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

Proceeding no.	92074719
Party	Plaintiff Sung Hwan E&B Co. Ltd. d/b/a SHEnB Co. Ltd.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

SUNG HWAN E&B CO. LTD. D/B/A SHENB CO., LTD., Petitioner,	Cancellation No. 92074719
v.	Mark: VIVACE Registration No. 5,317,218
AESTHETICS BIOMEDICAL, INC. Respondent.	Mark: THE VIVACE EXPERIENCE Registration No.: 5,317,219

REPLY BRIEF FOR PETITIONER
SUNG HWAN E&B CO. LTD. D/B/A SHENB CO., LTD.

March 24, 2024

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PETITIONER'S REPLY BRIEF

I. INTRODUCTION

Respondent Aesthetics Biomedical, Inc. (hereinafter "Respondent" or "ABM") does not dispute that Petitioner Sung Hwan E&B Co. Ltd. D/B/A SHEnB Co., Ltd. (hereinafter "SHEnB" or "Petitioner") created the VIVACE mark and device and used the mark in U.S. commerce before Respondent ever used or sought to register the mark. Respondent also does not dispute that the use was sufficient to create trademark rights in the VIVACE mark. Rather, Respondent seeks to undermine Petitioner's prior and continuous use of the VIVACE mark by arguing that Petitioner either assigned the mark to Respondent or abandoned it. There is no trademark assignment and Petitioner never discontinued using the VIVACE mark.

The uncontroverted facts show that Petitioner has continuously used the VIVACE mark in U.S. commerce since 2013 and established common law rights long before Respondent ever filed for or used any mark incorporating the dominant term VIVACE. After three years of demonstrating, promoting, and shipping VIVACE devices around the United States, three clinical trials using the VIVACE device on patients in Arizona and New Mexico, and three years of work to obtain FDA clearance to sell the device in the U.S., Petitioner granted Respondent an exclusive distributorship to distribute the VIVACE device in the United States, Canada, and Mexico for a limited time subject to certain sales requirements. As part of that agreement, which was amended and replaced in 2017, Respondent was granted a license to use the VIVACE mark in connection with its distribution and sale of the device. Accordingly, Respondent's conduct following the execution of the distributorship agreement was routine for a licensee acting as domestic distributor of a foreign manufacturer's mark and in no way resulted in abandonment or assignment of any rights in the VIVACE mark. Moreover, as licensee of the mark and distributor of the VIVACE device, Respondent is barred from even arguing that Petitioner abandoned the VIVACE mark under the doctrine of licensee estoppel.

Because Petitioner used the mark first and there is an agreement providing Respondent with a license to use the VIVACE mark, the *Fuji Medical* factors do not apply to this case. However, even under the *Fuji Medical* factors, the presumption that Petitioner, as the manufacturer of the device, is the owner of the VIVACE mark has not been rebutted by Respondent. Respondent's evidence, most of which is after the mark was filed, cannot overcome the reality that Petitioner used the mark for years before Respondent began using the mark under the license, and continued to use the mark throughout the license and to the present day. Further, as Petitioner's licensee, any use by Respondent inured to the benefit of Petitioner. Accordingly, Petitioner requests that the Board grant its petition to cancel Reg. Nos. 5317218 and 5317219 on the grounds of priority, fraud, void ab initio, and likelihood of confusion.

II. ARGUMENT

A. Petitioner's prior use of the VIVACE mark establishes common law rights and the subsequent use by Respondent, its licensee, inured to the benefit of Petitioner

Petitioner used the VIVACE mark in the United States for three years before Respondent was retained as Petitioner's distributor. 85 TTABVUE 12-19 (discussing Petitioner's use of the VIVACE mark from 2013 through 2016). Under similar circumstances involving a distributorship agreement between a foreign manufacturer and domestic distributor that was silent with respect to trademark rights, the Board determined that the foreign manufacturer's earlier use of the mark and minimal sales were sufficient to establish its priority in the mark. *Opes, Inc. v. Aladin Communs., Inc.*, 2016 TTAB LEXIS 494, at *24 (TTAB Sept. 30, 2016) ("In view of the foregoing, and because Applicant established that it first used the ALADDIN mark in English in the United States in the period July to December, 1999, and Opposer has not alleged any earlier use of any trademark to which it may claim rights, we find that Applicant has established priority of use in the United States."). Petitioner's use of the mark from 2013 through 2016 created common law rights in the mark that were maintained through its sales and importation of product to Respondent for re-sale in the United States, and through Respondent's licensed use following the execution of the parties' distributorship agreements. There is no need to even reach the presumption that Petitioner, as a foreign manufacturer, owns the trademark on its product, because it established common law rights in the VIVACE mark that it never transferred to Respondent. *See ZAO Gruppa Predpriyatij Ost v. Vosk Int'l Co.*, 2011 TTAB LEXIS 240, at *78 (TTAB Aug. 9, 2011) (*citing Global Maschinen GmbH v. Global Banking Sys., Inc.*, 227 USPQ 862, 866-67 (TTAB 1985)).

