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**TTAB**

Via U.S. Express Mail

United States Patent and Trademark Office  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

Re: *The Wet Seal, Inc. v. FD Management, Inc.*; Opposition No. 91157022  
Serial No. 76,372,550 — ARDENBEAUTY

Dear Sir or Madam:

Attached are three copies of Applicant's Trial Brief for filing.

Sincerely,

  
Joseph R. Dreitler

Attachments - 3

cc: John M. Cone, Esq.



09-07-2005

U.S. Patent & TMO/TM Mail Rcpt Dt. #72

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

In the Matter of Application No. 76/372,550 ARDENBEAUTY

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THE WET SEAL, INC., )  
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Opposer, ) Opposition No. 91157022  
 )  
v. )  
 )  
FD MANAGEMENT, INC., )  
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 )  
Applicant. )  
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**APPLICANT'S TRIAL BRIEF**

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

In the Matter of Application No. 76/372,550 ARDENBEAUTY

THE WET SEAL, INC.,	)	
	)	
Opposer,	)	
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v.	)	Opposition No. 91157022
	)	
FD MANAGEMENT, INC.,	)	
	)	
Applicant.	)	
	)	
	)	
	)	
	)	

**APPLICANT'S TRIAL BRIEF**

TO THE HONORABLE UNITED STATES TRADEMARK TRIAL AND APPEAL BOARD:

Applicant, FD Management, Inc. ("FD" or "Applicant"), in further support of its U.S. Trademark Application No. 76/372,500 (the "Application") for the mark ARDENBEAUTY, and in rebuttal to the Trial Brief of Opposer, The Wet Seal, Inc., d/b/a/ Arden B ("Arden B" or "Opposer") in support of its Opposition No. 91167022 to the Application, would respectfully show the Board as follows:

**I. RECORD EVIDENCE**

The evidence of record consists of:

- (1) U.S. Application No. 76/372,550 ARDENBEAUTY (the "Application").
- (2) Trial testimony of Laura Nicholas on behalf of Arden B ("Nicholas Dep.").
- (3) Trial testimony of James Perry on behalf of FD ("Perry Dep.").

- (4) Trial testimony of Ronald Rolleston on behalf of FD (“Rolleston Dep.”).
- (5) Arden B’s Notice of Reliance Pursuant to 37 C.F.R. § 2.122(e) dated February 24, 2005, which includes the Declaration of Vicki Martin and attachments, and the Declaration of Patrick Dredden and attached business records produced in this action (“2/24/05 Notice”).
- (6) Arden B’s Notice of Reliance Under Rule 2.122(e) and attachments dated June 9, 2005 (“6/9/05 Notice”)<sup>1</sup>.
- (7) FD’s Notice of Reliance Under 2.122(d) and attachments dated 3/30/05 (“3/30/05 Notice”).
- (8) FD’s Notice of Reliance Under Rule 2.122(e) dated 4/8/05 and attachments (“4/8/05 Notice”).

## **II. STATEMENT OF THE ISSUES**

1. Whether Opposer, a clothing retailer that does not sell cosmetics or fragrances and which did not begin using its “ARDEN B” mark on women’s clothing until 1997 and on clothing stores until 1999, has priority over Applicant, which has been selling cosmetics and fragrances under the famous “Elizabeth Arden” and “Arden” trademarks since 1910, with registrations of “Elizabeth Arden” for cosmetics and fragrances going back to 1922.
  - a. Whether Applicant’s 85 year priority of use over Opposer of the mark “Arden” for fragrances and cosmetics precludes any damage to Opposer from registration of the ARDENBEAUTY mark.
  - b. Whether Opposer’s prior contractual agreement with Applicant in which Opposer agreed never to use or seek to register the mark ARDEN B in any manner on

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<sup>1</sup> Applicant restates and incorporates by reference the objections raised in its Motion to Strike Opposer’s June 9, 2005 Notice of Reliance, inasmuch as the evidence attached thereto is not rebuttal evidence.

fragrances, cosmetics and toiletries, precludes any damage to Opposer from registration of the ARDENBEAUTY mark, and negates any potential likelihood of confusion between Opposer's ARDEN B mark and Applicant's ARDENBEAUTY mark.

- c. Whether Applicant, with 85 years of priority of use of "Arden" over Opposer, can add the merely descriptive word "beauty" to its famous Arden trademark for cosmetics and fragrances and register that combination term for cosmetics and fragrances.
  - d. Whether Opposer, a much junior common law user of Arden, and then only as "Arden B" and only for clothing, jewelry, handbags and retail clothing stores, can be damaged by the Applicant (and senior user's) registration of ARDENBEAUTY for cosmetics and fragrances.
2. Whether Applicant's ARDENBEAUTY mark, as used in connection with fragrances, cosmetics and related products, so resembles Opposer's ARDEN B mark, as used solely connection with its retail stores, clothing, jewelry and handbag products, is to be likely, when applied to Applicant's goods, to cause confusion, mistake or deception among consumers.

### **III. INTRODUCTION**

The Opposer puts forward a very strange and dangerous theory of trademark law to this Board in opposing the application of ARDENBEAUTY. According to its testifying representative, Opposer began use of the term ARDEN B on women's clothing, jewelry, handbags in 1997 and opened its first retail apparel stores in November 1999 (Nicholas Dep. at

68:15-20), and it applied to register ARDEN B for these goods shortly thereafter. That application was opposed by Applicant herein, which had been using “Elizabeth Arden” and “Arden” on cosmetics, fragrances and toiletries as far back as 1910, and first registered “Elizabeth Arden” in 1922 for “skin lotions and creams [,reducing lotion, bleach cream,] and depilatory”. In order to settle that Opposition in 2001, the Opposer herein both abandoned its Arden B applications, Serial Nos. 75/365,543, 75/394,241 and 75/583,075, and re-filed on March 6, 2002, two (2) applications for Arden B in a stylized form for: 1) retail apparel stores and 2) women’s clothing, jewelry and handbags, which registered on December 16, 2003 as Registration No. 2,795,689 and August 31, 2004 as Registration No. 2,879,970, respectively. In addition, Opposer herein contractually agreed that it would never use nor seek to register ARDEN B for cosmetics, fragrances, skin care, and hair care products, and that it would only use and register ARDEN B in a highly stylized form. (Perry Dep. at 7-8 and Exhibit 1 thereto.)

Nevertheless, even though Opposer does not own a registration of, and has never sold cosmetics, fragrances or toiletries using the term ARDEN B; even though Opposer has a contractual agreement with Applicant that it may never use or seek to register ARDEN B for cosmetics, fragrances and toiletries; and even though Applicant herein has used “Arden” and “Elizabeth Arden” on cosmetics, fragrances and toiletries since 1910 and owns registrations for such goods going back to 1922; and even though Opposer did not put its two (2) 2002 registrations of Arden B into evidence,<sup>2</sup> the Opposer still filed this Opposition to prevent Elizabeth Arden from registering ARDENBEAUTY for fragrances, cosmetics and toiletries.

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<sup>2</sup> The claimed dates of first use in Opposer’s Registration Nos. 2,795,689 and 2,879,970, neither of which is of record in this matter, are April, 2002 and March, 2002, respectively.

#### IV. SUMMARY OF ARGUMENTS

In order to successfully oppose the registration of ARDENBEAUTY, Opposer must demonstrate that it will be legally damaged by such registration. 15 U.S.C. §1063. This requires a showing of priority, enforceable trademark rights and likelihood of confusion. Opposer cannot succeed on any of these requirements. First and foremost, it simply does not have priority of use of the "Arden" mark for fragrances, cosmetics or any related products. Opposer has no trademark rights in ARDEN B for such goods, and makes no claim of such rights. Moreover, given that Applicant has been selling cosmetics, fragrances toiletries and related goods under the "Arden" and "Elizabeth Arden" marks for 90 years, Opposer cannot show that any consumer would likely be confused between the fragrance and cosmetic products sold under the ARDENBEAUTY mark, and Opposer's retail ARDEN B stores, which sell only clothing and related accessories, and not cosmetics and fragrances. Indeed, Opposer is precluded, by virtue of an earlier contractual agreement with Applicant's predecessor, from ever using or trying to register the ARDEN B mark for fragrances, cosmetics and toiletries -- or even for sunglasses.

Finally, Opposer argues that registration should be refused under Section 1(b), because Applicant purportedly admitted during trial testimony that it had no intention of using the ARDENBEAUTY mark for some of the goods for which it sought registration. As will be demonstrated, however, Opposer has misstated the testimony of Applicant's representative, Ronald Rolleston, regarding Applicant's intentions for the ARDENBEAUTY mark.<sup>3</sup> Accordingly, Opposer's Section 1(b) grounds for refusal of registration should be dismissed out-of-hand.

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<sup>3</sup> In fact, Applicant is currently using the ARDENBEAUTY mark on a wide variety of fragrance and cosmetic products, and has been selling such products nationally since mid-2002. (Rolleston Dep. at 48)

## V. ARGUMENT

- A. **By virtue of Applicant's 90 years' of prior use of the "Arden" mark for cosmetics, fragrances and related products, its numerous trademark registrations of "Elizabeth Arden" and variants, and its extensive advertising and sale of cosmetics and fragrances under the marks "Elizabeth Arden" and "Arden", Applicant owns a famous mark for those goods.**

The "Elizabeth Arden" name is one of the most famous trademarks in the cosmetics and fragrance industry. First registered as a trademark in 1922, with use back to 1910, "Elizabeth Arden" and "Arden" have been used continuously for many decades to identify a wide variety of cosmetic and fragrance products. (Rolleston Dep. at 11:3-6.) The Elizabeth Arden Red Door Salon on Fifth Avenue in New York City is a New York institution, and has been cited as an example of a famous trademark by the Ninth Circuit in *Grupo Gigante SA de CV v. Dallo & Co.*, 73 U.S.P.Q.2d 1258 (9th Cir. 2004) ("[I]f someone opened a high-end salon with a red door in Wellington and called it Elizabeth Arden's, women might very well go there because they thought they were going to an affiliate of the Elizabeth Arden chain, even if there had not been any other Elizabeth Ardens in New Zealand prior to the salon's opening. If it was not an affiliate, just a local store with no connection, customers would be fooled. The real Elizabeth Arden chain might lose business if word spread that the Wellington salon was nothing special.").

