

THIS OPINION
IS NOT A PRECEDENT OF
THE T.T.A.B.

Mailed: 12/9/08

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Facing The World
v.
Dan Maerovitz

Opposition No. 91181253
to application Serial No. 76672929
filed on February 21, 2007

William C. Wright of Epstein Drangel Bazerman & James for
Facing The World.

Dan Maerovitz, *pro se*.

Before Quinn, Cataldo and Taylor, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

Dan Maerovitz filed an intent-to-use application to
register the mark FACE THE WORLD for "cosmetics, namely
skincare and beauty products, in cream or liquid form."

Facing The World opposed registration under Section
2(d) of the Trademark Act on the ground that applicant's
mark, if used in connection with applicant's goods, would so
resemble opposer's mark FACING THE WORLD, the subject of
intent-to-use application Serial No. 78710155, filed on

Opposition No. 91181253

September 9, 2005, as to be likely to cause confusion. Opposer's application seeks registration of the mark FACING THE WORLD for "educational services, namely conducting seminars, conferences and courses in the field of medicine; training in the use and operation of medical equipment; medical training and teaching; on-line publication of case studies, news, and general articles relating to cranio-facial surgery; publishing education material in the nature of books, leaflets, reports, magazines and brochures in the field of medicine" (in International Class 41); and "provision of medical services; providing medical consultancy services" (in International Class 44). In the notice of opposition, opposer identifies itself as "a children's charity" that under the mark FACING THE WORLD "provides medical services and consultancy services, including complex surgeries for children in desperate need to transform their faces and radically change their quality of life."

Applicant, in his answer, denied the salient allegations in the notice of opposition. Applicant also set forth several statements amplifying its position that there is no likelihood of confusion between the marks.¹

¹ Statements made in pleadings cannot be considered as evidence in behalf of the party making them; such statements must be established by competent evidence. *Times Mirror Magazines, Inc. v. Sutcliff*, 205 USPQ 656, 662 (TTAB 1979); and TBMP §704.06(a) (2d ed. rev. 2004).

Opposition No. 91181253

Pursuant to agreement, the parties tried this case by using the Board's "Accelerated Case Resolution" (ACR) procedure. See www.uspto.gov/web/offices/dcom/ttab/adr.doc. Given the parties' agreement, familiarity with this procedure is presumed. The record consists of the pleadings; the involved application; and the evidence accompanying opposer's ACR brief. More specifically, opposer filed the declaration of Jason Drangel, an attorney with opposer's law firm. Attached as exhibits to the declaration are copies of opposer's and applicant's applications;² applicant's responses to opposer's discovery requests; and excerpts of third-party websites and articles retrieved from the Internet. Applicant neither filed a brief nor submitted any testimony or other evidence.

Insofar as priority is concerned, an opposer may rely on the constructive use provisions of Section 7(c) of the Trademark Act to establish its priority for purposes of Section 2(d). An opposer may rely on Section 7(c) to establish priority if it owns a registration for the mark it is asserting under Section 2(d) or if it has filed an application (even an intent-to-use application) for registration of that mark. *Larami Corp. v. Talk To Me*

² Opposer's submission of applicant's application was unnecessary inasmuch as the application file against which a notice of opposition is filed forms part of the record of the proceeding without any action by the parties. Trademark Rule 2.122(b); and TBMP §704.03(a) (2d ed. rev. 2004).

Opposition No. 91181253

Programs Inc., 36 USPQ2d 1840, 1845 n. 7 (TTAB 1995). In the present case, opposer filed a copy of its pleaded intent-to-use application.³ Opposer is entitled to claim the filing date, September 9, 2005, of this application as its date of constructive use.

Applicant did not offer any evidence regarding use of its mark, so the earliest priority date upon which it can rely is the filing date of its application, namely February 21, 2007. See, e.g., *Mason Engineering & Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956, 961 (TTAB 1985). In saying this, however, we recognize that applicant's discovery responses submitted by opposer arguably show a first use of applicant's mark on January 19, 2007. Nevertheless, both applicant's first use date and filing date are later than opposer's constructive use date of September 9, 2005.

Inasmuch as opposer's constructive use date precedes the earliest date upon which applicant may rely, we find that opposer has priority.

As to likelihood of confusion, our determination is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563

³ The mark was published for opposition, a Notice of Allowance has issued, and a second extension of time to file a statement of use has been filed.

