

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

Mailed: March 28, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Johnson & Johnson

v.

Valentino Gitto

Opposition No. 91197584
to application Serial No. 79061192

Darren S. Cahr, Jeffrey T. Baravetto and Mita K. Lakhia of Drinker Biddle & Reath LLP for Johnson & Johnson.

Valentino Gitto, pro se.

Before Seeherman, Cataldo and Masiello,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Valentino Gitto, an individual citizen of France, has applied
to register on the Principal Register the mark

POSITIVE
ageing

for the following goods and services:

Opposition No. 91197584

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 (International Class 3); and

medical services; hygienic and beauty care for human beings or animals; plastic surgery; nursing homes with medical care; beauty salons; hairdressing salons (International Class 44).¹

Opposer, Johnson & Johnson, opposes registration on the ground that it is the owner of the mark POSITIVELY AGELESS, previously used and registered in standard characters on the Principal Register for the following goods:

skin care preparations, namely, skin cleansers, skin moisturizers, skin creams and serums, eye creams (International Class 3).²

In its notice of opposition, opposer alleges that it has used its registered mark in connection with the above-listed goods since prior to any date upon which applicant may rely for purposes of priority of use of its involved mark; that applicant's mark, when used in connection with applicant's goods and services so resembles opposer's mark for its recited goods as to be likely to

¹ Application Serial No. 79061192 was filed on September 19, 2008 seeking an extension of protection under Section 66(a) of the Trademark Act based upon International Registration No. 0982863, issued on September 19, 2008.

² Registration No. 3605906 issued on April 14, 2009.

Opposition No. 91197584

cause confusion, to cause mistake, or to deceive; and that opposer will be damaged by the registration thereof.³

Applicant, in his answer, admits opposer's ownership of its pleaded registration and otherwise generally denies the allegations in the notice of opposition.

The record in this case consists of the pleadings and the file of the involved application. *See* Trademark Rule 2.122(b); 37 C.F.R. § 2.122(b). During its testimony period, opposer timely filed notices of reliance, thereby introducing a copy of its pleaded Registration No. 3605906 showing status and title in opposer; official records obtained from the Trademark Electronic Search System (TESS) showing search results for marks containing the words "positive" and "age;" and applicant's answers to opposer's first set of interrogatories. In addition, opposer filed the testimony deposition, with accompanying exhibits, of William Collins, opposer's brand manager for its Aveeno Facial Care products.⁴

³ On the ESTTA cover sheet accompanying the notice of opposition, opposer lists deceptiveness and false suggestion of a connection under Section 2(a) as additional grounds for opposition. However, opposer did not pursue these grounds at trial and, accordingly, they are deemed waived.

⁴ We will refer to those portions of Mr. Collins' testimony designated as "confidential" only in general terms.

Opposition No. 91197584

Applicant did not take testimony or offer any evidence during his assigned testimony period, or object to any of opposer's testimony or evidence.⁵ Only opposer filed a brief on the case.

Opposer's Standing

Because opposer has properly made its pleaded registration of record,⁶ we find that opposer has established its standing to oppose registration of applicant's mark. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Priority of Use

Because opposer's pleaded registration is of record, Section 2(d) priority is not an issue in this case as to its POSITIVELY AGELESS mark for the goods covered thereby. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Likelihood of Confusion

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue, even those not specifically

⁵ Applicant did not attend the testimony deposition of Mr. Collins.

⁶ TTABVue 21, at 4-7. The citations to "TTABVue" throughout the decision are to the Board's public online database that contains the proceeding file, available on the USPTO website, www.USPTO.gov. The first number represents the docket entry number listed in the electronic case file and the second represents the page number(s).

Opposition No. 91197584

discussed in this decision. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Fame of Opposer's Mark

We begin our likelihood of confusion analysis with the fifth *du Pont* factor, which requires us to consider evidence of the fame of opposer's mark and to give great weight to such evidence if it exists. *See Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot Inc. v. Becton*, 214 F.3d 1322, 54 F.2d 1894 (Fed. Cir. 2000); and *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

Fame of an opposer's mark or marks, if it exists, plays a "dominant role in the process of balancing the *DuPont* factors," *Recot*, 214 F.3d at 1327, 54 USPQ2d at 1456, and "[f]amous marks thus enjoy a wide latitude of legal protection." *Id.* This is true as famous marks are more likely to be remembered and associated in the public mind than a weaker mark, and are thus more attractive as targets for would-be copyists. *Id.* Indeed, "[a] strong mark ... casts a long shadow which competitors must avoid." *Kenner Parker Toys*, 963 F.2d at 353, 22 USPQ2d at 1456. A famous mark is one "with extensive public recognition and renown." *Id.*

Bose Corp. v. QSC Audio Products Inc., 63 USPQ2d at 1305. As we have stated in previous decisions, in view of the extreme deference that is accorded

Opposition No. 91197584

to a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of a plaintiff asserting that its mark is famous to clearly prove it.

