

ESTTA Tracking number: **ESTTA1396597**
Filing date: **11/19/2024**

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

Proceeding no.	92086459
Party	Defendant Dr. Grandel GmbH
Correspondence address	DR. GRANDEL GMBH PFLADERGASSE 7-13 86150 AUGSBURG GERMANY Primary email: rliebowitz@venable.com No phone number provided
Submission	Answer and Counterclaim
Filer's name	Rebecca Liebowitz
Filer's email	trademarkdocket@venable.com, rliebowitz@venable.com
Signature	/rliebowitz/
Date	11/19/2024
Attachments	79278930#TMSN.png(bytes) DRG answer and counterclaim.pdf(194143 bytes)

Registration subject to the submission

Registration no.	7218977	Registration date	11/14/2023
Register	Principal		
Registrant	GOWOONSESANG COSMETICS CO., LTD. 11F, 55, BUNDANG-RO, BUNDANG-GU SEONGNAM, GYEONGGI-DO, 13591 KOREA, REPUBLIC OF Email: hr@gwss.co.kr		

Goods/services subject to the submission


Class 003. First Use: Jul 21, 2017 First Use In Commerce: Jul 21, 2017
All goods and services in the class are requested, namely: Mask pack for cosmetic purposes; Make-up removing gel; Skin whitening preparations; Facial cleansers

Grounds for cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
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Mark cited by petitioner as basis for cancellation

U.S. registration no.	6208074	Application date	12/13/2019
Register	Principal		
Registration date	12/01/2020	Foreign priority date	06/17/2019
Word mark	DRG		

Design mark	
Description of mark	<p>The mark consists of the letters "R", "D" and "G", with the letter "R" appearing in the lower left part of the letter "D" and the letters "D" and "G" are larger and interlocking.</p>
Goods/services	<p>Class 003. First use: First Use: None First Use In Commerce: None Cosmetics, perfumery, essential oils, cosmetic soaps; non-medicated soaps; bath soaps, dentifrices</p> <p>Class 035. First use: First Use: None First Use In Commerce: None Retail store and wholesale store services featuring preparations for cosmetics, perfumery, essential oils, soaps, dentifrices</p> <p>Class 041. First use: First Use: None First Use In Commerce: None Training and further training of personnel in the wellness field, in particular in the cosmetics sector, in the body and beauty care field and in the field of nutritional consultancy; arranging and conducting of educational congresses, educational conferences, educational symposiums, seminars and educational colloquiums in the wellness and lifestyle sector, in particular in the cosmetics sector, in the field of body and beauty care and in the field of nutritional consultancy; providing training in the aforesaid fields, in particular in the field of cosmetics, body care and nutritional consultancy; providing a teaching institute for health and wellness training</p> <p>Class 044. First use: First Use: None First Use In Commerce: None Lifestyle and wellness consultancy, namely advice in the field of health and beauty care; advisory services relating to health; hygienic and beauty care; cosmetician services; provision of a cosmetics institute in the nature of beauty care services; all of the foregoing related to hygienics, beauty care and cosmetics</p>

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

Gwoonsesang Cosmetics Co., Ltd.)	
Petitioner,)	
)	
vs.)	Cancellation No. 92086459
)	Registration No. 6208074
Dr. Grandel GmbH)	
)	
Registrant (aka Respondent))	
Attorney's Reference: 37385-602045)	

REGISTRANT'S ANSWER and COUNTERCLAIM

Registrant (aka Respondent), Dr. Grandel GmbH, through counsel, hereby Answers the Petition for Cancellation as follows:

Registrant denies each and every allegation of the Petition for Cancellation unless otherwise admitted or responded to as follows:

1. Answering paragraph 1 of the Petition, Registrant lacks knowledge or information sufficient to form a belief concerning the allegations of paragraph 1 of the Petition, and therefore denies the same.
2. Answering paragraph 2 of the Petition, Registrant lacks knowledge or information sufficient to form a belief concerning the allegations of paragraph 2 of the Petition, and therefore denies the same.
3. Answering paragraph 3 of the Petition, Registrant lacks knowledge or information sufficient to form a belief concerning the allegations of paragraph 3 of the Petition, and therefore denies the same.