Over the years, Applicant has spent millions of dollars advertising and promoting fragrance and cosmetics products bearing the "Elizabeth Arden" and "Arden" marks. For the ARDENBEAUTY fragrance alone, Applicant spent an estimated \$4 million in advertising. (Rolleston Dep. at Exhibit 9.) From its launch in mid-2002 through January 31, 2005, retail sales of ARDENBEAUTY products totaled more than \$26 million. (Rolleston Dep. at Exhibit 31.) Applicant owns eight (8) registrations of ELIZABETH ARDEN for cosmetics and fragrances. (3/30/05 Notice of Reliance.) Applicant's many years of use, extensive advertising, significant

sales and numerous registrations clearly establish that the “Arden” mark is famous and entitled to a wide scope of protection. *Recot, Inc. v. M.C. Becton*, 54 U.S.P.Q.2d 1894 (Fed. Cir. 2000) (“Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark.”). Moreover, by virtue of this extensive and long-standing use, advertising and sales, Applicant established common law rights in the “Arden” mark *per se* for cosmetics, fragrances and toiletries long prior to Opposer’s first use of its ARDEN B mark for clothing and accessories, and for retail clothing stores.

**B. Adding the merely descriptive word “Beauty” to its famous “Arden” mark does not affect Applicant’s priority of use of the “Arden” mark.**

It is not surprising that the word “beauty” is widely used in the cosmetics and fragrance industry to describe a whole host of products intended to make the user feel more attractive. In fact, there are nearly two hundred active third-party registrations containing the word “beauty” for personal care products in International Class 3, which demonstrates that the USPTO does not consider the word to have origin-indicating capacity. (4/8/05 Notice of Reliance) Clearly, the merely descriptive word “beauty” contributes little to the overall commercial impression created by the ARDENBEAUTY mark. *Knight Textile Corp. v. Jones Investment Co.*, 75 U.S.P.Q.2d 1313 (TTAB 2005) (confusion between “Essentials” and “Norton McNaughton Essentials” unlikely because house mark renders the two marks sufficiently distinguishable). Rather, “Arden” is the dominant portion of the mark, ensuring that consumers will associate a fragrance product called ARDENBEAUTY with the famous “Elizabeth Arden” and “Arden” trademarks, and the fragrance and cosmetic products they have known for decades that have been sold under those marks. Indeed, Applicant chose the ARDENBEAUTY name specifically to “capitalize on the rich heritage of the Elizabeth Arden fragrances.” (Rolleston Dep. at 22:13-14.) And that “rich heritage” predates Opposer’s use of ARDEN B by more than 80 years.

**C. Applicant's priority of use and numerous registrations of "Elizabeth Arden" and "Arden" preclude any damage to Opposer as a matter of law, since Opposer has no rights in ARDEN B for cosmetics and fragrances.**

Opposer is a specialty retail clothing store that sells only its own ARDEN B branded products. (Nicholas Dep. at 70:13-16.) Those products are young women's tops, bottoms, outerwear, suiting, dresses, shoes and accessories. (Nicholas Dep. at 24:25 and 25:1.) ARDEN B stores do not sell cosmetics or fragrance products. (Nicholas Dep. at 47:16-18; 65:1-22.) Opposer considers its direct competitors to be other specialty retail clothing stores, such as bebe, BCBG and Anthropology. (Nicholas Dep. at 24:11-14.) According to its Notice of Opposition herein, Opposer uses its ARDEN B mark "in connection with the promotion and sale of women's jewelry, clothing including outerwear, underwear, swimwear, handwear, footwear, purses and bags, hair ornaments and the operation of retail apparel stores featuring women's clothing, footwear, hats and clothing accessories."

Opposer makes no claim to rights in ARDEN B for fragrances, cosmetics or toiletries of any type, and did not even allege in its Notice of Opposition that the goods and services it sells under its ARDEN B mark are similar or related to those of the Applicant, as set forth in Application Serial No. 76/372,550: a required element to sustain an Opposition. Clearly, Opposer has absolutely no rights in its ARDEN B mark for cosmetics, fragrances and toiletries, nor does it have priority of use.<sup>4</sup> Opposer simply cannot demonstrate that it has any enforceable rights in ARDEN B that will be damaged by the registration of ARDENBEAUTY.

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<sup>4</sup> Opposer cannot rely on its Registration Nos. 2,879,970 and 2,795,689 for ARDEN B to establish priority over Applicant under *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400 (CCPA 1974). First, any priority accorded Opposer would be limited to the goods described in Opposer's registrations. *San Fernando Elec. Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683 (CCPA 1977). However, Opposer has neither pleaded its Registrations, nor put them into evidence pursuant to 37 CFR § 2.122(d), presumably because the first use dates recited in those registrations are subsequent to Applicant's filing date of February 5, 2002. Thus, such Registrations have no evidentiary weight in these proceedings.

**D. Opposer will not be damaged by the registration of ARDENBEAUTY for fragrance and cosmetic products because Opposer is contractually precluded from using its ARDEN B mark on any fragrance or cosmetic products.**

At the time Opposer applied for registration of its ARDEN B marks, Applicant's predecessor opposed such registrations. (2/24/05 Notice of Reliance at A and B) The parties settled those Oppositions by entering into an agreement whereby Opposer 1) abandoned those applications, later re-filing for them in a distinctive typestyle; and 2) agreed never to use the ARDEN B mark on or in connection with:

cosmetics, skin care, hair care, fragrance products, eau de toilette, eau de cologne, eau de parfum, parfum, body lotion, body talc and powder, bath and shower gel, body oil, body soap, body wash, body splash, facial moisturizer, facial wash, after-shave lotion/balm, deodorants, antiperspirants and such other products commonly sold in a full fragrance line of goods or their packaging, or as the name of spas, salons or stores specializing in the sale of cosmetics, skin care, hair care or body products or services in the United States.

(Perry Dep. at Exhibit 1.)

For Opposer to now claim that it will be damaged by the registration of ARDENBEAUTY by Applicant, who clearly has priority and valid trademark rights in "Arden", for very different products that Opposer has never sold, and is contractually precluded from ever providing, is frivolous, and is a bald-faced attempt to establish rights in gross for its ARDEN B mark.

**E. There is no likelihood of confusion between Opposer's ARDEN B mark on its goods and services and Applicant's ARDENBEAUTY mark on the goods set forth in its Application.**

Opposer devotes a considerable portion of its Trial Brief to a discussion of likelihood of confusion under the *du Pont* factors. The issue of likelihood of confusion does not even need to be addressed, inasmuch as Opposer cannot establish the requisite priority of use in the "Arden"

mark. Thus, its arguments should properly be ignored by this Board. However, to the extent this tribunal determines that Opposer's asserted common law rights in "Arden" for clothing and a chain of retail clothing stores, based upon claimed common law use since 1997, trump Applicant's 90 years of registrations and common law rights in "Elizabeth Arden" and "Arden" for fragrances, cosmetics and toiletries, a few of Opposer's more egregious misstatements of law and fact need to be addressed.

First, there is no *per se* rule that cosmetics and clothing are related such that there will be a likelihood of confusion when the same or similar mark is used for these respective goods.<sup>5</sup> *In re Jacques Bernier, Inc.*, 1 U.S.P.Q.2d 1924 (TTAB 1987) ("Each case must be resolved on its own facts."). Indeed, in every case cited by Opposer where clothing and cosmetics were found to be related, likelihood of confusion was found because the Opposer was the senior user of a well-known mark that was being adopted by a junior user. *See, e.g., In re Arthur Holland, Inc.*, 192 U.S.P.Q. 494 (TTAB 1976) (owner of LEVI'S mark for clothing opposed registration of LEVI'S for use on men's cologne); *The All England Lawn Tennis Club (Wimbledon) Limited v. Creations Aromatiques, Inc.*, 220 U.S.P.Q. 1069 (TTAB 1983) (owner of famous "Wimbledon" mark for clothing opposed registration of "Wimbledon" for cologne). In this case, the roles are reversed: the junior user is opposing the senior user and owner of a famous trademark. Moreover, in this case the Applicant is not expanding into a new field; rather, it is applying for precisely the types of goods it has sold under the "Arden" and "Elizabeth Arden" marks for more than 90 years. Under these facts, confusion is not likely, and this factor favors Applicant.

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<sup>5</sup> Moreover, this argument should also be ignored, inasmuch as Opposer did not allege in its Notice of Opposition that its goods and services were related to those of Applicant.

In further support of its strained assertion that confusion is likely because consumers will assume that the same marks used on both clothing and women's cosmetics indicate a common source, Opposer belatedly submitted a list of third party registrations of trademark owners who use the same mark for cosmetics in International Class 3 and clothing in International Class 25. *See* 6/9/05 Notice of Reliance and Opposer's Trial Brief at 13-14. Apart from being irrelevant, because Opposer is contractually barred from selling cosmetics under its ARDEN B mark, this evidence may not be considered by this Board because it was filed outside of Opposer's testimony period and is being used to support its case-in-chief and not as rebuttal evidence. *See International Order of Job's Daughters v. Lindeburg & Co.*, 727 F.2d 1087, 220 U.S.P.Q. 1017 (Fed. Cir. 1984) and *American Speech-Language-Hearing Association v. National Hearing Aid Society*, 224 U.S.P.Q. 798 (TTAB 1985) (proper rebuttal testimony is introduced solely to deny, explain or otherwise discredit the facts and witnesses of applicant).

Opposer also asserts that the parties' target markets and trade channels are identical: women of all ages shopping in malls. Opposer not only oversimplifies its analysis, it contradicts the testimony of its own witness, Laura Nicholas, who stated "[o]ur branding focus is a young woman in her mid to late twenties." (Nicholas Dep. at 24:21-22.) In an analogous case discussing the similarity of trade channels and target markets for products sold in supermarkets, the Court of Customs and Patent Appeals stated:

A wide variety of products, not only from different manufacturers within an industry but also from diverse industries, have been brought together in the modern supermarket for the convenience of the customer. The mere existence of such an environment should not foreclose further inquiry into the likelihood of confusion arising from the use of similar marks on any goods so displayed. (Citation omitted) The means of distribution and sale, although certainly relevant, are areas of peripheral inquiry. The fundamental inquiry mandated by Section 2(d) goes to the

cumulative effect of differences in the essential characteristics of the goods and differences in the marks. (Emphasis in original.)

