

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Alinnehan

Mailed: October 13, 2011

Cancellation No. 92052897

Thomas Sköld

v.

Galderma Laboratories, Inc.

Before Bucher, Zervas, and Bergsman,
Administrative Trademark Judges

By the Board:

Petitioner has filed a petition to cancel two registrations for the mark RESTORADERM for "therapeutic skin care preparations and treatment for skin" in International Class 5¹ and for "non-medicated skin care preparations" in International Class 3.² As grounds for cancellation, petitioner pleads priority of use and likelihood of confusion with its previously used mark RESTORADERM.³

This case now comes up for consideration of (1) respondent's fully-briefed motion (filed February 24, 2011) to strike and for a more definite statement Fed. R. Civ. P.

¹ Registration No. 2985751, issued August 16, 2005, alleging May 27, 2005, as a date of first use and first use in commerce.

² Registration No. 3394514, issued March 3, 2008, alleging June 21, 2007, as a date of first use and first use in commerce.

³ Petitioner also pleads ownership of application Serial No. 85037342 for the mark BASED ON RESTORADERM LIPOGRID TECHNOLOGY and Serial No. 85037362 for the mark RESTORADERM LIPIDGRID.

Cancellation No. 92052897

12(e); (2) petitioner's motion to amend its pleading; and (3) respondent's fully-briefed motion (filed April 4, 2011) to dismiss certain portions of petitioner's amended pleading and to strike certain portions of such amended pleading.

By way of background, on September 24, 2010, respondent filed a motion to dismiss under Fed. R. Civ. P. 12(b)(6). In an order issued on January 25, 2011, the Board denied the motion holding that petitioner had sufficiently alleged facts for priority of use and likelihood of confusion under Section 2(d) of the Trademark Act. The order further noted that petitioner's claim of breach of contract is not a proper grounds for cancellation and noted that if petitioner wants to plead abandonment or nonuse as grounds for cancellation of the subject registrations he must do so with specificity. The order allowed respondent until February 25, 2011 to file an answer. On February 24, 2011, respondent filed its combined motion to strike petitioner's initially-asserted ground that the "Mark is no longer owned by Registrant" from the petition to cancel and motion for a more definitive statement under Fed. R. Civ. P. 12(e) with regard to the priority of use and likelihood of confusion ground. Following an extension of time to file a brief in response to this combined motion, on February 23, 2011, petitioner filed his response brief along with a motion to amend his petition to cancel. A copy of the amended

Cancellation No. 92052897

pleading was filed with the motion. Thereafter, on April 11, 2011, respondent filed a combined motion to dismiss and motion to strike portions of the amended petition.

Petitioner's motion to amend his pleading is granted as conceded. Trademark Rule 2.127(a). The amended pleading is accepted into the record and is now the operative pleading. To the extent it concerns the original pleading filed by petitioner, respondent's February 24, 2011 combined motion to strike and for a more definite statement is, therefore, moot.

We now turn to respondent's April 11, 2011 motion to dismiss the second (in part) and third claims of the amended petition and to strike the fourth, fifth, and sixth claims of the amended petition.

Claim 2

Respondent seeks to "dismiss" the claim of abandonment as it relates to Registration No. 3394514. Respondent argues that allegations pertaining to petitioner's abandonment claim relate only to Registration No. 2985751, not to Registration No. 3394514, and in fact the allegations are presented under a heading which reads: "Cause 2: Abandonment of the '751 Registration." Respondent further alleges that in paragraph no. 55 of the petition to cancel, petitioner states that "Accordingly, Registration Nos. 2985751 and 3394514 should both be cancelled..." Respondent

Cancellation No. 92052897

argues that because petitioner has failed to allege any facts which, if proved, would establish abandonment of Registration No. 3394514, petitioner's ground of abandonment with respect to such registration should be dismissed.

In response, petitioner acknowledges that paragraph no. 55 mistakenly recited Registration No. 3394514 and that the claim of abandonment "addresses" Registration No. 2985751 only.

In view thereof, we find it appropriate to strike, rather than dismiss the claim in its entirety, the language "and 3394514" from paragraph no. 55 of the petition to cancel.⁴ The motion is granted insofar as it pertains to striking "and 3394514."

