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

Proceeding	91233046
Party	Defendant Sesderma, S.L.
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UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Mediderm Laboratories, LLC,

Opposer/Counter-Respondent,

v. Opposition No. 91233046

Sesderma, S.L.,

Applicant/Counter-Petitioner,

_____)

SESDERMA'S REPLY IN SUPPORT OF SESDERMA'S MOTION FOR SUMMARY JUDGMENT

Applicant/Counter-Petitioner Sesderma S.L. (hereinafter "Sesderma") responds as follows to Opposer/Counter-Respondent Mediderm Laboratories LLC's (hereinafter "Mediderm") Cross-Motion for Summary Judgment.

ARGUMENT

I. MEDIDERM'S OBJECTION TO INVOICES IN SPANISH IS UNTIMELY AS IT WAS NOT RAISED IN DISCOVERY AND SESDERMA HAS NO OBLIGATION TO TRANSLATE DOCUMENTS

Sesderma's invoices presented in Exhibit GS-1 are the same exhibits that Sesderma produced during discovery. Mediderm in its Response cites TBMP 104 stating "Board proceedings are conducted in English. If a party intends to rely upon any submissions that are not in a language other than English, the party should also file a translation of the submissions. If a translation is not filed, the submissions may not be considered." Mediderm has overlooked that

its citation refers to submissions that are *filed*. The invoices in question showing Sesderma's priority were served and Mediderm thus had ample opportunity to object, translate the documents, and/or request Sesderma to translate the documents, none of which it did. Also, it would not be fair to allow Mediderm to untimely object as it would unnecessarily delay the proceedings causing undue delay and hardship to Sesderma since the invoices are clear to read, including the dates, marks, and areas sold. Furthermore, there have been no representations by Mediderm as to whether or not they already translated the documents or that they have employees or agents that are fluent in Spanish and they were able to understand the contents of the documents. Sesderma's allegations of use are undisturbed except for challenging the documents introduced as exhibits for not having been translated and due to the entity named in the evidence of use as not being a party in these proceeding. Importantly, the authenticity of the invoices provided to demonstrate prior use have not been challenged and thus Mediderm has consented to their genuineness.

II. MEDIDERMA, S.L. IS A PREDECESSOR IN INTEREST OF SESDERMA AND THUS THE BENEFIT OF ITS USE SHOULD INURE TO SESDERMA

With respect to the second objection, the entity named in the invoices, Mediderma S.L., is a predecessor in interest and related company of Applicant/Counter-Petitioner Sesderma S.L. 37 USC § 1127 provides, "the terms "applicant" and "registrant" embrace the legal representatives, predecessors, successors and assigns of such applicant or registrant." Section 5 of the Trademark Act, states, in part, as follows:

> Where a registered mark or a mark sought to be registered is or may be used legitimately by related companies, such use shall inure to the benefit of the registrant or applicant for registration, and such use shall not affect the validity of such mark or of its registration, provided such mark is not used in such manner as to deceive the public.

15 U.S.C. §1055. Therefore, §5 of the Act permits applicants to rely on use of the mark by related companies; either a natural person or a juristic person may be a related company. Sesderma disclosed the existence of Mediderma S.L. in its response to Mediderm's First Set of Interrogatories stating,

> Sesderma Group was founded in 1989 in Valencia Spain by a group of dermatologists lead by Dr. Gabriel Serrano. MEDIDERMA was created to address the needs of the Dermatologist professional practice and Sesderma for the end consumer. In 1993, Dr. Serrano created Mediderma SL. Petitioner has a professional team under it marketing department, which develops the strategy and design of names and logos for the marks. Petitioner conducts a pre-sales advertising campaign, announcements to consumers including dermatologists, and features displays prior to placing products on the shelves.

Response to Request No. 2 of Mediderm's First Set of Interrogatories. Furthermore, Sesderma's application states, "the mark was first used by the applicant or the applicant's related company or licensed predecessor in interest at least as early as 4/20/2012, and first used in commerce at least as early as 4/20/2012". Therefore, there are no issues of material fact that would prevent the issues of a judgment and petitioners favor. On that basis, Applicant/Counter-Petitioner is entitled to a favorable judgment as a matter of law.

Notwithstanding the above, in the Declaration of Lina Twaian, Mediderm's principal Ms. Twaian alleges use in interstate commerce at least as early as February 2, 1999 for the mark MEDIDERM for "marketing and selling a variety of cosmetics, skin care, and hair care goods as well as for private label and contract manufacturing and retail sales services of cosmetics, skin care, and hair care goods". DE 10, p. 20. Ms. Twaian includes in her declaration Invoice No. 1001, purportedly provided as documentary support for its first use in commerce date. That invoice is addressed to an individual/entity in California, the same state where Mediderm is

located as can also be noted on the invoice. As the sale and transportation of goods took place within the same state, this is not sufficient evidence of interstate commerce. 15 USC 1127.

Mediderm's catalogs and promotional material submitted as Exhibit 7 in support of its declaration also lack dates and there is no indication on the declaration itself when said catalogs were made available to the public.