*Federated Foods, Inc. v. Fort Howard Paper Company*, 544 F.2d 1098, 192 U.S.P.Q. 24 (CCPA 1976).

In this case, Opposer's goods are only sold in Opposer's stores, and Opposer does not sell Applicant's products. Thus, the products will *never* be sold together. The mere fact that Opposer's stores are in shopping malls, and Applicant's products are sold in department stores which are generally located in shopping malls, simply does not support a blanket finding that the target markets and trade channels are identical.<sup>6</sup> Thus, these factors favor Applicant and do not support a finding of likelihood of confusion.

Finally, Opposer argues that the "fame of the prior mark" factor weighs in its favor. Clearly, it does not, and such a statement fails the red-face test. There is a famous mark in this case, but it is owned by Applicant. The Board must consider the fame of the Applicant's "Elizabeth Arden" and "Arden" marks in any analysis of the *du Pont* factors. *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1992) ("The fifth du Pont factor, fame of the prior mark, plays a dominant role in cases featuring a famous or strong mark."); *see also Bose Corp. v. QSC Audio Products Inc.*, 63 U.S.P.Q.2d 1303 (Fed. Cir. June 14, 2002); *Recot, Inc. v. M.C. Becton*, 54 U.S.P.Q.2d 1894 (Fed Cir. 2000) ("fame deserves its full measure of weight in assessing likelihood of confusion").

In its Trial Brief, Opposer attempts to establish that its ARDEN B mark is famous by virtue of its seven years use of the mark in less than one hundred specialty stores. Opposer has submitted evidence of less than \$5 million in advertising expense in total over seven years, and

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<sup>6</sup> Furthermore, Applicant's products are not sold exclusively in department stores. In fact, the ARDENBEAUTY products are now being sold in mass merchandisers, such as Wal-Mart, grocery stores and drug stores -- none of which are stores where Opposer's products would be found. (Rolleston Dep. at 89-91.)

less than \$20 million in sales for that seven year period. Compared with Applicant's \$4 million in advertising *on just the ARDENBEAUTY line*, and \$26 million in sales *on just the ARDENBEAUTY line*, and the 8500 stores in which ARDENBEAUTY has been sold since its introduction in 2002, not to mention Applicant's 85 years of use, advertising and promotion of "Elizabeth Arden" and "Arden" fragrances, cosmetics and toiletries, it is absurd to suggest that the "fame of the prior mark" factor weighs in Opposer's favor. Since Applicant clearly has priority in use of "Arden" and "Elizabeth Arden", and these marks are indeed famous for fragrances, cosmetics and toiletry products, the "fame of the prior mark" factor weighs heavily in Applicant's favor.

**F. Opposer's assertion that the Application is *void ab initio* is premised on a misstatement of the testimony, and is not supported by the facts in evidence.**

In a sign of sheer desperation, Opposer argues that Applicant "admitted" that it had no intention of using the ARDENBEAUTY mark for some of the goods recited in the Application, rendering the Application void *ab initio*. In support, Opposer cites to the testimony of Ronald Rolleston, stating that Mr. Rolleston testified that Applicant "never had any plans to use the mark ARDENBEAUTY on shampoo and candles." As an initial matter, the Application is confined to related goods in International Class 3, and the description of goods and services does not list "candles". Nevertheless, and to the extent this even makes a difference, since Applicant has not yet filed its Statement of Use, here is what Mr. Rolleston actually said in the portions of testimony cited by Opposer in its Trial Brief:

- Q: What other products were you intending to sell under the trademark, under the new brand?
- A: Everything that's listed here [in Rolleston Exhibit No. 2].
- Q: Anything else that's not listed there?

A: **Yes. Eventually we would put these things together in gift sets, we eventually would make new product types with it. That's all part of what we do.**

\* \* \* \* \*

Q: How about ardenbeauty candles, were you planning on selling ardenbeauty candles?

A: That could have happened.

Q: Did you plan for that?

A: No. I have people who do stuff like that for me. There is a group of women whose whole lives are spent finding marvelous ways to extend my fragrances in a variety of different areas to that we can promote it. There have been Elizabeth Arden candles in the past. But, no, I didn't sit down and go let's make sure we formulate the oils so that we can have a candle. But I wouldn't do that anyhow.

Q: Have any steps been taken to produce an ardenbeauty candle?

A: You know what, I don't know. I would have to go back and ask one of the girls who works for me who does that. That could very easily have been considered. I don't know.

\* \* \* \* \*

Q: How about shampoos?

A: We might have considered doing it at some point in time. But at that point I hadn't decided to do a shampoo **or not do a shampoo**. I mean, it wouldn't preclude me from it because of the nature of formulations. That's a category that I'm familiar with.

(Rolleston Dep. at 85-88.)

Without question, Applicant is making extensive use of ARDENBEAUTY on a wide variety of goods covered by the Application, and Mr. Rolleston certainly did not "admit" that Applicant never had a bona fide intention of using the ARDENBEAUTY name on any of the goods listed in the Application. This argument is specious, without merit, and does not establish a grounds for refusal of the Application under Section 1(b).

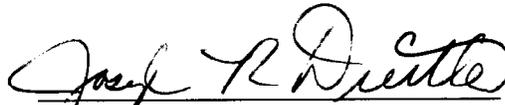
## VI. CONCLUSION

The only thing difficult about this case is figuring out why Opposer brought it. Opposer clearly does not have prior common law rights in "Arden"; it has not plead or relied upon its registrations of ARDEN B for clothing accessories and retail clothing stores, nor did it allege in its Notice of Opposition that the goods it sells under its ARDEN B mark are similar or related to the goods sold under the ARDENBEAUTY mark. Thus, Opposer does not even get to the likelihood of confusion analysis under the *du Pont* factors. And, even if it did, all of those factors heavily favor Applicant, which has been selling cosmetics, fragrances and toiletries under the "Elizabeth Arden" and "Arden" marks for more than 90 years.

Opposer has failed to demonstrate any superior rights in ARDEN B, or that it will be damaged by the registration of ARDENBEAUTY; accordingly, this Opposition should be dismissed.

Dated: September 7, 2005

Respectfully submitted,



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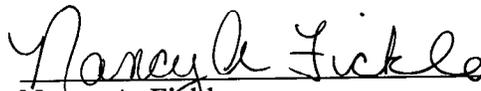
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MANAGEMENT, INC.

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing Applicant's Trial Brief has been served on John M. Cone, counsel for Opposer, by mailing said copy on September 7, 2005, via First Class Mail, postage prepaid to John M. Cone, c/o Akin Gump Strauss Hauer & Feld LLP, 1700 Pacific Avenue, Suite 4100, Dallas, Texas 75201-4675

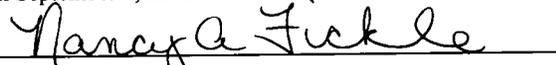
  
Nancy A. Fickle

**CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8**

I hereby certify that three copies of the foregoing Applicant's Trial Brief enclosed herein are being deposited with the United States Postal Service with sufficient postage as Express Mail in an envelope addressed to:

United States Patent and Trademark Office  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

on September 7, 2005

  
Signature \_\_\_\_\_  
Name Nancy A. Fickle \_\_\_\_\_

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

In the Matter of Application No. 76/372,550 ARDENBEAUTY

-----  
THE WET SEAL, INC., )  
 )  
 )  
Opposer, ) Opposition No. 91157022  
 )  
v. )  
 )  
FD MANAGEMENT, INC., )  
 )  
 )  
Applicant. )  
 )  
-----

**APPLICANT'S TRIAL BRIEF**

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

In the Matter of Application No. 76/372,550 ARDENBEAUTY

THE WET SEAL, INC.,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. 91157022
	)	
FD MANAGEMENT, INC.,	)	
	)	
Applicant.	)	
	)	
	)	
	)	
	)	

**APPLICANT'S TRIAL BRIEF**

TO THE HONORABLE UNITED STATES TRADEMARK TRIAL AND APPEAL BOARD:

Applicant, FD Management, Inc. ("FD" or "Applicant"), in further support of its U.S. Trademark Application No. 76/372,500 (the "Application") for the mark ARDENBEAUTY, and in rebuttal to the Trial Brief of Opposer, The Wet Seal, Inc., d/b/a/ Arden B ("Arden B" or "Opposer") in support of its Opposition No. 91167022 to the Application, would respectfully show the Board as follows:

**I. RECORD EVIDENCE**

The evidence of record consists of:

- (1) U.S. Application No. 76/372,550 ARDENBEAUTY (the "Application").
- (2) Trial testimony of Laura Nicholas on behalf of Arden B ("Nicholas Dep.").
- (3) Trial testimony of James Perry on behalf of FD ("Perry Dep.").

- (4) Trial testimony of Ronald Rolleston on behalf of FD (“Rolleston Dep.”).
- (5) Arden B’s Notice of Reliance Pursuant to 37 C.F.R. § 2.122(e) dated February 24, 2005, which includes the Declaration of Vicki Martin and attachments, and the Declaration of Patrick Dredden and attached business records produced in this action (“2/24/05 Notice”).
- (6) Arden B’s Notice of Reliance Under Rule 2.122(e) and attachments dated June 9, 2005 (“6/9/05 Notice”)<sup>1</sup>.
- (7) FD’s Notice of Reliance Under 2.122(d) and attachments dated 3/30/05 (“3/30/05 Notice”).
- (8) FD’s Notice of Reliance Under Rule 2.122(e) dated 4/8/05 and attachments (“4/8/05 Notice”).

