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

Proceeding	92061916
Party	Defendant Himani Gupta
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Submission	Motion for Summary Judgment
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Attachments	160222 Motion Gupta Document.pdf(246279 bytes) Gupta L300 Exhibit 1.pdf(1468409 bytes)

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

In the matter of Registration No. 4460761
Date of Issue: January 7, 2014
Trademark HIMANI Makeup – Skincare

M/s. Emami Limited)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92061916
)	
Himani Gupta)	
Registrant.)	

**REGISTRANT’S MOTION AND SUPPORTING BRIEF FOR SUMMARY
JUDGEMENT**

MOTION FOR SUMMARY JUDGMENT

Himani Gupta (hereinafter Gupta), Registrant in the above-entitled Cancellation respectfully moves the board under Rule 56 of the Federal Rules of Civil Procedure for Summary Judgment because Petitioner, Emami Limited (herein after Emami), is contractually estopped and has waived all rights for seeking cancellation of Registrant’s Mark based on a settlement Agreement between the parties dated May 30, 2013 (hereinafter “2013 Agreement”). The 2013 Agreement is attached hereto as an EXHIBIT. It was also attached to Gupta’s Answer and to Gupta’s Initial Disclosures.

BRIEF IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT

I. UNDISPUTED FACTS

Gupta filed for trademark registration of her mark, “HIMANI MAKE – SKINCARE” on January 14, 2011 in class IC 003 for cosmetics (Application No. 85218544). At that time Emami had a registered mark, HIMANI, in class 005 for “Ayurvedic preparations (Registration No.

3005688). Based on its registered mark Emami filed a Notice of Opposition (No. 91200679) against Gupta's application on July 13, 2011. On May 30, 2013, the parties entered into a settlement agreement (attached EXHIBIT), hereinafter 2013 Agreement. Gupta agreed to and did amend her registration to "Non-ayurvedic preparation....." Gupta also agreed:

4. Gupta shall not, directly or indirectly, challenge before any court, adjudicative body, arbitrator and/or in any judicial or quasi-judicial proceeding, the use and/or registration by or on behalf of Emami of the Himani Mark as well as any use or registration of the mark EMAMI.

In return, Emami agreed:

"6. Emami agrees as long as Gupta complies with the terms of this Agreement Emami will not challenge the registration of the Gupta Application and any resulting registration and usage rights of the HIMANI MAKEUP-SKINCARE and Design mark."

On October 31, 2013 the Board approved Gupta's amendment to her identification of goods. On November 21, 2013 the parties filed a stipulated withdrawal of the opposition and on November 27, 2013 the opposition was dismissed without prejudice. Gupta's Mark was registered as No. 4460761 on January 7, 2014.

On December 22, 2011, Emami filed for a second time on the mark HIMANI (Application No. 85502259), this time in Class IC 003 and broadened the description of goods from their previously registered MARK to include among, other goods, "cosmetics" that were not limited to "ayurvedic" goods. The Trademark Office rejected and refused to register the second filed for Emami mark "HIMANI" based on likelihood of confusion with the then registered Gupta '761 MARK. Emami also has a registered mark "EMAMI" for Class 1C 003 for cosmetics (Reg. No.

2997093-date September 20, 2006)

On July 21, 2015, Emami Petitioned for Cancellation of Gupta's mark based on Emami's pending application. Gupta has Answered and asserted among other Affirmative Defenses Contractual Estoppel. The 2013 Agreement between the parties was attached thereto as an Exhibit. Gupta has also served its Initial Disclosures and the 2013 Agreement is attached thereto as an Exhibit.

Gupta has never, directly or indirectly, challenged before any court, adjudicative body, arbitrator and/or in any judicial or quasi-judicial proceeding, the use and/or registration by or on behalf of Emami of the Himani Mark, or any use or registration of the mark EMAMI.

II. THE PARTIES

Gupta operates her business as a small sole proprietor having developed her line of cosmetics and makeup and first selling them from a boutique store located in Flint Michigan in 2001. She has also had a store in Saginaw, Michigan and now sells her products from a boutique store located in the Midland Mall in Midland, Michigan. Her products are not ayurvedic.

