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

Proceeding	91218304
Party	Plaintiff Kosan Kozmetik Sanayi Ve Ticaret Anonim Sirketi
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Date	05/20/2015
Attachments	2015-05-20 Opposer's Opposition to Applicants' Motion for Leave to Amend Their Answer to Add Counterclaims.pdf(5086404 bytes)

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

KOSAN KOZMETIK SANAYI VE TICARET ANONIM SIRKETI, OPPOSER, v. MIRJAM ASAM, MARCUS ASAM, and AXEL RUTH APPLICANTS	Opp. No. 91218304 Application Serial No.: 86080166 Mark: FLORA MARE & Design

OPPOSER'S OPPOSITION TO APPLICANT'S MOTION FOR LEAVE TO AMEND THEIR ANSWER TO ADD COUNTERCLAIMS

Applicants seek to amend their Answer, the original of which was filed on October 10, 2014, to add counterclaims against Opposer's pleaded Registrations. The grounds for such counterclaims are that Opposer lacked a bona fide intent to use at time of filing. Opposer believes that there is no basis for the counterclaims and that they violate the compulsory counterclaim rules.

THERE IS NO BASIS FOR THE COUNTERCLIAMS

In response to written discovery, Opposer has provided a representative sampling of evidence showing that its FLORMAR mark, the subject of Registration No. 4626632, is in use and has been in use since at least as early as 2012. Applicants' document requests asked for representative samples and that is what was produced. Opposer's website identifies no fewer than 26 categories of makeup, personal care products and related accessories (KOSAN00025 through KOSN00048 attached in Exhibit 4 to Applicants' Motion). Opposer identified its four franchised retail outlets in the United States and provided photos from the website showing scores of Class 3 cosmetic products bearing the mark FLORMAR on display in those locations (KOSAN00003 through KOSAN00020 attached as Exhibit 1).

Opposer provided photos of its trade show display in 2012 (KOSAN00021 through KOSAN00024 attached as Exhibit 2), again showing scores of Class 3 cosmetic products on display. By some convoluted reasoning, the Applicants believe that because Opposer did not specifically show and identify use for each and every item of goods in its Registration, all in Class 3, that it lacked a bona fide intent to use at the time of filing. That defies logic and is totally frivolous. What is logical is proof of use on dozens of goods and like kind goods in Class 3. This evidence demonstrates that the then applicant not only had the capacity to market and manufacture the goods identified in its applications, but it did so, further suggesting that the then applicant was acting in good faith and not merely trying to reserve a right in the FLORMAR and FLORMAR TURK MALI marks. *Commodore Electronics v. CBM Kabushiki Kaisha Opp.,* 26 USPQ2d 1503, 1507 (TTAB 1993).

Opposer's Reg. No. 4626632 is based on section 66(a) of the Trademark Act. It was filed on January 18, 2012. No demonstration of use is required prior to registration for an application based on the Madrid Protocol. The attendance at a trade show in the same year as the filing affords a strong inference that Opposer did indeed have a bona fide intent at the time of filing.

Opposer's Reg. No. 4472 860 for the mark FLORMAR TURK MALI & Design is based on the Paris Convention. It was filed on November 6, 2006 and issued on January 28, 2014. Again no demonstration of use is required prior to registration for Section 44(e) applications. Opposer relies on evidence in the record of the Registration of an assignment of the mark to Opposer executed on July 24, 2013 as evidence of its ongoing bona fide intent to use the mark in commerce. The fact that Opposer does not have prior specific written evidence regarding its plans for use of this mark or that it has not yet commenced use of this particular mark does not mean that it did not have a bona fide intent to use the mark at the time of filing or now. Opposer's domain name www.flormar.com was created and registered on December 23, 1998. Opposer has been successfully marketing its cosmetics goods in Turkey and throughout Europe since that time. There is no reason to believe under the circumstances

that their intent with respect to the US is anything other than bona fide.

THE COUNTERCLAIMS ARE BARRED BY THE COMPULSORY COUNTERCLAIM RULES

Applicants no doubt reviewed Opposer's website prior to filing its Answer. There they would see a myriad of Class 3 products bearing the mark and being shown on display in Opposer's four US franchised retail outlets. These are the same materials, for the most part (other than the trade show evidence), produced in response to Applicants' document requests. Thus, Applicants had the materials that form the basis of its counterclaims at the time of filing the Answer. Trademark Rule 37 CFR § 2.106(b)(2)(i) states: "A defense attacking the validity of any one or more of the registrations pleaded in the opposition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed." *See, Jack Rajca v. New Yorker S.H.K. Jeans GmbH & Co. KG,* Cancellation No. 92056995 (July 22, 2014) *citing Turbo Sportswear Inc. v. Marmot Mountain Ltd.,* 77 USPQ2d 1152 (TTAB 2005).

As the information Applicants now have is essentially the same as the information it had at the time, Applicants could have alleged lack of a bona fide intent at the time it filed the Answer in the opposition. "If the grounds for a counterclaim are known to the applicant when the answer to the opposition is filed, the counterclaim shall be pleaded with or as part of the answer." 37 CFR § 2.106(b)(2)(i). *S & L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ 2d 1221 (TTAB 1987) (motion to amend answer to add additional ground to existing counterclaim denied since such ground was available at time of original answer). *See also, Consolidated Foods Corp. v. Big Red, Inc.*, 231 USPQ 744, 746 (TTAB 1986); *Vitaline, Corp. v. General Mills Inc.*, 13USPQ2d 1172, 1174 (Fed. Cir. 1989).