## **II. STATEMENT OF THE ISSUES**

1. Whether Opposer, a clothing retailer that does not sell cosmetics or fragrances and which did not begin using its “ARDEN B” mark on women’s clothing until 1997 and on clothing stores until 1999, has priority over Applicant, which has been selling cosmetics and fragrances under the famous “Elizabeth Arden” and “Arden” trademarks since 1910, with registrations of “Elizabeth Arden” for cosmetics and fragrances going back to 1922.
  - a. Whether Applicant’s 85 year priority of use over Opposer of the mark “Arden” for fragrances and cosmetics precludes any damage to Opposer from registration of the ARDENBEAUTY mark.
  - b. Whether Opposer’s prior contractual agreement with Applicant in which Opposer agreed never to use or seek to register the mark ARDEN B in any manner on

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<sup>1</sup> Applicant restates and incorporates by reference the objections raised in its Motion to Strike Opposer’s June 9, 2005 Notice of Reliance, inasmuch as the evidence attached thereto is not rebuttal evidence.

fragrances, cosmetics and toiletries, precludes any damage to Opposer from registration of the ARDENBEAUTY mark, and negates any potential likelihood of confusion between Opposer's ARDEN B mark and Applicant's ARDENBEAUTY mark.

c. Whether Applicant, with 85 years of priority of use of "Arden" over Opposer, can add the merely descriptive word "beauty" to its famous Arden trademark for cosmetics and fragrances and register that combination term for cosmetics and fragrances.

d. Whether Opposer, a much junior common law user of Arden, and then only as "Arden B" and only for clothing, jewelry, handbags and retail clothing stores, can be damaged by the Applicant (and senior user's) registration of ARDENBEAUTY for cosmetics and fragrances.

2. Whether Applicant's ARDENBEAUTY mark, as used in connection with fragrances, cosmetics and related products, so resembles Opposer's ARDEN B mark, as used solely connection with its retail stores, clothing, jewelry and handbag products, is to be likely, when applied to Applicant's goods, to cause confusion, mistake or deception among consumers.

### **III. INTRODUCTION**

The Opposer puts forward a very strange and dangerous theory of trademark law to this Board in opposing the application of ARDENBEAUTY. According to its testifying representative, Opposer began use of the term ARDEN B on women's clothing, jewelry, handbags in 1997 and opened its first retail apparel stores in November 1999 (Nicholas Dep. at

68:15-20), and it applied to register ARDEN B for these goods shortly thereafter. That application was opposed by Applicant herein, which had been using “Elizabeth Arden” and “Arden” on cosmetics, fragrances and toiletries as far back as 1910, and first registered “Elizabeth Arden” in 1922 for “skin lotions and creams [,reducing lotion, bleach cream,] and depilatory”. In order to settle that Opposition in 2001, the Opposer herein both abandoned its Arden B applications, Serial Nos. 75/365,543, 75/394,241 and 75/583,075, and re-filed on March 6, 2002, two (2) applications for Arden B in a stylized form for: 1) retail apparel stores and 2) women’s clothing, jewelry and handbags, which registered on December 16, 2003 as Registration No. 2,795,689 and August 31, 2004 as Registration No. 2,879,970, respectively. In addition, Opposer herein contractually agreed that it would never use nor seek to register ARDEN B for cosmetics, fragrances, skin care, and hair care products, and that it would only use and register ARDEN B in a highly stylized form. (Perry Dep. at 7-8 and Exhibit 1 thereto.)

Nevertheless, even though Opposer does not own a registration of, and has never sold cosmetics, fragrances or toiletries using the term ARDEN B; even though Opposer has a contractual agreement with Applicant that it may never use or seek to register ARDEN B for cosmetics, fragrances and toiletries; and even though Applicant herein has used “Arden” and “Elizabeth Arden” on cosmetics, fragrances and toiletries since 1910 and owns registrations for such goods going back to 1922; and even though Opposer did not put its two (2) 2002 registrations of Arden B into evidence,<sup>2</sup> the Opposer still filed this Opposition to prevent Elizabeth Arden from registering ARDENBEAUTY for fragrances, cosmetics and toiletries.

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<sup>2</sup> The claimed dates of first use in Opposer’s Registration Nos. 2,795,689 and 2,879,970, neither of which is of record in this matter, are April, 2002 and March, 2002, respectively.

#### **IV. SUMMARY OF ARGUMENTS**

In order to successfully oppose the registration of ARDENBEAUTY, Opposer must demonstrate that it will be legally damaged by such registration. 15 U.S.C. §1063. This requires a showing of priority, enforceable trademark rights and likelihood of confusion. Opposer cannot succeed on any of these requirements. First and foremost, it simply does not have priority of use of the "Arden" mark for fragrances, cosmetics or any related products. Opposer has no trademark rights in ARDEN B for such goods, and makes no claim of such rights. Moreover, given that Applicant has been selling cosmetics, fragrances toiletries and related goods under the "Arden" and "Elizabeth Arden" marks for 90 years, Opposer cannot show that any consumer would likely be confused between the fragrance and cosmetic products sold under the ARDENBEAUTY mark, and Opposer's retail ARDEN B stores, which sell only clothing and related accessories, and not cosmetics and fragrances. Indeed, Opposer is precluded, by virtue of an earlier contractual agreement with Applicant's predecessor, from ever using or trying to register the ARDEN B mark for fragrances, cosmetics and toiletries -- or even for sunglasses.

Finally, Opposer argues that registration should be refused under Section 1(b), because Applicant purportedly admitted during trial testimony that it had no intention of using the ARDENBEAUTY mark for some of the goods for which it sought registration. As will be demonstrated, however, Opposer has misstated the testimony of Applicant's representative, Ronald Rolleston, regarding Applicant's intentions for the ARDENBEAUTY mark.<sup>3</sup> Accordingly, Opposer's Section 1(b) grounds for refusal of registration should be dismissed out-of-hand.

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<sup>3</sup> In fact, Applicant is currently using the ARDENBEAUTY mark on a wide variety of fragrance and cosmetic products, and has been selling such products nationally since mid-2002. (Rolleston Dep. at 48)

## V. ARGUMENT

- A. **By virtue of Applicant's 90 years' of prior use of the "Arden" mark for cosmetics, fragrances and related products, its numerous trademark registrations of "Elizabeth Arden" and variants, and its extensive advertising and sale of cosmetics and fragrances under the marks "Elizabeth Arden" and "Arden", Applicant owns a famous mark for those goods.**

The "Elizabeth Arden" name is one of the most famous trademarks in the cosmetics and fragrance industry. First registered as a trademark in 1922, with use back to 1910, "Elizabeth Arden" and "Arden" have been used continuously for many decades to identify a wide variety of cosmetic and fragrance products. (Rolleston Dep. at 11:3-6.) The Elizabeth Arden Red Door Salon on Fifth Avenue in New York City is a New York institution, and has been cited as an example of a famous trademark by the Ninth Circuit in *Grupo Gigante SA de CV v. Dallo & Co.*, 73 U.S.P.Q.2d 1258 (9th Cir. 2004) ("[I]f someone opened a high-end salon with a red door in Wellington and called it Elizabeth Arden's, women might very well go there because they thought they were going to an affiliate of the Elizabeth Arden chain, even if there had not been any other Elizabeth Ardens in New Zealand prior to the salon's opening. If it was not an affiliate, just a local store with no connection, customers would be fooled. The real Elizabeth Arden chain might lose business if word spread that the Wellington salon was nothing special.").

Over the years, Applicant has spent millions of dollars advertising and promoting fragrance and cosmetics products bearing the "Elizabeth Arden" and "Arden" marks. For the ARDENBEAUTY fragrance alone, Applicant spent an estimated \$4 million in advertising. (Rolleston Dep. at Exhibit 9.) From its launch in mid-2002 through January 31, 2005, retail sales of ARDENBEAUTY products totaled more than \$26 million. (Rolleston Dep. at Exhibit 31.) Applicant owns eight (8) registrations of ELIZABETH ARDEN for cosmetics and fragrances. (3/30/05 Notice of Reliance.) Applicant's many years of use, extensive advertising, significant

sales and numerous registrations clearly establish that the “Arden” mark is famous and entitled to a wide scope of protection. *Recot, Inc. v. M.C. Becton*, 54 U.S.P.Q.2d 1894 (Fed. Cir. 2000) (“Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark.”). Moreover, by virtue of this extensive and long-standing use, advertising and sales, Applicant established common law rights in the “Arden” mark *per se* for cosmetics, fragrances and toiletries long prior to Opposer’s first use of its ARDEN B mark for clothing and accessories, and for retail clothing stores.

**B. Adding the merely descriptive word “Beauty” to its famous “Arden” mark does not affect Applicant’s priority of use of the “Arden” mark.**

It is not surprising that the word “beauty” is widely used in the cosmetics and fragrance industry to describe a whole host of products intended to make the user feel more attractive. In fact, there are nearly two hundred active third-party registrations containing the word “beauty” for personal care products in International Class 3, which demonstrates that the USPTO does not consider the word to have origin-indicating capacity. (4/8/05 Notice of Reliance) Clearly, the merely descriptive word “beauty” contributes little to the overall commercial impression created by the ARDENBEAUTY mark. *Knight Textile Corp. v. Jones Investment Co.*, 75 U.S.P.Q.2d 1313 (TTAB 2005) (confusion between “Essentials” and “Norton McNaughton Essentials” unlikely because house mark renders the two marks sufficiently distinguishable). Rather, “Arden” is the dominant portion of the mark, ensuring that consumers will associate a fragrance product called ARDENBEAUTY with the famous “Elizabeth Arden” and “Arden” trademarks, and the fragrance and cosmetic products they have known for decades that have been sold under those marks. Indeed, Applicant chose the ARDENBEAUTY name specifically to “capitalize on the rich heritage of the Elizabeth Arden fragrances.” (Rolleston Dep. at 22:13-14.) And that “rich heritage” predates Opposer’s use of ARDEN B by more than 80 years.

**C. Applicant's priority of use and numerous registrations of "Elizabeth Arden" and "Arden" preclude any damage to Opposer as a matter of law, since Opposer has no rights in ARDEN B for cosmetics and fragrances.**

Opposer is a specialty retail clothing store that sells only its own ARDEN B branded products. (Nicholas Dep. at 70:13-16.) Those products are young women's tops, bottoms, outerwear, suiting, dresses, shoes and accessories. (Nicholas Dep. at 24:25 and 25:1.) ARDEN B stores do not sell cosmetics or fragrance products. (Nicholas Dep. at 47:16-18; 65:1-22.) Opposer considers its direct competitors to be other specialty retail clothing stores, such as bebe, BCBG and Anthropology. (Nicholas Dep. at 24:11-14.) According to its Notice of Opposition herein, Opposer uses its ARDEN B mark "in connection with the promotion and sale of women's jewelry, clothing including outerwear, underwear, swimwear, handwear, footwear, purses and bags, hair ornaments and the operation of retail apparel stores featuring women's clothing, footwear, hats and clothing accessories."