Emami is an old Indian company who in the mid-seventies acquired another Indian company, Himani Ltd., who produced an ayurvedic preparation they called "their first flagship brand, Boroplus Antiseptic Cream". The Emami story is told at their website "The Journey – Emami Ltd".

III. THE LAW OF SUMMARY JUDGMENT

The Board has adopted the Federal Rules of Civil Procedure for *inter partes* proceedings 37 C.F.R. section 2.116(a). Under Rule 56 of the Rules, granting of summary judgment is appropriate "if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law".

With respect to the 2013 Agreement the only issue is interpretation of the Agreement, which is a matter of law which may be decided by the Board on summary judgment, *Kimberly-Clark Corp. v. Fort Howard Paper Co.*, 772 F. 2d 860 (Fed. Cir. 1985). In interpreting contracts, “unless a different intention is manifested, . . . where language has a generally prevailing meaning, it is interpreted in accordance with that meaning.” Restatement (Second) of Contracts, Section 202 (3) (a).

There is no dispute as to a material fact, and Gupta is entitled to a judgment dismissing the Petition for Cancellation as a matter of law. Summary judgment in trademark matters is beyond dispute. *Danskin Inc. v. Dan River, Inc.*, 498 F 2d. 1386 (1974).

IV. SUMMARY JUDGMENT IS PROPER BECAUSE EMAMI IS CONTRACTUALLY ESTOPPED FROM CHALLENGING GUPTA’S EXCLUSIVE RIGHT’S IN HER MARK FOR THE IDENTIFIED GOODS.

In good faith and in reliance on terms of the 2013 Agreement Gupta agreed to limit the identification of her goods to “nonayurvedic” makeup and skin care. The word ayurvedic has a very specific meaning: i.e. “the ancient Hindu art of medicine and prolonging life” (Dictionary.com). It is based on the use of various herbs used in lotions, balms and the like to promote health. “Himani Boro Plus Lotion”. Emami provided this as a specimen in the filing of its second trademark application for the HIMANI mark. Himani Boro Plus Lotion contains malai, badam, rosewater and saffron (Indian Products Online) which places it in the ayurvedic category. Gupta’s products are nonayurvedic cosmetics and makeup.

If Gupta had known that the next act by Emami would be a second attack on her MARK because of Emami’s late recognition of the market she was developing she might have taken other actions. Contractual Estoppel is an equitable defense and sounds in the public policy favoring the settlement of disputes and the finality of these settlements should be respected when settled by

agreement.

Gupta agreed:

“4. Gupta shall not, directly or indirectly, challenge before any court, adjudicative body, arbitrator and/or in any judicial or quasi-judicial proceeding, the use and/or registration by or on behalf of Emami of the Himani Mark as well as any use or registration of the mark EMAMI.”

Gupta never has made any such challenge, either directly or indirectly.

Emami by the 2013 Agreement agreed that, in return for Gupta amending the identification of goods to “nonayurvedic preparations “(Paragraph 1 of the 2013 Agreement) to:

“6. Emami agrees as long as Gupta complies with the terms of this Agreement Emami will not challenge the registration of the Gupta Application and any resulting registration and usage rights of the HIMANI MAKEUP-SKINCARE and Design mark.”

Gupta amended her application as required by the 2013 Agreement, and the amendment was accepted by the Trademark Office and the Opposition was dismissed. Gupta has and continues to comply with the terms of the 2013 Agreement.

Unknown to Gupta, Emami had applied for registration for the same HIMANI name that Emami had previously registered for “Ayurvedic preparation” but for a second group of goods in Class 003 that is broad enough to include Gupta’s goods. When the Trademark Office refused to register the HIMANI name based on Gupta’s registered mark Emami breached the 2103 Agreement and filed a Petition for Cancellation of Gupta’s mark. The specimen Emami provided to the Office was for Himani Boro Plus Lotion, an “ayurvedic lotion” not a nonayurvedic preparation. Emami in the 2013 Agreement also categorized its registered HIMANI Mark as

“for a variety of goods including but not limited to Ayurvedic preparations” when the identification of the goods was in class IC005 for only “Ayurvedic preparations”. Class 005 is identified in the Trademark Acceptable Identification of Goods and Services as follows:

197 “Antimicrobial preservatives for cosmetics for pharmaceuticals “

198 “Medicated cosmetics”

199 “Plant and herb extracts sold as components of medicated cosmetics”

200 “Vitamins for use in the manufacture of (specify, e.g. cosmetics, food products etc.)”

