

ESTTA Tracking number: **ESTTA892770**

Filing date: **04/26/2018**

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

Proceeding	91231958
Party	Defendant Amorepacific Corporation
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Attachments	Reply ISO Motion to Strike.pdf(30144 bytes )

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

In the matter of Trademark  
Application Serial No. 86873750  
Mark: PRIMERA  
Filed: January 13, 2016  
Published for Opposition: July 5, 2016

In the matter of Trademark  
Registration No. 3632484  
Mark: PRIMAVERA  
Filed: February 7, 2008  
Registered: June 2, 2009

PRIMAVERA LIFE GMBH,	)	
	)	
Opposer/Respondent,	)	
	)	
v.	)	Consolidated Proceeding
	)	Opposition No. 91231958 (parent)
	)	Cancellation No. 92065305
AMOREPACIFIC CORPORATION,	)	
	)	
Applicant/Petitioner.	)	
	)	

**APPLICANT/PETITIONER'S REPLY IN SUPPORT OF MOTION TO STRIKE  
OPPOSER/RESPONDENT'S EXHIBITS TO ITS  
REPLY TO ITS MOTION FOR SUMMARY JUDGMENT**

## I. INTRODUCTION

Applicant/Petitioner Amorepacific Corporation (“Amorepacific”), by and through counsel, respectfully files this Reply in support of its Motion to Strike (“Motion”) (20 TTABVUE) Opposer/Respondent Primavera Life GmbH’s (“PLG”) Exhibits A and B (“Exhibits”) to PLG’s Reply in support of its Motion for Summary Judgment (“Reply”) (19 TTABVUE) in the above-captioned proceeding. Amorepacific’s Motion should be granted because PLG’s Exhibits are immaterial, impertinent, and improper as they were not part of PLG’s opening Motion for Summary Judgment (16 TTABVUE), and thus foreclosed Amorepacific’s opportunity to respond thereto. T.B.M.P. § 517; Fed. R. Civ. P. 12(f).

## II. ARGUMENT

PLG argues that attaching two new Exhibits to its Reply was proper because PLG was merely responding to Amorepacific’s arguments in its Opposition to PLG’s Motion for Summary Judgment (“Opposition”) (18 TTABVUE). Specifically, PLG argues that Exhibit A, comprised of two purported print-outs from the United States Patent and Trademark Office’s (“USPTO”) *Acceptable Identification of Goods and Services Manual*, allegedly reflecting PLG’s searches for “soap cosmetic” and “cosmetic bath” (19 TTABVUE 12-13), and that Exhibit B, a purported distribution agreement between PLG and “Nordblom Inst. of Rejuvenation” (19 TTABVUE 14-24), should not be considered new evidence and could not have been submitted with PLG’s Motion for Summary Judgment.

PLG’s argument defies reason and the rules and case law of the U.S. Trademark Trial and Appeal Board (“Board”). First, parties are not allowed to submit new evidence in support in a reply brief, particularly evidence that is not verified. *See Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1300 n.18 (TTAB 2016); *Kellogg Co. v. Pack’Em Enters. Inc.*, 14 USPQ2d 1545, 1549 n.9 (TTAB 1990), *aff’d*, 951 F.2d 330, 21 USPQ2d 1142

(Fed. Cir. 1991); *Seay v. Tenn. Valley Auth.*, 339 F.3d 454, 481 (6th Cir. 2003); *Provenz v. Miller*, 102 F.3d 1478, 1483 (9th Cir. 1996). *See also* 37 C.F.R. § 2.123(b) (parties may only introduce testimony by declaration or affidavit upon written stipulation).

While PLG argues that the Board may, in its discretion, accept evidence submitted with reply briefs (*see* 21 TTABVUE 5), this is an exception to the rule that does not change the prohibition of such practice. Further, in those rare exceptions, the Board often makes a ruling not based on the improper submission, even if it was ultimately considered. *See Action Prods., Inc. v. Serta Inc.*, Opposition No. 91203260, 2014 WL 4674998, at \* 4 n. 7 (TTAB Sept. 4, 2014) (noting that “irrespective of and independent of our rulings regarding opposer’s exhibits, applicant has made a showing (as further discussed below) that indicates the existence of genuine disputes that preclude granting to opposer judgment as a matter of law with respect to likelihood of confusion”).

Second, the cases PLG tries to distinguish absolutely apply here. PLG argues that the reply evidence which the Board refused to consider in *Omega SA*, 118 USPQ2d at 1300 n.18, was trademark use evidence and therefore different. But PLG’s distinction is inapposite: There is no meaningful difference between late submission of evidence reflecting use of a trademark in a likelihood of confusion and dilution case, and late submission of a purported distribution agreement in a naked licensing case, where both sets of evidence are presented to resolve issues of fact on dispositive questions of law.