Opposer makes no claim to rights in ARDEN B for fragrances, cosmetics or toiletries of any type, and did not even allege in its Notice of Opposition that the goods and services it sells under its ARDEN B mark are similar or related to those of the Applicant, as set forth in Application Serial No. 76/372,550: a required element to sustain an Opposition. Clearly, Opposer has absolutely no rights in its ARDEN B mark for cosmetics, fragrances and toiletries, nor does it have priority of use.<sup>4</sup> Opposer simply cannot demonstrate that it has any enforceable rights in ARDEN B that will be damaged by the registration of ARDENBEAUTY.

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<sup>4</sup> Opposer cannot rely on its Registration Nos. 2,879,970 and 2,795,689 for ARDEN B to establish priority over Applicant under *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400 (CCPA 1974). First, any priority accorded Opposer would be limited to the goods described in Opposer's registrations. *San Fernando Elec. Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683 (CCPA 1977). However, Opposer has neither pleaded its Registrations, nor put them into evidence pursuant to 37 CFR § 2.122(d), presumably because the first use dates recited in those registrations are subsequent to Applicant's filing date of February 5, 2002. Thus, such Registrations have no evidentiary weight in these proceedings.

**D. Opposer will not be damaged by the registration of ARDENBEAUTY for fragrance and cosmetic products because Opposer is contractually precluded from using its ARDEN B mark on any fragrance or cosmetic products.**

At the time Opposer applied for registration of its ARDEN B marks, Applicant's predecessor opposed such registrations. (2/24/05 Notice of Reliance at A and B) The parties settled those Oppositions by entering into an agreement whereby Opposer 1) abandoned those applications, later re-filing for them in a distinctive typestyle; and 2) agreed never to use the ARDEN B mark on or in connection with:

cosmetics, skin care, hair care, fragrance products, eau de toilette, eau de cologne, eau de parfum, parfum, body lotion, body talc and powder, bath and shower gel, body oil, body soap, body wash, body splash, facial moisturizer, facial wash, after-shave lotion/balm, deodorants, antiperspirants and such other products commonly sold in a full fragrance line of goods or their packaging, or as the name of spas, salons or stores specializing in the sale of cosmetics, skin care, hair care or body products or services in the United States.

(Perry Dep. at Exhibit 1.)

For Opposer to now claim that it will be damaged by the registration of ARDENBEAUTY by Applicant, who clearly has priority and valid trademark rights in "Arden", for very different products that Opposer has never sold, and is contractually precluded from ever providing, is frivolous, and is a bald-faced attempt to establish rights in gross for its ARDEN B mark.

**E. There is no likelihood of confusion between Opposer's ARDEN B mark on its goods and services and Applicant's ARDENBEAUTY mark on the goods set forth in its Application.**

Opposer devotes a considerable portion of its Trial Brief to a discussion of likelihood of confusion under the *du Pont* factors. The issue of likelihood of confusion does not even need to be addressed, inasmuch as Opposer cannot establish the requisite priority of use in the "Arden"

mark. Thus, its arguments should properly be ignored by this Board. However, to the extent this tribunal determines that Opposer's asserted common law rights in "Arden" for clothing and a chain of retail clothing stores, based upon claimed common law use since 1997, trump Applicant's 90 years of registrations and common law rights in "Elizabeth Arden" and "Arden" for fragrances, cosmetics and toiletries, a few of Opposer's more egregious misstatements of law and fact need to be addressed.

First, there is no *per se* rule that cosmetics and clothing are related such that there will be a likelihood of confusion when the same or similar mark is used for these respective goods.<sup>5</sup> *In re Jacques Bernier, Inc.*, 1 U.S.P.Q.2d 1924 (TTAB 1987) ("Each case must be resolved on its own facts."). Indeed, in every case cited by Opposer where clothing and cosmetics were found to be related, likelihood of confusion was found because the Opposer was the senior user of a well-known mark that was being adopted by a junior user. *See, e.g., In re Arthur Holland, Inc.*, 192 U.S.P.Q. 494 (TTAB 1976) (owner of LEVI'S mark for clothing opposed registration of LEVI'S for use on men's cologne); *The All England Lawn Tennis Club (Wimbledon) Limited v. Creations Aromatiques, Inc.*, 220 U.S.P.Q. 1069 (TTAB 1983) (owner of famous "Wimbledon" mark for clothing opposed registration of "Wimbledon" for cologne). In this case, the roles are reversed: the junior user is opposing the senior user and owner of a famous trademark. Moreover, in this case the Applicant is not expanding into a new field; rather, it is applying for precisely the types of goods it has sold under the "Arden" and "Elizabeth Arden" marks for more than 90 years. Under these facts, confusion is not likely, and this factor favors Applicant.

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<sup>5</sup> Moreover, this argument should also be ignored, inasmuch as Opposer did not allege in its Notice of Opposition that its goods and services were related to those of Applicant.

In further support of its strained assertion that confusion is likely because consumers will assume that the same marks used on both clothing and women's cosmetics indicate a common source, Opposer belatedly submitted a list of third party registrations of trademark owners who use the same mark for cosmetics in International Class 3 and clothing in International Class 25. *See* 6/9/05 Notice of Reliance and Opposer's Trial Brief at 13-14. Apart from being irrelevant, because Opposer is contractually barred from selling cosmetics under its ARDEN B mark, this evidence may not be considered by this Board because it was filed outside of Opposer's testimony period and is being used to support its case-in-chief and not as rebuttal evidence. *See International Order of Job's Daughters v. Lindeburg & Co.*, 727 F.2d 1087, 220 U.S.P.Q. 1017 (Fed. Cir. 1984) and *American Speech-Language-Hearing Association v. National Hearing Aid Society*, 224 U.S.P.Q. 798 (TTAB 1985) (proper rebuttal testimony is introduced solely to deny, explain or otherwise discredit the facts and witnesses of applicant).

Opposer also asserts that the parties' target markets and trade channels are identical: women of all ages shopping in malls. Opposer not only oversimplifies its analysis, it contradicts the testimony of its own witness, Laura Nicholas, who stated "[o]ur branding focus is a young woman in her mid to late twenties." (Nicholas Dep. at 24:21-22.) In an analogous case discussing the similarity of trade channels and target markets for products sold in supermarkets, the Court of Customs and Patent Appeals stated:

A wide variety of products, not only from different manufacturers within an industry but also from diverse industries, have been brought together in the modern supermarket for the convenience of the customer. The mere existence of such an environment should not foreclose further inquiry into the likelihood of confusion arising from the use of similar marks on any goods so displayed. (Citation omitted) The means of distribution and sale, although certainly relevant, are areas of peripheral inquiry. The fundamental inquiry mandated by Section 2(d) goes to the

cumulative effect of differences in the essential characteristics of the goods and differences in the marks. (Emphasis in original.)

*Federated Foods, Inc. v. Fort Howard Paper Company*, 544 F.2d 1098, 192 U.S.P.Q.2d 24 (CCPA 1976).

In this case, Opposer's goods are only sold in Opposer's stores, and Opposer does not sell Applicant's products. Thus, the products will *never* be sold together. The mere fact that Opposer's stores are in shopping malls, and Applicant's products are sold in department stores which are generally located in shopping malls, simply does not support a blanket finding that the target markets and trade channels are identical.<sup>6</sup> Thus, these factors favor Applicant and do not support a finding of likelihood of confusion.

Finally, Opposer argues that the "fame of the prior mark" factor weighs in its favor. Clearly, it does not, and such a statement fails the red-face test. There is a famous mark in this case, but it is owned by Applicant. The Board must consider the fame of the Applicant's "Elizabeth Arden" and "Arden" marks in any analysis of the *du Pont* factors. *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1992) ("The fifth *du Pont* factor, fame of the prior mark, plays a dominant role in cases featuring a famous or strong mark."); *see also Bose Corp. v. QSC Audio Products Inc.*, 63 U.S.P.Q.2d 1303 (Fed. Cir. June 14, 2002); *Recot, Inc. v. M.C. Becton*, 54 U.S.P.Q.2d 1894 (Fed Cir. 2000) ("fame deserves its full measure of weight in assessing likelihood of confusion").

In its Trial Brief, Opposer attempts to establish that its ARDEN B mark is famous by virtue of its seven years use of the mark in less than one hundred specialty stores. Opposer has submitted evidence of less than \$5 million in advertising expense in total over seven years, and

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<sup>6</sup> Furthermore, Applicant's products are not sold exclusively in department stores. In fact, the ARDENBEAUTY products are now being sold in mass merchandisers, such as Wal-Mart, grocery stores and drug stores -- none of which are stores where Opposer's products would be found. (Rolleston Dep. at 89-91.)

less than \$20 million in sales for that seven year period. Compared with Applicant's \$4 million in advertising *on just the ARDENBEAUTY line*, and \$26 million in sales *on just the ARDENBEAUTY line*, and the 8500 stores in which ARDENBEAUTY has been sold since its introduction in 2002, not to mention Applicant's 85 years of use, advertising and promotion of "Elizabeth Arden" and "Arden" fragrances, cosmetics and toiletries, it is absurd to suggest that the "fame of the prior mark" factor weighs in Opposer's favor. Since Applicant clearly has priority in use of "Arden" and "Elizabeth Arden", and these marks are indeed famous for fragrances, cosmetics and toiletry products, the "fame of the prior mark" factor weighs heavily in Applicant's favor.

