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

Proceeding	92053769
Party	Defendant Jane Wan Chou dba Ideal Skin, Inc.
Correspondence Address	LISA A KANE 77 ROCSAM PARK ROAD BRAINTREE, MA 02164-6705 UNITED STATES lklegal123@gmail.com
Submission	Other Motions/Papers
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Date	07/25/2011
Attachments	COUNTERCLAIMrev1[1].pdf (5 pages)(47539 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL & APPEAL BOARD

In the matter of
Trademark Registration NO. 3,152,675
For the Mark: HEALTHY SKIN IS IDEAL SKIN
Registration Date: October 10, 2006
Cancellation No. 92953768

David M. Morrow (an individual), and
The Morrow Institute Medical Group,
Inc. (a California Corporation),

Defendant

V.

Janet Wan Chou (an individual), dba.
Ideal Skin, Inc. (A Massachusetts Corporation)

Plaintiff

Counter Claim for Cancellation No. 92953768

Plaintiff, Janet Wan Chou by and through undersigned counsel, alleges:

- 1) Janet Wan Chou is an individual doing business as Ideal Skin, Inc. , a Massachusetts Corporation with it principal place of business in Massachusetts.
- 2) On information and belief, Defendant, David M. Morrow is an individual doing business as The Morrow Institute Medical Group, Inc. a California Corporation, and transacting interstate business with Massachusetts and elsewhere in the United States.
- 3) Plaintiff operates a business for skin care services and spa services namely cosmetic body care services including facial, microdermabrasion, blue peels various chemical peels, etc. Plaintiff also sells skin care products in connection with her services.
- 4) Plaintiff's Goods and Services are provided to clients from a number of states in the United States.
- 5) Plaintiff identifies Plaintiff's Good and Services in commerce and across the United States with the following marks, among others:
HEALTHY SKIN IS IDEAL SKIN.
- 6) Plaintiff has been using Plaintiff's mark since as early as August 18, 2005 and in United States Commerce to identify Plaintiff's Goods and Services since as early as September 19, 2005.
- 7) The USPTO issued on October 10, 2006 , a registration number 3,152,675 to Plaintiff for HEALTHY SKIN IS IDEAL SKIN as a service mark for Skin care services in Class 044.
- 8) The Plaintiff has substantial and exceedingly valuable goodwill in connection with Plaintiff's Mark.

Defendant's trademark Application, Goods and Designation.

- 9) On or about April 30, 2010, Defendant filed an application with the USPTO , application no 85,027,889 for the Mark HEALTHY SKIN IS BEAUTIFUL SKIN. (Defendant's Designation)
- 10) On or about August 16, 2010, the USPTO Examiner issued an office action rejecting the Defendant's application under 2(d), finding a

likelihood of confusion with Plaintiff's Mark. That rejection was continued in a final Office Action issued on or about February 9, 2011.

11) Defendant's Goods and Services are identical or substantially similar to Plaintiff's Goods and Services.

12) Defendant's Goods and Services are goods and services others might reasonably expect Plaintiff to provide, or license others to provide using Plaintiff's Mark.

13) Plaintiff has no control over the quality of Defendant's Goods and Services provided using Defendant's Designations.

14) Defendant's Goods and Services are likely to be encountered by users and prospective users of Plaintiff's Goods and Services.

15) The confusion created, or likely to be created, by defendant's use of Defendant's Designation, as identified by the USPTO, in its Office Action can damage the reputation and goodwill that Plaintiff has created in Plaintiff's Marks.

16) Defendant's acts have damaged, or may damage, Plaintiff's business, reputation and goodwill and have interfered, or may interfere, with Plaintiff's use of its own Mark.

17) Defendant has caused, and unless enjoined, will cause irreparable harm and injury to Plaintiff for which there is no adequate remedy at law.

18) Defendant should be, upon final hearing, permanently enjoined from using Defendant's Designations.

19) Plaintiff is entitled to recover from Defendant (i) Defendant's profits in selling Defendant's Goods using Defendant's Designation; (ii) Damages sustained by Plaintiff due to Defendant's sale of Defendant's goods using Defendant's Designation, (iii) cost of this action (iv) and exceptional damages for intentional infringement, bad faith and willful conduct.

20) Furthermore, Plaintiff seeks an order from the TTAB compelling Defendant to destroy all materials bearing the Defendant's Designation

and notify all customers, distributors, advertisers and other person involved in Defendant's offer of Goods and Services under Defendant's Designation that the Mark is owned and controlled exclusively for the benefit of the Plaintiff.

21) Additionally awarding the Plaintiff such other and further relief that is just and proper.

Respectfully submitted,

A handwritten signature in cursive script that reads "Lisa A. Kane". The signature is written in black ink on a white background.

Lisa A. Kane, Esq.

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Dated: July 25, 2011

Attorney for Plaintiff

CERTIFICATE OF SERVICE

I hereby certify that true and complete copies of the foregoing Counterclaim have been served on the Defendant, David M. Morrow by mailing said copies on July 26, 2011, First Class Mail, to his attorney of record at the following address:

Clark D. Gross
Law Office of Clark D. Gross
1800 Century Park East, Suite 600
Los Angeles , CA 90067
Attorney for Defendant

A handwritten signature in cursive script that reads "Lisa A. Kane". The signature is written in black ink and is positioned to the left of the typed name.

Lisa A. Kane, Esq.

Dated July 25, 2011