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

Proceeding	92062880
Party	Defendant Paramount Brand Roses, Inc.
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Attachments	Paramount Brand Roses, Inc. - Reply Brief in Further Support of Motion to Dismiss.pdf(330438 bytes ) Paramount Brand Roses, Inc. - Proof of Service of Reply Brief in Further Support of Motion to Dismiss.pdf(8691 bytes )

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

_____ )	Cancellation No.: 92062880
POULSEN ROSER A/S, )	Registration No. 1980921
)	
Petitioner, )	Mark: PARAMOUNT
vs. )	
)	
PARAMOUNT BRAND ROSES, INC., )	
)	
Respondent. )	
_____ )	

**RESPONDENT’S REPLY BRIEF IN FURTHER SUPPORT OF MOTION TO  
DISMISS PETITION FOR CANCELLATION FOR LACK OF STANDING  
PURSUANT TO 15 U.S.C. § 1064 AND FAILURE TO STATE A CLAIM  
PURSUANT TO FED. R. CIV. P. 12(b)(6)<sup>1</sup>**

Petitioner’s brief in opposition to Respondent’s Motion to Dismiss (the “Opposition Brief”) fails to overcome the glaring deficiencies in the Petition for Cancellation that mandate its dismissal. Without dispute, Petitioner fails to allege any use of the Registered Mark that would support its required “real interest” in this proceeding. Petitioner’s failure to allege use of the Registered Mark in the Petition for Cancellation mandates dismissal of this action for lack of standing. Moreover, Petitioner’s Opposition Brief fails to justify the woefully deficient factual allegations in the Petition for Cancellation that merely parrot the statutory elements of a cause of action for abandonment under 15 U.S.C. § 1127. Tellingly, absent from the Petition for Cancellation is any allegation that Paramount is *not* using the Registered Mark. Without more, Petitioner’s “threadbare recitals of the elements of a cause of action” are insufficient to withstand this motion to dismiss. See Ashcroft v. Iqbal, 556 U.S. 662, 678 (2009); Nike, Inc. v. Palm Beach Crossfit Inc. d/b/a Crossfit CityPlace, Opposition No. 91218512 \*5 (T.T.A.B. 2015).

<sup>1</sup> Undefined capitalized terms used herein have the meanings set forth in Paramount’s initial Respondent’s Brief in support of its motion.

Accordingly, the Board should dismiss the Petition for Cancellation for lack of standing and failure to adequately state a claim for abandonment.

### LEGAL ARGUMENT

#### **I. PETITIONER’S FAILURE TO ALLEGE USE OF THE REGISTERED MARK IS FATAL TO ITS PETITION FOR CANCELLATION.**

Unable to dispute that it never alleged use of the Registered Mark, Petitioner argues the cease and desist letter it received from Respondent is sufficient to demonstrate its standing in this proceeding. However, in each of the cases relied on by Petitioner in support of its self-serving conclusion, the petitioner alleged and/or demonstrated its use of the mark that formed the basis for the “real interest” required by 15 U.S.C. § 1064 and the case law interpreting it. Petitioner, in contrast, fails to allege *any use* of the mark in the underlying Petition for Cancellation, and its Petition for Cancellation must therefore be dismissed.

The cases on which Petitioner relies are readily distinguishable. In Alcatraz Media Inc. v. Chesapeake Marine Tours Inc., the Board explained that a plaintiff’s belief in damage must have “a reasonable basis in fact and reflect[] a real interest in the case” to demonstrate standing to pursue the proceeding. 107 U.S.P.Q.2d 1750 \*11 (T.T.A.B. 2013). There, the petitioner established it operated “a website . . . comprised in part of respondent’s registered mark,” and because of that use the Board determined, “petitioner has shown it is not a mere intermeddler, but has a real interest in this proceeding.” Id. Similarly, in Miller v. Miller, plaintiff opposed registration of defendant’s mark. The Board found that “because opposer has **demonstrated its usage** and competitive need of the wording comprising [the challenged mark], opposer has established its standing to oppose applicant’s mark.” 105 U.S.P.Q.2d 1615 (T.T.A.B. 2013) (emphasis added). The Board cited the cease and desist letters sent by the applicant as merely “additional evidence that opposer has business interests that have been affected.” Id. However,

the Board only considered this additional evidence *after* it determined the opposer had a real interest in the proceeding based on the opposer's actual use of the challenged mark.

The remaining two non-precedential decisions of the Board relied on by Petitioner are also inapposite. In Chauvin v. Sasser, the petitioner established its common law rights in the challenged mark, which, together with respondent's cease and desist letter, formed the basis for the Board's finding that standing existed. (Cancellation No. 92058148 \*12 Nov. 19, 2014, a copy of this decision is attached hereto as Exhibit A). In Life Enhancement Center v. CR License, LLC, the mark petitioner sought to cancel was its business name, which demonstrated the basis for its interest in seeking cancellation of the subject mark. (Cancellation No. 92057149 Aug. 1, 2014, a copy of this decision is attached hereto as Exhibit B). In each of these cases, the petitioner's *use* of the mark was the *sine qua non* of its standing to prosecute the cancellation proceeding.

Here, Petitioner failed to allege facts that demonstrate its alleged interest in this action, any relationship to the Registered Mark, and/or any damage it suffers as a result of the Registered Mark. Petitioner never responded to the cease and desist letter to admit or deny its alleged misuse of the Registered Mark, and the Petition for Cancellation contains no allegations that Petitioner uses the Registered Mark and/or seeks to do so. As a result, Petitioner has not alleged the required "direct and personal stake" in the outcome of this cancellation proceeding. Notwithstanding its receipt of a cease and desist letter from Paramount, if Petitioner is not using the Registered Mark, then its receipt of a cease and desist letter is meaningless as there is no conduct for it to cease. Therefore, the Petition for Cancellation should be dismissed due to Petitioner's failure to plead any use of the Registered Mark that would support its standing to proceed.

**II. PETITIONER'S CONCLUSORY ALLEGATIONS AND RECITALS OF THE ELEMENTS OF A CLAIM FOR ABANDONMENT ARE INSUFFICIENT TO DEFEAT THIS MOTION TO DISMISS.**

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Petitioner essentially asks this Board to disregard its jurisprudence and that of the Supreme Court and *lower* the pleading standard required in cancellation proceedings. The Board should decline to do so. The Supreme Court and this Board require a plaintiff to plead more than just the elements of a cause of action to support its initial pleading. See Ashcroft v. Iqbal, 556 U.S. 662, 678 (2009) (citing Bell Atlantic Corp. v. Twombly, 550 U.S. 544, 555 (2007)). Because Petitioner has done nothing more than repeat the statutory verbiage for a claim of abandonment, the Board should grant Paramount's motion and dismiss the Petition for Cancellation.

To successfully plead its claim for abandonment purportedly based on "non-use," Petitioner must allege facts that show use of the Registered Mark "has been discontinued with intent not to resume such use." (15 U.S.C. § 1127; see Petition for Cancellation ¶ 11.) The statute expressly provides that "[n]onuse for 3 consecutive years shall be prima facie evidence of abandonment" and further states that "[i]ntent not to resume may be inferred from circumstances." Id. However, Petitioner has not alleged that Paramount did not use the Registered Mark for 3 consecutive years, nor has Petitioner pled any factual circumstances whatsoever from which Paramount's "intent not to resume" use of its Registered Mark could be inferred.

In an attempt to overcome its factual deficiencies, Petitioner relies on Johnson & Johnson and Roc Int'l v. Obschestvo S Ogranitchennoy, 104 U.S.P.Q.2d 2037 (T.T.A.B. 2012). There, the Board confirmed that "a complaint must contain sufficient factual matter . . . to state a claim to relief that is plausible on its face." 104 U.S.P.Q.2d 2037 \*1 (citing Ashcroft v. Iqbal, 556 U.S.

at 570). The Board determined that the complaint adequately pled a claim for abandonment when it contained, among others, the following allegations:

37. Upon information and belief, Opposers **are not using the mark** in pleaded Registration No. 1015041 in connection with “skin powder”.

[. . .]

40. Upon information and belief, Opposers **are not using the mark** in pleaded Registration No. 1015041 in connection with “rouge”.

[. . .]

43. Upon information and belief, Opposers **are not using the mark** in pleaded Registration No. 1015041 in connection with “rouge”.

[See Answer and Counterclaim filed by Applicant/Cross-Petitioner in Johnson & Johnson, attached hereto as Exhibit C (emphasis added).]

Unlike the Cross-Petitioner in Johnson & Johnson, Petitioner here has **not** alleged that Paramount is currently “not using the Registered Mark” in connection with any of its covered goods. Rather, with respect to the time period during which Paramount purportedly ceased using its Registered Mark, Petitioner alleges only one specific date on which Paramount did not use its Registered Mark; Petitioner alleges that Paramount “ceased using [its] mark . . . on or about January 1, 2009.” (Petition for Cancellation ¶ 8.) This allegation regarding termination of “use” pales in comparison to the allegations of non-use in Johnson & Johnson, where the Cross-Petitioner alleged the opposer was not using the mark at the time the counterclaim for abandonment was filed. (See 104 U.S.P.Q.2d 2037 \*1.) Petitioner’s failure to allege that Paramount is currently “not using the Registered Mark” renders its reliance on Johnson & Johnson misplaced. It also completely undermines any inference that, if Paramount ceased use

of the Registered Mark at any time (which it did not), Paramount intended not to resume use of the Registered Mark.<sup>2</sup> As a result, its abandonment claim based on alleged non-use fails.

Petitioner's reliance on Dragon Bleu (SARL) v. VENM, LLC, 112 U.S.P.Q.2d 1925 (T.T.A.B. 2014) is also misplaced and actually supports *Paramount's* position. There, VENM applied for registration of its mark and Dragon Bleu opposed registration. VENM filed a counterclaim for abandonment alleging, among other things, Dragon Bleu "has not used its [marks]" since it stated its use in the applications for registration and that in the 5-year period since the application, Dragon Bleu has made "no use" of its marks. Id. at 6. Dragon Bleu moved to dismiss for failure to state a claim, and the Board granted the motion, finding that "[b]ecause Applicant pleaded no facts from which we could conclude that Opposer does not intend to commence use of its registered marks, the counterclaim fails to state a claim upon which relief can be granted." Id. at 9. These allegations contained substantially more detailed facts than Petitioner has alleged here, and yet the Board nonetheless determined the allegations were insufficient to adequately plead the requisite intent to support the abandonment claim.

