

ESTTA Tracking number: **ESTTA280986**

Filing date: **04/29/2009**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	philosophy, inc.
Granted to Date of previous extension	04/29/2009
Address	3809 East Watkins Street Phoenix, AZ 85034 UNITED STATES

Correspondence information	J. Rick Tache Attorney of Record Snell & Wilmer L.L.P. 600 Anton Boulevard, Suite 1400 Costa Mesa, CA 92626 UNITED STATES rtache@swlaw.com, hscott@swlaw.com, sleach@swlaw.com, lwood@swlaw.com, cneu@swlaw.com, ksearcy@swlaw.com Phone:714-427-7039
----------------------------	---

Applicant Information

Application No	77499953	Publication date	12/30/2008
Opposition Filing Date	04/29/2009	Opposition Period Ends	04/29/2009
Applicant	Trivani International, LLC Suite D2 1190 North Spring Creek Place Springville, UT 84663 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 2007/11/03 First Use In Commerce: 2007/11/03 All goods and services in the class are opposed, namely: Multi-level marketing business services
--

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
--------------------------------------	----------------------------

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2016208	Application Date	10/24/1994
Registration Date	11/12/1996	Foreign Priority Date	NONE
Word Mark	PHILOSOPHY		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 003. First use: First Use: 1996/01/01 First Use In Commerce: 1996/01/01 cosmetics, namely lipsticks, lip gloss, lip liner, lip pencil, eye pencil, mascara, eye liner, eye shadow, face powder, foundation, and blush; for fragrances, namely perfume, toilet water and cologne; for facial and body skin care products, namely exfoliation scrubs, washes, cleansers, lotions, and creams; for sun care products, namely suntanning creams, lotions, oils and gels, after sun creams and lotions, sunblock preparations, and sunscreens; for hair care products, namely shampoo, conditioner, and hairspray; for massage lotions and oils; for foot care products, namely creams and lotions; for non-medicated skin lightening preparations

U.S. Registration No.	2214968	Application Date	04/02/1996
Registration Date	12/29/1998	Foreign Priority Date	NONE
Word Mark	PHILOSOPHY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 1997/09/01 First Use In Commerce: 1997/09/01 [trunks and] travelling bags [; umbrellas and parasols]		

U.S. Registration No.	2269341	Application Date	04/02/1996
Registration Date	08/10/1999	Foreign Priority Date	NONE
Word Mark	PHILOSOPHY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1999/03/15 First Use In Commerce: 1999/03/15 educational seminars and workshops in the field of cosmetics and skin care; entertainment in the nature of award ceremonies		

U.S. Registration No.	2388010	Application Date	09/25/1995
Registration Date	09/19/2000	Foreign Priority Date	NONE
Word Mark	PHILOSOPHY		

Design Mark	PHILOSOPHY
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 2000/05/12 First Use In Commerce: 2000/05/12 retail store services featuring a full line of cosmetics, hair care products, bath products, skin care products, fragrances, music, books, jewelry and accessories

U.S. Registration No.	3412632	Application Date	04/05/2004
Registration Date	04/15/2008	Foreign Priority Date	NONE

Word Mark	PHILOSOPHY
-----------	------------

Design Mark	PHILOSOPHY
-------------	-------------------

Description of Mark	NONE
---------------------	------

Goods/Services	Class 016. First use: First Use: 2007/11/05 First Use In Commerce: 2007/11/05 Greeting cards Class 041. First use: First Use: 1996/00/00 First Use In Commerce: 1996/00/00 Publishing services, namely, books, short stories, pamphlets, newsletters
----------------	---

U.S. Registration No.	3406516	Application Date	05/24/2004
Registration Date	04/01/2008	Foreign Priority Date	NONE

Word Mark	PHILOSOPHY
-----------	------------

Design Mark	PHILOSOPHY
-------------	-------------------

Description of	NONE
----------------	------

Mark	
Goods/Services	Class 014. First use: First Use: 2007/12/21 First Use In Commerce: 2007/12/21 Jewelry

