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

Proceeding	91214779
Party	Defendant Marke Enterprises, LLC
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Date	06/04/2014
Attachments	Reply to Opposition to Order to Show Cause.pdf(241202 bytes) Answer to Opposition 91214779.pdf(230777 bytes)

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

IN THE MATTER OF APPLICATION SERIAL NO. 86038104

PUBLISHED IN THE OFFICIAL GAZETTE OF JANUARY 7, 2014

COMBE INCORPORATED,)	
)	
Opposer,)	Opposition Proceeding
)	No. 91214779
v.)	
)	
MARKE ENTERPRISES, LLC,)	
)	
Applicant.)	

**APPLICANT'S REPLY TO OPPOSER'S OPPOSITION
TO APPLICANT'S OPPOSITION TO ORDER TO SHOW CAUSE
WHY JUDGMENT SHOULD NOT BE ENTERED AGAINST
APPLICANT IN ACCORDANCE WITH FED.R.CIV.P. 55(b)(2)**

Applicant Marke Enterprises, LLC, a Georgia limited liability company ("Applicant"), submits this Reply to the Opposition ("Opposer's Opposition") of Combe Incorporated, a Delaware corporation ("Opposer"), to Applicant's previously filed Brief in Opposition to Order to Show Cause Why Judgment By Default Should Not Be Entered Against Applicant in Accordance with Fed.R.Civ.P. 55(b)(2) (the "Show Cause Opposition").¹

¹ In the interests of brevity, capitalized terms used herein which are not otherwise defined shall have the meanings set forth in the Show Cause Opposition.

I. INTRODUCTION

In its response to the Notice of Default, Applicant, citing Fred Hayman Beverly Hills Inc. v. Jacques Bernier Inc., 21 U.S.P.Q.2d 1556, 1557 (T.T.A.B. 1991) and Keegel v. Key West & Caribbean Trading Co., 627 F.2d 372, 373 (D.C.Cir. 1980) ["Keegel"], argued that default judgment should not be entered against Applicant because Applicant's default was not the result of willfulness or gross negligence (Show Cause Opposition, pp. 3-4); that opening the default will occasion no substantial prejudice to Opposer (id., p. 4); and that Applicant has meritorious defenses to the Opposition (id., pp. 4-6). The Opposer's Opposition's sole disagreement is with the third of the foregoing arguments, that Applicant has meritorious defenses. See, Opposer's Opposition, pp. 1 & 4-9. As a threshold matter, Opposer complains that Applicant did not submit an answer with the Show Cause Opposition. Id., p. 4. The Show Cause Opposition specifically requested "that Applicant be allowed such time as the Court [sic] directs to respond to the Opposition." Show Cause Opposition, p. 6. Notwithstanding that request, Applicant is submitting its Answer concurrently with this Reply, and modifies its previous request for relief to include leave to file the same.

More importantly, Opposer claims that "Applicant's Opposition does not argue that there is no likelihood of confusion from Opposer's use of Opposer's Mark and Applicant's use of Applicant's Mark." Opposer's Opposition, p. 4. From this

false premise, Opposer jumps to the conclusion that "Applicant has for all intents and purposes conceded that confusion is inevitable" Ibid. The premise and the conclusion are both false. The Show Cause Opposition specifically asserts that Applicant is entitled to a defense of "famousness," described as meaning

that the public is not likely to be misled into thinking that Applicant's Mark is a variant of Opposer's Trademarks (see, e.g., Ringling Bros. v. Utah Division of Travel, 42 U.S.P.Q.2d 1161, 1171, 955 F.Supp. 605, 619-20 (E.D.Va. 1997), aff'd, 50 U.S.P.Q.2d 1065, 1076, 160 F.3d 449 (4th Cir. 1999) (slogan "The Greatest Snow on Earth" did not dilute mark "The Greatest Show on Earth"); American Express Co. v. CFK Inc., 41 U.S.P.Q.2d 1756, 1761-63, 947 F.Supp. 310, 318-19 (E.D.Mich. 1996) (triable issue of fact whether mark "Don't Leave Home Without Me Pocket Address Book" diluted the mark "Don't Leave Home Without _____"). Each

of the foregoing represents a genuine fact-based defense based upon the history of the Previous Mark and its cognizable distinctiveness from Opposer's Mark.