Opposition No. 91181253

(CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Turning first to a consideration of the marks, we must compare the marks in their entireties as to appearance, sound, connotation and commercial impression to determine the similarity or dissimilarity between them. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The test, under the first *du Pont* factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods and services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Applicant's mark FACE THE WORLD is strikingly similar to opposer's mark FACING THE WORLD. The marks are virtually

Opposition No. 91181253

identical in appearance and sound, differing only in the "-ING" portion of the first word of opposer's mark. Further, the marks have similar meanings and they engender virtually identical overall commercial impressions. The marks are only somewhat suggestive, but, as pointed out by opposer, the marks suggest the same idea, i.e., "the ability of the consumer to meet the world head on without embarrassment, given the consumer's improved appearance from the use of a cosmetic product, or the change in the consumer's appearance, resulting from Opposer's medical services, e.g., cosmetic surgery services." (Brief, p. 6).

The virtual identity between the marks weighs heavily in opposer's favor.

With respect to the *du Pont* factor of the nature and number of similar third-party marks in use on similar goods and/or services, the record is devoid of any such evidence.

With respect to the goods and services, it is not necessary that the respective goods and/or services be competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods and/or services are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and/or services are such that they would or could be encountered by the same persons under circumstances that could, because of

Opposition No. 91181253

the similarity of the marks, give rise to the mistaken belief that they originated from the same producer. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991). Moreover, if the marks are the same or almost so, it is only necessary that there is a viable relation between the goods and/or services to support a holding of likelihood of confusion. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); and *In re Opus Wine Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001).

Opposer has submitted evidence of third-party websites and articles retrieved from the Internet to show that opposer's services, most particularly, its medical services, are related to cosmetics. The evidence shows that physicians, in conjunction with their medical services, frequently sell cosmetic products to their patients and other consumers. One article notes that well known doctors may turn their clinical experience into products backed by their own names and medical credentials. (www.beauty-online.com). Another article discusses the fact that Rodeo Drive Plastic Surgery in Los Angeles has been named the exclusive distributor of a line of skincare cosmetics. (www.rodeodriveplasticsurgery.com). An additional article captioned "New wrinkle in anti-aging cosmetics. Doctors jumping into lucrative market." discusses the trend that doctor-branded lines of "cosmeceuticals," as they have been come

Opposition No. 91181253

to be known in the industry, are rapidly moving from spas and physicians offices into retail markets, and have become the fastest-growing segment of the \$2.1 billion cosmetics market at prestige department stores...now they are heading for even greater growth by infiltrating mid-level department stores and chain drugstores. "This whole sector is exploding," said Dr. Bruce Katz, a New York dermatologist who sells an extensive line of products from his office. "Cosmetic companies are rushing to get on board. They know this is the next big thing."

(www.bostonglobe.com) Opposer introduced several other articles, all discussing the above-referenced trend among dermatologists and plastic surgeons to offer, in conjunction with their medical services, a line of skin care cosmetics, often times under the physician's name.

Likelihood of confusion must be determined on the basis of the goods as they are identified in the involved application, "cosmetics, namely skincare and beauty products, in cream or liquid form." There are no restrictions in applicant's identification, and we must presume that the cosmetics include those sold or recommended by physicians. Further, opposer's medical services, as identified in its application, are not limited, and we presume that they include those rendered by dermatologists and plastic surgeons. Opposer's services and applicant's goods are capable of being sold through the same trade channels to the same classes of purchasers, including

Opposition No. 91181253

consumers who may have undergone cosmetic surgery and who wish, for example, to diminish or hide scarring by using cosmetics.

The similarity between the goods and services, trade channels and classes of purchasers are factors that weigh in favor of a finding of likelihood of confusion.

On balance, the *du Pont* factors weigh in favor of a finding of likelihood of confusion. We conclude that consumers familiar with opposer's medical services rendered under the mark FACING THE WORLD, upon encountering applicant's mark FACE THE WORLD for cosmetics, would be likely to believe that the goods and services originate from or are associated with or sponsored by the same entity.

As noted earlier, opposer's priority is based on constructive use. In such a circumstance, the Board will not enter a final judgment until the registration issues. This is because constructive use is "[c]ontingent on the registration of a mark on the principal register." Section 7(c). Section 18 of the Trademark Act provides that "no final judgment shall be entered in favor of an applicant under Section 1(b) before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to Section 7(c)." TBMP §901.02(b) (2d ed. rev. 2004).

Opposition No. 91181253

Decision: The opposition is sustained *contingent* upon opposer's registration of the mark in application Serial No. 78710155. The time of filing an appeal or for commencing a civil action will run from the date of the present decision. See Trademark Rules 2.129(d) and 2.145. When opposer's mark has registered or its application therefor becomes abandoned, opposer should promptly inform the Board, so that appropriate action may be taken to terminate this proceeding.