In its brief, Respondent does not dispute and therefore concedes that Petitioner's use from 2013 was a use in commerce that gave rise to common law rights. *See generally* 86 TTABVUE. Instead, Respondent argues that its subsequent use of the VIVACE mark under the distributorship agreement does not inure to Petitioner's benefit because it alleges it is not a "related entity" as defined by 15 U.S.C. § 1127.

First, Petitioner has never stopped using the VIVACE mark in U.S. commerce. Petitioner has been the manufacturer of every device that Respondent sold under the agreement. Petitioner manufactured the devices in Korea, affixed the VIVACE mark to them, shipped them to Respondent in the United States, and sold them to Respondent for resale continuously between February 2016 and July 2023. 60 TTABVUE 4 (Sup. Kang Decl., ¶ 11.) Petitioner continues to market and promote the VIVACE device in the U.S. and continues to ship VIVACE devices to its new U.S. distributor. 79 TTABVUE 9-10, Ex. JJ and KK. Petitioner's continuous importation of VIVACE branded devices rebuts any allegation that Petitioner abandoned the VIVACE mark through non-use.

Second, Respondent easily qualifies as a related entity within the meaning of 15 U.S.C. § 1127. Section 1127 defines "related entity" as an "entity whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which a mark is used." The facts show that Petitioner does in fact control the quality of the goods sold by Respondent under the mark such that Respondent's use inures to Petitioner's benefit.

Respondent, in arguing that Petitioner did not control the nature and quality of the goods as manufacturer of the VIVACE devices, points to the 2016 agreement and its silence regarding quality control. 86 TTABVUE 16. However, the powers that are or are not granted under an agreement with respect to quality control are not determinative – what matters is what actually occurs. *Tequila Cuervo La Rojena, S.A. De C.V. v. Mush, Inc. D1b1a Igloo's Frozen Drinks*, 2017 WL 1345075, at *8 (TTAB 2017) ("[I]t is important to point out that a written license agreement—or any agreement so titled—is not required. . . . [I]f the quality of the goods bearing the mark remains satisfactory, the lack of a written contract, specific inspection procedures and other formalities does not support a finding of abandonment."); *Embedded Moments, Inc. v. Int'l Silver Co.*, 648 F. Supp. 187, 194 (E.D.N.Y. 1986) (denying summary judgment of lack of quality control because there was sufficient evidence of "a history of trouble-free manufacture" and noting "[i]t is not necessary . . . for the licenses themselves to contain a written provision for control; actual control by the licensor is sufficient."). At all relevant times, Petitioner has made the machine, programmed it, packaged it, warrantied it, provided replacement parts for it, provided guidance on servicing and repairs, and made the needle cartridges. Petitioner has total control over quality and the related entity standard set forth under 15 U.S.C. § 1127 is readily met under these facts. Not only has Petitioner established common law rights through its prior and continuous use of the VIVACE mark, any subsequent or concurrent use by Respondent also inured to Petitioner's benefit under section 1127. *See Quality Candy Shoppes/Buddy Squirrel of Wisconsin, Inc. v. Grande*

Foods, 90 U.S.P.Q.2d 1389 (TTAB 2007) ("[Y]ears of precedent make it very clear that proper use of a mark by a trademark owner's licensee or related company constitutes 'use' of that mark attributable to the trademark owner."); *Watec Co., Ltd. v. Liu*, 403 F.3d 645, 74 U.S.P.Q.2d 1128 (9th Cir. 2005) (affirming a jury verdict that a foreign manufacturer was the owner of the trademark and that the U.S. importer and distributor's licensed use inured to the benefit of the foreign manufacturer).

