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

Proceeding	91203898
Party	Defendant Beautiful People Magazine, Inc.
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Submission	Motion to Amend/Amended Answer or Counterclaim
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

PeopleNetwork Aps AKA BeautifulPeople.com Opposer	.	
	.	Mark: Beautiful People Magazine
v.	.	Serial No. 85,196,831
	.	
Beautiful People Magazine, Inc. Applicant	.	Opposition No. 91203898
	.	

MOTION FOR LEAVE TO FILE FOURTH AMENDED ANSWER

In accordance with Trademark Trial and Appeal Board procedures, Applicant, by and through its President Joshua Domond, requests leave to file Applicant's Fourth Amended Answer to this Opposition.

I. STATEMENT OF FACTS

On February 15, 2012, Opposer filed this action, Opposition 91203898 against Applicant's federal trademark application, Serial No. 85,196,381.

Applicant filed Applicant's First Amended Answer to the Notice of Opposition on September 11, 2012 and the Trademark Trial and Appeal Board granted the Motion.

In Applicant's First Amended Answer, Applicant reserved the right to assert additional affirmative defenses and/or to supplement the Applicant's First Amended Answer upon further discovery or investigation.

Applicant filed Applicant's Second Amended Answer to the Notice of Opposition on January 15, 2013 along with a corresponding motion. Applicant also filed Applicant's Third Amended Answer to the Notice of Opposition on March 7, 2013 along with a corresponding motion. In those amended answers, the Applicant also reserved the right to assert additional affirmative defenses and/or to supplement Applicant's previous answers upon further discovery or investigation. The Board granted the motions and the Third Amended Answer was designated as the operative responsive pleading.

Since Applicant filed Applicant's Third Amended answer, Applicant has become aware of new relevant affirmative defenses via research of TTAB case database and has become aware of new legal doctrine to amplify Applicant's affirmative defenses.

Applicant has recently learned of TTAB precedent case Opposition 91152662 which clarifies issues relevant to this opposition, including priority, merely descriptive marks, secondary meaning, likelihood of confusion, and fraud. Additionally, Applicant has learned other TTAB precedent cases such as Opposition Nos. 91168142 & 91170668 - University Games Corporation v. 20Q.net Inc. which provide clarification of (1) the elements of fraud and (2) the point at which it may be too late to cure material false representations in a trademark application. Applicant has also become aware of case law relevant to the analysis of descriptiveness, such as *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002) and *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 44 (CCPA 1981).

Pursuant to lessons learned from Opposition 91152662 and the other oppositions and/or court cases mentioned above, Applicant desires to amend Applicant's answer to include (1) the new defense of "lack of priority" due to descriptiveness (without secondary meaning or acquired distinctiveness) and (2) provide facts supporting that defense. Applicant also wishes to add other affirmative defenses such as good faith, weak mark, analogous use, and other various affirmative defenses.

Additionally, Applicant seeks to clarify the definitions of descriptive marks and secondary meaning, as well as articulate test for merely descriptive marks according to TTAB precedential case such as *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002). Applicant also seeks to supplement applicant's denial of "false suggestion of a connection" and amplify that denial in the affirmative defense section as well.

Applicant also wishes to clearly express the elements of fraud, including pleading the element of "intent to defraud the US Patent and Trademark Office." Applicant also seeks to provide a more in depth examination of the material false representations made by Opposer in the Opposer's cited trademark applications. Additionally, applicant wishes to articulate case law that suggests that (1) the material false representations in Opposer's current trademark applications cannot be cured since the Applicant has challenged these false representations in this opposition and that suggests that (2) the Opposer must file new trademark applications to cure the materially false representations. (See Opposition Nos. 91168142 & 91170668 - University Games Corporation v. 20Q.net Inc.)

Applicant also wishes to supplement Applicant's previous answers and affirmative defenses in this opposition to make these answers and defenses more comprehensive.

Applicant files this motion in hopes that the TTAB will allow the Applicant to file Applicant's Fourth Amended Answer to preserve all rights in this matter and preserve affirmative defenses.

II. ARGUMENT

a. The Court Should Freely Grant Leave to Amend

FRCP 15(a) states that “leave [to amend] shall be freely given when justice so requires.” Though leave to amend is firmly within the discretion of the Board, “In exercising this discretion, a court must be guided by the underlying purpose of Rule 15 – to facilitate decision on the merits, rather than on the pleadings or technicalities.” *Roth v. Garcia Marquez*, 942 F.2d 617, 628 (9th Cir. 1991), quoting *United States v. Webb*, 655 F.2d 977, 979 (9th Cir. 1981).

Furthermore, “this policy is to be applied with extreme liberality.” *Morongo Band of Mission Indians v. Rose*, 893 F.2d 1074, 1079 (9th Cir. 1990).

New affirmative defenses (or claims) may be set forth via amendment, but a proposed amendment need not, of itself, set forth a claim or defense. A proposed amendment may serve simply to amplify allegations already included in the moving party's pleading. See *Avedis Zildjian Co. v. D. H. Baldwin Co.*, 180 USPQ 539 (TTAB 1973).

In this case, justice requires that the Board grant leave to amend so that Applicant is fully able to address all legal issues in the Notice of Opposition, provide more comprehensive affirmative defenses supported by precedent of the TTAB, and preserve affirmative defenses. Justice also requires that the Board grant leave to amend so that the Board, when deciding this case, will have a more complete record on which to rule. This furthers the goal of justice and efficiency.

b. Opposer Will Not Be Unfairly Prejudiced by Granting Leave to Amend the Answer and Granting Leave to Amend Will Not Violate Settled Law

Reasons to deny leave to amend a pleading under FRCP 15(a) include “undue delay, bad faith, or dilatory motive on the part of the movant.” *Foman v. Davis*, 371, U.S. 178, 182 (1962). According to TTAB precedent and/or relevant case law, leave to amend a pleading may be denied if doing so violates settled law. Here, there has been no bad conduct, bad faith, or bad/dilatory motive by the Applicant. Additionally, no settled law will be violated by granting this Leave to File Applicant's Fourth Amended Answer.

Please note that Opposer will not suffer unfair prejudice if the Leave to Amend the Answer is granted because the discovery has not closed and the trial has not begun. There is simply no prejudice here.

Finally, granting this Leave to File Applicant's Fourth Amended Answer will not

violate settled law.

c. The Board Should Reset All Subsequent Dates for Discovery and Trial.

Applicant respectfully requests that the Board reset all of the discovery dates or deadlines, as well as all trial dates or deadlines, upon resolution of the motion.

d. The Board Should Suspend All Proceedings Pending the Outcome of This Motion.

Pursuant to 37 CFR § 2.127(d), the Board should suspend “the case... with respect to all matters not germane to the motion.” T.B.M.P. § 528.03. Thus, Applicant respectfully requests that the Board issue an order suspending all proceedings pending the outcome of this motion.

III. CONCLUSION

For the foregoing reasons, Applicant hereby requests that the Trademark Trial and Appeal Board grant this Motion for Leave to file Applicant’s Fourth Amended Answer.

Dated: 06/27/2013

Respectfully submitted,



Joshua Domond
President
Beautiful People Magazine, Inc
PO Box 1157
Hallandale, Florida 33008
Phone: 305-305-5122

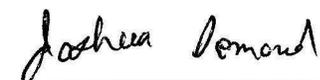
PROOF OF SERVICE BY MAIL

I, Joshua Domond, the undersigned, hereby declare as follows:

1. I am over 18 years and I am the President of the Applicant/Defendant in Opposition No. 91203898.
2. My address is PO Box 1157, Hallandale, Florida 33008.
3. On 06/27, 2013 at PO Box 1157, Hallandale, Florida 33008, I served a true copy of the attached document, entitled "Motion For Leave To File Fourth Amended Answer" by placing the documents in an addressed, sealed envelope clearly labeled to identify the person being served at the address shown below and placed this in the mail for deposit in the United States Postal Service on that date in accordance with ordinary business practices:

David K. Caplan
Kilpatrick Townsend & Stockton LLP
Attorneys for PeopleNetwork Aps AKA Beautiful People.com
9720 Wilshire Blvd, Penthouse Suite
Beverly Hills, CA 90212

4. An electronic copy was also emailed to Opposer's email at dcaplan@kmwlaw.com.
5. I declare that the foregoing is true and correct. Executed 06/27, 2013 at Hallandale, FL.



Joshua Domond
President of Beautiful People Magazine, Inc.
Beautiful People Magazine, Inc.
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Hallandale, Florida 33008
Phone: 305-305-5122

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v.	.	Serial No. 85,196,831
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Beautiful People Magazine, Inc. Applicant	.	Opposition No. 91203898
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APPLICANT'S FOURTH AMENDED ANSWER TO NOTICE OF OPPOSITION

Beautiful People Magazine, Inc. ("Applicant"), a Florida corporation, by and through its president, Joshua Domond, hereby, answers the Notice of Opposition as follows:

1. Applicant lacks knowledge or information sufficient to form a belief as to the allegations in Paragraph 1 of the Notice of Opposition and the preceding background supplied by Opposer, and on that basis denies such allegations. Additionally, Opposer failed to plead and/or provide any specific details on how it will be damaged by registration of Applicant's intent to use mark presented in application Serial No. 85,196,831.
2. Applicant lacks knowledge or information sufficient to form a belief as to the allegations in Paragraph 2 of the Notice of Opposition, and on that basis denies such allegations.
3. Applicant lacks knowledge or information sufficient to form a belief as to the allegations in Paragraph 3 of the Notice of Opposition, and on that basis denies such allegations.
4. Applicant lacks knowledge or information sufficient to form a belief as to the allegations in Paragraph 4 of the Notice of Opposition, and on that basis denies such allegations.

Additionally, Applicant denies that Opposer has common law trademarks. Opposer's alleged marks cited in the Notice of Opposition are not inherently distinctive and do not have acquired distinctiveness or secondary meaning. In fact, Opposer's alleged marks are "merely descriptive" of goods and services provided by the Opposer and do not serve as indicators of the source of the goods and services. For descriptiveness, the relevant question is whether someone who knows what the goods or services are will understand the mark to convey information about them. (See *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002). Since the Opposer's alleged marks are merely descriptive and do not have secondary meaning, the alleged marks that Opposer references in the Notice of Opposition do not qualify as common law trademarks.

Additionally, Opposer does not have the exclusive right to the alleged beautiful people marks in the United States as illustrated by several active registrations or applications for marks which include the words "beautiful people" and as illustrated by the fact that those applications or registrations have owners other than the Opposer. More specifically, there are active registrations and applications containing the words beautiful people in classes 018, 025, 041, and 045.

The registrations and/or applications with their associated dates of first use in commerce in the United States are listed below.

Registration No. 3960506 for Beautiful People in Class 025 owned 37.37, Inc. (Date of first use in commerce in the United States - June 1998)

Registration 2941226 for Where Beautiful People Come to Get Ugly in class 025 and 043 owned by Sports Entertainment, Inc. (Date of first use in commerce in the United States - 1991)

Registration 3274447 for Beautiful Bags for Beautiful People in Class 018 owned by Charlotte Parker. (Date of first use in commerce in the United States - May 01, 2005)

Application No. 85281311 for Date Beautiful People in Class 045 (on the Supplemental Register) owned by Infostream Group, Inc. (Date of first use in commerce in the United States - December 4, 2011)

Registration 3850544 for Beautiful People in Action in Class 041 owned by Applicant. (Date of first use in commerce in the United States - August 31, 2009).

Applicant has also found evidence that one or more of the above trademark registrants and/or trademark applicants are currently using their marks.

Opposer filed trademark applications in Class 41 dealing with entertainment or entertainment services and in Class 45 for dating services. Likewise, at least two of the above listed trademark applications or registrations have goods and services

similar to those that are offered by the Opposer in Class 41 and Class 45.

Applicant's mark Beautiful People in Action (Registration No. 3850544) in class 41 has a goods and services description consisting of entertainment services. Similarly, Infostream Group, Inc's Application No. 85281311 for Date Beautiful People in Class 45 on the Supplemental Register has a goods and services description of "internet based dating, social introduction, and social networking services."

Additionally, there are many other businesses that are currently using the "beautiful people" name without a registered federal trademark. Examples include Beautiful People, LLC in Arizona, Beautiful People, LLC in Florida, Beautiful People LLC in Nevada, Beautiful People BP LLC in Illinois, Beautiful People Salon, LLC in South Carolina, and Beautiful People Salon & Day Spa in Connecticut.

There are many websites that contain the terms "beautiful people" such as <http://wearebeautifulpeople.com> or <http://beautifulpeopleliveart.com>.

There was a TV series named Beautiful People that ran on ABC network in the United States in the past and a documentary named Beautiful People, which is described at <http://www.beautifulpeopledocfilm.com>.

Based on the facts above, it is clear that the Opposer does not have exclusive rights to use the terms "beautiful people" and that the Opposer has not had "substantially exclusive" use of the terms "beautiful people" in the United States.

5. Applicant lacks knowledge or information sufficient to form a belief as to the allegations in Paragraph 5 of the Notice of Opposition, and on that basis denies such allegations.
6. Applicant lacks knowledge or information sufficient to form a belief as to the allegations in Paragraph 6 of the Notice of Opposition, and on that basis denies such allegations.
7. Applicant lacks knowledge or information sufficient to form a belief as to the allegations in Paragraph 7 of the Notice of Opposition, and on that basis denies such allegations.
8. Applicant lacks knowledge or information sufficient to form a belief as to the allegations in Paragraph 8 of the Notice of Opposition, and on that basis denies such allegations.

Applicant denies that Opposer has common law trademarks. Opposer's alleged marks are not inherently distinctive and do not have acquired distinctiveness or secondary meaning. In fact, Opposer's alleged marks are "merely descriptive" of

goods and services provided by the Opposer and do not serve as indicators of the source of the goods and services. For descriptiveness, the relevant question is whether someone who knows what the goods or services are will understand the mark to convey information about them. (See *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002). Since the Opposer's alleged marks are merely descriptive and do not have secondary meaning, the alleged marks that Opposer references in the Notice of Opposition do not qualify as common law trademarks.

Additionally, Opposer does not state whether Opposer used the Opposer's cited alleged marks in commerce in the United States in 2001. There is no evidence that Opposer's alleged marks were used for dating services, calendars, or for a reality TV show in commerce in the United States in 2001. Opposer did not present any evidence in response to Applicant's discovery requests to support any claims of usage of the Opposer's marks in commerce in the United States in 2001.

However, there is evidence that Opposer did not use Opposer's alleged marks in commerce in the United States for dating services until July of 2005. Likewise, there is evidence that Opposer did not use Opposer's alleged marks in commerce in the United States for calendars until 2010 (if use in the U.S. occurred at all).

Lastly, there is no clear evidence that Opposer has ever used Opposer's alleged marks in the United States for a reality TV show. The specimens provided by the Opposer were taken from the Opposer's reality TV show that aired in Canada and from a Canadian website at slice.ca. These Canadian specimens will not suffice as specimens for a U.S. trademark application because the specimens do not show use in commerce in the United States.

As mentioned above, Applicant asserts that Opposer has never used Opposer's alleged marks in commerce in the United States for a reality TV show. However, the Opposer stated (in answers to interrogatories) that Opposer did not use Opposer's alleged marks for a reality TV show in commerce in the United States until 2009. This date of 2009 is clearly different than the 2001 date that Opposer listed on the trademark applications.

Also, the Opposer failed to provide specific facts to illustrate that the general public recognizes Opposer's marks as designations of source of Opposer's services or goods.

9. Applicant denies all allegations in Paragraph 9 of the Notice of Opposition.

Applicant denies that Opposer has common law trademarks. Opposer's alleged marks are not inherently distinctive and do not have acquired distinctiveness or secondary meaning. In fact, Opposer's alleged marks are "merely descriptive" of goods and services provided by the Opposer and do not serve as indicators of the source of the goods and services. For descriptiveness, the relevant question is whether someone who knows what the goods or services are will understand the

mark to convey information about them. (See *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002). Since the Opposer's alleged marks are merely descriptive and do not have secondary meaning, the alleged marks that Opposer references in the Notice of Opposition do not qualify as common law trademarks.

Furthermore, Applicant denies that Applicant's mark is similar to Opposer's alleged marks as to appearance, sound, connotation, and/or commercial impression, as illustrated by the following analysis.

- (i) Applicant's mark has a different appearance, sound, and commercial impression than the Opposer's alleged marks because Applicant's mark has the term "magazine" as the final word in the mark. The word "magazine" provides three extra syllables and lets consumers know that the Applicant intends to put out an online and/or hard copy magazine. Applicant's mark also does not have .com at the end.
- (ii) The words "beautiful people" in the Applicant's mark have a primary meaning that is equivalent to "inner beauty."
- (iii) The connotation or secondary meaning of the words "beautiful people" in Applicant's mark is equivalent to "philanthropy." Additional secondary meanings for the words "beautiful people" in the Applicant's mark include providing assistance to mankind, performing good deeds, or transforming the world in a positive way."