As a result of the glaring factual deficiencies in the Petition for Cancellation, the Board should grant Paramount's motion to dismiss, and dismiss the Petition for Cancellation with prejudice.

### **CONCLUSION**

The Petition for Cancellation is based on self-serving legal conclusions and devoid of factual allegations from which the Board could determine that: (i) Petitioner has standing to pursue this proceeding; and/or (ii) Paramount has abandoned its Registered Mark. Petitioner has

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<sup>2</sup> In fact, Petitioner cannot in good faith allege that Paramount is not using its Registered Mark. A good faith investigation by Petitioner will show Paramount is currently, and has consistently, used its Registered Mark.

not alleged it has ever used the Registered Mark and/or specified how the Registered Mark causes it to suffer damages, and therefore Petitioner has not demonstrated a “real interest” in the cancellation of Paramount’s incontestable registration. Furthermore, the conclusory *legal* statements in the Petition for Cancellation – which amount to nothing more than a recitation of the elements of a claim for abandonment – are wholly insufficient. Petitioner has not, and indeed *cannot* allege that Paramount is not using the Registered Mark and has failed to plead any factual circumstances from which the Board could infer that Paramount stopped using its Registered Mark – at any time – much less with intent not to resume use. At an absolute minimum, Paramount is entitled to fair notice of Petitioner’s factual theory of abandonment, and the Petition for Cancellation provides no such direction. For the foregoing reasons, Respondent Paramount Brand Roses, Inc. respectfully requests the Board dismiss the Petition for Cancellation with prejudice.

COLE SCHOTZ P.C.  
Attorneys for Respondent Paramount Brand  
Roses, Inc.

By: /s/ Nicole G. McDonough  
David M. Kohane  
Nicole G. McDonough

DATED: March 17, 2016

# **EXHIBIT A**

This Opinion is Not a  
Precedent of the TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

CME

Mailed: November 19, 2014

Cancellation No. 92058148

*Jesse Chauvin d/b/a Deth Roll*<sup>1</sup>

*v.*

*K. Shane Sasser*

Before Bucher, Bergsman and Greenbaum,  
Administrative Trademark Judges.

By the Board:

This case now comes up for consideration of Petitioner's motion for summary judgment, filed June 24, 2014. Respondent opposes the motion.<sup>2</sup>

### ***Background***

Petitioner has filed a petition for cancellation of Respondent's registration No. 4404240 for the mark DEATH ROLL, in standard characters, for "Hats; Hooded sweatshirts; Shirts; Shorts; Sweatpants; T-shirts; Tank tops."<sup>3</sup> In its

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<sup>1</sup> Petitioner is identified in the petition for cancellation and accompanying ESTTA cover sheet as doing business as DETH ROLL, a New Hampshire sole proprietorship. Accordingly, in referring to Petitioner, we use the pronoun "it" as opposed to "he."

<sup>2</sup> We note that Respondent's response brief is single-spaced in contravention of Trademark Rule 2.126(a)(1). Nevertheless, because of the dispositive nature of Petitioner's motion, we have exercised our discretion to consider Respondent's response brief.

<sup>3</sup> Issued on September 17, 2013 from an application filed on March 18, 2012 and claiming first use anywhere and first use in commerce on June 10, 2013.

petition for cancellation, Petitioner alleges (i) prior common law use of the mark DETH ROLL<sup>4</sup> for apparel and retail store and online store services featuring apparel, and that Respondent's use of the mark DEATH ROLL for the involved goods is likely to cause confusion with Petitioner's mark, and (ii) that Respondent fraudulently procured the involved registration. Petitioner moves for summary judgment only on its claim of priority and likelihood of confusion.

In his answer, Respondent admits that:

- “On September 12, 2013, [Respondent] contacted Petitioner via email claiming to be the sole owner of the DEATH ROLL trademark and of the crocodile design logo. [Respondent] asserted that the words DEATH ROLL and DETH ROLL were confusingly similar when both were used on apparel. Relying on its trademark application, [Respondent] then demanded that Petitioner cease use of the DETH ROLL mark and of the crocodile design mark.” Answer, ¶ 8; and
- “both parties are involved in apparel.” *Id.* at ¶ 14.

Respondent denies the remaining salient allegations in the petition for cancellation, but in so doing he elaborates that “[b]oth words are phonetically identical.” *Id.* at ¶ 11; *see also id.* at ¶ 12. Respondent also asserts various “affirmative defenses,” that are not proper affirmative defenses, but instead are mere amplifications of Applicant's denials.

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<sup>4</sup> Petitioner also alleges that it “has continuously used two design trademarks for its apparel and retail thereof: one a stylized version of the DETH ROLL mark, the other a stylized image consisting of a profile silhouette of a crocodile with its mouth open.” Petition, ¶ 3. Petitioner alleges use of the crocodile design since 2009, *see id.* at ¶ 7, but does not allege when it began using the stylized version of the DETH ROLL mark.

***Evidentiary Issues***

As an initial matter, we address the admissibility of the evidence that the parties have submitted in connection with their briefs. In support of its motion, Petitioner submitted: (1) the declaration of its founder and owner, Jesse Chauvin; (2) Exhibit A to the Chauvin declaration consisting of documents related to the establishment of the DETH ROLL business; (3) Exhibit B to the Chauvin declaration consisting of website pages showing Petitioner's "currently offered collection"; (4) Exhibit C to the Chauvin declaration, consisting of a copy of email correspondence between the parties; (5) Exhibit D to the Chauvin declaration consisting of a letter from Petitioner to Respondent; (6) two of Petitioner's invoices bearing the mark DETH ROLL attached to the motion as Exhibit E; (7) an Internet printout from the Merriam-Webster online dictionary for the term "death"; and (8) Wikipedia pages for the term "Death roll."

The documents attached as Exhibit A to the Chauvin declaration are not specifically identified therein, and therefore, we cannot consider them as exhibits to the declaration. *See Missouri Silver Pages Directory Publ'g Corp. Inc. v. Southwestern Bell Media, Inc.*, 6 USPQ2d 1028, 1030 n.9 (TTAB 1988). We also have not considered the invoices attached to Petitioner's motion as Exhibit E because they are not authenticated by (or even referenced in) the Chauvin declaration, and invoices are not otherwise self-authenticating. *See Hiraga v. Arena*, 90 USPQ2d 1102, 1105 (TTAB 2009) (company invoices not

official records). In addition, we give no consideration to Exhibit B to the Chauvin declaration and the dictionary and Wikipedia website pages as these webpages are undated and do not include the URL addresses and their source is not otherwise authenticated by the Chauvin declaration. *See Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010) (holding that a document obtained from the Internet is admissible in the same manner as a printed publication if it identifies its date of publication or date that it was accessed and printed).

Respondent submitted various Internet pages with his response brief. Each of these pages bears the date the document was accessed and printed, but in many cases the URL address is only partially visible. We have considered only those documents clearly bearing both the URL address and the date the page was accessed and printed.<sup>5</sup>

### ***The Parties' Arguments***

Petitioner argues that its common law rights in the mark DETH ROLL predate Respondent's actual and constructive first use dates, *see* Motion, pp. 5-6; that the marks are "highly similar," are pronounced the same, and create "identical" commercial impressions, *Id.* at p. 7; that both parties use their marks in connection with apparel and Respondent has conceded as much, *see id.* at pp. 8-9; and that because there is no trade channel restriction in the

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<sup>5</sup> We hasten to add, however, that even if we had considered unauthenticated documents or those not submitted in compliance with Board rules, it would not change our decision herein.

involved registration, Respondent's clothing items are presumed to travel in the ordinary channels of trade for such goods, "namely, apparel retail stores, department stores, outlet stores, and online retail stores that sell to the general public." *Id.* at pp. 9-10. Petitioner further contends that Respondent has conceded the similarity of the marks because he admitted in his answer that he sent Petitioner a letter "assert[ing] that the words DEATH ROLL and DETH ROLL were confusingly similar when both were used on apparel," and because he has acknowledged that the parties' marks are phonetically identical and that "the words 'deathroll' and 'dethroll' are not dissimilar, are confusingly similar." *Id.* at p. 8.

In support of Petitioner's motion, Mr. Chauvin attests as follows:<sup>6</sup>

- "Petitioner first commenced use of DETH ROLL as a trademark on its apparel and in connection with its retail services on March 29, 2009, and has since continuously used the trademark DETH ROLL to brand its apparel and handbags." Chauvin Declaration, ¶ 5;

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<sup>6</sup> Petitioner's petition for cancellation and brief as well as the Chauvin declaration consistently display Petitioner's mark DETH ROLL as two words. Exhibit 7 to Respondent's brief shows Petitioner's mark displayed as both one word (DETHROLL) and two words (DETH ROLL). Whether Petitioner's mark is displayed with or without a space has no bearing on our decision as DETH ROLL and DETHROLL create the same commercial impression, and therefore, are legal equivalents. *See Stock Pot, Inc. v. Stockpot Restaurant, Inc.*, 220 USPQ 52, 54 (TTAB 1983), *aff'd* 737 F.2d 1576, 22 USPQ 665 (Fed. Cir. 1984) ("There is no question that the marks of the parties [STOCKPOT AND STOCK POT] are confusingly similar. The word marks are phonetically identical and visually almost identical."); *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1025 (TTAB 2009) ("[T]he spaces that respondent places between the words [in its mark] do not create a distinct commercial impression from petitioner's presentation of his mark as one word"); *Cf. In re Carlson*, 91 USPQ2d 1198 (TTAB 2009) (finding "that the compression of the words URBAN HOUSING into a single term, URBANHOUSING, still conveys the commercial impression of two words"); *In re Planalytics Inc.*, 70 USPQ2d 1453, 1456 (TTAB 2004). ("gasbuyer" is the equivalent of "gas buyer"). Accordingly, for ease of reference, we display Petitioner's mark herein as DETH ROLL (two words).