B. Respondent has not overcome Petitioner's presumptive ownership of the VIVACE mark

Respondent's attempts to rebut the presumption that Petitioner is the rightful owner of the VIVACE mark fall flat. Respondent primarily points to uses that either 1) postdate the filing date or 2) are common uses by a domestic distributor of a foreign manufacturer's product and not indicative of an intent to transfer trademark ownership. Respondent likewise misconstrues the facts in attempting to rebut the presumption that Petitioner owns the mark.

As an initial matter, Respondent understates the exposure that U.S. customers, doctors, and patients have to Petitioner's name in conjunction with the VIVACE devices. 86 TTABVUE 18. Respondent states that it "placed stickers with Respondent's name over Petitioner's name on the front of the devices and Petitioner was aware that this was being done," however, Petitioner's name was never removed from the display screen nor the plate on the machine. Petitioner's name likewise remained on the owner's manual until February 2017, three months prior to the filing date. 42 TTABVUE 4-5 (Kang Decl. ¶¶ 12-13, 15, Ex. S & T); 86 TTABVUE 12. Respondent also overstates the impact of it placing its name on the front of the device, as Respondent's own declarant testified that he knew Respondent did not manufacture the device and that the product originated from Korea. 84 TTABVUE 8 (Deposition of Emil A. Tanghetti, M.D. ("Tanghetti Dep.") at 7:6–7).

In alleging that it was the party that maintained quality and uniformity of the product, Respondent points to the fact that U.S. customers communicated with Respondent regarding warranties and repairs. 86 TTABVUE 23. Respondent also points out that it took over warranty and repair services – however, Respondent fails to include in the body of its brief the relevant date that that change took place: November 2017, after the filing date. *See* 28 TTABVUE 56 (Responses to Interrogatories 24, 25); 79 TTABVUE 4 (Guerra Supl. Decl. ¶ 12). It is undisputed that Petitioner manufactured the devices and handled all warranty and repair services prior to and as of the filing date. This factor unquestionably favors Petitioner.

Respondent repeatedly dodges providing relevant dates in its brief and lumping together all activity from 2017 into sweeping statements. Respondent's references to advertising expenditures in 2017 are not broken up by what was spent prior to the May 2017 filing date and what was spent after. 86 TTABVUE 27. Instead, Respondent merely states it its brief that Respondent spent "a significant amount of its 2017 advertising and marketing expenditure prior to filing its marks." *Id.* Respondent's repeated failure to provide relevant dates in connection with its proffered evidence artificially inflates the extent of its pre-filing use of the VIVACE mark.

Moreover, while Respondent engaged in advertising and promotional efforts, such activity is typical for a domestic distributor or seller of a product manufactured abroad and doesn't alone give rise to trademark rights. *See* S*ea-Roy Corp. v. Parts R Parts*, 1997 U.S. Dist. LEXIS 21809, at *91 (M.D.N.C. Dec. 2, 1997) ("The proposition that an exclusive domestic distributor acquires *de facto* ownership rights in the United States of marks associated with foreign-made goods by virtue of the distributor exercising control over the goods and spending money on developing the market for the goods is far from clear."). Altogether, the balance of the evidence favors a finding that Respondent has failed to rebut the presumption that Petitioner is the rightful owner of the VIVACE mark. *See ARSA Distrib. v. Salud Nat. Mexicana S.A. De C.V.*, 2022 TTAB LEXIS 347, at *30-31 (TTAB Sept. 28, 2022) (finding that the application of the *Fuji Medical* factors favored the manufacturer where it "created the mark and product, maintained quality control over the product, and was identified on product packaging as the manufacturer of the goods" and where the distributor was identified by phone number and address on product packaging for consumer inquiries and paid for advertising the products).

