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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
Correspondence Address	LILE H. DEINARD DORSEY & WHITNEY LLP 250 PARK AVENUE NEW YORK, NY 10177 UNITED STATES deinard.lile@dorsey.com
Submission	Other Motions/Papers
Filer's Name	Sarah M. Robertson, Esq.
Filer's e-mail	robertson.sarah@dorsey.com, deinard.lile@dorsey.com
Signature	/SMR/
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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.)

**PETITIONERS' BRIEF IN OPPOSITION TO REGISTRANT'S MOTION TO STRIKE
PETITIONERS' SECOND AMENDED PETITION FOR CANCELLATION AND
PETITIONERS' CROSS- MOTION TO REOPEN THE DEADLINE TO FILE SUCH
SECOND AMENDED PETITION FOR CANCELLATION**

Petitioners Merz Pharmaceuticals, LLC and Merz, Incorporated (collectively, “Petitioner”) submit this brief in opposition to Registrant’s Motion to Strike Petitioners’ Second Amended Petition for Cancellation (the “Motion”).¹ In its Motion, Registrant seeks to strike Petitioner’s Second Amended Petition for Cancellation submitted in response to the June 25, 2010 Order (the “Order”) of the Trademark Trial and Appeal Board (“TTAB”) granting leave to Petitioner to amend paragraph 9 of its Amended Petition for Cancellation, on the basis that such Second Amended Petition for Cancellation was filed on July 19, 2010 instead of July 15, 2010. Registrant also seeks to strike Paragraph 9 of such Second Amended Petition for Cancellation on the purported basis that this Paragraph 9, as amended, does not comply with the Board’s Order. Petitioner submits that Registrant’s Motion should be denied in its entirety on the basis that Paragraph 9, as amended, clearly complies with the Board’s Order and provides full and fair

¹ Petitioner notes, at the outset, that this is the fifth Motion filed by Registrant in the initial stages of this proceeding, which motions reflect a pattern of vexatious and overly aggressive conduct by Registrant, designed to substantially increase Petitioner’s costs of prosecuting this cancellation action.

disclosure of Petitioner's claims in this proceeding. Petitioner also cross-moves to reopen the period set by the Board for the filing of Petitioner's Second Amended Petition for Cancellation on the basis that any late filing by Petitioner was due to excusable neglect with no prejudice whatsoever to Registrant's ability to litigate this case being suffered.

I. Cross-Motion to Reopen Period for Filing of Second Amended Petition For Cancellation

Petitioner hereby cross-moves pursuant to Fed. R. Civ. P. 6(b) to reopen the time period set by the Board in its June 25, 2010 Order for the filing of Petitioner's Second Amended Petition for Cancellation. As stated above, Petitioner filed its Second Amended Petition For Cancellation on July 19, 2010, 2 business days after the July 15, 2010 deadline set by the Order. Petitioner made its filing on July 19th because the 20 day deadline set by the Order to make such filing was erroneously docketed by Petitioner's counsel as 20 days following the mailing date of the Order plus an enlargement of such 20 day period by 5 days pursuant to 37 C.F.R. § 2.119(c). The entering of this "20 plus 5" docketing deadline followed the correct entering of multiple docketing deadlines for Petitioner to respond to Registrant's myriad of other motions filed within a short time frame in this cancellation action and served upon Petitioner by mail, taking into account this same 5-day enlargement period. Based on this docketing error, Petitioner's counsel was under the mistaken belief that Petitioner was in fact filing its Second Amended Petition for Cancellation ahead of the applicable deadline as docketed, i.e., July 20th.