Claim 3

Respondent seeks to dismiss petitioner's third claim involving an assertion that an assignment of the subject registrations violated Section 10 of the Trademark Act because the invalid assignment resulted in a situation where respondent as the "assignee" of the subject marks commenced use of the mark on a type or quality of goods or services

⁴ Because the parties did not communicate with each other to resolve such a simple issue and engaged in motion practice regarding a typo, the Board finds it necessary to intervene in an effort to eliminate unlimited, uncontrolled motion practice. Accordingly, (1) the Board will be involved in the parties' discovery conference (the assigned Interlocutory Attorney, Ann Linnehan, should be contacted at 571-272-3946 to schedule such conference) (2) the parties are prohibited from filing any motions without first seeking leave of the Board by contacting the assigned Interlocutory Attorney.

Cancellation No. 92052897

very different from those of the predecessor-in-interest of respondent (the "assignor").

Specifically, respondent asserts that while an assignment in violation of Section 10 of the Trademark Act can be a valid ground for cancellation, an assignment can only violate Section 10 if it is an intent-to-use application filed under Section 1(b); that it is not possible that the assignment of the subject registrations violated Section 10 of the Trademark Act since they were not intent-to-use applications at the time of the assignment; and any alleged ground under Section 10 is inapplicable to the present facts and thus this ground should be dismissed.

We note that in our order of January 25, 2011 we stated that we would not again interpret the grounds for cancellation on behalf of petitioner. We also note that petitioner has captioned this particular claim as an "Improper Assignment Under Section 10 of the Lanham Act." We agree with respondent that an invalid assignment is not a separate ground for cancellation. Rather such allegations relate to the priority of respondent's mark. We, therefore, construe the allegations under claim 3 as not a separate claim, but as amplifications regarding petitioner's claim of priority. We do not interpret these allegations as asserting claims of abandonment or fraud.

Cancellation No. 92052897

In view thereof, respondent's motion to dismiss is denied as it pertains to claim 3.

Claim 4

Respondent seeks to strike petitioner's fourth claim (paragraphs 63-65) as redundant and immaterial of the likelihood of confusion claim. We note in its brief in response that petitioner indicates that its amended claim mis-identifies the source of statutory authority. The correct authority is 15 U.S.C. Section 1064(3).⁵

The Board may, upon motion or by its own initiative, order stricken from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. See Fed. R. Civ. P. 12(f). Motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues under litigation. See, e.g., *FRA S.p.A. v. Surg-O-Flex of America, Inc.*, 194 USPQ 42, 46 (SDNY 1976); *Leon Shaffer Golnick Advertising, Inc. v. William G. Pendil Marketing Co., Inc.*, 177 USPQ 401, 402 (TTAB 1977).

In this instance, we read petitioner's paragraph nos. 63 and 65 as merely an amplification of its abandonment claim set forth in Claim 2. We see no need to strike paragraphs 63-65; respondent's motion to strike paragraphs 63 - 65 is denied.

Claims 5 and 6

Respondent seeks to strike claims 5 (paragraph nos. 66-74) and 6 (paragraph nos. 75-80) containing petitioner's "First Contract Theory" and "Second Contract Theory" from the petition to cancel because they do not allege any grounds for cancellation and/or they are redundant of the likelihood of confusion claim set forth under the first heading of the amended petition.

We note that in our previous order of January 25, 2011, we found that breach of contract is not a proper ground for cancellation. In view of this finding and to the extent that petitioner has now clearly set forth its likelihood of confusion claim under the first section of the amended petition, we see no need for paragraph nos. 66-80 and, accordingly, strike them.⁶ The motion is granted as to paragraphs 66 - 80.

Proceedings Resumed

Proceedings are hereby resumed. The answer is due on November 18, 2011. All dates are reset as follows:

Answer Due	11/18/2011
Deadline for Discovery Conference	12/18/2011
Discovery Opens	12/18/2011
Initial Disclosures Due	1/17/2012

⁵ We find that ample notice of the claim was provided nonetheless.

⁶ To the extent petitioner's March 23, 2011 brief in opposition to respondent's motion to strike and motion for a more definite statement may be construed as a motion for reconsideration of our decision regarding whether breach of contract is a valid ground for cancellation, we deny it.

Cancellation No. 92052897

Expert Disclosures Due	5/16/2012
Discovery Closes	6/15/2012
Plaintiff's Pretrial Disclosures	7/30/2012
Plaintiff's 30-day Trial Period Ends	9/13/2012
Defendant's Pretrial Disclosures	9/28/2012
Defendant's 30-day Trial Period Ends	11/12/2012
Plaintiff's Rebuttal Disclosures	11/27/2012
Plaintiff's 15-day Rebuttal Period Ends	12/27/2012

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.