**F. Opposer's assertion that the Application is *void ab initio* is premised on a misstatement of the testimony, and is not supported by the facts in evidence.**

In a sign of sheer desperation, Opposer argues that Applicant "admitted" that it had no intention of using the ARDENBEAUTY mark for some of the goods recited in the Application, rendering the Application void *ab initio*. In support, Opposer cites to the testimony of Ronald Rolleston, stating that Mr. Rolleston testified that Applicant "never had any plans to use the mark ARDENBEAUTY on shampoo and candles." As an initial matter, the Application is confined to related goods in International Class 3, and the description of goods and services does not list "candles". Nevertheless, and to the extent this even makes a difference, since Applicant has not yet filed its Statement of Use, here is what Mr. Rolleston actually said in the portions of testimony cited by Opposer in its Trial Brief:

Q: What other products were you intending to sell under the trademark, under the new brand?

A: Everything that's listed here [in Rolleston Exhibit No. 2].

Q: Anything else that's not listed there?

A: **Yes. Eventually we would put these things together in gift sets, we eventually would make new product types with it. That's all part of what we do.**

\* \* \* \* \*

Q: How about ardenbeauty candles, were you planning on selling ardenbeauty candles?

A: That could have happened.

Q: Did you plan for that?

A: No. I have people who do stuff like that for me. There is a group of women whose whole lives are spent finding marvelous ways to extend my fragrances in a variety of different areas to that we can promote it. There have been Elizabeth Arden candles in the past. But, no, I didn't sit down and go let's make sure we formulate the oils so that we can have a candle. But I wouldn't do that anyhow.

Q: Have any steps been taken to produce an ardenbeauty candle?

A: You know what, I don't know. I would have to go back and ask one of the girls who works for me who does that. That could very easily have been considered. I don't know.

\* \* \* \* \*

Q: How about shampoos?

A: We might have considered doing it at some point in time. But at that point I hadn't decided to do a shampoo **or not do a shampoo**. I mean, it wouldn't preclude me from it because of the nature of formulations. That's a category that I'm familiar with.

(Rolleston Dep. at 85-88.)

Without question, Applicant is making extensive use of ARDENBEAUTY on a wide variety of goods covered by the Application, and Mr. Rolleston certainly did not "admit" that Applicant never had a bona fide intention of using the ARDENBEAUTY name on any of the goods listed in the Application. This argument is specious, without merit, and does not establish a grounds for refusal of the Application under Section 1(b).

## VI. CONCLUSION

The only thing difficult about this case is figuring out why Opposer brought it. Opposer clearly does not have prior common law rights in "Arden"; it has not plead or relied upon its registrations of ARDEN B for clothing accessories and retail clothing stores, nor did it allege in its Notice of Opposition that the goods it sells under its ARDEN B mark are similar or related to the goods sold under the ARDENBEAUTY mark. Thus, Opposer does not even get to the likelihood of confusion analysis under the *du Pont* factors. And, even if it did, all of those factors heavily favor Applicant, which has been selling cosmetics, fragrances and toiletries under the "Elizabeth Arden" and "Arden" marks for more than 90 years.

Opposer has failed to demonstrate any superior rights in ARDEN B, or that it will be damaged by the registration of ARDENBEAUTY; accordingly, this Opposition should be dismissed.

Dated: September 7, 2005

Respectfully submitted,



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**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing Applicant's Trial Brief has been served on John M. Cone, counsel for Opposer, by mailing said copy on September 7, 2005, via First Class Mail, postage prepaid to John M. Cone, c/o Akin Gump Strauss Hauer & Feld LLP, 1700 Pacific Avenue, Suite 4100, Dallas, Texas 75201-4675

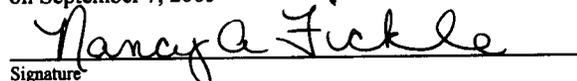
  
Nancy A. Fickle

**CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8**

I hereby certify that three copies of the foregoing Applicant's Trial Brief enclosed herein are being deposited with the United States Postal Service with sufficient postage as Express Mail in an envelope addressed to:

United States Patent and Trademark Office  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

on September 7, 2005



Signature

Nancy A. Fickle

Name

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

In the Matter of Application No. 76/372,550 ARDENBEAUTY

-----  
THE WET SEAL, INC., )  
 )  
 )  
Opposer, ) Opposition No. 91157022  
 )  
v. )  
 )  
FD MANAGEMENT, INC., )  
 )  
 )  
Applicant. )  
 )  
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**APPLICANT'S TRIAL BRIEF**

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

In the Matter of Application No. 76/372,550 ARDENBEAUTY

THE WET SEAL, INC.,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. 91157022
	)	
FD MANAGEMENT, INC.,	)	
	)	
Applicant.	)	
	)	
	)	
	)	
	)	

**APPLICANT'S TRIAL BRIEF**

TO THE HONORABLE UNITED STATES TRADEMARK TRIAL AND APPEAL BOARD:

Applicant, FD Management, Inc. ("FD" or "Applicant"), in further support of its U.S. Trademark Application No. 76/372,500 (the "Application") for the mark ARDENBEAUTY, and in rebuttal to the Trial Brief of Opposer, The Wet Seal, Inc., d/b/a/ Arden B ("Arden B" or "Opposer") in support of its Opposition No. 91167022 to the Application, would respectfully show the Board as follows:

**I. RECORD EVIDENCE**

The evidence of record consists of:

- (1) U.S. Application No. 76/372,550 ARDENBEAUTY (the "Application").
- (2) Trial testimony of Laura Nicholas on behalf of Arden B ("Nicholas Dep.").
- (3) Trial testimony of James Perry on behalf of FD ("Perry Dep.").

- (4) Trial testimony of Ronald Rolleston on behalf of FD (“Rolleston Dep.”).
- (5) Arden B’s Notice of Reliance Pursuant to 37 C.F.R. § 2.122(e) dated February 24, 2005, which includes the Declaration of Vicki Martin and attachments, and the Declaration of Patrick Dredden and attached business records produced in this action (“2/24/05 Notice”).
- (6) Arden B’s Notice of Reliance Under Rule 2.122(e) and attachments dated June 9, 2005 (“6/9/05 Notice”)<sup>1</sup>.
- (7) FD’s Notice of Reliance Under 2.122(d) and attachments dated 3/30/05 (“3/30/05 Notice”).
- (8) FD’s Notice of Reliance Under Rule 2.122(e) dated 4/8/05 and attachments (“4/8/05 Notice”).

## **II. STATEMENT OF THE ISSUES**

1. Whether Opposer, a clothing retailer that does not sell cosmetics or fragrances and which did not begin using its “ARDEN B” mark on women’s clothing until 1997 and on clothing stores until 1999, has priority over Applicant, which has been selling cosmetics and fragrances under the famous “Elizabeth Arden” and “Arden” trademarks since 1910, with registrations of “Elizabeth Arden” for cosmetics and fragrances going back to 1922.
  - a. Whether Applicant’s 85 year priority of use over Opposer of the mark “Arden” for fragrances and cosmetics precludes any damage to Opposer from registration of the ARDENBEAUTY mark.
  - b. Whether Opposer’s prior contractual agreement with Applicant in which Opposer agreed never to use or seek to register the mark ARDEN B in any manner on

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<sup>1</sup> Applicant restates and incorporates by reference the objections raised in its Motion to Strike Opposer’s June 9, 2005 Notice of Reliance, inasmuch as the evidence attached thereto is not rebuttal evidence.

fragrances, cosmetics and toiletries, precludes any damage to Opposer from registration of the ARDENBEAUTY mark, and negates any potential likelihood of confusion between Opposer's ARDEN B mark and Applicant's ARDENBEAUTY mark.

- c. Whether Applicant, with 85 years of priority of use of "Arden" over Opposer, can add the merely descriptive word "beauty" to its famous Arden trademark for cosmetics and fragrances and register that combination term for cosmetics and fragrances.
- d. Whether Opposer, a much junior common law user of Arden, and then only as "Arden B" and only for clothing, jewelry, handbags and retail clothing stores, can be damaged by the Applicant (and senior user's) registration of ARDENBEAUTY for cosmetics and fragrances.

- 2. Whether Applicant's ARDENBEAUTY mark, as used in connection with fragrances, cosmetics and related products, so resembles Opposer's ARDEN B mark, as used solely connection with its retail stores, clothing, jewelry and handbag products, is to be likely, when applied to Applicant's goods, to cause confusion, mistake or deception among consumers.

### **III. INTRODUCTION**

The Opposer puts forward a very strange and dangerous theory of trademark law to this Board in opposing the application of ARDENBEAUTY. According to its testifying representative, Opposer began use of the term ARDEN B on women's clothing, jewelry, handbags in 1997 and opened its first retail apparel stores in November 1999 (Nicholas Dep. at

68:15-20), and it applied to register ARDEN B for these goods shortly thereafter. That application was opposed by Applicant herein, which had been using “Elizabeth Arden” and “Arden” on cosmetics, fragrances and toiletries as far back as 1910, and first registered “Elizabeth Arden” in 1922 for “skin lotions and creams [,reducing lotion, bleach cream,] and depilatory”. In order to settle that Opposition in 2001, the Opposer herein both abandoned its Arden B applications, Serial Nos. 75/365,543, 75/394,241 and 75/583,075, and re-filed on March 6, 2002, two (2) applications for Arden B in a stylized form for: 1) retail apparel stores and 2) women’s clothing, jewelry and handbags, which registered on December 16, 2003 as Registration No. 2,795,689 and August 31, 2004 as Registration No. 2,879,970, respectively. In addition, Opposer herein contractually agreed that it would never use nor seek to register ARDEN B for cosmetics, fragrances, skin care, and hair care products, and that it would only use and register ARDEN B in a highly stylized form. (Perry Dep. at 7-8 and Exhibit 1 thereto.)

Nevertheless, even though Opposer does not own a registration of, and has never sold cosmetics, fragrances or toiletries using the term ARDEN B; even though Opposer has a contractual agreement with Applicant that it may never use or seek to register ARDEN B for cosmetics, fragrances and toiletries; and even though Applicant herein has used “Arden” and “Elizabeth Arden” on cosmetics, fragrances and toiletries since 1910 and owns registrations for such goods going back to 1922; and even though Opposer did not put its two (2) 2002 registrations of Arden B into evidence,<sup>2</sup> the Opposer still filed this Opposition to prevent Elizabeth Arden from registering ARDENBEAUTY for fragrances, cosmetics and toiletries.

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<sup>2</sup> The claimed dates of first use in Opposer’s Registration Nos. 2,795,689 and 2,879,970, neither of which is of record in this matter, are April, 2002 and March, 2002, respectively.