Show Cause Opposition, pp. 5-6; emphasis added. Unmistakably, Applicant has denied that there is a likelihood of confusion between Opposer's Mark and Applicant's Mark. With this in mind, the matter of defenses may be addressed.

II. APPLICANT HAS SUFFICIENTLY ESTABLISHED THE EXISTENCE OF MERITORIOUS DEFENSES TO THE OPPOSITION

A. Opposer Has Not Refuted The Proffered Affirmative Defenses.

The standard to be met by a litigant in seeking to show the existence of meritorious defenses for the purpose of setting aside a default has been described as follows:

The "absence of meritorious defense" criterion is also lacking. Likelihood of success is not the measure. Defendants' allegations are meritorious if they contain "even a hint of a suggestion" which, proven at trial, would constitute a complete defense. In their proposed answer, defendants here alleged lack of subject matter jurisdiction and denied any

misrepresentations, fraudulent acts, or securities law violations. Though somewhat broad and conclusory, those allegations adequately meet the meritorious defense criterion for setting aside the default.

Keegel, 627 F.2d at 374; citations omitted. Noting that Opposer acquiesced in the concurrent registration of the Previous Mark for more than seven years after Opposer's first trademark was issued (see, Show Cause Opposition, pp. 4-5; cf., Anheuser-Busch, Inc. v. Du Bois Brewing Co., 81 U.S.P.Q. 423, 175 F.2d 370, 374 (3d Cir. 1949)), that a laches defense may be based on an opposer's failure to object to an earlier expired registration of substantially the same mark for substantially the same goods (Aquion Pictures L.P. v. Envirogard Ltd., 43 U.S.P.Q.2d 1371, 1373 (T.T.A.B. 1991)), that Applicant asserts it relied on Opposer's inaction toward the Previous Mark in filing the initial application for registration (see, Decl., ¶¶5-6) and that Opposer did not even attempt to address the "famousness" defense on the merits (see, Opposer's Opposition, pp. 8-9), Applicant submits that the Keegel criterion for defenses has been met.

B. Applicant Has Denied Opposer's Claim Of Likelihood of Confusion, Constituting A Cognizable Defense As A Matter of Law.

Both in the Show Cause Opposition (see, pp. 5-6) and in the Answer lodged concurrently with this Reply (see, ¶¶27-30 & 35), Applicant has denied Opposer's claim of likelihood of

confusion between Opposer's Marks and Applicant's Mark. By well-established authority, this is a factual contention notoriously difficult to dispose of as a matter of law. See, e.g., In re E.I. du Pont de Nemours & Co., 177 U.S.P.Q. 563, 567, 476 F.2d 1357, 1361 (C.C.P.A. 1973) ("[t]here is no litmus rule which can provide a ready guide to all cases"). Moreover, what Opposer is seeking to do is appropriate the term "vagi," obviously descriptive of a body part, for its own future use in personal care products to the exclusion of the rest of the world. This it cannot do, as explained by the Second Circuit Court of Appeals:

A trademark holder cannot appropriate generic or descriptive terms for its exclusive use, and a trademark infringement finding thus cannot be based on the use of a generic or descriptive term such as "Hib." See, e.g., Flintkote Co. v. Tizer, 266 F.2d 849, 852 (3d Cir. 1959); Upjohn Co. v. Schwartz, 246 F.2d 254, 262 (2d Cir. 1957); Eastern Wine Corp. v. Winslow-Warren, Ltd., 137 F.2d 955, 959 (2d Cir.), cert. denied, 320 U.S. 758, 64 S.Ct. 65, 88 L.Ed. 452 (1943). . . .

This principle applies equally to a generic component of a trademark. Although such a component will not necessarily render the entire mark invalid, its presence does affect

the analysis of whether a competitor's mark containing the same component is likely to create confusion. As a result, because the generic term "Hib" may not be appropriate by Lederle for its exclusive use, any likelihood of confusion between HibVAX and HIB-IMUNE, and any consequent finding of infringement, must be based on a similarity between the suffixes "VAX" and "IMUNE." The very statement of the issue, however, resolves it. The suffixes are totally different. They are of different length, sound, and appearance. They share not even a letter in common.

