTAR mark in the United States for a number of years in connection with a variety of hair care products.

5. Denied.

6. Denied.

7. Denied.

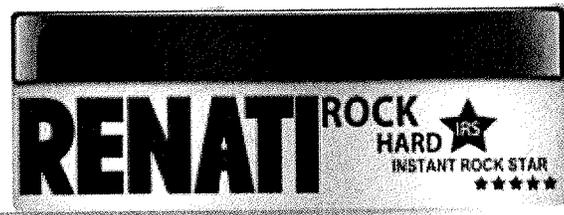
8. Applicant denies that it needs the consent or permission of Opposer to use the trademark INSTANT ROCKSTAR in the United States and denies that Opposer has superior rights in the United States with respect to this mark. Consistent with the foregoing, Opposer admits that it has not sought Opposer's consent or permission to use the trademark INSTANT ROCKSTAR in the United States because no such consent or permission is required.

Affirmative Defenses

1. Opposer's Notice of Opposition fails and/or is barred because, on information and belief, Opposer has either not used the mark INSTANT ROCK STAR in the United States or any such use does not constitute bona fide use of the mark in the ordinary course of trade.

2. Opposer's Notice of Opposition fails and/or is barred because, to the extent Opposer established any use of the mark INSTANT ROCK STAR in the United States, any continuing use of the INSTANT ROCK STAR mark is mere token use that does not satisfy the requirements of continuing use in interstate commerce.

3. Opposer's Notice of Opposition fails and/or is barred by the doctrine of unclean hands. Specifically, Opposer falsely states that Opposer (a) has used the INSTANT ROCK STAR mark "in the United States in connection with hair products in commerce, validly, continuously, and exclusively, without abandonment, for a number of years in connection hair care products" and that such use is "widespread," (b) has "developed goodwill" in the United States in connection with the mark, and (c) has engaged in "advertising [and] promotion" directed to the "consuming public" in the United States. *See* Notice of Opposition, ¶¶ 5-6. After conducting a diligent investigation, however, Applicant cannot locate any evidence supporting any of the foregoing allegations. In fact, Opposer's web page, located at <terencerenati.com>, includes "testimonials" in which purported consumers complain about not being able to locate Opposer's products in the United States. (*See* Exhibit A hereto). Opposer's false statements in this regard were undertaken for the sole purpose of attempting to prevent Applicant from obtaining U.S. trademark registration for its internationally well-known INSTANT ROCKSTAR hair care products. Moreover, Applicant and Opposer are both from Australia and it was Applicant that developed and used the INSTANT ROCKSTAR mark in Australia. In contrast, Opposer branded its hair care products under the separate and distinct RENATI mark. Opposer, however, has recently promoted a product called **RENATI ROCK HARD IRS INSTANT ROCKSTAR**, depicted below.



On information and belief, the words "Instant Rock Star" were added solely as a potential means to exclude Applicant's well-known INSTANT ROCKSTAR mark from certain markets, such as

the European Union. Accordingly, for all the foregoing reasons, the Notice of Opposition fails and/or is barred by the doctrine of unclean hands.

WHEREFORE, Applicant respectfully requests that the Board dismiss this notice of opposition proceeding in its entirety.

Respectfully submitted,

December 5, 2013

/s/ David L. Ter Molen
Andrew L. Goldstein
David L. Ter Molen

Attorneys for Applicants Craig Andrew Delmo,
as trustee for The IRS Holdings Unit Trust,
and Margaret Mirsalina Clayton, as trustee for
The IRS Holdings Unit Trust

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EXHIBIT A



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TESTIMONIALS

Terence thanks all you faithful loyal patrons! Keep using Wax and keep me updated on how my Wax has changed your life! Come on, Make My Day!

I'm a Norwegian student, currently living in Hawaii, US.

Life as a graduate student in Hawaii is great, but there is one thing missing in my life.

Ever since a friend introduced me to your great Strong Hold hair wax many years ago, it's been with me everywhere. My problem is that I'm all out of wax, and I can't get hold of any more here in the US. I've tried several products from different brands, but none is able to replace your great wax, by far. Therefore I was wondering if you could please send me some of your Renati Strong Hold wax?

This would definitely ease my everyday life, and I can focus 100% on my school work.

It would be a perfect gift for Christmas, and I promise I will continue to be a loyal customer for the rest of my life!

- Andreas H.

I've been using renati for years now and I'm super happy with it! I just fell in love with your product after trying it some years ago, and never stopped using it since. I don't know if you receive this kind of mail very often, but I just wanted to say thanks! I can't remember having a bad hair day since I started with it :) Keep on working, and improving your product!