C. Petitioner never assigned or abandoned its rights in the VIVACE mark

Respondent alleges that Petitioner assigned and consequently abandoned its rights in the VIVACE mark by granting Respondent the sole right to import the VIVACE devices into the United States. As with the promotional efforts that Respondent engaged in under the agreement, this type of provision is a hallmark of a typical agreement between a foreign manufacturer and domestic distributor and is in no way indicative of intent to assign trademark rights in a device presently manufactured and sold by Petitioner under the VIVACE mark throughout the world. *Nahshin v. Prod. Source Int'l, LLC*, 2013 TTAB LEXIS 312, at *19-20 (TTAB June 21, 2013) ("[T]he mere fact that a U.S. distributor distributes a foreign manufacturer's branded product does not, without more, give the U.S. distributor an ownership interest in the mark."). "Absent a clear manifestation of intent by a supplier [or manufacturer] to transfer ownership of a trademark to a distributor, the supplier [or manufacturer] remains the rightful owner" of a trademark registration. *Software AG, Inc. v. Consist Software Solutions, Inc.*, No. 08 CV 389, 2008 U.S. Dist. LEXIS 19347, 2008 WL 563449, at *17 (S.D.N.Y. Feb. 21, 2008), *aff'd*, 323 F. App'x 11 (2d Cir. 2009). "This is true even when two parties have an exclusive distributorship agreement; if that agreement comes to an end, any rights which [the distributor] may have had in the mark during the life of the agency immediately revert[] to [the manufacturer]." *Haggar Int'l Corp. v. United Co. for Food Industry Corp.*, 906 F. Supp. 2d 96, 111 (E.D.N.Y. 2012) (quoting *Major-Prodotti Dentari-Societa in Nome Collettivo di Renaldo*, 161 U.S.P.Q. 437, 438 (TTAB 1968) (internal quotations omitted);

see also Omag Optik Und Mechanik A.G. v. Weinstein, 85 F. Supp. 631, 635 (S.D.N.Y. 1949) (stating that the distributor must demonstrate "a clear intention on the part of the manufacturer to transfer the mark to the distributor" before the distributor may lay claim to the benefits of the registration).

The danger of allowing domestic distributors or importers to register a foreign manufacturer's mark created the need for Section 1201.06(a) of the Trademark Manual of Examining Procedure (TMEP). That guidance makes clear that "[a] distributor, importer, or other distributing agent of the goods of a manufacturer or producer does not acquire a right of ownership in the manufacturer's or producer's mark merely because it moves the goods in trade." TMEP § 1201.06(a) (citing *In re Bee Pollen from Eng. Ltd.*, 219 USPQ 163 (TTAB 1983); *Audioson Vertriebs - GmbH v. Kirksaeter Audiosonics, Inc.*, 196 USPQ 453 (TTAB 1977); *Jean D'Albret v. Henkel-Khasana G.m.b.H.*, 185 USPQ 317 (TTAB 1975); *In re Lettmann*,183 USPQ 369 (TTAB 1974); *Bakker v. Steel Nurse of Am. Inc.*, 176 USPQ 447 (TTAB 1972)). This provision requires refusal of an application except in the following situations:

> (2) If an applicant is the United States importer or distribution agent for a foreign manufacturer, then the applicant can register the foreign manufacturer's mark in the United States, if the applicant submits one of the following:
> (a) written consent from the owner of the mark to registration in the applicant's name, or
> (b) written agreement or acknowledgment between the parties that the importer or distributor is the owner of the mark in the United States, or
> (c) an assignment (or true copy) to the applicant of the owner's rights in the mark as to the United States together with the business and good will appurtenant thereto.

Here, none of the prerequisites for registration of a manufacturer's mark is present and the registration of the VIVACE marks to Respondent should not have issued. Respondent argues that the First Amended and Restated Exclusive License to Distribute assigns the VIVACE trademark from Petitioner to Respondent because of the clause that assigns Respondent the right to import the device. Assigning a right to import a device is very different than assigning a trademark. In fact, the clause to which Respondent points as the trademark assignment, does not even mention the VIVACE mark. Trademark assignments between a foreign manufacturer and domestic distributor must be in writing and unambiguously transfer all rights to a mark, including the "business and good will appurtenant thereto." TMEP § 1201.06(a). In addition, the novel assignment argument contradicts the testimony of Respondent's CEO, who testified that the exclusive license to distribute the VIVACE devices contained no assignment of trademark rights in the VIVACE mark. 41 TTABVUE 110-11 (Guerra Dep. at 34-35). When asked whether the agreement said that the mark was assigned from one party to the other, Ms. Guerra stated that no, the "only thing that was assigned was the irrevocable license for [Respondent] to act as the regulatory – as the sole importer in Canada, United States, and Mexico. That was the only thing that was assigned under the agreement." 41 TTABVUE 111. The agreement was never understood by either party to assign any trademark rights, and Respondent's scramble to take up the argument at this late stage in the proceeding is disingenuous and contradicted by its own admissions.