U.S. Registration No.	3440195	Application Date	10/02/2007
Registration Date	06/03/2008	Foreign Priority Date	NONE

Word Mark	PHILOSOPHY
-----------	------------

Design Mark	
-------------	--

Description of Mark	NONE
---------------------	------

Goods/Services	Class 021. First use: First Use: 1996/05/31 First Use In Commerce: 1996/05/31 Cosmetic brushes
----------------	--

Attachments	75082661#TMSN.gif (1 page)(bytes) 74734177#TMSN.gif (1 page)(bytes) 78396564#TMSN.jpeg (1 page)(bytes) 78423910#TMSN.jpeg (1 page)(bytes) 77293608#TMSN.jpeg (1 page)(bytes) DO NO HARM NOO.pdf (10 pages)(812869 bytes)
-------------	--

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	//J. Rick Tache//
Name	J. Rick Tache
Date	04/29/2009

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

In the matter of Application Serial No. 77/499,953
Mark: DO NO HARM PHILOSOPHY
Published in the *Official Gazette* on December 30, 2008

<p>philosophy, inc.,</p> <p style="text-align: center;"><i>Opposer,</i></p> <p style="text-align: center;">vs.</p> <p>Trivani International, LLC,</p> <p style="text-align: center;"><i>Applicant.</i></p>	<p>Opposition No.: _____</p>
--	------------------------------

NOTICE OF OPPOSITION

philosophy, inc., a corporation organized and existing under the laws of the State of Arizona, with a mailing address at 3809 East Watkins Street, Phoenix, Arizona 85034 (hereinafter referred to as “Opposer”), opposes the registration of the mark shown in United States Trademark Application Serial No. 77/499,953, on grounds that Opposer believes it will be damaged by registration of the mark on the Principal Register.

As grounds for this opposition, including grounds under the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. § 1063, as amended, it is alleged that:

1. Trivani International, LLC (hereinafter referred to as “Applicant”) seeks to register the mark DO NO HARM PHILOSOPHY as a service mark for multi-level marketing business services in International Class 35, as evidenced by the United States Trademark Application Serial No. 77/499,953, filed June 16, 2008, claiming first use at least as early as November 3, 2007, and published in the *Official Gazette* dated December 30, 2008 (hereinafter referred to as “Applicant’s Application”).

2. Opposer is a trendsetting personal wellness company and a leading provider of high quality skin care and cosmetic products. Opposer was founded by Cristina Carlino, who has spent over 25 years in the health and beauty industry as a product researcher and skincare specialist. Ms. Carlino is a recognized leader in pioneering and identifying

medically based skin care technologies. Opposer's products contain cutting-edge ingredients for face and body. They also come with words of encouragement for the mind and soul printed on the exterior of each product.

3. Opposer is built on the premise that the best cosmetic is great looking skin, and produces products that help a person's skin stay healthy, vibrant and clear. Opposer has used an integrated approach, with a combination of science and nature, to create quality products. In view of Opposer's unique approach to cosmetics and skin care, the company's products became a phenomenon in the cosmetics industry.

4. Opposer has continued to grow and expand into new distribution outlets, new geographic markets, and new product categories. In 2005, Opposer's products were featured on the highly rated Oprah Winfrey television show as some of Oprah's favorite things. These products are currently featured on Oprah's website (www.oprah.com). In 2006, Opposer was the number one beauty brand on QVC, the number one skin care and bath & body care brand at Sephora USA, and among the fastest-growing beauty brands in select department and specialty stores. Also in 2006, Ms. Carlino received an award from the Christopher & Dana Reeve Foundation in recognition of her support and charitable efforts for the Foundation. Ms. Carlino has also received a number of other public service awards and has made numerous public and television appearances, which have all added to the goodwill associated with Opposer.

