

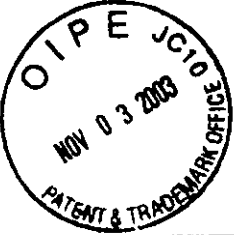
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EXPRESS MAIL NO. EV327494245US

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



TECHNOGYM S.p.A.,

Opposer,

v.

Opposition No. 91157128

MELALEUCA, INC.,

Applicant.



11-03-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #78

ANSWER

Applicant Melaleuca, Inc. (hereinafter "Melaleuca" or "applicant") for its Answer states as follows:

1. Admits that opposer is the record owner of certain federal trademark registrations for marks that contain the word "wellness" and, except as so admitted, denies the allegations in paragraph 1 of the Notice of Opposition.
2. Admits that Ser. No. 76/468,521 was filed on November 8, 2002, in the name of Technogym S.p.A., for the goods listed in paragraph 2 of the Notice of Opposition and, except as so admitted, states that it is without knowledge sufficient to admit or deny the remaining allegations in paragraph 2 of the Notice of Opposition and therefore denies the remaining allegations in paragraph 2 of the Notice of Opposition.
3. Admits that opposer is the record owner of the federal trademark registrations and applications listed in paragraph 3 of the Notice of Opposition and, except as so admitted, denies the allegations in paragraph 3 of the Notice of Opposition.

CERTIFICATION UNDER 37 C.F.R. 1.10

I hereby certify that this paper is being deposited with the United States Postal Service as Express Mail, Label No. EV327494245US in the envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514, on November 3, 2003.

Peter D. Vogl
(Name)

(Signature)

(Reg. No.)

November 3, 2003

(Date of Signature)

NY2: 1477143.1

4. States that it is without knowledge sufficient to admit or deny the allegations in paragraph 4 of the Notice of Opposition and therefore denies the allegations in paragraph 4 of the Notice of Opposition.
5. States that it is without knowledge sufficient to admit or deny the allegations in paragraph 5 of the Notice of Opposition and therefore denies the allegations in paragraph 5 of the Notice of Opposition.
6. Admits that applicant filed Ser. No. 76/302,883 for the mark MELALEUCA...THE WELLNESS COMPANY for "mail order catalog services featuring health care products, nutritionals, dietary supplements, vitamins and mineral supplements, nutritious foods, snacks and beverages, cosmetics, toiletries, laundry care products, cleaners, soaps, dishwasher detergents, air fresheners, detergents and disinfectants" and, except as so admitted, denies the allegation in paragraph 6 of the Notice of Opposition.
7. Admits that applicant made no use of the mark MELALEUCA...THE WELLNESS COMPANY prior to the date that Ser. No. 76/302,883 was filed and, except as so admitted, denies the allegations in paragraph 7 of the Notice of Opposition.
8. States that it is without knowledge sufficient to admit or deny the allegations in paragraph 8 of the Notice of Opposition and therefore denies the allegations in paragraph 8 of the Notice of Opposition.
9. Denies the allegations in paragraph 9 of the Notice of Opposition.
10. Denies the allegations in paragraph 10 of the Notice of Opposition.
11. Denies the allegations in paragraph 11 of the Notice of Opposition.
12. Denies the allegations in paragraph 12 of the Notice of Opposition.
13. Denies the allegations in paragraph 13 of the Notice of Opposition.
14. Denies the allegations in paragraph 14 of the Notice of Opposition.
15. Admits that *melaleuca alternifolia* produces an essential oil that can be used in cosmetics and, except as so admitted, denies the allegations in paragraph 15 of the Notice of Opposition.
16. Admits that applicant did not disclaim MELALEUCA from Ser. No. 76/302,883 and, except as so admitted, denies the allegations in paragraph 16 of the Notice of Opposition.
17. Denies the allegations in paragraph 17 of the Notice of Opposition.
18. Denies the allegations in paragraph 18 of the Notice of Opposition.

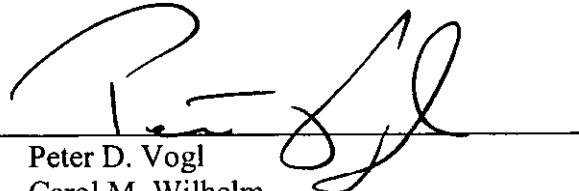
19. Denies the allegations in paragraph 19 of the Notice of Opposition.
20. Denies the allegations in paragraph 20 of the Notice of Opposition.

AFFIRMATIVE DEFENSES

1. The Notice of Opposition fails to state a claim upon which relief can be granted.
2. Opposer lacks standing to oppose the application on grounds that MELALEUCA is merely descriptive or generic.
3. Applicant is the owner of an incontestable registration for the mark MELALEUCA, which precludes challenge of the mark on descriptiveness grounds.
4. Opposer's claim is barred by the equitable defenses of acquiescence, laches and estoppel.

Dated: New York, New York
November 3, 2003

By: _____



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Colleen M. Keegan
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(212) 790-9090

Attorneys for Applicant

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **ANSWER** has been served by first class mail, postage prepaid, on November 3, 2003 upon:

Michael A. Grow, Esq.
Arent Fox Kinter Plotkin & Kahn, PLLC
1050 Connecticut Avenue, NW
Washington, DC 20003

A handwritten signature in black ink, appearing to read "Michael A. Grow", is written over a horizontal line. The signature is stylized and cursive.

