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

Proceeding	91218304
Party	Defendant Marcus Asam, Mirjam Asam, Ruth Axel
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

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KOSAN KOZMETIK SANAYI VE TICARET  
ANONIM SIRKETI,

OPPOSER,

V.

MIRJAM ASAM, MARCUS ASAM, and  
AXEL RUTH

APPLICANTS.

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Opp. No. 91218304

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**REPLY IN SUPPORT OF APPLICANTS' MOTION FOR LEAVE TO AMEND THEIR  
ANSWER TO ADD COUNTERCLAIMS**

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Applicants have sought leave to amend their Answer to add counterclaims based on: 1). Opposer's lack of bona fide intent to use its pleaded marks in the U.S.; and 2). abandonment.

Opposer ignores Applicants abandonment claim altogether, acknowledges that ". . . Opposer does not have prior specific written evidence regarding its plans for use of this mark . . ." *Opposer's Opposition to Applicant's Motion for Leave to Amend Their Answer to Add Counterclaims ("Opposition to Motion")*, Pg. 2, and argues that Applicants should have known of Opposer's lack of intent to use its pleaded marks, as of Opposer's application filing dates of November 6, 2006 and January 18, 2012, because Opposer allegedly had a website in October, 2014, the time Applicants filed their Answer. Based on the lack of evidence of record and

Opposer's acknowledgement that "Opposer does not have prior specific written evidence regarding its plans for use of this mark", it is clear that Applicants' motion for leave to amend should be granted. *Id.*

### **Opposer's Lack of Evidence of Intent to Use**

In an arguing that there is no basis for the counterclaims, Opposer relies on print-outs from its website, photos from its alleged franchised retail outlets in the U.S., and photos of its trade show display taken allegedly in 2012. None of this evidence, however, supports the position that Opposer had a bona fide intent to use its pleaded marks on each and every one of the goods set forth in its pleaded registrations at least as early as the application filing dates of November 6, 2006 and January 18, 2012.

First, it is not clear when Opposer's website went live, when or if it was available to U.S. consumers, if the website allows a U.S. consumer to purchase goods or when, if ever, a U.S. consumer utilized the site to purchase branded products. It also not clear from the website printouts when any such items first appeared on the site and/or which specific items in Opposer's registrations have appeared or currently appear on Opposer's site. Opposer, rather than enumerating which items in the pleaded registrations supposedly appear on Opposer's site, broadly and vaguely states that "Opposer's website identifies no few than 26 categories of makeup, personal care products and related accessories". *Opposition to Motion, Pg. 1.* Opposer's website is simply not probative on the question of Opposer's intent to use or use in commerce at the time of filing its applications all of the goods set forth in its pleaded registrations.

Second, it is not clear when the photos of Opposer's supposed retail outlets in the U.S. were taken and/or when or which products the pleaded marks are or have been used on.

Third, much like Opposer's website and its photos of its supposed retail outlets, the photos of Opposer's trade show display tell us nothing. Specifically, there is no means for Applicants to identify which goods were branded with the pleaded mark at the supposed trade show or even where the trade show was held. Moreover, the photos seem to be dated in 2010, not 2012 as alleged by Opposer, calling into question the accuracy of the any allegation pertaining to these photos.

In conclusion, the evidence on which Opposer relies is insufficient to show that Opposer had a bona fide intent to use its pleaded marks at the time of filing its U.S. application for registrations for each and every item identified in the issued registrations.

#### **Applicants Abandonment Claim Must Stand**

Opposer does not address Applicants' abandonment claim and, as such, there is no dispute as to whether Applicants' should be granted leave to amend to add a counterclaim for abandonment.

#### **Applicants Claims Are Timely**

Fed. R. Civ. P. 15(a) provides that leave to amend pleadings shall be freely given when justice so requires. As stated by the Board in *Boral Ltd. v. FMC Corp.*, 59 USPQ2d 1701, 1702 (TTAB 2000): "[c]onsistent therewith, the Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the parties." *See also* TBMP §507.02(a).

Here, Petitioner never argues that it will be prejudiced by the requested amendment. Moreover, there will be no actual prejudice to Opposer because as of the date of Applicants filing their Motion for Leave to Amend, discovery was still open, and the testimony period has not even opened. *e.g., United States Olympic Committee v. O-M Bread Inc.*, 26 U.S.P.Q.2d 1221,

1222 (TTAB 1993) (applicant not prejudiced because proceeding still in pre-trial phase); *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 U.S.P.Q.2d 1316, 1318 (TTAB 1992) (motion to amend filed prior to opening of petitioner's testimony period permitted); *Caron Corp. v. Helena Rubinstein, Inc.*, 193 U.S.P.Q. 113 (TTAB 1976) (neither party had yet taken testimony); *Mack Trucks, Inc. v. Monroe Auto Equip. Co.*, 182 U.S.P.Q. 511, 512 (TTAB 1974) (applicant would not be unduly prejudiced since no testimony has yet been taken); TBMP § 507.02(a).

Instead of alleging prejudice, Opposer relies a single argument that Applicants' claims are compulsory counterclaim and that given Opposer's website, Applicants were aware of its counterclaims at the time they filed their Answer. *Opposition to Motion, Pg. 3*. However, such an argument is fatally flawed.

First, there is no evidence of record which supports Opposer's position that its website was active at the time Applicants filed their Answer. Second, even assuming *arguendo*, that Opposer's website was active, it is not clear when Opposer's website went live, when or if it was available to U.S. consumers, if the website allows a U.S. consumer to purchase goods or when, if ever, a U.S. consumer utilized the site to purchase branded products. It also not clear from the website printouts when any such items first appeared on the site and/or which specific items in Opposer's registrations have appeared or currently appear on Opposer's site. Opposer, rather than enumerating which items in the pleaded registrations supposedly appear on Opposer's site, broadly and vaguely states that "Opposer's website identifies no few than 26 categories of makeup, personal care products and related accessories". *Opposition to Motion, Pg. 1*. Opposer's website is simply not probative on the question of Opposer's intent to use at the time of filing its applications or use in commerce of all of the goods set forth in its pleaded registrations. Therefore, the website does not and would not have revealed any facts at the time

of Applicants preparing and filing its Answer which would have given rise to Applicants' counterclaim that Opposer did not have the requisite intent to use at the time of filing back in 2006 and 2012 and/or abandoned its pleaded marks. It was only after reviewing Opposer's deficient discovery responses that Applicants determined they had grounds to petition to cancel the pleaded registrations. As such, Applicants are well within their right to seek leave to amend. See, e.g., *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355, 1359 (TTAB 1989) (counterclaim pleaded promptly after obtaining the information necessary to assert counterclaim during discovery and before discovery had closed); *S & L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221 (TTAB 1987); *M. Aron Corp. v. Remington Products, Inc.*, 222 USPQ 93, 96 (TTAB 1984). See also *J.B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 579 (TTAB 1975) (if applicant learns through discovery that grounds exist for counterclaim, applicant may move to amend answer to assert such counterclaim).

Respectfully submitted,

**EPSTEIN DRANGEL, LLP**

Dated: May 29, 2015

By: \_\_\_\_\_

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**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing **REPLY IN SUPPORT OF APPLICANTS' MOTION FOR LEAVE TO AMEND THEIR ANSWER TO ADD COUNTERCLAIMS** was served by First Class Mail, with sufficient postage prepaid on this 29<sup>th</sup> day of May, 2015, upon Opposer's counsel:

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