

THIS OPINION IS  
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OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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wbc

Mailed: July 28, 2016

Cancellation No. 92061916

*M/s. Emami Limited*

*v.*

*Himani Gupta*

**Before Mermelstein, Lykos and Kuczma,  
Administrative Trademark Judges.**

**By the Board:**

Himani Gupta (“Respondent”) is the owner of a registration for the stylized mark



for “cosmetics, namely, 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, facial cleaner, facial toner, facial moisturizer, eye cream, and neck and bust moisturizer” in International Class 3.<sup>1</sup>

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<sup>1</sup> Registration No. 4460761 issued January 7, 2014 on the Principal Register claiming a date of first use anywhere and in commerce of November 1, 2009. The mark is described as “a lotus flower above the text “HIMANI Makeup. Skincare” MAKEUP and SKINCARE have been disclaimed.

***Background***

In a prior proceeding between Respondent and M/s. Emami Limited (“Petitioner”), Petitioner opposed Respondent’s underlying application, application Serial No. 85218544, in Opposition No. 91200679,<sup>2</sup> on the ground of likelihood of confusion under Section 2(d) of the Trademark Act, claiming prior common law rights in the mark HIMANI for “goods in International Class 05” and ownership of Registration No. 3005688 for the mark HIMANI in standard characters for “[a]yurvedic 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” in International Class 5.<sup>3</sup>

Pursuant to a settlement agreement dated May 30, 2013 between the parties (the “Agreement”),<sup>4</sup> resolving the parties’ dispute in Opposition No. 91200679,

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<sup>2</sup> Opposition No. 91200679 was filed July 13, 2011 based on the claim of likelihood of confusion.

<sup>3</sup> Registration No. 3005688 issued October 11, 2005 on the Principal Register claiming a date of first use anywhere of 1942 and in commerce of September 2, 2002. A Section 8 and 9 affidavit was filed September 8, 2015 and accepted by the Office October 8, 2015.

<sup>4</sup> A copy of the Agreement was included with Respondent’s answer and its motion for

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Respondent filed a motion to amend the identification of goods in application Serial No. 85218544 on September 10, 2013, which the Board granted. Thereafter, on November 21, 2013, Petitioner filed a motion to withdraw the opposition without prejudice, which the Board granted. Respondent's application Serial No. 85218544 eventually matured into Registration No. 4460761.

Petitioner now seeks to cancel Respondent's Registration No. 4460761. Petitioner filed its petition to cancel on July 21, 2015 on the ground of likelihood of confusion under Section 2(d) of the Trademark Act claiming prior common law rights in the mark HIMANI for "goods in International Class 03" as well as a pending application for HIMANI for "soaps for personal use; shampoo; perfumery; essential oils; cosmetics; hair oils and lotions; dentifrices, namely, talcum powder, petroleum jelly for cosmetic use, cosmetic creams and lotions and toiletries" in International Class 3.<sup>5</sup> In her answer, Respondent denied the salient allegations of the petition to cancel and raised a variety of affirmative defenses, including contractual estoppel based on the parties' Agreement.

This case now comes up for consideration of Respondent's motion for summary judgment (filed February 22, 2016) based on contractual estoppel. The motion is fully briefed.

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summary judgment.

<sup>5</sup> Application Serial No. 85502259 was filed December 22, 2011 under Section 1(a) on the Principal Register claiming a date of first use anywhere and in commerce of May 10, 2005.

Respondent bases her motion for summary judgment on the Agreement between the parties which provides, in pertinent part, that:

1. Gupta agrees to amend the Gupta Application for HIMANI MAKEUP – SKINCARE and Design<sup>[6]</sup> 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.<sup>[7]</sup>
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....
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 ..., 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<sup>[8]</sup> as well as any use or registration of the mark EMAMI.

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<sup>6</sup> The Agreement provides that HIMANI MAKEUP – SKINCARE and Design is:

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

<sup>7</sup> The parties executed an addendum to the Agreement, dated November 18, 2013, which amends paragraph 1 of the Agreement to read as follows:

Gupta agrees to amend the Gupta Application for HIMANI MAKEUP SKINCARE and Design to narrow the identification of goods to the following: “cosmetics, namely, 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, facial cleaner, facial toner, facial moisturizer, eye cream, and neck and bust moisturizer, in Class 3.”

<sup>8</sup> The Agreement provides that “Emami is the owner of the mark ‘HIMANI’ (the ‘Himani Mark’) for a variety of goods, including but not limited to, Ayurvedic preparations,

5. Emami agrees to withdraw without prejudice basis its opposition to the Gupta Application ....
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.

Respondent argues that she limited her identification of goods pursuant to the Agreement and has otherwise complied with its terms; and that Petitioner's petition to cancel violates the terms of the Agreement.

