

ESTTA Tracking number: **ESTTA741676**

Filing date: **04/22/2016**

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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Date	04/22/2016
Attachments	Gupta_ReplyMotionG.pdf(101487 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 REPLY TO PETITIONER’S OPPOSITION TO REGISTRANT’S
MOTION FOR SUMMARY JUDGMENT**

PETITIONER’S OPPOSITION IS NOT LEGALLY NOR FACTUALLY SUPPORTED

The material facts supporting Registrant’s Summary Judgment Motion are undisputed.

Petitioner advances two arguments in PETITIONER’S OPPOSITION TO REGISTRANT’S MOTION FOR SUMMARY JUDGMENT in asking the Board to deny Registrant’s Motion for Summary Judgment.:

First: Petitioner would have Registrant’s Motion denied because Petitioner claims that Registrant has breached the Settlement Agreement.

Second: Petitioner would have Registrant’s Motion denied because Petitioner claims that certain language of the Settlement Agreement is ambiguous and genuine issues of material fact exist.

Both positions fail, factually and legally.

Petitioner's position regarding breach of contract is not supported by the facts nor legally supported because breach of contract is not within the jurisdiction of the Board.

"If an agreement settling an inter parties proceeding before the Board is breached by one of the parties, an adverse party's remedy is by way of civil action. The Board has no jurisdiction to enforce such an agreement. However, while the Board does not have jurisdiction to enforce the contract, agreements to cease use of a mark or not to use a mark in a certain format are routinely upheld and enforced to the extent a party may not obtain a registration for exclusive use that may be precluded by the terms of a settlement agreement."

TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP)

June 2015. Section 605.03(d)

For Petitioner to argue that Registrant's Agreement to not challenge was breached because Registrant responded to the Petition for Cancellation and because Registrant would not consent to the registration of Petitioner's Application is without merit. To construct a breach based on challenges by Petitioner to Registrant's Mark is specious. Challenge as used in the Agreement is a verb and clearly means Registrant must to take some affirmative offensive action, not reply to a challenge to Registrant's Mark by Petitioner.

In response to Petitioner's position that the definition of the "Himani Mark" is ambiguous, it is only relevant material facts that are relevant and the "Himani Mark" is not relevant to the grounds set forth in Registrant's Motion for Summary Judgment, nor is the term ambiguous. It is not relevant because the issue raised in Registrant's motion is whether Petitioner is Contractually Estopped from bringing the Cancellation proceeding because Paragraph 6 of the Settlement Agreement obligated Petitioner not to do so.

The term "Himani Mark" is not ambiguous because it is defined in in the Settlement Agreement in the second Whereas Clause on page 1 as "the Himani Mark is the subject of federal trademark registration no. 3,005,688." Basic contract interpretation fundamentals say that the

specific overrides the general.

The issue raised by Registrant in its Summary Judgment Motion to the Board is whether Petitioner is contractually estopped from bringing the Cancellation Proceeding because of Emami's 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.”

Petitioner has challenged again Registrant's mark.

Petitioner's positions also raise a second ground for granting Summary Judgment, Claim Preclusion.

Petitioner's U.S. Application 85/502,259 (which is the grounds asserted in the Petition for Cancellation) was pending at the time of the Petitioner's Opposition, the basis of which was Petitioner's Registered Mark (both mark's reading "HIMANI"). Petitioner's Registration and its Application were part of the same transaction and should have been made part of the Opposition proceeding. There is no dispute that Registrant's Application in the prior Opposition matured into the subject Registration of this Petition for Cancellation. Failure of Petitioner to raise both the Registration of HAMANI and the application for registration of HIMANI together in the Opposition prevents Petitioner from Petitioning for Cancellation of Registrant's mark under the doctrine of Claim Preclusion.

Petitioner has disputed no material facts.

In good faith and in reliance on terms of the 2013 Settlement Agreement. Gupta agreed to limit the identification of her goods to "nonayurvedic" makeup and skin care".

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. Claim Preclusion has same objectives.

Emami agreed it would, in return for Gupta amending the identification of her goods to "nonayurvedic preparations "(Paragraph 1 of the 2013 Agreement):

"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 2013 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). Claim Preclusion applies when there exists "(1) an identity of parties or their privies; (2) a final judgment on the merits of the prior claim; and (3) the second claim is based on the same transactional facts as the first as the first and second should have been litigated in the prior case." *V.V.V. & Sons Edible Oils Limited v. Meenakshi Overseas LLC d/b/a Meenakshi Overseas*, Cancellation No. 92060602.

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. Petitioner's argument which results in the unconceivable conclusion that Registrant could not oppose any attack on its mark by Petitioner (this Cancellation proceeding) in face of Petitioner's explicit agreement to the contrary is unconscionable.

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 should 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

April 22, 2016

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CERTIFICATE OF SERVICE

I, Bruce Kanuch, hereby certifies that a true and correct copy of the foregoing **REGISTRANT'S REPLY TO PETITIONER'S OPPOSITION TO REGISTRANT'S MOTION FOR SUMMARY JUDGMENT**, was served on Petitioner's counsel of record, this 22nd day of April, 2016, by mailing via Frist Class Mail at the following address:

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