For the foregoing reasons, Opposer requests that the Board issue an order denying Applicants Motion.

Respectfully submitted,

Date: May 20, 2015

By:

P. Jay Hines

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Attorneys for Opposer

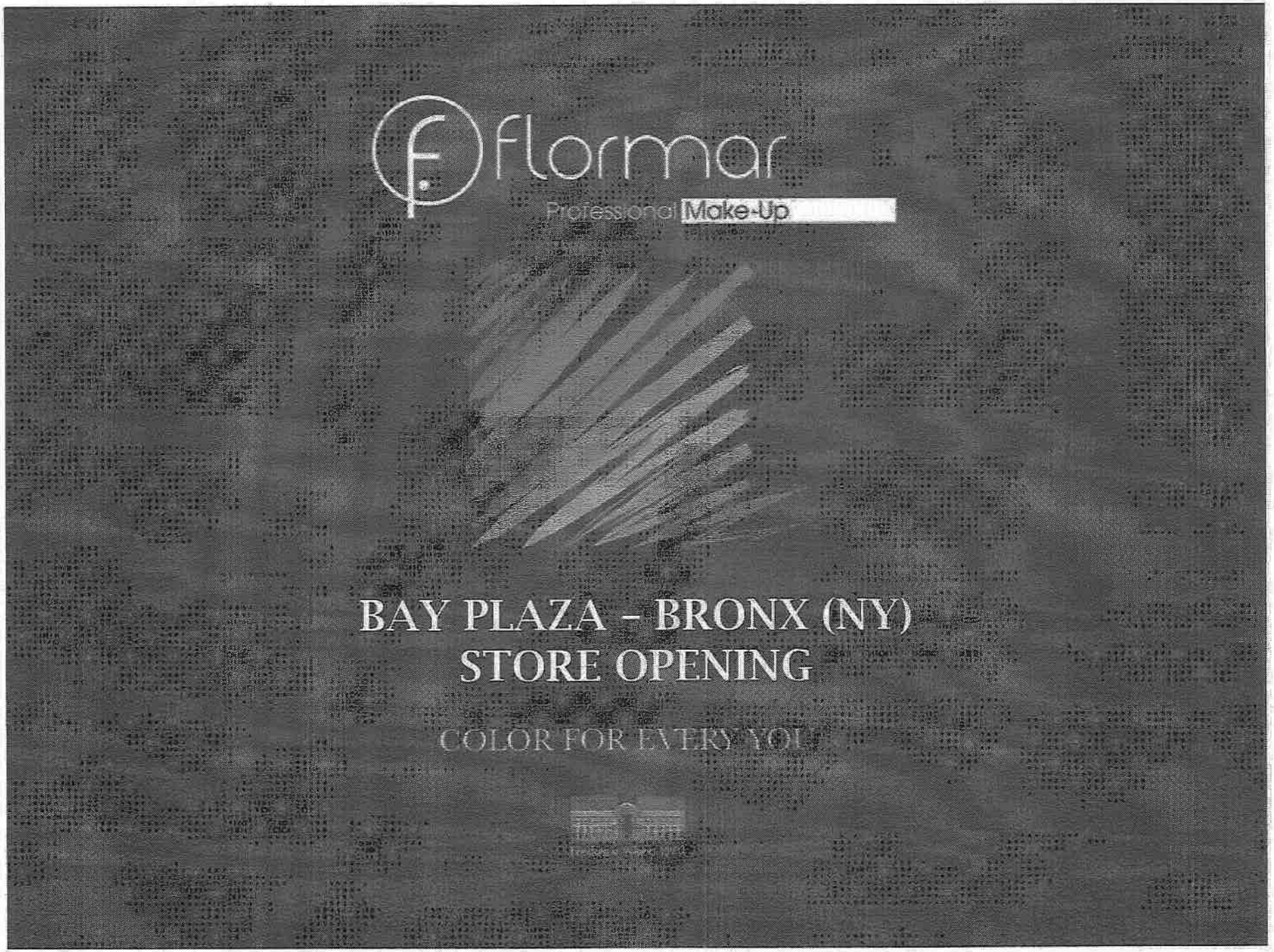
CERTIFICATE OF SERVICE

I hereby certify that a true copy of OPPOSER'S OPPOSITION TO APPLICANTS' MOTION FOR LEAVE TO AMEND THEIR ANSWER TO ADD COUNTERCLAIMS was served on by regular U.S. mail, postage prepaid, this 20th day of May 2015 to:

