

TAB

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

PRAMIL S.R.L. (ESAPHARMA))
)
 Petitioner,)
)
 v.)
)
 MITCHELL COSMETICS SARL,)
)
 Applicant.)

Opposition No. 122,317
Mark: REGGE LEMON



03-20-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #77

**APPLICANT MITCHELL COSMETICS SARL's MOTION TO STRIKE
TESTIMONY AND EVIDENCE OF PETITIONER**

Applicant Mitchell Cosmetics SARL moves the Board to strike certain testimony and evidence submitted by the Petitioner, on the ground that the evidence was not properly made of record because Petitioner failed to produce the evidence in discovery, and on the ground of hearsay.

Specifically, Applicant moves to strike the following exhibits proffered by Petitioner, and all related testimony:

Exhibit 4, Trial Testimony of Jacob Aini, page 16 (Objection noted at p. 18 of transcript).

Exhibit 5, Trial Testimony of Jacob Aini, page 21 (Objection noted at p. 22); Trial Testimony of Michael Aini, page 11 (Objection noted at p. 12).

Exhibit 6, Trial Testimony of Jacob Aini, page 24 (Objection noted at p. 24).

Exhibit 7, Trial Testimony of Jacob Aini, page 27 (Objection noted at p. 29).

Exhibit 10, Trial Testimony of Jacob Aini, page 42 (Objection noted at p. 43).

Exhibit 11, Trial Testimony of Jacob Aini, page 45 (Objection noted at p. 47).

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TRADEMARK TRIAL AND APPEAL BOARD

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Exhibit 12, Trial Testimony of Michael Aini, pages 14-15 (Objection noted at pages 15-16).

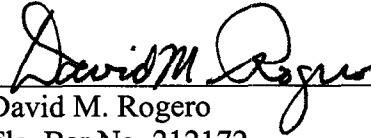
Exhibit 13, Trial Testimony of Michael Aini, page 16 (Objection noted at pages 16-17).

In each instance, Petitioner attempts to rely on these documents, even though they were not produced to the Applicant in discovery. In two instances, regarding Exhibits 7 and 11, the Petitioner admits on the record that the documents were not produced. (Trial Testimony of Jacob Aini, pages 30-31, 45-46).

Use of these documents, and the testimony surrounding them, violates the Applicant's rights and should be stricken from the record and disregarded by the Board. *Weiner King, Inc. v. Wiener King Corp.*, 615 F.2d 512, 521-22 (C.C.P.A. 1980); *Panelfold, Inc. v. ChemRex Inc.*, 2002 TTAB LEXIS 452, *10-11 (2002) ("It is unfair and prejudicial to opposer for applicant to assert such matters for the first time during applicant's testimony period."); *see also* TBMP 527.05.

In addition, Applicant moves to strike Exhibit 10 and certain portions of Petitioner's proffered testimony as inadmissible hearsay. In the Trail Testimony of Jacob Aini, pages 16-17, the witness testifies as to statements attributed to another. Applicant's counsel asserted objection (at page 17), and the testimony should be stricken. Further, the self-serving document identified as Opposer's Exhibit 10 is clearly hearsay and should be disregarded. *See* Federal Rule of Evidence 802, 37 C.F.R. § 2.122(a).

Respectfully submitted,



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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Applicant Mitchell Cosmetics SARL's Motion to Strike Testimony and Evidence of Petitioner was sent by first class mail with proper postage affixed, the 20th day of March, 2003, to the following:

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David M. Rogero

CERTIFICATE OF MAILING BY "EXPRESS MAIL"

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service in an envelope addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on March 20, 2003.

"Express Mail" mailing label number 948 348 681


David M. Rogero

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Opposition No. 122,317
Mark: REGGE LEMON



03-20-2003
U.S. Patent & TMO/c/TM Mail Rcpt Dt. #7

BRIEF OF APPLICANT, MITCHELL COSMETICS SARL

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DESCRIPTION OF RECORD

The Opposer, Pramil S.R.L., has submitted as evidence the trial transcripts of the depositions of Jacob Aini and Michael Aini, officers of I.C.E. Marketing, and, through the testimony of these witnesses, documents that have been marked as Opposer's Exhibits 1 through 15. Eight of the exhibits and portions of the testimony are the subject of a motion to strike.

Through the inaction of Opposer's prior counsel, which is the subject of a pending motion to reopen the testimony period, the Opposer has not presented trial testimony or evidence.

STATEMENT OF ISSUE

Whether Opposer has met its burden of proof to support its claim of priority.

RECITATION OF FACTS

Applicant seeks registration pursuant to 15 U.S.C. § 1126(e), based upon a registration of the mark in Switzerland with an effective date of December 7, 1998. Opposer apparently claims priority, based upon testimony of its witnesses about a "test program" in the mid-1980's, and the receipt of shipments of goods from various sources in Europe in 1997. The admissible evidence submitted by the Opposer, however, does not support Opposer's use of the mark in commerce prior to December 7, 1998.

ARGUMENT

Opposer has failed to meet its burden of proof to support its claim of priority.

