

ESTTA Tracking number: **ESTTA566825**

Filing date: **10/24/2013**

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

Proceeding	92054617
Party	Defendant Y.Z.Y., Inc.
Correspondence Address	RICHARD S ROSS ATTORNEY AT LAW 4801 SOUTH UNIVERSITY DRIVE, SUITE 237 FT LAUDERDALE, FL 33328-3836 UNITED STATES prodp@ix.netcom.com
Submission	Opposition/Response to Motion
Filer's Name	RICHARD S. ROSS, ESQ.
Filer's e-mail	prodp@ix.netcom.com
Signature	/RICHARD S. ROSS, ESQ./
Date	10/24/2013
Attachments	2can8.yzy.pdf(269624 bytes)

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

In the matter of trademark Registration No. 3,504,398
for the mark BIO CLAIRE registered September 23, 2008.

NOUVELLE PARFUMERIE GANDOUR,

Petitioner,

v.

Cancellation No. 92054617

Y.Z.Y., INC.

Respondent.

**RESPONDENT Y.Z.Y., INC.’S RESPONSE IN OPPOSITION TO PETITIONER’S
MOTION TO STRIKE THE SECOND, THIRD AND FOURTH AFFIRMATIVE
DEFENSES IN RESPONDENT’S AMENDED ANSWER, AND TO SUSPEND
PROCEEDINGS**

COMES NOW, the Respondent, Y.Z.Y., INC. (“YZY”), who respectfully responds in opposition to the Petitioner’s NOUVELLE PARFUMERIE GANDOUR (“GANDOUR”) motion to strike and to suspend. YZY takes no position on the motion to suspend. With regard to the motion to strike, YZY responds and asserts that the motion is without merit and should be denied. However, to the extent the motion is granted in whole or in part, YZY requests that it be granted further leave to amend, as argued below.

GANDOUR contends that all of YZY’s affirmative defenses: laches; acquiescence; and abandonment should be stricken as insufficient or improperly pled. For the following reasons, GANDOUR’s arguments fail.

GANDOUR argues that YZY cannot raise the defenses of laches and acquiescence because the subject marks are identical and GANDOUR was the manufacturer of the goods under

which the BIO CLAIRE mark was used. However, such an argument does not support a motion to strike and GANDOUR has provided no case law that it does. GANDOUR'S assertion is subject to proof that GANDOUR was the prior lawful user of the mark, and this it cannot do as will be made evident upon completion of discovery. The evidence will show that GANDOUR is not a prior user of the BIO CLAIRE mark in the United States because all such use was unlawful. As between these parties, YZY was the prior lawful user of the BIO CLAIRE mark.

Moreover, these defenses are specifically enumerated as viable affirmative defenses available in a cancellation proceeding. *See* TBMP 311.02(b) (“Affirmative defenses may include unclean hands, laches, estoppel, acquiescence, fraud, mistake, prior registration (*Morehouse*) defense, prior judgment, or any other matter constituting an avoidance or affirmative defense.”). The parties are merely at the beginning stage of these proceedings. Again, GANDOUR cites no case law or other authority supporting the striking of the defenses of laches and acquiescence.

The Board has already ruled in this case that YZY's affirmative defenses were inadequate as they did not “provid[e] enough sufficient detail to give petitioner fair notice of the basis therefor.” Order, 2/8/2013. GANDOUR does not object to the fair notice pled by amendment as to laches and acquiescence.

Regarding the defense of abandonment, YZY has explicitly alleged sufficient fair notice, i.e., that GANDOUR has not established prior lawful use of the BIO CLAIRE mark in the United States. GANDOUR has long had actual knowledge that the Federal Food and Drug Administration of the United States determined that the goods it was delivering to YZY under the BIO CLAIRE mark were unlawful. It is rather disingenuous, therefore, for GANDOUR to argue that the amended answer alleging that its asserted right to the BIO CLAIRE mark is based upon unlawful

use does not adequately give fair notice of the abandonment defense.

The affirmative defenses pled by YZY are authorized and permitted by the rules of court and the TTAB's manual of procedure. The motion should be denied and the parties be allowed to proceed to discovery on these defenses. However, if it is not, YZY respectfully requests an opportunity to amend its defenses further.

Respectfully submitted,

/s/Richard S. Ross, Esq.
RICHARD S. ROSS, ESQ.
Attorney for Respondent
Atrium Centre
4801 South University Drive, Suite 237
Ft. Lauderdale, Florida 33328
Tel (954) 252-9110
Fax (954) 252-9192
E mail prod@ix.netcom.com

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true and correct copy of the foregoing has been served by United States Postal Service first class regular mail on this 24th day of October, 2013, and addressed to counsel for the Petitioner as follows:

Scott R. Austin, Esq.
VLP LAW GROUP LLP
5200 N. Federal Highway Suite 2-1081
Ft. Lauderdale, Florida 33308

/s/Richard S. Ross, Esq.
Richard S. Ross, Esq.