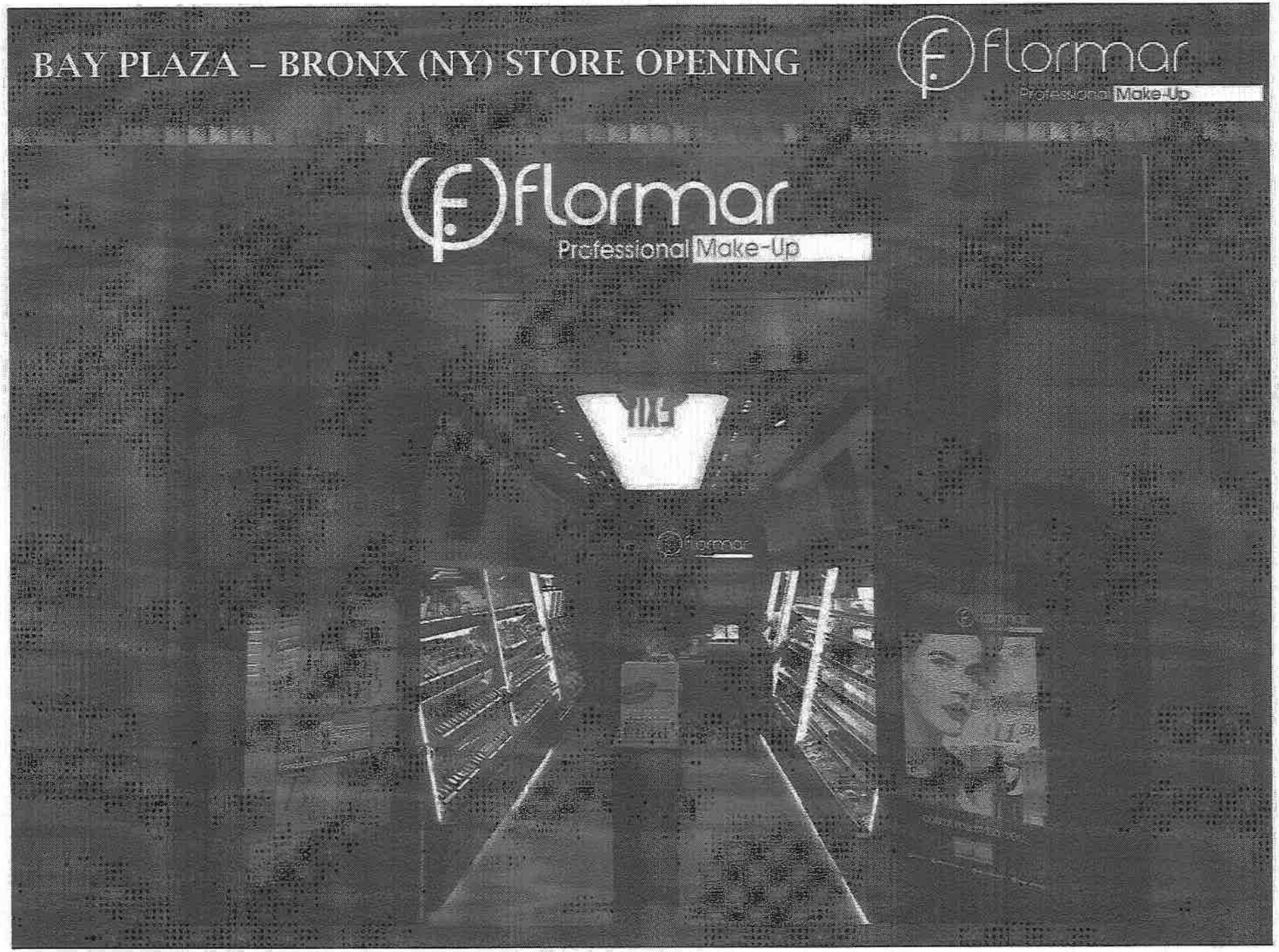
William C. Wright
Jason M. Drangel
Robert L. Epstein
Epstein Drangel LLP
60 East 42nd Street, Suite 2410
New York, New York 10165

Akiyo Yoshida

EXHIBIT 1


flormar
Professional Make-Up
BAY PLAZA – BRONX (NY)
STORE OPENING
COLOR FOR EVERY YOU

KOSAN00003


BAY PLAZA – BRONX (NY) STORE OPENING
flormar
Professional Make-Up
flormar
Professional Make-Up

KOSAN00004

BAY PLAZA - BRONX (NY) STORE OPENING

flormar
Professional Make-Up

KOSAN00005

BAY PLAZA – BRONX (NY) STORE OPENING
flormar
Professional Make-Up
PERSONAL CARE
NEW PRODUCTS