III. SESDERMA'S TRADEMARKS

1. Sesderma's Pending U.S. Application for MEDI+DERMA

Mediderm contends that in pending U.S. application Serial No. 86/817,072 for the mark MEDI+DERMA, Sesderma listed December 12, 2000 as its date of first use in commerce. This is inaccurate and misleading. In U.S. application Serial No. 86/817,072, Sesderma declared that it had use in commerce of the mark MEDI+DERMA *at least as early as* December 12, 2000. See pages 57 and 60 of Exhibit C of Declaration of Kamran Fattahi. In its motion for summary judgment, Sesderma has provided ample evidence through invoices and the declaration of Dr. Gabriel Serrano of Sesderma's use in commerce of MEDI+DERMA and MEDIDERMA for cosmetics and for wholesale and retail store services featuring cosmetics since at least as early as 1997.

Mediderma also makes mention that Sesderma has never filed a trademark application for the variant MEDIDERMA. While this is true, this does not preclude Sesderma's superior common law rights to the mark MEDIDERMA in the vast geographic areas where Sesderma has sales prior to Mediderm's application filing date.

2. Sesderma's U.S. Registration for MEDI+DERMA BY SESDERMA

Mediderm alleges that in Sesderma's U.S. Registration for MEDI+DERMA BY SESDERMA, Sesderma claimed a date of first use and first use in commerce of April 20, 2012. Mediderm further alleges that Sesderma stated similarly in its Second Amended Petition for Cancellation. Both of these allegations are inaccurate and misleading. In the U.S. application for MEDI+DERMA BY SESDERMA, Sesderma declared that it had use in commerce of the mark MEDI+DERMA BY SESDERMA *at least as early as* April 20, 2012. See pages 24 and 26 of Exhibit E of Declaration of Kamran Fattahi. Similarly, in the Second Amended Petition, Sesderma also uses the language "at least as early as" rather than first use date. In its motion for summary judgment, Sesderma has provided ample evidence through invoices and the declaration of Dr. Gabriel Serrano of Sesderma's use in commerce of its marks for cosmetics and for wholesale and retail store services featuring cosmetics since at least as early as 1997.

IV. MEDIDERM'S FIRST SET OF REQUESTS FOR ADMISSION TO SESDERMA

Mediderm's further contends that it served on Sesderma a First Set of Requests for Admission, on November 30, 2016 but they have never been responded to (see Fattahi Decl. ¶¶ 3-4). Sesderma and its counsel never received Mediderm's First Set of Requests for Admission. See Sesderma's "Motion for Leave from Suspension Order to Serve Applicant's Responses to Opposer's Requests for Admission Purportedly Served on Applicant/Counterclaim-Plaintiff" and declaration by counsel in support thereof. It would be unfair to deem that the assertions in the requests were admitted by Applicant when it did not have an opportunity to respond.

V. CONCLUSION

A. There Is a Likelihood of Confusion Between the Parties' Marks

Pursuant to Mediderm's Response, both parties have now agreed that there is a likelihood of confusion between the parties' marks. See DE 10 "Mediderm's Response to Motion for Summary Judgment", pp. 10-11; and DE 1 "Notice of Opposition", par. 11.

B. Mediderm's First Set of Requests for Admissions Should Not Be Deemed Admitted.

Sesderma and its counsel never received Mediderm's First Set of Requests for Admission allegedly served on November 30, 2016. See Sesderma's "Motion for Leave from Suspension Order to Serve Applicant's Responses to Opposer's Requests for Admission Purportedly Served on Applicant/Counterclaim-Plaintiff" and declaration by counsel in support thereof. It would be unfair to deem that the assertions in the requests were admitted by Applicant when it did not have an opportunity to respond.

C. Sesderma Should Prevail on the Issue of Priority

Mediderm's argument that it should prevail based on the issue of priority is based mostly on the assertion that Mediderm's First Set of Requests for Admission should be deemed legally admitted. As mentioned above, it would be unfair to deem the requests admitted as Sesderma and its counsel never received a copy of the said requests for admission.

Furthermore, Sesderma has provided evidence through invoices and the declaration of Sesderma's founder, owner, and CEO, Dr. Gabriel Serrano, of Sesderma's use in commerce of MEDIDERMA, MEDI+DERMA, and MEDI+DERMA BY SESDERMA for cosmetics and for wholesale and retail store services featuring cosmetics since at least as early as 1997. Sesderma

has prior and continuous use of its marks, MEDIDERMA, MEDI+DERMA, and MEDI+DERMA BY SESDERMA prior to Respondent Mediderm's filing date of April 21, 2012 for Reg. No. 4257206 and prior to Respondent Mediderm's adoption of the mark.

Based on the foregoing reasons, Sesderma has prior rights to its marks and there is a likelihood of confusion between Mediderm's MEDIDERM mark and Sesderma's MEDIDERMA, MEDI+DERMA and MEDI+DERMA BY SESDERMA marks. Accordingly, Mediderm's cross-motion for summary judgment should be denied and Sesderma's motion for summary judgment should be granted.

Dated: September 25, 2017 Respectfully submitted,

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true and correct copy of the foregoing was served via email on this 25th day of September 2017 to:

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