#### **IV. SUMMARY OF ARGUMENTS**

In order to successfully oppose the registration of ARDENBEAUTY, Opposer must demonstrate that it will be legally damaged by such registration. 15 U.S.C. §1063. This requires a showing of priority, enforceable trademark rights and likelihood of confusion. Opposer cannot succeed on any of these requirements. First and foremost, it simply does not have priority of use of the "Arden" mark for fragrances, cosmetics or any related products. Opposer has no trademark rights in ARDEN B for such goods, and makes no claim of such rights. Moreover, given that Applicant has been selling cosmetics, fragrances toiletries and related goods under the "Arden" and "Elizabeth Arden" marks for 90 years, Opposer cannot show that any consumer would likely be confused between the fragrance and cosmetic products sold under the ARDENBEAUTY mark, and Opposer's retail ARDEN B stores, which sell only clothing and related accessories, and not cosmetics and fragrances. Indeed, Opposer is precluded, by virtue of an earlier contractual agreement with Applicant's predecessor, from ever using or trying to register the ARDEN B mark for fragrances, cosmetics and toiletries -- or even for sunglasses.

Finally, Opposer argues that registration should be refused under Section 1(b), because Applicant purportedly admitted during trial testimony that it had no intention of using the ARDENBEAUTY mark for some of the goods for which it sought registration. As will be demonstrated, however, Opposer has misstated the testimony of Applicant's representative, Ronald Rolleston, regarding Applicant's intentions for the ARDENBEAUTY mark.<sup>3</sup> Accordingly, Opposer's Section 1(b) grounds for refusal of registration should be dismissed out-of-hand.

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<sup>3</sup> In fact, Applicant is currently using the ARDENBEAUTY mark on a wide variety of fragrance and cosmetic products, and has been selling such products nationally since mid-2002. (Rolleston Dep. at 48)

## V. ARGUMENT

- A. **By virtue of Applicant's 90 years' of prior use of the "Arden" mark for cosmetics, fragrances and related products, its numerous trademark registrations of "Elizabeth Arden" and variants, and its extensive advertising and sale of cosmetics and fragrances under the marks "Elizabeth Arden" and "Arden", Applicant owns a famous mark for those goods.**

The "Elizabeth Arden" name is one of the most famous trademarks in the cosmetics and fragrance industry. First registered as a trademark in 1922, with use back to 1910, "Elizabeth Arden" and "Arden" have been used continuously for many decades to identify a wide variety of cosmetic and fragrance products. (Rolleston Dep. at 11:3-6.) The Elizabeth Arden Red Door Salon on Fifth Avenue in New York City is a New York institution, and has been cited as an example of a famous trademark by the Ninth Circuit in *Grupo Gigante SA de CV v. Dallo & Co.*, 73 U.S.P.Q.2d 1258 (9th Cir. 2004) ("[I]f someone opened a high-end salon with a red door in Wellington and called it Elizabeth Arden's, women might very well go there because they thought they were going to an affiliate of the Elizabeth Arden chain, even if there had not been any other Elizabeth Ardens in New Zealand prior to the salon's opening. If it was not an affiliate, just a local store with no connection, customers would be fooled. The real Elizabeth Arden chain might lose business if word spread that the Wellington salon was nothing special.").

Over the years, Applicant has spent millions of dollars advertising and promoting fragrance and cosmetics products bearing the "Elizabeth Arden" and "Arden" marks. For the ARDENBEAUTY fragrance alone, Applicant spent an estimated \$4 million in advertising. (Rolleston Dep. at Exhibit 9.) From its launch in mid-2002 through January 31, 2005, retail sales of ARDENBEAUTY products totaled more than \$26 million. (Rolleston Dep. at Exhibit 31.) Applicant owns eight (8) registrations of ELIZABETH ARDEN for cosmetics and fragrances. (3/30/05 Notice of Reliance.) Applicant's many years of use, extensive advertising, significant

sales and numerous registrations clearly establish that the “Arden” mark is famous and entitled to a wide scope of protection. *Recot, Inc. v. M.C. Becton*, 54 U.S.P.Q.2d 1894 (Fed. Cir. 2000) (“Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark.”). Moreover, by virtue of this extensive and long-standing use, advertising and sales, Applicant established common law rights in the “Arden” mark *per se* for cosmetics, fragrances and toiletries long prior to Opposer’s first use of its ARDEN B mark for clothing and accessories, and for retail clothing stores.

**B. Adding the merely descriptive word “Beauty” to its famous “Arden” mark does not affect Applicant’s priority of use of the “Arden” mark.**

It is not surprising that the word “beauty” is widely used in the cosmetics and fragrance industry to describe a whole host of products intended to make the user feel more attractive. In fact, there are nearly two hundred active third-party registrations containing the word “beauty” for personal care products in International Class 3, which demonstrates that the USPTO does not consider the word to have origin-indicating capacity. (4/8/05 Notice of Reliance) Clearly, the merely descriptive word “beauty” contributes little to the overall commercial impression created by the ARDENBEAUTY mark. *Knight Textile Corp. v. Jones Investment Co.*, 75 U.S.P.Q.2d 1313 (TTAB 2005) (confusion between “Essentials” and “Norton McNaughton Essentials” unlikely because house mark renders the two marks sufficiently distinguishable). Rather, “Arden” is the dominant portion of the mark, ensuring that consumers will associate a fragrance product called ARDENBEAUTY with the famous “Elizabeth Arden” and “Arden” trademarks, and the fragrance and cosmetic products they have known for decades that have been sold under those marks. Indeed, Applicant chose the ARDENBEAUTY name specifically to “capitalize on the rich heritage of the Elizabeth Arden fragrances.” (Rolleston Dep. at 22:13-14.) And that “rich heritage” predates Opposer’s use of ARDEN B by more than 80 years.

**C. Applicant's priority of use and numerous registrations of "Elizabeth Arden" and "Arden" preclude any damage to Opposer as a matter of law, since Opposer has no rights in ARDEN B for cosmetics and fragrances.**

Opposer is a specialty retail clothing store that sells only its own ARDEN B branded products. (Nicholas Dep. at 70:13-16.) Those products are young women's tops, bottoms, outerwear, suiting, dresses, shoes and accessories. (Nicholas Dep. at 24:25 and 25:1.) ARDEN B stores do not sell cosmetics or fragrance products. (Nicholas Dep. at 47:16-18; 65:1-22.) Opposer considers its direct competitors to be other specialty retail clothing stores, such as bebe, BCBG and Anthropology. (Nicholas Dep. at 24:11-14.) According to its Notice of Opposition herein, Opposer uses its ARDEN B mark "in connection with the promotion and sale of women's jewelry, clothing including outerwear, underwear, swimwear, handwear, footwear, purses and bags, hair ornaments and the operation of retail apparel stores featuring women's clothing, footwear, hats and clothing accessories."

Opposer makes no claim to rights in ARDEN B for fragrances, cosmetics or toiletries of any type, and did not even allege in its Notice of Opposition that the goods and services it sells under its ARDEN B mark are similar or related to those of the Applicant, as set forth in Application Serial No. 76/372,550: a required element to sustain an Opposition. Clearly, Opposer has absolutely no rights in its ARDEN B mark for cosmetics, fragrances and toiletries, nor does it have priority of use.<sup>4</sup> Opposer simply cannot demonstrate that it has any enforceable rights in ARDEN B that will be damaged by the registration of ARDENBEAUTY.

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<sup>4</sup> Opposer cannot rely on its Registration Nos. 2,879,970 and 2,795,689 for ARDEN B to establish priority over Applicant under *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400 (CCPA 1974). First, any priority accorded Opposer would be limited to the goods described in Opposer's registrations. *San Fernando Elec. Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683 (CCPA 1977). However, Opposer has neither pleaded its Registrations, nor put them into evidence pursuant to 37 CFR § 2.122(d), presumably because the first use dates recited in those registrations are subsequent to Applicant's filing date of February 5, 2002. Thus, such Registrations have no evidentiary weight in these proceedings.

**D. Opposer will not be damaged by the registration of ARDENBEAUTY for fragrance and cosmetic products because Opposer is contractually precluded from using its ARDEN B mark on any fragrance or cosmetic products.**

At the time Opposer applied for registration of its ARDEN B marks, Applicant's predecessor opposed such registrations. (2/24/05 Notice of Reliance at A and B) The parties settled those Oppositions by entering into an agreement whereby Opposer 1) abandoned those applications, later re-filing for them in a distinctive typestyle; and 2) agreed never to use the ARDEN B mark on or in connection with:

cosmetics, skin care, hair care, fragrance products, eau de toilette, eau de cologne, eau de parfum, parfum, body lotion, body talc and powder, bath and shower gel, body oil, body soap, body wash, body splash, facial moisturizer, facial wash, after-shave lotion/balm, deodorants, antiperspirants and such other products commonly sold in a full fragrance line of goods or their packaging, or as the name of spas, salons or stores specializing in the sale of cosmetics, skin care, hair care or body products or services in the United States.

(Perry Dep. at Exhibit 1.)

For Opposer to now claim that it will be damaged by the registration of ARDENBEAUTY by Applicant, who clearly has priority and valid trademark rights in "Arden", for very different products that Opposer has never sold, and is contractually precluded from ever providing, is frivolous, and is a bald-faced attempt to establish rights in gross for its ARDEN B mark.

**E. There is no likelihood of confusion between Opposer's ARDEN B mark on its goods and services and Applicant's ARDENBEAUTY mark on the goods set forth in its Application.**

Opposer devotes a considerable portion of its Trial Brief to a discussion of likelihood of confusion under the *du Pont* factors. The issue of likelihood of confusion does not even need to be addressed, inasmuch as Opposer cannot establish the requisite priority of use in the "Arden"

mark. Thus, its arguments should properly be ignored by this Board. However, to the extent this tribunal determines that Opposer's asserted common law rights in "Arden" for clothing and a chain of retail clothing stores, based upon claimed common law use since 1997, trump Applicant's 90 years of registrations and common law rights in "Elizabeth Arden" and "Arden" for fragrances, cosmetics and toiletries, a few of Opposer's more egregious misstatements of law and fact need to be addressed.

