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

Proceeding	92054617
Party	Plaintiff Nouvelle Parfumerie Gandour
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Attachments	Petitioner's Motions to Strike and to Suspend Proceeding.pdf(3418859 bytes )

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

In the Matter of Trademark Registration  
Registration No.: 3,504,398  
Serial No. 77/385,169  
Filed: January 31, 2008  
By: Y.Z.Y., Inc.  
For the Trademark: "BIO CLAIRE"

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Cancellation No. 92054617

NOUVELLE PARFUMERIE GANDOUR,  
an Ivory Coast Corporation,  
Petitioner,

v.

Y.Z.Y., Inc.,  
a Florida Corporation,

Respondent.

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**PETITIONER'S MOTIONS TO STRIKE THE SECOND, THIRD AND FOURTH  
AFFIRMATIVE DEFENSES IN RESPONDENT'S AMENDED ANSWER AND  
TO SUSPEND PROCEEDINGS**

**MOTIONS**

Petitioner Nouvelle Parfumerie Gandour ("Petitioner") hereby moves pursuant to Fed. R. Civ. P. 12(f) and TBMP § 503 to strike the second, third and fourth affirmative defenses set forth in the paragraphs numbered 2, 3, and 4 under the heading "Affirmative Defenses" in the Amended Answer of Y.Z.Y., Inc. ("Respondent") as immaterial, impertinent, irrelevant or insufficient defenses.

Additionally, as the Board's determination of Petitioner's motion and the possible time required to reach its determination will affect the current deadlines as well as the scope of discovery in this proceeding, Petitioner moves that the Board suspend this proceeding pending consideration of Petitioner's Motion to Strike and that, after the Board decides the motion, the deadlines for the initial discovery conference, discovery and trial be reset.

## MEMORANDUM IN SUPPORT OF MOTIONS

Section 506.01 of the TBMP provides that the Board may, upon motion or upon its own initiative, "order stricken from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter." (3d ed. Rev. 2011); *see also* Fed. R. Civ. P. 12(f).

On October 31, 2012 Petitioner filed a motion to strike respondent's affirmative defenses, and in the Board order of February 8, 2013, the Board granted the motion and struck all four of Respondent's affirmative defenses, but granted Respondent leave to replead Affirmative Defense Nos. 2, 3 and 4, "if it believes it can sufficiently allege a basis therefor". Board order mailed February 8, 2013.

On this basis, Petitioner moves that the defenses of laches and acquiescence set forth in Respondent's second and third defenses are still impertinently pled since these are inapplicable in an action involving identical marks used on identical goods, which remains precisely at issue in this action. Finally, the Petitioner moves that the fourth affirmative defense for abandonment be stricken as inadequately pled, as even though Responded has repled the affirmative defense it still merely consists of a conclusory statement without the appropriate factual allegations required for Petitioner to respond. Based upon the foregoing, and for the reasons discussed below, the Board should strike the second, third and fourth affirmative defenses in Respondent's Amended Answer<sup>1</sup>

1. Respondent's Second And Third Affirmative Defense Of Laches And Acquiescence Are Each Inappropriate Given the Marks and Goods At Issue

As the basis for its cancellation proceeding, Petitioner alleged in paragraphs 2 and 3 of its Complaint that Petitioner is the owner and senior user of the BIO CLAIRE Mark, having created, developed and used the mark on its cosmetic products it manufactures in Ivory Coast, Africa. Moreover, Petitioner pled that Respondent Registrant was to serve only as the importer/distributor of

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<sup>1</sup> The facts upon which this motion is based are taken from Respondent's Amended Answer and Affirmative Defenses To Petition For Cancellation dated October 3, 2013.

these goods which were already labeled with the manufacturer's mark before they reached the U.S. and that the parties understood that the BIO CLAIRE Mark was owned by Petitioner.

