

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

FINANZ ST. HONORÉ, B.V.,
 Opposer/Counterclaim Respondent

v.

Opposition No. 91-161028

JOHNSON & JOHNSON
 Applicant/Counterclaim Petitioner

ANSWER TO COUNTERCLAIM

Finanz St. Honoré, B.V., Opposer and Counterclaim Respondent (hereinafter “Finanz”) in the above-captioned action, hereby answers the Counterclaim of Johnson & Johnson, Counterclaim Petitioner (hereinafter “Johnson & Johnson”):

1. Finanz admits the allegations contained in Paragraph 11 of the Counterclaim.

2. Finanz denies the allegations of Johnson & Johnson in Paragraph 12 of the Counterclaim for want of knowledge as to how long Johnson & Johnson has used the phrase “baby soft” in ad copy, etc. However, to the extent Johnson & Johnson has used this phrase as evidenced by the exhibits to its Counterclaim, it has used this only a descriptive term of the tactile sensations of its products, not as a trademark.

3. Finanz admits the allegations in Paragraph 13 of the Counterclaim that its products are closely related to the products listed in the trademark application of Johnson & Johnson, and in fact its licensees have manufactured and sold shampoo, lotion and body wash, the very products for which Johnson & Johnson is seeking trademark protection. However, this in no way makes the use of “Baby Soft” in Finanz’s trademark “Love’s Baby Soft” generic, and thus Finanz denies the allegations of Johnson & Johnson in Paragraph 13 of the Counterclaim that the term “baby soft” is generic. On the



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contrary, "Love's Baby Soft" is the only trademark that is registered with the Patent and Trademark Office that uses the clause "Baby Soft" as part of a trademark for fragrance products and related health and beauty goods, and thus this clause is unique to Finanz's products. Furthermore, the use of the clause "Baby Soft" on products manufactured and sold by Finanz's licensees is in no way merely descriptive. Products bearing the trademark "Love's Baby Soft" were first sold in the form of colognes, fragrance body sprays and similar products used to perfume oneself. Finanz, through its licensees, continues the use of Love's Baby Soft in the sale of such fragrance products. Such fragrance products, by their nature, have no tactile sensation, and thus the term "Baby Soft" as applied to such fragrance products cannot be descriptive. Moreover, the trademark "Love's Baby Soft" has become known in the minds of consumers for a particular brand of fragrance products and related beauty aids, without have anything to do with the tactile sensation of these products. Because of the fame and popularity of these fragrance products bearing the Love's Baby Soft trademark, Finanz and its predecessor were able to expand the use of Love's Baby Soft from fragrance products to other products that are ancillary to fragrance products, such as lotions, body washes and shampoo, in addition to other health and beauty products, cosmetics and even "fashion accessories". Thus, while some ancillary products bearing the "Love's Baby Soft" trademark might have a tactile sensation, a consumer identifies these products as part of the Love's Baby Soft line of products, not because of the tactile sensation, and thus the clause "Baby Soft" is in no way used as merely a descriptive phrase. As such, the allegation that the "Baby Soft" in "Love's Baby Soft" is merely a descriptive phrase, and thus the name is generic, is denied.

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Opposer/Counterclaim-Respondent: Finanz St. Honore, B.V.
Opposition No.: 91161028
Serial No: 78164712
Opposition Filed: June 1, 2004
For: KISSABLY BABY SOFT

Box TTAB NO FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Dear Sir:

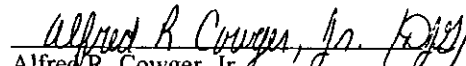
CERTIFICATE OF SERVICE

On September 24, 2004, a copy of the Reply to Counterclaim was sent to the Petitioner's attorney at the following address:

Christen M. English
Drinker Biddle & Reath LLP
1500 K Street, N.W., Suite 1100
Washington, D.C. 20005-1209

Respectfully submitted,


Date: September 24, 2004


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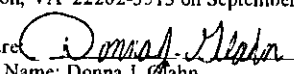
CERTIFICATE OF SERVICE

I hereby certify that a copy of this correspondence was served via first class mail, postage prepaid, in an envelope addressed to counsel for applicant, Christen M. English, Drinker Biddle & Reath LLP, 1500 K Street, N.W., Suite 1100, Washington, D.C. 20005-1209 on September 24, 2004.

Signature: 
Printed Name: Donna J. Glahn

CERTIFICATE OF MAILING

I certify that the foregoing is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to BOX TTAB-NO FEE, Appeal Board, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 on September 24, 2004, 2004.

Signature: 
Printed Name: Donna J. Glahn