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

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

JOHNSON & JOHNSON, :

Opposer, :

v. : Opposition No. 91-197584

VALENTINO GITTO

Applicant. :

OPPOSER'S MAIN BRIEF

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TABLE OF CONTENTS

	Page
I. DESCRIPTION OF THE RECORD	1
II. STATEMENT OF THE ISSUE.....	2
III. RECITATION OF FACTS.....	2
A. Applicant’s POSITIVE AGEING and Design Mark and Application	2
B. Johnsons & Johnsons’s POSITIVELY AGELESS Mark and Product.....	2
C. Evidence Regarding Likelihood of Confusion	4
IV. STATEMENT OF THE LAW	5
V. ARGUMENT	6
A. Applicant’s Lack of Evidence.....	6
B. Likelihood of Confusion.....	7
1. Opposer Has Priority in its Mark	8
2. Evidence of Record Establishes Likelihood of Confusion Between Opposer’s Positively Ageless Mark and Applicant’s Positive Ageing and Design Mark.....	8
a. Applicant’s POSITIVE AGEING mark is highly similar to the POSITIVELY AGELESS mark.....	9
b. Applicants’ proposed goods are substantially identical to, or otherwise encompass, Opposer’s goods	10
c. The parties’ trade channels are virtually identical	11
d. Opposer’s POSITIVELY AGELESS mark is entitled to a broad scope of protection.....	12
e. Record contains no evidence of third-party marks	13
f. Opposer’s mark is used in a wide variety of products	14
g. Conditions surrounding the sale of Opposer’s goods enhance the likelihood of confusion	15
3. Balancing the DuPont Factors	15
VI. CONCLUSION.....	16

TABLE OF AUTHORITIES

	Page(s)
CASES	
<i>Alfacell Corp. v. Anticancer Inc.</i> , 71 U.S.P.Q.2d 1301 (T.T.A.B. 2004)	10
<i>Bose Corp v. QSC Audio Prods., Inc.</i> , 63 U.S.P.Q.2d 1303 (Fed. Cir. 2002).....	12
<i>Boston Red Sox Baseball Club LP v. Sherman</i> , 88 U.S.P.Q. 2d 1581 (T.T.A.B. 2008)	7
<i>CBS Inc. v. Morrow</i> , 218 U.S.P.Q. 198 (Fed. Cir. 1983).....	11
<i>Centraz Indus. Inc. v. Spartan Chem. Co.</i> , 77 U.S.P.Q.2d 1698 (T.T.A.B. 2006)	9
<i>Century 21 Real Estate Corp. v. Century Life of Am.</i> , 23 U.S.P.Q.2d 1698 (Fed. Cir. 1992).....	10
<i>CTS Corp. v. Cronstoms Manuf. Inc.</i> , 185 U.S.P.Q. 773 (C.C.P.A. 1975)	10
<i>In re E.I. Du Pont de Nemours & Co.</i> , 177 U.S.P.Q. 563 (C.C.P.A. 1973)	5, 6
<i>Hewlett-Packard Co. v. Packard Press, Inc.</i> , 62 U.S.P.Q.2d 1001 (Fed. Cir. 2000).....	9, 10, 11
<i>Interlego AG v. Abrams/Gentile Entm't, Inc.</i> , 63 U.S.P.Q.2d 1862 (T.T.A.B. 2002)	5, 7
<i>Interstate Brands v. McKee Foods Corp</i> , 53 U.S.P.Q.2d 1910 (T.T.A.B. 2000)	14, 16
<i>Jansen Enter., Inc. v. Rind</i> , 85 U.S.P.Q. 2d 1104 (T.T.A.B. 2007)	7
<i>Kellogg Co. v. Pack'Em Enter. Inc.</i> , 14 U.S.P.Q. 2d 1545 (T.T.A.B. 1990), <i>aff'd</i> , 951 F.2d 330, 21 U.S.P.Q. 2d 1142 (Fed. Cir. 1991).....	6
<i>Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.</i> , 22 U.S.P.Q.2d 1453 (Fed. Cir. 1992).....	6, 12

TABLE OF AUTHORITIES
(cont'd.)