5. Opposer has become famous for its charitable endeavors and has raised awareness and significant funds that support educational programs and medical research relating to breast, ovarian, and colon cancers as well as other charitable foundations and programs. All of the gross profits from the sale of the following Opposer's products are donated to the respective charities identified below:

- (a) "shower for the cure" shower gel – 100% of gross profits donated to the Women's Cancer Research Fund;
- (b) "message in a bottle" shower gel – 100% of gross profits donated to the Rainforest Foundation;
- (c) "believe in miracles" shower gel – 100% of gross profits donated to the Christopher & Dana Reeve Foundation;

- (d) “inner grace” shower gel – 100% of gross profits donated to the Christopher & Dana Reeve Foundation;
- (e) “joyful heart” shower gel – 100% of gross profits donated to the Joyful Heart Foundation;
- (f) “joyful heart” candle – 100% of gross profits donated to the Joyful Heart Foundation; and
- (g) “the tree house” hand wash & hand cream – 100% of gross profits donated to PBS and PBS KIDS.

6. In addition to the traditional substantial expenditures in advertising and promotion, Opposer has built up significant goodwill in connection with its business as a result of its involvement in charitable efforts and public service.

7. Prior to launching its line of products, Opposer committed significant time and expense to developing trade dress for its products that would be distinctive, aesthetically pleasing, memorable to its customers, and that would celebrate feeling well and living joyously.

8. Opposer is the owner of the valid, subsisting, and incontestable United States Trademark Registration No. 2,016,208 for the trademark PHILOSOPHY, registered November 12, 1996, for cosmetics, namely lipsticks, lip gloss, lip liner, lip pencil, eye pencil, mascara, eye liner, eye shadow, face powder, foundation, and blush; for fragrances, namely perfume, toilet water and cologne; for facial and body skin care products, namely exfoliation scrubs, washes, cleansers, lotions, and creams; for sun care products, namely suntanning creams, lotions, oils and gels, after sun creams and lotions, sunblock preparations, and sunscreens; for hair care products, namely shampoo, conditioner, and hairspray; for massage lotions and oils; for foot care products, namely creams and lotions; for non-medicated skin lightening preparations, in International Class 03.

9. Opposer is the owner of the valid and subsisting United States Trademark Registration No. 3,406,516 for the trademark PHILOSOPHY, registered April 1, 2008, for jewelry in International Class 14.

10. Opposer is the owner of the valid and subsisting United States Trademark Registration No. 3,412,632 for the trademark PHILOSOPHY, registered April 15, 2008, for greeting cards in International Class 16 and publishing services, namely, books, short stories, pamphlets, newsletters in International Class 41.

11. Opposer is the owner of the valid, subsisting, and incontestable United States Trademark Registration No. 2,214,968 for the trademark PHILOSOPHY, registered December 29, 1998, for traveling bags; umbrellas and parasols, in International Class 18.

12. Opposer is the owner of the valid and subsisting United States Trademark Registration No. 3,440,195 for the trademark PHILOSOPHY, registered June 3, 2008, for cosmetic brushes in International Class 21.

13. Opposer is the owner of the valid, subsisting, and incontestable United States Trademark Registration No. 2,269,341 for the trademark PHILOSOPHY, registered August 10, 1999, for seminars and workshops in the field of cosmetics and skin care; entertainment in the nature of award ceremonies, in International Class 41.

14. Opposer is the owner of the valid, subsisting, and incontestable United States Trademark Registration No. 2,388,010 for the trademark PHILOSOPHY, registered September 19, 2000, for retail store services featuring a full line of cosmetics, hair care products, bath products, skin care products, fragrances, music, books, jewelry and accessories, in International Class 42 (United States Trademark Registration Nos. 2,016,208, 2,214,968, 2,269,341, 2,388,010, 3,412,632, 3,406,516 and 3,440,195 for the trademark PHILOSOPHY, hereinafter collectively referred to as "Opposer's Registrations").

