

ESTTA Tracking number: **ESTTA320965**

Filing date: **12/09/2009**

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

**Petition for Cancellation**

Notice is hereby given that the following parties request to cancel indicated registration.

**Petitioner Information**

Name	MERZ PHARMACEUTICALS, LLC		
Entity	Limited Liability Company	Citizenship	North Carolina
Address	4215 Tudor Lane Greensboro, NC 27410 UNITED STATES		

Name	MERZ, INCORPORATED		
Entity	Corporation	Citizenship	North Carolina
Address	4215 Tudor Lane Greensboro, NC 27410 UNITED STATES		

Attorney information	Sarah Robertson Dorsey & Whitney LLP 250 Park Avenue, Floor 15 New York, NY 10177 UNITED STATES ny.trademark@dorsey.com, deinard.lile@dorsey.com, robertson.sarah@dorsey.com		
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**Registration Subject to Cancellation**

Registration No	3608042	Registration date	04/21/2009
Registrant	MONTANI COSMETICS INC 333 NORTH MICHIGAN AVE, SUITE #528 CHICAGO, IL 60601 UNITED STATES		

**Goods/Services Subject to Cancellation**

Class 003. First Use: 2008/02/20 First Use In Commerce: 2008/02/20 All goods and services in the class are cancelled, namely: COSMETICS AND CLEANING PREPARATIONS, namely, beauty creams, beauty lotions, and facial bars
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**Grounds for Cancellation**

Priority and likelihood of confusion	Trademark Act section 2(d)
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**Marks Cited by Petitioner as Basis for Cancellation**


U.S. Registration No.	2360460	Application Date	07/03/1995
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Registration Date	06/20/2000	Foreign Priority Date	NONE
Word Mark	MEDERMA		
Design Mark	<b>MEDERMA</b>		
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 2000/03/03 First Use In Commerce: 2000/03/03 skin care products, namely, essential oils for personal use		

U.S. Registration No.	2464771	Application Date	10/10/1996
Registration Date	07/03/2001	Foreign Priority Date	NONE
Word Mark	MEDERMA		
Design Mark	<b>MEDERMA</b>		
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1997/04/04 First Use In Commerce: 1997/04/04 cosmetic and cleaning preparations, namely, a gel, cream, or ointment designed to improve the appearance of scars, blemishes, and other skin imperfections Class 005. First use: First Use: 1997/04/04 First Use In Commerce: 1997/04/04 pharmaceuticals, namely, a gel, cream, or ointment designed to improve the appearance of scars, blemishes, and other topical imperfections		

U.S. Application No.	76635447	Application Date	04/08/2005
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	MEDERMA SKIN CARE FOR LIFE		
Design Mark	<b>MEDERMA SKIN CARE FOR LIFE</b>		
Description of Mark	NONE		
Goods/Services	Class 003. First use: Non-medicated cosmetic and cleaning preparations for skin, namely, gels, creams, and ointments for improving the appearance of scars, blemishes, and		

	<p>other skin imperfections  Class 005. First use:  Pharmaceuticals, namely, gels, creams, and ointments designated to improve the appearance of scars, blemishes, and other skin imperfections</p>
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U.S. Registration No.	3139600	Application Date	09/16/2004
Registration Date	09/05/2006	Foreign Priority Date	NONE
Word Mark	MEDERMA FOR KIDS		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use: First Use: 2004/12/15 First Use In Commerce: 2004/12/15  Non-medicated cosmetic and cleaning preparations for skin, namely, a gel, cream, and ointment for improving the appearance of scars, blemishes, and other skin imperfections</p> <p>Class 005. First use: First Use: 2004/12/15 First Use In Commerce: 2004/12/15  Pharmaceuticals, namely, a gel, cream, and ointment designed to improve the appearance of scars, blemishes, and other skin imperfections</p>		

U.S. Registration No.	3233153	Application Date	06/14/2006
Registration Date	04/24/2007	Foreign Priority Date	NONE
Word Mark	MEDERMA		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 005. First use: First Use: 1997/04/04 First Use In Commerce: 1997/04/04  Pharmaceuticals, namely, a gel, cream, or ointment designed to improve the appearance of scars, blemishes, and other topical imperfections</p>		