- “The DETH ROLL brand has consistently offered graphic print t-shirts, hooded sweatshirts, tank-tops, base-ball style hats, and handbags.” *Id.* at ¶ 6;
- “Since 2009, Petitioner has established loyal local customers and has made sales throughout the United States and internationally through its online retail website, www.dethroll.com.” *Id.* at ¶ 7;
- “On September 12, 2014, I received an email from [Respondent] demanding that Petitioner immediately cease use of the DETH ROLL mark on apparel, claiming that it was confusingly similar to [Respondent’s] own DEATH ROLL mark.” *Id.* at ¶ 9; and
- “Petitioner seeks to federally register its own mark, DETH ROLL, but believes it is incapable of doing so while a nearly identical mark is currently registered for identical goods.” *Id.* at ¶ 11.

In opposition to the motion, Respondent argues that Petitioner’s standing “is without merit” and that there is no likelihood of confusion because the parties’ marks “are not similar visually, in spelling, in construction, in meaning, nor are the goods identical, and nor are they used for the same target consumers or in the exact same channels of trade.”<sup>7</sup> Response, p. 3. With respect to the connotation of the marks, Respondent argues that the term “death roll” has three meanings, namely, (1) “the attacking behavior of crocodiles and alligators when subduing their prey”; (2) “the act of a keel boat broaching to windward, putting the spinnaker pole into the water and causing a crash-gybe of the boom and main sail, which sweep across the deck and plunge down into the water”; and (3) “[a] list of persons killed in war.” *Id.*

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<sup>7</sup> *Pro se* Respondent also argues that he “has standing to oppose the petition to cancel” based on his “submitted evidence of [his] ownership and use of the mark DETH ROLL for apparel (via Statement of Use) as well as [his] evidence of [his] prior use of [the DEATH ROLL] mark in connection with apparel.” Response, p. 3. This argument, however, is misplaced as it is not Respondent but Petitioner – the claimant in this proceeding – who needs to establish its standing to bring this cancellation action. *See* 15 USC § 1064.

at p. 4. Respondent argues that because he uses his mark DEATH ROLL in connection with a design of two crocodiles, his mark “refers specifically to the attacking behavior of crocodiles and alligators” whereas Petitioner’s mark DETH ROLL “is clearly without meaning, as the word is not a real word ... .” *Id.* Respondent further contends that Petitioner uses its mark in connection with a “2 wings and a cross” design, which “many war medals display.” *Id.*

With regard to the relatedness of the goods, Respondent concedes that “both parties are involved in apparel, and ... both utilize hats, hooded sweatshirts, T-shirts, and tank tops,” but Respondent points out that he does not use his mark DEATH ROLL in connection with handbags as does Petitioner. *Id.* at p. 5. Respondent argues that this fact “clearly shows” that the parties’ products are different. *Id.* Respondent also argues that the parties’ trade channels are different with Petitioner “oriented toward the ‘tattooed/hardcore community’” and Respondent “focused strictly on the athletic community, specifically, on the Mixed Martial Arts (MMA) community.” *Id.* at p. 6. In addition, Respondent asserts that “it is clear from Petitioner that its business is conducted via tradeshow and the Web” whereas Respondent markets his products at mixed martial arts events, sporting goods stores, “and, in the future, the [W]eb.” *Id.*

***Summary Judgment Standard***

Summary judgment is only appropriate where there are no genuine disputes as to any material facts, thus allowing the case to be resolved as a

matter of law. Fed. R. Civ. P. 56(a). The party seeking summary judgment bears the burden of demonstrating the absence of any genuine dispute of material fact, and that it is entitled to a judgment under the applicable law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Sweats Fashions, Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1796 (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 most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. *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.

**A. Standing**

Respondent has conceded the issue of standing by admitting in his answer that he sent a cease and desist letter to Petitioner. *See Answer*, ¶ 8; *Kellogg Co. v. Pack'Em Enters. Inc.*, 14 USPQ2d 1545, 1548 n.6 (TTAB 1990) (pleadings have evidentiary value only to the extent they contain opponent's

admission against interest), *aff'd on other grounds*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); TBMP § 704.06(a) (2014); *see also Miller v. Miller*, 105 USPQ2d 1615 (TTAB 2013) (determining that the cease and desist letters applicant sent to opposer “provide[d] additional evidence that opposer has business interests that have been affected, i.e., a real interest in the proceeding, and thus, has standing.”); *Ipcor Corp. v. Blessings Corp.*, 5 USPQ2d 1974, 1977 (TTAB 1988) (finding cease and desist letter sent by applicant sufficient to demonstrate opposer’s standing). The Chauvin declaration provides further evidence of Petitioner’s standing as it establishes Petitioner’s prior common law rights in the mark DETH ROLL, *see infra* at 10-11, and that Petitioner is interested in registering its DETH ROLL mark, “but believes it is incapable of doing so while [Respondent’s] nearly identical mark is currently registered for identical goods.” Chauvin Declaration, ¶ 11. Accordingly, there are no genuine disputes of any material fact regarding Petitioner’s standing. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

**B. Priority**

For Petitioner to prevail on its claim of likelihood of confusion based on common law rights in the mark DETH ROLL, “the mark must be distinctive, inherently or otherwise, and [Petitioner] must show priority of use.” *Wet Seal Inc. v. FD Mgmt. Inc.*, 82 USPQ2d 1629, 1634 (TTAB 2007) (citing *Otto Roth*

*& Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981)). Respondent has not submitted any evidence that Petitioner's mark DETH ROLL is merely descriptive of or generic for apparel or the retail sale of apparel. Accordingly, we find that there are no genuine disputes of material fact regarding the distinctiveness of the mark DETH ROLL.

With respect to priority, there is no evidence of record concerning when Respondent commenced use of the mark DEATH ROLL. Accordingly, the earliest date upon which Respondent may rely for priority is the filing date of the application underlying the involved registration, which is May 18, 2012. *See Giersch*, 90 USPQ2d at 1022-23.

The Chauvin declaration establishes Opposer's prior and continuous use of the mark DETH ROLL for apparel, namely, graphic print t-shirts, hooded sweatshirts, tank-tops, base-ball style hats, and handbags since March 29, 2009, as the declaration is clear and convincing and uncontradicted by Respondent. *See, e.g. Nat'l Bank Book Co. v. Leather Crafted Prods., Inc.*, 218 USPQ 827, 828 (TTAB 1993) (acknowledging that oral testimony may be sufficient to prove the first use of a party's mark when it is based on personal knowledge, it is clear and convincing, and it has not been contradicted); *GAF Corp. v. Amatol Analytical Servs., Inc.*, 192 USPQ 576, 577 (TTAB 1976) ("It is established that ownership of a trademark and of a trademark registration *as well as use of a mark* may be established by the oral testimony of a single

witness where such testimony is clear, consistent, convincing, circumstantial and uncontradicted.”) (emphasis added).

In view of the foregoing, Petitioner has carried its burden on summary judgment of establishing that there are no genuine disputes of material fact regarding its prior rights in the mark DETH ROLL.

**C. Likelihood of Confusion**

We treat Respondent’s admission in his answer that he sent a cease and desist letter to Petitioner asserting “that the words DEATH ROLL and DETH ROLL were confusingly similar when both were used on apparel” as an admission against interest with respect to Petitioner’s claim of likelihood of confusion. Answer, ¶ 8; *Pack’Em Enters.*, 14 USPQ2d at 1548 n.6, *aff’d on other grounds*, 951 F.2d at 330, 21 USPQ2d at 1142. Still, we proceed with analyzing the issue of likelihood of confusion based on all the facts in evidence relevant to the factors enumerated in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See *Giersch*, 90 USPQ2d at 1025. Here, the relevant factors for consideration are the similarities between the parties’ marks and goods, and the relevant trade channels.

Turning first to the similarity of the parties’ goods, we must compare the goods identified in the involved registration to those that Petitioner offers under its mark. See *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002). Here, Respondent has registered the mark DEATH ROLL for “Hats; Hooded sweatshirts; Shirts;

Shorts; Sweatpants; T-shirts; Tank tops” and Petitioner has proven use of its mark for overlapping goods, namely, graphic print t-shirts, hooded sweatshirts, tank-tops, and base-ball style hats. Respondent also has conceded that “both parties are in apparel, and that both parties utilize hats, hooded sweatshirts, T-shirts, and tank tops.” Response at p. 5. Accordingly, the goods are in part identical.

Under this *du Pont* likelihood of confusion factor, Petitioner need not prove and we need not find similarity as to each and every Class 25 product identified in the registration in order to grant the petition for cancellation as to the entire class of identified goods. See *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1492 n.30 (TTAB 2007); *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1848 n.9 (TTAB 2004).

Because the goods are in part identical, we must presume that the channels of trade and classes of consumers are the same. See *In re Yawata Iron & Steel Co., Ltd.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); see also *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence

regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

With respect to the degree of similarity between the parties' marks, we note that where the goods of a petitioner and respondent are in part identical, as is the case in this proceeding, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse goods. *See In re Viterra*, 101 USPQ2d at 1908 (citing *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992)). Here, the parties' marks are visually very similar differing by only one letter, and Respondent concedes that the marks are phonetically identical. *See Answer at ¶¶ 11-12; see Pack'Em Enters.*, 14 USPQ2d at 1548 n.6, *aff'd on other grounds*, 21 USPQ2d at 1142. Indeed, consumers are likely to recognize the term "deth" in Petitioner's mark as the correctly spelled word "death." *See Armstrong Paint & Varnish Works v. Nu-Enamel Corp.*, 305 U.S. 315 (1938 (NU in the mark NU-ENAMEL is the equivalent of "new")); *In re Quik-Print Copy Shops*, 616 F.2d 523, 205 USPQ 505, 507 n.9 (CCPA 1980) ("There is no legally significant difference here between 'quik' and 'quick.'"); *Cf. In re South Bend Toy Manufacturing Company, Inc.*, 218 USPQ 479, 480 (TTAB 1983) (LIL' LADY BUGGY is similar to LITTLE LADY because the contraction of a term does not alter the essential identity and character of the full word and the contraction); *In re*

*Strathmore Products, Inc.*, 171 USPQ 766 (TTAB 1971) (GLISTEN is similar to GLISS'N because GLISS'N is a contraction of GLISTEN).