- Chris

I was recently in Sweden & whilst having my hair cut there, I was introduced to your products. I purchased the 'Rock Hard' hair wax & now that I have run out, I cannot seem to find any in Adelaide. The guy that cut my hair in Sweden was also surprised that I hadn't heard of your products up till then! Could you please tell me how I can purchase replacements?? Have you considered setting up an 'online store' to sell your products? I was impressed with the wax & would like to get some more!

Thanks

- Darren M.

Hi my name is Espen P. a born Norwegian who is currently living in the US. As a big fan of your products I made my mom ship over some cans of Soft Hold. However I was wondering how I should store those cans and is it any "use by that date" on them. Or is the products as good if you use them a year later assuming that the cap is still on?

- Espen P.

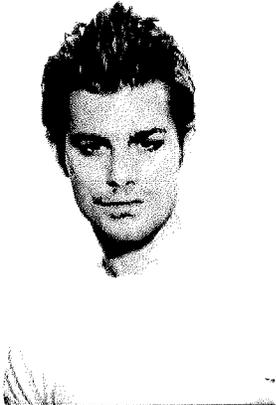
I really like your product, and have no problem finding it in my home country Norway. However, I am now living in Barcelona and cannot find your product. Is there any reason to continue looking? You do not happen to know where?

- Anders G.

My name is Christian L. I'm an exchange student from Norway who currently lives in North Carolina, USA.

I have been using your hair products since I can remember. My mom has always given me the opportunity to try the new products since she is a Hairdresser and a big fan of your products. I'm currently using your Renati Shampoo and Renati Strong Hold hair wax, and I LOVE THEM!

But I have a little problem; I can't find your products down here in the US. And my friends down here are literally crazy after it. They are always asking for my wax and asking me if my mom can send some to them. It has worked out pretty



Achieved with Rock Hard IRS Instant Rock Star

good so far, but it gets kind of expensive when she has to pay for the waxes for me and all my friends. So I just wondered if it's possible to buy your products anywhere in the US? Or if it's possible to order some?

- Christian L.

Does the below screen print tell me that your products are not sold here in the US?
I have been looking for your products everywhere and I am not happy with the products I have tried as substitutes over here, as they do not live up to my expectations. If I am wrong and you do sell your products in the US please direct me to a source.

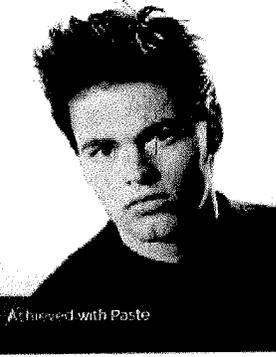
- Alf K.

I lived in Stockholm some months and I started using your Waxes "Strong Hold". I love the effect and I can't find any better. Now I'm back in Lisbon (Portugal) and I couldn't find it anywhere. I found your website and saw that you don't have a Renati Distributor in Portugal. Is there any possibility to purchase your products and send it to my address?
Looking forward to an answer.
Regards,

- Frederico C.



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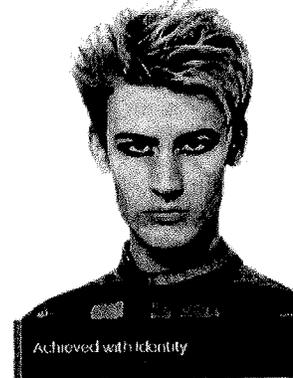
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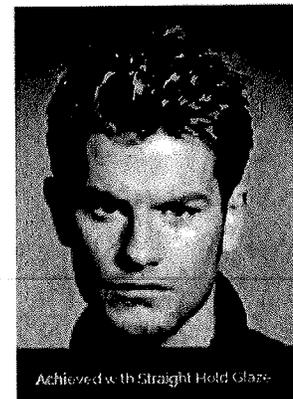
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Achieved with Straight Hold Glaze

Next Page >

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TESTIMONIALS

Terence thanks all you faithful loyal patrons! Keep using Wax and keep me updated on how my Wax has changed your life! Come on, Make My Day!

I recently moved from Norway to the US and have been a user of Soft Hold. I thought I would easily find Renati in the States, unfortunately not. Any advice on how I can get some Soft Hold?