As between a foreign manufacturer and a United States distributor, the foreign manufacturer is presumed, absent evidence to the contrary, to be the owner of the mark in the United States. *See Sengoku Works Ltd. v. RMC International Ltd.*, 40 U.S.P.Q.2d 1149 (9th Cir. 1996); *Bakker v. Steel Nurse of America Inc.*, 176 U.S.P.Q. 447 (Trademark Trial & App. Bd. 1972). As established by the principles enunciated by the Board in *Bakker* and the Ninth Circuit in *Sengoku Works Ltd.*, as between Petitioner, a foreign manufacturer and Respondent, its U.S. distributor, Petitioner, as the foreign manufacturer is presumed, absent evidence to the contrary, to be the owner of the mark BIO CLAIRE in the U.S.

Most importantly, since the Respondent distributor was distributing Petitioner's goods using Petitioner's mark, the goods and mark at issue in this case are identical. Where the marks and goods involved are identical, laches, even if established, will not avoid a judgment in favor of the prior user. *Chun King Corp. v. Genii Plant Line, Inc.*, 56 C.C.P.A. 740, 403 F.2d 274 (C.C.P.A. 1968); *Far-Best Corp. v. Die Casting "ID" Corp.*, 165 U.S.P.Q. (BNA) 277, 280 (Trademark Trial & App. Bd. 1970). Acquiescence as a defense is barred in such circumstance because protection of the public from confusion by trademarks dominates over any injury caused by delay or acquiescence. *Swank, Inc. v. Ravel Perfume Corp.*, 168 U.S.P.Q. (BNA) 723, 725 (C.C.P.A. 1971) citing *In re Avedis Zildjian Co.*, 157 U.S.P.Q. (BNA) 517 (C.C.P.A. 1968) and *In re Continental Baking Co.*, 156 U.S.P.Q. (BNA) 514 (C.C.P.A. 1968).

In *Far-Best Corp.*, the Board encountered facts analogous to those in the instant action. In that proceeding, the petitioner manufacturer brought a cancellation action against the respondent, who served as the manufacturer's exclusive retailer, and who had registered

manufacturer's marks. In that action, the Board held that "with regard to respondent's pleaded affirmative defense, where, as here, the marks and goods of the parties are identical, laches and acquiescence will not serve to preclude the granting of appropriate relief..." *Far-Best Corp.*, 165 U.S.P.Q. at 280, citing *Menendez et al. v. Holt et al.*, 128 U.S. 514 (1888); *McLean v. Fleming*, 96 U.S. 245 (1878); *Chun King Corp. v. Genii Plant Line, Inc.*, 56 C.C.P.A. 740, 403 F.2d 274 (C.C.P.A. 1968).

Here, Petitioner instituted this cancellation proceeding on the same grounds as the petitioner in *Far-Best Corp.*, namely to cancel the registration improperly obtained by its distributor. In its Complaint, Petitioner seeks cancellation of Respondent's registration of the mark BIO CLAIRE (Reg. No. 3,504,398), because: (1) Petitioner is the true owner of the identical mark, BIO CLAIRE, (2) Respondent fraudulently obtained the BIO CLAIRE trademark registration; and (3) Respondent's use as Registrant of the registered BIO CLAIRE Mark will cause confusion, mistake or deceive as to the source of origin of Petitioner's goods since Registrant's use is on Petitioner's goods, or worse, on counterfeit goods of inferior quality. Thus, like *Far-Best Corp.*, this case involves a trademark dispute between a manufacturer and its distributor over the unauthorized registration obtained by the distributor.

As made clear by *Far-Best Corp.*, acquiescence and laches are inappropriate defenses in such actions since the marks and the goods associated with the marks are identical and likelihood of confusion is certain. Were such defenses permitted, the right of consumers to be free from confusion would be compromised. As stated above, protecting consumers from confusion is an overarching concern that outweighs a respondent's right to be free from undue delay in a cancellation proceeding. Thus Respondent's second and third affirmative defenses should be stricken as impertinent given the facts present in this case.