Because the Opposer does not claim a registration of the mark in question, it can only assert a priority date based upon its first use in commerce. *Lucent Information Management, Inc. v. Lucent Technologies, Inc.*, 186 F.3d 311, 315 (3rd Cir. 1999). Section 7(c) of the Lanham Act states that “the filing of an application to register [a mark] shall . . . confer[] a right of priority, nationwide in effect, . . . against any other person except for a person . . . who, prior to such filing, has used the mark” 15 U.S.C. § 1057(c). Consequently, Opposer must establish rights in the mark REGGE LEMON by its prior “use [of the mark] in commerce”—“use” being defined as “the bona fide use of a mark in the ordinary course of trade. . . .” 15 U.S.C. § 1127. *Id.*¹

“In Board proceedings, the plaintiff must establish its pleaded case, as well as its standing, and must generally do so by a preponderance of the evidence. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000); *Martahus v. Video*

¹ TMEP 901.02 states in part:

The definition of use in commerce (TMEP §901.01) was amended by the Trademark Law Revision Act of 1988 (TLRA), Public Law 100-667, 102 Stat. 3935, to add the phrase “the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark.” The primary purpose of the amendment was to eliminate the practice of “token use,” or use made solely to reserve rights in a mark.

Some factors that may be important in determining compliance with the statutory requirement for a “bona fide use of a mark in the ordinary course of trade” are: (1) the amount of use; (2) the nature or quality of the transaction; and (3) what is typical use within a particular industry.

The legislative history of the TLRA makes it clear that the meaning of “use in the ordinary course of trade” will vary from one industry to another.

Duplication Services Inc., 3 F.3d 417, 27 USPQ2d 1846, 1850 (Fed. Cir. 1993); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1554 (Fed. Cir. 1991); and *Cerveceria Centroamericana, S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989).” *S Industries, Inc., v. Casablanca Industries, Inc.*, 2002 TTAB LEXIS 644 (2002).

The evidence presented by the Opposer in this matter falls short of proof of priority by a preponderance of evidence.

Jacob Aini, who describes his business, I.C.E. Marketing, as a distributor for Pramil S.R.L., first testifies that in 1983, he thought of using the word “reggae” in products sold to Jamaican clients. J. Aini, pp. 11-14. Without testimony of any particular product distributed at that time, bearing the mark REGGE LEMON, this testimony does not establish a use in commerce.

Mr. Aini then offers that in 1984, as part of a “Plan Test Program,” his company, and not the Opposer, distributed products bearing the mark REGGE LEMON to customers of “our stores.” Mr. Aini testifies that this project was “shelved.” J. Aini, pp. 14-15, 25-26. Without testimony supporting continued use of such a mark, or use by the Opposer, this testimony does not establish a use in commerce.

Mr. Aini also testifies about a transaction in April 1997 in which his company received a shipment of products described as Regge Lemon gel from the Opposer. J. Aini pp. 27-29, Exhibit 7. This exhibit and the attendant testimony is the subject of a motion to strike, and should be disregarded. In addition, there is no testimony from Mr. Aini about any distribution of the goods contained in this particular shipment, and no evidence to establish “the bona fide use of a mark in the ordinary course of trade. . . .” by the Opposer at the time of this shipment.

In his testimony, Michael Aini also refers to the importation of Regge Lemon products “[i]n ’97,” and discusses how I.C.E. currently distributes these products. M. Aini, p. 10. Michael Aini then testifies about several transactions involving Regge Lemon products, all occurring after December 7, 1998, the priority date of the Applicant. M. Aini, pp. 14-21, Exhibits 12-15. In sum, Michael Aini’s testimony does nothing to establish use in commerce by Pramil S.R.L. prior to Applicant’s priority date.

The sum of Opposer’s evidence as to its prior use in commerce, then, consists of the reference to one shipment of goods in April 1997, and that evidence is the subject of a motion to strike as inadmissible. “Because petitioner bears the burden of proof, it is axiomatic that without admissible evidence, it cannot prevail.” *Boyd’s Collection, Ltd v. Herrington & Company*, 2003 TTAB LEXIS 11 (2003).

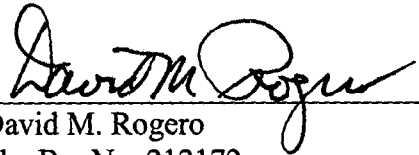
It is curious that the Opposer could not produce the evidence of its one and only claimed prior use of the mark during the discovery period, that it could not produce or offer any other evidence of prior use, and that there is a nearly two-year gap between its receipt of its first claimed shipment and subsequent shipments of similarly named goods. Further, the Opposer chose not to offer testimony of its own officers or employees to establish its prior use of the mark in commerce in the United States.

Under these circumstances, Opposer’s evidence falls woefully short of meeting its burden of proof to establish its prior use in commerce. Accordingly this opposition should be dismissed.

SUMMARY

Because the Opposer has failed to carry its burden of proof that it had established prior use of the mark, the opposition should be dismissed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "David M. Rogero", written over a horizontal line.

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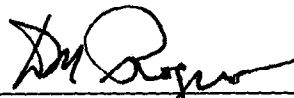
March 20, 2003

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Agreed Motion for Extension of Trial Dates was sent by first class mail with proper postage affixed, the 20th day of March, 2003, to the following counsel:

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