American Cyanamid Corp. v. Connaught Laboratories, Inc., 231 U.S.P.Q. 128, 129, 800 F.2d 306, 308 (2d Cir. 1986).

The applicability of the quoted case to the Opposition is immediate. Eliminating the generic term "VAGI" from the two trademarks, the task of determining likelihood of confusion reduces to that of ascertaining how similar "SIL" -- Opposer's distinctive designation, used in its even more famous trademark "CLEARASIL" -- is to "SERT." It isn't. If anything, Applicant is not only entitled to relief from default; Applicant may even be entitled to judgment.

III. CONCLUSION

Not only has Opposer applied too strict a standard in evaluating Applicant's affirmative defenses; Applicant did not,

and does not, concede Opposer's case-in-chief, as to which Applicant, based on the doctrine of American Cyanamid Corp., supra, would appear to have the upper hand. Opposer's attack on the existence of meritorious defenses fails, the relief requested by the Show Cause Opposition should be granted, and the proposed Answer filed.

Respectfully submitted,

Dated: June 4, 2014

MARKE ENTERPRISES, LLC

By: /Brian J. Jacobs/
Brian J. Jacobs
Brian J. Jacobs, Attorney at Law
6464 Woodman Avenue, Suite 103
Van Nuys, California 91401
Telephone: (310) 770-6874
Attorney for Applicant

PROOF OF SERVICE

STATE OF CALIFORNIA, COUNTY OF LOS ANGELES:

I am employed in the County of Los Angeles, State of California. I am over the age of 18 and not a party to the within action; my business address is 6464 Woodman Avenue, Suite 103, Van Nuys, California 91401.

On June 4, 2014, I served the foregoing document described as **APPLICANT'S REPLY TO OPPOSER'S OPPOSITION TO APPLICANT'S OPPOSITION TO ORDER TO SHOW CAUSE WHY JUDGMENT SHOULD NOT BE ENTERED AGAINST APPLICANT IN ACCORDANCE WITH FED.R.CIV.P. 55(b)(2)** on the interested parties in this action by placing true copies thereof enclosed in (a) sealed envelope(s) addressed as follows:

Robert R. Caliri
Alissa A. Digman
Olson & Cepuritis, Ltd.
20 North Wacker Drive
36th Floor
Chicago, Illinois 60606

I deposited this envelope in the mail at Los Angeles, California. The envelope was mailed with postage thereon fully prepaid.

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

BRIAN J. JACOBS
Type or Print Name

/Brian J. Jacobs/
Signature

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

IN THE MATTER OF APPLICATION SERIAL NO. 86038104

PUBLISHED IN THE OFFICIAL GAZETTE OF JANUARY 7, 2014

COMBE INCORPORATED,)	
)	
Opposer,)	Opposition Proceeding
)	No. 91214779
v.)	
)	
MARKE ENTERPRISES, LLC,)	
)	
Applicant.)	

APPLICANT'S ANSWER TO NOTICE OF OPPOSITION

Applicant Marke Enterprises, LLC, a Georgia limited liability company ("Applicant"), for its answer to the Notice of Opposition filed by Combe Incorporated, a Delaware corporation ("Opposer"), against application for registration of Applicant's trademark VAGISERT, Serial No. 86038104, filed August 14, 2013 and published in the Official Gazette of January 7, 2014, pleads and avers as follows:

1. Answering paragraph 1 of the Notice of Opposition, Applicant has no knowledge or information sufficient to form a belief as to the truth of the allegations contained therein, and accordingly denies the allegations.

2. Answering paragraph 2 of the Notice of Opposition, Applicant denies the allegations at least because Applicant does not know that Registration 1,104,172 is in fact Opposer's registration.

3. Answering paragraph 3 of the Notice of Opposition, Applicant admits the allegations thereof.

4. Answering paragraph 4 of the Notice of Opposition, Applicant denies the allegations at least because Applicant does not know that Registration 1,424,503 is in fact Opposer's registration.