15. Opposer owns and operates retail stores under the mark THE PHILOSOPHY STORE currently located in Chandler and Mesa, Arizona and Santa Monica, California. Within each of these retail stores, philosophy offers for sale clothing within International Class 25 and philosophy employees and staff wear clothing bearing the PHILOSOPHY mark. In addition, each of these retail stores use T-shirts, aprons, bath robes, hospital scrubs (tops), hats, and other clothing goods within International Class 25 as giveaways and for advertising purposes to promote products associated with Opposer's Marks. Clothes in International Class 25 are also promoted and sold on philosophy's website.

16. Opposer also owns almost forty (40) pending trademark applications for the trademark PHILOSOPHY for a wide variety of products and services including, but not limited to, cosmetics and personal care items, fragrances, music, books, jewelry, accessories, traveling bags, umbrellas, and educational seminars and workshops in the field of cosmetics and skin care (hereinafter referred to collectively as "Opposer's Applications") (Opposer's Registrations, Opposer's common law rights in the PHILOSOPHY mark, and Opposer's

Applications, hereinafter collectively referred to as “Opposer’s Marks”). Opposer’s numerous registrations, pending applications, and common law rights in the PHILOSOPHY mark, clearly established Opposer’s Marks as a lifestyle mark associated with Opposer for an ever-expanding variety of goods and services.

17. Opposer has the exclusive right to use the Opposer’s Marks in commerce on or in connection with the goods and services identified in each of the Opposer’s Marks. Opposer has continuously used the Opposer’s Marks in commerce on and in connection with products that are the same or similar to those associated with Applicant’s Application, since at least as early as November 1996; *more than ten years prior* to the date of first use alleged in Applicant’s Application.

18. Products and services bearing Opposer’s Marks have been highly successful and enjoy a national reputation as premier products and services. Opposer has made a substantial investment in advertising and promoting Opposer’s Marks. Products associated with Opposer’s Marks have been promoted and sold in retail outlets such as Sephora, Nordstrom, and Marshall Fields, on television outlets such as the QVC Channel, and on the Internet through Opposer’s own website and other retail websites.

19. Upon information and belief, the multi-level marketing business services that are identified in Applicant’s Application are associated with products that are identical to the skin and hair care products associated with Opposer’s Marks. Upon information and belief, Applicant’s services are be marketed through to the same class of consumers as the products and services currently being offered by Opposer in connection with Opposer’s Marks.

20. Applicant had knowledge of the unique and distinctive Opposer’s Marks and sought to capitalize upon the goodwill associated therewith by adopting the confusingly similar mark DO NO HARM PHILOSOPHY for multi-level marketing business services in International Class 35.

21. The mark proposed for registration by Applicant, namely DO NO HARM PHILOSOPHY, is confusingly similar in sound, appearance, and connotation to Opposer’s Marks for the PHILOSOPHY trademarks. The dominant portion of each mark is the word “PHILOSOPHY.” Applicant’s addition of the words of the DO NO HARM does little to change the sound, appearance, or connotation of Applicant’s Application relative to Opposer’s Mark, when viewed in their entirety. This is especially true when considering that the services

associated with Applicant's Application relate to marketing and selling skin and hair care products that directly compete with products associated with Opposer's Marks. According to Applicant's own website, Applicant's Application is intended to convey that "Trivani's innovative, high-science products are some of the very best in health and personal care, following our unique Do No Harm Philosophy™, which ensures that every Trivani product is safe for you, your family, and the environment." As evidenced above, since their first use in commerce, Opposer's Marks have been associated with products and services of the highest order that are manufactured in a socially and environmentally responsible manner, resulting in Opposer's customers associating "living well", "being happy", and seeking emotional and physical "well being" with Opposer's products and services. Products and services associated with Opposer's Marks are therefore inherently "safe." Consequently, the addition of the words "DO NO HARM" does little, if anything, to distinguish Applicant's Application from Opposer's Mark in appearance or connotation when viewed in its entirety. This fact, in combination with the similarity of the services associated with each mark and the competing products to be sold in conjunction with the services associated with each mark, establishes a likelihood of confusion between Applicant's Application and Opposer's Mark.

