

ESTTA Tracking number: **ESTTA61761**

Filing date: **01/12/2006**

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

Proceeding	91162247
Party	Plaintiff ROYAL LABS NATURAL COSMETICS
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Submission	Motion to Amend Pleading/Amended Pleading
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Date	01/12/2006
Attachments	Motion to Amend Opposition Notice.pdf ( 9 pages )

**Royal Labs Natural Cosmetics, Inc.,** )  
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 Opposer, )  
 )  
 v. )  
 )  
**Visual Changes Skin Care International** )  
**Inc.** )  
 Applicant. )  
\_\_\_\_\_ )

**Opposition No. 91162247**

**MOTION TO AMEND NOTICE OF OPPOSITION**

Opposer, Royal Labs Natural Cosmetics, Inc., hereby moves to amend its Notice of Opposition in the above-captioned case, pursuant to Rules 2.107 of the Rules of Practice of the Patent and Trademark Office and Rule 15 of the Federal Rules of Civil Procedure. Specifically, Opposer seeks to amend said Notice of Opposition to assert causes of action related to Applicant’s failure to consummate and abide by an agreement between the parties, reflected in correspondence between them, which resolved this matter.

**Factual Basis:** As stated in paragraph 6 of the proposed Amended Notice of Opposition, attached hereto, “the parties entered into negotiations to resolve this matter. These negotiations culminated in an exchange of correspondence agreeing to all material terms of a settlement of the issues between the parties.” As a result of this agreement, Opposer seeks to add causes of action for declaratory judgment, breach of contract, waiver, and estoppel. *See M-5 Steel Mfg., Inc. v. O’Hagin’s, Inc.*, 61 U.S.P.Q. 2d 1086 (2001).

Although the initial correspondence referred to in paragraph 6 of the proposed Amended Notice of Opposition were May 9 and June 2, 2005, it did not become clear until November 16,

2005, after much delay by Applicant, that Applicant would not honor the settlement agreement.<sup>1</sup> Opposer anticipates filing a motion for summary judgment on the Settlement Agreement, assuming this amendment is allowed.

**Applicable law:** Rule 15(a) of the Federal Rules of Civil Procedure provides liberality in amending pleadings where justice so requires. For example, the Fourth Circuit Court of Appeals has construed Rule 15(a) as follows:

Under Federal Rule of Civil Procedure 15(a), leave to amend a pleading ‘shall be freely given when justice so requires.’ Fed. R. Civ. P. 15(a). The Supreme Court has declared that ‘this mandate is to be heeded.’ *Foman v. Davis*, 371 U.S. 178, 182, 83 S. Ct. 227, 230, 9 L. Ed. 2d 222 (1962). The law is well settled ‘that leave to amend a pleading should be denied only when the amendment would be prejudicial to the opposing party, there has been bad faith on the part of the moving party, or the amendment would be futile.’ *Johnson v. Oroweat Foods Co.*, 785 F.2d 503, 509 (4th Cir. 1986). Delay alone is an insufficient reason to deny leave to amend. *See id.* Rather, the delay must be accompanied by prejudice, bad faith, or futility. *See id.*

*Edwards v. City of Goldsboro*, 178 F.3d 231 (4th Cir. 1999).

In *Island Creek Coal Co. v. Lake Shore, Inc.*, 832 F.2d 274, 279 (4th Cir. 1987), the Court held that even though the action had been pending in the district court for three and a half years, the district court abused its discretion by denying the plaintiffs’ motion for leave to amend their complaint to allege a new theory of recovery. *See also Sweetheart Plastics, Inc. v. Detroit Forming, Inc.*, 743 F.2d 1039 (4th Cir. 1984) (finding trial court abused its discretion by refusing to permit plaintiff to amend its complaint on the first day of trial to add a claim for trademark infringement where plaintiff did not discover the alleged infringement until after filing its original complaint). By contrast, this case has been stayed for much of the one and one half years that it has been pending (to allow consummation of a settlement agreement - the very reason

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<sup>1</sup> Opposer has since served discovery to meet the requirements of the scheduling order, reserving all rights there under.



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                   Opposer, )  
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                   Applicant. )  
\_\_\_\_\_ )

**Opposition No. 91162247**

*Certificate of Service*

I hereby certify that a true copy of the foregoing **OPPOSER’S MOTION TO AMEND NOTICE OF OPPOSITION** was served upon the Applicant by mailing the same to Louis J. Hoffman, Esq., Hoffman & Zur, 14614 North Kierland Boulevard, Suite 300, Scottsdale, Arizona 85254, attorneys for Applicant this 12th day of January, 2006.

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/clarkewdubose/  
Clarke W. DuBose

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

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<b>ROYAL LABS NATURAL COSMETICS, INC</b>	)	
	)	<b>PROPOSED AMENDED</b>
(Opposer)	)	<b>NOTICE OF OPPOSITION</b>
	)	
v.	)	
	)	<b>Opposition No. 91162247</b>
	)	
<b>VISUAL CHANGES SKIN CARE INTERNATIONAL, INC</b>	)	
	)	
(Applicant)	)	

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Opposer, Royal Labs Natural Cosmetics, Inc., a South Carolina Corporation, located and doing business at P.O. Box 22434, Charleston, South Carolina, 29413 believes that it is, or will be damaged by registration of the mark shown in Serial No. 78235588, and hereby opposes the same.

Description of Applicant's application: Filed on April 9, 2003. Published for Opposition in the Official Gazette of July 27, 2004. Mark: BELLAROMA in International Class 5 for Nutritional Supplements and in International Class 9 for Electronic media, including but not limited to, compact discs, DVD's, and video tapes on beauty and motivational topics.