KOSAN00006

BAY PLAZA – BRONX (NY) STORE OPENING

flormar
Professional Make-Up

Flormar Bay Plaza Store

Address: 200 Baychester Avenue, Bronx,
10475 NY

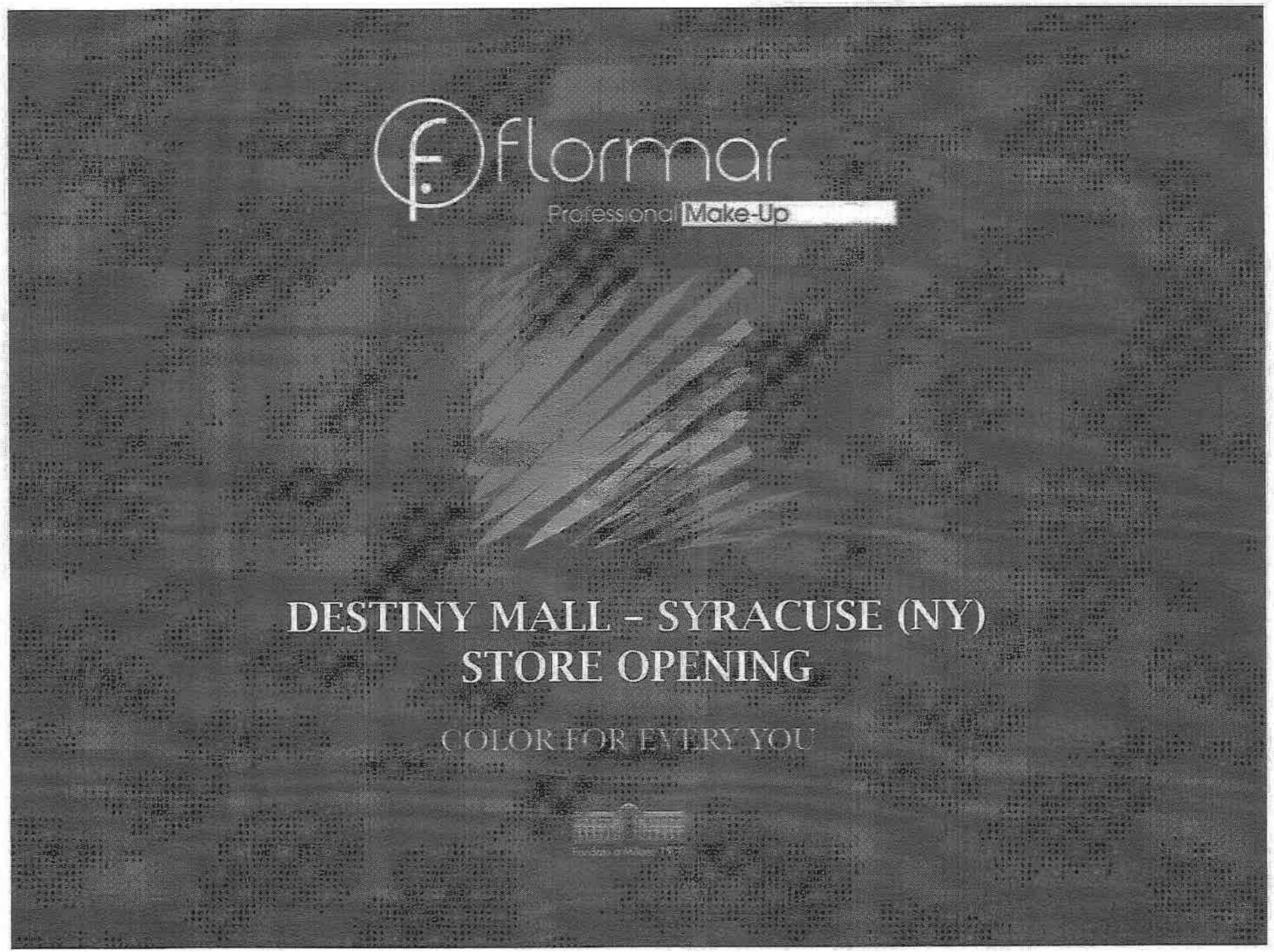
Phone: 347-331-0814

COLOR FOR EVERY YOU

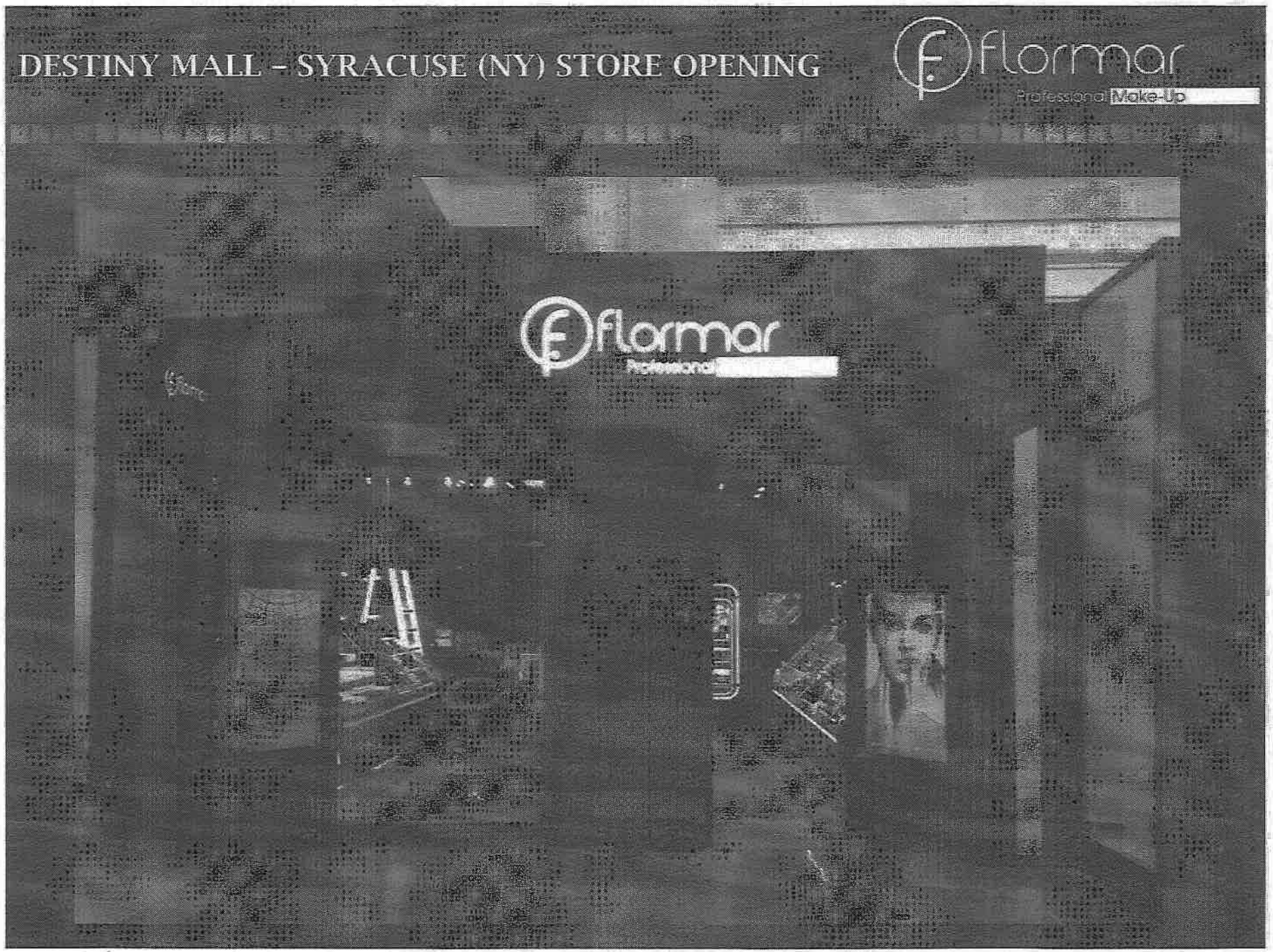
