

ESTTA Tracking number: **ESTTA20125**

Filing date: **11/24/2004**

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

<b>Proceeding</b>	91162247
<b>Party</b>	Plaintiff ROYAL LABS NATURAL COSMETICS ,
<b>Correspondence Address</b>	STEVE A. MATTHEWS HYNSWORTH SINKLER BOYD, P.A. P.O. BOX 11889 COLUMBIA, SC 29211-1889
<b>Submission</b>	Opposition/Response to Motion
<b>Filer's Name</b>	Clarke W. DuBose
<b>Filer's e-mail</b>	cdubose@hsblawfirm.com
<b>Signature</b>	/clarkewdubose/
<b>Date</b>	11/24/2004
<b>Attachments</b>	Response to Applicant's Motion to Strike.pdf ( 8 pages )

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

<b>Royal Labs Natural Cosmetics, Inc.,</b>	)	
	)	
Opposer,	)	
	)	
v.	)	<b>Opposition No. 91162247</b>
	)	
<b>Visual Changes Skin Care International</b>	)	
<b>Inc.,</b>	)	
Applicant.	)	
<hr style="border: 1px solid black;"/>		

**Opposer Royal Labs Natural Cosmetics, Inc.’s Response to Applicant’s Motion to Strike Opposition Paragraph Nos. 3 & 4.**

Opposer, Royal Labs Natural Cosmetics, Inc. (“Royal Labs” or “Opposer”), hereby responds to Applicant Visual Changes Skin Care International, Inc.’s (“Visual Changes” or “Applicant”) motion to strike Paragraph Nos. 3 & 4 of the Opposition. For the reasons set forth below, Visual Changes’ motion should be denied.

**INTRODUCTION**

Royal Labs is the owner of U.S. Trademark Registration No. 75222648 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.<sup>1</sup> Royal Labs’ mark AROMA BELLA was registered on the Principal Register on July

---

<sup>1</sup> Namely, “facial creams, night creams, herbal creams, acne creams, liposome creams, eye creams, vanishing creams, emollient creams, body creams, face and body gels, hand and body lotions, beauty masks, face and body scrubs, face and body exfoliants, fruit acid facial wash, fruit acid creme, fruit acid mask, topical skin vitamin supplements, acne gel aromatherapy face and body creams, cleansers, powders, gels, lotions, and oils, massage oils, massage cream, herbal oils, tanning oils, essential oils for personal use, body moisture gels, essential plant extracts used in skincare products, herbal body splitters, seaweed face and body creams, body washes, shower gels, bath salts, bubble baths, skin cleansing lotions and creams, aloe toners, shaving creams, after shave lotion, cream and gels, toilet soap, skin soap, deodorant soap, suntan and sunscreen lotions, gels and creams, aromatherapy cushions, hair shampoos, hair gels, hair rinses, hair spray, hair styling preparations and personal deodorants.”

13, 1999. On April 9, 2003, Visual Changes filed United States Trademark Registration Application Serial No. 78235588 for BELLAROMA under International Class 5 for nutritional supplements and International Class 9 for Electronic media, including but not limited to, compact discs, DVD's, and video tapes on beauty and motivational topics. Visual Changes' Application was published in the Official Gazette on July 27, 2004, and Royal Labs timely filed its Opposition to Visual Changes' Application alleging that Visual Changes' mark so resembles Royal Labs' registered mark, as to be likely to cause confusion, or to cause mistake, or to deceive.

Visual Changes filed a Motion to Strike Opposition Paragraph Nos. 3 & 4 on November 2, 2004, alleging that the Notice of Opposition contains immaterial and impertinent allegations. The allegations in the Notice of Opposition are material to the Opposition proceeding, and therefore Visual Changes' Motion to Strike should be denied.

## **ARGUMENT**

### **I. Opposition Paragraph No. 3 is Material and not Impertinent.**

Proceedings before the Board are governed by the Federal Rules of Civil Procedure, unless otherwise provided in the Trademark Rules of Practice. TBMP § 101.02. Although pursuant to Fed. R. Civ. P. 12(f) the Board "may order stricken from any pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter," motions to strike are not favored. *See Harsco Corp. v. Electrical Sciences Inc.*, 9 U.S.P.Q.2d 1570 (T.T.A.B. 1988). "Both because striking a portion of a pleading is a drastic remedy and because it often is sought by the movant simply as a dilatory or harassing tactic, numerous judicial decisions make it clear that motions under Rule 12(f) are viewed with disfavor by the federal courts and are infrequently granted."