As grounds for this opposition, it is alleged that:

**FOR A FIRST CAUSE OF ACTION**

1. Opposer is the owner of U.S. Trademark Registration No. 2261385 for the mark AROMA BELLA as used to identify skin care products, moisturizing agents, and other beauty products including topical skin vitamin supplements, in International Class 3, which was registered on the Principal Register on July 13, 1999. Said Registration was based on an application filed in the U.S. Patent and Trademark Office on January 8, 1997, which is a date

prior to the date of filing of Applicant's Application for Registration of BELLAROMA. Said registered mark of Opposer is valid, subsisting, and is now incontestable, and is prima facie evidence of Opposer's exclusive right to use said mark in commerce on the goods specified in said registration. In view of the similarity of the respective marks and the related nature of the goods of the respective parties, it is alleged that Applicant's mark so resembles Opposer's registered mark as to be likely to cause confusion, or to cause mistake, or to deceive.

2. Opposer, since January 11, 1999, has been, and is now, using the mark AROMA BELLA in connection with the sale of skin care products, moisturizing agents and other beauty products. Said use has been valid and continuous since said date of first use and has not been abandoned. Said mark AROMA BELLA of Opposer is symbolic of extensive good will and consumer recognition built up by Opposer through substantial amounts of time and effort in advertising and promotion. In view of the similarity of the respective marks and the related nature of the goods and services of the respective parties, it is alleged that Applicant's mark so resembles Opposer's mark, AROMA BELLA, previously used in the United States and not abandoned, as to be likely to cause confusion, or to cause mistake or to deceive.

3. Opposer is aware that Applicant has made previous use of its proposed mark BELLAROMA in connection with the same goods for which the Opposer has registered the mark AROMA BELLA. One example of this use is the Applicant's activity as an exhibitor of skincare products, shown on the attached flyer from the International Academy of Aesthetics Cutting-Edge Training Symposium on September 27, 2003. Opposer believes that Applicant's goods for which Applicant seeks registration of the mark BELLAROMA will be sold and distributed in conjunction with such skincare products covered by Opposer's registered mark

AROMA BELLA and that the Applicant's mark BELLAROMA will therefore be used in conjunction with the offering of such products.

4. Applicant is aware of the Opposer, its products, and its registered mark, inasmuch as Applicant has previously been a customer of the Opposer, purchasing products manufactured by the Opposer for distribution by the Applicant under the Applicant's own prior brand names (that did not include the name for which Applicant now seeks registration, BELLAROMA).

**FOR A SECOND CAUSE OF ACTION**  
(Declaratory Judgment)

5. Opposer re-alleges the allegations of the foregoing paragraphs as fully as if restated verbatim herein.

6. After the filing of this Opposition, the parties entered into negotiations to resolve this matter. These negotiations culminated in an exchange of correspondence agreeing to all material terms of a settlement of the issues between the parties.

7. These letters constitute a settlement of the action with the terms of the settlement sufficiently detailed so as to be enforceable.

8. Applicant is informed and believes that it is entitled to an order by this Board declaring that there is an enforceable contract of settlement between the parties.

**FOR A THIRD CAUSE OF ACTION**

(Breach of Contract)

9. Opposer re-alleges the allegations of the foregoing paragraphs as fully as if restated verbatim herein.

10. Applicant has breached the agreement memorialized in the correspondence by failing and refusing to execute any further agreement memorializing the settlement and has further breached the agreement by, *inter alia*, failing and refusing to dismiss the application that



is the subject of this Opposition and failing and refusing to dismiss Application Serial Number 78401332, for the mark BELLAROMA for use with goods in International Class 003.

11. Opposer has relied to its detriment on the agreement between the parties by, among other things, allowing the opposition period to run on Application Serial Number 78401332, for the mark BELLAROMA for use with goods in International Class 003.

12. Opposer is informed and believes that it is entitled to an order of this Board finding Applicant in breach of this contract and dismissing the Application at issue pursuant to the contract between the parties.

**FOR A FOURTH CAUSE OF ACTION**

(Waiver)

13. Opposer re-alleges the allegations of the foregoing paragraphs as fully as if restated verbatim herein.

14. By its knowing and intentional actions, stated above, Applicant has waived any right to further prosecute the subject trademark application and has waived its right to contest this opposition.

15. As a result, Opposer is entitled to an order dismissing the application.

**FOR A FIFTH CAUSE OF ACTION**

(Estoppel)

16. Opposer re-alleges the allegations of the foregoing paragraphs as fully as if restated verbatim herein.

17. Opposer in good faith entered into the settlement agreement alleged above.

18. Opposer was without knowledge and without means of knowledge to know that Applicant would not comply with its obligations under the agreement.

19. Opposer has relied in good faith on Applicant's agreement to perform its obligations under the agreement by, among other things, delaying prosecution of this Opposition and by allowing the opposition period to run on Application Serial Number 78401332, for the mark BELLAROMA for use with goods in International Class 003.

20. Applicant is thus estopped from denying the agreement between the parties, estopped from further prosecuting its applications, and is estopped from defending this Opposition.

**WHEREFORE**, Opposer prays that said application Serial No. 78235588 be rejected, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Opposer.

Opposer hereby appoints Clarke DuBose of the law firm Haynsworth Sinkler Boyd, P.A., a law firm whose members are all members of the bar of the State of South Carolina, to act as attorneys for Opposer herein, with full power to prosecute said opposition, to transact all relevant business with the Patent and Trademark Office and in the United States Courts and to receive all official communications in connection with this opposition.

Opposer: **Royal Labs Natural Cosmetics, Inc., a South Carolina Corporation**

**Haynsworth Sinkler Boyd, P.A.**

**By:** \_\_\_\_\_  
**Clarke W. DuBose**  
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**Attorney for Opposer Royal Labs Natural Cosmetics, Inc.**

**Date:**