4. Answering paragraph 4 of the Petition, Registrant lacks knowledge or information sufficient to form a belief concerning the allegations of paragraph 4 of the Petition, and therefore denies the same.
5. Answering paragraph 5 of the Petition, Registrant lacks knowledge or information sufficient to form a belief concerning the allegations of paragraph 5 of the Petition, and therefore denies the same.
6. Answering paragraph 6 of the Petition, Registrant lacks knowledge or information sufficient to form a belief concerning the allegations of paragraph 6 of the Petition, and therefore denies the same.
7. Answering paragraph 7 of the Petition, Registrant lacks knowledge or information sufficient to form a belief concerning the allegations of paragraph 7 of the Petition, and therefore denies the same.
8. Answering paragraph 8 of the Petition, Registrant lacks knowledge or information sufficient to form a belief concerning the allegations of paragraph 8 of the Petition, and therefore denies the same.
9. Admitted except as to the email address tmcurcio@venable.com.
10. Admitted
11. Admitted
12. Admitted
13. Admitted
14. Answering paragraph 14 of the Petition, Registrant lacks knowledge or information sufficient to form a belief concerning the allegations of paragraph 14 of the Petition, and therefore denies the same.

15. Answering paragraph 15 of the Petition, Registrant lacks knowledge or information sufficient to form a belief concerning the allegations of paragraph 15 of the Petition, and therefore denies the same.

16. Denied

17. Admitted

18. Admitted

19. Admitted

20. Denied

21. Admitted

22. Denied

23. Admitted

24. Admitted

25. Denied

26. Admitted

27. Denied

28. Denied

29. Denied

30. Denied

31. Answering paragraph 31 of the Petition, Registrant lacks knowledge or information sufficient to form a belief concerning the allegations of paragraph 31 of the Petition, and therefore denies the same.

32. Answering paragraph 32 of the Petition, Registrant lacks knowledge or information sufficient to form a belief concerning the allegations of paragraph 32 of the Petition, and therefore denies the same.

33. Answering paragraph 33 of the Petition, Registrant lacks knowledge or information sufficient to form a belief concerning the allegations of paragraph 33 of the Petition, and therefore denies the same.

34. Admitted

35. Answering paragraph 35 of the Petition, Registrant lacks knowledge or information sufficient to form a belief concerning the allegations of paragraph 35 of the Petition, and therefore denies the same.

36. Answering paragraph 36 of the Petition, Registrant lacks knowledge or information sufficient to form a belief concerning the allegations of paragraph 36 of the Petition, and therefore denies the same.

37. Admitted

38. Answering paragraph 38 of the Petition, Registrant lacks knowledge or information sufficient to form a belief concerning the allegations of paragraph 38 of the Petition, and therefore denies the same.

39. Denied

40. Answering paragraph 40 of the Petition, Registrant lacks knowledge or information sufficient to form a belief concerning the allegations of paragraph 40 of the Petition, and therefore denies the same.

41. Answering paragraph 41 of the Petition, Registrant lacks knowledge or information sufficient to form a belief concerning the allegations of paragraph 41 of the Petition, and therefore denies the same.

42. Answering paragraph 42 of the Petition, Registrant lacks knowledge or information sufficient to form a belief concerning the allegations of paragraph 42 of the Petition, and therefore denies the same.

43. Answering paragraph 43 of the Petition, Registrant lacks knowledge or information sufficient to form a belief concerning the allegations of paragraph 43 of the Petition, and therefore denies the same.
44. Answering paragraph 44 of the Petition, Registrant lacks knowledge or information sufficient to form a belief concerning the allegations of paragraph 44 of the Petition, and therefore denies the same.
45. Answering paragraph 45 of the Petition, Registrant lacks knowledge or information sufficient to form a belief concerning the allegations of paragraph 45 of the Petition, and therefore denies the same.
46. Denied

