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

Proceeding	91162247
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

**ROYAL LABS NATURAL COSMETICS,
INC.,**

Opposer

v.

**VISUAL CHANGES SKIN CARE
INTERNATIONAL, INC.,**

Applicant.

Opposition No. 91162247
Serial No. 78235588

**APPLICANT VISUAL CHANGES SKIN
CARE INTERNATIONAL, INC.'S REPLY
IN SUPPORT OF MOTION TO STRIKE
OPPOSITION PARAGRAPH NOS. 3 & 4
PURSUANT TO FED. R. CIV. P. 12(f) AND
TBMP § 506.**

I. INTRODUCTION.

Opposer ROYAL LABS NATURAL COSMETICS, INC.'S ("Royal Labs" or "Opposer") Response to Applicant VISUAL CHANGES SKIN CARE INTERNATIONAL, INC.'S ("Visual Changes" or "Applicant") Motion to Strike Opposition Paragraph Nos. 3 & 4 fails to overcome the fact that said paragraphs plead matter that is irrelevant, impertinent and immaterial to the Opposition. Consequently, under Opposer's own authorities, Rule 12(f) of the Federal Rules of Civil Procedure and Section 506 of the Trademark Trial and Appeal Board Manual of Procedure ("TBMP"), Opposition Paragraph Nos. 3 & 4 (and the attached flyer) should be stricken.

1 **II. PARAGRAPH NO. 3 SHOULD BE STRICKEN BECAUSE IT CONTAINS**
2 **IRRELEVANT, IMMATERIAL AND IMPERTINENT ALLEGATIONS.**

3 Opposer's Response ignores the well-established principle that facts alleged outside the
4 relevant application and registration purporting to show the nature of goods, channels of trade
5 and/or methods of distribution are irrelevant, immaterial and impertinent to an opposition. The
6 Federal Circuit has repeatedly held that:

7 The issue in an opposition is the right of an applicant to register the
8 mark depicted in the application for the goods identified therein.
9 The authority is legion that the question of registerability of an
10 applicant's mark must be decided on the basis of the identification
of goods set forth in the application regardless of what the record
may reveal as to the particular nature of an applicant's goods, the
particular channels of trade or the class of purchasers to which
sales of the goods are directed.

11 Octocom Systems, Inc. v. Houston Computer Services, Inc., 918 F.2d 937, 942 (Fed. Cir. 1990)
12 (emphasis added) (internal citations omitted). Additionally, Opposer ignores that the flyer
13 attached to the Notice of Opposition cannot be presented as evidence pursuant to 37 CFR
14 § 2.122(c).

15 Still, Opposer attempts to defend Opposition Paragraph No. 3 by arguing that the
16 extraneous allegations contained in the paragraph, "show how the goods/services listed in
17 Applicant's registration, specifically electronic media on beauty products and nutritional
18 supplements¹, relate to Royal Labs' registered goods/services."² Response at p. 4 (emphasis
19 added). Yet, it is plainly apparent that Paragraph No. 3 makes no mention of electronic media on
20 beauty products and nutritional supplements. Instead, Paragraph No. 3 alleges that, "Applicant
21 has made previous use of its proposed mark BELLAROMA in connection with the same goods
22 for which the Opposer has registered the mark AROMA BELLA." These "same goods,"
23 however, do not include, "[e]lectronic media, namely compact discs, DVDs, and video tapes on
24 beauty and motivational topics," in International Class No. 9 and "[n]utritional [s]upplements" in
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27 ¹ Opposer misstates the goods listed in Applicant's application. Applicant's application does not list "electronic
28 media on beauty products and nutritional supplements." Applicant's application lists, "[e]lectronic media, namely
compact discs, DVDs, and video tapes on beauty and motivational topics," in International Class No. 9 and
"[n]utritional [s]upplements" in International Class No. 5. See Visual Changes' Registration Application Serial No.
78235588.

² Royal Labs' mark is not registered in connection with services. See Notice of Opposition.

1 International Class No. 5. Consequently, it is impossible for Paragraph No. 3 to tend to show
2 how the goods in Applicant’s application relate to Royal Labs’ registered goods.

3 Opposer attempts to defend Opposition Paragraph No. 3 by arguing that it, “show[s] the
4 distribution and channels of trade used by Visual Changes, facts which are relevant and material
5 in the central issue of this case: likelihood of confusion.” Again, Opposer ignores that as a
6 matter of law, “the question of registerability of an applicant’s mark must be decided on the basis
7 of the identification of goods set forth in the application regardless of what the record may reveal
8 as to ... the particular channels of trade.” Octocom Systems, 918 F.2d at 937 (emphasis added).