The Opposition was dismissed “without prejudice”. Any attempt by Emami to use the dismissal to legitimize its breach of the 2013 Agreement by later filing the Petition for Cancellation based on it then later pending Application for registration of the same HIMANI mark supports Gupta’s position Emami is using these techniques as an attempt to encroach into Gupta’s nonayurvedic market. The “without prejudice” language should only be used in the rare case that an accused party to a settlement breaches the agreement and then only to the extent of the specific subject matter of the Agreement.

Contractual Estoppel is an equitable remedy. Equitable remedies should attempt to follow the principles of fairness. *Richmond v. Office of Personnel Management*, 862 F. 2d 294, 301 (Fed. Cir. 1988). Allowing Emami to further its attempted encroachment into Gupta’s market using a similar mark violates principles of fairness allowing Emami to accept the benefits of the 2013 Agreement without living up to its promises.

For the foregoing reasons granting of Gupta’s request for Summary Judgment dismissing the Petition for Cancellation filed by Emami is respectfully requested. If Summary Judgment is not granted Gupta will face a long and expensive process to prove using her mark. Settlement

agreements are intended to remove this risk.

For these reason Ms. Gupta respectfully prays for Summary Judgment in her favor.

WHEREFORE, Registrant prays the Petition for Cancellation be dismissed with prejudice.

Respectfully Submitted

/Bruce M. Kanuch/

Bruce M. Kanuch P15689 State of Michigan
Mitchell Intellectual Property Law, PLLC
1595 Galbraith Avenue, SE
Grand Rapids, MI 49546

Attorney for Registrant

Cancellation No. 92049828

CERTIFICATE OF SERVICE

I, Bruce Kanuch, hereby certifies that a true and correct copy of the foregoing **REGISTRANT's MOTION AND SUPPORTING BRIEF FOR SUMMARY JUDGMENT**, including Exhibit 1, was served on Petitioner's counsel of record, this 22nd day of February, 2016, by mailing via Frist Class Mail at the following address:

Leo M. Loughlin
Rothwell, Figg, Ernst & Manbeck, pc
607 14th Street, N.W. 8th Floor
Washington, D.C. 20005

And by sending a courtesy copy by electronic mail at the following email address:

lloughlin@rothwellfigg.com

/Bruce M. Kanuch/
Bruce M. Kanuch P15689 State of Michigan
Mitchell Intellectual Property Law, PLLC
1595 Galbraith Avenue, SE
Grand Rapids, MI 49546

AGREEMENT

THIS AGREEMENT is between **Emami Limited**, an Indian Limited Company, (hereinafter "Emami") with an address at Emami Tower, 687, Anandapur, EM Bypass, Kolkata – 700107, West Bengal, India , and **Himani Gupta**, a Michigan individual, with an address at 6914 Vista Drive, Saginaw, Michigan 48603 ("Gupta"), and is effective as of the date last signed below (the "Effective Date").

WHEREAS, Emami is the owner of the mark "HIMANI" (the "Himani Mark") for a variety of goods, including but not limited to, Ayurvedic preparations, namely, medicated oils, soaps, creams, powders and balms made from herbs and plants for medicinal use, namely for healing cuts, burns, minor wounds, skin rashes, cracked skin, dry skin diseases, relieving headaches, tension, insomnia, muscular and joint pain, relaxation of muscles, and curing cough and cold; medicated preparations, namely, medicated oils, soaps, creams, powders and balms for healing cuts, burns, minor wounds, skin rashes, cracked skin, dry skin diseases, relieving headaches, tension, insomnia, muscular and joint pain, relaxation of muscles, and curing cough and cold.