Applicant also denies that the Applicant's mark has services similar to Opposer's goods/services, as discussed later in this answer.

Applicant denies the Applicant's mark will cause a mistake as to source, sponsorship, affiliation, or to deceive. Additionally, Opposer has not properly pled a case for "false suggestion of a connection." Section 2(a) prohibits the registration of a mark that consists of or comprises matter that may falsely suggest a connection with persons, institutions, beliefs or national symbols. See TMEP §1203.03(a) regarding persons, TMEP §1203.03(b) regarding national symbols, and TMEP §1203.03 for information about the legislative history of §2(a). To establish that a proposed mark falsely suggests a connection with a person or an institution, it must be shown that: (1) the mark is the same as, or a close approximation of, the name or identity previously used by another person or institution; (2) the mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution; (3) the person or institution named by the mark is not connected with the activities performed by the applicant under the mark; and (4) the fame or reputation of the person or institution is such that, when the mark is used with the applicant's goods or services, a connection with the person or institution would be presumed. Opposer has not proven these elements (as discussed in the affirmative defenses section) and cannot prove these elements because there is no false suggestion of a connection in this matter.

Additionally, Applicant denies that Applicant's mark poses any likelihood of confusion, mistake, or deception under Section 2d of the Act, in relation to the Opposer's alleged marks on several grounds, including, but not limited to the following analysis:

In order for an Opposer to prevail on a claim of likelihood of confusion based on its ownership of common-law rights in a mark, the alleged marks must be distinctive, inherently or otherwise, and the Opposer must show priority of use. In this case, Opposer's alleged marks are not inherently distinctive and do not have acquired distinctiveness or secondary meaning. In fact, Opposer's alleged marks are merely descriptive of goods and services provided by the Opposer and do not serve as an indicator of the source of Opposer's goods and services. The Opposer's alleged marks are not suitable for registration on the Principal Register. All of the Opposer's alleged marks should have been filed on the Supplemental Register due to the descriptive nature of the wording and the lack of secondary meaning.

Opposer also fails to prove that Opposer has priority over the Applicant because Opposer's alleged marks are merely descriptive without secondary meaning. Because the Opposer cannot establish priority, which is a necessary element of the ground of likelihood of confusion, the Opposer's priority claim and likelihood of confusion claim should be dismissed.

Additionally, there is no likelihood of confusion according to the factors articulated via *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). The analysis of below illustrates the Applicant's mark and Opposer's alleged marks are not confusingly similar.

Applicant makes the following assertions:

(a) Applicant's mark is a strong and distinctive mark, such that no conflicting registered or pending marks were found by the trademark examiner.

Conversely, Opposer's alleged marks are not inherently distinctive and do not have acquired distinctiveness or secondary meaning. Additionally, the Opposer does not have "substantially exclusive" use of the terms "beautiful people," as explained in this answer.

Opposer's application Serial No. 85236075 for Beautiful People in classes 016 and 045 was initially refused registration on the Principal Register because the trademark examiner determined the alleged mark to be merely descriptive of features of the Opposer's goods and services.

An excerpt from the Opposer's website states that subjects become members of its dating services when they are voted "beautiful" after uploading a photograph. Thus, the products and services feature "beautiful people." The trademark examiner concluded that both the individual components and the words combined were

descriptive of Opposer's goods and services and did not create a unique, incongruous, or non-descriptive meaning in relation to the goods and services. The Opposer's application for Serial No. 85236075 was later suspended, but the rejection for being merely descriptive was "continued" by the trademark examiner.

The Opposer filed an identical application for Beautiful People in Class 041 on the Supplemental Register, the register reserved for descriptive marks. The co-pending Opposer's application for Beautiful People on the Supplemental Register is Serial No. 85/264,026 and the prosecution of the Opposer's application has been suspended. It was appropriate for the Opposer to file this application on the supplemental register because the Opposer's alleged mark is merely descriptive. Likewise, the Opposer's other cited application Serial No 85472690 for BeautifulPeople.com would have likely faced rejection by the trademark examiner for being merely descriptive.

All of the alleged marks cited by the Opposer in the Notice of Opposition should have been filed on the supplemental register because those alleged marks are merely descriptive and do not have secondary meaning.

Additionally, the Opposer does not have "substantially exclusive" use of the terms beautiful people and Opposer's alleged marks are not famous.

(b) The Opposer's alleged marks are not famous.

Opposer failed to plead and provide specific facts to support any claim that the Opposer's marks are famous. Opposer did not plead and/or provide facts to prove that the Opposer's marks are famous to customers or to potential customers in the relevant market. Opposer also failed to plead and/or provide specific facts to prove that the Opposer's marks have widespread renown and recognition by general public.

Opposer failed to plead specific facts and/or provide detailed evidence to establish fame of the Opposer's marks, such as detailed advertising figures, detailed sales figures, market share analyses, brand recognition surveys, and details regarding length of use. Furthermore, the Opposer failed to produce such evidence in response to Applicant's discovery requests.

Additionally, Opposer failed to plead specific facts to prove that the Opposer's marks have been adjudicated as famous by a court of competent jurisdiction in the United States. Opposer, in fact, admitted in answers to discovery that the Opposer's alleged marks have not been adjudicated as famous.

(c) Applicant's mark is sufficiently different in its entirety from Opposer's mark as to appearance, sound, connotation, and/or commercial impression so as to preclude any likelihood of confusion.

- (i) Applicant's mark has a different appearance, sound, and commercial impression than the Opposer's alleged marks because Applicant's mark has the term "magazine" as the final word in the mark. The word "magazine" provides three extra syllables and lets consumers know that the Applicant intends to put out an online and/or hard copy magazine. Applicant's mark also does not have .com at the end.
 - (ii) The words "beautiful people" in the Applicant's mark have a primary meaning that is equivalent to mean "inner beauty."
 - (iii) The connotation or secondary meaning of the words "beautiful people" in Applicant's mark is equivalent to "philanthropy." Additional secondary meanings for the words "beautiful people" in the Applicant's mark include providing assistance to mankind, performing good deeds, or transforming the world in a positive way."
 - (iv) There has been no reported and/or documented actual confusion between Opposer's alleged marks and Applicant's marks.
- (d) Goods to be sold by Applicant are sufficiently different from those sold by Opposer so as to preclude any likelihood of confusion.

Applicant's application (Serial No. 85196831) is filed in Class 009 with a goods and services description listed as "downloadable electronic publication, namely general interest magazine featuring philanthropy, fashion, health, food, world issues, travel, art, and entertainment. Applicant's application (Serial No. 85196831) will focus mainly on philanthropy and inner beauty.

Opposer has no trademark applications filed and/or pending in class 009 because Opposer's goods and services are not eligible to be listed in Class 009. Additionally, Opposer's goods and services focus on outer beauty and outer physical attractiveness.

In fact, Opposer's applications are filed in Classes 016, 041, and 045 and these applications have goods/services that are different from those of Applicant. The goods and services referenced in Opposer's applications do not belong in Class 009. A more specific listing of Opposer's cited applications is as follows:

Opposer's application Serial No. 85236075 for Beautiful People is filed in Class 16 for "calendars" and in Class 045 for "dating services." Opposer's specimens do not prove that Opposer has used the alleged mark in commerce for calendars "in the United States." Applicant also ran a thorough internet search and found no other evidence of Opposer using the alleged mark in commerce for

calendars “in the United States.” Furthermore, Applicant’s goods and services are clearly different than these goods and services of Opposer for Serial No. 85236075.

Opposer’s application Serial No. 85264026 for Beautiful People is filed in Class 041 on the supplemental register for “entertainment, namely a continuing reality television show broadcast over television, cable television, audio, video, digital media, and the internet.”

Opposer’s application 85472690 for BeautifulPeople.com is filed in Class 041 for “entertainment services in the nature of an ongoing reality based television program and in Class 045 for “internet based dating, social introduction, and social networking services.”

Note that there is no clear evidence that Opposer has ever used Opposer’s alleged marks in the United States for a reality TV show. The specimens provided by the Opposer were taken from Opposer’s reality TV show that aired in Canada and from a Canadian website at slice.ca.

The Applicant asserts that Opposer has never used Opposer’s alleged marks in commerce in the United States for a reality TV show. Applicant conducted a thorough internet search and has found no evidence that Opposer has used the mark in commerce for a reality TV show “in the United States.”

However, the Opposer stated (in answers to interrogatories) that Opposer used the Opposer’s alleged marks for a reality TV show in commerce in the United States in 2009. This 2009 alleged date of first use in commerce that Opposer presented in the answers to discovery is quite different than the date of first use in commerce listed on the Opposer’s trademark applications.

Furthermore, Applicant’s goods and services are clearly different than these goods and services of Opposer for Serial No. 85264026 & for Serial No. 85472690.

(e) The consumer markets and trade channels through which Applicant shall sell Applicant’s goods/services are sufficiently different from those of the Opposer so as to preclude any likelihood of confusion.

Applicant will market Beautiful People Magazine (Serial No. 85,196,831) to consumers of all ages and not exclusively to physically attractive persons. Applicant especially hopes to attract consumers who have a yearning for philanthropy, inner beauty, and spirituality. Readers of Beautiful People Magazine will be interested in learning about inner beauty. Inner Beauty can be illustrated by providing assistance to mankind, performing good deeds or philanthropic acts, or transforming the world in a positive way.

Since the focus of Beautiful People Magazine will be inner beauty and not outer beauty, there will be no requirement that a person's face and/or body be physically attractive to be featured on the cover or in the body of Beautiful People Magazine.

The only requirements for Applicant's Beautiful People Magazine will be that the persons appearing on the cover page or in the body of Beautiful People Magazine have inner beauty (as described above) and/or have some unique contribution worthy of being featured in Beautiful People Magazine.

Thus, the cover page and content of Beautiful People Magazine could feature photos and stories concerning average looking persons, attractive looking persons, ugly or unattractive persons, obese persons, dwarfs, elderly persons, persons with age spots and wrinkles, young children, physically or mentally disabled persons, disfigured persons, persons with missing limbs, and any other persons who have inner beauty (as illustrated by providing assistance to persons in need, performing good deeds or philanthropic acts, or transforming the world in a positive way.)

The online publication for Beautiful People Magazine may feature physically attractive persons, especially if these persons fit the criteria for inner beauty (as described above) or if those persons have a unique contribution worthy of being featured in Beautiful People Magazine.

Trade channels for Beautiful People Magazine will be via internet webpage download, via email, and/or any other suitable means.

In contrast, the Opposer markets the goods/services associated with Opposer's alleged marks to physically attractive persons exclusively and/or to shallow people who are primarily concerned with outer physical appearance, as evidenced on Opposer's BeautifulPeople.com website.

The Opposer, according to press releases, has a strict ban on "ugliness" and a strict ban on persons who are overweight (termed as "fatties"). One of the founders of Beautifulpeople.com (Robert Hintze) has directly stated that "letting fatties roam the beautifulpeople.com website is a direct threat to the beautifulpeople.com business model. Another founding member of beautifulpeople.com (Greg Hodge) has directly stated "We have to stick to our founding principles of only accepting beautiful people – that's what our members have paid for. We can't just sweep 30,000 ugly people under the carpet."

The BeautifulPeople.com website states "As a member of BeautifulPeople, you will have access to the most attractive people locally and from around the globe." Additionally, the website BeautifulPeople.com has a voting system for picking the most physically attractive persons. To become a member, applicants are required to be voted in by existing members of the opposite sex. Members rate new applicants over a 48 hour period based on whether or not they find the applicant 'beautiful'. Should applicants secure enough positive votes from members, they will be granted

membership to the BeautifulPeople community.

Additionally, materials that the Opposer submitted to allege use of the Opposer's alleged mark related to a Reality TV show, state the following:

"The Good, The Bad, Not The Ugly...There are thousands of dating agencies but this series lifts the lid on the most exclusive. The Beautiful People is only open to the lovely looking, the achingly attractive, and the down-right drop-dead gorgeous. It's like being in an exclusive club--Mensa for the beautiful!"

"Each episode delves into the world of the vain, the egotistical, and the self-obsessed. New applicants are allowed in only if they pass the beauty test. We join them on dates---will they think their date is as beautiful as they are or will they be sadly disappointed?---go to Beautiful People events, and meet the ones desperate to get into this exclusively gorgeous club. Each week we follow those who have tried (and tried again) to get membership---but keep failing."

Trade Channels for Opposer's marks appear to be the internet and Television.

(f) The conditions under which Applicant will sell Applicant's goods are sufficiently different from those under which Opposer's goods are sold so as to preclude any likelihood of confusion.

Consumers who will purchase Applicant's Beautiful People Magazine will not purchase the magazine on impulse or based on the physical attractiveness of persons featured on the cover or in the body of the magazine. Consumers who will purchase Beautiful People Magazine will have thought through the benefits of the magazine and purchase the magazine to read about persons with inner beauty. There will be no voting system based on physical attractiveness to determine which persons are featured on the cover or within the body of the Applicant's magazine. Similarly, there will be no voting system based on physical attractiveness to determine who buys or can buy Beautiful People Magazine.

In contrast, sales and utilization of Opposer's products/services are governed by a voting system, as described on the BeautifulPeople.com website and as described in Opposer's answers to Applicant's discovery.

The beautifulpeople.com website states" The website for beautifulpeople.com also has a voting system for picking the most physically attractive persons. To become a member, applicants are required to be voted in by existing members of the opposite sex. Members rate new applicants over a 48 hour period based on whether or not they find the applicant 'beautiful'. Should applicants secure enough positive votes from members, they will be granted membership to the BeautifulPeople community.

10. Applicant lacks knowledge or information sufficient to form a belief as to the allegations in Paragraph 10 of the Notice of Opposition, and on that basis denies such allegations.

Applicant denies that Opposer has common law trademarks. Opposer's alleged marks are not inherently distinctive and do not have acquired distinctiveness or secondary meaning. In fact, Opposer's alleged marks are "merely descriptive" of goods and services provided by the Opposer and do not serve as indicators of the source of the goods and services. For descriptiveness, the relevant question is whether someone who knows what the goods or services are will understand the mark to convey information about them. (See *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002). Since the Opposer's alleged marks are merely descriptive and do not have secondary meaning, the alleged marks that Opposer references in the Notice of Opposition do not qualify as common law trademarks.

Applicant also denies Opposer's statements about use of Opposer's alleged marks in the U.S.

In the Notice of Opposition, Opposer implicitly states that Opposer has used Opposer's alleged marks in commerce in the United States since 2001. However, Opposer does not state whether Opposer used the Opposer's alleged marks in commerce in the United States since 2001. There is no evidence that Opposer's alleged marks were used for dating services, calendars, or for a reality TV show in commerce in the United States in 2001.

However, there is evidence that Opposer did not use Opposer's alleged marks in commerce in the United States for dating services until July of 2005. Likewise, there is evidence that Opposer did not use Opposer's alleged marks in commerce in the United States for calendars until 2010.

Lastly, there is no clear evidence that Opposer has ever used Opposer's alleged marks in the United States for a reality TV show. The specimens provided by the Opposer were taken from Opposer's reality TV show that aired in Canada and from a Canadian website at slice.ca.

Applicant asserts that Opposer has never used Opposer's alleged marks in commerce in the United States for a reality TV show. However, Opposer states (in answers to interrogatories) that Opposer used the Opposer's marks for a reality TV show in commerce in the United States in 2009. This 2009 date is clearly different than the date listed on Opposer's trademark applications.

Opposer also failed to provide specific facts to illustrate that the general public recognizes Opposer's marks as designations of source of Opposer's services or goods.

Additionally, Applicant denies any implied or express claims by Opposer that Opposer's alleged marks are famous. Opposer failed to plead and provide specific facts to support any implied or express claim that the Opposer's alleged marks are famous.

Opposer did not plead and/or provide facts to prove that the Opposer's alleged marks are famous to customers or to potential customers in the relevant market. Opposer also failed to plead and/or provide specific facts to prove that Opposer's marks have widespread renown and recognition by general public.

Opposer also failed to plead specific facts and/or provide detailed evidence to establish fame of the Opposer's alleged marks, such as detailed advertising figures, detailed sales figures, market share analyses, brand recognition surveys, and details regarding length of use. Additionally, Opposer failed to produce such evidence in response to Applicant's discovery requests.