Based on these circumstances, Petitioner submits that the July 19th filing date of its Second Amended Petition for Cancellation was solely the result of excusable neglect and that Petitioner acted in good faith in seeking to comply with the deadline in issue. See Trademark Trial and Appeal Board Manual of Procedure (TBMP), §509.01(b); see also Pioneer Investment Services Company v. Brunswick Associates Ltd. Partnership, 507 U.S. 380, 392 (1993)

(“excusable neglect” under Rule 6(b) is an elastic concept not limited strictly to omissions caused by circumstances beyond the control of the movant and may extend to inadvertent delays), as adopted by the Board in Pumpkin Ltd. v. The Seed Corps, 43 U.S.P.Q.2d 1582 (T.T.A.B. 1997). Further, no prejudice can be said to be suffered to Registrant’s ability to litigate this case due to the 2 business day delay in the making of Petitioner’s filing, since no loss or unavailability of evidence or witnesses could ever be alleged to have ensued as a result of such small delay. See TBMP 5.09.01(b)(1) (“prejudice to the nonmovant” is prejudice to the nonmovant’s ability to litigate the case and must be more than mere inconvenience and delay or loss of any tactical advantage); see also Pumpkin Ltd. v. The Seed Corps, supra. at 1587, citing Pratt v. Philbrook, 109 F.3d 18 (1st Cir. 1997) and Paolo’s Associates Ltd. Partnership v. Bodo, 21 U.S.P.Q.2d 1899, 1904 (Comm’r 1990).

Based on Petitioner’s excusable neglect in this case, the very short length of the delay in issue, the lack of any prejudice to Registrant as a result of such short delay and Petitioner’s good faith in seeking to comply with the deadline in issue, Petitioner respectfully requests that the Board reopen the applicable time period until July 19th and accept Petitioner’s filing of its Second Amended Petition for Cancellation in this case.

II. Paragraph 9 of Petitioners’ Second Amended Petition for Cancellation Fully Complies With the Board’s June 25th Order

In its Motion herein, Registrant also seeks to strike Paragraph 9 of Petitioner’s Second Amended Petition for Cancellation on the purported basis that such Paragraph 9, as amended, does not comply with the Board’s Order mailed June 25, 2010. This is simply not true.

As the Board is aware, the Board's Order granted leave to Petitioner to further amend Paragraph 9 of its Amended Petition for Cancellation in order to clarify whether Petitioner seeks to cancel Registrant's Registration No. 3608042 (the "Registration") on grounds of fraud, and whether Petitioner is alleging that the representations contained in Registrant's letter dated July 22, 2009 (attached as Exhibit A to the Amended Petition for Cancellation) constitute an admission against interest. See Board's Order at p. 7. Petitioner submits that Paragraph 9 of Petitioner's Second Amended Petition for Cancellation filed in response to the Order makes absolutely clear that: (i) Petitioner does not allege fraud as a ground for cancellation in this proceeding, since no separate ground for cancellation for fraud is stated in such Second Amended Petition for Cancellation; (ii) Petitioner is alleging that the contents of the July 22nd letter in issue constitute an admission against interest; and (iii) Petitioner alleges that the Registration was procured in bad faith. More specifically, Petitioner's amended Paragraph 9 states as follows (emphasis added):

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 [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 registration in bad faith. Further, the statements volunteered by Registrant's President in aforesaid letter to Petitioner constitute an admission against interest and/or a concession with regard to the likelihood of confusion between the marks at issue in this proceeding.***

Petitioner respectfully submits that the allegations contained in Paragraph 9 as amended are clearly stated and provide full and fair notice of the claims asserted by Petitioner in this proceeding, and thus comply in all respects with the Board's Order in issue. See TBMP § 506.01. As a result, no further motion to strike by Registrant should be entertained in this case.

CONCLUSION

For the reasons stated above, Petitioner respectfully submits that the Board should deny Registrant's motion to strike Petitioner's Second Amended Petition for Cancellation and should grant Petitioner's motion to reopen the deadline for Petitioner to submit such Second Amended Petition for Cancellation on the basis that any delay by Petitioner in making this submission was due to excusable neglect.

Dated: August 3, 2010

DORSEY & WHITNEY LLP

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

Attorneys for Petitioners
Merz Pharmaceuticals, LLC and
Merz, Incorporated

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CERTIFICATE OF SERVICE

I hereby certify that the foregoing **PETITIONERS' BRIEF IN OPPOSITION TO REGISTRANT'S MOTION TO STRIKE PETITIONERS' SECOND AMENDED PETITION FOR CANCELLATION AND PETITIONERS' CROSS-MOTION TO REOPEN THE DEADLINE TO FILE SUCH SECOND AMENDED PETITION FOR CANCELLATION** 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 August 3, 2010.

/pnb/

Phoebe N. Baker