Fondata a Milano 1970

KOSAN00007

KOSAN00008


flormar
Professional Make-Up
DESTINY MALL - SYRACUSE (NY)
STORE OPENING
COLOR FOR EVERY YOU

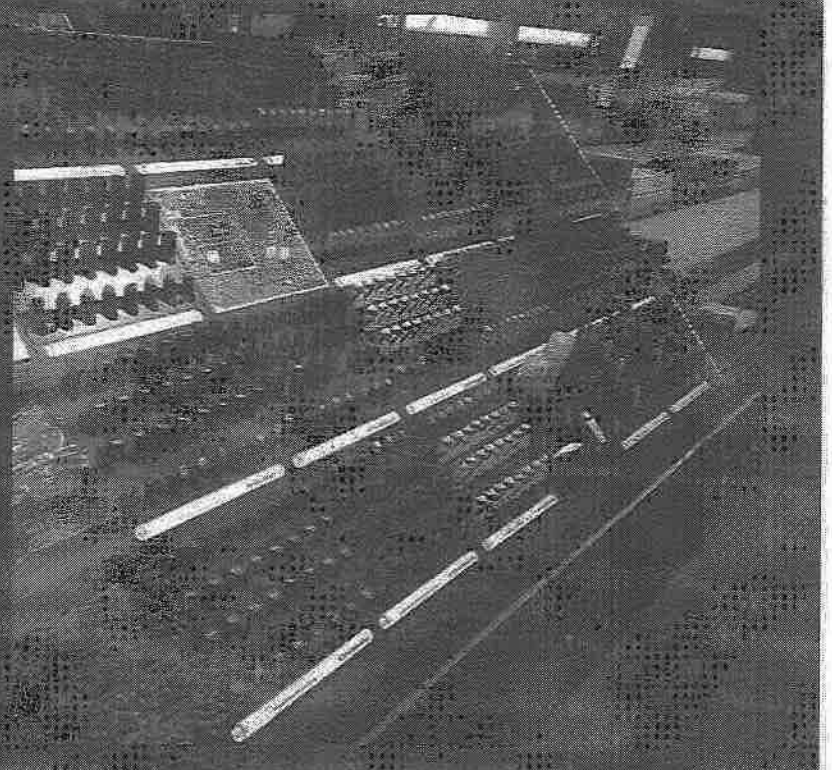
KOSAN00009


DESTINY MALL - SYRACUSE (NY) STORE OPENING
flormar
Professional Make-Up
flormar
Professional