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**MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM
AND LACK OF STANDING**

Applicant Melaleuca, Inc. (hereinafter "Melaleuca" or "applicant") hereby moves to dismiss the opposition of Ser. No. 76/302,882 for the mark MELALEUCA ... THE WELLNESS COMPANY, insofar as it is based on the allegations that the "MELALEUCA" portion of the mark is generic or merely descriptive. The notice of opposition fails to state a claim on these grounds, and Opposer has no standing to oppose the mark on these grounds.

According to the Notice of Opposition, opposer is in the business of selling highly specialized personal fitness and physical rehabilitation equipment and services. Nowhere in the Notice of Opposition does opposer allege that it is in the business of providing mail order services or of manufacturing or selling any of the goods identified in Ser. No. 76/302,882, such

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Peter D. Vogl
(Name)

(Signature)

(Reg. No.)

11/3/03
(Date of Signature)

NY2: 1476977.1

as vitamins, dietary supplements, foods, laundry care products, cleaners, air fresheners and the like. Opposer does not allege that it has any intention of selling or marketing these products. Opposer does not allege that it is a competitor of applicant or that the products or services of opposer and applicant compete in any way.

In order to oppose a mark on grounds that it is merely descriptive or generic, the TTAB has stated the following:

Standing to oppose [on the ground of mere descriptiveness] is presumed when the mark sought to be registered is allegedly descriptive of the goods and the opposer is one who has a sufficient interest in using the descriptive term in his business. For example, one who makes and sells a product that could be described by the term applicant seeks to register has standing to oppose. . . . However, at the minimum, it is necessary for opposer to prove that it is engaged in the sale of goods of which the applied-for mark is allegedly descriptive.

The Trademark [Trial and Appeal] Board has indicated that a competitor presumptively has standing. That is, one has standing to oppose on the basis of alleged descriptiveness if one has a present or prospective right to use the term descriptively in its business. This can be proven by evidence that opposer is a present or potential competitor.

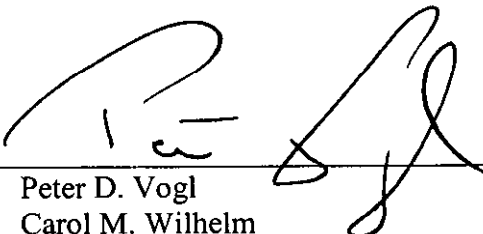
Plyboo America, Inc. v. Smith & Fong Co., 51 U.S.P.Q.2d 1633, 1634 n.5 (TTAB 1999) (quoting McCarthy, *Trademarks and Unfair Competition*, § 20:11 (4th ed. 1998)). See also *James River Petroleum, Inc. v. Petro Shopping Centers, L.P.*, 57 U.S.P.Q.2d 1249 (TTAB 2000) (same rule applies for claim of genericness).

Thus, where the parties are not competitors and the opposer does not sell goods or services for which the mark is allegedly descriptive or generic, there is no basis for opposition and no standing. See, e.g., *No Nonsense Fashions, Inc. v. Consolidated Foods Corp.*, 226 U.S.P.Q. 502 (TTAB 1985). That is the case in this opposition. Opposer identifies its interest in the mark as being the same as the general public (Notice. of Opp. ¶19), not as a competitor or potential competitor that will be damaged if it cannot use the term to describe its goods or

business. Indeed, opposer has failed to allege that it has any need to use the term MELALEUCA in its business.¹

Opposer has failed to state a claim, or establish its standing for asserting, that the term MELALEUCA is generic or merely descriptive.² The allegations of the Notice of Opposition clearly indicate that opposer's interest in and only basis for opposing Ser. No. 76/302,883 is the presence of the words "THE WELLNESS COMPANY". Applicant respectfully submits that the opposition be dismissed insofar as it is based on anything other than a likelihood of confusion under 15 U.S.C. § 1052(d).

Dated: New York, New York
November 3, 2003

By: 
Peter D. Vogl
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Colleen M. Keegan
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Attorneys for Applicant

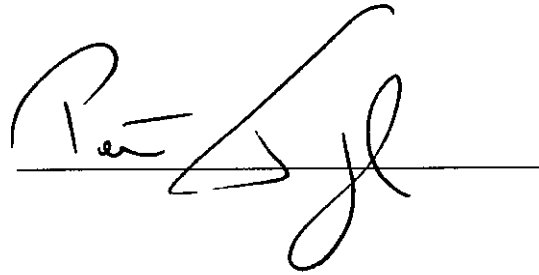
¹ None of the applications and registrations cited by opposer in paragraph 3 of the Notice of Opposition refer to any "melaleuca" product or service.

² To the extent opposer claims that MELALEUCA is merely descriptive of the products identified in Ser. No. 76/302,883, applicant is the owner of Reg. No. 1,917,518, which is incontestable, for the goods identified in the opposed application.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM AND LACK OF STANDING** has been served by first class mail, postage prepaid, on November 3, 2003 upon:

Michael A. Grow, Esq.
Arent Fox Kinter Plotkin & Kahn, PLLC
1050 Connecticut Avenue, NW
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