- Hunter .F

HELLO HEY!!
SKICKA UPP HÄRLIGASTE 'ROCK HARD' OCH 'PASTE'-PROVERNA TILL SKÖNASTE NORRBOTTEN SÅ HAR NI LULEÅS GLADASTE KILLE HÄR!!
Could you please send up Rock Hard and Paste samples to Luleå, Norrbotten?
That would make me the happiest guy in the world!
Lots of love,

- Jonas .B

Hi Terence, I hope you still remember me. We have training with you in Singapore before. I understand from Lenz that he is no longer distributing Renati products but we are still interested to carry them. Have you got a distributor in Singapore already?

-Seng .W.T

We would like to express our interest in representing and distributing the Terence Renati products in the Dominican Republic. Med-Tec, S.A. was incorporated in 1991 as a wholesale distributor of professional beauty and consumer products. At the present time we represent and distribute several lines of Consumer, Professional Beauty, and Hair Care products from the United States and Europe. We have distribution channels nationwide and are supported by an excellent staff of sales people. Servicing: Salons, Spas, Supermarkets Pharmacies, Retailers, wholesalers, and Hotels.
We would like to expand and include among the lines that we represent, Terence Renati. We believe, in the Dominican Republic there is a great potential market for your products!
I look forward to receiving as much information as possible for us to begin this project and please do not hesitate in contacting us if you need further information. A complete list of the products and pricing would be a great start.

- Raquel .B

Our distribution companies in GR & CY sole business is distributing professional hair care to salons within our territory's. We have heard very positive comments about your products and brand and we are keen to commence dialog regarding the possibility of representing you within our territory's.

- Athos .

I have a salon in Adelaide SA and would like to try your wax. One of my clients wants me to get him some.

- Antonio

Hi My name is Helen from Allegria hair and beauty and I have a few clients who love your strong hold Glaze and I was wondering if there is anyone in Adelaide who sells it or can you tell me whom I can get it from anyway. I've been selling it now for over a year and the old supplier says they dont stock it anymore and just wanted to sell me their brand. Im sick of trying to replace one product with another and would like to keep stocking your product. Thank you

- Helen



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Hi Renati, I lived in Norway for 9 years. When I was living there i was using the Renati Rock Hard hair wax. About 5 years ago I moved back to my home country Iceland. What im trying to say is that for the past 5 years I have tried out too many different hair-waxes, and I cannot find any wax as good as the Renati Rock Hard.
My best friend is a hardresser and he is very interested to try the Renati products. No one in Iceland is selling this (that i know of)
So i need to know what i can do to be able to get this exellent products here in Iceland.

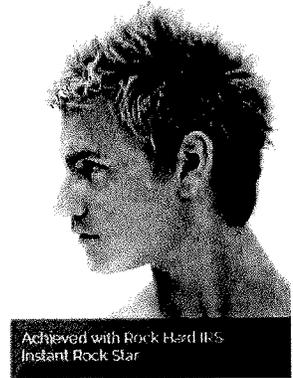
- Andri D P.

Hi, I wonder if Renati products are sold in USA? Do you have an internet address? I have moved from Norway to Las Vegas and I need it J

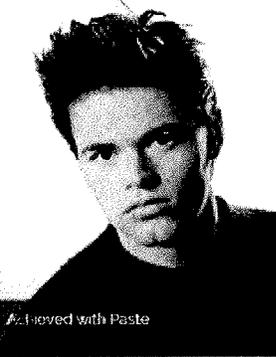
- Andreas H.

The reason for our email is that we would like you to consider our company to Represent your enterprise in the Honduran Market, Frangcias is well know For solidarity with companies all over the world our company distributes Professional hair Care, salon products to the local market, and we are currently looking to expand our distriбуtions. We are pioneers introducing the concept of professional care products to the Honduran market with experience since 1986. We would love to hear from your international department.

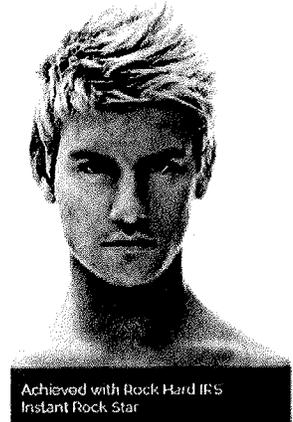
- Criss R.



