

ESTTA Tracking number: **ESTTA365322**

Filing date: **08/26/2010**

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

Proceeding	92051832
Party	Defendant Montani Cosmetics Inc.
Correspondence Address	CHARLES T. RIGGS JR. PATULA & ASSOCIATES, P.C. 116 S. MICHIGAN AVENUE, 14TH FLOOR CHICAGO, IL 60603 UNITED STATES riggs@patula.com
Submission	Reply in Support of Motion
Filer's Name	Charles T. Riggs Jr.
Filer's e-mail	riggs@patula.com
Signature	/Charles T. Riggs Jr./
Date	08/26/2010
Attachments	10C53.pdf (5 pages)(272711 bytes) 09C53.08-26-10.pdf (2 pages)(249930 bytes)

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

Merz Pharmaceuticals, LLC and)	
Merz, Incorporated)	
)	
Petitioner,)	
)	Cancellation No. 92051832
v.)	
)	Reg. No. 3,608,042
Montani Cosmetics Inc.,)	
)	
Registrant.)	
<hr/>		

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

**REGISTRANT’S REPLY TO PETITIONERS’ RESPONSE
TO REGISTRANT’S MOTION FOR SUMMARY JUDGMENT
AND TO PETITIONERS’ CROSS-MOTION FOR SUMMARY JUDGMENT**

In reply to Petitioners’ Response¹ to Registrant’s Summary Judgment Motion, and to Petitioners’ Cross-Motion for Summary Judgment, Registrant Montani Cosmetics Inc. states:

1. Petitioners’ Response brief, p. 2, initially argues that the Board is not bound by the PTO’s examination of the registration Petitioners’ seek to cancel. This is not disputed. However,

¹ It is noted that Petitioners’ footnote 1 on the first page of its Response brief, disingenuously asserts that Registrant’s actions have been “*designed to substantially increase Petitioner’s cost of prosecuting this cancellation action.*” To suggest that an independent, small business owner is attempting to increase the costs of this cancellation proceeding against a gigantic pharmaceutical group with revenues approaching one billion dollars annually, is quite frankly laughable. Registrant offered to settle this matter at the beginning on very favorable terms to Petitioners. After initially accepting Registrant’s settlement offer, Petitioners reneged on the agreed to settlement, and apparently chose to use its billion dollar war chest to have its way by bleeding Registrant to death. It is Petitioners who have made the curious decision to pursue this matter rather than settle it on very favorable terms.

the fact that the PTO granted registration after having carefully considered Petitioners' cited registrations with respect to the issue of likelihood of confusion, is itself incredibly strong evidence which supports Registrant's position in this proceeding that there is no likelihood of confusion between Registrant's mark and Petitioners' marks.

2. Petitioners' Response brief, p. 3, next argues that the Exhibits to Registrant's Summary Judgment Motion should be disallowed as unauthenticated. However, it is believed that these Exhibits need not be authenticated because they are already part of the record in this matter by virtue of the fact that they are the same Exhibits, other than the dictionary page, submitted during the prosecution of the registration Petitioners seek to cancel. Trademark Rule 2.122(b). With respect to the dictionary page (S.J. Motion, Ex. A), Petitioners attach the same dictionary page to their Response brief as Exhibit A. There simply is no dispute as to the authenticity of any of the Summary Judgment Motion Exhibits. Nonetheless, to the extent any of the Summary Judgment Motion Exhibits need be authenticated, attached hereto is the Declaration of the undersigned providing such authentication.

3. Petitioners' Response brief, p. 5, wrongly alleges bad faith and admission against interest on behalf of Registrant. This is nothing more than a red herring. There is no bad faith or admission against interest in the July 2008 letter, which Petitioners' misquote out of context. While Registrant acknowledges "close similarities with existing marks," Registrant does not state there are close similarities with Petitioners' marks. Nonetheless, the vast majority of registered marks have "close similarities with existing marks." In fact, there are a plethora of identical marks registered to different entities for different goods. Registrant does not dispute the fact that Petitioners' marks and Registrant's mark both begin with the letters "MEDERM." However, this similarity did not and

does not create a likelihood of confusion when all relevant factors are analyzed, just as the closely similar “DERMA” marks in S.J. Motion Group Exhibit D are all concurrently registered.

4. Further, Registrant’s July 2008 acknowledgement that the USPTO made “on a preliminary basis” a likelihood of confusion refusal based on Petitioners’ marks, is nothing more than the truth. When Registrant subsequently had the opportunity to discuss this initial refusal with trademark counsel, Registrant learned that Petitioners’ marks were very easily distinguishable from Registrant’s mark. Registrant then decided in good faith to go ahead and pursue the registration.