	Page(s)
<i>Krim-Ko Corp. v. The Coca-Cola Co.</i> , 156 U.S.P.Q. 523 (C.C.P.A. 1968)	9
<i>Nina Ricci S.A.R.L. v. E.T.F. Enters. Inc.</i> , 12 U.S.P.Q.2d 1901 (Fed. Cir. 1989).....	13
<i>Octocom Sys. Inc. v. Houston Computers Servs. Inc.</i> , 16 U.S.P.Q.2d 1783 (Fed. Cir. 1990).....	10, 12
<i>Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Masison Fondée En 1772</i> , 73 U.S.P.Q.2d 1689 (Fed. Cir. 2005).....	15
<i>Planter’s Nut & Chocolate Co. v. Crown Nut Co., Inc.</i> , 134 U.S.P.Q. 504 (C.C.P.A. 1962)	13
<i>Saul Zaentz Co. v. Bumb</i> , 95 U.S.P.Q. 2d 1723 (T.T.A.B. 2010)	6, 7
<i>In re Sox Unlimited, Inc.</i> , 169 U.S.P.Q. 682 (T.T.A.B. 1971)	13
<i>TBC Corp. v. Holsa Inc.</i> , 44 U.S.P.Q.2d 1315 (Fed. Cir. 1997).....	16
<i>The Coca-Cola Bottling Co. of N.Y. v. Krim-Co Corp.</i> , 148 U.S.P.Q. 369 (T.T.A.B. 1965)	9
<i>Tuxedo Monopoly, Inc. v. Gen. Mills Fun Group</i> , 209 U.S.P.Q. 986 (C.C.P.A. 1981)	10, 11
<i>Uncle Ben’s Inc. v. Stubenberg Int’l, Inc.</i> , 47 U.S.P.Q.2d 1310 (T.T.A.B. 1998)	14, 15
 STATUTES	
15 U.S.C. § 1052(d)	5, 7

Opposer Johnson & Johnson (“Opposer”) respectfully submits this trial brief in support of its opposition to the registration of the mark shown in Ser. No. 79/061,192 – POSITIVE AGEING and Design filed by Applicant Valentino Gitto (“Applicant”).

I. DESCRIPTION OF THE RECORD

The evidence of record consists of the application file at issue, Ser. No. 79/061,192 - POSITIVE AGEING and Design filed by Applicant and made of record pursuant to Trademark Rule 2.122(b), together with the evidence properly admitted, and not otherwise the subject of valid objection.

During Opposer’s testimony period, Opposer submitted the following evidence:

- (1) A status and title copy of Opposer Johnson & Johnson’s POSITIVELY AGELESS registration certificate, Reg. No. 3,605,906, submitted under Notice of Reliance dated May 24, 2013 in accordance with Trademark Rule 2.122(d)(2);
- (2) An official record from the United States Patent and Trademark Office Trademark Electronic Search System electronic database records (“TESS”) showing search results for marks comprised of formatives of the words “positive” and “age,” submitted under Notice of Reliance dated May 24, 2013 in accordance with Trademark Rule 2.122(e).
- (3) Applicant’s Answers to Opposer’s First Set of Interrogatories, submitted under Notice of Reliance dated May 24, 2013 in accordance with Trademark Rule 2.12(j).
- (4) The testimonial deposition of William Collins, together with all exhibits properly admitted therein, filed with the Board on September 4, 2013.

Applicant did not object to any of Opposer’s evidence.

Applicant did not submit any evidence under notice of reliance or file any testimony during his testimony period. No additional evidence was submitted during Opposer’s rebuttal period.

II. STATEMENT OF THE ISSUE

The sole issue for trial is whether Applicant's POSITIVE AGEING and Design mark, as set forth in Ser. No. 79/061,192, should be denied registration because it is likely to cause confusion, mistake, or deception in view of Opposer's prior use and registration of its POSITIVELY AGELESS mark.

III. RECITATION OF FACTS

A. Applicant's POSITIVE AGEING and Design Mark and Application

On September 19, 2008, Valentino Gitto ("Applicant") filed application Ser. No. 79/061,192 to register the POSITIVE AGEING and Design mark. *See* Appln. Ser. No. 79/061,192. The Application was filed based on the Madrid Protocol for the following goods in Class 3: "soaps; perfumes, essential oils, cosmetics, hair lotions; dentifrices; make-up removing preparations; beauty masks; shaving products, namely, shaving balm, shaving cream, shaving gel, and shaving mousse," and in Class 44: "medical services; hygienic and beauty care for human beings or animals; plastic surgery; nursing homes with medical care; beauty salons; hairdressing salons." *Id.*

According to the Applicant's discovery responses, Applicant has not, to date, used the POSITIVE AGEING and Design mark in the United States. *See* Opposer's Notice of Reliance – Applicant's Ans. To Opposer's First Set of Interrog. (hereafter "Applicant's Interrog. Ans.") at No. 2. Opposer testified that it was likewise unaware of any such use by Applicants. *See* Collins Dep. at 29.