Attachments	74696128#TMSN.gif ( 1 page )( bytes ) 75179474#TMSN.gif ( 1 page )( bytes ) 76635447#TMSN.gif ( 1 page )( bytes ) 76611608#TMSN.gif ( 1 page )( bytes ) 78908193#TMSN.jpeg ( 1 page )( bytes ) Petition for Cancellation.pdf ( 6 pages )(195814 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/sr/
Name	Sarah Robertson
Date	12/09/2009

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

In the Matter of Trademark Registration No. 3,608,042  
For the Mark MEDERMIS & Design  
Registered on April 21, 2009

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: MERZ PHARMACEUTICALS, LLC and :  
: MERZ, INCORPORATED, : Cancellation No.  
: :  
: Petitioners, :  
: :  
: - against - :  
: :  
: MONTANI COSMETICS INC., : PETITION FOR  
: : CANCELLATION  
: Registrant. :  
: :  
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Merz, Incorporated, a North Carolina corporation (“Merz”), and its wholly owned subsidiary Merz Pharmaceuticals, LLC, a North Carolina limited liability company (“Merz Pharmaceuticals”), each having a principal place of business at 4215 Tudor Lane, Greensboro, North Carolina 27410 (hereinafter, collectively, “Petitioner”) believe they will be damaged by the above-identified registration owned by Montani Cosmetics Inc., an Illinois corporation doing business at 333 North Michigan Avenue, Suite #528, Chicago, Illinois 60601 (“Registrant”), and hereby petition to cancel the same.

The grounds for cancellation are as follows:

1. Registrant has obtained a registration for MEDERMIS & Design for “cosmetics and cleaning preparations, namely, beauty creams, beauty lotions, and facial bars,” in International Class 3 (the “Registration”). The Registration issued on April 21, 2009.

2. Since long prior to February 25, 2008, the date Registrant filed its application upon which the Registration sought to be cancelled herein is based, and since long prior to February 20, 2008, the first use date claimed by Registrant in such application, Petitioner has engaged in the development, manufacture, advertising, distribution and sale in interstate commerce of, *inter alia*, non-medicated and medicated skin care products bearing the trademark MEDERMA® and related trademarks.

3. The trademark MEDERMA was adopted by Petitioner as a trademark for skin products as early as April 4, 1997. Petitioner has used the trademark MEDERMA continuously for over twelve (12) years in connection with said goods in interstate commerce by applying labels bearing the trademark to the goods and to the packages in which said goods are shipped and sold, by displaying representations of the trademark in advertising and in other ways customary to the trade.

4. Merz and/or its wholly owned subsidiary Merz Pharmaceuticals are the owners of the entire right, title and interest in and to the trademark MEDERMA and related marks as evidenced by the following:

<u>Mark</u>	<u>Reg./ Appl. Serial No.</u>	<u>Reg. / Appl. Date</u>	<u>Goods</u>
MEDERMA	Reg. No. 2,360,460	June 20, 2000	"Skin care products, namely, essential oils for personal use," in International Class 3
MEDERMA (Stylized)	Reg. No. 2,464,771	July 3, 2001	"Cosmetic and cleaning preparations, namely, a gel, cream, or ointment designed to improve the appearance of scars, blemishes, and other skin imperfections," in International Class 3; and "Pharmaceuticals, namely, a gel, cream, or ointment designed to improve the appearance of scars, blemishes, and other topical imperfections," in International Class 5