5. Answering paragraph 5 of the Notice of Opposition, Applicant admits the allegations thereof.

6. Answering paragraph 6 of the Notice of Opposition, Applicant denies the allegations at least because Applicant does not know that Registration 2,971,826 is in fact Opposer's registration.

7. Answering paragraph 7 of the Notice of Opposition, Applicant admits the allegations thereof.

8. Answering paragraph 8 of the Notice of Opposition, Applicant denies the allegations at least because Applicant does not know that Registration 3,285,997 is in fact Opposer's registration.

9. Answering paragraph 9 of the Notice of Opposition, Applicant admits the allegations thereof.

10. Answering paragraph 10 of the Notice of Opposition, Applicant denies the allegations at least because Applicant does not know that Registration 3,696,951 is in fact Opposer's registration.

11. Answering paragraph 11 of the Notice of Opposition, Applicant admits the allegations thereof.

12. Answering paragraph 12 of the Notice of Opposition, Applicant denies the allegations at least because Applicant does not know that Registration 4,073,832 is in fact Opposer's registration.

13. Answering paragraph 13 of the Notice of Opposition, Applicant admits the allegations thereof.

14. Answering paragraph 14 of the Notice of Opposition, Applicant denies the allegations at least because Applicant does not know that Registration 4,205,458 is in fact Opposer's registration.

15. Answering paragraph 15 of the Notice of Opposition, Applicant admits the allegations thereof.

16. Answering paragraph 16 of the Notice of Opposition, Applicant denies the allegations at least because Applicant does not know that Registration 4,343,995 is in fact Opposer's registration.

17. Answering paragraph 17 of the Notice of Opposition, Applicant admits the allegations thereof.

18. Answering paragraph 18 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to form a belief as to the truth of the allegations contained therein, and accordingly denies the same. Applicant does note that Exhibits 1 through 8 do appear to be copies of trademark registrations and TSDR database printouts.

19. Answering paragraph 19 of the Notice of Opposition, Applicant admits the allegations thereof.

20. Answering paragraph 20 of the Notice of Opposition, Applicant admits the allegations thereof.

21. Answering paragraph 21 of the Notice of Opposition, Applicant admits the allegations thereof.

22. Answering paragraph 22 of the Notice of Opposition, Applicant admits the allegations thereof.

23. Answering paragraph 23 of the Notice of Opposition, Applicant admits the allegations thereof.

24. Answering paragraph 24 of the Notice of Opposition, Applicant admits the allegations thereof.

25. Answering paragraph 25 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to form a belief as to the truth of the allegations contained therein, and accordingly denies the same. Applicant does note that Exhibits 1 through 8 do appear to be copies of trademark registrations and TSDR database printouts.

26. Answering paragraph 26 of the Notice of Opposition, Applicant has no knowledge or information sufficient to form a belief as to the truth of the allegations contained therein, and accordingly denies the allegations.

27. Answering paragraph 27 of the Notice of Opposition, Applicant denies each and every allegation contained therein.

28. Answering paragraph 28 of the Notice of Opposition, Applicant admits that Applicant's goods would be offered through the same or similar channels of trade, and used by one or more of the same classes of purchasers and users, and in all other

respects denies each and every averment contained therein.

29. Answering paragraph 29 of the Notice of Opposition, Applicant denies each and every allegation contained therein.

30. Answering paragraph 30 of the Notice of Opposition, Applicant denies each and every allegation contained therein.

31. Applicant further affirmatively alleges that as a result of the registration by The Chicago Pharmacal Company, an Illinois corporation ("Pharmacal"), on April 27, 1943 of a trademark identical to Applicant's mark herein as Registration 401,202 (the "Previous Mark"), just under 35 years before Opposer's application for the trademark attached to the Notice of Opposition as Exhibit 1 was filed and more than 42 years before Opposer's application for the trademark attached to the Notice of Opposition as Exhibit 2 was filed, in both cases without any cancellation proceedings ever being filed by Opposer against the Previous Mark, Opposer's Notice of Opposition is subject to the defense of acquiescence.