B. Johnsons & Johnsons's POSITIVELY AGELESS Mark and Product

Opposer objects to the registrability of Applicants' mark based on Opposer's rights in the POSITIVELY AGELESS mark, as evidenced by Reg. No. 3,605,906 for "skin care preparations,

namely, skin cleansers, skin moisturizers, skin creams and serums, eye creams.” *See* Opposer’s Not. of Rel. – POSITIVELY AGELESS Registration Certificate (herein “Opposer’s Reg. Cert.”).

As explained by William Collins, Aveeno Facial Care brand manager, Opposer has used the mark in commerce since May 2007 in connection with its variety of POSITIVELY AGELESS anti-aging skincare products. *See* Collins Dep. at 15; 26-28.¹ The Aveeno brand has a number of sub-platforms and offers a wide range of products including facial care, body cleansing, baby care, and hair care. *Id.* at 33. The overall brand equity of the Aveeno line centers on three main pillars: 1) active natural ingredients, 2) clinical efficacy, and 3) professional accreditation. *Id.* at 25-26. Throughout the years, Aveeno has maintained strong partnerships with dermatologists, and in fact was first developed with the Mayo Clinic. *Id.*

POSITIVELY AGELESS is currently the third largest sub-platform of the Aveeno Facial Care portfolio. *Id.* at 14. Since 2007, the product offerings under the POSITIVELY AGELESS mark have expanded from the facial care category to also include the body and hand care categories. *Id.* at 33. Currently, the POSITIVELY AGELESS mark is used on a variety of products, including a cleanser, eye cream, day product, scrub, and tinted moisturizer. *Id.* at 16-17.

In this regard, Opposer has promoted and continues to promote its POSITIVELY AGELESS products in various channels, including retailers, beauty boutiques, and directly to customers. *Id.* at 40-42. Opposer has invested heavily in its POSITIVELY AGELESS mark and products, expending substantial sums on marketing and promotion, the amounts of which are set forth in Mr. Collins’ testimony. *See id.* at 42-44.² Opposer has also used a variety of new media

¹ Mr. Collins is employed by Johnson & Johnson Consumer Companies, Inc. a wholly owned subsidiary of Johnson & Johnson, Inc.

² The exact amounts are confidential, but are set forth in the cited materials. Opposer does not reference specific figures here so as to enable the public filing of this document without redactions.

marketing channels to build the brand, including a Buzz Agent Word of Mouth Program, reaching over 277,000 people; a sweepstakes in conjunction with Allure magazine, a leading publication in all things beauty; Expo TV videos created for YouTube and Facebook; and high impact digital media with partners such as WebMD, Total Beauty and SheKnows. *Id.* at 58-64.

As a result of Opposer's extensive efforts, POSITIVELY AGELESS products have enjoyed enormous commercial success, with substantial sales from 2007 through April 2013 as described in Mr. Collins' testimony. *See id.* at 66-67 & Exh. 26; *see also* n.1, *supra*. Due to Opposer's longstanding use of the mark and considerable investment therein, and substantial sales as a result of these efforts, the mark has become famous and well-known among consumers. *Id.* at 19-20.

C. Evidence Regarding Likelihood of Confusion

Opposer's witness, Mr. Collins, testified that confusion is likely to result from the proposed use and registration of Applicant's POSITIVE AGEING and Design mark. *Id.* at 29-35.

For example, Mr. Collins noted that a number of the goods specified in the POSITIVE AGEING application are categories in which Opposer has a presence in and are goods which "provid[e] the same sort of end benefit to the consumer [as Opposer's POSITIVELY AGELESS products]. Consumers would shop those in the same way." *Id.* at 31. The similarities in the product offerings increase the likelihood of consumer confusion.