In response, Petitioner argues that paragraph 4 of the Agreement prohibits Respondent from "directly or indirectly[ ] challeng[ing]" Petitioner's use or registration of the Himani Mark, which it argues includes the mark that is subject to application Serial No. 85502259 (which Respondent disputes); that by refusing to consent to Petitioner's application, which has been refused registration by the Office based on Respondent's registration, Respondent has failed to comply with paragraph 4 of the Agreement; and that therefore, Petitioner is relieved from paragraph 6 of the Agreement and is thus, not contractually estopped from pursuing the instant cancellation. In support of its arguments, Petitioner filed the declaration of its attorney, Leo Loughlin, who

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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."

declares that the parties discussed application Serial No. 85502259 during the parties' February 16, 2012 discovery conference for Opposition No. 91200679.

***Summary Judgment***

Summary judgment is an appropriate method of disposing of cases in which there are no genuine disputes as to any material fact, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(c). The party moving for summary judgment has the initial burden of demonstrating that there is no genuine dispute of material fact remaining for trial and that it is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317 (1987); *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *See Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). Evidence on summary judgment must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. *See Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA*, 23 USPQ2d at 1472. The Board may not resolve genuine disputes as to material facts; it may only ascertain whether genuine disputes as to material facts exist. *See Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1542.

***Standing***

Inasmuch as Petitioner has alleged that its pending application Serial No. 85502259 has been refused registration based on Respondent's registration, it has alleged a real interest, a personal stake, in the outcome of this proceeding. *See Empresa Cubana del Tabaco v. General Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Saddlesprings Inc. v Mad Croc Brands Inc.*, 104 USPQ2d 1948, 1950 (TTAB 2012); *see also Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999). Furthermore, standing is adequately established by the introduction of the parties' Agreement, which provides evidence of a real interest in this proceeding. *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1530 (TTAB 2008) (citing *Vaughn Russell Candy Co. v. Coolies in Bloom Inc.*, 47 USPQ2d 1635, 1638 n.7 (TTAB 1998)).

***The Agreement***

The Board will give effect to a settlement agreement to the extent that the agreement is relevant to issues properly before the Board. *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641, 647 (Fed. Cir. 1983). *See also, M-5 Steel Mfg. Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086, 1095 (TTAB 2001). "Although other courts would be the proper tribunals in which to litigate a cause of action for enforcement or breach of the contract here involved, that is not sufficient reason for the board to decline to consider the agreement...." *Bausch & Lomb Inc.*, 87 USPQ2d at 1530 (quoting *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1315, 217 USPQ 641, 647 (Fed. Cir. 1983)). Construction of a

contract is a question of law and therefore, resolution of the meaning and interpretation of a contract is appropriate on summary judgment. *Id.*

The parties' settlement agreement contains a choice-of-law-clause stating that the agreement "shall be construed in accordance with the federal trademark laws and the laws of the District of Columbia." 11 TTABVUE Agreement ¶ 10. We accordingly look to that jurisdiction for precedent on substantive, non-trademark issues. Precedent teaches that where a contract is clear on its face, extrinsic or parol evidence is not admissible to interpret it. *See, e.g., Bragdon v. Twenty-Five Twelve Assocs. Ltd. P'ship*, 856 A.2d 1165, 1170 (D.C. 2004) ("A court must honor the intentions of the parties as reflected in the settled usage of the terms they accepted in the contract ... and will not torture the words to import ambiguity where the ordinary meaning leaves no room for ambiguity.") (citations omitted); *1010 Potomac Assocs. v. Grocery Mfrs. Of Am., Inc.*, 485 A.2d 199, 205 (D.C. 1984) (In construing a contract, the court must "determin[e] what a reasonable person in the position of the parties would have thought the disputed language meant."); *Bolling Fed. Credit Union v. Cumis Ins. Soc'y, Inc.*, 475 A.2d 382, 385 (D.C. 1984) (If the document is facially unambiguous, the court "must rely upon its language as providing the best objective manifestation of the parties' intent."). However, when the terms of the contract are ambiguous, we may look beyond the language of the contract to ascertain the parties' intentions. *See Stamenich v. Markovic*, 462 A.2d 452, 455 (D.C. App. 1983); *Fistere, Inc. v. Helz*, 226 A.2d 578, 580 (D.C. App. 1967). *See*