Additionally, Opposer failed to plead specific facts to prove that the Opposer's marks have been adjudicated as famous by a court of competent jurisdiction in the United States. Opposer, in fact, admitted in answers to discovery that Opposer's alleged marks have not been adjudicated as famous.

11. Denied. Applicant denies all of the allegations set forth in Paragraph 11 of the Notice of Opposition.

Applicant denies that Opposer has common law trademarks. Opposer's alleged marks are not inherently distinctive and do not have acquired distinctiveness or secondary meaning. In fact, Opposer's alleged marks are "merely descriptive" of goods and services provided by the Opposer and do not serve as indicators of the source of the goods and services. The Opposer's alleged marks are not suitable for registration on the Principal Register. All of the Opposer's alleged marks should have been filed on the Supplemental Register due to the descriptive nature of the wording and the lack of secondary meaning.

For descriptiveness, the relevant question is whether someone who knows what the goods or services are will understand the mark to convey information about them. (See *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002). Since the Opposer's alleged marks are merely descriptive and do not have secondary meaning, the alleged marks that Opposer references in the Notice of Opposition do not qualify as common law trademarks.

Additionally, Applicant denies all allegations that Applicant's mark dilutes, will dilute, or is likely to dilute the Opposer's alleged marks via blurring or tarnishment.

Applicant denies any implied or express claims that Opposer's alleged marks are famous.

As referenced above, Applicant denies that the Opposer's alleged marks are inherently distinctive for the goods and services listed in Opposer's applications. Opposer's alleged marks do not have acquired distinctiveness or secondary meaning. In fact, Opposer's alleged marks are merely descriptive of the goods and services offered under Opposer's trademark applications.

Opposer's application Serial No. 85236075 for Beautiful People in classes 016 and 045 was initially refused registration on the Principal Register because the trademark examiner determined the alleged mark to be merely descriptive of features of the Opposer's goods and services.

The Opposer acknowledged the descriptive nature of the words "beautiful people" in regards to Opposer's goods/services when Opposer filed application Serial No. 85264026 on the Supplemental Register. The Supplemental Register is reserved for descriptive marks that do not have secondary meaning.

Additionally, Opposer's specimens submitted for Opposer's alleged marks do not prove that Opposer has used the alleged marks in commerce in the United States for calendars or for a reality TV show.

Applicant asserts that Opposer has never used Opposer's alleged marks in commerce in the United States for a reality TV show. The specimens that the Opposer submitted with the trademark applications were taken from Opposer's reality TV show that aired in Canada and from a Canadian website at slice.ca.

Even if one assumes that the Opposer has used the alleged marks in commerce in the United States for a reality TV show, the Opposer stated (in answers to Applicant's interrogatories) that Opposer used the Opposer's marks for a reality TV show in commerce in the United States in 2009. This 2009 date is clearly different from the date of first use in commerce listed on the Opposer's trademark applications.

Additionally, the Opposer's alleged marks are not famous. Opposer failed to plead and provide specific facts to support any claim that the Opposer's alleged marks are famous. Opposer did not plead and/or provide facts to prove that the Opposer's alleged marks are famous to customers or to potential customers in the relevant market. Opposer also failed to plead and/or provide specific facts to prove that the Opposer's alleged marks have widespread renown and recognition by general public.

Opposer also failed to plead specific facts and/or provide detailed evidence to establish fame of the Opposer's alleged marks, such as detailed advertising figures, detailed sales figures, market share analyses, brand recognition surveys, and details regarding length of use. Additionally, Opposer failed to produce such evidence in response to Applicant's discovery requests.

Furthermore, Opposer failed to plead specific facts to prove that the Opposer's alleged marks have been adjudicated as famous by a court of competent jurisdiction in the United States. The Opposer admitted (in answers to discovery) that Opposer's alleged marks have not been adjudicated as famous

Since the alleged marks referenced by the Opposer in the Notice of Opposition are not famous, there is no dilution.

Opposer also failed to plead or provide specific facts to prove that Applicant's mark weakens the power of the Opposer's alleged marks through identification with dissimilar goods.

Additionally, Opposer has not pleaded specific facts to prove the traditional factors of dilution by blurring via examination of:

- (i) the degree of similarity between the mark and the alleged famous mark,
- (ii) the degree of inherent or acquired distinctiveness,
- (iii) the extent to which the owner of the alleged famous mark is engaging in substantially exclusive use of the mark,
- (iv) degree of recognition of the alleged famous mark,
- (v) whether the user of the alleged infringing mark intended to create an association with the alleged famous mark, and
- (vi) any actual association between the mark and the alleged famous mark.

As to the degree of similarity between the Applicant's mark and the alleged famous mark, Applicant denies that Applicant's mark is identical or similar to Opposer's mark as to appearance, sound, connotation, and/or commercial impression.

Applicant's mark has a different appearance, sound, and commercial impression than the Opposer's alleged marks because Applicant's mark has the term "magazine" as the final word in the mark. The extra word provides three extra syllables and lets consumers know that the Applicant intends to put out an online and/or hard copy magazine. Applicant's mark also does not have .com at the end.

The words "beautiful people" in the Applicant's mark have a primary meaning that is equivalent to "inner beauty."

The connotation or secondary meaning of the words "beautiful people" in Applicant's mark is equivalent to "philanthropy." Additional secondary

meanings for the words “beautiful people” in the Applicant’s mark include providing assistance to mankind, performing good deeds, or transforming the world in a positive way.”

As to the degree of inherent or acquired distinctiveness, Applicant makes the following assertions:

(a) Applicant’s mark is a strong and distinctive mark, such that no conflicting registered or pending marks were found by the trademark examiner.

Conversely, Opposer’s alleged marks are not inherently distinctive and do not have secondary meaning. Additionally, Opposer does not have “substantially exclusive” use of the terms “beautiful people,” as explained in this answer.

Opposer’s application Serial No. 85236075 for Beautiful People in classes 016 and 045 was initially refused registration on the Principal Register because the trademark examiner determined the alleged mark to be merely descriptive of features of the Opposer’s goods and services.

An excerpt from the Opposer’s website states that subjects become members of its dating services when they are voted “beautiful” after uploading a photograph. Thus, the products and services feature “beautiful people.” The trademark examiner concluded that both the individual components and the words combined were descriptive of Opposer’s goods and services and did not create a unique, incongruous, or non-descriptive meaning in relation to the goods and services. The Opposer’s application for Serial No. 85236075 was later suspended, but the rejection for being merely descriptive was “continued” by the trademark examiner.

The Opposer filed an identical application for Beautiful People in Class 041 on the Supplemental Register, the register reserved for descriptive marks. The co-pending Opposer’s application for Beautiful People on the Supplemental Register is Serial No. 85/264, 026 and the prosecution of the Opposer’s application has been suspended. It was appropriate to file this alleged mark on the Supplemental Register due to the descriptive nature of the wording.

Likewise, the Opposer’s other cited application Serial No 85472690 for BeautifulPeople.com would have likely faced rejection by the trademark examiner for being merely descriptive.

Opposer does not have “substantially exclusive” use of the terms beautiful people and Opposer’s alleged marks are not famous.

As to the extent to which the owner of the alleged famous mark is engaging in substantially exclusive use of the mark, Applicant asserts that Opposer does not have the exclusive right to the beautiful people mark in the United States as illustrated by several active registrations or applications for marks which include the

words “beautiful people” and as illustrated by the fact that those applications or registrations have owners other than the Opposer. More specifically, there are active registrations and applications containing the words beautiful people in classes 018, 025, 041, and 045.

The registrations and/or applications with their associated dates of first use in commerce in the United States are listed below.

Registration No. 3960506 for Beautiful People in Class 025 owned 37.37, Inc. (Date of first use in commerce in the United States - June 1998)

Registration 2941226 for Where Beautiful People Come to Get Ugly in class 025 and 043 owned by Sports Entertainment, Inc. (Date of first use in commerce in the United States - 1991)

Registration 3274447 for Beautiful Bags for Beautiful People in Class 018 owned by Charlotte Parker. (Date of first use in commerce in the United States - May 01, 2005)

Application No. 85281311 for Date Beautiful People in Class 045 (on the Supplemental Register) owned by Infostream Group, Inc. (Date of first use in commerce in the United States - December 4, 2011)

Registration 3850544 for Beautiful People in Action in Class 041 owned by Applicant. (Date of first use in commerce in the United States - August 31, 2009).

Applicant has also found evidence that one or more of the above trademark registrants and/or trademark applicants are currently using their marks.

Opposer filed trademark applications in Class 41 dealing with entertainment or entertainment services and in Class 45 for dating services. At least two of the above listed trademark applications or registrations have goods and services similar to those that are offered by the Opposer in Class 041 and Class 045.

Applicant’s mark Beautiful People in Action (Registration No. 3850544) in class 41 has a goods and services description consisting of entertainment services. Similarly, Infostream Group, Inc’s Application No. 85281311 for Date Beautiful People in Class 45 on the Supplemental Register has a goods and services description of “internet based dating, social introduction, and social networking services.”

There are many other businesses that are currently using the “beautiful people” name without a registered federal trademark. Examples include. Beautiful People, LLC in Arizona, Beautiful People, LLC in Florida, Beautiful People LLC in Nevada, Beautiful People BP LLC in Illinois, Beautiful People Salon, LLC in South Carolina, and Beautiful People Salon & Day Spa in Connecticut.

There are many websites that contain the terms "Beautiful People" such as <http://wearebeautifulpeople.com> or <http://beautifulpeopleliveart.com>.

There was a TV series named Beautiful People that ran on ABC network in the United States in the past and a documentary named Beautiful People, which is described at <http://www.beautifulpeopledocfilm.com>.

Based on the facts above, it is clear that Opposer does not have exclusive rights to use the terms "Beautiful People."

As to the degree of recognition of the alleged famous mark, Opposer also failed to provide specific facts to illustrate that the general public recognizes Opposer's alleged marks as designations of the source of Opposer's services or goods.

As to whether the user of the alleged infringing mark intended to create an association with the alleged famous mark, Applicant asserts that Applicant did not intend to create an association with the Opposer's alleged marks and that Applicant has, in fact, not created an association with Opposer's alleged marks.

Applicant acted in good faith in selecting Applicant's mark that was applied for in Application Serial No. 85-196,831. As noted in Applicant's answers to Opposer's discovery, Applicant's president selected Applicant's mark by himself. Applicant's President did not select the Beautiful People Magazine mark to trick consumers in order to "cash in" on the Opposer's business or good will. In fact, Applicant's President did not know about the Opposer's company or Opposer's alleged marks until the Opposer filed the Notice of Opposition for Opposition No. 91203898.

Furthermore, Applicant's concept of focusing on inner beauty is totally different from Opposer's concept of focusing on outer beauty exclusively, such that there would be no benefit for Applicant to create any type of association with Opposer's alleged marks.

At the time of filing of the Applicant's application Serial No. 85,196,831, Applicant had a bona fide intent to use Applicant's mark and Applicant still has a bona fide intent to use Applicant's mark for the goods/services listed in Applicant's trademark application. Applicant did not know of Opposer's existence or of the existence of Opposer's marks at the time Applicant filed application Serial No. 85,196,831.

As to any actual association between Applicant's mark and the alleged famous mark, Applicant asserts that there has been no reported or observed actual confusion between the Applicant's mark and Opposer's alleged marks. Opposer confirmed this in the Opposer's answers to Applicant's interrogatories.

Additionally, Opposer has failed to plead specific facts to prove dilution by tarnishment. More specifically, Opposer failed to plead or provide specific facts to prove that Applicant's mark casts the Opposer's alleged marks in an unflattering light or harms the reputation of the Opposer's alleged marks through association with inferior products or services.

12. Denied. Although registration of Applicant's mark might give Applicant at least a prima facie exclusive right to the use of Applicant's mark and right to enforcement against third parties using confusingly similar marks after the filing date of the intent to use application Serial No. 85,196,831, Applicant would recognize the rights of senior third party users.

Opposer will not be damaged by registration of Applicant's mark because there is no likelihood of confusion. The alleged marks that Opposer references in the Notice of Opposition do not qualify as common law trademarks. Opposer's alleged marks are not inherently distinctive and do not have acquired distinctiveness or secondary meaning. In fact, Opposer's alleged marks are "merely descriptive" of goods and services provided by the Opposer and do not serve as indicators as to the source of the goods and services. All of the Opposer's alleged marks should have been filed on the Supplemental Register, the register reserved for descriptive marks. The Opposer's alleged marks, clearly, does not have priority over the Applicant's marks.

Applicant also denies that Opposer will be damaged by registration of the Applicant's mark, in view of the differences between the goods and services of Applicant's application Serial No. 85,196,831 and Opposer's alleged marks. None of the Opposer's trademark applications are in class 009 and Opposer's cited applications are not eligible for Class 009 as illustrated by the goods/services descriptions listed on Opposer's applications.

Opposer will not be damaged by the registration of Applicant's mark because there is no likelihood of dilution. The alleged marks cited by the Opposer in the Notice of Opposition are not famous, and thus, there is no trademark dilution. The Opposer also does not satisfy several of the other factors examined in a trademark dilution analysis.

Additionally, the Opposer will not be damaged by registration of Applicant's mark because Opposer does not have substantially exclusive use of the term's "beautiful people" in view of all of the other senior common law mark holders who are currently using the terms "beautiful people."

Moreover, Opposer has not pleaded or provided specific details and/or written evidence to support a reasonable basis for Opposer's belief that the Opposer will be damaged by registration of the Applicant's mark.

13. Applicant lacks knowledge or information sufficient to form a belief as to the allegations in Paragraph 13 of the Notice of Opposition, and on that basis denies such allegations.

The Opposer does not have superior rights in the terms “beautiful people” and does not have priority. Because Opposer does not own a U.S. registration, in order to prevail on a claim under Trademark Act § 2(d), Opposer bears the burden of demonstrating a proprietary interest acquired through use of Opposer’s alleged marks prior to the filing date of Applicant’s intent-to-use application.

Since the Opposer has not pleaded ownership of any registered trademark, the Opposer must rely on its alleged common-law use of the terms “beautiful people” as a trademark to prove priority. In order to establish priority of use, Opposer must prove that it acquired trademark rights prior to the filing date of Applicant’s intent to use trademark application. (See Opposition 91152662 and See *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 44 (CCPA 1981)).

Opposer must establish that it acquired trademark rights in the alleged beautiful people marks, that these alleged marks are distinctive, either inherently or through acquired distinctiveness, and that its use predates Applicant’s first actual or first constructive use. Evidence of acquired distinctiveness can include the length of use of the mark, advertising expenditures, sales, survey evidence, and affidavits asserting source-indicating recognition.

Opposer’s alleged marks are not inherently distinctive and do not have acquired distinctiveness or secondary meaning. In fact, Opposer’s alleged marks are “merely descriptive” of goods and services provided the Opposer and do not serve as indicators as to source of the goods and services. For descriptiveness, the relevant question is whether someone who knows what the goods or services are will understand the mark to convey information about them. (See *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002)). The Opposer’s alleged marks are not suitable for registration on the Principal Register. All of the Opposer’s alleged marks should have been filed on the Supplemental Register due to the descriptive nature of the wording and the lack of secondary meaning. Opposer has provided very little, if any, evidence to prove secondary meaning and that is because Opposer simply cannot produce such evidence.

Opposer clearly does not have priority over the Applicant’s trademark application Serial No. 85,196,831.

The Opposer has not pleaded or proved that, in the minds of the public, the terms “beautiful people” identify the source of Opposer’s products or services. As related to the services provided the Opposer, the terms “beautiful people” are highly descriptive and Opposer hasn’t shown “substantially exclusive” use of these terms.

Trademark examiners at the USPTO have determined that Opposer's marks are merely descriptive during prosecution of Opposer's trademark applications.

Namely, Opposer's application Serial No. 85236075 for Beautiful People in classes 016 and 045 was initially refused registration on the Principal Register because the trademark examiner determined the mark to be merely descriptive of features of the Opposer's goods and services. The Opposer's application for Serial No. 85236075 was suspended, but the rejection for being merely descriptive was "continued" by the trademark examiner.

The Opposer filed an identical application for Beautiful People in Class 041 on the Supplemental Register, the register reserved for descriptive marks. The co-pending Opposer's application for Beautiful People on the Supplemental Register is Serial No. 85/264,026 and the prosecution of the Opposer's application has been suspended. It was appropriate to file this alleged mark on the Supplemental Register because the alleged mark is descriptive in nature.

The Opposer's other cited application Serial No 85472690 for BeautifulPeople.com would have likely faced rejection by the trademark examiner for being merely descriptive.

Additionally, Opposer does not have the exclusive right to the beautiful people mark in the United States and the public would not be misled or deceived if the Applicant's mark were registered.

Opposer's claim of exclusive rights to the mark "beautiful people" is disproved by examining various active registrations or applications for marks which include the terms "beautiful people" and by noticing that the registrations or applications have owners other than Opposer. More specifically, there are active registrations and applications containing the words beautiful people in at classes 018, 025, 041, and 045.

The registrations and/or applications with their associated dates of first use in commerce in the United States are listed below.

Registration No. 3960506 for Beautiful People in Class 025 owned 37.37, Inc. (Date of first use in commerce in the United States - June 1998)

Registration 2941226 for Where Beautiful People Come to Get Ugly in class 025 and 043 owned by Sports Entertainment, Inc. (Date of first use in commerce in the United States - 1991)

Registration 3274447 for Beautiful Bags for Beautiful People in Class 018 owned by Charlotte Parker. (Date of first use in commerce - United States - May 01, 2005)

Application No. 85281311 for Date Beautiful People in Class 045 (on the Supplemental Register) owned by Infostream Group, Inc.
(Date of first use in commerce in the United States - December 4, 2011)

Registration 3850544 for Beautiful People in Action in Class 041 owned by Applicant. (Date of first use in commerce in the United States - August 31, 2009).

Applicant has also found evidence that one or more of the above trademark registrants and/or trademark applicants are currently using their marks.

Opposer filed trademark applications in Class 41 dealing with entertainment or entertainment services and in Class 45 for dating services. Similarly, at least two of the above listed trademark applications or registrations have goods and services similar to those that are offered by the Opposer in Class 41 and Class 45.

Applicant's mark Beautiful People in Action (Registration No. 3850544) in class 41 has a goods and services description consisting of entertainment services as well. Similarly, Infostream Group, Inc's Application No. 85281311 for Date Beautiful People in Class 045 on the Supplemental Register has a goods and services description of "internet based dating, social introduction, and social networking services."

Additionally, there are many other businesses that are currently using the "beautiful people" name without a registered federal trademark. Examples include Beautiful People, LLC in Arizona, Beautiful People, LLC in Florida, Beautiful People LLC in Nevada, Beautiful People BP LLC in Illinois, Beautiful People Salon, LLC in South Carolina, and Beautiful People Salon & Day Spa in Connecticut.

There are many websites that contain the terms "beautiful people" such as <http://wearebeautifulpeople.com> or <http://beautifulpeopleliveart.com>.

There was a TV series named Beautiful People that ran on ABC network in the United States in the past and a documentary named Beautiful People, which is described at <http://www.beautifulpeopleocfilm.com>.

Based on the facts above, it is clear that Opposer does not have exclusive rights to use the terms "Beautiful People."

AFFIRMATIVE DEFENSES

Without admitting or acknowledging that Beautiful People Magazine, Inc. and/or its President, Joshua Domond, bear any burden of proof as to any of the defenses listed below, Applicant asserts the following defenses.

First Affirmative Defense (Lack of Standing)

Opposer has not demonstrated sufficient standing because Opposer has not pleaded or provided specific details to support a reasonable claim that Opposer has common law marks. Opposer's alleged common-law marks are not inherently distinctive and do not have acquired distinctiveness or secondary meaning. In fact, the Opposer's alleged marks are "merely descriptive" of goods and services provided by the Opposer and do not serve as indicators as to the source of the goods and services. The Opposer's alleged marks are not suitable for registration on the Principal Register. All of the Opposer's alleged marks should have been filed on the Supplemental Register due to the descriptive nature of the wording and the lack of secondary meaning. The Opposer acknowledged the descriptive nature of the wording by filing at least one of Opposer's trademark applications on the Supplemental Register.

The Opposer has not pleaded or proved that, in the minds of the public, the terms "beautiful people" identify the source of Opposer's products or services. As related to the services provided by the Opposer, the terms "beautiful people" are highly descriptive and the alleged marks of the Opposer do not have secondary meaning. Furthermore, the Opposer hasn't shown "substantially exclusive" use of these terms.

Additionally, the Opposer did not plead secondary meaning in the Opposer's Notice of Opposition and the Notice of Opposition has not been amended. The Opposer knew and/or should have known of any facts that the Opposer could use in a pleading to support any claim of secondary meaning when the Opposition was filed on February 15, 2012. Any attempted amendment of the Notice of Opposition at this point to include pleadings regarding secondary meaning or acquired distinctiveness should be considered as untimely, given the amount of time that the Opposer has had to amend the pleadings since the opposition was filed on February 15, 2012.

Thus, the Opposer should not be allowed to amend the Notice of Opposition to plead secondary meaning at this time and the Applicant objects to any attempt by the Opposer to amend the Notice of Opposition to plead secondary meaning or acquired distinctiveness. Likewise, the Applicant objects to any attempt by the Opposer to introduce evidence of secondary meaning in the trial phase of the Opposition since the Opposer did not plead secondary meaning in the Notice of Opposition or in any amended Notice of Opposition. Similarly and for the same reason, the Opposer should not be allowed to amend the Notice of Opposition to claim analogous use, tacking, trade identity rights, and the like. Additionally, Opposer should not be allowed to amend Opposer's Notice of Opposition to claim lack of bona fide intent by Applicant or to properly plead

the allegation of false suggestion of connection.

Trademark examiners at the USPTO determined that the Opposer's alleged marks were merely descriptive during prosecution of Opposer's trademark applications.

Namely, Opposer's application Serial No. 85236075 for Beautiful People in classes 016 and 045 was initially refused registration on the Principal Register because the trademark examiner determined the mark to be merely descriptive of features of the Opposer's goods and services. The trademark examiner concluded that both the individual components and the words combined were descriptive of Opposer's goods and services and did not create a unique, incongruous, or non-descriptive meaning in relation to the goods and services. The Opposer's application for Serial No. 85236075 was later suspended, but the rejection for being merely descriptive was "continued" by the trademark examiner.

The Opposer filed an identical application for Beautiful People in Class 041 on the Supplemental Register, the register reserved for descriptive marks. The co-pending Opposer's application for Beautiful People on the Supplemental Register is Serial No. 85/264,026 and the prosecution of the Opposer's application has been suspended. It was appropriate to file this application on the Supplemental register as the alleged mark is highly descriptive in nature.

Additionally, the Opposer's other cited application Serial No 85472690 for BeautifulPeople.com would have likely faced rejection by the trademark examiner for being merely descriptive.

Furthermore, the Opposer will not be damaged by registration of Applicant's mark because the Opposer does not have "substantially exclusive" use of the term's "beautiful people" in view of all of the other third party common law mark users who are currently using the terms "beautiful people." The Applicant has already discussed third party registrations and/or applications such as:

- (i) Registration No. 3960506 for Beautiful People in Class 025 owned 37.37, Inc.,
- (ii) Registration 2941226 for Where Beautiful People Come to Get Ugly in class 025 and 043 owned by Sports Entertainment, Inc.
- (iii) Registration 3274447 for Beautiful Bags for Beautiful People in Class 018 owned by Charlotte Parker,
- (iv) Application No. 85281311 for Date Beautiful People in Class 045 (on the Supplemental Register) owned by Infostream Group, Inc.
- (v) Registration 3850544 for Beautiful People in Action in Class 041 owned by Applicant.

The probative value of third party trademarks depends entirely on their usage. (See Scarves by Vera, Inc. vs Todo Imports, Ltd, 544 F.2d 1167, 1173 (2nd Cir. 1976)) Applicant has also found evidence that one or more of the above trademark registrants and/or trademark applicants are currently using their marks. Thus, the Opposer does not

have “substantially exclusive” use of the terms “beautiful people.”

Additionally, Opposer has not demonstrated sufficient standing, in that Opposer has not pleaded or provided specific details and/or written evidence to support a reasonable basis for a belief that the Opposer will be damaged by registration of the Applicant’s mark. In fact, the Opposer will not suffer damage because there is no likelihood of confusion and there is no likelihood of dilution, as explained during discussion of later defenses in this amended answer.

Second Affirmative Defense
(No Inherent Distinctiveness)

The Opposer’s alleged marks are not inherently distinctive. Applicant alleges that Opposer’s alleged marks are weak, and have not obtained the level of distinctiveness sufficient to obtain relief under the Lanham Act or other applicable state and federal laws. In fact, Opposer’s marks are merely descriptive and do not have secondary meaning. Opposer’s alleged marks are not suitable for registration on the Principal Register and should have been filed on the supplemental register.

Third Affirmative Defense
(Merely Descriptive Mark)

Opposer’s alleged marks are merely descriptive of the goods and services provided by the Opposer. Opposer’s alleged marks do not have inherent distinctiveness and do not have acquired distinctiveness or secondary meaning. Without inherent distinctiveness or acquired distinctiveness, the Opposer cannot establish that it is the “substantially exclusive” user of the marks — a prerequisite for applicant to obtain registration. “Distinctiveness is acquired by ‘substantially exclusive and continuous use’ of the mark in commerce.” In order to establish acquired distinctiveness, applicant must show that the primary significance of the proposed marks in the minds of consumers is not the goods or services, but the source of those goods and services.

As stated earlier, the Opposer’s alleged marks are merely descriptive. A mark is merely descriptive if it immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. The entire mark, not just a single component, must be considered. For descriptiveness, the relevant question is whether someone who knows what the goods or services are will understand the mark to convey information about them. (See *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002))

The Opposer’s alleged marks are not suitable for registration on the Principal Register. All of the Opposer’s alleged marks should have been filed on the Supplemental Register due to the descriptive nature of the wording and the lack of secondary meaning.

Opposer's application Serial No. 85236075 for Beautiful People in classes 016 and 045 was initially refused registration on the Principal Register because the trademark examiner determined the mark to be merely descriptive of features of the Opposer's goods and services. The Opposer's application for Serial No. 85236075 was later suspended, but the rejection for being merely descriptive was "continued" by the trademark examiner.

The Opposer already conceded the descriptive nature of this wording, by applying to register identical wording on the Supplemental Register, the register reserved for descriptive marks. The Opposer applied for its co-pending mark for Beautiful People, Serial No. 85/264026, in Class 041 on the Supplemental Register. Prosecution of the co-pending Opposer's application for Beautiful People on the Supplemental Register (Serial No. 85/264, 026) has been suspended. It was appropriate to file this application on the supplemental register because the Opposer's alleged mark is "merely descriptive" without secondary meaning.

The Opposer's other cited application Serial No 85472690 for BeautifulPeople.com would have likely faced rejection by the trademark examiner for being "merely descriptive."

As stated earlier, the opposer's alleged marks do not have secondary meaning. Opposer did not expressly plead secondary meaning in the Notice of Opposition filed on February 15, 2012 and the Opposer has not amended the Notice of Opposition to plead secondary meaning. More specifically, Opposer did not adequately plead facts concerning length of use of the mark in the United States, advertising expenditures in the United States, or sales in the United States to establish secondary meaning. Opposer also did not plead facts from surveys or affidavits to prove acquired distinctiveness or secondary meaning.

If the Opposer's alleged marks possessed secondary meaning, then the Opposer knew or should have known of facts to support such an assertion at the time that the Notice of Opposition was filed. The Opposer had more than fifteen months to plead matters involving secondary meaning and to provide supporting facts. However, the Opposer has failed to plead such facts thus far and the Notice of Opposition has not been amended. Any attempt to amend the Notice of Opposition at this point to include pleadings asserting secondary meaning should be considered as untimely, given the amount of time that the Opposer has had to make such pleadings since the opposition was filed on February 15, 2012.

Through the use of discovery, Applicant has also asked Opposer to answer interrogatories, document production requests, and requests for admission concerning length of use of the mark, advertising expenditures, sales, survey evidence, and affidavits asserting source-indicating recognition to show acquired distinctiveness. The Opposer has provided little evidence concerning length of use of the mark in the United States, advertising expenditures in the United States, sales in the United States, survey evidence for the United States, and affidavits from the United States asserting source-indicating

recognition to show acquired distinctiveness in response to Applicant's discovery requests.

Lastly, it is important to note that the Opposer did not assert secondary meaning or provide facts to support a claim of secondary meaning or acquired distinctiveness in response to the trademark examiner's office action for Serial No. 85236075.

Fourth Affirmative Defense (Lack of Secondary Meaning)

Applicant alleges that Opposer's alleged marks cited in the Notice of Opposition are merely descriptive of the goods and/or services offered by the Opposer and lack secondary meaning. Opposer's alleged marks do not serve as indicators of the source of the goods and services. For descriptiveness, the relevant question is whether someone who knows what the goods or services are will understand the mark to convey information about them. (See *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002). Based on the holding and dicta from the case *In re Tower Tech Inc.*, Opposer's alleged marks are merely descriptive.

Opposer's marks also lack secondary meaning and lack acquired distinctiveness. Evidence of secondary meaning or acquired distinctiveness can include the length of use of the mark, advertising expenditures, sales, survey evidence, and affidavits asserting source-indicating recognition. In response to Applicant's discovery requests, Opposer has produced very little responses, documents, or other evidence concerning length of use, advertising expenditures, sales, survey evidence, or affidavits asserting source-indicating recognition. Opposer does not have such evidence of secondary meaning because Opposer's alleged marks do not have secondary meaning.

Since the Opposer's alleged marks are merely descriptive and do not have secondary meaning, the alleged marks that Opposer references in the Notice of Opposition do not qualify as common law trademarks and are not enforceable. Accordingly, Opposer does not have priority due the fact that Opposer's alleged marks are merely descriptive without secondary meaning.

Fifth Affirmative Defense (Opposer's Lack of Priority)

Because the Opposer does not own a U.S. registration, in order to prevail on a claim under Trademark Act § 2(d), the Opposer bears the burden of demonstrating a proprietary interest acquired through use of Opposer's alleged marks prior to the filing date of the Applicant's intent-to-use trademark application Serial No. 85,196,831. The Applicant may rely on the filing date of Applicant's application Serial No. 85,196,831 for priority (and possible analogous use and tacking, as discussed later in this answer).

Since the Opposer has not pleaded ownership of any registered trademark, the Opposer must rely on its alleged common-law use of the terms “beautiful people” as a trademark to prove priority. In order to establish priority of use, Opposer must prove that the Opposer acquired trademark rights prior to the filing date of the Applicant’s intent to use application Serial No. 85,196,831. (See Opposition 91152662 and See *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 44 (CCPA 1981))

The Opposer must establish that it acquired trademark rights in the Opposer’s alleged beautiful people marks, that these marks are distinctive, either inherently or through acquired distinctiveness, and that the Opposer’s use of the alleged marks predates Applicant’s first actual or constructive use. (See *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 44 (CCPA 1981)). Evidence of acquired distinctiveness (or secondary meaning) can include the length of use of the mark, substantially exclusive usage of mark, advertising expenditures, sales, survey evidence, and affidavits asserting source-indicating recognition.

In this case, the Opposer’s alleged marks are not inherently distinctive and do not have acquired distinctiveness or secondary meaning. In fact, Opposer’s alleged marks are “merely descriptive” of goods and services provided by the Opposer and do not serve as indicators as to the source of the goods and services. For descriptiveness, the relevant question is whether someone who knows what the goods or services are will understand the mark to convey information about them. (See *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002). Since the Opposer’s alleged marks are not inherently distinctive and do not have secondary meaning, this means that the Opposer does not have priority in this opposition. Since the Opposer does not have priority, then there is no likelihood of confusion, as discussed later in this answer.

The Opposer’s alleged marks are not suitable for registration on the Principal Register. All of the Opposer’s alleged marks should have been filed on the Supplemental Register due to the descriptive nature of the wording and the lack of secondary meaning.

The Opposer has not pleaded or proved that, in the minds of the public, the terms “beautiful people” identify the source of Opposer’s products or services. As related to the services provided by the Opposer, the terms “beautiful people” are highly descriptive without secondary meaning and the Opposer hasn’t shown “substantially exclusive” use of these terms.

The Applicant has already discussed third party registrations and/or applications such as:

- (i) Registration No. 3960506 for Beautiful People in Class 025 owned 37.37, Inc.,
- (ii) Registration 2941226 for Where Beautiful People Come to Get Ugly in class 025 and 043 owned by Sports Entertainment, Inc.
- (iii) Registration 3274447 for Beautiful Bags for Beautiful People in Class 018 owned by Charlotte Parker,

- (iv) Application No. 85281311 for Date Beautiful People in Class 045 (on the Supplemental Register) owned by Infostream Group, Inc.
- (v) Registration 3850544 for Beautiful People in Action in Class 041 owned by Applicant.

The probative value of third party trademarks depends entirely on their usage. (See *Scarves by Vera, Inc. vs. Todo Imports, Ltd*, 544 F.2d 1167, 1173 (2nd Cir. 1976)). Applicant has also found evidence that one or more of the above trademark registrants and/or trademark applicants are currently using their marks. Thus, the Opposer does not have “substantially exclusive” use of the terms “beautiful people.”

Trademark examiners at the USPTO determined that Opposer’s marks were merely descriptive during prosecution of Opposer’s trademark applications. Namely, Opposer’s application Serial No. 85236075 for Beautiful People in classes 016 and 045 was initially refused registration on the Principal Register because the trademark examiner determined the mark to be merely descriptive of features of the Opposer’s goods and services.

An excerpt from the Opposer’s website states that subjects become members of its dating services when they are voted “beautiful” after uploading a photograph. Thus, the products and services feature “beautiful people.” The trademark examiner concluded that both the individual components and the words combined were descriptive of Opposer’s goods and services and did not create a unique, incongruous, or non-descriptive meaning in relation to the goods and services. The Opposer’s application for Serial No. 85236075 was later suspended, but the rejection for being merely descriptive was “continued” by the trademark examiner.

The Opposer already conceded the descriptive nature of this wording, by applying to register identical wording on the Supplemental Register, the register reserved for descriptive marks. The Opposer applied for its co-pending mark for Beautiful People, Serial No. 85/264026, in Class 041 on the Supplemental Register. Prosecution of the co-pending Opposer’s application for Beautiful People on the Supplemental Register (Serial No. 85/264,026) has been suspended. It was appropriate to file this application on the supplemental register because the Opposer’s alleged mark is “merely descriptive” without secondary meaning.

The Opposer’s other cited application Serial No 85472690 for BeautifulPeople.com would have likely faced rejection by the trademark examiner for being merely descriptive.

As stated earlier, the Opposer’s marks do not have secondary meaning and the Opposer did not plead secondary meaning. The Opposer did not expressly plead secondary meaning in the Notice of Opposition filed on February 15, 2012 and the Opposer has not amended the Notice of Opposition to plead secondary meaning. More specifically, Opposer did not adequately plead facts concerning length of use of the mark in the United States, advertising expenditures in the United States, or sales in the United

States to establish secondary meaning. Opposer also did not plead facts from surveys or affidavits to prove acquired distinctiveness or secondary meaning. Similarly, Opposer has failed to provide information and/or documents during discovery concerning the following: length of use of the Opposer's alleged marks in the United States, advertising expenditures in the United States, sales in the United States, survey evidence and affidavits asserting source-indicating recognition in the United States.

If the Opposer's alleged marks possessed secondary meaning, then the Opposer knew or should have known of facts to support such an assertion at the time that the Notice of Opposition was filed. The Opposer has had over fifteen months to plead matters involving secondary meaning and to provide supporting facts. However, the Opposer has failed to plead such facts thus far and the Opposer has not amended the Notice of Opposition. Any attempt to amend the Notice of Opposition at this point to include pleadings asserting secondary meaning should be considered as untimely, given the amount of time that the Opposer has had to make such pleadings since the opposition was filed on February 15, 2012. Similarly and for the same reason, the Opposer should not be allowed to amend the Notice of Opposition to claim analogous use, tacking, trade identity rights, and the like. Additionally, Opposer should not be allowed to amend Opposer's Notice of Opposition to claim lack of bona fide intent by Applicant or to properly plead the allegation of false suggestion of connection.

Lastly, it should be noted that the Opposer did not assert secondary meaning or provide facts to support a claim of secondary meaning or acquired distinctiveness in response to the trademark examiner's office action for Serial No. 85236075.

Sixth Affirmative Defense
(No likelihood of Confusion)

In order for the Opposer to prevail on a claim of likelihood of confusion based on its ownership of common-law rights in a mark, the Opposer's alleged marks must be distinctive, inherently or otherwise, and Opposer must show priority of use. (See *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981))

Thus in order to prevail, the Opposer must establish that it acquired trademark rights in the alleged marks, that the alleged marks are distinctive, either inherently or through acquired distinctiveness, and that the Opposer's use predates the Applicant's first actual or constructive use. (See *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981))

In this case, the Opposer's alleged marks are not inherently distinctive and do not have acquired distinctiveness or secondary meaning. The Opposer also does not have priority. Thus, the Opposer should not prevail on a likelihood of confusion claim.

More specifically, the Opposer's alleged marks are merely descriptive of goods and services provided by the Opposer and the alleged marks do not serve as an indicator

of the source of Opposer's goods and services. For descriptiveness, the relevant question is whether someone who knows what the goods or services are will understand the mark to convey information about them. (See *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002). Since the Opposer's alleged marks are merely descriptive and do not have secondary meaning, the alleged marks that Opposer references in the Notice of Opposition do not qualify as common law trademarks.

The Opposer's alleged marks are not suitable for registration on the Principal Register. In fact, all of the Opposer's alleged marks should have been filed on the Supplemental Register due to the descriptive nature of the wording and the lack of secondary meaning.

As stated earlier, the Opposer's marks do not have secondary meaning and the Opposer did not plead secondary meaning. The Opposer did not expressly plead secondary meaning in the Notice of Opposition filed on February 15, 2012 and the Opposer has not amended the Notice of Opposition to plead secondary meaning. More specifically, Opposer did not adequately plead facts concerning length of use of the mark in the United States, advertising expenditures in the United States, or sales in the United States to establish secondary meaning. Opposer also did not plead facts from surveys or affidavits to prove acquired distinctiveness or secondary meaning.

If the Opposer's alleged marks possessed secondary meaning, then the Opposer knew or should have known of facts to support such an assertion at the time that the Notice of Opposition was filed. The Opposer has had over fifteen months to plead matters involving secondary meaning and to provide supporting facts. However, the Opposer has failed to plead such facts thus far and the Notice of Opposition has not been amended. Any attempt to amend the Notice of Opposition at this point to include pleadings asserting secondary meaning should be considered as untimely, given the amount of time that the Opposer has had to make such pleadings since the opposition was filed on February 15, 2012.

Through the use of discovery, Applicant has also asked Opposer to answer interrogatories, document production requests, and requests for admission concerning length of use of the mark, advertising expenditures, sales, survey evidence, and affidavits asserting source-indicating recognition to show acquired distinctiveness. The Opposer has provided very little evidence concerning length of use of the alleged marks in the United States, advertising expenditures in the United States, sales in the United States, survey evidence for the United States, and affidavits from the United States asserting source-indicating recognition to show acquired distinctiveness in response to Applicant's discovery requests.

Lastly, It is important to note that the Opposer did not assert secondary meaning or provide facts to support a claim of secondary meaning or acquired distinctiveness in response to the trademark examiner's office action for Serial No. 85236075

As discussed earlier, the Opposer also fails to establish priority because Opposer's alleged marks are merely descriptive without secondary meaning and because Opposer does not have "substantially exclusive" use of the words "beautiful people" in the United States. Because the Opposer cannot establish its priority and Opposer's alleged marks are merely descriptive without secondary meaning, the Opposer's likelihood of confusion claim fails and the Opposition should be dismissed.

Additionally, there is no likelihood of confusion according to the factors articulated via *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). case. The analysis below illustrates the marks are not confusingly similar.

Applicant makes the following assertions:

(a) Applicant's mark is a strong and distinctive mark, such that no conflicting registered or pending marks were found by the trademark examiner. The trademark examiner did not state that the Applicant's mark was merely descriptive of goods and services provided by the Applicant. In fact, the trademark examiner felt that Applicant has a strong, distinctive mark worthy of registration on the Principal Register (as long as Applicant provided a statement of use and specimen within the allowed period of time in the future).

Conversely, Opposer's alleged marks are not inherently distinctive and do not have acquired distinctiveness. Opposer has not demonstrated that Opposer's descriptive marks have secondary meaning. Additionally, the Opposer does not have "substantially exclusive" use of the terms "beautiful people," as explained in more detail throughout this amended answer.

Opposer's application Serial No. 85236075 for Beautiful People in classes 016 and 045 was initially refused registration on the Principal Register because the trademark examiner determined the mark to be merely descriptive of features of the Opposer's goods and services.

An excerpt from the Opposer's website states that subjects become members of its dating services when they are voted "beautiful" after uploading a photograph. Thus, the products and services feature "beautiful people." The trademark examiner concluded that both the individual components and the words combined were descriptive of Opposer's goods and services and did not create a unique, incongruous, or non-descriptive meaning in relation to the goods and services. The Opposer's application for Serial No. 85236075 was later suspended, but the rejection for being merely descriptive was "continued" by the trademark examiner.

The Opposer filed an identical application for Beautiful People in Class 041 on the Supplemental Register, the register reserved for descriptive marks. The co-pending Opposer's application for Beautiful People on the Supplemental Register is Serial No. 85/264,026 and the prosecution of the Opposer's application has been suspended. It was

appropriate to file this application on the Supplemental Register due to the descriptive nature of the terms “beautiful people” in regards to Opposer’s goods/services.

Likewise, the Opposer’s other cited application Serial No 85472690 for BeautifulPeople.com would have likely faced rejection by the trademark examiner for being merely descriptive.

Furthermore, the Opposer does not have “substantially exclusive” use of the terms beautiful people. The Applicant has already discussed third party registrations and/or applications such as:

- (i) Registration No. 3960506 for Beautiful People in Class 025 owned 37.37, Inc.,
- (ii) Registration 2941226 for Where Beautiful People Come to Get Ugly in class 025 and 043 owned by Sports Entertainment, Inc.
- (iii) Registration 3274447 for Beautiful Bags for Beautiful People in Class 018 owned by Charlotte Parker,
- (iv) Application No. 85281311 for Date Beautiful People in Class 045 (on the Supplemental Register) owned by Infostream Group, Inc.
- (v) Registration 3850544 for Beautiful People in Action in Class 041 owned by Applicant.

The probative value of third party trademarks depends entirely on their usage. (See *Scarves by Vera, Inc. vs Todo Imports, Ltd*, 544 F.2d 1167, 1173 (2nd Cir. 1976)). Applicant has also found evidence that one or more of the above trademark registrants and/or trademark applicants are currently using their marks. Thus, the Opposer does not have “substantially exclusive” use of the terms “beautiful people.”

(b) The Opposer’s alleged marks are not famous.

Opposer also failed to plead and provide specific facts to support any claim that the Opposer’s marks are famous. Opposer did not plead and/or provide facts to prove that the Opposer’s marks are famous to customers or to potential customers in the relevant market. Opposer also failed to plead and/or provide specific facts to prove that the Opposer’s marks have widespread renown and recognition by general public.

Opposer also failed to plead specific facts and/or provide detailed evidence to establish fame of the Opposer’s marks, such as detailed advertising figures, detailed sales figures, market share analyses, brand recognition surveys, and details regarding length of use. Furthermore, Opposer failed to produce evidence of alleged fame (as described earlier in this paragraph) in response to Applicant’s discovery requests.

Opposer also failed to plead specific facts to prove that the Opposer’s marks have been adjudicated as famous by a court of competent jurisdiction in the United States. Opposer admitted in answers to discovery that Opposer’s alleged marks have not been adjudicated as famous

(c) Applicant's mark is sufficiently different in its entirety from Opposer's mark as to appearance, sound, connotation, and/or commercial impression so as to preclude any likelihood of confusion.

Applicant's mark has a different appearance, sound, and commercial impression than the Opposer's alleged marks because Applicant's mark has the term "magazine" as the final word in the mark. The extra word provides three extra syllables and lets consumers know that the Applicant intends to put out an online and/or hard copy magazine. Applicant's mark also does not have .com at the end.

The words "beautiful people" in the Applicant's mark have a primary meaning that is equivalent to mean "inner beauty."

The connotation or secondary meaning of the words "beautiful people" in Applicant's mark is equivalent to "philanthropy." Additional secondary meanings for the words "beautiful people" in the Applicant's mark include providing assistance to mankind, performing good deeds, or transforming the world in a positive way."

There has been no reported actual confusion between Opposer's alleged marks and Applicant's intent to use mark Serial No. 85,196,831.

(d) Goods to be sold by Applicant are sufficiently different from those sold by Opposer so as to preclude any likelihood of confusion.

Applicant's application (Serial No. 85196831) is filed in Class 009 with a goods and services description listed as "downloadable electronic publication, namely general interest magazine featuring philanthropy, fashion, health, food, world issues, travel, art, and entertainment. The Applicant's mark listed in trademark application Serial No. 85196831 will focus mainly on philanthropy and inner beauty.

The Opposer has no trademark applications filed in and/or pending in class 009 because Opposer's goods and services are not eligible to be listed in Class 009. Additionally, Opposer's goods and services focus on outer beauty and outer physical attractiveness.

In fact, Opposer's applications are filed in Classes 016, 041, and 045 and these applications have goods/services that are different from those of Applicant. The goods and services referenced in Opposer's applications do not belong in Class 009. A more specific listing of Opposer's cited applications is as follows:

Opposer's trademark application Serial No 85236075 for Beautiful People is filed in Class 16 for "calendars" and in Class 045 for "dating services." The Opposer's specimens do not prove that Opposer has used the alleged

mark in commerce for calendars “in the United States.” Applicant also ran a thorough internet search and found no evidence of the Opposer using the mark in commerce for calendars “in the United States.” Furthermore, Applicant’s goods and services are clearly different than these goods and services of Opposer for trademark application Serial No. 85236075.

Opposer’s application Serial No. 85264026 for Beautiful People is filed in Class 041 on the supplemental register for “entertainment, namely a continuing reality television show broadcast over television, cable television, audio, video, digital media, and the internet.” Similarly, Opposer’s application 85472690 for BeautifulPeople.com is filed in Class 041 for “entertainment services in the nature of an ongoing reality based television program and in Class 045 for “internet based dating, social introduction, and social networking services.”

There is no clear evidence that the Opposer has ever used Opposer’s alleged marks in the United States for a reality TV show. The specimens provided by the Opposer were taken from Opposer’s reality TV show that aired in Canada and from a Canadian website at <http://www.slice.ca>.

Applicant asserts that Opposer has never used Opposer’s alleged marks in commerce in the United States for a reality TV show. Applicant conducted a thorough internet search and has found no evidence that Opposer has used the mark in commerce for a reality TV show “in the United States.” Furthermore, Applicant’s goods and services are clearly different than these goods and services of Opposer for Serial No. 85264026 and Serial No. 85472690.

However, the Opposer states (in answers to interrogatories) that Opposer used the Opposer’s alleged marks for a reality TV show in commerce in the United States in 2009. That 2009 date that Opposer provided in the answers to interrogatories is later in time than the date that the Opposer specified on the trademark application.

(e) The consumer markets and trade channels through which Applicant shall sell Applicant’s goods/services are sufficiently different from those of the Opposer so as to preclude any likelihood of confusion.

Applicant will market Beautiful People Magazine (Serial No. 85,196,831) to consumers of all ages and not exclusively to physically attractive persons. Applicant especially hopes to attract consumers who have a yearning for philanthropy, inner beauty, and spirituality. Readers of Beautiful People Magazine will be interested in learning about inner beauty. Inner Beauty can be illustrated by providing assistance to mankind, performing good deeds or philanthropic acts, or transforming the world in a positive way.

Since the focus of Beautiful People Magazine will be inner beauty and not outer beauty, there will be no requirement that a person’s face and/or body be physically

attractive to be featured on the cover or in the body of Beautiful People Magazine.

The only requirements for Applicant's Beautiful People Magazine will be that the persons appearing on the cover page or in the body of Beautiful People Magazine have inner beauty (as described above) and/or have some unique contribution worthy of being featured in Beautiful People Magazine.

Thus, the cover page and content of Beautiful People Magazine could feature photos and stories concerning average looking persons, attractive looking persons, ugly or unattractive persons, obese persons, dwarfs, elderly persons, persons with age spots and wrinkles, young children, physically or mentally disabled persons, disfigured persons, persons with missing limbs, and any other persons who have inner beauty (as illustrated by providing assistance to persons in need, performing good deeds or philanthropic acts, or transforming the world in a positive way.)

The online publication for Beautiful People Magazine may feature physically attractive persons, especially if these persons fit the criteria for inner beauty (as described above) or if those persons have a unique contribution worthy of being featured in Beautiful People Magazine.

Trade channels for Beautiful People Magazine will be via internet webpage download, via email, and/or any other suitable means.

In contrast, the Opposer markets the goods/services associated with Opposer's alleged marks to physically attractive persons exclusively and/or to shallow people who are primarily concerned with outer physical appearance, as evidenced on Opposer's BeautifulPeople.com website.

The Opposer, according to press releases, has a strict ban on "ugliness" and a strict ban on persons who are overweight (termed as "fatties"). One of the founders of Beautifulpeople.com (Robert Hintze) has directly stated that "letting fatties roam the beautifulpeople.com website is a direct threat to the beautifulpeople.com business model. Another founding member of beautifulpeople.com (Greg Hodge) has directly stated "We have to stick to our founding principles of only accepting beautiful people – that's what our members have paid for. We can't just sweep 30,000 ugly people under the carpet."

The BeautifulPeople.com website states "As a member of BeautifulPeople, you will have access to the most attractive people locally and from around the globe." Additionally, the website BeautifulPeople.com has a voting system for picking the most physically attractive persons. To become a member, applicants are required to be voted in by existing members of the opposite sex. Members rate new applicants over a 48 hour period based on whether or not they find the applicant 'beautiful'. Should applicants secure enough positive votes from members, they will be granted membership to the BeautifulPeople community.

Additionally, materials that the Opposer submitted to allege use of the Opposer's alleged mark related to a Reality TV show, state the following:

"The Good, The Bad, Not The Ugly...There are thousands of dating agencies but this series lifts the lid on the most exclusive. The Beautiful People is only open to the lovely looking, the achingly attractive, and the down-right drop-dead gorgeous. It's like being in an exclusive club--Mensa for the beautiful!"

"Each episode delves into the world of the vain, the egotistical, and the self-obsessed. New applicants are allowed in only if they pass the beauty test. We join them on dates--- will they think their date is as beautiful as they are or will they be sadly disappointed?--- go to Beautiful People events, and meet the ones desperate to get into this exclusively gorgeous club. Each week we follow those who have tried (and tried again) to get membership---but keep failing."

Trade Channels for Opposer's marks appear to be the internet and Television.

(f) The conditions under which Applicant will sell Applicant's goods are sufficiently different from those under which Opposer's goods are sold so as to preclude any likelihood of confusion.

Consumers who will purchase Applicant's Beautiful People Magazine will not purchase the magazine on impulse or based on the physical attractiveness of persons featured on the cover or in the body of the magazine. Consumers who will purchase Beautiful People Magazine will have thought through the benefits of the magazine and purchase the magazine to read about persons with inner beauty. There will be no voting system based on physical attractiveness to determine which persons are featured on the cover or within the body of the Applicant's magazine. Similarly, there will be no voting system based on physical attractiveness to determine who buys or can buy Beautiful People Magazine.

In contrast, sales and utilization of Opposer's products/services are governed by a voting system, as described on the BeautifulPeople.com website and as described in Opposer's answers to Applicant's discovery.

The beautifulpeople.com website states "The website for beautifulpeople.com also has a voting system for picking the most physically attractive persons. To become a member, applicants are required to be voted in by existing members of the opposite sex. Members rate new applicants over a 48 hour period based on whether or not they find the applicant 'beautiful'. Should applicants secure enough positive votes from members, they will be granted membership to the BeautifulPeople community."

(Seventh Affirmative Defense)
No Famous Marks

As stated earlier, the Opposer's alleged marks are not famous. Applicant alleges that Opposer's alleged marks have not obtained a level of fame, renown, and distinctiveness sufficient to obtain relief as a famous marks under the Lanham Act or other applicable state and federal laws.

Opposer also failed to plead and provide specific facts to support any claim that the Opposer's marks are famous. Opposer did not plead and/or provide facts to prove that the Opposer's marks are famous to customers or to potential customers in the relevant market. Opposer also failed to plead and/or provide specific facts to prove that the Opposer's marks have widespread renown and recognition by general public.

Opposer also failed to plead specific facts and/or provide detailed evidence to establish fame of the Opposer's marks, such as detailed advertising figures, detailed sales figures, market share analyses, brand recognition surveys, and details regarding length of use. Furthermore, Opposer failed to produce evidence of alleged fame (as described earlier in this paragraph) in response to Applicant's discovery requests.

Opposer has also admitted that Opposer's marks have not been adjudicated as famous by a court of competent jurisdiction in the United States.

Eighth Affirmative Defense
(No Likelihood Dilution and No Actual Dilution)

There is no likelihood of dilution and no actual dilution between Applicant's mark and Opposer's alleged marks. Opposer's alleged marks are not famous and thus, there is no dilution. Additionally, the Opposer's alleged marks are not inherently distinctive and do not have acquired distinctiveness or secondary meaning. Opposer has not proven the other elements of trademark dilution.

Opposer failed to plead and/or prove that Opposer's marks are distinctive for the goods and services listed in Opposer's applications. In fact, Opposer's application Serial No. 85236075 for Beautiful People in classes 016 and 045 was initially refused registration on the Principal Register because the trademark examiner determined the mark to be merely descriptive of features of the Opposer's goods and services. The Opposer's application for Serial No. 85236075 was later suspended, but the rejection for being merely descriptive was "continued" by the trademark examiner.

The Opposer filed an identical application for Beautiful People in Class 041 on the Supplemental Register, the register reserved for descriptive marks. The co-pending Opposer's application for Beautiful People on the Supplemental Register is Serial No. 85/264,026 and the prosecution of the Opposer's application has been suspended. It was appropriate to file this application on the Supplemental Register due to the descriptive nature of the terms "beautiful people" in regards to Opposer's goods/services.

Likewise, the Opposer's other cited application Serial No 85472690 for BeautifulPeople.com would have likely faced rejection by the trademark examiner for being merely descriptive.

The Opposer's alleged marks are not suitable for registration on the Principal Register. All of the Opposer's alleged marks should have been filed on the Supplemental Register due to the descriptive nature of the wording and the lack of secondary meaning, as discussed in more detail earlier in this amended answer.

Additionally, the specimens submitted for Opposer's marks do not prove that Opposer has used the marks in commerce for calendars and for a reality TV show "in the United States."

Furthermore, The Opposer's alleged marks are not famous. Opposer also failed to plead and provide specific facts to support any claim that the Opposer's marks are famous. Opposer did not plead and/or provide facts to prove that the Opposer's marks are famous to customers or to potential customers in the relevant market. Opposer also failed to plead and/or provide specific facts to prove that the Opposer's marks have widespread renown and recognition by general public.

Opposer also failed to plead specific facts and/or provide detailed evidence to establish fame of the Opposer's marks, such as detailed advertising figures, detailed sales figures, market share analyses, brand recognition surveys, and details regarding length of use. In response to Applicant's discovery requests, the Opposer produced very little evidence to support any claims that Opposer's alleged marks are famous.

Additionally, Opposer failed to plead specific facts to prove that the Opposer's marks have been adjudicated as famous by a court of competent jurisdiction in the United States. Opposer, in fact, admitted (in answers to discovery) that Opposer's alleged marks have not been adjudicated as famous. Since the Opposer's marks are not famous, there is no likelihood of dilution and no actual dilution.

Opposer also failed to plead or provide specific facts to prove that Applicant's mark weakens the power of the Opposer's marks through identification with dissimilar goods.

Additionally, Opposer did not plead specific facts to prove the traditional factors of dilution by blurring via examination of:

- (i) the degree of similarity between the mark and the alleged famous mark,
- (ii) the degree of inherent or acquired distinctiveness,
- (iii) the extent to which the owner of the alleged famous mark is engaging in substantially exclusive use of the mark,

- (iv) degree of recognition of the alleged famous mark,
- (v) whether the user of the alleged infringing mark intended to create an association with the alleged famous mark, and
- (vi) any actual association between the mark and the alleged famous mark.

As to the degree of similarity between the Applicant's mark and the alleged famous mark, Applicant denies that Applicant's mark is identical or similar to Opposer's mark as to appearance, sound, connotation, and/or commercial impression.

Applicant's mark has a different appearance, sound, and commercial impression than the Opposer's marks because Applicant's mark has the term "magazine" as the final word in the mark. The extra word provides three extra syllables and lets consumers know that the Applicant intends to put out an online and/or hard copy magazine. Applicant's mark also does not have .com at the end.

The words "beautiful people" in the Applicant's mark have a primary meaning that is equivalent to "inner beauty."

The connotation or secondary meaning of the words "beautiful people" in Applicant's mark is equivalent to "philanthropy." Additional secondary meanings for the words "beautiful people" in the Applicant's mark include providing assistance to mankind, performing good deeds, or transforming the world in a positive way."

As to the degree of inherent or acquired distinctiveness, Applicant makes the following assertions:

(a) Applicant's mark is a strong and distinctive mark, such that no conflicting registered or pending marks were found by the trademark examiner. The trademark examiner did not state that Applicant's mark was merely descriptive of goods/services provided by the Applicant. In fact, the trademark examiner felt that Applicant's mark was a strong, distinctive mark worthy of registration on the Principal Register (as long as the Applicant provided specimens and a statement of use within the allowed time period in the future).

Conversely, Opposer's alleged marks are not inherently distinctive and do not have secondary meaning, as explained more thoroughly earlier in this amended answer. Additionally, the Opposer does not have "substantially exclusive" use of the terms "beautiful people."

Opposer's application Serial No. 85236075 for Beautiful People in classes 016 and 045 was initially refused registration on the Principal Register because the trademark examiner determined the mark to be merely descriptive of features of the Opposer's

goods and services.

An excerpt from the Opposer's website states that subjects become members of its dating services when they are voted "beautiful" after uploading a photograph. Thus, the products and services feature "beautiful people." The trademark examiner concluded that both the individual components and the words combined were descriptive of Opposer's goods and services and did not create a unique, incongruous, or non-descriptive meaning in relation to the goods and services. The Opposer's application for Serial No. 85236075 was later suspended, but the rejection for being merely descriptive was "continued" by the trademark examiner.

The Opposer filed an identical application for Beautiful People in Class 041 on the Supplemental Register, the register reserved for descriptive marks. The co-pending Opposer's application for Beautiful People on the Supplemental Register is Serial No. 85/264,026 and the prosecution of the Opposer's application has been suspended. It was appropriate to file this alleged mark on the Supplemental Register due to the descriptive nature of the wording.

Likewise, the Opposer's other cited application Serial No 85472690 for BeautifulPeople.com would have likely faced rejection by the trademark examiner for being merely descriptive.

Opposer does not have "substantially exclusive use of the terms beautiful people.

As to the extent to which the owner of the alleged famous mark is engaging in substantially exclusive use of the mark, Applicant asserts that Opposer does not have the exclusive right to the Beautiful People mark in the United States as illustrated by several active registrations or applications for marks which include the words "beautiful people" and as illustrated by the fact that those applications or registrations have owners other than the Opposer. More specifically, there are active registrations and applications containing the words Beautiful People in classes 018, 025, 041, and 045.

The Applicant has already discussed third party registrations and/or applications such as:

- (i) Registration No. 3960506 for Beautiful People in Class 025 owned 37.37, Inc.,
- (ii) Registration 2941226 for Where Beautiful People Come to Get Ugly in class 025 and 043 owned by Sports Entertainment, Inc.
- (iii) Registration 3274447 for Beautiful Bags for Beautiful People in Class 018 owned by Charlotte Parker,
- (iv) Application No. 85281311 for Date Beautiful People in Class 045 (on the Supplemental Register) owned by Infostream Group, Inc.
- (v) Registration 3850544 for Beautiful People in Action in Class 041 owned by Applicant.

The probative value of third party trademarks depends entirely on their usage. (See *Scarves by Vera, Inc. vs Todo Imports, Ltd*, 544 F.2d 1167, 1173 (2nd Cir. 1976)). Applicant has also found evidence that one or more of the above trademark registrants and/or trademark applicants are currently using their marks. Thus, the Opposer does not have “substantially exclusive” use of the terms “beautiful people.”

Opposer filed trademark applications in Class 41 dealing with entertainment or entertainment services and in Class 45 for dating services. Similarly, at least two of the above listed trademark applications or registrations have goods and services similar to those that are offered by the Opposer in Class 041 and Class 045.

Applicant’s mark Beautiful People in Action (Registration No. 3850544) in class 41 has a goods and services description consisting of entertainment services. Similarly, Infostream Group, Inc’s Application No. 85281311 for Date Beautiful People in Class 45 on the Supplemental Register has a goods and services description of “internet based dating, social introduction, and social networking services.”

Additionally, there are many other businesses that are currently using the “beautiful people” name without a registered federal trademark. Examples include. Beautiful People, LLC in Arizona, Beautiful People, LLC in Florida, Beautiful People LLC in Nevada, Beautiful People BP LLC in Illinois, Beautiful People Salon, LLC in South Carolina, and Beautiful People Salon & Day Spa in Connecticut.

There are many websites that contain the terms “Beautiful People” such as <http://wearebeautifulpeople.com> or <http://beautifulpeopleliveart.com>.

There was a TV series named Beautiful People that ran on ABC network in the United States in the past and a documentary named Beautiful People, which is described at <http://www.beautifulpeopledocfilm.com>.

Based on the facts above, it is clear that Opposer does not have exclusive rights to use the terms “Beautiful People” in the United States.

As to the degree of recognition of the alleged famous mark, Opposer also failed to provide specific facts to illustrate that the general public recognizes Opposer’s marks as designations of source of Opposer’s services or goods. Opposer failed to plead specific facts and/or provide detailed evidence to establish fame of the Opposer’s marks, such as detailed advertising figures, detailed sales figures, market share analyses, brand recognition surveys, and details regarding length of use. Opposer also failed to produce such evidence in response to Applicant’s discovery requests. Additionally, Opposer admitted in answers to discovery that Opposer’s alleged marks have not been adjudicated as famous.

As to whether the user of the alleged infringing mark intended to create an association with the alleged famous mark, Applicant asserts that Applicant did not intend to create an association with the Opposer’s alleged marks and that Applicant has, in fact, not created

an association with Opposer's alleged marks.

Applicant acted in good faith in selecting Applicant's mark that was applied for in Application Serial No. 85,196,831. As noted in Applicant's answers to Opposer's discovery, Applicant's president selected Applicant's mark by himself. Applicant's President did not select the Beautiful People Magazine mark to trick consumers in order to "cash in" on the Opposer's business or good will. In fact, Applicant's President did not know about the Opposer's company or Opposer's alleged marks until the Opposer filed the Notice of Opposition for Opposition No. 91203898.

Furthermore, Applicant's concept of focusing on inner beauty is totally different from Opposer's concept of focusing on outer beauty exclusively, such that there would be no benefit for Applicant to create any type of association with Opposer's alleged marks.

At the time of filing of the Applicant's application Serial No. 85,196,831, Applicant had a bona fide intent to use Applicant's mark and applicant still has a bona fide intent to use Applicant's mark. Applicant did not know about the existence of the Opposer or Opposer's websites at the time the Applicant filed for trademark application Serial No. 85,196,831.

As to any actual confusion between the mark and the alleged famous mark, Applicant asserts that there has been no reported or observed actual confusion between the Applicant's mark and Opposer's alleged marks. Opposer confirmed this in the Opposer's answers to Applicant's interrogatories.

Additionally, Opposer has failed to plead specific facts to prove dilution by tarnishment. More specifically, Opposer failed to plead or provide specific facts to prove that Applicant's mark casts the Opposer's marks in an unflattering light or harms the reputation of the Opposer's marks through association with inferior products or services.

Ninth Affirmative Defense
(No Exclusive Right to the Beautiful People Mark)

Opposer does not have the exclusive right to the beautiful people mark in the United States as illustrated by several active registrations and/or applications for marks that include the term "beautiful people" with such marks having owners different than the Opposer. More specifically, there are active registrations and applications containing the words Beautiful People in classes 018, 025, 041, and 045.

The registrations and/or applications with their associated dates of first use in commerce in the United States are listed below.

Registration No. 3960506 for Beautiful People in Class 025 owned 37.37, Inc.
(Date of first use in commerce in the United States - June 1998)

Registration 2941226 for Where Beautiful People Come to Get Ugly in class 025 and 043

owned by Sports Entertainment, Inc. (Date of first use in commerce in the United States - 1991)

Registration 3274447 for Beautiful Bags for Beautiful People in Class 018 owned by Charlotte Parker. (Date of first use in commerce in the United States - May 01, 2005)

Application No. 85281311 for Date Beautiful People in Class 045 (on the Supplemental Register) owned by Infostream Group, Inc. (Date of first use in commerce in the United States - December 4, 2011)

Registration 3850544 for Beautiful People in Action in Class 041 owned by Applicant. (Date of first use in commerce in the United States - August 31, 2009).

The probative value of third party trademarks depends entirely on their usage. (See *Scarves by Vera, Inc. vs Todo Imports, Ltd*, 544 F.2d 1167, 1173 (2nd Cir. 1976)). Applicant has also found evidence that one or more of the above trademark registrants and/or trademark applicants are currently using their marks. Thus, the Opposer does not have “substantially exclusive” use of the terms “beautiful people.”

Opposer filed trademark applications in Class 41 dealing with entertainment or entertainment services and in Class 45 for dating services. Similarly, at least two of the above listed trademark applications or registrations have goods and services similar to those that are offered by the Opposer in Class 41 and Class 45.