Additionally, as Opposer's POSITIVELY AGELESS products are sold through various channels, consumers can purchase these products in a variety of settings including drug stores, spas and dermatologists. *Id.* at 38-39. Applicant similarly plans to sell the applied-for-goods at beauty salons, spa chains and aesthetic doctors' offices. Applicant's Interrog. Ans. at No. 5. Mr. Collins notes that this will increase the likelihood of confusion for both consumers and

dermatologists. Collins Dep. At 47-49. A consumer getting a facial treatment with a POSITIVE AGEING product, for instance, would likely assume it is connected to the POSITIVELY AGELESS line. *Id.* at 47-48. The consumer would perceive that the product would be providing “the same skin benefit that Positively Ageless would be giving them.” *Id.*

Due to the large number of POSITIVELY AGELESS and Aveeno product offerings, consumers are likely to assume similarly named products at their hairdresser or dermatologist originate from the same source. *Id.* at 48-49. For instance, if a consumer receives a recommendation for a hair care product which sounds similar to POSITIVELY AGELESS, the consumer is likely to associate the other product with the POSITIVELY AGELESS products they already know. *Id.* The other product would then be receiving credit for the good will and associations related to the POSITIVELY AGELESS mark. *Id.* Similarly, if someone has a bad experience with POSITIVE AGEING they may associate it with POSITIVELY AGELESS and no longer wish to purchase POSITIVELY AGELESS products. *Id.* at 53.

IV. STATEMENT OF THE LAW

To prevail in an opposition proceeding based on likelihood of confusion, the Opposer must establish: (1) that it has prior trademark rights, and (2) that the Applicant’s applied-for mark so resembles Opposer’s mark “as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d); *see, e.g., Interlego AG v. Abrams/Gentile Entm’t, Inc.*, 63 U.S.P.Q.2d 1862, 1862-64 (T.T.A.B. 2002).

In evaluating likelihood of confusion, the Board weighs the factors set forth in *In re E.I. Du Pont de Nemours & Co.*, for which there is evidence of record.³ 177 U.S.P.Q. 563, 567

³ The thirteen factors identified in *DuPont* are: (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression; (2) the similarity or dissimilarity of the nature of the

(C.C.P.A. 1973). Though the Board considers each factor for which evidence is submitted, the Board may, where appropriate, consider certain factors dominant or dispositive. *See, e.g., Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 22 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1992).

V. ARGUMENT

A. Applicant's Lack of Evidence

The trial record before the Board is completely void of any evidence from the Applicant. Applicant did not submit any evidence under notice of reliance or file any testimony during his testimony period. In fact, Applicant has only submitted a cursory Answer and Answers to Opposer's First Set of Interrogatories. Applicant has submitted no evidence to back up any statement or assertion made in response to Opposer's First Set of Interrogatories. Therefore, no evidence has been submitted by Applicant to allow any reasonable fact finder to rule in its favor.

Applicant may not rely on any exhibits or factual assertions that were not made of record during trial. *See* TBMP §§ 704.05 (b), 704.06(b). In fact, even assertions made in Applicant's answer are not evidence unless supported by evidence introduced at trial. *Saul Zaentz Co. v. Bumb*, 95 U.S.P.Q. 2d 1723, 1725 n.7 (T.T.A.B. 2010) (assertions in answer not evidence unless supported by evidence introduced at trial); *Kellogg Co. v. Pack'Em Enter. Inc.*, 14 U.S.P.Q. 2d 1545, 1547 n.6 (T.T.A.B. 1990), *aff'd*, 951 F.2d 330, 21 U.S.P.Q. 2d 1142 (Fed. Cir. 1991).

If Applicant attempts to make any factual assertions in a subsequent brief, the Board should give those assertions no consideration as they are not supported by any evidence properly

goods or services as described in an application or registration or in connection with which a prior mark is in use; (3) the similarity or dissimilarity of established, likely-to-continue trade channels; (4) the conditions under which and buyers to whom sales are made, i.e., "impulse" vs. careful, sophisticated purchasing; (5) the fame of the prior mark (sales advertising, length of use); (6) the number and nature of similar marks in use or on similar goods; (7) the nature and extent of any actual confusion; (8) the length of time during and conditions under which there have been concurrent use without evidence of actual confusion; (9) the variety of goods on which a mark is or is not used (house mark, "family" mark, product mark); (10) the proper market interface between applicant and the owner of a prior mark; (11) the extent to which applicant has a right to exclude others from use of its mark on its goods; (12) the extent of the potential confusion, i.e., whether de minimis or substantial; and (13) any other established fact probative of the effect of use. 177 U.S.P.Q. at 567.

introduced at trial. *See, e.g., Saul Zaentz Co.*, 95 U.S.P.Q.2d at 1725 n.7 (assertions in brief not evidence unless supported by evidence introduced at trial or except as admission against interest); *Boston Red Sox Baseball Club LP v. Sherman*, 88 U.S.P.Q. 2d 1581, 1587 (T.T.A.B. 2008) (broad and general statements in brief regarding marketing experience not supported by any evidence and cannot be accorded evidentiary value or consideration); *Jansen Enter., Inc. v. Rind*, 85 U.S.P.Q. 2d 1104, 1110 (T.T.A.B. 2007) (no consideration given to reference in brief to third-party registrations not of record). Thus, Applicant has effectively defaulted by providing nothing of substance to the record.