COUNTERCLAIM FOR CANCELLATION OF REGISTRATION NO. 7218977

1. Petitioner is the owner of U.S. Trademark Registration No. 7218977 issued November 14, 2023 from an application filed October 20, 2017 for the mark Dr.G for “Mask pack for cosmetic purposes; Make-up removing gel; Skin whitening preparations; Facial cleansers” A copy is attached as Exhibit “1” to the Petition for Cancellation.
2. Petitioner has alleged in Paragraph 4 of the Petition for Cancellation that “Petitioner has used Petitioner’s DR.G Mark in interstate commerce in the United States continuously since July 21, 2017...”
3. In U.S. Trademark Registration No. 7218977 Petitioner has alleged that July 21, 2017 is the date of first use and date of first use in commerce of the mark shown in said registration for the goods listed therein.
4. As alleged in paragraph 17 of the Petition for Cancellation it is Petitioner’s belief that “Respondent’s DRG Mark has the same letters as Petitioner’s DR.G Mark.”
5. As alleged in paragraph 18 of the Petition for Cancellation it is Petitioner’s belief that “The letters in Respondent’s DRG Mark are presented in a similar order as the letters in Petitioner’s DR.G Mark.”
6. As alleged in paragraph 19 of the Petition for Cancellation it is Petitioner’s belief that “The letter “R” is presented in a smaller size than the “D” and “G” within Respondent’s DRG Mark.”
7. As alleged in paragraph 20 of the Petition for Cancellation it is Petitioner’s belief that “The smaller-sized letter “R” in Respondent’s DRG Mark is confusingly similar in appearance to the lower-case letter “r” in Petitioner’s DR.G Mark.”

8. As alleged in paragraph 21 of the Petition for Cancellation it is Petitioner's belief that "The smaller-sized letter "R" appears in the lower left part of the letter "D" within Respondent's DRG Mark."
9. As alleged in paragraph 22 of the Petition for Cancellation it is Petitioner's belief that "As the smaller-sized letter "R" appears in the lower left part of the letter "D" within Respondent's DRG Mark, it presents a similar separation of the letters "DR" from the "G" in Respondent's DRG Mark as the period that separates the "DR" from the "G" in Petitioner's DR.G Mark."
10. As alleged in paragraph 23 of the Petition for Cancellation it is Petitioner's belief that "The letters "D", "R", "and "G" are dominant elements of both Respondent's DRG Mark and Petitioner's DR.G Mark."
11. As alleged in paragraph 24 of the Petition for Cancellation it is Petitioner's belief that "The capitalized or larger-sized letters "D" and "G" are dominant elements of both Respondent's DRG Mark and Petitioner's DR.G Mark."
12. As alleged in paragraph 25 of the Petition for Cancellation it is Petitioner's belief that "Respondent's DRG Mark incorporates the entirety of Petitioner's DR.G Mark."
13. As alleged in paragraph 27 of the Petition for Cancellation it is Petitioner's belief that "Respondent's DRG Mark is confusingly similar to Petitioner's DR.G Mark in appearance."
14. As alleged in paragraph 28 of the Petition for Cancellation it is Petitioner's belief that "Respondent's DRG Mark is confusingly similar to Petitioner's DR.G Mark in sound."
15. As alleged in paragraph 29 of the Petition for Cancellation it is Petitioner's belief that Respondent's DRG Mark is confusingly similar to Petitioner's DR.G Mark in connotation."

16. As alleged in paragraph 30 of the Petition for Cancellation it is Petitioner's belief that
"Respondent's DRG Mark is confusingly similar to Petitioner's DR.G Mark in commercial impression."
17. As alleged in paragraph 31 of the Petition for Cancellation it is Petitioner's belief that
"Respondent's Goods and Services and Petitioner's Goods are both sold or provided in the field of beauty and skincare."
18. As alleged in paragraph 32 of the Petition for Cancellation it is Petitioner's belief that
"Respondent's Goods and Services covered by Respondent's DRG Mark are related to Petitioner's Goods covered by Petitioner's DR.G Mark."
19. As alleged in paragraph 33 of the Petition for Cancellation it is Petitioner's belief that
"Respondent's Goods and Services covered by Respondent's DRG Mark are confusingly similar to Petitioner's Goods covered by Petitioner's DR.G Mark."
20. As alleged in paragraph 39 of the Petition for Cancellation it is Petitioner's belief that
"There is similarity between Petitioner's DR.G Mark and Respondent's DRG Mark."
21. As alleged in paragraph 40 of the Petition for Cancellation it is Petitioner's belief that
"There is similarity between Petitioner's Goods sold under Petitioner's DR.G Mark and Respondent's Goods and Services sold and provided under Respondent's DRG Mark."
22. As alleged in paragraph 41 of the Petition for Cancellation it is Petitioner's belief that
"There is similarity in the channels of trade used by Petitioner and Respondent to sell goods and provide services under the at-issue marks."
23. As alleged in paragraph 42 of the Petition for Cancellation it is Petitioner's belief that
"There is similarity in the target purchasers of Petitioner and Respondent for the goods and services under the at-issue marks."