WHEREAS, the Himani Mark is the subject of federal trademark registration no. 3,005,688;

WHEREAS, Gupta filed a U.S. trademark application for the mark,



(hereinafter, "HIMANI MAKEUP- SKINCARE and Design"), assigned Serial No. 85/218,544 for "Cosmetics" in International Class 3 (the "Gupta Application");

WHEREAS, Emami filed a Notice of Opposition before the Trademark Trial & Appeal Board, which has been assigned Opposition No. 91200679 opposing the Gupta Application;

WHEREAS, the parties are desirous of settling this matter; and

WHEREAS, each party warrants and represents that it has the sole right and exclusive authority to execute this agreement and has not sold, assigned, transferred, conveyed or otherwise disposed of (or purported to do so) any claim, right, debt, liability, demand, obligation, account, reckoning, cost, expense, lien, loss, damage, action or cause of action, or any portion thereof of interest therein, relating to or arising out of any matter covered in this agreement ("Agreement").



NOW, THEREFORE, in consideration of the foregoing recitals, including warranties and representations, and the promises and other consideration hereinafter given, Emami and Gupta agree as follows:

1. Gupta agrees to amend the Gupta Application for HIMANI MAKEUP-SKINCARE and Design to narrow the identification of goods to the following: "nonayurvedic preparations solely for cosmetic purposes, namely, make-up foundation, lipstick, lip balm, lip gloss, eye shadow, lip primer, blush, eye liners, face finishing powder, skin bronzer, make-up-brushes, facial cleaner, facial toner, facial moisturizer, eye cream, and neck and bust moisturizer, in Class 3."

2. Gupta undertakes and agrees to always use only the HIMANI MAKEUP-SKINCARE and Design mark exactly as it appears in the Gupta application, namely



as , on the goods identified in Paragraph 1. Gupta agrees to not use the mark HIMANI alone for as long as Emami owns and uses the Himani Mark in the U.S.

3. Gupta undertakes and agrees to use the HIMANI MAKEUP—SKINCARE and Design mark for only the Class 3 goods listed in Paragraph 1 above, namely, non-ayurvedic preparations solely for cosmetic purposes, namely, make-up foundation, lipstick, lip balm, lip gloss, eye shadow, lip primer, blush, eye liners, face finishing powder, skin bronzer, make-up-brushes, facial cleaner, facial toner, facial moisturizer, eye cream, and neck and bust moisturizer, and not for any other Class 3 or Class 5 goods.

4. Gupta shall not, directly or indirectly, challenge before any court, adjudicative body, arbitrator and/or in any judicial or quasi-judicial proceeding, the use and/or registration by or on behalf of Emami of the Himani Mark as well as any use or registration of the mark EMAMI.

5. Emami agrees to withdraw on a without prejudice basis its opposition to the Gupta Application within ten days following receipt of the notice from the United States Patent and Trademark Office that it accepts the amendment as set forth in Paragraph 1 of this Agreement.

6. Emami agrees that as long as Gupta complies with the terms of this Agreement, Emami will not challenge the registration of the Gupta Application and any resulting registration and usage rights of the HIMANI MAKEUP—SKINCARE and Design mark.

7. The terms of this Agreement shall be binding upon, and inure to the benefit of, the respective successors, assigns, parent, subsidiaries, affiliated companies and officers of the

parties hereto.

8. Each party shall bear all of its own attorney fees, costs and expenses incurred in connection with this Agreement and all matters covered herein.

9. No waiver or any breach of this Agreement shall be construed to be a continuing waiver or consent to any subsequent breach thereof. If any provision of this Agreement is invalid or unenforceable, it shall not affect the validity or enforceability of the other provisions.

10. This Agreement shall be construed in accordance with the federal trademark laws and the laws of the District of Columbia and without regard to the party responsible for the preparation of same or clauses in same and shall be deemed as prepared jointly by the parties hereto. Any ambiguity or uncertainty existing in this Agreement shall not be interpreted or construed against any party hereto.

11. This Agreement is limited to the United States of America.

This is the entire Agreement of the parties with respect to the subject matter hereof. This Agreement shall not be modified except by written agreement of all the parties hereto.

12. This Agreement may be executed in counterparts, each of which may be deemed an original, and all of which together constitute the Agreement.

IN WITNESS WHEREOF, the parties hereto execute this document on the dates set forth below.

FOR EMAMI LIMITED

For Emami Limited

Signature :



Company Secretary & AVP-Legal

Name: Arun Kumar Joshi

Title : Company Secretary & AVP-Legal

Date: 30.5.2013

FOR HIMANI GUPTA

Name:



Title:

Owner

Date: