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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.
Correspondence Address	JEFFREY M. BECKER HAYES AND BOONE, LLP 2323 VICTORY AVENUE, SUITE 700 DALLAS, TX 75219 UNITED STATES jeff.becker@haynesboone.com
Submission	Reply in Support of Motion
Filer's Name	Jeffrey M. Becker
Filer's e-mail	jeff.becker@haynesboone.com
Signature	/Jeffrey M. Becker/
Date	10/26/2010
Attachments	Reply Brief - RESTORADERM.pdf ( 4 pages )(319076 bytes )

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

Thomas Sköld  
Petitioner,

v.

Galderma Laboratories, L.P.  
Registrant.

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Cancellation No.: 92052897

Mark: RESTORADERM

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

**REPLY IN SUPPORT OF  
MOTION TO DISMISS PETITION FOR CANCELLATION**

Registrant, Galderma Laboratories, L.P., hereby files this Reply in Support of Registrant's Motion to Dismiss Petition for Cancellation.

The sole ground cited in the Petition in support of cancellation is that the "Mark is no longer owned by Registrant." In Petitioner's Response to Registrant's Motion to Dismiss, Petitioner confirms that this single ground, that Registrant allegedly no longer owns the mark, is the only ground being asserted. This is not, however, a valid ground for a cancellation of properly issued registrations. Thus, this Cancellation should be dismissed.

**I. "Mark No Longer Owned by Registrant" Is Not a Valid Ground of Cancellation.**

The Petition does not identify a single overt act on the part of Registrant that would prevent Registrant's maintenance of the registrations. Petitioner does not allege, for instance, that Registrant has abandoned the mark, that Registrant was not the owner at the time the applications were filed, or that Registrant fraudulently filed a Section 8 Declaration of Continued Use—all valid grounds of cancellation—but none of which are asserted by Petitioner since none of them are supported by the present facts, even the facts as set forth by Petitioner.

Instead, Petitioner in his Response merely asserts that **if** Registrant **were** to file a Section 8 Declaration **in the future**, it could only do so fraudulently. His Response also states, without support, that allowing a registration to exist constitutes a continuing representation on the part of a registrant and goes so far as to charge the Board with a duty, also unsupported, to prevent prospectively the future filing

of a false Section 8 Affidavit. Facts, however, change over time, which is why a Cancellation must look back in time or to the present, not to some future event that has not yet occurred.

Instead of articulating a valid ground, Petitioner's argument appears to be that there might eventually be an applicable statutory ground for cancellation. Even if that were true, Petitioner has still failed to state facts supporting a ground for cancelling the registrations that exists and applies as of today.

## **II. The Petition Simply Asserts a Breach of Contract Claim.**

Petitioner's primary argument is simply that Registrant breached an agreement by not transferring the mark to Petitioner. The Board is not the appropriate tribunal to adjudicate this issue.

Registrant understands that in some cases the Board must construe contracts to determine the parties' rights relating to matters that are otherwise properly within the jurisdiction of the Board. For example, in *Vaughn Russell Candy Co. v. Cookies in Bloom, Inc.*, 47 U.S.P.Q.2d 1635 (T.T.A.B. 1998), cited in Petitioner's Response, a contract in which a party expressly agreed not to use a particular mark was found to bear on whether that party had the right to initially obtain a registration on a mark: "While it does not lie within the jurisdiction of the Board to enforce the contract between the parties, agreements to cease use of a mark . . . are routinely upheld and enforced." As the preceding excerpt indicates, because the applicant in that case had previously agreed not to ever use the mark at issue, it could not establish an element necessary for obtaining a registration. *Id.* at 1637. No such agreement to cease use of the mark has been asserted by Petitioner in the present case.

Similarly, the Board may also construe and apply a contract in a case, for instance, involving an opposer's prior agreement to refrain from opposing an application to register a particular mark. *Ron Cauldwell Jewelry Inc. v. Clothestime Clothes, Inc.*, 63 U.S.P.Q.2d 2009, 2012-13 (T.T.A.B. 2002). Such a contract necessarily bears on whether a party has the right to bring an opposition or cancellation proceeding and is properly considered by the Board. Such a contract is also not at issue here.

In this case, Petitioner does not allege that the contract directly affects Registrant's past or current right to register the mark. Rather, the crux of Petitioner's theory is that Registrant allegedly agreed to transfer the trademark to Petitioner, and that it has not done so. *See* Petition for Cancellation, ¶ 18.

Petitioner's theory is not that Registrant should have never been issued the registrations, but only that Registrant is allegedly contractually obligated to assign the mark and has failed to comply with this obligation. This alleged breach of contract does not bear on an issue properly before the Board—it is the alleged breach itself that Petitioner wants considered.

Since Petitioner has not asserted any ground related to whether the registrations should have ever issued or whether they are still valid today, Registrant respectfully requests that its Motion to Dismiss be granted and that the Petition for Cancellation be dismissed with prejudice.

Respectfully submitted,

Date: October 26, 2010

  
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Jeffrey M. Becker, Esq.  
*Attorney for Registrant*  
HAYNES AND BOONE, LLP  
2323 Victory Avenue, Suite 700  
Dallas, Texas 75219  
Telephone: 214-651-5066  
Facsimile: 214-200-0558  
*jeff.becker@haynesboone.com*  
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**Cancellation No.: 92052897**

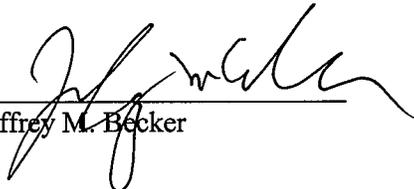
Mark: RESTORADERM

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that on this 26 day of October, 2010, the foregoing *Reply in Support of Motion to Dismiss Petition for Cancellation* was served on Petitioner's counsel of record, via first-class to the following:

Arthur E. Jackson  
Moser IP Law Group  
1030 Broad Street, Suite 203  
Shrewsbury, NJ 07702

  
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Jeffrey M. Becker