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

Proceeding	92052897
Party	Defendant Galderma Laboratories, Inc.
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Date	05/16/2011
Attachments	Reply in Support of Registrant's Motions to Dismiss or Strike Causes 2, 3, 4, 5, and 6.pdf ( 4 pages )(360752 bytes )



fails to explain how invalidating the assignment creates a ground for canceling a registration.

Registrant acknowledges that a trademark assignee may not be able to assert the benefit of a purchased trademark if it separates the mark from its prior goodwill—e.g., it may not be able to tack back to an earlier date of first use—but this is not the same as an independent ground for canceling a registration. In fact, in the case relied upon by the Petitioner, *Visa USA, Inc. v. Birmingham Trust Nat'l Bank*, 696 F.2d 1371 (Fed. Cir. 1982), the Federal Circuit was not reviewing the Board's decision to sustain an opposition on the ground that the applicant had received an assignment in gross, but that because the applicant had received an assignment in gross, the applicant could not tack back to an earlier date of first use, and thus opposer gained priority over the applicant in the mark at issue. So, the ground sustained in *Visa USA, Inc.* was priority and likelihood of confusion, not some newly-found ground established by Section 10 of the Lanham Act as Petitioner would have us believe.

In other words, while a finding that an assignment is in violation of Section 10 might change the facts of a dispute, it does not create a separate and independent cause of action—except in the case of an improper assignment of an intent-to-use application, which is not the case here. Accordingly, Registrant maintains that dismissal of Cause 3 is appropriate.

### **III. Cause 4, as Redefined in Petitioner's Brief, Is Redundant and Should Be Striken**

Petitioner, in his Amended Petition, added Cause 4 for "Deception Under Section 2(d) of the Lanham Act." Registrant, in its Motion to Strike this Cause, noted that a cause of action under Section 2(d) is for priority and likelihood of confusion, which Petitioner had already claimed in Cause 1. In Petitioner's Response, he now admits that he cited the wrong statutory authority in the Amended Petition for this Cause 4, and now wants Cause 4 to be construed as a ground for abandonment.

Registrant notes that this new understanding of the nature of Cause 4 is not incorporated into an Amended Petition and that the current, operative pleading remains incoherent. Registrant should not have to rely on subsequent briefing to decipher the nature of Petitioner's claims. But even if the Petition was amended again to have Cause 4 assert abandonment, it still would not state a cause of action distinct

from Cause 2 which already asserts abandonment and contains the identical factual allegations and arguments.

On its face, Cause 4 remains redundant of Cause 1 for likelihood of confusion/priority. In the alternative, based on Petitioner's Response, it is redundant of Petitioner's Cause 2 for abandonment. Accordingly, Cause 4 of the Amended Petition should be stricken.

**IV. Causes 5 and 6 Are Merely Restatements of Causes Already Found to Be Deficient**

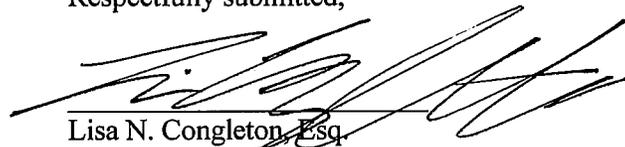
Causes 5 and 6, Petitioner's "First Contract Theory" and "Second Contract Theory," have already been found by the Board to be deficient. In Petitioner's Response, he does not refute this, but he simply asks one more time for the Board to reconsider its prior Order even though "Petitioner acknowledges that such is unlikely." Response at p. 5. Thus, his Response is not even responsive to Registrant's Motion to Strike these Causes, and thus Causes 5 and 6 should be stricken in their entirety for the reasons stated in Registrant's Motion to Strike them.

**V. Conclusion**

Registrant asks the Board to dismiss Cause 2 as it relates to Reg. No. 3,394,514 and dismiss Cause 3 in its entirety. Registrant further requests that the Board strike Causes 4, 5, and 6 in their entirety.

Respectfully submitted,

Date: May 16, 2011



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

**Thomas Skold**  
Petitioner,

v.

**Galderma Laboratories, L.P.**  
Registrant.



Cancellation No.: 92052897

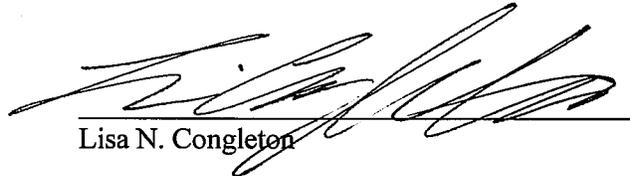
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Reg. Nos.: 2,985,751 and 3,394,514

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that on this 16th day of May, 2011, the foregoing Reply in Support of Registrant's Motions to Dismiss or Strike Causes 2 (in part), 3, 4, 5 and 6 of Petitioner's Amended Petition was served on Petitioner's counsel of record, via first-class mail to the following:

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