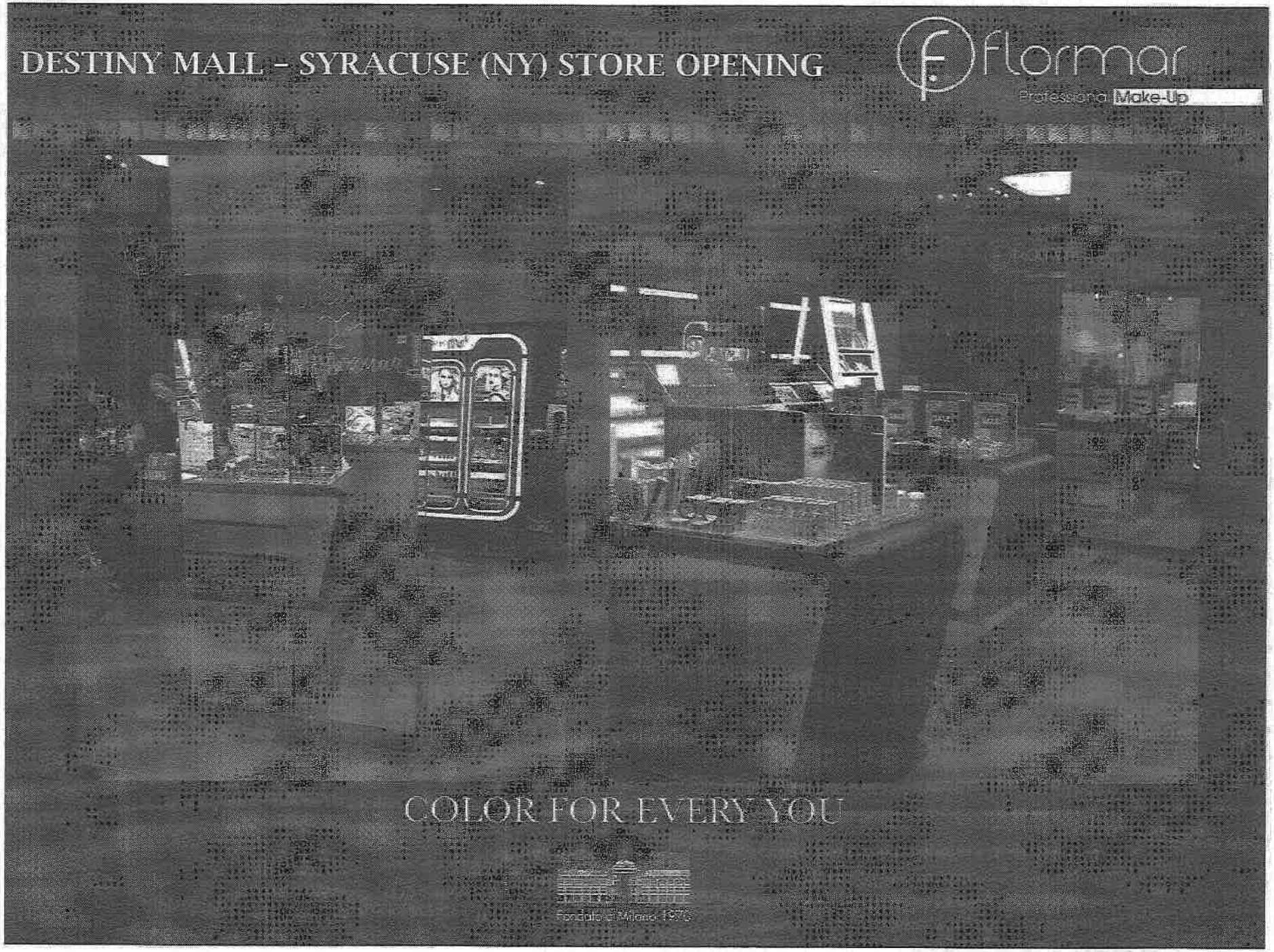
KOSAN00010

DESTINY MALL - SYRACUSE (NY) STORE OPENING

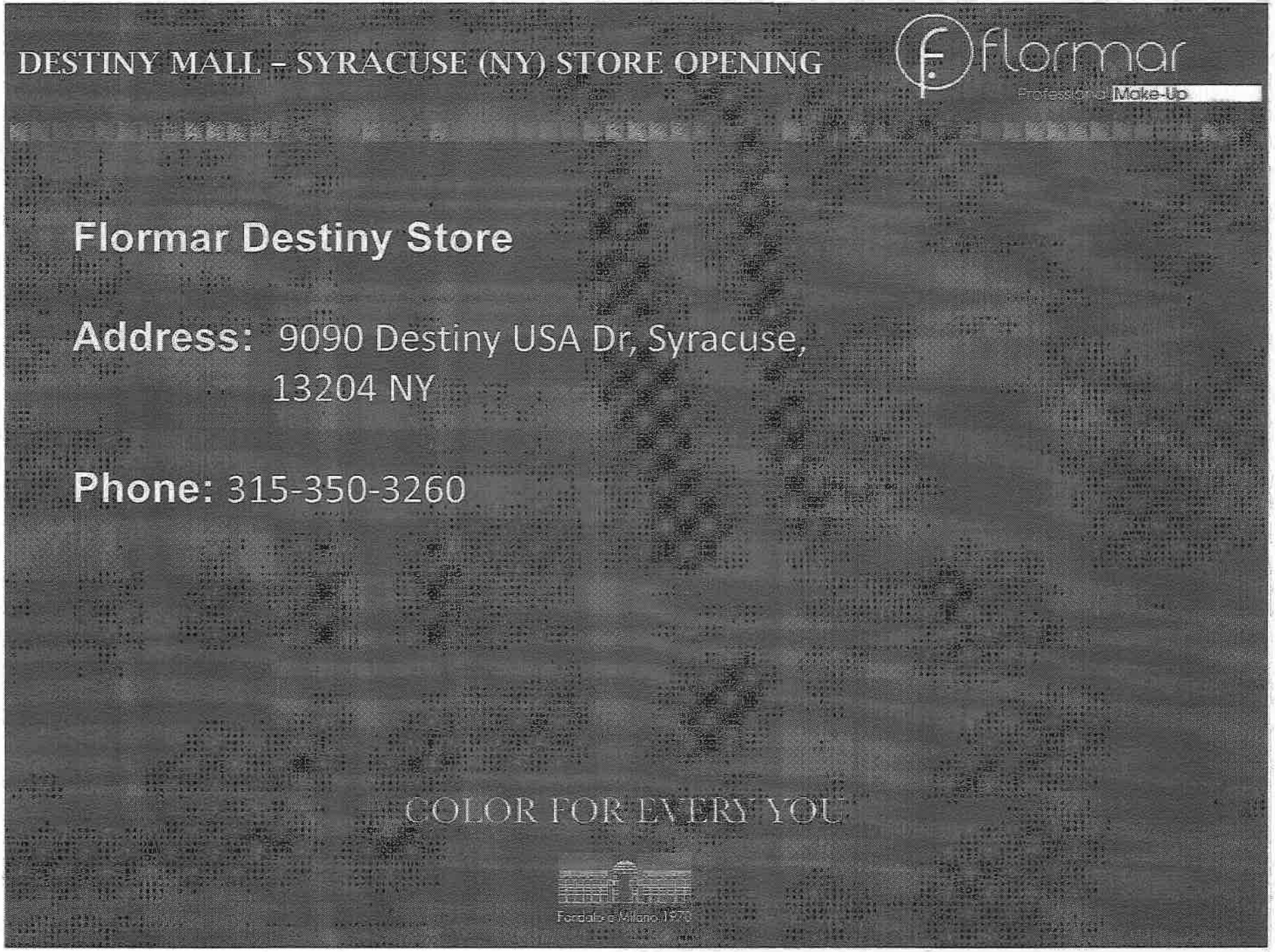
flormar
Professional Make-Up



KOSAN00011


DESTINY MALL - SYRACUSE (NY) STORE OPENING
flormar
Professional Make-Up
COLOR FOR EVERY YOU

KOSAN00012


DESTINY MALL – SYRACUSE (NY) STORE OPENING
flormar
Professional Make-Up
Flormar Destiny Store
Address: 9090 Destiny USA Dr, Syracuse, 13204 NY
Phone: 315-350-3260
COLOR FOR EVERY YOU
Fondata a Milano 1970