Given the close similarities between the parties' marks in sound and appearance, they engender very similar overall commercial impressions, Respondent's argument to the contrary notwithstanding. Specifically, Respondent argues that because his mark is displayed with a crocodile design, it conveys a different commercial impression from Petitioner's mark. Respondent's registration, however, is not for the mark DEATH ROLL with a crocodile design, but for the mark DEATH ROLL in standard character format, meaning that the mark is not limited to any specific form of display. Accordingly, the Board must assume that Respondent's mark could be displayed in the same style as Petitioner's mark. *See Weider Pub's, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1355 (TTAB 2014) (citing Trademark Rule 2.52(a)); *see also Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011); *In re RSI Systems LLC*, 88 USPQ2d 1445, 1448 (TTAB 2008).

Weighing all of the relevant likelihood of confusion factors together, and considering all of the admissible evidence of record, we find that there are no genuine disputes of material fact that a likelihood of confusion exists between the parties' marks when used on the identified goods.

***Conclusion***

Based on careful consideration of all the admissible evidence of record and the applicable law, we find that there are no genuine disputes as to any material facts and that Petitioner has established its standing and priority and a likelihood of confusion as a matter of law. Accordingly, Petitioner's motion for summary judgment is **GRANTED**. Judgment is entered against Respondent, the petition to cancel is sustained, and Registration No. 4404240 will be cancelled in due course.

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# **EXHIBIT B**

**This Opinion is Not a  
Precedent of the TTAB**

Mailed: August 1, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Life Enhancement Center v. CR License, LLC*  
—

Cancellation No. 92057149  
against Registration No. 2066095  
—

Jamie Carpenter of J. Carpenter Law Offices PLLC  
for Life Enhancement Center.

Jennifer A. Van Kirk, Sean D. Garrison and Cindy Villanueva of Lewis Roca  
Rothgerber LLP  
for CR License, LLC.

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Before Seeherman, Taylor and Lykos,  
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

On April 27, 2013, Life Enhancement Center (“Petitioner”) filed a petition to cancel CR License, LLC’s (“Respondent” or “CR License”) registration on the Principal Register for the mark **LIFE ENHANCEMENT CENTER**, in typed format,<sup>1</sup> for “health club services, namely providing exercise classes to others and conducting classes in exercise and physical conditioning” in International Class 41

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<sup>1</sup> Prior to November 2, 2003, “standard character” drawings were known as “typed” drawings. A typed mark is the legal equivalent of a standard character mark. Trademark Manual of Examining Procedure (“TMEP”) § 807.03(i) (April 2014).

and “medical, nutritional and therapeutic services and counseling on behavior modification and stress management; health resort and spa services” in International Class 42.<sup>2</sup> The mark is registered pursuant to Section 2(f), 15 U.S.C. § 1052(f),<sup>3</sup> with a disclaimer of the word **CENTER**.

As set forth in the amended petition to cancel, the grounds for cancellation are as follows: Respondent’s registered mark is generic “as it relates to counseling services,” (Amended Petition to Cancel ¶ 17) or alternatively, the mark is merely descriptive and has not acquired distinctiveness under Section 2(f) for “counseling services, nutrition or any other service...” (Petition to Cancel ¶ 14);<sup>4</sup> and that the involved registration and underlying application were improperly assigned.

With regard to Petitioner’s claims of genericness and improper assignment, Respondent denied the salient allegations. As to Petitioner’s claim in the alternative of mere descriptiveness and lack of acquired distinctiveness, Respondent asserted the affirmative defense that “Petitioner has failed to state a claim that the mark **LIFE ENHANCEMENT CENTER** is merely descriptive, as this ground fails as a

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<sup>2</sup> Registration No. 2066095 issued June 3, 1997 from an application filed March 7, 1994 pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). The registration alleges October 31, 1988 as the date of first use anywhere and in commerce; Sections 8 and 15 affidavits accepted and acknowledged; renewed.

<sup>3</sup> During the prosecution history of the application which ultimately matured into registration for the mark **LIFE ENHANCEMENT CENTER**, the Trademark Examining Attorney found acquired distinctiveness on the basis of Respondent’s Section 2(f) declaration of five years of “substantially exclusive and continuous use” immediately preceding the date of execution made with the application.

<sup>4</sup> Respondent incorrectly asserts in its main ACR Brief that Petitioner failed to plead this claim in the amended petition to cancel. Respondent’s ACR Brief, p. 11.

matter of law because the mark has been registered more than five years.” Answer ¶ 18.

I. *Accelerated Case Resolution (“ACR”)*

The parties stipulated to resolve this proceeding under the summary judgment model of the Board’s Accelerated Case Resolution (“ACR”) procedure. “Stipulated ACR Schedule and Request for Phone Conference” (TTABVUE Entry #10) (hereinafter referred to as “ACR Stipulation”). *See, e.g., Chanel Inc. v. Makarczyk*, 106 USPQ2d 1774, 1775 (TTAB 2013) (ACR stipulation approved by Board). *See also* Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) § 528.05(a)(2) (“*Accelerated Case Resolution*”) and § 702.04(b) (“*ACR using Summary Judgment Briefs*”) (2014). Under the ACR model selected by the parties, in lieu of separate assigned testimony and briefing periods, each party submitted a summary judgment style main brief and rebuttal brief with evidentiary submissions attached thereto, effectively merging the trial and briefing periods into a single phase. The parties also agreed to various efficiencies, including, for example, the presentation of direct testimony from witnesses by affidavit or declaration, with the adverse party or parties reserving the right to utilize live cross-examination through deposition testimony, and waiver of the right to submit expert testimony. ACR Stipulation ¶¶ 3 and 4.

There appears, however, to be some confusion regarding the nature of ACR on the part of Petitioner, and in particular the meaning of the following paragraph in the Parties’ ACR Stipulation:

5. The Parties hereby stipulate to utilize summary judgment format and that the Board will be able to resolve any genuine disputes of material fact that are presented by the record or which may be discovered by a panel of judges working on a final decision for this case.

(emphasis added). Petitioner contends that the highlighted language in ¶ 5 means that this designated panel of judges may conduct independent research outside of the record to further substantiate Petitioner's claim that Respondent's registered mark is generic. Petitioner's ACR Rebuttal Brief, p. 2. Petitioner's assertion reflects a misunderstanding of the ACR process. We interpret the highlighted phrase above as referring to any genuine disputes of material fact not identified by the parties but rather identified by the Board. This language does not mean that the panel of Board judges has the authority or obligation to engage in independent fact-finding outside of the record. Indeed, when read in conjunction with the remainder of the ACR Stipulation, it is clear that the evidentiary record is limited to the parties' submissions. *See* ACR Stipulation, ¶ 2. As plaintiff in this proceeding, Petitioner bears the burden of proving its standing and claims by a preponderance of the evidence, and election by the parties to utilize ACR does not alter this standard of proof, nor does it grant to the Board the authority to initiate its own factual investigation. *See* TBMP § 702.04(a) ("The standards of proof in an ACR proceeding are the same as the standards of proof in a traditional Board proceeding.") (citing *Dan Robbins & Associates, Inc. v. Questor Corp.*, 599 F.2d 1009, 202 USPQ 100, 105 (CCPA 1979)). The purpose of this paragraph is to make clear that, although the evidence and briefing follows a summary judgment format, the Board may resolve

genuine disputes of material fact, and it may do so whether one of the parties asserts such disputes or the Board determines on its own that there are any.

## II. *Evidentiary Objections*

Respondent objects to Petitioner's submission with its main ACR Brief of printouts from various official state government web sites (for example, the Arizona State Commission State of Arizona Public Access System, South Carolina Secretary of State "Corporate Search Results," and Secretary of State North Dakota "Business Records Search") on grounds of relevance, foundation, hearsay and authenticity. Petitioner's ACR Brief, Ex. E. The objection is overruled. Paragraph No. 2 of the parties' ACR Stipulation reads as follows:

The Parties agree that the affidavits and exhibits before the Board for purposes of the pending motion and cross-motion for summary judgment shall be the testimony and evidence of the parties for purposes of final hearing; that the briefs in support of and in opposition to the pending motion and cross-motion for summary judgment shall be deemed to be the briefs at final hearing pursuant to Trademark Rule 2.128 and that all office records, matters of public record, discovery deposition excerpts and the like incorporated in or annexed as exhibits to the briefs or affidavits shall be deemed to have been properly filed pursuant to notice of reliance pursuant to Trademark Rule 2.122(e).

(emphasis added). To the extent that Petitioner obtained this evidence from the public corporate name records from Internet web sites of the states of the United States, it falls within the category of "matters of public record" and is therefore admissible by the terms of the Parties' ACR Stipulation. For this reason, the printouts are deemed to be properly of record. As for Respondent's other objections to this evidence, these materials are admissible to show that the various

corporations have been incorporated under the listed corporate names, and trade names or “doing business as” names have been registered.

Respondent also objects on grounds of relevance, foundation and hearsay to Petitioner’s submission with its main ACR Brief of a *Wikipedia* entry regarding the Canadian Television version of the Oprah Winfrey Network using the term “life enhancement” in connection with television programming. Petitioner’s ACR Brief, Ex. F. More specifically, Respondent contends that because the entry relates to television programming in a foreign country with no evidence of exposure to the U.S. television audience, it has no bearing on Petitioner’s genericness claim as it applies to the U.S. public. All statements in the article describing the nature of the television programming on the Oprah Winfrey Network, whether in the United States or Canada, would be hearsay if used to prove what type of television programming takes place on the network. However, the article can be considered for the exposure of the article itself to readers in the United States, although the extent of such exposure is unknown and, therefore, the article has little probative value.

Lastly, Respondent objects to Petitioner’s discussion in its rebuttal brief of Google search engine results of “19 links ...of businesses using the term Life Enhancement who provide counseling, health and nutrition related type services” as failing to comply with the guidelines for submission of evidence obtained from the Internet as set forth in the case of *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031 (TTAB 2010). However, we need not even reach this objection because Petitioner did not submit the actual printouts from the Internet, but only links to

webpages. Because the webpages were not actually submitted, they are not before us and we can give them no consideration. *See* ACR Stipulation ¶ 2. Accordingly, we have not considered any of Petitioner’s arguments made in connection therewith.

### III. *The Record*

The record includes the pleadings,<sup>5</sup> and pursuant to Trademark Rule 2.122(b), Respondent’s registration file.

