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

Proceeding	92051832
Party	Plaintiff MERZ PHARMACEUTICALS, LLC and MERZ INCORPORATED
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Submission	Other Motions/Papers
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Date	07/19/2010
Attachments	PET AMD TO PAR 9 OF PET FOR CANCEL.pdf (14 pages)(159249 bytes)

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, : Cancellation No. 92051832
 :
Petitioners, :
 :
- against - :
 :
MONTANI COSMETICS INC., :
 :
Registrant. :
 :
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**PETITIONERS' AMENDMENT TO PARAGRAPH 9 OF PETITIONERS'
AMENDED PETITION FOR CANCELLATION PURSUANT TO ORDER
OF THE TRADEMARK TRIAL AND APPEAL BOARD DATED JUNE 25, 2010**

Petitioners Merz Pharmaceuticals, LLC and Merz, Incorporated (collectively, "Petitioner") by their undersigned counsel, hereby make this submission in response to the June 25, 2010 Order of the Trademark Trial and Appeal Board requesting Petitioner to amend the allegations contained in paragraph 9 of its Amended Petition for Cancellation. In compliance with such Order, Petitioner submits herewith its Second Amended Petition for Cancellation incorporating Petitioner's amendments to paragraph 9 thereof (attached as Exhibit 1).

DORSEY & WHITNEY LLP

Dated: July 19, 2010

By: _____ /lhd/

Lile H. Deinard
Sarah Robertson
250 Park Avenue
New York, New York 10177
(212) 735-0788

Attorneys for Petitioners
Merz Pharmaceuticals, LLC and Merz
Incorporated

EXHIBIT 1

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

	X	
MERZ PHARMACEUTICALS, LLC and MERZ INCORPORATED,	:	
Petitioners,	:	Cancellation No. 92051832
- against -	:	
MONTANI COSMETICS INC.,	:	SECOND AMENDED PETITION <u>FOR CANCELLATION</u>
Registrant.	:	
	X	

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	“ <i>Skin care products, namely, essential oils for personal use,</i> ” in International Class 3
MEDERMA (Stylized)	Reg. No. 2,464,771	July 3, 2001	“ <i>Cosmetic and cleaning preparations, namely, a gel, cream, or ointment designed to improve the appearance of scars, blemishes, and other skin imperfections,</i> ” in International Class 3; and “ <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

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. The President of Registrant sent to Petitioner Merz Pharmaceuticals, LLC and its German parent company, Merz GmbH & Co. KGaA, an unsolicited letter dated July 22, 2008 which stated that Registrant "was [aware] that registration [of its Medermis mark] might not be obtained given close similarities with existing marks"; that "the U.S. Patent and Trademark Office's [had] recently indicated... that [the Medermis mark] would not be registrable due to likelihood of confusion with other existing marks, namely, Mederma®, a trademark registered by Merz"; that Registrant "[had] opted not to pursue this registration" as a result; and that "Medermis is sold at retail within very close proximity of brands such as Mederma in major retailers such as Walgreens." Registrant's July 22, 2008 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 vigorously prosecute its application to registration, which Petitioner now seeks to cancel. As a consequence, Registrant obtained its

EXHIBIT A



Skin Care

Montani Cosmetics, Inc.

333 N. Michigan Avenue, Suite 528, Chicago, Illinois 60601 USA
Tel: (312) 201 1700 Fax: (312) 201 0600
E-mail: sales@dermisa.com www.dermisa.com

July 22, 2008

Legal Department
Merz Pharmaceuticals, LLC
P.O. Box 18806
Greensboro, North Carolina 27419

To whom it may concern:

I am Jaime Valle, President of Montani Cosmetics Inc., writing to you in connection with the registration of the trademark Medermis in the USA.

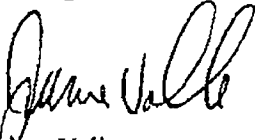
Earlier this year, we initiated the trademark registration process for the Medermis mark with the awareness that registration might not be obtained given close similarities with existing marks. Indeed, the United States Patent and Trademark Office recently indicated to us, on a preliminary basis, that it would not be registrable due to "likelihood of confusion" with other existing marks, namely Mederma®, a trademark registered by Merz (International Classification 03).

Given this preliminary ruling, we have opted not to pursue this registration. However, and to our surprise, we have just come across the recent introduction of the Medermis Skin Care line of products in Puerto Rico (see advertisement attachment). According to our unofficial sources, this trademark supposedly was granted registration within the territory of Puerto Rico. We are perplexed that such Trademark and Patent Office would grant and allow use of this mark without similar consideration by stateside USPTO given that Puerto Rico is considered U.S. territory for commercial purposes.