Opposer, as the only party who submitted evidence, has proven there is a likelihood of confusion between Applicant and Opposer's marks. The record evidence firmly establishes Opposer has priority in its mark and there is a strong likelihood of confusion between Opposer's POSITIVELY AGELESS mark and Applicant's POSITIVE AGEING and Design Mark.

Thus, the Board ought to sustain Opposer's Opposition solely based on the lack of any evidence submitted by the Applicant.

B. Likelihood of Confusion

Regardless if the Board does grant Opposer's Opposition solely on Applicant's lack of evidence, Opposer has also established that it has prior trademark rights, and that the Applicant's applied-for mark so resembles Opposer's mark "as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1052(d); *see, e.g., Interlego AG*, 63 U.S.P.Q.2d at 1862-64.

1. *Opposer Has Priority in its Mark*

Opposer's priority is not in dispute. Opposer's status and title copy of its pleaded POSITIVELY AGELESS registration, submitted under Notice of Reliance, conclusively

establishes Opposer's priority. Opposer's first use date pre-dates Applicants' international registration date for Applicants' 66(a) application, thereby removing priority as an issue in this case.

2. *Evidence of Record Establishes Likelihood of Confusion Between Opposer's POSITIVELY AGELESS Mark and Applicant's POSITIVE AGEING and Design Mark*

Because priority is not in dispute, the Board's sole task is examining the *DuPont* factors for which evidence has been properly made of record. Here, the following *DuPont* factors are particularly relevant to Opposer's claim of confusion, and each weighs in favor of Opposer:

1. *Similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.* Here, the parties' marks consist of slightly different forms of identical words, and therefore are visually, aurally, and connotatively similar.
2. *Similarity or dissimilarity and nature of the goods as described in an application or registration or in connection with which a prior mark is in use.* Applicant's goods, as identified in their application to include cosmetics, make-up preparations, and beauty masks, are substantially similar to the goods identified in Opposer's registration which includes a variety of skin care products.
3. *Similarity or dissimilarity of established, likely-to-continue trade channels.* Both parties' goods are sold, or will travel in substantially similar channels of trade, including beauty boutiques, retailers, and spa chains.
4. *Fame of the prior mark (sales, advertising, length of use).* Opposer's mark is extraordinarily well-known among relevant consumers due to its longstanding, exclusive use of the mark. Opposer's sales figures bolster the fame of Opposer's mark.
5. *Number and nature of similar marks in use on similar goods.* Opposer has produced evidence of a total lack of third party use of similar marks, and Applicant has provided no evidence to the contrary.
6. *The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).* Opposer's mark is used on a wide variety of products, including facial, skin and body care, such that consumers are likely to assume that Applicant's goods sold under Applicant's mark are a natural extension of Opposer's goods.

7. *The conditions surrounding the sale of Opposer's goods enhance the likelihood of confusion.* Opposer's goods are a relatively low risk purchase which consumers do not make with total haste, but also do not expect to last a lifetime.

As set forth more fully below, each relevant *DuPont* factor weighs in favor of Opposer. In short, all evidence properly made of record supports a finding of confusion, such that registration should be refused.

- a. **Applicant's POSITIVE AGEING mark is highly similar to the POSITIVELY AGELESS mark.**

The similarity or dissimilarity of the marks in their entireties is frequently a "predominant inquiry." *See Hewlett-Packard Co. v. Packard Press, Inc.*, 62 U.S.P.Q.2d 1001, 1003 (Fed. Cir. 2000). Here, in comparing Opposer's POSITIVELY AGELESS mark and Applicants' POSITIVE AGEING and Design mark, it is immediately apparent that each is two words, beginning with a form of the word "positive" and ending with a form of the word "age." There is only one fewer syllable in Applicant's mark. The marks differ only in the endings of each word, while the dominant beginnings remain the same. The overall appearance and sound of the two marks is highly similar.