2. Respondent's Fourth Affirmative Defense Of Abandonment Consists Of Mere Conclusory Allegations, Lacks The Requisite Particularity And Should Be Stricken As Insufficient

Respondent's fourth affirmative defense of abandonment should be stricken because, as replead, it remains merely conclusory and fails to state any facts whatsoever, let alone facts that would give adequate notice of the basis for such defense. As TBMP § 300 makes clear, "a petition to cancel must include (1) a short and plain statement of the reason(s) why petitioner believes it is or will be damaged by the registration sought to be cancelled (see TBMP § 303.03 and TBMP § 309.03(b)) and (2) a short and plain statement of the ground(s) for cancellation. Likewise an affirmative defense "should include enough detail to give the plaintiff fair notice of the basis for the defense". TBMP § 311.02(b); See *IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 U.S.P.Q.2d 1952, 1953 (Trademark Trial & App. Bd. 2009)(Trademark Act § 18, 15 U.S.C. § 1068 claim or defense must be specific enough to provide fair notice to adverse party of restriction being sought); *Fair Indigo LLC v. Style Conscience*, 85 U.S.P.Q.2d 1536, 1538 (Trademark Trial & App. Bd. 2007) (elements of each claim should include enough detail give fair notice of claim); and *Ohio State University v. Ohio University*, 51 U.S.P.Q.2d 1289,1292 (Trademark Trial & App. Bd. 1999) (primary purpose of pleadings "is to give fair notice of the claims or defenses asserted"). Where a defense contains mere conclusory allegations that do not give a petitioner fair notice as to the specific conduct which provides the basis for the defense, the defense will be stricken by the Board. *Kiko Foods, Inc. v. Land O'Lakes, Inc.*, 1996 TTAB LEXIS 87 (Trademark Trial & App. Bd. June 6, 1996) ("Applicant's pleading of bare legal conclusions as affirmative defenses is insufficient to give opposer fair notice of the bases therefore. Thus, the pleading is legally insufficient.")

Here, Respondent has once again failed to replead any facts in connection with its affirmative defense of abandonment sufficient to apprise Petitioner of what grounds support this

affirmative defense, and what unlawful actions or inactions Petitioner's rights are derived from that led to the alleged abandonment. Thus, the fourth affirmative defense should be stricken as it fails to apprise Petitioner of facts upon which the asserted defense is predicated and as pleaded continues to consist of a mere conclusory allegation.

### **CONCLUSION**

For the foregoing reasons, Respondent's second, third and fourth affirmative defenses as pleaded should be stricken. Moreover, the proceeding should be suspended pending consideration of Petitioner's motion to strike, and the deadlines for the initial discovery conference, discovery and trial periods should be reset accordingly.

Date: October 21, 2013

Respectfully submitted,

**VLP LAW GROUP LLP**

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**CERTIFICATE OF ELECTRONIC FILING**

I hereby certify that the above document was filed electronically with the Trademark Trial and Appeal Board on this 21st day of October, 2013.

**VLP LAW GROUP LLP**

ls/Scott R. Austin/  
Scott R. Austin

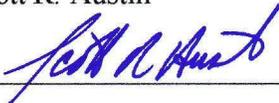
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I hereby certify that a copy of this PETITIONER'S MOTIONS TO STRIKE THE SECOND, THIRD AND FOURTH AFFIRMATIVE DEFENSES IN RESPONDENT'S AMENDED ANSWER AND TO SUSPEND PROCEEDINGS is being served by First Class U.S. Mail service, Certified, with Return Receipt Requested, to the below addressee on October 21, 2013, as follows:

RICHARD S. ROSS, ESQ.  
4801 S. UNIVERSITY DRIVE  
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Date of Mailing:       October 21, 2013

Printed Name:         Scott R. Austin

Signature:               
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