KOSAN00013

THANK YOU

COLOR FOR EVERY YOU

Fondata a Milano 1970

KOSAN00014

flormar

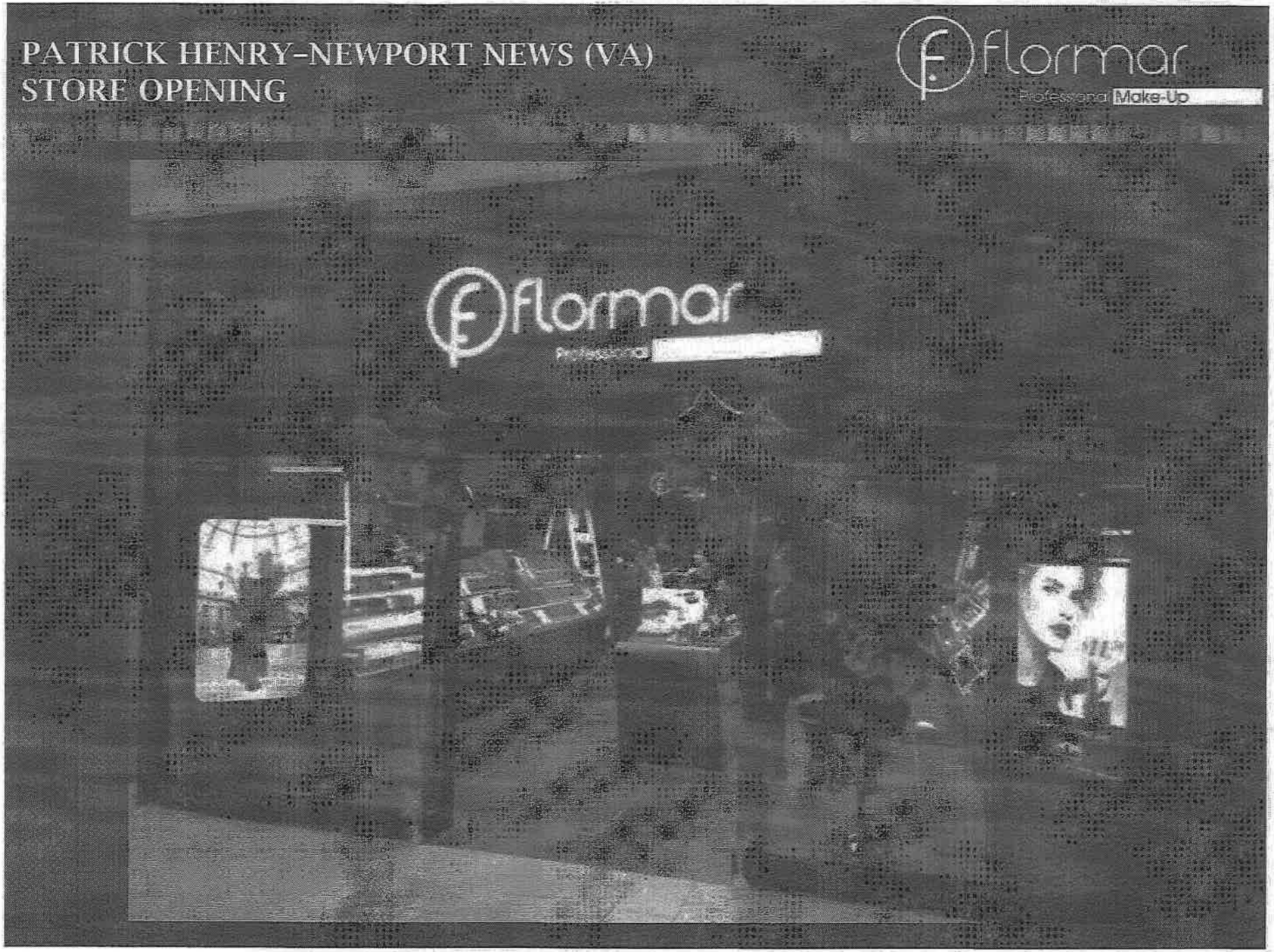
Professional Make-Up

PATRICK HENRY – NEWPORT NEWS (VA)
STORE OPENING

COLOR FOR EVERY YOU

KOSAN00015

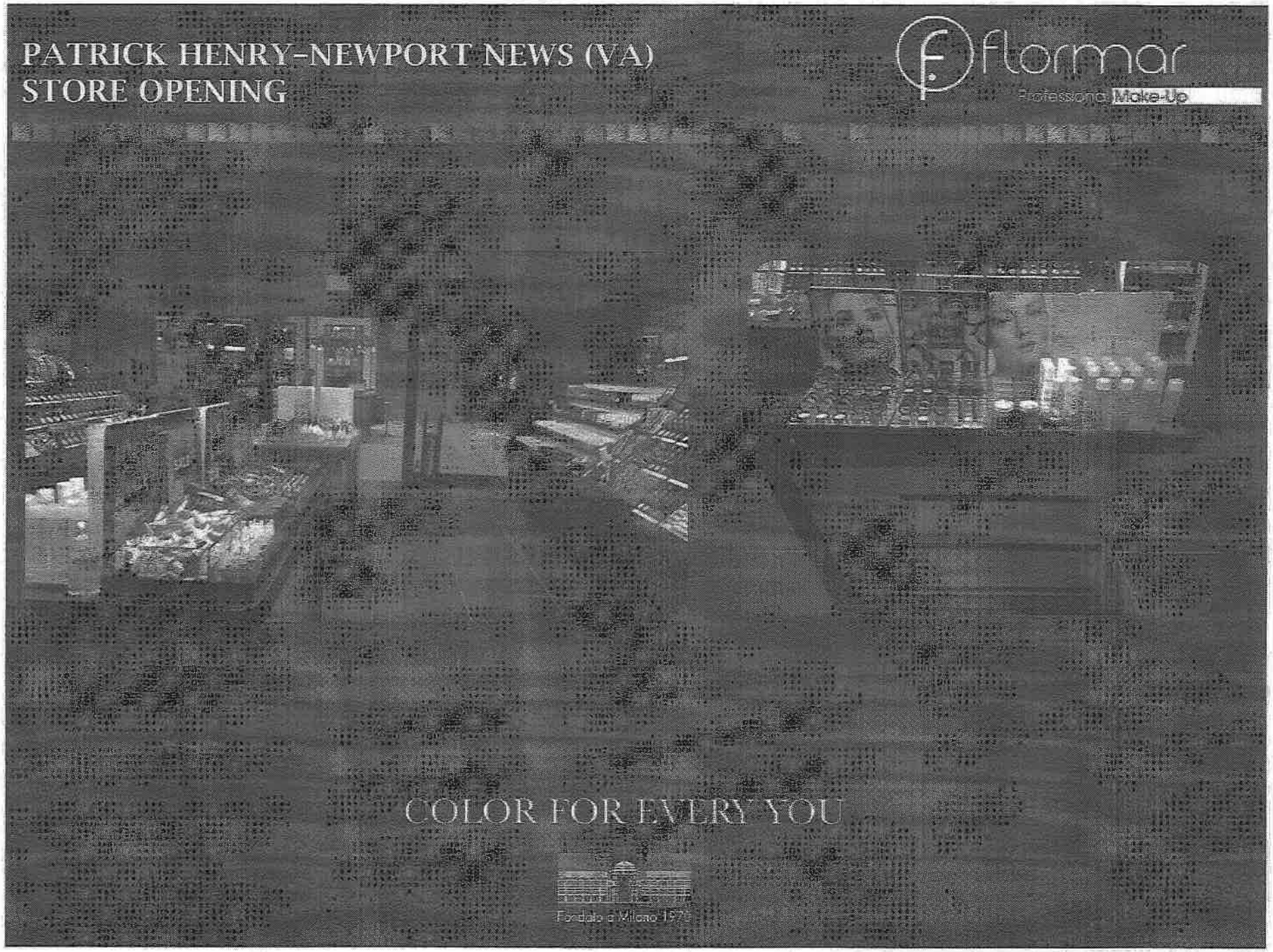
PATRICK HENRY-NEWPORT NEWS (VA)
STORE OPENING



KOSAN00016

PATRICK HENRY-NEWPORT NEWS (VA)
STORE OPENING
flormar
Professional Make-Up
COLOR FOR EVERY YOU
Fondata a Milano 1970

KOSAN00017


PATRICK HENRY-NEWPORT NEWS (VA)
STORE OPENING
flormar
Professional Make-Up
COLOR FOR EVERY YOU
Fondata a Milano 1971

KOSAN00018

PATRICK HENRY-NEWPORT NEWS (VA)
STORE OPENING

flormar
Professional Make-Up

Flormar Patrick Henry Store

Address: 12300 Jefferson Ave, Newport News, 23602 VA

Phone: 757-243-1872

COLOR FOR EVERY YOU

Fondata a Milano 1970

KOSAN00019

THANK YOU

COLOR FOR EVERY YOU

Fondato a Milano 1970

KOSAN00020

EXHIBIT 2

KOSAN
Kozmetik Pazarlama ve Ticaret A.Ş.
FLORMAR
Turkey
A19409
flormar
professional make-up
KOSAN00021

BULGARIA
CHINA
19 7 2010

FLORMAR
Turkey
A19409
HOSAN
Kozmetik Pazarlama ve Ticaret A.Ş.
KOSAN00023

A
KOSAN
Kozmetik Pazarlama ve Ticaret A.Ş.
FLORMAR
Turkey
A19409
ormar
ofessional make-u
19 7 2010
KOSAN00024