Moreover, when comparing the parties' marks it is immediately apparent that they are immensely similar when spoken and heard. "Sound is of particular importance when dealing with products like soft drinks which may frequently be purchased by the spoken word." *Krim-Ko Corp. v. The Coca-Cola Co.*, 156 U.S.P.Q. 523, 526 (C.C.P.A. 1968) (quoting, with approval, lower court opinion, *The Coca-Cola Bottling Co. of N.Y. v. Krim-Co Corp.*, 148 U.S.P.Q. 369 (T.T.A.B. 1965)). Further, it is well established that there is no "correct pronunciation" of a trademark and that consumers will vocalize a mark in various ways that the trademark owner cannot control. *See, e.g., Centraz Indus. Inc. v. Spartan Chem. Co.*, 77 U.S.P.Q.2d 1698, 1701 (T.T.A.B. 2006).

Here, the marks use only slightly different forms of identical words. Because of the dominant similarities at the beginning of each term, consumers are apt to hear POSITIVELY AGELESS and POSITIVE AGEING similarly to the point of confusion. When spoken aloud, the two marks could be easily confused, making them aurally indistinguishable and practically identical in commercial impression.

In any event, where the parties' marks are applied to virtually identical goods, the degree of similarity between the marks necessary to support a holding of confusing similarity declines. *See Alfacell Corp. v. Anticancer Inc.*, 71 U.S.P.Q.2d 1301, 1305 (T.T.A.B. 2004) (citing *Century 21 Real Estate Corp. v. Century Life of Am.*, 23 U.S.P.Q.2d 1698, 1700 (Fed. Cir. 1992)). As discussed below, the parties' goods are indeed virtually identical.

b. **Applicants' proposed goods are substantially identical to, or otherwise encompass, Opposer's goods.**

"The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods" *Octocom Sys. Inc. v. Houston Computers Servs. Inc.*, 16 U.S.P.Q.2d 1783, 1787 (Fed. Cir. 1990). Thus, under this factor, the Board compares the similarity of the goods described in the applicant's application to the goods listed in Opposer's registration. *See Hewlett-Packard*, 62 U.S.P.Q.2d at 1004.

However, the parties' goods do not have to be perfectly identical to support a conclusion of likelihood of confusion, as the consuming public may confuse closely related goods as emanating from the same source. *Id.* Opposer, as prior user of the mark, also benefits from having the description of goods construed in its favor. *See Tuxedo Monopoly, Inc. v. Gen. Mills Fun Group*, 209 U.S.P.Q. 986, 988 (C.C.P.A. 1981) (citing *CTS Corp. v. Cronstoms Manuf. Inc.*, 185 U.S.P.Q. 773 (C.C.P.A. 1975)).

Here, the goods are substantially similar such that the relevant consumer would find that they are naturally related. The POSITIVELY AGELESS brand equity draws from Aveeno's long partnership with dermatologists and POSITIVELY AGELESS's focus on addressing a customer's anti-aging needs in a way that is good for the consumer and helps to achieve healthier looking skin. Collins Dep. at 14, 33. The product offerings under the POSITIVELY AGELESS mark have expanded over time, from the facial care category to also include the body and hand care categories. *Id.* at 33. Presently, the POSITIVELY AGELESS mark is used on a variety of products, including a cleanser, eye cream, day product, scrub, and tinted moisturizer. *Id.* at 16-17.

The goods identified in Applicant's application include, among others, cosmetics, make-up removing preparations, and beauty masks. *See* Appln. Ser. No. 79/061,192. These goods are substantially similar and can easily be seen as extensions of Opposer's goods. In fact, unrebutted witness testimony regarding this overlap supports this conclusion as well. Collins Dep. at 31. As the goods offer similar end benefits and consumers shop them the same way, there is a high likelihood of confusion. *Id.*

Accordingly, the parties' goods, as defined by each party's respective registration or application, are substantially identical. This factor weighs in favor of the Opposer.

c. The parties' trade channels are virtually identical.

The channels of trade and methods of distribution for the parties' products are presumed to be the normal channels and methods unless limitations are specified in the application or registration. *See CBS Inc. v. Morrow*, 218 U.S.P.Q. 198, 199 (Fed. Cir. 1983). Thus, where neither the applicant nor the opposer has indicated a specific channel of trade in its description of goods, the channels of trade are presumed to be all channels appropriate to the goods, and are, therefore, identical. *See Hewlett-Packard*, 62 U.S.P.Q.2d at 1005 (citation omitted). Similarly,

where, as here, an application or registration's description of goods does not specify a class of consumers, the Board will not consider evidence that the actual class of purchasers is more narrow. *See Octocom Sys. Inc. v. Houston Computers Servs. Inc.*, 16 U.S.P.Q.2d 1783, 1788.