First, there is no *per se* rule that cosmetics and clothing are related such that there will be a likelihood of confusion when the same or similar mark is used for these respective goods.<sup>5</sup> *In re Jacques Bernier, Inc.*, 1 U.S.P.Q.2d 1924 (TTAB 1987) ("Each case must be resolved on its own facts."). Indeed, in every case cited by Opposer where clothing and cosmetics were found to be related, likelihood of confusion was found because the Opposer was the senior user of a well-known mark that was being adopted by a junior user. *See, e.g., In re Arthur Holland, Inc.*, 192 U.S.P.Q. 494 (TTAB 1976) (owner of LEVI'S mark for clothing opposed registration of LEVI'S for use on men's cologne); *The All England Lawn Tennis Club (Wimbledon) Limited v. Creations Aromatiques, Inc.*, 220 U.S.P.Q. 1069 (TTAB 1983) (owner of famous "Wimbledon" mark for clothing opposed registration of "Wimbledon" for cologne). In this case, the roles are reversed: the junior user is opposing the senior user and owner of a famous trademark. Moreover, in this case the Applicant is not expanding into a new field; rather, it is applying for precisely the types of goods it has sold under the "Arden" and "Elizabeth Arden" marks for more than 90 years. Under these facts, confusion is not likely, and this factor favors Applicant.

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<sup>5</sup> Moreover, this argument should also be ignored, inasmuch as Opposer did not allege in its Notice of Opposition that its goods and services were related to those of Applicant.

In further support of its strained assertion that confusion is likely because consumers will assume that the same marks used on both clothing and women's cosmetics indicate a common source, Opposer belatedly submitted a list of third party registrations of trademark owners who use the same mark for cosmetics in International Class 3 and clothing in International Class 25. *See* 6/9/05 Notice of Reliance and Opposer's Trial Brief at 13-14. Apart from being irrelevant, because Opposer is contractually barred from selling cosmetics under its ARDEN B mark, this evidence may not be considered by this Board because it was filed outside of Opposer's testimony period and is being used to support its case-in-chief and not as rebuttal evidence. *See International Order of Job's Daughters v. Lindeburg & Co.*, 727 F.2d 1087, 220 U.S.P.Q. 1017 (Fed. Cir. 1984) and *American Speech-Language-Hearing Association v. National Hearing Aid Society*, 224 U.S.P.Q. 798 (TTAB 1985) (proper rebuttal testimony is introduced solely to deny, explain or otherwise discredit the facts and witnesses of applicant).

Opposer also asserts that the parties' target markets and trade channels are identical: women of all ages shopping in malls. Opposer not only oversimplifies its analysis, it contradicts the testimony of its own witness, Laura Nicholas, who stated "[o]ur branding focus is a young woman in her mid to late twenties." (Nicholas Dep. at 24:21-22.) In an analogous case discussing the similarity of trade channels and target markets for products sold in supermarkets, the Court of Customs and Patent Appeals stated:

A wide variety of products, not only from different manufacturers within an industry but also from diverse industries, have been brought together in the modern supermarket for the convenience of the customer. The mere existence of such an environment should not foreclose further inquiry into the likelihood of confusion arising from the use of similar marks on any goods so displayed. (Citation omitted) The means of distribution and sale, although certainly relevant, are areas of peripheral inquiry. The fundamental inquiry mandated by Section 2(d) goes to the

cumulative effect of differences in the essential characteristics of the goods and differences in the marks. (Emphasis in original.)

*Federated Foods, Inc. v. Fort Howard Paper Company*, 544 F.2d 1098, 192 U.S.P.Q. 24 (CCPA 1976).

In this case, Opposer's goods are only sold in Opposer's stores, and Opposer does not sell Applicant's products. Thus, the products will *never* be sold together. The mere fact that Opposer's stores are in shopping malls, and Applicant's products are sold in department stores which are generally located in shopping malls, simply does not support a blanket finding that the target markets and trade channels are identical.<sup>6</sup> Thus, these factors favor Applicant and do not support a finding of likelihood of confusion.

Finally, Opposer argues that the "fame of the prior mark" factor weighs in its favor. Clearly, it does not, and such a statement fails the red-face test. There is a famous mark in this case, but it is owned by Applicant. The Board must consider the fame of the Applicant's "Elizabeth Arden" and "Arden" marks in any analysis of the *du Pont* factors. *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1992) ("The fifth *du Pont* factor, fame of the prior mark, plays a dominant role in cases featuring a famous or strong mark."); *see also Bose Corp. v. QSC Audio Products Inc.*, 63 U.S.P.Q.2d 1303 (Fed. Cir. June 14, 2002); *Recot, Inc. v. M.C. Becton*, 54 U.S.P.Q.2d 1894 (Fed. Cir. 2000) ("fame deserves its full measure of weight in assessing likelihood of confusion").

In its Trial Brief, Opposer attempts to establish that its ARDEN B mark is famous by virtue of its seven years use of the mark in less than one hundred specialty stores. Opposer has submitted evidence of less than \$5 million in advertising expense in total over seven years, and

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<sup>6</sup> Furthermore, Applicant's products are not sold exclusively in department stores. In fact, the ARDENBEAUTY products are now being sold in mass merchandisers, such as Wal-Mart, grocery stores and drug stores -- none of which are stores where Opposer's products would be found. (Rolleston Dep. at 89-91.)

less than \$20 million in sales for that seven year period. Compared with Applicant's \$4 million in advertising *on just the ARDENBEAUTY line*, and \$26 million in sales *on just the ARDENBEAUTY line*, and the 8500 stores in which ARDENBEAUTY has been sold since its introduction in 2002, not to mention Applicant's 85 years of use, advertising and promotion of "Elizabeth Arden" and "Arden" fragrances, cosmetics and toiletries, it is absurd to suggest that the "fame of the prior mark" factor weighs in Opposer's favor. Since Applicant clearly has priority in use of "Arden" and "Elizabeth Arden", and these marks are indeed famous for fragrances, cosmetics and toiletry products, the "fame of the prior mark" factor weighs heavily in Applicant's favor.

**F. Opposer's assertion that the Application is *void ab initio* is premised on a misstatement of the testimony, and is not supported by the facts in evidence.**

In a sign of sheer desperation, Opposer argues that Applicant "admitted" that it had no intention of using the ARDENBEAUTY mark for some of the goods recited in the Application, rendering the Application void *ab initio*. In support, Opposer cites to the testimony of Ronald Rolleston, stating that Mr. Rolleston testified that Applicant "never had any plans to use the mark ARDENBEAUTY on shampoo and candles." As an initial matter, the Application is confined to related goods in International Class 3, and the description of goods and services does not list "candles". Nevertheless, and to the extent this even makes a difference, since Applicant has not yet filed its Statement of Use, here is what Mr. Rolleston actually said in the portions of testimony cited by Opposer in its Trial Brief:

Q: What other products were you intending to sell under the trademark, under the new brand?

A: Everything that's listed here [in Rolleston Exhibit No. 2].

Q: Anything else that's not listed there?

A: **Yes. Eventually we would put these things together in gift sets, we eventually would make new product types with it. That's all part of what we do.**

\* \* \* \* \*

Q: How about ardenbeauty candles, were you planning on selling ardenbeauty candles?

A: That could have happened.

Q: Did you plan for that?

A: No. I have people who do stuff like that for me. There is a group of women whose whole lives are spent finding marvelous ways to extend my fragrances in a variety of different areas to that we can promote it. There have been Elizabeth Arden candles in the past. But, no, I didn't sit down and go let's make sure we formulate the oils so that we can have a candle. But I wouldn't do that anyhow.

Q: Have any steps been taken to produce an ardenbeauty candle?

A: You know what, I don't know. I would have to go back and ask one of the girls who works for me who does that. That could very easily have been considered. I don't know.

\* \* \* \* \*

Q: How about shampoos?

A: We might have considered doing it at some point in time. But at that point I hadn't decided to do a shampoo **or not do a shampoo**. I mean, it wouldn't preclude me from it because of the nature of formulations. That's a category that I'm familiar with.

(Rolleston Dep. at 85-88.)

Without question, Applicant is making extensive use of ARDENBEAUTY on a wide variety of goods covered by the Application, and Mr. Rolleston certainly did not "admit" that Applicant never had a bona fide intention of using the ARDENBEAUTY name on any of the goods listed in the Application. This argument is specious, without merit, and does not establish a grounds for refusal of the Application under Section 1(b).

## VI. CONCLUSION

The only thing difficult about this case is figuring out why Opposer brought it. Opposer clearly does not have prior common law rights in "Arden"; it has not plead or relied upon its registrations of ARDEN B for clothing accessories and retail clothing stores, nor did it allege in its Notice of Opposition that the goods it sells under its ARDEN B mark are similar or related to the goods sold under the ARDENBEAUTY mark. Thus, Opposer does not even get to the likelihood of confusion analysis under the *du Pont* factors. And, even if it did, all of those factors heavily favor Applicant, which has been selling cosmetics, fragrances and toiletries under the "Elizabeth Arden" and "Arden" marks for more than 90 years.

Opposer has failed to demonstrate any superior rights in ARDEN B, or that it will be damaged by the registration of ARDENBEAUTY; accordingly, this Opposition should be dismissed.

Dated: September 7, 2005

Respectfully submitted,



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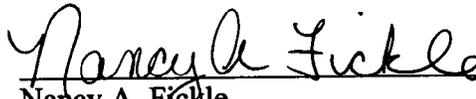
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**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing Applicant's Trial Brief has been served on John M. Cone, counsel for Opposer, by mailing said copy on September 7, 2005, via First Class Mail, postage prepaid to John M. Cone, c/o Akin Gump Strauss Hauer & Feld LLP, 1700 Pacific Avenue, Suite 4100, Dallas, Texas 75201-4675

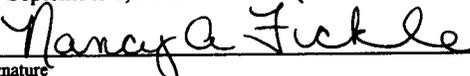
  
Nancy A. Fickle

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I hereby certify that three copies of the foregoing Applicant's Trial Brief enclosed herein are being deposited with the United States Postal Service with sufficient postage as Express Mail in an envelope addressed to:

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Signature \_\_\_\_\_  
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