As per the Parties’ ACR stipulation, Petitioner filed a summary judgment styled ACR brief with the following evidence attached thereto: visitor guide entitled “This Week at Canyon Ranch: March 2-8, 2014” (Ex. A); search results from the Arizona Corporation Commission State of Arizona Public Access System for “Corporate Inquiry” of CR License, LLC (Ex. B); copies of assignment documents showing chain of title of the involved registration and USPTO Assignment Recordation Sheets, (Ex. C); Affidavit of Barbara A. Hosler, founder and owner of Center for Life Enhancement located in Monroe, Michigan (“Hosler Affidavit”); Affidavit of Lynn Denson, Chief Executive Officer of the Life Enhancement Center located in Riverside, California (“Denson Affidavit”); Affidavit of Russell C. Gaede and Jason H. King, Executive and Clinical Directors of Life Enhancement Center located in Utah (“Gaede and King Affidavit”) (Ex. D); search results for “Life Enhancement” from all 50 official state government Internet web sites of registered business or

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<sup>5</sup> The list of Respondent’s and third-party registrations obtained from the Trademark Electronic Search System (“TESS”) attached to Petitioner’s amended petition to cancel was not properly made of record. *See* ACR Stipulation ¶ 2. In Board *inter partes* proceedings, only a plaintiff’s pleaded registration can be made of record by attaching it to a complaint, and then only if it shows status and title. Trademark Rule 2.122(d). The Parties’ ACR Stipulation did not provide that exhibits attached to pleadings would be considered as part of the record.

trade names (Ex. E); entry for “Oprah Winfrey Network (Canadian TV channel)” from *Wikipedia* (Ex. F); and printout from the USPTO “Trademark Electronic Search System” (“TESS”) showing a list of applications and registrations owned by CR License LLC (Ex. G). Petitioner attached to its ACR Rebuttal Brief an advertisement for Canyon Ranch, Tucson entitled “Canyon Ranch. Power of Possibility.”

Respondent submitted a summary judgment styled ACR brief accompanied by the following affidavits with exhibits attached thereto: (1) Jerrold I. Cohen, President of JC Management (manager of CR License LLC d/b/a Canyon Ranch) (“Cohen Affidavit”); (2) Jim Eastburn, Director of the Life Enhancement Center at Canyon Ranch (“Eastburn Affidavit”); and (3) Erin Dougherty, Director of Marketing at Canyon Ranch (“Dougherty Affidavit”).

## VI. *Background*

The underlying application of the involved registration in this proceeding was filed by Canyon Ranch, Inc. The application and subsequently issued registration were assigned on three separate occasions “to new operating companies as part of corporate reorganizations...all part of the Canyon Ranch family of companies,” and each assignment was properly recorded with the Assignment Division of the USPTO. Cohen Affidavit ¶ 6, Ex. 6; Petitioner’s ACR Brief, Ex. C (USPTO Assignment Division Records). The first assignment took place on May 6, 1997, prior to issuance of the registration, from Canyon Ranch, Inc. to Cohen Enterprises, LLC and provided for the assignment of “all ... right, title and interest in and to the

tradenames, trademarks and copyrights described [therein] together with all of the goodwill arising out of or relating to such tradenames, trademarks and copyrights.” Cohen Affidavit ¶ 6, Ex. 6; Petitioner’s ACR Brief, Ex. C (“Assignment and Assumption of Tradenames, Trademarks and Copyrights” dated May 6, 1997.). The second assignment occurred on June 27, 1997, shortly after the mark was registered, from Cohen Enterprise, LLC to ZC Investments, LLC and provided for the sale, transfer, assignment and conveyance of all of Cohen Enterprises’ “right, title and interest in and to the tradenames, trademarks and copyrights” described [therein] “together with all of the goodwill arising out of or relating to such tradenames, trademarks and copyrights.” Cohen Affidavit ¶ 6, Ex. 6; Petitioner’s ACR Brief, Ex. C (“Assignment and Assumption of Tradenames, Trademarks and Copyrights” dated June 27, 1997.). Finally, on July 1, 2004, the mark was assigned from ZC Investments to the present owner CR License, LLC. Cohen Affidavit ¶ 6, Ex. 6; Petitioner’s ACR Brief, Ex. C (“U.S. Trademark Assignment” dated July 1, 2004.). This assignment document provides in relevant part:

WHEREAS, Assignee wishes to acquire whatever rights Assignor may possess in the trademarks listed below and the corresponding applications and registrations (the “Marks”),

NOW THEREFORE, for good and valuable consideration, the receipt of which is hereby acknowledged Assignor agrees to hereby irrevocably assigns to Assignee any and all right, title and interest in the Marks, together with any goodwill symbolized by the Marks and the corresponding trademark applications and registrations set forth [therein].

*Id.*

The Canyon Ranch health resort located in Tucson, Arizona is the entity which “sells, advertises and distributes goods and services bearing the Life Enhancement Center mark nationwide and worldwide.” Dougherty Affidavit ¶ 4, Ex. A. Canyon Ranch has advertised the registered mark in a “broad range of media, including brochures, newspapers, magazines, the internet and broadcast media.” *Id.* at ¶ 5, Ex. B. The “Life Enhancement Center” facility has continuously provided the services identified in the involved registration for “[o]ver the last 25 years” under the mark LIFE ENHANCEMENT CENTER from the Canyon Ranch health resort in Tucson. Cohen Affidavit ¶ 3. The present owner of the registered mark, CR License, uses the d/b/a designation “Canyon Ranch” when sending cease and desist letters policing third-party use of the mark. Cohen Affidavit ¶ 11, Ex. I.

#### V. *Standing*

Respondent’s admission “that it sent Petitioner a cease and desist letter” (Answer ¶ 15) in response to Petitioner’s allegation that it “has been threatened with legal action” by Respondent if it “does not cease and desist using its name ‘Life Enhancement Center’” (Amended Petition to Cancel ¶ 15), suffices to confer Petitioner standing to bring the instant cancellation proceeding. *See Ipco Corp. v. Blessings Corp.*, 5 USPQ2d 1974, 1976-77 (TTAB 1988) (cease and desist letter sent by applicant found sufficient to demonstrate opposer’s standing). *See generally Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999) (the threshold for determining standing is liberal, namely, whether a plaintiff’s belief in damage has a reasonable basis in fact and reflects a real interest in the case).

## VI. *Genericness Claim*

Turning now to the substantive matters before us, we first direct our attention to Petitioner's genericness claim. A mark is treated as generic if it refers to the class or category of goods and/or services on or in connection with which it is used. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001) (citing *Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986)). The test for determining whether a mark is generic is its "primary significance . . . to the relevant public." Section 14(3) of the Trademark Act, 15 U.S.C. § 1064(3) (emphasis added); *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991); *Marvin Ginn, supra*. It is Petitioner's burden to establish that the mark **LIFE ENHANCEMENT CENTER** is generic by a preponderance of the evidence. *Magic Wand Inc.*, 19 USPQ2d at 1554.<sup>6</sup>

To determine whether a mark is generic, first we determine the genus of the goods or services at issue; second, we determine whether the term sought to be registered would be understood by the relevant public primarily to refer to that genus of goods or services. *See Marvin Ginn, supra*.

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<sup>6</sup> Respondent, relying on an excerpt from 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 12:12 (4<sup>th</sup> ed. 2014), incorrectly argues that Petitioner is required to provide "persuasive and clear evidence" that Respondent's registered mark is generic. Respondent's ACR Brief, p. 1. This is not the standard of proof in a Board *inter partes* proceeding.

With regard to the first prong, although the registration is for services in Classes 35, 41 and 42, Petitioner pleaded genericness only as to a portion of the services, “counseling services” in Class 42 (Amended Petition to Cancel ¶ 17). In its brief Petitioner argued that the mark was generic for “counseling services or nutrition or yoga classes.” Petitioner’s ACR Brief, p. 4. Respondent maintains that Petitioner’s claim applies only to the services identified in International Class 42 based on Petitioner’s amended complaint and arguments presented in its ACR Brief, and does not apply to the services identified in International Class 41, which would include yoga classes. Respondent’s ACR Brief, p. 3 n.1. Since the operative complaint gave no notice to Respondent that its mark was being attacked as generic for any of the services identified in Class 41, we agree, and therefore limit our analysis to the services identified in Class 42, delineated as “medical, nutritional and therapeutic services and counseling on behavior modification and stress management; health resort and spa services.” We further find that the genus of services at issue in this case is adequately defined by the identification as set forth in relevant part in the registration. *See Magic Wand*, 19 USPQ2d at 1552 (“The Lanham Act permits cancellation when a ‘registered mark becomes the generic name for the goods or services...for which it is registered...’”) (quoting 15 U.S.C. § 1064(3)).

Our next task is to define the “relevant purchasing public.” Both Petitioner and Respondent refer to the general public or “general purchaser” as the relevant public. This categorization is overly broad. The “relevant purchasing public” means “the

relevant public which does or may purchase the goods or services in the marketplace.” *Magic Wand*, 19 USPQ2d at 1552-53. Therefore, we find the relevant public to be comprised of members of the general public who are consumers or prospective consumers of “medical, nutritional and therapeutic services and counseling on behavior modification and stress management; health resort and spa services.”

We further determine that the mark **LIFE ENHANCEMENT CENTER** is a phrase and should be analyzed according to the test set forth by the Court of Appeals for the Federal Circuit, our primary reviewing court, in *In re American Fertility Society*, *supra*, and further clarified in *In re Dial-A-Mattress Operating Corp.*, *supra*, 57 USPQ2d at 1810:

[W]here the proposed mark is a phrase (such as “Society for Reproductive Medicine”), the board “cannot simply cite definitions and generic uses of the constituent terms of a mark”; it must conduct an inquiry into “the meaning of the disputed phrase as a whole.” *In re The Am. Fertility Soc’y*, 188 F.3d at 1347, 51 USPQ2d at 1836.

Respondent’s disclaimer of the individual word **CENTER** in its Section 2(f) registration constitutes a tacit admission that this individual term is generic for the identified services. *See In re Creative Goldsmiths of Wash., Inc.*, 229 USPQ 766, 768 (TTAB 1986). Nonetheless, as explained above, the evidence must show that the registered mark **LIFE ENHANCEMENT CENTER** “as a whole” is generic.