9 Additionally, Opposer misinterprets the holding of CBS, Inc. v. Morrow, 708 F.2d 1579,
10 1581 (Fed. Cir. 1983). In CBS, the court held that, “in the absence of specific limitations in the
11 application and registration, [the issue of likelihood of confusion will be decided from]
12 consideration of the normal and usual channels of trade and methods of distribution”) (emphasis
13 added). Opposer misinterprets the holding of CBS to mean that in the absence of specific
14 limitations in the relevant application and registration, Opposer is free to attempt to introduce its
15 own evidence and speculate about the normal and usual channels of trade and methods of
16 distribution. This is not the law.

17 Opposer attempts to defend Opposition Paragraph No. 3 by citing CBS for the
18 proposition that, “although a registrant’s current business practices may be quite narrow, they
19 may change from time to time, from, for example, industrial sales to consumer sales.” CBS, 708
20 F.2d at 1581 (emphasis added). Yet, Opposer attempts to support this proposition by speculating
21 about how Applicant’s business practices may change over time *vis a vis* an unrelated trademark
22 registration application not at issue in this Opposition, (i.e., “it is extremely likely that Visual
23 Changes intends to use its proposed BELLAROMA electronic media to market the
24 BELLAROMA beauty products contemplated by Visual Changes’ Registration Application
25 Serial No. 78401332.”). Response at p. 5. As stated by Applicant in its moving papers,
26 however, “[t]he proper time for Opposer to challenge Applicant’s alleged use of BELLAROMA
27 in connection with skincare products under International Class 3 is when/if Applicant’s United
28 States Trademark Registration Application Serial No. 78401332 is published in the Official

1 Gazette.” Motion at p. 4.

2 Finally, Opposition Paragraph No. 3 has no bearing on the Opposition and would
3 severely prejudice Applicant if the question of registerability was decided on the basis of the
4 alleged “facts” contained in this paragraph.³ As Opposer concedes, in no case is the inclusion of
5 irrelevant, immaterial and impertinent material allowed under the justification of giving “full
6 notice” and a “full understanding of the complaint,” if the other party is prejudiced by the
7 inclusion of such material. See Response at p. 3, citing Leon Shaffer Golnick Advertising, Inc.
8 v. William G. Pendill Marketing Co., 177 U.S.P.Q. 401, 402 (T.T.A.B. 1973) and Harsco Corp.
9 v. Electrical Sciences Inc., 9 U.S.P.Q.2d 1570 (T.T.A.B. 1988). Yet this is exactly what Opposer
10 is attempting to do. If allowed to remain in the Opposition, Paragraph No. 3 would
11 unnecessarily prejudice Applicant by complicating the Opposition and causing Applicant to
12 expend needless time and money in defending itself against irrelevant, immaterial and
13 impertinent allegations. Because “the function of a 12(f) motion to strike is to avoid the
14 expenditure of time and money that must arise from litigating spurious issues by dispensing with
15 those issues prior to trial,” Opposition Paragraph No. 3 should be stricken. See Fantasy, Inc. v.
16 Fogerty, 984 F.2d 1524, 1527 (9th Cir. 1993), *rev’d on other grounds*, 510 U.S. 517 (1994).

17 **III. THE PARTIES’ PREVIOUS BUSINESS DEALINGS ARE ALSO IRRELEVANT,**
18 **IMMATERIAL AND IMPERTINENT TO THE OPPOSITION.**

19 Opposer freely admits that all products “manufactured by the Opposer for distribution by
20 the Applicant [were] under the Applicant’s own prior brand names.” Response at p. 7 (emphasis
21 added). Moreover, although there might have been a prior business relationship between the
22 parties, Opposition Paragraph No. 4 (and Opposer’s Response) offers no evidence or explanation
23 whatsoever as to how Applicant knew about the AROMA BELLA mark by ordering products
24 under Applicant’s own marks from a company called “Royal Labs.”

25 Opposer attempts to defend Opposition Paragraph No. 4 by arguing that the holding of
26 Fantasy, Inc. v. Fogerty, 984 F.2d 1524, 1527 (9th Cir. 1993) that, “[s]uperfluous historical
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28 ³ In response to Opposer’s suggestion that such “facts” are evidentiary (Response at p. 6), please see Applicant’s
Written Objections to Opposer’s Evidence submitted in Response to Applicant’s Motion to Strike.

1 allegations are a proper subject of a motion to strike,” does not apply here. Specifically, Opposer
2 suggests that Fantasy stands for the proposition that only “stale and barred charges” are the
3 proper subject of a motion to strike. See Response at p. 6. Opposer fails to mention, however,
4 that when the Fantasy court held that “[s]uperfluous historical allegations are a proper subject of
5 a motion to strike,” the Fantasy court cited as precedent Healing v. Jones, 174 F. Supp. 211, 220
6 (D. Ariz. 1959), a case involving the parties to an action with respect to charges that were not
7 previously litigated or barred. See Fantasy, 984 F.2d at 1527. The point remains that
8 Opposition Paragraph No. 4 contains superfluous historical allegations that should be stricken
9 from the Opposition.