Furthermore, the fact that this new product line, Medermis, is sold at retail within very close proximity of brands such as Mederma in major retailers such as Walgreens is even more confusing to us. As a matter of reference, the company marketing the Medermis Skin Care line in Puerto Rico is MC Brands Corp. (DBA Morales Distributors Inc.) located in Parque Industrial Guanajibo, Calle W.F. Brennan 1100, Suite 4, Mayaguez, Puerto Rico, 00682, tel 787 805-3775. The principal of the firm is Mr. Luis Morales Caro, President. It is also our understanding that initial efforts have begun to introduce this product line within mainland USA in the New York/New Jersey territories channeling the Medermis Skin Care product line through distributors and wholesalers reaching the Hispanic consumers.

Should you require additional information please feel free to contact me.

Best regards,



Jaime Valle
President

Cc: Merz GmbH - Legal Department, Frankfurt, Germany
Fax 011-49-69-1503-200

Medermis® SKIN CARE

¡Muéstrate segura con tu cuerpo libre de manchas!

PASO

1



Jabón Exfoliante y Anti-Bacterial

Acelera la eliminación de las células muertas y ayuda a combatir las manchas al mismo tiempo limpia a profundidad la epidermis y reduce la cantidad de bacterias en la piel.

PASO

2



Crema Anti-Manchas

Es una crema no grasosa creada para ayudar a acelerar y eliminar manchas oscuras (hiperpigmentación) y pecas manteniendo una tonalidad pareja en la piel.

PASO

3

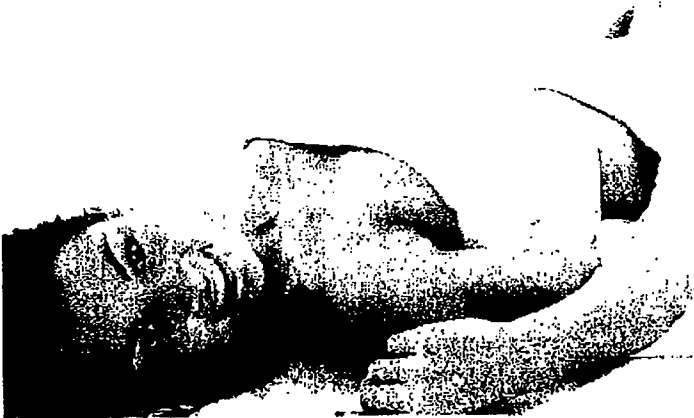


Loción Hidratante Anti-Manchas

Fórmula que ayuda a eliminar manchas y empareja la tonalidad de la piel mientras la mantiene humectada y radiante. Ideal para eliminar manchas e hidratar manos, codos y rodillas.



Medermis[®]
SKIN CARE



Tratamiento completo para eliminar las manchas en la piel de todo el cuerpo.

El tratamiento completo Medermis Skin Care contiene ingrediente aclarador seguro y efectivo (Hidroquinona) aprobado por el FDA, el cual se absorbe suavemente y rápidamente en la capa dermis de la piel donde forman las manchas oscuras. Este ingrediente funciona deteniendo la formación del pigmento (melanina) que causa que ciertas áreas de la piel se oscurezcan, principalmente por demasiada exposición al sol. Luego, al renovarse la piel naturalmente estas manchas oscuras se aclaran y gradualmente desaparecen dejando una tonalidad y apariencia uniforme a la piel. Podrás ver resultados entre 4-6 semanas, a veces mas tempranos. Medermis no elimina cicatrices, lunares o decoloraciones causadas por enfermedad.

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

MERZ PHARMACEUTICALS, LLC and)
MERZ INCORPORATED,)
) Cancellation No. 92051832
Petitioners,)
)
v.)
)
MONTANI COSMETICS INC.,)
)
Registrant.)

CERTIFICATE OF SERVICE

I hereby certify that the foregoing **PETITIONERS' AMENDMENT TO
PARAGRAPH 9 OF PETITIONERS' AMENDED PETITION FOR CANCELLATION
PURSUANT TO ORDER OF THE TRADEMARK TRIAL AND APPEAL BOARD
DATED JUNE 25, 2010**, together with Exhibit 1, are being served upon the Registrant by
mailing a true copy thereof by first class mail, postage prepaid, addressed to:

Charles T. Riggs Jr.
PATULA & ASSOCIATES, P.C.
116 S. Michigan Avenue, 14th Floor
Chicago, IL 60603
United States

on July 19, 2010.

/pnb/

Phoebe N. Baker