MEDERMA SKIN CARE FOR LIFE	Appl. Serial No. 76/635,447	April 8, 2005	<i>“Non-medicated cosmetic and cleaning preparations for skin, namely, gels, creams, and ointments for improving the appearance of scars, blemishes, and other skin imperfections,”</i> in International Class 3; and <i>“Pharmaceuticals, namely, gels, creams, and ointments designated to improve the appearance of scars, blemishes, and other skin imperfections,”</i> in International Class 5
MEDERMA FOR KIDS (Stylized)	Reg. No. 3,139,600	Sept. 5, 2006	<i>“Non-medicated cosmetic and cleaning preparations for skin, namely, a gel, cream, and ointment for improving the appearance of scars, blemishes, and other skin imperfections,”</i> in International Class 3; and <i>“Pharmaceuticals, namely, a gel, cream, and ointment designed to improve the appearance of scars, blemishes, and other skin imperfections,”</i> in International Class 5
MEDERMA	Reg. No. 3,233,153	April 24, 2007	<i>“Pharmaceuticals, namely a gel, cream, or ointment designed to improve the appearance of scars, blemishes, and other topical imperfections,”</i> in International Class 5

The above-identified registrations on the Principal Register of the U.S. Patent and Trademark Office are in all respects valid, subsisting and owned by Petitioner. Further, U.S. Reg. Nos. 2,464,771 and 2,360,460 are incontestable pursuant to 15 U.S.C. §1065.

5. Petitioner has spent and continues to spend large sums of money on the advertisement and promotion of the goods bearing the mark MEDERMA and related marks, and by reason of such advertising and the high quality of the goods carrying these marks, Petitioner enjoys a valuable goodwill and an enviable reputation with respect to the MEDERMA marks in question.

6. Petitioner’s trademark MEDERMA is a distinctive and well-known mark and became well-known long prior to the filing date of the application upon which the Registration sought to be cancelled herein is based and the date of first use claimed in such Registration.

7. Petitioner's MEDERMA trademark and Registrant's MEDERMIS & Design trademark are confusingly similar in sight, sound and meaning. Further, Petitioner's non-medicated and medicated skin care products bearing the MEDERMA trademark and the goods covered by the Registration, which include skin creams and lotions, are identical and/or very closely related.

8. As a result of the foregoing, the purchasing public familiar with Petitioner's products bearing Petitioner's MEDERMA trademarks are likely to be confused, misled or deceived into thinking the MEDERMIS products of Registrant are products of Petitioner or are in some way sponsored by or connected with Petitioner, to Petitioner's irreparable damage and injury, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

9. Registrant falsely represented to Petitioner in writing in July 2008 that Registrant would not be pursuing registration of its MEDERMIS & Design mark based on the close similarities between this mark and existing marks, namely, Petitioner's MEDERMA mark. Registrant's aforesaid letter to Petitioner is annexed hereto as Exhibit A and made a part hereof. Contrary to Registrant's representation that it would not pursue registration of "MEDERMIS," Registrant did, in fact, pursue such registration. As a consequence, Registrant obtained its registration in bad faith by employing fraudulent pretenses, and making false representations to Petitioner, and Petitioner has been damaged thereby.

WHEREFORE, Petitioner respectfully prays that Trademark Registration No. 3,608,042 be cancelled.



Please recognize as attorneys for Petitioner in this proceeding Lile H. Deinard, Sarah Robertson and Jose Hernandez, members of the Bar of the State of New York, whose address is Dorsey & Whitney LLP, 250 Park Avenue, New York, New York, 10177, telephone number (212) 415-9200.

Dated: New York, New York  
December 8, 2009

DORSEY & WHITNEY LLP

By:         /lhd/          
Lile H. Deinard  
Sarah Robertson  
250 Park Avenue  
New York, New York 10177  
(212) 415-9200

Attorneys for Petitioner  
Merz Pharmaceuticals, LLC  
Merz, Incorporated

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

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MERZ PHARMACEUTICALS, LLC and :  
MERZ, INCORPORATED, :  
 :  
Petitioners, : Cancellation No.  
 :  
v. :  
 :  
MONTANI COSMETICS INC., :  
 :  
Respondent. :  
\_\_\_\_\_ x

**CERTIFICATE OF SERVICE**

I hereby certify that the foregoing Petition for Cancellation is being served upon the counsel for Respondent by sending a true copy thereof via First Class Mail, addressed to:

Charles T. Riggs Jr.  
Patula & Associates, P.C.  
14th Floor  
116 S. Michigan Ave.  
Chicago IL 60603

December 9, 2009



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Svetlana Korzhin  
Trademark Paralegal