5. Not until page 6 of Petitioners’ Response brief do Petitioners finally begin to address the issue of likelihood of confusion on the merits. After admitting that “derma” means skin, Petitioners suggest that the prefix “MED” connotes the word “medical” or “medicine.” Petitioners are apparently suggesting that consumers of their medicated scar care products perceive their product as “medicine for the skin².” This however only serves to clearly distinguish Registrant’s mark and cosmetic goods, which have no “medical” connotation. Registrant’s MEDERMIS mark used in connection with cosmetics connotes beauty products for the skin, while Petitioners’ MEDERMA marks admittedly connote medicine for skin, or specifically scars. This is a very different connotation for two very different product lines.

6. Petitioners’ Response brief goes on to dance around the fact that their sole MEDERMA product is a scar care product, while Registrant’s MEDERMIS products are cosmetics/cleaning preparations namely beauty creams, beauty lotions and facial bars. Petitioners even try to suggest that these different product lines would not travel in their different ordinary

² Based on this admission, it appears Petitioners’ MEDERMA marks may actually be generic as used in connection with their medicated skin care products.

channels of trade, i.e., medical/first aid products versus cosmetics products. Despite Petitioner's best efforts, Petitioners' simply fail to establish any reasons which would rise to the level of a genuine issue of material fact so as to preclude a finding that there is no likelihood of confusion between Registrant's MEDERMIS mark used in connection with cosmetic/beauty products and Petitioners' MEDERMA mark used for a scar care product, as conclusively established in Registrant's Motion for Summary Judgment.

7. Unequivocally, summary judgment in favor of Registrant is proper, and Petitioners' Amended Petition for Cancellation should be summarily dismissed in the interest of judicial economy.

WHEREFORE, Registrant respectfully requests that summary judgment be granted in Registrant's favor, and that this cancellation proceeding be dismissed.

Respectfully submitted,
PATULA & ASSOCIATES, P.C.

Dated: August 26, 2010

By: /Charles T. Riggs Jr./
Charles T. Riggs Jr.
Attorney for Registrant

Charles T. Riggs Jr.
Patula & Associates, P.C.
116 S. Michigan Ave., 14th Floor
Chicago, IL 60603
(312) 201-8220
riggs@patula.com

10C53

CERTIFICATE OF SERVICE

I hereby certify that a copy of REGISTRANT'S REPLY TO PETITIONERS' RESPONSE TO REGISTRANT'S MOTION FOR SUMMARY JUDGMENT AND TO PETITIONERS' CROSS-MOTION FOR SUMMARY JUDGMENT together with the DECLARATION OF CHARLES T. RIGGS JR. was served upon Petitioners by depositing a copy with the United States Postal Service as first class mail, postage paid, in an envelope addressed to Lile H. Deinard, Esq., DORSEY & WHITNEY LLP, 250 Park Avenue, New York, New York 10177, this 26th day of August, 2010.

/Charles T. Riggs Jr./

Charles T. Riggs Jr.

Patula & Associates, P.C.

116 S. Michigan Ave., 14th Floor

Chicago, IL 60603

(312) 201-8220

riggs@patula.com

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

Merz Pharmaceuticals, LLC and)	
Merz, Incorporated)	
)	
Petitioner,)	
)	Cancellation No. 92051832
v.)	
)	Reg. No. 3,608,042
Montani Cosmetics Inc.,)	
)	
Registrant.)	
<hr/>		

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

DECLARATION OF CHARLES T. RIGGS JR.

I, Charles T. Riggs Jr., hereby declare, under penalty of perjury, the following:

1. I am an attorney with Patula & Associates, P.C. in Chicago, Illinois, I am over the age of 18 and I am one of the attorneys representing Registrant Montani Cosmetics Inc. in this matter.
2. The Exhibit A attached to Registrant’s Summary Judgment Motion filed July 2, 2010 is a true and correct copy of page 342 of Webster’s Ninth New Collegiate Dictionary, Merriam-Webster Inc. 1988, setting forth the dictionary definitions of the term “DERMA” and the term “DERMIS.”
3. The Group Exhibit B attached to Registrant’s Summary Judgment Motion filed July 2, 2010 is a true and correct copy of the specimens submitted with the Section 8 and 15 Declarations in Reg. No. 2360460 on May 5, 2006, as obtained from on-line USPTO records.

4. The Group Exhibit C attached to Registrant's Summary Judgment Motion filed July 2, 2010 is a true and correct copy of a printout of all of the webpages found on Petitioners' website www.mederma.com on or about December 5, 2008.

5. The Group Exhibit D attached to Registrant's Summary Judgment Motion filed July 2, 2010 are true and correct copies of numerous registrations of marks incorporating the term "DERM" or "DERMA," as obtained from on-line USPTO records.

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

FURTHER DECLARANT SAYETH NOT.

Dated: August 26, 2010

By: /Charles T. Riggs Jr./
Charles T. Riggs Jr.

09C53