Further, Respondent's brief inaccurately states that "the only place the term 'license' is used is in the title of the agreement which states that it is an 'exclusive license to distribute.'"[1] 86 TTABVUE 33. The truth is that the term "LICENSEE" is used throughout the Amended and Restated Exclusive License to Distribute to identify Respondent. In addition, Article 5, paragraph 4 in the 2016 agreement states that the "exclusiveness agreement shall be automatically converted into the non-exclusive licensing agreement" if minimum sales are not met, and Article 5, paragraph 5 in the 2017 agreement, states if the minimum sales commitments of the first year are not met, "this agreement shall be automatically converted into the non-exclusive licensing agreement." 62

[1] Respondent's reliance on the language of the 2016 agreement is misplaced. The 2017 amendment "amende[d], restate[d], and replace[d] in its entirety" the 2016 agreement and is the controlling agreement between the parties. 62 TTABVUE Ex. HH (confidential).

TTABVUE Exs. GG (confidential) & HH (confidential); 86 TTABVUE 14-15. The agreement conveyed a license to use the VIVACE mark in order to market and sell the device in the United States but did not permanently assign ownership of the trademark from manufacturer to distributor.

Moreover, Respondent's argument with respect to abandonment via transfer of the importation right misconstrues the language and effect of the agreement. As noted above, both agreements contain provisions that allow Petitioner to convert the exclusive license to distribute the VIVACE devices into a non-exclusive license after one year if certain sales benchmarks are not met. 62 TTABVUE Exs. GG (confidential) and HH (confidential). If the minimum sales benchmarks are not met by Respondent in subsequent years, Petitioner was authorized to terminate the agreement altogether. *Id.* In order for these provisions to have effect, Petitioner would need to have retained ownership of the VIVACE mark so that other United States distributors would be able to sell the VIVACE devices. Respondent's hand waving about irrevocability is nonsensical, as no term is truly "irrevocable" in an agreement with a finite term and/or termination provision. Accordingly, the agreement carried with it a license to use the VIVACE mark, rather than an assignment.

Respondent has failed to meet the exceedingly high burden for demonstrating abandonment. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 U.S.P.Q. 335, 1980 WL 30138 (T.T.A.B. 1980) (holding that clear and convincing proof is needed to prove that lapses in exercising quality control resulted in abandonment of the mark). The record is clear that Petitioner never abandoned its rights to the VIVACE marks. At all relevant times prior to and following the filing date, Petitioner continued to manufacture, package, and ship the VIVACE devices for global sale, including in the United States. *G.D. Searle & Co. v. Nutrapharm, Inc.*, 1999 U.S. Dist. LEXIS 16862, at *9 (S.D.N.Y. Oct. 29, 1999) (noting that "[i]n the legislative history discussing the 1989 Amendment to the Lanham Act, the Senate Judiciary Committee Report and the House Report cite as an example of sufficient use in commerce a pharmaceutical company's shipment to clinical investigators during the FDA approval process."). Shipping alone is sufficient to establish continuous use in commerce and refute Respondent's abandonment argument, even despite the fact that Respondent's use of the VIVACE mark inured to the benefit of Petitioner. *See* Lanham Act § 45; 15 U.S.C. § 1127 (stating that use in commerce requires "the bona fide use of a mark in the ordinary course of trade" and that the goods be "sold or transported" in commerce); *New England Duplicating Co. v. Mendes*, 190 F.2d 415, 418 (1st Cir. 1951) (holding that due to the use of the disjunctive "or" between "sold" and "transported," transportation alone is enough to constitute a "use" in commerce, even without a sale). Respondent has failed to make any legally cognizant argument with respect to assignment or abandonment, let alone a clear and convincing one.

D. As Petitioner's licensee and distributor, Respondent is barred from arguing Petitioner abandoned the mark

Respondent's abandonment argument is fatally afflicted due to its status as Petitioner's licensee and distributor. The argument that Petitioner abandoned its trademark rights through the distributorship agreement and turning over certain duties to its U.S. distributor amounts to a naked licensing argument. Such an argument is wholly futile, as Petitioner was the exclusive manufacturer of the VIVACE devices at all relevant times, including the date of the filing of the registration, May 11, 2017, and has never relinquished control over the quality of the VIVACE devices. *Fuji Med. Instruments*, 2021 USPQ2d 831, at *14, 23 (stating "a licensee cannot challenge the validity of the licensed mark including on the ground that the licensor has not exercised sufficient quality control" and that the "argument that Petitioner abandoned its FUJIIRYOKI mark at the same time that Respondent—as Petitioner's exclusive U.S. distributor—was selling Petitioner's FUJIIRYOKI-branded chairs not only defies logic and the law, it strains credulity.").