See Leading Jewelers Guild v. JLOW Holdings, LLC, 82 USPQ2d 1901 (TTAB 2007).

Upon careful review of the record in this case, we are not persuaded by opposer's claim that its POSITIVELY AGELESS mark is famous. In support of its claim, opposer has submitted confidential testimony and evidence regarding its dollar sales and advertisements from 2007 through 2013.⁷ Opposer further has submitted evidence of advertisements placed in Allure magazine, and such digital media as Buzz Agent, WebMD, Total Beauty, SheKnows, Facebook and YouTube.⁸ In addition, opposer has submitted evidence in the form of the results of its search of the USPTO's TESS database indicating that the only two live marks containing the root terms "positive" and "age" are its registration and the involved application.⁹

The testimony and evidence demonstrate that opposer has enjoyed considerable financial success in sales of goods under its POSITIVELY AGELESS mark and has expended considerable effort in marketing the goods identified under that mark. However, such evidence falls short of

⁷ TTABVue 25 at 21, 89.

⁸ *Id.* at 18-19, 77-86.

⁹ TTABVue 23 at 4.

Opposition No. 91197584

demonstrating the extent to which such success translates into widespread recognition of the POSITIVELY AGELESS mark among the general public. For instance, there is no testimony or evidence regarding how opposer's sales relate to sales of comparable products by its competitors such that we may place its raw sales numbers into relevant context. In addition, opposer's annual sales and marketing figures are rather low, compared to annual sales or advertising figures for other marks we have found to be famous. *See, for example, Motion Picture Association of America, Inc. v. Respect Sportswear Inc.*, 83 USPQ2d 1555 (TTAB 2007) (opposer's member companies annually sold 2.8 billion movie tickets and DVDs and spent 4 billion dollars on advertisements and promotion.).

Accordingly, we find on this record that the evidence is insufficient to establish that opposer's POSITIVELY AGELESS mark is famous for purposes of our likelihood of confusion determination. Nevertheless, we find that the evidence is sufficient to show that opposer's POSITIVELY AGELESS mark has achieved at least some degree of recognition and strength in the skin care market and that the mark is therefore entitled to a broader scope of protection than might be accorded a mark with less recognition.

The Marks

We consider the first *du Pont* factor, i.e., whether applicant's mark and opposer's mark are similar or dissimilar when viewed in their entireties in

Opposition No. 91197584

terms of appearance, sound, connotation and commercial impression. *See Palm Bay Imports, Inc. v. Veuve Clicquot*, 73 USPQ2d at 1691.

In this case, applicant's mark

POSITIVE
ageing

and opposer's POSITIVELY AGELESS mark are highly similar in that both consist of variations of the root terms "positive" and "age." As a result, POSITIVELY AGELESS and POSITIVE AGEING are highly similar in appearance and sound. The slight stylization of applicant's mark does not impart a significant difference in appearance and the rendering of the letter "t" in "positive" as a plus "+" sign simply reinforces the term "positive." As a result, we find that the stylization in applicant's mark does not significantly distinguish it from that of opposer. Opposer's mark suggests a desirable timeless quality while that of applicant suggests beneficial and healthy ageing. These connotations, while not exactly the same, nonetheless are similar inasmuch as both suggest benefits to users' appearance or wellbeing as they age.

As a result, we find that applicant's mark is highly similar in appearance and sound, and similar in connotation to opposer's mark and, overall, conveys a highly similar commercial impression.

Opposition No. 91197584

The Goods and Services

Turning next to our consideration of the similarities or dissimilarities between opposer's goods and applicant's goods and services, we note that it is well established that the goods and/or services of the parties need not be similar or competitive, or even offered through the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods and/or services of the parties 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 the similarity of the marks, give rise to the mistaken belief that they originate from the same source. *See Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *In re International Telephone & Telephone Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue, of course, is not whether purchasers would confuse the goods and/or services, but rather whether there is a likelihood of confusion as to the source thereof. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

As recited in its pleaded registration, opposer's goods are identified as:

skin care preparations, namely, skin cleansers, skin moisturizers, skin creams and serums, eye creams

and applicant's goods and services are identified as:

soaps; perfumes, essential oils, cosmetics, hair lotions; dentifrices; make-up removing preparations; beauty masks; shaving products, namely, shaving balm, shaving cream,

Opposition No. 91197584

shaving gel, and shaving mousse; and

medical services; hygienic and beauty care for human beings or animals; plastic surgery; nursing homes with medical care; beauty salons; hairdressing salons.