Applicant’s mark Beautiful People in Action (Registration No. 3850544) in class 41 has a goods and services description consisting of entertainment services. Similarly, Infostream Group, Inc’s Application No. 85281311 for Date Beautiful People in Class 45 on the Supplemental Register has a goods and services description of “internet based dating, social introduction, and social networking services.”

Additionally, there are many other businesses that are currently using the “beautiful people” name without a registered federal trademark. Examples include Beautiful People, LLC in Arizona, Beautiful People, LLC in Florida, Beautiful People LLC in Nevada, Beautiful People BP LLC in Illinois, Beautiful People Salon, LLC in South Carolina, and Beautiful People Salon & Day Spa in Connecticut.

There are many websites that contain the terms “Beautiful People” such as <http://wearebeautifulpeople.com> or <http://beautifulpeopleliveart.com>.

There was a TV series named Beautiful People that ran on ABC network in the United States in the past and a documentary named Beautiful People, which is described at <http://www.beautifulpeopleocfilm.com>.

Based on the facts above, it is clear that Opposer does not have exclusive rights to use the terms “beautiful people.” It is also clear that there is no likelihood of dilution and no actual dilution.

Tenth Affirmative Defense
(Prior Registration of Similar Mark)

Applicant's current application, Serial No. 85,196,831 is for Beautiful People Magazine. Applicant has registered a similar mark for Beautiful People in Action (Registration No. 3850544) for "Entertainment services, namely, conducting contests designed to promote socially beneficial goals" in Class 41.

Note that at least one of Opposer's trademark applications is also filed in class 41 with a goods and services description covering entertainment or entertainment services.

Opposer did not file an opposition to Applicant's mark Beautiful People in Action (Registration No. 3850544) covering entertainment services and Opposer has not filed a cancellation petition for the registered mark Beautiful People in Action.

The Opposer cannot be injured by registration of Application Serial No. 85,196,831 which could contain entertainment content connected with philanthropy because there already exists a similar registration by Applicant, (i.e. Beautiful People in Action - Registration No. 3850544) which has goods/services dealing with entertainment services.

Thus, the Opposer should be prevented from seeking opposition of the Applicant's current application Serial No. 85,196,831 and should be prevented from prevailing in such an opposition.

If the Opposer did not object to the registered mark for Beautiful People in Action, then the Opposer should not prevail in an opposition proceeding concerning Applicant's current trademark application Serial No. 85,196,831 for Beautiful People Magazine.

Eleventh Affirmative Defense
(Laches)

Opposer's opposition is barred via the doctrine of Laches by virtue of Opposer's failure to object to Applicant's prior registration of Beautiful People in Action (Registration No. 3,850,544). Furthermore, Opposer failed to file a letter of protest or take any other action for over a year from the filing date of the trademark application for Beautiful People Magazine. Facts supporting Applicant's laches defense include:

- (a) Applicant has a family of marks including Registration No. 3850544, for Beautiful People in Action and Application Serial No. 85,196,831 for Beautiful People Magazine. Applicant has plans to file trademark applications for other marks in the family.
- (b) Applicant filed for Beautiful People in Action on May 5, 2008 as an intent to use mark with a goods/services description listed as "Entertainment services,

namely, conducting contests designed to promote socially beneficial goals” in Class 41

- (c) The Beautiful People in Action mark was published for Opposition on March 31, 2009 and no person or entity filed a Notice of Opposition during the Opposition period.
- (d) The US Patent and Trademark Office issued a notice of Allowance for Beautiful People in Action on June 23, 2009.
- (e) The Use amendment was filed Jun. 22, 2010 and the date of first use in commerce is listed as Aug. 31, 2009. The USPTO accepted Statement of Use on August. 11, 2010.
- (f) The US Patent and Trademark Office issued a registered mark for Beautiful People in Action on Sep. 21, 2010 and the Registration number is 3850544.
- (g) There have been no petitions for cancellation filed for Registration No. 3850544.
- (h) Opposer’s application 85264026 for Beautiful People is filed in Class 41 on the supplemental register for “entertainment, namely a continuing reality television show broadcast over television, cable television, audio, video, digital media, and the internet.” The date of first use is listed as September 1, 2008. There is no evidence that the Opposer used the alleged mark in commerce for a reality TV show on or before September 1, 2008. Additionally, the Opposer’s specimens do not prove that the Opposer’s alleged mark was ever used in commerce in the United States for the goods/services listed on that application. Applicant also ran a thorough internet search and found no other evidence of Opposer using the alleged mark in commerce for reality television show “in the United States.”

- (i) Opposer's application 85472690 for BeautifulPeople.com is filed in Class 41 for entertainment services in the nature of an ongoing reality based television program and in Class 45 for "internet based dating, social introduction, and social networking services." The date of first use is listed as January 1, 2001 for the reality TV show and listed as March 1, 2009 for the internet based dating and social networking. There is no evidence that Opposer used the alleged mark in commerce in the United States for a reality TV show on or before January 1, 2001. Additionally, Opposer's specimens for Class 41 do not prove that the alleged mark has ever been used in commerce in the United States for a reality TV show. Applicant also ran a thorough internet search and found no other evidence of Opposer using the alleged mark in commerce for reality television show "in the United States."

- (j) Opposer's application Serial No. 85236075 for Beautiful People is filed in Class 16 for "calendars" and in Class 045 for "dating services." The date of first use in commerce for both international classes is listed as January 1, 2001. There is no evidence that Opposer used the alleged mark in commerce for calendars or for dating services on or before January 1, 2001. The Opposer's specimens do not prove that the Opposer has ever used the alleged mark in commerce for calendars "in the United States." Applicant also ran a thorough internet search and found no other evidence of Opposer using the alleged mark in commerce for calendars "in the United States."

- (k) Opposer claims common law trademark rights in the alleged marks for application Serial No. 85264026, application Serial No. 85472690, and application Serial No. 85,236,075. However, all of Opposer's alleged marks are merely descriptive and do not have secondary meaning. Merely descriptive marks without secondary meaning are not valid common law marks. Since Opposer's alleged marks are merely descriptive without secondary meaning, this also means that the Opposer does not have priority in this opposition. Additionally, Opposer's specimens for these alleged marks do not provide proof of use in commerce in the United States for calendars or for a reality TV show.

- (l) If the Opposer believed that Opposer's alleged common law marks were valid, then the Opposer had a duty to "police" and enforce Opposer's alleged common law marks under traditional trademark law and theory.

- (m) Opposer failed to file a Notice of Opposition against Applicant's application for Beautiful People in Action (Registration No. 3850544).
- (n) The Opposer did not file a letter of protest during the trademark prosecution period for the mark Beautiful People in Action (Registration No. 3850544).
- (o) The Opposer has not filed a petition for cancellation of the mark Beautiful People in Action (Registration No. 3850544).
- (p) Since Beautiful People in Action (Registration No. 3850544) is part of a family of marks that are or will be filed, the Opposer's assertion of rights against a mark in the same family of marks invokes the laches doctrine (i.e. substantial and unreasonable delay in asserting rights resulting in material prejudice to Applicant).

Twelfth Affirmative Defense
(Fraud)

A trademark registration is obtained, or maintained fraudulently if the respondent knowingly makes a false, material representation with the intent to deceive the USPTO.

In this case, the Opposer knowingly made material, false representations concerning specimens and dates of first use in commerce in the United States on the Opposer's trademark applications with intent to deceive the USPTO. Since these material false representations have been challenged by the Applicant in this opposition proceeding, Applicant asserts that the material false representations in Opposer's current trademark applications cannot be cured and that the Opposer must file new trademark applications to cure the materially false representations. (See Opposition Nos. 91168142 & 91170668, Hurley International LLC v. Volta, 82 USPO2d 1339 (TTAB 2007), Universal Overall Co. v. Stonecutter Mills Corp., 154 USPO 104 (CCPA 1967).

Applicant asserts that Opposer knowingly submitted specimens to the USPTO that do not show use in commerce in the United States for calendars and for a reality TV show with the intent to deceive the US Patent and Trademark Office.

First, Opposer's application Serial No. 85236075 for Beautiful People is filed in Class 16 with a goods and services description including calendars. Opposer knowingly

submitted specimens that do not prove use in commerce in the United States for calendars. Upon independent internet research, Applicant found no other evidence that proves use in commerce in the United States of Opposer's alleged mark for calendars. Opposer submitted these specimens with the intent to deceive the US Patent and Trademark Office.

The Opposer also knowingly submitted specimens that do not prove use in commerce in the United States for a reality TV show for applications Serial No. 85264026 and Serial No. 85472690. More specifically, the specimens that Opposer submitted to the USPTO for the trademark applications referenced in the previous sentence were taken from the Opposer's reality TV show that aired in Canada and from a Canadian website at slice.ca. These specimens show use in commerce in Canada, but not in the United States. With services, "interstate commerce in the United States" generally involves offering a service to customers in another state in the United States or rendering a service that affects interstate commerce in the United States. Clearly, the specimens that the Opposer submitted for applications Serial No. 85264026 and Serial No. 85472690 do not prove or show use in commerce in the United States. Applicant also conducted a thorough internet search and found no evidence that Opposer has ever used the alleged marks in commerce in the United States for a reality TV show. The Opposer submitted these false, material specimens with the intent to deceive the USPTO.

Applicant asserts that the material false specimens submitted by the Opposer in Opposer's current trademark applications cannot be cured since the Applicant has challenged these specimens. (See Opposition Nos. 91168142 & 91170668, *Hurley International LLC v. Volta*, 82 USPQ2d 1339 (TTAB 2007), *Universal Overall Co. v. Stonecutter Mills Corp.*, 154 USPQ 104 (CCPA 1967).

Furthermore, Applicant asserts that the Opposer must file new trademark applications to cure the materially false representations. (See Opposition Nos. 91168142 & 91170668, *Hurley International LLC v. Volta*, 82 USPQ2d 1339 (TTAB 2007), *Universal Overall Co. v. Stonecutter Mills Corp.*, 154 USPQ 104 (CCPA 1967).

Additionally, Applicant asserts that Opposer knowingly and fraudulently submitted false dates of use on Opposer's trademark Applications for Serial No. 85236075, Serial No 85264026, and Serial No 85472690 with the intent to deceive the US Patent and Trademark Office. Applicant asserts that the material false representations (i.e. false dates of use) in Opposer's trademark applications cannot be cured since the Applicant challenged these alleged dates of use in this opposition and Applicant asserts that the Opposer must file new trademark applications to cure the materially false representations. (See Opposition Nos. 91168142 & 91170668, *Hurley International LLC v. Volta*, 82 USPQ2d 1339 (TTAB 2007), *Universal Overall Co. v. Stonecutter Mills Corp.*, 154 USPQ 104 (CCPA 1967).

Opposer listed January 1, 2001 as the date of first use in commerce in the United States for calendars in class 016 on Application Serial No. 85236075. In Opposer's answers to Applicant's First Set of Interrogatories, Opposer stated that Beautiful People launched a United States specific site in July 2005. Opposer also stated that the calendars were available in the US via the Opposer's website at beautifulpeople.com or beautifulpeople.net.

As stated earlier, the specimens that the Opposer submitted to the USPTO do not prove that Opposer has used the alleged mark in commerce in the United States for calendars. Even if one assumes (for the sake of argument) that the Opposer has used the alleged mark in commerce in the United States for calendars, the date of first use in commerce in the United States for calendars listed on Application Serial No. 85236075 is not correct. The earliest date that the Opposer could have used the alleged mark in commerce in the United States for calendars was after Beautiful People launched a United States specific site in July 2005. The Opposer intentionally did not list the date of first use in commerce in the United States for calendars as a date in 2005 on Application Serial No. 85236075. Instead, the Opposer listed January 1, 2001 as the date of first use in commerce in the United States for calendars on this trademark application. The Opposer made this material, false representation with the intent to deceive the USPTO.

Similarly, the Opposer listed January 1, 2001 as the date of first use in commerce in the United States for dating services in class 045 for Application Serial No. 85236075. In Opposer's answers to Applicant's First Set of Interrogatories, the Opposer stated that the Opposer launched a United States specific site for dating services in July 2005. The earliest date that a United States specific site for Beautifulpeople.com and Beautifulpeople.net was actually used in commerce in the United States for dating services was in July 2005. Thus, the earliest date of first use in commerce in the United States for Opposer's alleged mark for dating services was in July of 2005. The Opposer intentionally did not list the date of first use in commerce in the United States for dating services as a date in 2005 on Opposer's Application Serial No. 85236075. Instead, the Opposer listed January 1, 2001 as the date of first use in commerce in the United States for dating services. The Opposer made this material, false representation with the intent to deceive the USPTO.

The Opposer listed September 1, 2008 as the date of first use in commerce in the United States for Entertainment, namely, a continuing reality television show broadcast over television, cable television, audio, video, digital media and the Internet in class 41 on the supplemental register for Application Serial No. 85264026. In Opposer's answers to Applicant's First set of Interrogatories, Opposer stated that the Opposer used the Beautiful People marks, Beautifulpeople.com, and/or Beautifulpeople.net in commerce in Canada for a reality based television program on or before September 1, 2008. With services, "interstate commerce" generally involves offering a service to customers in another state in the United States or rendering a service that affects interstate commerce in the United States. Applicant asserts that Opposer never offered goods or services to customers in the United States for a reality TV show under the alleged mark for

trademark application Serial No. 85264026. Applicant also conducted a thorough internet search and found no evidence that Opposer has used the alleged marks in commerce in the United States for a reality TV show. The Opposer made material, false representations concerning date of first use in commerce in the US with the intent to deceive the USPTO.

Even if one assumes (for the sake of argument) that the Opposer has used the alleged mark in commerce in the United States for a reality TV show, the date of first use in commerce in the United States listed on Application Serial No. 85264026 is not correct. The Opposer stated (in the answers to interrogatories) that the reality TV show was used in commerce on YouTube in the United States in 2009 and/or used in commerce on veoh.com (date unspecified). Even if that were true, the Opposer listed September 1, 2008 as the date of first use on the application Serial No. 85264026. The Opposer made this material, false representation with the intent to deceive the USPTO.

Note that the Applicant searched youtube.com and did not find any evidence of Opposer's reality TV show ever being posted for view on youtube.com and the videos of the Opposer's reality TV show are not currently available on youtube.com. Additionally, the two videos of the Opposer's reality TV show on veoh.com do not have a time/date stamp to show when the videos were posted. The two videos that the Opposer has on veoh.com do not prove that the Opposer's alleged mark was used in commerce in the United States in connection with the sale of any product or service, before the Opposer filed its trademark application(s).

As for trademark application Serial Number 85472690, Opposer listed January 1, 2001 as the date of first use in commerce in the United States for Entertainment services in the nature of an on-going reality based television program in class 041 on that application. In Opposer's answers to Applicant's First set of Interrogatories, Opposer stated that Opposer used the Beautifulpeople.com, Beautifulpeople.net, and/or the Beautiful People marks in commerce in Canada for a reality based television program on or before September 1, 2008. With services, "interstate commerce" generally involves offering a service to customers in another state in the United States or rendering a service that affects interstate commerce in the United States. Applicant asserts that Opposer never offered goods or services to customers in the United States for a reality TV show under the alleged mark for trademark application Serial No. 85472690. Applicant also conducted a thorough internet search and found no evidence that Opposer has used the alleged marks in commerce in the United States for a reality TV show. The Opposer made material, false representations concerning date of first use in commerce in the US with the intent to deceive the USPTO.

Even if one assumes (for the sake of argument) that the Opposer has used the alleged mark in commerce in the United States for a reality TV show, the date of first use in commerce in the United States listed on Application Serial No. 85472690 is not correct. The Opposer stated (in the answers to interrogatories) that the reality TV show was used in commerce on YouTube in the United States in 2009 and/or used in commerce on veoh.com (date unspecified). Even if that were true, the Opposer listed

January 1, 2001 as the date of first use on the application Serial No. 85472690. The Opposer made this material, false representation with the intent to deceive the USPTO

Note that the Applicant searched youtube.com and did not find any evidence of Opposer's reality TV show ever being posted for view on youtube.com and the videos of the Opposer's reality TV show are not currently available on youtube.com. Additionally, the two videos of the Opposer's reality TV show on veoh.com do not have a time/date stamp to show when the videos were posted. The two videos that the Opposer has on veoh.com do not prove that the Opposer's alleged mark was used in commerce in the United States in connection with the sale of any product or service, before the Opposer filed its trademark application(s).