32. Applicant further alleges that as a result of the registration by Pharmacal on April 27, 1943 of the Previous Mark, just under 35 years before Opposer's application for the trademark attached to the Notice of Opposition as Exhibit 1 was filed and more than 42 years before Opposer's application for the trademark attached to the Notice of Opposition as Exhibit 2 was filed, in both cases without any cancellation proceedings ever being filed by Opposer against the Previous Mark, Opposer's Notice of Opposition is subject to the defense of laches.

33. Applicant further alleges that as a result of the registration by Pharmacal on April 27, 1943 of the Previous Mark, just under 35 years before Opposer's application for the trademark attached to the Notice of Opposition as Exhibit 1 was filed and more than 42 years before Opposer's application for the trademark attached to the Notice of Opposition as Exhibit 2 was filed, in both cases without any cancellation proceedings ever being filed by Opposer against the Previous Mark, Opposer's Notice of Opposition is subject to the defense of estoppel.

34. Applicant further alleges that as a result of the registration by Pharmacal on April 27, 1943 of the Previous Mark, just under 35 years before Opposer's application for the trademark attached to the Notice of Opposition as Exhibit 1 was filed and more than 42 years before Opposer's application for the trademark attached to the Notice of Opposition as Exhibit 2 was filed, in both cases without any cancellation proceedings ever being filed by Opposer against the Previous Mark, Opposer's Notice of Opposition is subject to the defense of famousness, in that the public is not likely to be misled into thinking that Applicant's trademark is a variant of any of Opposer's trademarks under such decisions as Ringling Bros. v. Utah Division of Travel, 42 U.S.P.Q.2d 1161, 1171 (E.D.Va. 1997), aff'd, 50 U.S.P.Q.2d 1065, 1076 (4th Cir. 1999) and American Express Co. v. CFK Inc., 41 U.S.P.Q.2d 1756, 1761-63 (E.D.Mich. 1996).

35. Applicant further affirmatively alleges that the initial part of Opposer's trademark, "VAGI," is merely generic or

descriptive for purposes of American Cyanamid Corp. v. Connaught Laboratories, Inc., 231 U.S.P.Q. 128, 129, 800 F.2d 306, 308 (2d Cir. 1986), and cannot be distinctive to Opposer. Since the remaining portion of Applicant's trademark "VAGISERT" is in no way similar to the remaining portion of the "VAGISIL" trademark of Opposer, there can be no likelihood of confusion.

In view of the foregoing, Applicant contends that this Opposition is groundless and baseless in fact; that Opposer has not shown wherein it will be, or is likely to be, damaged by the registration of Applicant's trademark; that Applicant's trademark is manifestly distinct from any alleged mark of Opposer or any designation of Opposer; and Applicant prays that this Opposition be dismissed and that Applicant be granted registration of its trademark.

Respectfully submitted,

Dated: June 4, 2014

MARKE ENTERPRISES, LLC

By: /Brian J. Jacobs/
Brian J. Jacobs
Brian J. Jacobs, Attorney at Law
6464 Woodman Avenue, Suite 103
Van Nuys, California 91401
Telephone: (310) 770-6874
Attorney for Applicant

PROOF OF SERVICE

STATE OF CALIFORNIA, COUNTY OF LOS ANGELES:

I am employed in the County of Los Angeles, State of California. I am over the age of 18 and not a party to the within action; my business address is 6464 Woodman Avenue, Suite 103, Van Nuys, California 91401.

On June 4, 2014, I served the foregoing document described as **APPLICANT'S ANSWER TO NOTICE OF OPPOSITION** on the interested parties in this action by placing true copies thereof enclosed in (a) sealed envelope(s) addressed as follows:

Robert R. Caliri
Alissa A. Digman
Olson & Cepuritis, Ltd.
20 North Wacker Drive
36th Floor
Chicago, Illinois 60606

I deposited this envelope in the mail at Los Angeles, California. The envelope was mailed with postage thereon fully prepaid.

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

BRIAN J. JACOBS
Type or Print Name

/Brian J. Jacobs/
Signature