Turning to our consideration of the similarity between the parties' goods, opposer's witness, Mr. Collins, offered the following testimony:¹⁰

Q. Do you believe that any of the products listed there sold under the Positive Ageing brand would be likely to cause confusion with your products - ?

A. Yes.

Q. – sold as Positively Ageless?

A. Yeah. I think a couple of these categories are ones that are either something we have current presence in, cosmetics we have our tinted moisturizer that has a cosmetic application and purpose, as well as soaps versus cleansers. They're providing the same sort of end benefit to the consumer. Consumers would shop those in the same way.

Q. Can you talk a bit about how the brand has expanded in the past? What you started with and what products you expanded into the Positively Ageless line just to demonstrate what we're talking about?

A. Yep. So we began with cleansers, facial moisturizers and treatment products, and we have expanded into the body care category as well as the hand care category with our skin strengthening – our Aveeno Positively Ageless Skin Strengthening Body Lotion and Aveeno Positively Ageless Skin Strengthening Hand Cream, and so that was an idea and a concept that consumers are not only facing antiaging needs when they're dealing with their facial care, but they're also seeing other problem areas, if you will, on other parts of their body.

¹⁰ TTABVue 25 at 12-18.

Opposition No. 91197584

Q. And one more quick question on this. Can you please describe what “cosmetics” means in your market and whether or not what you’re selling are cosmetics?

A. Yep. Yeah. So cosmetics are products that would help change the appearance of a user’s skin, find a way to make them feel more beautiful, help them to highlight a particular area on their face, whether it’s their eyes or their lips, or to provide coverage. The one product in our Aveeno Positively Ageless line that would be similar is our tinted moisturizer. That product does provide a bit of a foundation. So often consumer would say, I don’t want to use a foundation because it’s heavy, but I need that coverage and I need that even tone that you get from a slight tint, and so part of the reason we went into the tinted moisturizer was to provide that benefit for consumers.

With regard to the similarity between applicant’s services and opposer’s goods, Mr. Collins offered the following testimony regarding a third-party’s business model, product line and activities under a single mark:¹¹

Q. I’ve got for you initially what is marked as Opposer’s Exhibit No. 21, which is an Internet printout. Can you please describe for us what this is?

A. Yep. This is a printout of the products for the Bliss line, which is a brand of skin care products, hair products, as well as spa services that are offered across those different lines. So Bliss has done a nice job of building up – they had spas to begin with, and consumers would go there and experience their products. They have leveraged that to sell different products like I said, in the categories I mentioned from skin care to hair and makeup, and use that spa entry point as a way to get consumers to use products elsewhere, and to my knowledge they’re sold – I believe they’re sold at ULTA and other channels that we would compete with.

From an Aveeno Positively Ageless perspective we see them as a competitor. We know that there are consumers that buy both of these – both of these platforms, both of these products, and so

¹¹ *Id.*

Opposition No. 91197584

someone is making a decision between do I buy this or do I buy Aveeno Positively Ageless?

Q. So they've tied together, sort of, services being provided to the consumer with - ?

A. Correct.

Q. – goods being sold to the consumer?

A. Correct.

Q. And so they provide hairdressing beauty salon services - ?

A. Yep.

Q. – and beauty care services?

A. Yes.

Q. Plus they also sell the products?

A. Yes.

Q. And in your experience does that mean that people are going to tie those things together in the public mind and expect that the same products are sold across the various different channels of trade?

A. Yes. Yes. And I think that, like you said, they would have an experience, whether it's a facial or a peel that they have as a spa treatment, then they would look for the products that the beautician or the woman who was doing this – person who's doing this service might use, and then obviously part of the business model is for them to recommend that product. If you like the feel of this, if you like the experience that you had, if you like the benefit that you're seeing on your skin, here's this product that I think you should use, and then here's where you can get it.

Q. So do you believe that if someone were to try to use or register the mark Positive Ageing in connection with beauty salon services that that would still be a problem for you?

A. I do.

Opposition No. 91197584

Q. And explain why.

A. I think, again, the consumer would have the perception that it's giving them the same skin benefit that Positively Ageless would be giving them, and there's the opportunity of confusion, so if they have used Positively Ageless in the past, they go to a salon that gives them a service and recommends Positive Ageing, I think there's definite confusion that would occur there, and a consumer would not always be able to distinguish what's unique or different about those two names.