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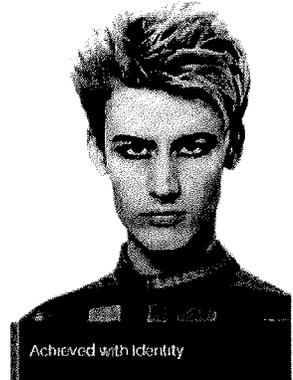
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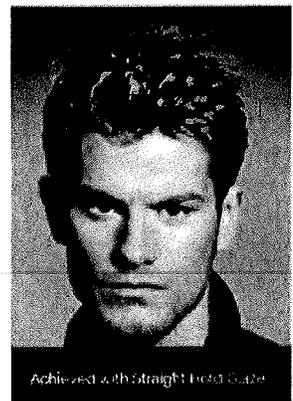
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Achieved with Straight Edge Care

[← Previous Page](#)

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TESTIMONIALS

Terence thanks all you faithful loyal patrons! Keep using Wax and keep me updated on how my Wax has changed your life! Come on, Make My Day!

Hi there
Im a Norwegian student, studying on the coast. I have looked everywhere for Renati, but I cant find it anywhere. Is it possible to buy it online, for then shipping it to here?

- Martin R

Dear Mr Renati, Let me tell u a story.... two months ago I went to a barbery shop to cut my hairs.After finish cutting my hairs the barber man started forming my hairs and he used a wax that it formed my hairs very well. When I asked the brand of that wax he told me it is Renati.I had never used any hair waxes befor that...then I decided to buy one but unfortunately I couldnot find it anywhere...therefor I called the barber and asked him where did you buy that wax and he answered I myself bought it when I was in a trip in Denmark.

Let me inform u that I work as a sales manager in a trading company called bagheri trading.Our main felid in this company is machinery of food industry and we are exclusive agent of more than 10 famous european companies in Iran.

I have studied your site and I am interested to know more about your company and products.I dont know if you have any information about Iran or not, but IRAN is a very very young country and our people pay attention about their hairs and faces and pay lots of money to have a better look.This is a fact and you can ask if you know some Iranian people.

Therefore I think there is a good market for your products especially your waxes in Iran and now if you are interested to work with Iran and have a good and honest partner we can start.

- Hamid

My name is Tore P, a former professional soccer player. I now work as an footballagent and one of our players is Morten Gamst Pedersen. I get all my Renati products in Norway , but I live in Germany and I just wondered if you can get the products there?
If not I would maybe be interested in taking the products there.
Hope to hear from you soon. Love your products.

- Tore P

I am from the Netherlands and I have a customers who are interested in your kind of quality products. I have several kind of companies and also in this market. My question is if there are possibilities to buy your products

- Jean V. W

Hi I am currently living in Arlington Virginia USA and cant seem to find a shop/salon that has your product. If there is one could you let me know where? Or if I can order online.

- Victor G.

Hello, can you please tell me where in Oslo or Bergen, Norway or in Copenhagen, Denmark I can buy your products Shaving cream and after shave Balm, I cannot find it anywhere in the hairdressers I've been looking for it. Looking forward hearing from you, Thanks.

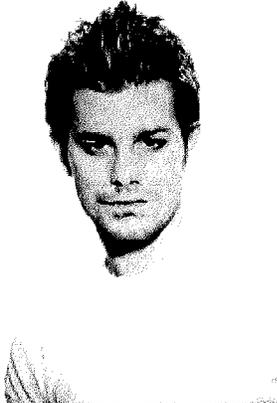
- Gunnar M.

Hi,I'd like to know if I can get your products in Albania.And which quantity I have to buy to get them direct from you?

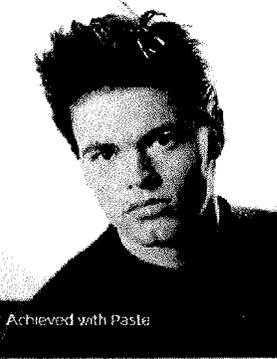
- Artur X.

Hey, I just moved to Barcelona, Spain. Where can I buy my Renati products? Its the product that works best for my hair. Hope to hear from you soon. Best Regards from a loyal Renati user!

- André T.



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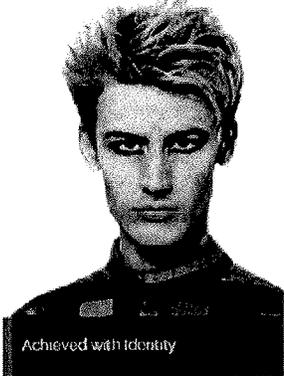
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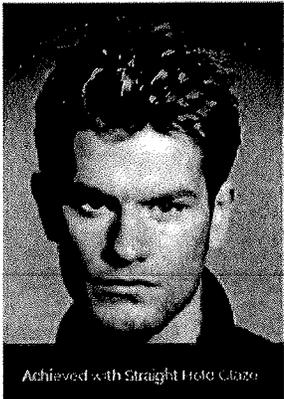
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Achieved with Straight Hole Claze

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