5A Charles Alan Wright & Arthur R. Miller, Federal Practice and Procedure § 1380 (3d ed. 2004); *see also Waste Mgmt. Holdings, Inc. v. Gilmore*, 252 F.3d 316, 347 (4th Cir. 2001) (“Rule 12(f) motions are generally viewed with disfavor ‘because striking a portion of a pleading is a drastic remedy.’”). Moreover, a matter will not be stricken unless “it clearly has no bearing upon the issues under litigation.” *Leon Shaffer Golnick Advertising, Inc. v. William G. Pendill Marketing Co.*, 177 U.S.P.Q. 401, 402 (T.T.A.B. 1973); *see also Harsco Corp. v. Electrical Sciences Inc.*, 9 U.S.P.Q.2d 1570 (T.T.A.B. 1988). “Thus, the Board, in its discretion, may decline to strike even objectionable pleadings where their inclusion will not prejudice the adverse party, but rather will provide fuller notice of the basis for a claim or defense.” *Ohio State University v. Ohio University*, 51 U.S.P.Q.2d 1289, 1293 (T.T.A.B. 1999); *see also Harsco Corp.*, 9 U.S.P.Q.2d at 1571; TBMP §5016.01.

In prosecuting an opposition, the opposer must plead and prove that it has both standing to oppose the registration of the applicant’s mark, and that there are valid grounds why the applicant is not entitled to register their mark. *See* TBMP §309.03(b)-(c). In the Notice of Opposition, an opposer need only set forth a short and plain statement showing how the opposer would be damaged by the registration of the opposed mark and state the grounds for opposition. *See* 37 C.F.R. § 2.104(a); TBMP § 312.03.

Visual Changes argues that Opposition Paragraph No. 3 is immaterial and impertinent because it alleges “use of the BELLAROMA trademark on products unrelated to those listed” in the Visual Changes’ Application. Opposition Paragraph No. 3 states:

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.

Paragraph No. 3 alleges facts showing how Opposer would be damaged by registration of Applicant's mark, and thus is material and pertinent to the Opposition. *See* 37 C.F.R. § 2.104(a); TBMP § 312.03. Further, these facts tend to show how the goods/services listed in Applicant's registration, specifically electronic media on beauty products and nutritional supplements, relate to Royal Labs' registered goods/services. Paragraph No. 3 alleges facts showing the distribution and channels of trade used by Visual Changes, facts which are relevant and material in the central issue of this case: likelihood of confusion. When an opposer alleges likelihood of confusion as a ground for opposition, "the issue must be resolved on the basis of not only a comparison of the involved marks, but also on consideration of the goods named in the application and in opposer's registration and, in the absence of specific limitations in the application and registration, on consideration of the normal and usual channels of trade and methods of distribution." *CBS, Inc. v. Morrow*, 708 F.2d 1579, 1581 (Fed. Cir. 1983) (finding likely confusion between Applicant's use of the mark THINKER TOYS for computer parts and the opposer's mark TINKERTOY for games and toys, because while Applicant did not make computer parts for video games, the applicant's registration could be interpreted

broadly to include parts for video games); accord *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 1 U.S.P.Q.2d 1813 (Fed. Cir. 1987).

Moreover, “although a registrant’s current business practices may be quite narrow, they may change from time to time, from, for example, industrial sales to consumer sales.” *CBS, Inc.*, 708 F.2d at 1581. This case involves an application for registration of marks that are themselves to be used in connection with channels of distribution, in the form of “Electronic media, including, but not limited to, compact discs, DVDs, and videotapes on beauty and motivational topics.” See Visual Changes’ Registration Application 78235588. The allegation in Paragraph No. 3 of the Notice of Opposition, that Visual Changes is already selling competing beauty products with the BELLAROMA mark, is thus relevant to the use to which Visual Changes may be expected to put its electronic media for which the Application is made. Indeed, it is extremely likely that Visual Changes intends to use its proposed BELLAROMA electronic media to market the BELLAROMA beauty products contemplated by Visual Changes’ Registration Application Serial No. 78401332. Thus, Paragraph No. 3 has significant bearing in this litigation and should not be stricken. See *Leon Shaffer Golnick Advertising, Inc. v. William G. Pendill Marketing Co.*, 177 U.S.P.Q. 401, 402 (T.T.A.B. 1973) (finding that a matter will not be stricken unless “it clearly has no bearing upon the issues under litigation”); see also *Harsco Corp. v. Electrical Sciences Inc.*, 9 U.S.P.Q.2d 1570 (T.T.A.B. 1988).<sup>2</sup>

---

<sup>2</sup> The likelihood of confusion present here is not limited to the potential of Visual Changes’ beauty products being labeled BELLAROMA, however. The sale of any of Visual Changes’ beauty-related products using the proposed mark BELLAROMA on electronic media is likely cause confusion in the marketplace between Visual Changes’ products and those of Opposer, because Visual Changes’ electronic media will be used to sell products that mistakenly will be associated with Opposer should the electronic media bear the mark BELLAROMA.