It follows that, in this case, the parties' goods travel in the same channels of trade. Because neither Opposer's registration nor Applicant's application specifies a channel of trade, they are presumed to be the usual channels appropriate to such goods and are, therefore, identical, for the same reason that the goods themselves are essentially identical.

Nonetheless, the record evidence affirmatively establishes the identity of trade channels. Opposer's POSITIVELY AGELESS products are sold through a variety of channels including retailers, beauty boutiques, and directly to customers. Collins Dep. at 40-42. Applicant similarly plans to sell the applied for goods at beauty salons, spa chains and aesthetic doctors. Applicant's Interrog. Ans. at No. 5. Inevitably, Opposer's goods and Applicant's goods will be sold by the same retailers to the same consumers, even possibly displayed side-by-side. Applicant's identification of goods contains no evidence to the contrary. Therefore, the similarity in channels of trade weighs in favor of Opposer.

d. Opposer's POSITIVELY AGELESS mark is entitled to a broad scope of protection.

A strong or famous mark is entitled to a broad scope of protection. *See Kenner Parker Toys*, 22 U.S.P.Q.2d at 1456. Direct evidence of fame, such as a consumer survey, is not required; instead, the existence of fame may be shown through indirect evidence, such as volume of sales, advertising expenditures, and duration of use. *Bose Corp v. QSC Audio Prods., Inc.*, 63 U.S.P.Q.2d 1303, 1305-06 (Fed. Cir. 2002). Fame, if present, can be a dominant factor in determining likelihood of confusion. *Id.* at 1305. Indeed, courts do not take favorably to a junior user's adoption of a mark approximating a prior user's famous mark, and have cautioned

that “there is no excuse for even approaching the well-known trademark of a competitor” *Planter’s Nut & Chocolate Co. v. Crown Nut Co., Inc.*, 134 U.S.P.Q. 504, 511 (C.C.P.A. 1962); *Nina Ricci S.A.R.L. v. E.T.F. Enters. Inc.*, 12 U.S.P.Q.2d 1901, 1904 (Fed. Cir. 1989).

Here, Opposer has submitted various indicia of the fame for its POSITIVELY AGELESS mark. For example, sales figures of the POSITIVELY AGELESS products are presented from 2007 - 2013, which yield extremely high numbers. Collins Dep. at 66-67 & Exh. 26. Opposer’s substantial investment in marketing and promoting its brand is also uncontroverted. *Id.* at 58-64. Opposer has used a variety of marketing and brand management techniques to build the brand equity in POSITIVELY AGELESS. *Id.* By utilizing such an array of techniques, Opposer has increased the awareness of POSITIVELY AGELESS over the years.

In sum, the evidence conclusively shows that POSITIVELY AGELESS is a well-known, famous mark, entitled to broad protection. This factor, therefore, weighs in favor of the Opposer.

e. Record contains no evidence of third-party marks.

Even with a strong mark, the scope of protection afforded such a mark may be affected by competent evidence of extensive use of similar third-party marks. However, the Board does not independently “take notice of the state of the registers as reflected in the Patent Office files.” *In re Sox Unlimited, Inc.*, 169 U.S.P.Q. 682, 683 (T.T.A.B. 1971). Because Applicant has not presented any evidence rebutting the strength of Opposer’s mark, this factor weighs in favor of Opposer.

Nevertheless, the record evidence affirmatively establishes that there is a lack of third-party marks comprised of formatives of the words “positive” and “age.” *See* Opposer’s Not. of Rel. – TESS database record. In fact, the relevant search only returns Opposer’s registration and Applicant’s application. *Id.* This complete lack of third party marks is a firm showing of the strength of Opposer’s mark. As Opposer noted above, Applicant has failed to provide the record

with any evidence in this trial. While the overall absence of evidence is significant, this omission is particularly notable, as Opposer has proven that had Applicant attempted to provide a record of a third party mark, that attempt would have been in vain. Therefore, this factor weighs heavily in favor of Opposer.