10 Opposer admits that Opposition Paragraph No. 4 is irrelevant, immaterial and impertinent
11 by expressly conceding that as a matter of law, “the motives of a party in selecting its mark are
12 not decisive on the issue of likelihood of confusion.” Response at p. 7, citing Leon Shaffer
13 Golnick Advertising, 177 U.S.P.Q. at 402 (other internal citations omitted). Yet ironically,
14 Opposer attempts to argue that Opposition Paragraph No. 4, “show[s] the motive of Visual
15 Changes in selecting its mark.” Response at p. 7. Visual Changes denies the motive ascribed to
16 it and the fact remains that regardless of whether Opposition Paragraph No. 4 alleges the motive
17 of Visual Changes in selecting its mark, it will not help resolve the issue of the likelihood of
18 confusion.

19 Consequently, allowing Opposition Paragraph No. 4 to remain in the Opposition will
20 unnecessarily complicate the Opposition by inviting unwarranted discovery into the confidential
21 business records of Visual Changes without the possibility of yielding any evidence relevant to
22 the Opposition. Because a court may properly grant a motion to strike for the purpose of
23 streamlining the ultimate resolution of an action and focusing attention on the real issues in a
24 case, striking this paragraph from the Opposition is especially warranted. Fantasy, Inc., 984 F.2d
25 at 1528; see also TBMP § 506.01 (striking matter that has no bearing upon the issues in the
26 case).

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1 **VI. CONCLUSION**

2 For the reasons set forth above, Applicant Visual Changes respectfully requests that the
3 Board strike Paragraph Nos. 3 & 4 (and the attached flyer) of the Opposition of ROYAL LABS
4 NATURAL COSMETICS, INC.

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6 Dated: December 14, 2004

DOWLING, AARON & KEELER INC.

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By: _____ /S/
K. Brian Bathurst
Attorneys for VISUAL CHANGES SKIN
CARE INTERNATIONAL, INC.

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1 CERTIFICATE OF SERVICE

2 I hereby certify that a copy of the foregoing **APPLICANT VISUAL CHANGES**
3 **SKIN CARE INTERNATIONAL, INC.’S REPLY IN SUPPORT OF MOTION TO**
4 **STRIKE OPPOSITION PARAGRAPH NOS. 3 & 4 PURSUANT TO FED. R. Civ.**
5 **P. 12(f) AND TBMP § 506** was sent via First Class Mail on December 14, 2004, to
6 counsel for the Opposer at the following address:

7 Steve A. Matthews
8 Haynsworth Sinkler Boyd, P.A.
9 P.O. Box 11889
10 Columbia, SC 29211-1889

11 /S/
12 Helen L. Walton

13 Date: December 14, 2004

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**ROYAL LABS NATURAL COSMETICS,
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Opposer

v.

**VISUAL CHANGES SKIN CARE
INTERNATIONAL, INC.,**

Applicant.

Opposition No. 91162247
Serial No. 78235588

**APPLICANT VISUAL CHANGES SKIN
CARE INTERNATIONAL, INC.'S
WRITTEN OBJECTIONS TO
EVIDENTIARY STATEMENTS
CONTAINED IN OPPOSER'S RESPONSE
TO APPLICANT'S MOTION TO STRIKE
OPPOSITION PARAGRAPH NOS. 3 & 4
PURSUANT TO FED. R. CIV. P. 12(f) AND
TBMP § 506.**

Pursuant to the Federal Rules of Evidence and Section 707 of the Trademark Trial and Appeal Board Manual of Procedure ("TBMP"), Applicant VISUAL CHANGES SKIN CARE INTERNATIONAL, INC. ("Visual Changes" or "Applicant") hereby objects to the following evidentiary statements submitted in connection with Opposer ROYAL LABS NATURAL COSMETICS, INC.'S ("Royal Labs" or "Opposer") Response to Applicant's Motion to Strike Opposition Paragraph Nos. 3 & 4:

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1. Page 5: “Visual Changes is already selling competing beauty products with the BELLAROMA mark...”

Irrelevant (FRE 402); vague and ambiguous regarding the identity of “beauty products”; lack of foundation; lack of personal knowledge (FRE 602); unsworn allegation (FRE 603); opinion testimony by counsel acting as a lay witness (FRE 701); and lack of authentication (FRE 901). Additionally, pursuant to TBMP § 704.06, factual statements in pleadings and briefs cannot be considered as evidence.

2. Page 7: “These facts show the prior business relationship between the parties and Visual Labs [sic] knowledge of Royal Labs’ trademark.”

Irrelevant (FRE 402); vague and ambiguous regarding the nature of “business relationship”; lack of foundation; lack of personal knowledge (FRE 602); unsworn allegation (FRE 603); opinion testimony by counsel acting as a lay witness (FRE 701); and lack of authentication (FRE 901). Additionally, pursuant to TBMP § 704.06, factual statements in pleadings and briefs cannot be considered as evidence.

Dated: December 14, 2004

DOWLING, AARON & KEELER INC.

By: _____ /S/
K. Brian Bathurst
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CARE INTERNATIONAL, INC.