Moreover, the third-party use evidence submitted in *New Chapter, Inc. v. Olympic Seafood AS*, Opposition No. 91215024, 2015 WL 9906669, at \*3 (TTAB July 9, 2015) (non-precedential) (20 TTABVUE 10-14) and 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) (20 TTABVUE 16-19), is no different than PLG’s submission of its

own tailored searches for “soap cosmetic” and “cosmetic bath” in the USPTO’s *Acceptable Identifications of Goods and Services Manual*.

Further, the declaration improperly submitted with the reply in *Seay v. Tenn. Valley Auth.*, 339 F.3d 454, 481 (6th Cir. 2003), is no different than PLG’s reliance on the declaration submitted by Titus Kaufman, PLG’s Chief Executive Officer (“Kaufman Declaration”) (16 TTABVUE 49, ¶ 3), in support of PLG’s Motion for Summary Judgment, which PLG uses to verify the newly submitted distribution agreement.

Thus, the case law prohibits PLG from offering new evidence in a reply or couching such evidence as mere argument rebutting Amorepacific’s Opposition. Indeed, PLG could have simply responded to Amorepacific’s Opposition without the Exhibits if that was all PLG intended to do, or could have attached the evidence to its original Motion for Summary Judgment.

Third, PLG is improperly asking the Board to draw conclusions of fact from the newly submitted Exhibits. For example, PLG states that Exhibit B, the purported distribution agreement, is the agreement alluded to in the Kaufman Declaration in support of PLG’s Motion for Summary Judgment. But the Kaufman Declaration does not state this fact, nor does the Declaration resolve the questions of whether there are any other distribution or licensing agreements at issue (indeed, the Kaufman Declaration refers to an additional distributor and licensee, Saffron Rouge) (16 TTABVUE 49-50, ¶¶ 3, 5, 8), whether PLG has any quality control over its PRIMAVERA mark, or even whether PLG really does send its finished product bearing the PRIMAVERA mark to its distributor as PLG claims in its Reply to its Motion for Summary

Judgment.<sup>1</sup> (19 TTABVUE 10). PLG cannot rely on the bare-boned statements in the Kaufman Declaration to support the findings of fact that PLG argues the Board should make. *See Ashe v. Corley*, 992 F.2d 540, 544 (5th Cir. 1993) (finding conclusory statements are insufficient to support a motion for summary judgment); T.B.M.P. § 517; Fed. R. Civ. P. 12(f). *See also* 37 C.F.R. § 2.123(b).

PLG also cannot rely on the Kaufmann Declaration to refute its statements in its discovery responses, where PLG has admitted it does not have knowledge or control of its channels of trade and “downstream retail settings” for the PRIMAVERA mark (18 TTABVUE 26; ¶ 7; Ex. A, Answer to Interrogatory No. 9), that “promotional campaigns are carried out by distributors, the expenses for which are outside PLG’s knowledge and control” (*id.*; Ex. A; Answer to Interrogatory No. 12), and that PLG has no documents advertising the PRIMAVERA mark in its control (*id.*; Ex. B; Response to Document Request No. 16).

Further, with Exhibit B, PLG is also improperly asking the Board to assume that PLG could not have included its searches for “soap cosmetic” and “cosmetic bath” with its Motion for Summary Judgment or that somehow these searches preclude listing soap goods for a mark without a cosmetic description. Such submissions are not proper for all of the reasons set forth above. *See Omega SA*, 118 USPQ2d at 1300 n.18; *Ashe*, 992 F.2d at 544; T.B.M.P. § 517; Fed. R. Civ. P. 12(f).

Accordingly, PLG’s Exhibits are immaterial, impertinent, and improper for having been attached to PLG’s Reply where Amorepacific did not have a chance to respond. Thus, the Board

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<sup>1</sup> Kaufman merely states: “Primavera Life in the past has sold personal care and essential oils products under the PRIMAVERA mark in the U.S. via its distributors Saffron Rouge and Nordblom American Institute of FootZonology, Inc. (“Nordblom”). Presently Primavera Life’s use of its PRIMAVERA mark entails its transporting and selling its personal care and essential

(continue)

should not take this new material into evidence or otherwise consider it. T.B.M.P. § 517; Fed. R. Civ. P. 12(f).

### III. CONCLUSION

For the foregoing reasons, the Board should grant Amorepacific's Motion and strike PLG's Exhibits to its Reply.

Dated: April 26, 2018

Respectfully submitted,

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(continued)  
oils products to Nordblom, which distributes the products in U.S. commerce.” (16 TTABVUE 49, ¶ 3).

**CERTIFICATE OF SERVICE**

This is to certify that a copy of the foregoing **APPLICANT/PETITIONER'S REPLY IN SUPPORT OF MOTION TO STRIKE OPPOSER/RESPONDENT'S EXHIBITS TO ITS REPLY TO ITS MOTION FOR SUMMARY JUDGMENT** was served via email to counsel of record:

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this 26th day of April, 2018.

/s/ Ann K. Ford  
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