Q. And what about a hairdresser?

A. Um-hum.

Q. How would confusion work in your mind that way?

A. Yep. Again, the same – the same sort of service. If someone is going to a beauty salon for a hair service, they make a recommendation for something that is going to address their ageing needs through a product called Positive Ageing, it would be easy for them to say there are other products that I've used in the past on different parts on my face that are Positively Ageless, and I might associate those two as the same thing, and some of the investment and the uniqueness that we have tried to develop through the Aveeno team would be – is going to be lost or would be less, kind of discredited. They would be getting credit for our work.

Q. And what about someone who was selling Positive Ageing products or services in connection with dermatological care or some other kind of medical care in connection with skin care – ?

A. Yeah.

Q. – would that be confusing?

A. Yes. And I think it would not only be confusing for the consumer, but it also could be confusing for some of the dermatologists because we have invested and detailed to them the Positively Ageless platform and the benefits of those products. There's obviously been communication to them about the benefits of Positively Ageless, and so the dermatologists could be confused about what product it would be as well as the

Opposition No. 91197584

recommendation that they would make to the - to their patient. Their patient may not understand that there's a difference there between Positive Ageing and Positively Ageless.

The testimony and evidence of record establishes that, at least, opposer's skin cleansers and (tinted) skin moisturizers are related to applicant's soaps and cosmetics. Furthermore, as identified, applicant's soaps and opposer's skin cleansers can be considered to be the same product; they are at least closely related inasmuch as both are used for the same purpose, namely, to clean the user's skin. Opposer's testimony and evidence further establish that opposer's skin care products are related to applicant's cosmetics and hair lotions inasmuch as spas and beauty salons use and sell both while providing their services. The testimony and evidence establishes in addition that applicant's beauty salons, hairdressing salons and beauty care for human beings are related to opposer's skin care products inasmuch as beauty salons and spas offering skin and beauty care also market skin and beauty products. Thus, we find that opposer's goods and applicant's goods and services are related for purposes of our likelihood of confusion determination.

Because we find that certain of applicant's goods and services are related to opposer's goods, we need not also determine the similarity or dissimilarity of opposer's goods to the other goods and services identified in applicant's application. Similarity as to *any* of the goods or services identified in the application and pleaded registration will suffice as a basis

Opposition No. 91197584

for finding the respective goods and services to be similar for purposes of the second *du Pont* factor. *See, for example, Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

Channels of Trade

Because there are no recited restrictions as to the channels of trade or classes of purchasers of the goods and services identified in the involved application or the goods identified in opposer's pleaded registration, we must assume that the goods and services are available in all the normal channels of trade to all the usual purchasers for such goods and services. *See Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("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, the particular channels of trade or the class of purchasers to which the sales of goods are directed."). *See also Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods."). As such, the parties' goods and services are presumed to be marketed to the general public through all normal trade channels therefor.

Opposition No. 91197584

Regarding the opposer's trade channels and classes of consumers for goods under its Positively Ageless mark, Mr. Collins offered the following testimony:¹²

Q. But you're also, I would imagine, interested in being able to get to the consumer from a variety of different channels of trade, too?

A. Yep. So as part of Johnson & Johnson Consumer Companies, Inc. we have relationships with major retailers throughout the country, and so that - consumers are not only looking for skin care solutions in one place.

Q. And do people sometimes buy these things in spas or -?

A. Um-hum.

Q. - from - and do some dermatologists sell -?

A. Yep.

Q. Sell these kinds of products as well?

A. Yes. So a lot of the - for example, a spa or salon, a place where you would get a facial, those types of things, obviously there's a connection there for the benefit that you're looking for and products that would address those benefits, and so we compete with the brands and the products that are offered in those - locations and are always looking for ways for us to expand there. ...

Applicant has indicated that the trade channels for his goods and services will include beauty salons, spas, and "aesthetic doctors" and that he plans to market his goods and services at trade shows, through mailers, the Internet and direct solicitation.¹³ As discussed above, opposer markets its goods

¹² TTABVue 25 at 15-18.

¹³ TTABVue 22 at 14.

Opposition No. 91197584

through magazines and various Internet and digital media outlets.¹⁴ As a result, the evidence of record establishes that applicant's goods and services as well as opposer's goods are or will be offered and advertised through some of the same channels of trade.

Summary

In view of the foregoing, we find that opposer has established its standing to bring this proceeding; its priority of use; that its POSITIVELY AGELESS mark is strong; that its goods are related to applicant's goods and services and are or will be marketed through some of the same channels of trade; and that the similarities between applicant's mark and opposer's mark far outweigh the differences between them.

DECISION: The opposition is sustained on the ground of likelihood of confusion, and registration to applicant is refused.

¹⁴ TTABVue 25 at 21, 89