Further, Visual Changes will not be prejudiced if Opposition Paragraph No. 3 remains. Rather, the paragraph provides for fuller notice of the basis for the claim in this Opposition proceeding. *See Harsco Corp. v. Electrical Sciences Inc.*, 9 U.S.P.Q.2d 1570 (T.T.A.B 1988) (stating “[e]ven if the allegations are redundant or immaterial, they need not be stricken if their presence in the pleading cannot prejudice the adverse party. If evidentiary facts are pleaded, and they aid in giving a full understanding of the complaint as a whole they need not be stricken.” (quoting 2A Moore’s Federal Practice, § 12.21[2] (2d ed. 1985))). Striking Paragraph No. 3 would preclude Royal Labs from showing how the goods/services listed in Visual Changes’ registration do relate to Opposer’s registered goods/services.

## **II. Opposition Paragraph No. 4 is Material and not Impertinent.**

Visual Changes further alleges that Opposition Paragraph No. 4 contains “superfluous historical allegations about the parties previous business dealings” and should be stricken. Opposition Paragraph No. 4 states:

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).

Visual Changes’ counsel cites to *Fantasy, Inc. v. Fogerty*, 984 F.2d 1524, 1527 (9th Cir. 1993), for the proposition that “‘superfluous historical allegations are a proper subject of a motion to strike.’” In *Fantasy, Inc.*, the court ordered stricken those allegations that “did not involve the parties to the copyright infringement action, but rather consisted of stale and barred charges that had already been extensively litigated.”

984 F.2d at 1528. The facts alleged in Paragraph No. 4 are not stale and barred charges as in *Fantasy, Inc.*, but instead these facts tend to show the motive of Visual Changes in selecting its mark. These facts show the prior business relationship between the parties and Visual Labs knowledge of Royal Labs' trademark. "It has been held that while the motives of a party in selecting its mark are not decisive on the issue of likelihood of confusion, they are nevertheless *not to be ignored*. *Leon Shaffer Golnick Advertising, Inc. v. William G. Pendill Marketing Co.*, 177 U.S.P.Q. 401, 402 (T.T.A.B 1973) (emphasis added) (citing *Lever Brothers Co. v. Riodela Chemical Co.*, 5 U.S.P.Q. 152 (C.C.P.A. 1930); *Tiffany & Co. v. Tiffany Tile Corp.*, 145 U.S.P.Q. 483 (C.C.P.A. 1965)). Thus, the factual assertions in Paragraph No. 4 are pertinent and material to a central issue in the this case, that is, the issue of likelihood confusion, and thus Paragraph No. 4 should not be stricken. *See Leon Shaffer Golnick Advertising, Inc.* 177 U.S.P.Q. at 402 (refusing to strike paragraph in cancellation petition relating to motives of party because paragraph was pertinent to issue of likelihood of confusion).

### CONCLUSION

For the reasons stated herein, Royal Labs respectfully requests that Applicant Visual Changes motion to strike Paragraphs 3 & 4 be denied.

HAYNSWORTH SINKLER BOYD, P.A.

By:           /clarkewdubose/            
Clarke W. DuBose  
Steve A. Matthews  
Post Office Box 11889  
Columbia, SC 29211-1889  
(803) 779-3080  
**Attorneys for Opposer Royal Labs  
Natural Cosmetics, Inc.**

November 24, 2004



## CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **Opposer Royal Labs Natural Cosmetics, Inc. Response to Applicant's Motion to Strike Opposition Paragraph Nos. 3 & 4** has been served on Applicant's attorney, K. Brian Bathurst, by mailing said copy on November 24, 2004, via First Class Mail, postage prepaid to:

K. Brian Bathurst, Esq.  
Dowling, Aaron & Keeler, Inc.  
6051 North Fresno Street, Suite 200  
Fresno, California 93710

/lindseycarlberg/  
Lindsey Carlberg

Columbia: 485342 v.1