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

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| Proceeding | 91231958 |
| Party | Plaintiff Primavera Life GmbH |
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matters of U.S. Application No. 86/873750
for the mark PRIMERA
and Registration No. 3632484
for the mark PRIMAVERA

| | | |
|-----------------------------------|---|----------------------------|
| PRIMAVERA LIFE GMBH, |) | |
| |) | |
| Opposer/Cancellation Defendant, |) | Opposition No.: 91231958 |
| |) | Cancellation No.: 92065305 |
| v. |) | |
| |) | |
| AMOREPACIFIC CORPORATION, |) | |
| |) | |
| Applicant/Cancellation Petitioner |) | |
| |) | |

**OPPOSER/REGISTRANT'S OPPOSITION TO
APPLICANT/CANCELLATION PETITIONER'S MOTION TO STRIKE**

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April 6, 2018

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I. Introduction

Applicant moves to strike the exhibit materials that Opposer included with its reply brief in support of Opposer's Motion for Summary Judgment relating to the captioned proceedings. The objected-to exhibits materials are (1) the Distribution Agreement dated April 30, 2010 and an amendment thereto (entitled "Addition to the Agreement") dated October 22, 2015 that Opposer entered into with its U.S. distributor Nordblom Institute of Rejuvenation (together the "Distribution Agreement"); and (2) extracts of result pages generated by online searches of the Office's Acceptable Identifications of Goods and Services Manual (the "Goods ID Manual") (collectively "the Exhibits") (19 TTABVUE 12-24). Opposer hereby opposes Applicant's Motion to Strike, and argues that the Board should fully consider and assign due weight to the Exhibits for the following reasons.

II. Arguments

A. Consideration of Reply Brief Exhibits Appropriate

The Board in the past has exercised its discretion to rule in favor of considering additional evidence offered with a summary judgment motion reply brief in Board proceedings. *Shalom Children's Wear Inc. v. In-Wear A/S*, 26 USPQ2d 1516, 1517 (TTAB 1993). For example, in the Board's decision in *Action Products, Inc. v. Serta Inc.*, Opposition No. 91203260, 2014 WL 4674998 (TTAB September 4, 2014) (non-precedential), it decided to consider Internet print-out materials submitted with an opposer/summary judgment movant's reply brief because the materials were offered to rebut the applicant's arguments about the similarity of the marks in question. Opposer's submission of the Exhibits with its summary judgment reply brief in this case similarly was in rebuttal of response brief arguments, namely, Applicant's arguments that Opposer had engaged in "naked licensing" in the case of the Distribution Agreement and that a subset of Applicant's goods allegedly fall outside what are

considered “cosmetics” in the case of the Goods ID Manual evidence. Because the Exhibits in this case are analogous to the rebuttal evidence in question in *Action Products* (a non-precedential decision but nevertheless persuasive in this context), the Board similarly should consider the reply brief Exhibits in this case. See also *Mattel, Inc. v. The Brainy Baby Company, LLC*, 101 USPQ 2d 1140 (TTAB 2011) (reply brief exhibits considered as rebuttal evidence, even where the reply brief itself received no consideration).

Applicant argues that the Exhibits are “immaterial, impertinent and improper” and do not have evidentiary value, but the Exhibits merely respond to a new issue and arguments raised in Applicant’s summary judgment response brief and are either verified by Opposer (in the case of the Distribution Agreement) or are self-authenticating official records (in the case of the Goods ID Manual evidence). Accordingly, the Exhibits are relevant and the Board should consider them. It is ironic that Applicant now is characterizing the Distribution Agreement as “irrelevant” and “impertinent” when it complained about Opposer’s not producing the document in its opposition brief.

Applicant cites a number of Board decisions where summary judgment reply brief evidence was disregarded, but the factual circumstances that gave rise to those determinations are distinguishable. In *Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1300 (TTAB 2016) the opposer and summary judgment movant tried to submit new evidence of its trademark usage. In *New Chapter, Inc. v. Olympic Seafood AS*, Opposition No. 91215024, 2015 WL 9906669, at *3 (TTAB July 9, 2015) (non-precedential) the applicant and cross movant for summary judgment submitted evidence of third-party use of an element that comprised the trademark at issue. In *Bosch Auto. Serv. Solutions LLC v. Powermax Battery (U.S.A.), Inc.*, Cancellation No. 92058770, 2014 WL 11034339, at *2 (TTAB Sept. 15, 2014)

(non-precedential) the registrant and cross movant for summary judgment submitted evidence of cancellation petitioner's and a third-party's use of an element that comprised the trademark at issue. The *Seay v. Tenn. Valley Auth.*, 339 F.3d 454, 481 (6th Cir. 2003) decision that Applicant cites involved declaration evidence included with a reply brief.

The substance of the evidence that was disregarded in each of the above-referenced cases involved evidence of difficult-to-verify marketplace trademark usage and declaration evidence, evidence different in kind from the already-identified Distribution Agreement and official record Goods ID Manual evidence at issue here. The Exhibits in comparison are authentic and more reliable on their face than the disregarded evidence at issue in the decisions that Applicant cites and merit consideration.