22. Any use by Applicant of her trademark as specified in Application Serial No. 77/499,953 is likely to cause confusion, mistake, or deception with respect to Opposer's Marks and is likely to damage the goodwill represented and symbolized by these trademarks.

23. Applicant's use of the DO NO HARM PHILOSOPHY mark would unfairly trade upon Opposer's substantial goodwill developed in its PHILOSOPHY trademarks and service marks. Registration of Applicant's mark would run counter to the public interest with respect to the ability to accurately ascertain the source of goods and services in the marketplace. Applicant's use of the DO NO HARM PHILOSOPHY mark is likely to create consumer confusion and will damage Opposer.

24. This Notice of Opposition is timely filed within an extension of time granted by the Trademark Trial and Appeal Board.

25. To cover the filing fee of \$300.00 for opposing an application in the first International Class and to cover any additional filing fees for opposing an application in any additional International Classes identified in such application as referenced in this Notice of

Opposition in accordance with 37 C.F.R. §2.6(a)(17), **please charge our deposit account no. 19-2814.**

WHEREFORE, Opposer prays that Application Serial No. 77/499,953 should be refused, that no registration be issued thereon, and that this opposition be sustained in favor of Opposer.

Respectfully submitted,

SNELL & WILMER L.L.P.

By

A handwritten signature in black ink, appearing to read "Leach", is written over a horizontal line.

Sid Leach, Reg. No. 29,186
One Arizona Center
400 East Van Buren
Phoenix, Arizona 85004-2202
Telephone: (602) 382-6372
Facsimile: (602) 382-6070

J. Rick Taché, Reg. No. 36,027
600 Anton Boulevard
Suite 1400
Costa Mesa, California 92626
Telephone: (714) 427-7039
Facsimile: (714) 427-7799
Attorneys for Opposer

CERTIFICATE OF MAILING

I hereby certify that the foregoing Notice of Opposition is being electronically filed with the United States Patent and Trademark Office, Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, VA 22313-1451:

Date: April 29, 2009

By: 
Holly Scott

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

In the matter of Application Serial No. 77/499,953
Mark: DO NO HARM PHILOSOPHY
Published in the *Official Gazette* on December 30, 2008

philosophy, inc., <i>Opposer,</i> vs. Trivani International, LLC, <i>Applicant.</i>	Opposition No.: _____
---	-----------------------

PROOF OF SERVICE

I am employed in the County of Orange, State of California. I am over the age of 18 and not a party to the within action; my business address is 600 Anton Boulevard, Suite 1400, Costa Mesa, CA 92626-7689.

On April 29, 2009, I served, in the manner indicated below, the foregoing document described as **Notice of Opposition** on counsel for the interested parties in this action by placing true copies thereof, enclosed in a sealed envelope, at Costa Mesa, addressed as follows:

John C. Stringham, Esq. Workman Nydegger, LLP 60 East South Temple 1000 Eagle Gate Tower Salt Lake City, Utah 84111	Applicant's counsel
---	---------------------

-
- BY REGULAR MAIL: I caused such envelope to be deposited in the United States mail at Costa Mesa, California, with postage thereon fully prepaid. I am readily familiar with the firm's practice of collection and processing correspondence for mailing. It is deposited with the United States Postal Service each day and that practice was followed in the ordinary course of business for the service herein attested to (C.C.P. § 1013(a)).
- BY FEDERAL EXPRESS: I caused such envelopes to be delivered by air courier, with next day service, to the offices of the addressees. (C.C.P. § 1013(c)(d)).
- BY PERSONAL SERVICE: I caused such envelopes to be delivered by hand to the offices of the addressees. (C.C.P. § 1011(a)(b)).

I declare under penalty of perjury under the laws of the State of California that the above is true and correct.

Executed on April 29, 2009, at Costa Mesa, California.



Holly Scott