Petitioner argues that the term “Life Enhancement” is a generic term when used alone or in combination with “center” or “program.” Competent sources to show the relevant purchasing public’s understanding of a contested term include purchaser

testimony, consumer surveys, dictionary definitions, trade journals, newspapers and other publications. *In re Dial-A-Mattress Operating Corp., supra; In re Bed & Breakfast Registry*, 791 F.2d 157, 160, 229 USPQ 818, 819 (Fed. Cir. 1986); *Magic Wand*, 19 USPQ2d at 1553. With the exception of a single entry from *Wikipedia*,<sup>7</sup> Petitioner did not submit any of the foregoing evidentiary materials.<sup>8</sup> Instead, Petitioner primarily relies on the following three affidavits from competitors in the industry, which state in relevant part:

**Hosler Affidavit:**

3. The name of my business is CENTER FOR LIFE ENHANCEMENT.

4. I chose to use the name “Life Enhancement” as a part of my business name because I believe the name is a general term used by many businesses who provide services such as counseling, education and so forth, the term is descriptive of a category of services used to improve or enhance one’s life.

**Denson Affidavit:**

3. Our business Life Enhancement Center has been in operation since approximately March of 2006.

5. We chose the term Life Enhancement Center because in our opinion, Life Enhancement is a descriptive and generic term signifying overall wellbeing, which can be accomplished through health services, counseling or perhaps nutrition.

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<sup>7</sup> The entry from *Wikipedia* for the Oprah Winfrey Network (Canadian Television) using the phrase “life enhancement” is not relevant to the extent that it does not include the entire mark at issue here.

<sup>8</sup> For example, Petitioner contends that Respondent’s mark is generic based on “dictionary meaning” (Petitioner’s ACR Brief, p. 4) but submits no dictionary definitions in support thereof. Similarly, Petitioner argues that “[t]he term life enhancement appears online in hundreds of web sites under google, yahoo or Bing type searches and describes generally a class of services” but has submitted no such printouts from the Internet. Petitioner’s ACR Brief, p. 6.

6. We believe Life Enhancement is a very common term to identify types of services.

**Gaede and King Affidavit:**

4. We chose to use the name Life Enhancement Center for our business because I believed that the term “Life Enhancement” is a type of generic, descriptive term symbolizing a category of services including counseling, mental health and overall wellbeing. In addition, we performed several searches online and found many other companies using the name for the same types of services in other States, with no registered trademarks.

Respondent argues that these affidavits carry “no evidentiary weight” because they are not from the consuming public and essentially constitute legal opinion testimony. We agree. None of the affiants states that he/she is a member of the relevant public or a consumer of the relevant services. Instead, each affiant discusses why he/she chose the phrase “life enhancement” or “life enhancement center” as the trade name for his/her business. Indeed, such statements call into question whether the affiants understand the legal concept of genericness. In addition, none of the affiants addresses the phrase “life enhancement center” in relation to Respondent’s identified services. As such, the affidavits are of minimal probative value for determining genericness of Respondent’s registered mark.

Petitioner also relies on evidence that the term “Life Enhancement” is used “in over 500 business names registered across 50 states” based on searches of the Internet websites of U.S. state agencies storing registered trade names. Petitioner’s ACR Brief, p. 6; Ex. E. Such evidence, however, merely shows that these businesses use the term “Life Enhancement” either alone or in combination with other terms to designate their business or trade names. It does not constitute evidence regarding

actual use of the phrase “life enhancement center” as a designation for the genus of the relevant services identified in Respondent’s registration. As such this evidence has limited probative value.

Petitioner also points to one of Respondent’s own advertisements purporting to show generic use of the phrase **LIFE ENHANCMENT CENTER**. Petitioner’s ACR Rebuttal Brief, Ex. A. An examination of the ad shows use of the mark to also identify the name of a building at the Canyon Ranch health resort in Tucson. This evidence by itself fails to show generic usage of Respondent’s mark.

Accordingly, based on the record before us, Petitioner falls short of demonstrating by a preponderance of the evidence that Respondent’s registered mark **LIFE ENHANCMENT CENTER** “as a whole” is generic for “medical, nutritional and therapeutic services and counseling on behavior modification and stress management; health resort and spa services.” *See In re Tennis Industry Ass’n*, 102 USPQ2d 1671, 1680 (TTAB 2012). The petition for cancellation on the claim of genericness is therefore dismissed.

VII. *Alternative Claim of Mere Descriptiveness and Lack of Acquired Distinctiveness*

In view of our dismissal of Petitioner’s genericness claim, we now turn to Petitioner’s claim in the alternative that Respondent’s registered mark is merely descriptive and lacks acquired distinctiveness under Section 2(f) as applied to “medical, nutritional and therapeutic services and counseling on behavior

modification and stress management; health resort and spa services” in International Class 42.<sup>9</sup>

As a threshold matter, we address Respondent’s affirmative defense that because its mark **LIFE ENHANCEMENT CENTER** has been registered for over five years, it cannot be challenged on a claim of mere descriptiveness and lack of acquired distinctiveness. Respondent is correct. As set forth in the provisions of Section 14 of the Trademark Act, once a registration is more than five years old, the grounds on which it may be cancelled are limited, and they do not include the ground of mere descriptiveness.<sup>10</sup> In this instance, the involved mark was registered on June 3, 1997, but the petition to cancel was filed nearly sixteen years later on April 27, 2013.

Thus, as a matter of law, Petitioner’s claim that Respondent’s mark is merely descriptive and lacks acquired distinctiveness is time-barred under Section 14(3). Judgment is granted in Respondent’s favor on its affirmative defense and Petitioner’s claim is dismissed.

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<sup>9</sup> Petitioner did not present arguments in support of its claim of descriptiveness and lack of acquired distinctiveness in its main ACR Brief. Nonetheless, we have considered this claim in our decision because it was discussed by Respondent in its main ACR Brief as well as by both parties in their respective ACR Rebuttal Briefs.

<sup>10</sup> A petition to cancel a registration issued on the Principal Register under the Act of 1946, on a ground not specified in Trademark Act § 14(3) or Trademark Act § 14(5), 15 U.S.C. § 1064(3) or 15 U.S.C. § 1064(5), must be filed within five years from the date of the registration of the mark. The grounds for cancellation which are thus available in the case of a petition filed within the five-year period, but not thereafter, include all of the grounds specified in Trademark Act § 2(e), 15 U.S.C. § 1052(e), including a claim that respondent’s mark is merely descriptive or deceptively misdescriptive, Section 2(e)(1), 15 U.S.C. § 1052(e)(1).

VIII. *Petitioner's Claim of Invalid Assignment*

Lastly, we consider Petitioner's claim that Respondent has lost any protection it may have had in the registered service mark **LIFE ENHANCEMENT CENTER** through improper assignment of the registration.

Petitioner's claim of invalid assignment is based on the following allegations:

1. Registration number 2066095 is an improperly registered and invalid trademark and should not receive protection.
2. The name "Life Enhancement Center", registration number 2066095 was first registered by Can[y]on Ranch, Inc.
3. Canyon Ranch is a chain of hotels and spas having locations in two or three states including Arizona, Nevada and Michigan.
4. Canyon Ranch provides hotel and spa services offering a variety of services which include programs designed for health, wellness and nutrition.
5. Canyon Ranch has a program called "Life Enhancement Program" (See web link....)
6. Canyon Ranch has a "Life Enhancement Center" that conducts the "Life Enhancement Program" [that] provides services such as health food, counseling and fitness.
14. Defendant has lost any protection he may have had, of the name "Life Enhancement Center" through improper assignment. The trademark "Life Enhancement Center" has been assigned numerous times and the new owners have not or do not themselves provide any products or services that bear the name "Life Enhancement" or "Life Enhancement Center." The owner of Life Enhancement Center appears to be a company by the name of Canyon Ranch. ...

Amended Petition to Cancel ¶ 14. Respondent answered these allegations as follows:

1. Respondent denies the allegations in Paragraph 1.

2. Respondent admits that the trademark LIFE ENHANCMENT CENTER, Reg. No. 2,066,095, was registered by Canyon Ranch, Inc.
3. Respondent admits that its related company licensees operate a number of health resorts, luxury spas, hotels and communities in a number of states, including Arizona and Nevada. Respondent denies the remaining allegations in Paragraph 3.
4. Respondent admits that its related company licensees provide hotel and spa services, which include programs designed for health, wellness and nutrition. Respondent denies the remaining allegations in Paragraph 4.
5. Respondent admits that its related company licensees provide a program called LIFE ENHANCEMENT PROGRAM.<sup>®</sup> Respondent admits that the website <http://www.canyonranch.com/tucson/health-wellness/life-enhancement-program> contains information about this program. Respondent denies the remaining allegations in Paragraph 5.
6. Respondent admits its related licensees offer a variety of programs, including the LIFE ENHANCMENT PROGRAM<sup>®</sup> that focus on health, nutrition, counseling and fitness under the LIFE ENHANCMENT CENTER<sup>®</sup> brand. Respondent denies the remaining allegations in Paragraph 6.
- ...
14. Respondent admits that the trademark LIFE ENHANCEMENT CENTER has been assigned three times, with the last assignment of the mark being to Respondent. Respondent denies the remaining allegations in Paragraph 14.

Petitioner argues that the mark has been assigned “numerous times along with 30 other trademarks” and that the current owner, CR License LLC, does not “physically own or operate or provide any of the services” identified in the involved registration. Petitioner’s ACR Brief, p. 7. Rather, Petitioner contends that the designation “Life Enhancement Center” merely refers to a building located on the Canyon Ranch complex where the “Life Enhancement Program” takes place. Petitioner’s ACR Brief, p. 3, Ex. 8 (Map of Canyon Ranch Tucson, Arizona health

resort). Petitioner further contends that not all of the services identified in the registration are offered from the Life Enhancement Center building. In addition, Petitioner, relying on the Board's decision in *Central Garden & Pet Co. v. Doskocil Manufacturing Co.*, 108 USPQ 1134 (TTAB 2013), asserts that the only evidence of transfer of ownership from the original owner Canyon Ranch Inc. is the transfer of the mark and the "goodwill' of the business connected with the mark" and that the "services, goods and facilities were not transferred to any of the five various assignees over the past 15 years." *Id.*

At the outset we point out that Petitioner's reliance on *Central Garden & Pet Co. v. Doskocil Manufacturing Co.*, *supra*, for its claim of invalid assignment of the mark is misplaced. That case involved the prohibition under Trademark Act Section 10(a)(1) of the assignment of a Section 1(b) application prior to the filing of an allegation of use, unless the assignment is "to a successor to the business of the applicant, or portion thereof, to which the mark pertains." In an application under § 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), the applicant cannot assign the application before the applicant files an allegation of use (i.e., either an amendment to allege use under 15 U.S.C. § 1051(c) or a statement of use under 15 U.S.C. § 1051(d)), except to a successor to the applicant's business, or portion of the business to which the mark pertains, if that business is ongoing and existing. Section 10 of the Trademark Act, 15 U.S.C. § 1060; 37 C.F.R. § 3.16. Such is not the case here where the underlying application which matured into the subject registration was not filed as an intent-to-use application under Section 1(b) but

rather as a use-based application under Section 1(a), and therefore could be assigned prior to a registration issuing.