B. Distribution Agreement Should be Considered Because it is Responsive to New Issue Raised in Applicant's Response Brief

As for the Distribution Agreement, Applicant complained in its summary judgment response brief of Opposer's not having provided a copy of the Distribution Agreement (which Opposer's President Titus Kaufmann had identified in his verified interrogatory responses and declaration included with Opposer's primary brief at 16 TTABVUE 49; Kaufmann Dec. ¶ 3) as part of Opposer's discovery responses or with Opposer's primary brief. Opposer, with its March 8, 2018 reply brief, properly included a copy of the Distribution Agreement (19 TTABVUE 12-24). The reason for Opposer's not having produced the Distribution Agreement copy with its discovery responses or with its primary brief was that it had difficulty locating a signed copy. Opposer produced to Applicant the Distribution Agreement copy as soon as it was able to do so, on February 20, 2018.

For the first time in these proceedings Applicant raised in its response brief the issue/allegation that Opposer had abandoned its PRIMAVERA mark through "naked licensing"

(18 TTABVUE 11). In introducing a copy of the Distribution Agreement for consideration as an exhibit to its reply brief, Opposer did not raise a new issue, introduce a new line of argument or re-argue an already-asserted argument. Opposer's providing that document was directly responsive to Applicant's response brief arguments about a new issue.

Opposer observes that responding to new issues raised in a response brief, such as the naked licensing allegation in this case, is the reason that the reply brief is available as a procedural tool.

C. Distribution Agreement was Sufficiently Authenticated

Opposer did not hide the existence of the Distribution Agreement, nor did it dispute its relevance. In fact, Opposer through Mr. Kaufmann had already entered a declaration under oath identifying the Distribution Agreement (16 TTABVUE 49; Kaufmann Dec. ¶ 3). Moreover, Applicant itself entered Opposer's verified interrogatory replies identifying the document with its summary judgment motion opposition brief (18 TTABVUE 36-37; Joyce Dec. Ex. A; Inter. Responses 9 & 13).

D. Goods ID Manual Evidence was Responsive to Applicant's Response Brief Arguments and Should Be Considered

Turning to the print-outs of the Goods ID Manual search results, those materials, like the Distribution Agreement, directly responded to arguments and issues raised in Applicant's response brief. In particular, Applicant asserted arguments in its response brief citing Federal Food, Drug and Cosmetic Act provisions defining "cosmetic" and Food and Drug Administration regulations interpreting the meaning of "cosmetic" (18 TTABVUE 14, ¶ 1). Opposer submitted its reply brief Goods ID Manual evidence for purposes of countering Applicant's argument and illustrating the understood meaning of "cosmetic" for purposes of trademark law. Opposer's submission of the Goods ID Manual evidence thus was appropriate.

E. Goods ID Manual Evidence Self-Authenticating Official Records

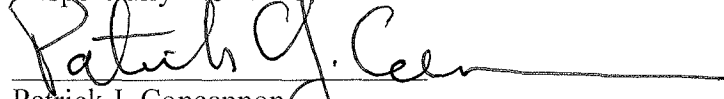
The Goods ID Manual print-out qualifies as a self-authenticating official document under 37 CFR § 2.122(e), and Opposer made the relevance of that evidence clear within its reply brief. In the alternative, Opposer asks the Board to consider the Goods ID Manual print-out in its judicial notice discretion pursuant to 37 CFR § 2.122(a). The accuracy and import of Office's Goods ID Manual contents is generally known and is not subject to reasonable dispute, so consideration of the materials is appropriate. TBMP 704.12(a).

III. Conclusion

Opposer's reply brief and its Exhibits clarified the issues before the Board. While obviously the Board is entitled to assign weight to evidence submitted in support of a summary judgment motion as it sees fit, entire removal of the Exhibits from consideration would impede full and fair consideration of the question as to whether genuine issues of material fact exist for purposes of the pending summary judgment motion.

Dated: April 6, 2018

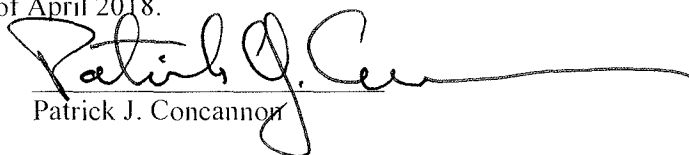
Respectfully submitted,



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CERTIFICATE OF SERVICE

I hereby certify that the foregoing OPPOSER/REGISTRANT'S OPPOSITION TO APPLICANT/CANCELLATION PETITIONER'S MOTION TO STRIKE was served by email upon counsel of record for Applicant/Cancellation Petitioner at detrademarks@dlapiper.com, ann.ford@dlapiper.com, john.nading@dlapiper.com, eunice.chung@dlapiper.com, alberto.zacapa@dlapiper.com on this 6th day of April 2018.



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