24. As alleged in paragraph 43 of the Petition for Cancellation it is Petitioner's belief that
"There is similarity in the sophistication of purchasers of Petitioner and Respondent for the goods and services under the at-issue marks."
25. As alleged in paragraph 44 of the Petition for Cancellation it is Petitioner's belief that
"There is similarity in the purchase conditions of Petitioner and Respondent for the goods and services under the at-issue marks."
26. As alleged in paragraph 45 of the Petition for Cancellation it is Petitioner's belief that
"actual or prospective consumers who encounter Respondent's DRG Mark on beauty and skincare goods are likely to think that said goods are authorized by, sponsored by, licensed by, affiliated with or related to Petitioner."
27. Respondent has used its DRG Mark in commerce in the U.S. since long prior to any date of first use in the U.S. that Petitioner can allege for its DR.G mark for the goods shown in Registration No. 7218977.
28. Respondent has used its DRG Mark in commerce in the U.S. since long prior to any date of first use in the U.S. that Petitioner can allege for its DR.G mark.
29. Petitioner believes that consumers may mistakenly believe that Respondent's goods and services offered under its mark are connected with or sponsored by Petitioner, thereby resulting in reverse confusion.
30. Petitioner believes that consumers may mistakenly believe that Respondent's goods and services offered under its mark are connected with or sponsored by Petitioner, thereby resulting in confusion.

31. Purchasers are likely to be confused into believing that Petitioner and/or its goods come from Respondent or that Respondent's goods and services come from Petitioner, or that there is a sponsorship, endorsement or license agreement between the parties.
32. Purchasers are likely to be confused into believing that Petitioner and/or its goods come from Respondent or that Respondent's goods and services come from Petitioner, or that there is a sponsorship, endorsement or license agreement between the parties. all to the damage of Respondent.
33. Petitioner's DR.G Mark should be cancelled because it consists of or comprises a mark which so resembles the previously used Respondent's DRG Mark, when used in connection with Petitioner's Goods, as to be likely to cause confusion, mistake, or deception within the meaning of 15 U.S.C. § 1052(d), and to cause damage to Registrant thereby.
34. If everything Petitioner alleges in the Petition for Cancellation is true, except for its claim of earlier dates of first use of its mark in the U.S., Petitioner's registration should be cancelled.

WHEREFORE, Registrant prays that the Petition for Cancellation be denied and dismissed with prejudice, and that Petitioner's Registrations No. 7218977 be cancelled.

Respectfully submitted,

Dated: November 19, 2024

/r/liebowitz/
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CERTIFICATE OF SERVICE

The undersigned, attorney for Registrant, hereby certifies that she served a copy of the REGISTRANT'S ANSWER and COUNTERCLAIM by electronic mail to Petitioner's counsel at the address of record set forth below.

EDWARD D. LANQUIST, JR.

BAKER, DONELSON, BEARMAN, CALDWELL, & BERKOWITZ, PC

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This 19th day of November, 2024.

/rliebowitz/
Rebecca Liebowitz

EXHIBIT 1

United States of America

United States Patent and Trademark Office

Dr.G

Reg. No. 7,218,977

Registered Nov. 14, 2023

Int. Cl.: 3

Trademark

Principal Register

GOWOONSESANG COSMETICS CO., LTD. (KOREA, REPUBLIC OF limited company (ltd.))
11F, 55, Bundang-ro, Bundang-gu
Seongnam, Gyeonggi-do, REPUBLIC OF KOREA 13591

CLASS 3: Mask pack for cosmetic purposes; Make-up removing gel; Skin whitening preparations; Facial cleansers

FIRST USE 7-21-2017; IN COMMERCE 7-21-2017

The mark consists of the stylized wording "Dr.G" above an underline that is shorter than the ends of the wording.

The name(s), portrait(s), and/or signature(s) shown in the mark does not identify a particular living individual.

SER. NO. 87-984,193, FILED 10-20-2017

Katherine Kelly Vidal

Director of the United States
Patent and Trademark Office