Respondent's argument that, by transferring over certain rights and duties to its domestic distributor, Petitioner has somehow abandoned and forfeited all rights to its trademark "not only defies logic and the law, it strains credulity." *Fuji Med. Instruments*, 2021 USPQ2d 831, at *23.

E. Petitioner's conduct was consistent with a foreign manufacturer reaching a U.S. market and it should not be equitably estopped from canceling Respondent's registrations

Respondent cites to no legal authority for the ludicrous proposition that making Respondent sole importer of the VIVACE devices in the U.S. contractually estops Petitioner from asserting ownership over the mark. Petitioner developed, used first, and continues to use the VIVACE mark globally on devices that Petitioner manufactures. Delegating importation to a domestic distributor and allowing it to take on a more customer facing role is yet again typical of these types of business arrangements and not indicative of an unspoken intent to surrender all trademark rights. *See Sea-Roy Corp.*, 1997 U.S. Dist. LEXIS 21809, at *91 ("The proposition that an exclusive domestic distributor acquires *de facto* ownership rights in the United States of marks associated with foreign-made goods by virtue of the distributor exercising control over the goods and spending money on developing the market for the goods is far from clear."); 75 TTABVUE 64 (stating that although the distributorship agreements were silent as to ownership of trademark rights, SHEnB still owns the mark and the rights were never transferred). It is exactly this kind of situation that gave rise to the creation of the presumption that, absent an agreement to the contrary, a foreign manufacturer retains all trademark rights regardless of use by a domestic distributor or purchaser. *See ZAO Gruppa*, 2011 TTAB LEXIS 240, at *76-77 (citing *Audioson Vertriebs-GmbH v. Kirksaeter Audiosonics, Inc.*, 196 USPQ 453, 456-57 (TTAB 1977)). However, Respondent need not even rely on this presumption, because Petitioner "had already established common-law rights in [the VIVACE marks] in the United States prior to [Respondent], and the contracts did not clearly transfer opposers' pre-existing rights to applicant." *Id.* at *78 (*citing Global Maschinen GmbH v. Global Banking Sys., Inc.*, 227 USPQ 862, 866-67 (TTAB 1985)).

The argument that Petitioner should be estopped from claiming ownership rights in the VIVACE mark because of its conduct is also at odds with the undisputed fact that Petitioner has objected to Respondent's ownership of the VIVACE registrations ever since Petitioner learned of them. 79 TTABVUE 6. At no time has Petitioner ever suggested that it wanted to abandon the VIVACE mark or that it consented to Respondent's ownership of the registrations. Given Petitioner's consistent objection, it is unreasonable for Respondent to believe it should own the VIVACE mark or any mark that includes the VIVACE mark for goods or services related to RF micro-needling. It would also be inequitable to allow a domestic importer and distributor of a foreign manufacturer's device to allege the manufacturer abandoned the mark "at the same time that Respondent—as Petitioner's exclusive U.S. distributor—was selling Petitioner's [VIVACE]-branded devices." *Fuji Med. Instruments*, 2021 USPQ2d 831, at *14, 23.

Respondent leaps through hurdles to patchwork a legal theory to support its estoppel argument. Because Petitioner had prior trademark rights in the VIVACE mark and has made clear throughout this dispute that it objected to Respondent's ownership of the VIVACE registrations, there can be no estoppel of Petitioner's claims.

III. CONCLUSION

Respondent's bases for claiming priority to Petitioner's VIVACE mark are unavailing. There is no dispute that 1) Petitioner used the VIVACE mark in commerce before Respondent even existed; 2) that there was never a written assignment of the VIVACE mark; and 3) Petitioner never abandoned the mark. Due to Petitioner's priority of use and ownership of the VIVACE trademark and the likelihood of confusion with the VIVACE and THE VIVACE EXPERIENCE marks at issue, the Board should grant Petitioner's Petition to Cancel and cancel the two registrations. The Board should also send a signal to Respondent that its attempts to register additional VIVACE marks for related goods or services will not be permitted.

Respectfully submitted,

SUNG HWAN E&B CO. LTD. D/B/A
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By its Attorneys,

Date: March 24, 2024

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing REPLY BRIEF FOR PETITIONER was served upon the following attorney of record for Respondent by email this 24th day of March 2024:

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