f. **Opposer's mark is used in a wide variety of products.**

In situations where the opposer's mark is applied to a variety of products, it becomes more likely that purchasers encountering the applicant's similar mark on related goods will believe that opposer is the source or sponsor of applicant's product. *See Uncle Ben's Inc. v. Stubenberg Int'l, Inc.*, 47 U.S.P.Q.2d 1310, 1313 (T.T.A.B. 1998), 47 U.S.P.Q.2d at 1313 (finding opposer's use of its UNCLE BEN'S mark on a variety of rice and stuffing mixes "significant" because consumers are more likely to believe that opposer makes BEN'S BREAD brand of bread mix); *see also Interstate Brands v. McKee Foods Corp.*, 53 U.S.P.Q.2d 1910, 1913-14 (T.T.A.B. 2000). Thus, where opposer markets a line of products and applicant's goods would be a natural product extension of opposer's line, the use of opposer's marks on a variety of goods enhances the likelihood of confusion. *See, id.*

Here, Opposer markets several skin, body, and facial care products. Over time the products offered under the POSITIVELY AGELESS brand have expanded. In view of the variety of products marketed under the POSITIVELY AGELESS brand, consumers would not be surprised to see Opposer selling additional beauty related products under "Positive Ageing," especially because such mark is highly suggestive of "POSITIVELY AGELESS." Just as consumers would readily accept a tinted moisturizer as a natural extension of Opposer's skin care preparations, consumers will assume a beauty mask is merely an extension of Opposer's already extensive beauty and skin offerings. This factor also weighs in Opposer's favor.

g. The conditions surrounding the sale of Opposer's goods enhance the likelihood of confusion

It is well settled that where the parties' goods are inexpensive items purchased on impulse, such fact tends to heighten the likelihood of confusion, whereas a high level of purchaser sophistication may tend to minimize likelihood of confusion. *See, e.g., Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Masison Fondée En 1772*, 73 U.S.P.Q.2d 1689, 1695 (Fed. Cir. 2005). When purchasing inexpensive food items, "the average purchaser may exercise less care in the purchasing decision." *Uncle Ben's*, 47 U.S.P.Q.2d at 1313 (T.T.A.B. 1998). While the relevant goods here are not food items, they are found in similar settings and conditions.

While they are a premium product on the market and consumers exercise some care when purchasing such products, POSITIVELY AGELESS products are not incredibly expensive. *Collins' Dep.* at 92-93. The products range in price from \$9.00 to \$35.00. *Id.* Thus, these products are a "relatively low risk purchase." *Id.* Consumers do not purchase these products daily, nor do they assume one purchase will last a lifetime. Therefore, the conditions surrounding the purchase of the parties' products are typified by impulse, rather than solely deliberate thought and consideration. Thus, this factor weighs in Opposer's favor.

3. Balancing the DuPont Factors

Evaluating all of the *DuPont* factors together, the balance overwhelmingly tips in favor of likelihood of confusion. Each of the *DuPont* factors for which there is evidence of record weighs in Opposer's favor. The POSITIVELY AGELESS mark is visually similar and aurally indistinguishable from "Positive Ageing." The parties' goods are virtually identical, and the channels of trade for the goods are in fact identical. Further, Opposer has provided substantial

evidence of the fame and strength of the POSITIVELY AGELESS mark through sales and long-term use.

By contrast, none of the *DuPont* factors favor the Applicant. Applicant has submitted no evidence in support his position, apart from a boilerplate answer to Opposer's Notice of Opposition.

To the extent that the Board has any doubt regarding whether the evidence supports a finding of likelihood of confusion, such doubt must be construed against Applicant, as the newcomer. *See Interstate Brands*, 53 U.S.P.Q.2d at 1915. Applicant selected his mark at his own peril. In this case, the rule of doubt should apply to sustain an opposition against the newcomer and in favor of Opposer as the established longtime user. *See TBC Corp. v. Holsa Inc*, 44 U.S.P.Q.2d 1315, 1318 (Fed. Cir. 1997).

VI. CONCLUSION

For the reasons stated herein, Opposer respectfully requests that its Opposition be sustained, and that Applicant's application Ser. No. 79/061,192 – POSITIVE AGEING be refused registration because the mark shown in Applicant's application is likely to cause confusion, mistake or deception in view of Opposer's POSITIVELY AGELESS mark.

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing OPPOSER'S MAIN BRIEF was served on Applicant at the following addresses of record by First Class Mail, postage prepaid, this 5th day of November, 2013:

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An additional courtesy copy was sent via electronic mail to valentin_gitto@yahoo.fr

/Mita K. Lakhia/