*also Regan v. Spicer HB, LLC*, 134 F. Supp. 3d 21, 32-33 (D.D.C. 2015) (citing *Segal Wholesale, Inc. v. United Drug Serv.*, 933 A.2d 780, 783 (D.C. 2007)); *Red Lake Band of Chippewa Indians v. Dep't of Interior*, 624 F. Supp. 2d 1, 15 (D.D.C. 2009); *U.S. v. Sears, Roebuck and Co.*, 623 F. Supp. 7, 9 (D.D.C. 1984); Wright, Miller & Kane, 10B *Fed. Prac. & Proc. Evid.* § 2703.1 (3d ed., April 2016 Update) (“[L]egal effect or construction of a contract is a question of law that properly may be determined on a summary-judgment motion when the parties’ intentions are not in issue. Indeed, when the contract is unambiguous on its face, the operation of the parol-evidence rule will preclude the introduction of outside evidence to dispute its terms and summary judgment is particularly appropriate.”). Contracts are not rendered ambiguous simply because the parties do not agree upon their construction. *See, e.g., Abdelrhman v. Ackerman*, 76 A.3d 883, 888 (D.C. App. 2013); *Tillery v. D.C. Contract Appeals Bd.*, 912 A.2d 1169, 1177 (D.C. App. 2006); *Washington Properties, Inc. v. Chin, Inc.*, 760 A.2d 546, 548 (D.C. 2000). “The question of whether an agreement is clear or ambiguous is one of law for the court.” *United States v. Bank of Am.*, 78 F. Supp. 3d 520, 526 (D.D.C. 2015) (citing *NRM Corp. v. Hercules, Inc.*, 758 F.2d 676, 682 (D.C. Cir. 1985)).

Neither party disputes that Respondent amended the identification of goods in her application Serial No. 85218544 (which later matured into Registration No. 4460761); nor that Opposition No. 91200679 was dismissed pursuant to the Agreement. The question now presented is whether Respondent breached the

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Agreement by not consenting to Petitioner's application Serial No. 85502259, thereby relieving Petitioner from the terms of the Agreement.

We find the Agreement quoted above to be complete, clear, and unambiguous on its face. Accordingly, we do not consider extrinsic evidence of the parties' intent, such as the declaration of Petitioner's counsel. Petitioner's position that the Agreement requires Respondent's consent to application Serial No. 85502259 is not supported by the language of the Agreement. No mention of application Serial No. 85502259 was included in the Agreement, nor did the Agreement require Respondent to execute a consent or any other document necessary for registration of Petitioner's mark set forth in application Serial No. 85502259. It is not reasonable to believe that the parties left out reference to this application, which was pending prior to execution of the Agreement, but intended it to be included in the terms of the Agreement, or that they intended Respondent to take on the obligation of signing anything on Petitioner's behalf.

Further, paragraph 4 of the Agreement prohibits Respondent from "directly or indirectly, challeng[ing] 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 [Petitioner] ...." Unless otherwise specified, words in a contract will be given their ordinary meaning. *See Bragdon v. Twenty-Five Twelve Assocs. Ltd. P'ship*, 856 A.2d 1165, 1170 (D.C. 2004); *Redmond v. State Farm Ins. Co.*, 728 A.2d 1202, 1206 (D.C. 1999); *Bank of Am.*, 78 F. Supp. 3d at 526 (citing *Mesa Air Grp., Inc. v. Dep't of Transp.*, 87 F.3d 498, 503 (D.C. Cir. 1996); *Washington*

*Metro. Area Transit Auth. v. Nello L. Teer Co.*, 618 A.2d 128, 132 (D.C. 1992).

And given its ordinary meaning, the word “challenge” as it is used in the parties’ agreement requires some action to be taken by the challenger. *See, e.g., Definition of “challenge,”* MERRIAM-WEBSTER.COM, <http://www.merriam-webster.com/dictionary/challenge> (visited July 19, 2016) (“to make or present a challenge”; “to question formally the legality or legal qualifications of <challenge a juror>.”).<sup>9</sup> Petitioner does not allege that Respondent has taken any action to prevent Petitioner’s use of the HIMANI mark, or to question the legality of Petitioner’s ownership or use of it. Petitioner cannot manufacture an issue of fact by advocating an unreasonable construction of terms in a clear and unambiguous agreement.

### ***Conclusion***

In view of the foregoing and on the record presented, we find that there are no genuine disputes as to material facts remaining for trial. As a matter of law, the Agreement is clear that Respondent is not required to give consent to Petitioner’s pending application and therefore, failure to provide consent does not render Respondent in breach of the terms of the Agreement. As a consequence, Petitioner is contractually estopped from pursuing the instant cancellation. In view thereof, Respondent’s motion for summary judgment based

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<sup>9</sup> The Board takes judicial notice of this dictionary definition. *See In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.23 (TTAB 2013); *In re Thomas White International Ltd.*, 106 USPQ2d 1158, 1160 n.1 (TTAB 2013); *In re Future Ads LLC*, 103 USPQ2d 1571, 1572 (TTAB 2012); *In re Premiere Distillery LLC*, 103 USPQ2d 1483, 1484 n.2 (TTAB 2012).

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on contractual estoppel is **granted**. This cancellation proceeding is hereby dismissed with prejudice.