As to the remainder of Petitioner's arguments, the precise nature of Petitioner's invalid assignment claim is unclear. It appears that Petitioner may be arguing that Respondent, CR License, LLC, the record owner of the registration, is not using the mark itself, and that, because Canyon Ranch is using it, Canyon Ranch is the true owner of the mark. We agree that the mark is currently being used by Canyon Ranch, Inc. However, that does not affect Respondent's ownership rights, since Canyon Ranch Inc. is a related company of the present owner CR License. CR License's Combined Declaration of Use and Renewal states in relevant part that "the owner is using or is using through a related company or licensee the mark in commerce on or in connection with all goods and/or services listed in the existing registration." This is corroborated by the affidavits presented by Respondent. The use of a registered mark by a related company is a permissible way of maintaining trademark rights. *See* Section 45 of the Trademark Act, 15 U.S.C. § 1127 ("The term 'related company' means any person whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which the mark is used); and Section 5 of the Trademark Act, 15 U.S.C. § 1055 ("Where a registered mark or a mark sought to be registered is or may be used legitimately by related companies, such use shall inure to the benefit of the registrant or applicant for registration, and such use shall not affect the validity of such mark or of its registration, provided such mark is not used in such

manner as to deceive the public.”). Petitioner points out that Respondent did not introduce into the record an operating contract or agreement. However, this is unnecessary in light of Respondent’s statement that CR License falls under the same corporate umbrella as Canyon Ranch, Inc., coupled with statements in the Combined Declaration of Use and Renewal that CR License is using the mark through a related company or licensee. *See* Cohen Affidavit ¶ 6. The fact that the present owner of the registration is a related company which does not physically operate or provide any of the identified services does not impinge on the validity of the registration. There is also evidence that CR License has been actively monitoring and policing uncontrolled third-party use of the mark through cease and desist letters, demonstrating that Canyon Ranch Inc.’s use of the mark **LIFE ENHANCEMENT CENTER** inures to CR License’s benefit. Cohen Affidavit ¶ 11, Ex. I.

Accordingly, Petitioner’s claim of invalid assignment is dismissed as well.

**DECISION:** The petition for cancellation is dismissed.

# **EXHIBIT C**

ESTTA Tracking number: **ESTTA383346**

Filing date: **12/13/2010**

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

Proceeding	91182207
Party	Defendant Obschestvo s Oranitchenny; Otvetstvenn Ostiu "Wds"
Correspondence Address	ERIK M PELTON ERIK M PELTON & ASSOCIATES PLLC PO BOX 100637 ARLINGTON, VA 22210 UNITED STATES dctrademarks@dbr.com, jaye.campbell@dbr.com
Submission	Answer and Counterclaim
Filer's Name	Erik M. Pelton
Filer's e-mail	uspto@tm4smallbiz.com
Signature	/ErikMPelton/
Date	12/13/2010
Attachments	ROCS - 2nd Amended Answer and Counterclaim - Final.pdf ( 13 pages ) (415304 bytes )

Registration Subject to the filing

Registration No	1015041	Registration date	07/08/1975
International Registration No.	NONE	International Registration Date	NONE
Registrant	ROC INTERNATIONAL 5 RUE C.M. SPOO LUXEMBURG, LUXEMBOURG		
Grounds for filing	The registered mark has been abandoned.		

Goods/Services Subject to the filing

Class 003. Requested goods and services in the class: LIQUID FOUNDATION, SKIN POWDER, ROUGE
--

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

Johnson & Johnson and Roc International  
S.A.R.L.  
Opposer / Cross-Respondent

Opposition Nos. 91182207 (Parent)  
91184467

v.

Mark:

Obschestvo s ogranichennoy; otvetstvenn  
ostiu "WDS",  
Applicant / Cross-Petitioner



**SECOND AMENDED ANSWER AND COUNTERCLAIM**

The following is the Second Amended Answer and Counterclaim of Applicant / Cross-Petitioner ("Applicant"), owner of Federal Trademark Application Serial No. 79032764 for the mark R.O.C.S. REMINERALIZING ORAL CARE SYSTEMS MINERAL PROTECTION TOTAL CARE & Design depicted below and Serial No. 79032762 for the mark R.O.C.S. REMINERALIZING ORAL CARE SYSTEMS & Design depicted below, (collectively "Applicant's Design Marks"), to the Notices of Opposition filed by JOHNSON & JOHNSON and ROC INTERNATIONAL S.A.R.L. (hereinafter "Opposers"), and assigned Opposition Nos. 91184467 and 91182207 (Parent).

<i>Applicant's Serial No. 79032762</i>	<i>Applicant's Serial No. 79032764</i>
<p>The logo for R.O.C.S. REMINERALIZING ORAL CARE SYSTEMS, featuring the letters 'R.O.C.S.' in a blue, mosaic-like font and the words 'REMINERALIZING ORAL CARE SYSTEMS' below in a smaller, blue, sans-serif font.</p>	<p>The logo for R.O.C.S. REMINERALIZING ORAL CARE SYSTEMS MINERAL PROTECTION TOTAL CARE. The letters 'R.O.C.S.' are in a multi-colored, mosaic-like font. Below the letters, the words 'REMINERALIZING ORAL CARE SYSTEMS' are in a smaller, multi-colored, sans-serif font, and 'MINERAL PROTECTION TOTAL CARE' is in a black, sans-serif font.</p>

Applicant hereby amends its answers in the April 28, 2008 Amended Answer to Notice of Opposition (in "parent" proceeding No. 91182207) as follows:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in paragraph 1 of the Notice of Opposition. Since Applicant can neither admit nor deny the paragraph as written, Applicant must deny.

2. Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in paragraph 2 of the Notice of Opposition. Since Applicant can neither admit nor deny the paragraph as written, Applicant must deny.

3. Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in paragraph 3 of the Notice of Opposition. Since Applicant can neither admit nor deny the paragraph as written, Applicant must deny.

4. Paragraph 4 is missing from the Notice of Opposition.

5. Denied.

6. Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in paragraph 6 of the Notice of Opposition. Since Applicant can neither admit nor deny the paragraph as written, Applicant must deny.

7. Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in paragraph 7 of the Notice of Opposition. Since Applicant can neither admit nor deny the paragraph as written, Applicant must deny.

8. Denied.

9. Admitted.

10. Admitted.

11. Denied.

12. Denied.

13. Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in paragraph 13 of the Notice of Opposition. Since Applicant can neither admit nor deny the paragraph as written, Applicant must deny.

14. Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in paragraph 14 of the Notice of Opposition. Since Applicant can neither admit nor deny the paragraph as written, Applicant must deny.

15. Denied.

16. Denied.

FURTHERMORE, Applicant sets forth the following in support of its defense:

17. Upon information and belief, Opposers' marks are not famous.

18. Upon information and belief, users of Applicant's goods are sophisticated purchasers.

19. Upon information and belief, purchasers and users of Opposers' goods are sophisticated purchasers.

20. Applicant's Design Marks are unique and distinctive.

21. Applicant's Design Marks and Opposers' mark are different in meaning.

22. Applicant's Design Marks and Opposers' mark are different in appearance.

23. Applicant's Design Marks and Opposers' mark are different in spelling.

24. Applicant's Design Marks and Opposers' mark have very different commercial impressions.

25. Applicant's Design Marks and Opposers' mark are not likely to cause confusion, mistake or deception among purchasers as to the source of Opposers' goods.

26. Applicant's Design Marks do not and cannot dilute Opposers' mark.

27. Applicant's Design Marks does not falsely suggest a connection with Opposers' mark.
28. Opposers' claims are barred by the doctrine of unclean hands or other applicable equitable principles.
29. Opposers have failed to adequately maintain, police, or enforce any trademark or proprietary rights it may have in its alleged trademarks.
30. Upon information and belief, Opposers do not use their mark on all the goods cited in Registration No. 1015041.
31. Upon information and belief, Opposers have partially abandoned the mark in Registration No. 1015041.

**Applicant's Counterclaim For Cancellation of Opposer  
Roc International's Registration No. 1015041**

Applicant hereby seeks partial cancellation of Opposer Roc International's Registration No. 1015041 due to abandonment. As grounds for the Counterclaim, pursuant to Trademark Act § 18, 15 U.S.C. § 1068 and TBMP §§ 309.03(d), 313.01, it is alleged that:

32. Applicant has standing to bring this counterclaim as a result of the Oppositions filed by Opposers, Opposition Nos. 91182207 (parent) and 9184467, in which Opposers pleaded ownership of the registration at issue, Registration No. 1015041 and alleged a likelihood of confusion with the marks in Application Serial Nos. 79032762 and 79032764.
33. Pursuant to the assignment records of the U.S. Patent and Trademark Office, Opposer Roc International is the owner of Registration No. 1015041. See Exhibit A.
34. Registration No. 1015041 was issued by the U.S. Patent and Trademark Office on July 8, 1975 for the design depicted below and currently covers "COSMETIC AND SKIN PREPARATIONS-NAMELY, EYE MAKE-UP, LIQUID FOUNDATION, SKIN POWDER,

ROUGE, SUN-TAN CREAM, MOISTURIZING CREAM, CLEANSING CREAMS, SKIN CREAMS, SKIN LOTIONS, AND FACIAL SOAP”. See Exhibit A.

35. The design mark in Registration No. 1015041 is:



. See Exhibit A.

36. Applicant attaches as Exhibit A the June 25, 1996 amended registration certificate, TARR printout, and Assignment records printout for Registration No. 1015041.

37. Upon information and belief, Opposers are not using the mark in pleaded Registration No. 1015041 in connection with “skin powder”.

38. Upon information and belief, Opposers have no intention to resume use of the mark in pleaded Registration No. 1015041 in connection with “skin powder”.

39. Upon information and belief, Opposers have abandoned the mark in pleaded Registration No. 1015041 in connection with “skin powder”.

40. Upon information and belief, Opposers are not using the mark in pleaded Registration No. 1015041 in connection with “rouge”.

41. Upon information and belief, Opposers have no intention to resume use of the mark in pleaded Registration No. 1015041 in connection with “rouge”.

42. Upon information and belief, Opposers have abandoned the mark in pleaded Registration No. 1015041 in connection with “rouge”.

43. Upon information and belief, Opposers are not using the mark in pleaded Registration No. 1015041 in connection with “liquid foundation”.

44. Upon information and belief, Opposers have no intention to resume use of the mark in pleaded Registration No. 1015041 in connection with “liquid foundation”.

45. Upon information and belief, Opposers have abandoned the mark in pleaded Registration No. 1015041 in connection with “liquid foundation”.

WHEREFORE, Applicant prays that the Trademark Trial and Appeal Board deny the Opposition, grant the partial cancellations requested, and permit registration of Applicant’s proposed marks in Application Serial Numbers 79032764 and 79032762 in the United States Patent and Trademark Office.

Dated this 13th day of December, 2010.



---

Erik M. Pelton  
ERIK M. PELTON & ASSOCIATES, PLLC  
PO Box 100637  
Arlington, Virginia 22210  
TEL: (703) 525-8009  
FAX: (703) 525-8089

Attorney for Applicant / Cross-Petitioner

Enclosure:

EXHIBIT A - registration certificate, TARR printout, and Assignment records printout for Registration No. 1015041

**CERTIFICATE OF SERVICE**

I hereby certify that a true and accurate copy of SECOND AMENDED ANSWER AND COUNTERCLAIM has been served on the following by delivering said copy on December 13, 2010, via First Class mail, to counsel for Opposer at the following address:

BRIAN A COLEMAN  
DRINKER BIDDLE & REATH LLP  
1500 K STREET NW, SUITE 1100  
WASHINGTON, DC 20005-1209

By:  \_\_\_\_\_  
Erik M. Pelton, Esq.

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

Johnson & Johnson and Roc International  
S.A.R.L.  
Opposer / Cross-Respondent

v.

Obschestvo s ogranichennoy; otvetstvenn  
ostiu "WDS",  
Applicant / Cross-Petitioner

Opposition Nos. 91182207 (Parent)  
91184467

Mark:



**AMENDED ANSWER AND COUNTERCLAIM**

**EXHIBIT A**

Int. Cl.: 3

Prior U.S. Cls.: 1, 4, 6, 50, 51 and 52

United States Patent and Trademark Office  
Amended

Reg. No. 1,015,041  
Registered July 8, 1975  
OG Date June 25, 1996

TRADEMARK  
PRINCIPAL REGISTER



ROC INTERNATIONAL (LUXEMBOURG LIMITED COMPANY),  
5 RUE C.M. SPOO  
LUXEMBURG, LUXEMBOURG, BY  
ASSIGNMENT AND CHANGE OF  
NAME FROM ROC S.A. (FRANCE COR-  
PORATION) COLOMBES (HAUTS-DE-  
SEINE), FRANCE

OWNER OF FRANCE REG. NO. 534969,  
DATED 7-9-1965.

THE WORD "ROC" IS A FRENCH  
WORD MEANING "ROCK" AND ALSO  
MEANS "ROOK" OR "CASTLE" IN  
CHESS.

FOR: COSMETIC AND SKIN PREP-  
ARATIONS—NAMELY, EYE MAKE-UP,  
[EYEBROW PENCILS, LIPSTICKS,]  
LIQUID FOUNDATION, SKIN POWDER,  
ROUGE, SUN-TAN CREAM, MOISTUR-  
IZING CREAM, CLEANSING CREAMS,  
SKIN CREAMS, SKIN LOTIONS, [NAIL  
POLISH, NAIL POLISH REMOVER,  
HAIR SHAMPOOS] AND FACIAL SOAP.  
IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND  
52).

SER. NO. 73-016,590, FILED 3-21-1974.

*In testimony whereof I have hereunto set my hand  
and caused the seal of The Patent and Trademark  
Office to be affixed on June 25, 1996.*

COMMISSIONER OF PATENTS AND TRADEMARKS

Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2010-12-13 11:11:10 ET

Serial Number: 73016590 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 1015041

Mark



(words only): [ROC](#)

Standard Character claim: [No](#)

Current Status: [This registration has been renewed.](#)

Date of Status: [2005-07-13](#)

Filing Date: [1974-03-21](#)

Transformed into a National Application: [No](#)

Registration Date: [1975-07-08](#)

Register: [Principal](#)

Law Office Assigned: (NOT AVAILABLE)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)

Current Location: [830 -Post Registration](#)

Date In Location: [2005-07-13](#)

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**LAST APPLICANT(S)/OWNER(S) OF RECORD**

---

1. [ROC INTERNATIONAL](#)

Address:

[ROC INTERNATIONAL](#)

5 RUE C.M. SPOO

LUXEMBURG

Luxembourg

**Legal Entity Type:** LIMITED COMPANY

**State or Country Where Organized:** Luxembourg

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### GOODS AND/OR SERVICES

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**International Class:** 003

**Class Status:** Active

COSMETIC AND SKIN PREPARATIONS-NAMELY, EYE MAKE-UP, LIQUID FOUNDATION, SKIN POWDER, ROUGE, SUN-TAN CREAM, MOISTURIZING CREAM, CLEANSING CREAMS, SKIN CREAMS, SKIN LOTIONS, AND FACIAL SOAP

**Basis:** 44(e)

**First Use Date:** (DATE NOT AVAILABLE)

**First Use in Commerce Date:** (DATE NOT AVAILABLE)

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### ADDITIONAL INFORMATION

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**Translation:** THE WORD "ROC" IS A FRENCH WORD MEANING "ROCK" AND ALSO MEANS "ROOK" OR "CASTLE" IN CHESS.

**Design Search Code(s):**

19.13.01 - Mortars and pestles

**Foreign Registration Number:** 534969

**Foreign Registration Date:** 1965-07-09

**Country:** France

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### MADRID PROTOCOL INFORMATION

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(NOT AVAILABLE)

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### PROSECUTION HISTORY

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**NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.**

2006-09-09 - Review Of Correspondence Complete

2006-08-21 - PAPER RECEIVED

2005-07-13 - Second renewal 10 year

2005-07-13 - Section 8 (10-year) accepted/ Section 9 granted

2005-07-13 - Assigned To Paralegal

2005-05-16 - Combined Section 8 (10-year)/Section 9 filed

2005-05-16 - TEAS Section 8 & 9 Received

1996-05-11 - Section 7 amendment issued

1996-02-28 - Response received for Post Registration action

1995-11-28 - Post Registration action mailed - Section 7

1995-07-03 - First renewal 10 year

1995-05-05 - Section 7 amendment filed

1995-05-05 - Section 9 filed/check record for Section 8

1981-01-13 - Section 8 (6-year) accepted

---

**ATTORNEY/CORRESPONDENT INFORMATION**

---

**Attorney of Record**

LAWRENCE E. ABELMAN

**Correspondent**

LAWRENCE E. ABELMAN  
ABELMAN, FRAYNE & SCHWAB  
666 THIRD AVE  
NEW YORK, NY 10017-5621

**Domestic Representative**

ABELMAN, FRAYNE & SCHWAB

---

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LUXEMBOURG, NONE**Correspondent:** MASON, FENWICK & LAWRENCE  
SUITE 310  
OFC BLDG.  
1730 RHODE ISLAND AVE., N.W.  
WASHINGTON, DC 20036**Assignment: 2****Reel/Frame:** [0345/0276](#)**Received:****Recorded:** 03/29/1979**Pages:** 4**Conveyance:** CHANGE OF NAME**Assignor:** [ERDI-SOCIETE ANONYME](#)**Exec Dt:** 09/20/1978**Entity Type:** UNKNOWN**Citizenship:** NONE**Entity Type:** UNKNOWN**Citizenship:** NONE**Assignee:** [ROC INTERNATIONAL](#)**Correspondent:** MASON, FENWICK, ET AL.  
1730 RHODE ISLAND AVE., N.W.  
WASHINGTON, DC 20036

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Web interface last modified: Apr 30, 2009 v.2.1[.HOME](#) | [INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [CONTACT US](#) | [PRIVACY STATEMENT](#)

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

_____ )	Cancellation No.: 92062880
POULSEN ROSER A/S, )	Registration No. 1980921
)	
Petitioner, )	Mark: PARAMOUNT
vs. )	
)	<b>PROOF OF SERVICE</b>
PARAMOUNT BRAND ROSES, INC., )	
)	
Respondent. )	
_____ )	

NICOLE G. MCDONOUGH, Esq. being of full age, hereby deposes and says:

1. I am an attorney with the law firm Cole Schotz P.C. attorneys for Respondent, Paramount Brand Roses, Inc. (“Respondent”), in the above-captioned matter. I am over the age of eighteen (18) years and not a party to this action.

2. On the 17<sup>th</sup> day of March 2016, this office filed and served a copy of the following document(s) on behalf of the Respondent:

(a) Reply Brief in Further Support of Motion to Dismiss Petition for Cancellation with accompanying Exhibits A through C;

In the following manner:

Via the ESTTA electronic filing system with the Trademark Trial and Appeal Board, Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

Via E-mail and Federal Express overnight delivery upon the following:

James J. Saul, Esq.  
FAEGRE BAKER DANIELS LLP  
311 S. Wacker Drive  
Suite 4300  
Chicago, IL 60606  
James.Saul@FaegreBD.com  
*Attorneys for Petitioner*

I hereby certify that the foregoing statements made by me are true. I am aware that if any of the foregoing statements made by me are willfully false, I am subject to punishment.

By:     /s/ Nicole G. McDonough      
Nicole G. McDonough

Dated: March 17, 2016