In summary, the Opposer knowingly submitted false dates of use in commerce on Opposer's trademark applications and knowingly submitted false or misleading specimens with Opposer's trademark applications with the intent to deceive the USPTO. Applicant asserts that the Opposer knowingly made the above referenced material false representations concerning specimens and dates of first use with the intent to deceive the USPTO and that this constitutes fraud. Furthermore, Applicant asserts that the material false representations in Opposer's current trademark applications cannot be cured since the Applicant has challenged these representations in this opposition. (See Opposition Nos. 91168142 & 91170668, Hurley International LLC v. Volta, 82 USPQ2d 1339 (TTAB 2007), Universal Overall Co. v. Stonecutter Mills Corp., 154 USPQ 104 (CCPA 1967).

Applicant also asserts that the Opposer must file new trademark applications to cure the false representations. (see Opposition Nos. 91168142 & 91170668, Hurley International LLC v. Volta, 82 USPQ2d 1339 (TTAB 2007), Universal Overall Co. v. Stonecutter Mills Corp., 154 USPQ 104 (CCPA 1967).

Thirteenth Affirmative Defense
(Lack of Rejection of Applicant's Mark by Trademark Examiner)

The United States Patent and Trademark Office (USPTO) did not cite any registration or pending application against Applicant's application for "Beautiful People Magazine." The trademark examiner found no conflicting pending trademark applications and found no conflicting trademark registrations. The trademark examiner would have refused registration, or at a minimum, issued at least an initial rejection, based on any existing registrations or pending applications, if there was any reason to believe that consumers would be confused as to the source of the respective goods/services offered by the Applicant.

Fourteenth Affirmative Defense
(Unclean Hands)

Opposer's claims are barred by the doctrine of unclean hands. Applicant is and/or will be a small business owner. Small businesses are having trouble staying afloat in

today's turbulent economic times. Opposer is attempting to devastate a small business by opposing Applicant's mark without doing research to determine if the marks truly will be competitive in the same market. In this case, Opposer has no legitimate justification for opposing Applicant's mark. This is clearly a case of attempted "trademark bullying" by a large, powerful international company with lots of money.

Additionally, the Opposer knowingly made material, false representations concerning specimens and dates of first use in commerce in the United States on the Opposer's trademark applications with intent to deceive the USPTO and this constitutes unclean hands. Since these material false representations have been challenged by the Applicant in this opposition proceeding, Applicant asserts that the material false representations in Opposer's current trademark applications cannot be cured and that the Opposer must file new trademark applications to cure the materially false representations. (See Opposition Nos. 91168142 & 91170668, Hurley International LLC v. Volta, 82 USPQ2d 1339 (TTAB 2007), Universal Overall Co. v. Stonecutter Mills Corp., 154 USPQ 104 (CCPA 1967).

Applicant asserts that Opposer knowingly submitted specimens to the USPTO that do not show use in commerce in the United States for calendars and for a reality TV show with the intent to deceive the US Patent and Trademark Office.

First, Opposer's application Serial No. 85236075 for Beautiful People is filed in Class 16 with a goods and services description including calendars. Opposer knowingly submitted specimens that do not prove use in commerce in the United States for calendars. Upon independent internet research, Applicant found no other evidence that proves use in commerce in the United States of Opposer's alleged mark for calendars. Opposer submitted these specimens with the intent to deceive the US Patent and Trademark Office.

The Opposer also knowingly submitted specimens that do not prove use in commerce in the United States for a reality TV show for applications Serial No. 85264026 and Serial No. 85472690. More specifically, the specimens that Opposer submitted to the USPTO for the trademark applications referenced in the previous sentence were taken from the Opposer's reality TV show that aired in Canada and from a Canadian website at slice.ca. These specimens show use in commerce in Canada, but not in the United States. With services, "interstate commerce in the United States" generally involves offering a service to customers in another state in the United States or rendering a service that affects interstate commerce in the United States. Clearly, the specimens that the Opposer submitted for applications Serial No. 85264026 and Serial No. 85472690 do not prove or show use in commerce in the United States. Applicant also conducted a thorough internet search and found no evidence that Opposer has ever used the alleged marks in commerce in the United States for a reality TV show. The Opposer submitted these false, material specimens with the intent to deceive the USPTO and this constitutes unclean hands.

Applicant asserts that the material false specimens submitted by the Opposer in Opposer's current trademark applications cannot be cured since the Applicant has challenged these specimens. (See Opposition Nos. 91168142 & 91170668, Hurley International LLC v. Volta, 82 USPQ2d 1339 (TTAB 2007), Universal Overall Co. v. Stonecutter Mills Corp., 154 USPQ 104 (CCPA 1967).

Furthermore, Applicant asserts that the Opposer must file new trademark applications to cure the materially false representations. (See Opposition Nos. 91168142 & 91170668, Hurley International LLC v. Volta, 82 USPQ2d 1339 (TTAB 2007), Universal Overall Co. v. Stonecutter Mills Corp., 154 USPQ 104 (CCPA 1967).

Additionally, Applicant asserts that Opposer knowingly and fraudulently submitted false dates of use on Opposer's trademark Applications for Serial No. 85236075, Serial No 85264026, and Serial No 85472690 with the intent to deceive the US Patent and Trademark Office and this constitutes unclean hands. Applicant asserts that the material false representations (i.e. false dates of use) in Opposer's trademark applications cannot be cured since the Applicant challenged these alleged dates of use and Applicant asserts that the Opposer must file new trademark applications to cure the materially false representations. (See Opposition Nos. 91168142 & 91170668, Hurley International LLC v. Volta, 82 USPQ2d 1339 (TTAB 2007), Universal Overall Co. v. Stonecutter Mills Corp., 154 USPQ 104 (CCPA 1967).

Opposer listed January 1, 2001 as the date of first use in commerce in the United States for calendars in class 016 on Application Serial No. 85236075. In Opposer's answers to Applicant's First Set of Interrogatories, Opposer stated that Beautiful People launched a United States specific site in July 2005. Opposer also stated that the calendars were available in the US via the Opposer's website at beautifulpeople.com or beautifulpeople.net.

As stated earlier, the specimens that the Opposer submitted to the USPTO do not prove that Opposer has used the alleged mark in commerce in the United States for calendars. Even if one assumes (for the sake of argument) that the Opposer has used the alleged mark in commerce in the United States for calendars, the date of first use in commerce in the United States for calendars listed on Application Serial No. 85236075 is not correct. The earliest date that the Opposer could have used the alleged mark in commerce in the United States for calendars was after Beautiful People launched a United States specific site in July 2005. The Opposer intentionally did not list the date of first use in commerce in the United States for calendars as a date in 2005 on Application Serial No. 85236075. Instead, the Opposer listed January 1, 2001 as the date of first use in commerce in the United States for calendars on this trademark application. The Opposer made this material, false representation with the intent to deceive the USPTO and this constitutes unclean hands.

Similarly, the Opposer listed January 1, 2001 as the date of first use in commerce in the United States for dating services in class 045 for Application Serial No. 85236075. In Opposer's answers to Applicant's First Set of Interrogatories, the Opposer stated that

the Opposer launched a United States specific site for dating services in July 2005. The earliest date that a United States specific site for Beautifulpeople.com and Beautifulpeople.net was actually used in commerce in the United States for dating services was in July 2005. Thus, the earliest date of first use in commerce in the United States for Opposer's alleged mark for dating services was in July of 2005. The Opposer intentionally did not list the date of first use in commerce in the United States for dating services as a date in 2005 on Opposer's Application Serial No. 85236075. Instead, the Opposer listed January 1, 2001 as the date of first use in commerce in the United States for dating services. The Opposer made this material, false representation with the intent to deceive the USPTO and this constitutes unclean hands.

The Opposer listed September 1, 2008 as the date of first use in commerce in the United States for Entertainment, namely, a continuing reality television show broadcast over television, cable television, audio, video, digital media and the Internet in class 41 on the supplemental register for Application Serial No. 85264026. In Opposer's answers to Applicant's First set of Interrogatories, Opposer stated that the Opposer used the Beautiful People marks, Beautifulpeople.com, and/or Beautifulpeople.net in commerce in Canada for a reality based television program on or before September 1, 2008. With services, "interstate commerce" generally involves offering a service to customers in another state in the United States or rendering a service that affects interstate commerce in the United States. Applicant asserts that Opposer never offered goods or services to customers in the United States for a reality TV show under the alleged mark for trademark application Serial No. 85264026. Applicant also conducted a thorough internet search and found no evidence that Opposer has used the alleged marks in commerce in the United States for a reality TV show. The Opposer made material, false representations concerning date of first use in commerce in the US with the intent to deceive the USPTO and this constitutes unclean hands.

Even if one assumes (for the sake of argument) that the Opposer has used the alleged mark in commerce in the United States for a reality TV show, the date of first use in commerce in the United States listed on Application Serial No. 85264026 is not correct. The Opposer stated (in the answers to interrogatories) that the reality TV show was used in commerce on YouTube in the United States in 2009 and/or used in commerce on veoh.com (date unspecified). Even if that were true, the Opposer listed September 1, 2008 as the date of first use on the application Serial No. 85264026. The Opposer made this material, false representation with the intent to deceive the USPTO and this constitutes unclean hands.

Note that the Applicant searched youtube.com and did not find any evidence of Opposer's reality TV show ever being posted for view on youtube.com and the videos of the Opposer's reality TV show are not currently available on youtube.com. Additionally, the two videos of the Opposer's reality TV show on veoh.com do not have a time/date stamp to show when the videos were posted. The two videos that the Opposer has on veoh.com do not prove that the Opposer's alleged mark was used in commerce in the United States in connection with the sale of any product or service, before the Opposer filed its trademark application(s).

As for trademark application Serial Number 85472690, Opposer listed January 1, 2001 as the date of first use in commerce in the United States for Entertainment services in the nature of an on-going reality based television program in class 041 on that application. In Opposer's answers to Applicant's First set of Interrogatories, Opposer stated that Opposer used the Beautifulpeople.com, Beautifulpeople.net, and/or the Beautiful People marks in commerce in Canada for a reality based television program on or before September 1, 2008. With services, "interstate commerce" generally involves offering a service to customers in another state in the United States or rendering a service that affects interstate commerce in the United States. Applicant asserts that Opposer never offered goods or services to customers in the United States for a reality TV show under the alleged mark for trademark application Serial No. 85472690. Applicant also conducted a thorough internet search and found no evidence that Opposer has used the alleged marks in commerce in the United States for a reality TV show. The Opposer made material, false representations concerning date of first use in commerce in the US with the intent to deceive the USPTO and this constitutes unclean hands.

Even if one assumes (for the sake of argument) that the Opposer has used the alleged mark in commerce in the United States for a reality TV show, the date of first use in commerce in the United States listed on Application Serial No. 85472690 is not correct. The Opposer stated (in the answers to interrogatories) that the reality TV show was used in commerce on YouTube in the United States in 2009 and/or used in commerce on veoh.com (date unspecified). Even if that were true, the Opposer listed January 1, 2001 as the date of first use on the application Serial No. 85472690. The Opposer made this material, false representation with the intent to deceive the USPTO and this constitutes unclean hands.

Note that the Applicant searched youtube.com and did not find any evidence of Opposer's reality TV show ever being posted for view on youtube.com and the videos of the Opposer's reality TV show are not currently available on youtube.com. Additionally, the two videos of the Opposer's reality TV show on veoh.com do not have a time/date stamp to show when the videos were posted. The two videos that the Opposer has on veoh.com do not prove that the Opposer's alleged mark was used in commerce in the United States in connection with the sale of any product or service, before the Opposer filed its trademark application(s).

In summary, the Opposer knowingly submitted false dates of use in commerce on Opposer's trademark applications and knowingly submitted false or misleading specimens with Opposer's trademark applications with the intent to deceive the USPTO and this constitutes unclean hands.

Applicant asserts that the Opposer knowingly made the above referenced material false representations concerning specimens and dates of first use with the intent to deceive the USPTO and that this constitutes unclean hands. Furthermore, Applicant asserts that the material false representations in Opposer's current trademark applications cannot be cured since the Applicant has challenged these representations in this

opposition. (See Opposition Nos. 91168142 & 91170668, Hurley International LLC v. Volta, 82 USPQ2d 1339 (TTAB 2007), Universal Overall Co. v. Stonecutter Mills Corp., 154 USPQ 104 (CCPA 1967).

Applicant also asserts that the Opposer must file new trademark applications to cure the false representations. (See Opposition Nos. 91168142 & 91170668, Hurley International LLC v. Volta, 82 USPQ2d 1339 (TTAB 2007), Universal Overall Co. v. Stonecutter Mills Corp., 154 USPQ 104 (CCPA 1967).

Fifteenth Defense
(Lack of False Suggestion of a Connection)

There is no “false suggestion of a connection” by the Applicant in this matter, as Applicant will demonstrate below.

Section 2(a) prohibits the registration of a mark that consists of or comprises matter that may falsely suggest a connection with persons, institutions, beliefs or national symbols. To establish that a proposed mark falsely suggests a connection with a person or an institution, it must be shown that: (1) the mark is the same as, or a close approximation of, the name or identity previously used by another person or institution; (2) the mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution; (3) the person or institution named by the mark is not connected with the activities performed by the applicant under the mark; and (4) the fame or reputation of the person or institution is such that, when the mark is used with the applicant's goods or services, a connection with the person or institution would be presumed.

First, Opposer did not state the elements of a “false suggestion” claim and thus, has not properly pled a case for “false suggestion of a connection” under Section 2a.

Next, the Applicant’s mark and the Opposer’s alleged marks are not the same. Applicant’s mark has a different appearance, sound, and commercial impression than the Opposer’s marks because Applicant’s mark has the term “magazine” as the final word in the mark. The extra word provides three extra syllables and lets consumers know that the Applicant intends to put out an online and/or hard copy magazine. Applicant’s mark also does not have .com at the end.

The words “beautiful people” in the Applicant’s mark have a primary meaning that is equivalent to “inner beauty.” The connotation or secondary meaning of the words “beautiful people” in Applicant’s mark is equivalent to “philanthropy.” Additional secondary meanings for the words “beautiful people” in the Applicant’s mark include providing assistance to mankind, performing good deeds, or transforming the world in a positive way.”

Next, the Opposer doesn’t have substantially exclusive use of the words “beautiful people” in the United States. Opposer does not have the exclusive right to the beautiful people mark in the United States as illustrated by several active registrations

and/or applications for marks that include the term “beautiful people” with such marks having owners different than the Opposer. More specifically, there are active registrations and applications containing the words Beautiful People in classes 018, 025, 041, and 045.

The registrations and/or applications with their associated dates of first use in commerce in the United States are listed below.

Registration No. 3960506 for Beautiful People in Class 025 owned 37.37, Inc. (Date of first use in commerce in the United States - June 1998)

Registration 2941226 for Where Beautiful People Come to Get Ugly in class 025 and 043 owned by Sports Entertainment, Inc. (Date of first use in commerce in the United States - 1991)

Registration 3274447 for Beautiful Bags for Beautiful People in Class 018 owned by Charlotte Parker. (Date of first use in commerce in the United States - May 01, 2005)

Application No. 85281311 for Date Beautiful People in Class 045 (on the Supplemental Register) owned by Infostream Group, Inc. (Date of first use in commerce in the United States - December 4, 2011)

Registration 3850544 for Beautiful People in Action in Class 041 owned by Applicant. (Date of first use in commerce in the United States - August 31, 2009).

The probative value of third party trademarks depends entirely on their usage. (See *Scarves by Vera, Inc. vs Todo Imports, Ltd*, 544 F.2d 1167, 1173 (2nd Cir. 1976)). Applicant has also found evidence that one or more of the above trademark registrants and/or trademark applicants are currently using their marks. Thus, the Opposer does not have “substantially exclusive” use of the terms “beautiful people.”

Opposer filed trademark applications in Class 41 dealing with entertainment or entertainment services and in Class 45 for dating services. Similarly, at least two of the above listed trademark applications or registrations have goods and services similar to those that are offered by the Opposer in Class 41 and Class 45.

Applicant’s mark Beautiful People in Action (Registration No. 3850544) in class 41 has a goods and services description consisting of entertainment services. Similarly, Infostream Group, Inc’s Application No. 85281311 for Date Beautiful People in Class 45 on the Supplemental Register has a goods and services description of “internet based dating, social introduction, and social networking services.”

Additionally, there are many other businesses that are currently using the “beautiful people” name without a registered federal trademark. Examples include Beautiful People, LLC in Arizona, Beautiful People, LLC in Florida, Beautiful People LLC in Nevada, Beautiful People BP LLC in Illinois, Beautiful People Salon, LLC in

South Carolina, and Beautiful People Salon & Day Spa in Connecticut.

There are many websites that contain the terms “Beautiful People” such as <http://wearebeautifulpeople.com> or <http://beautifulpeopleliveart.com>.

There was a TV series named Beautiful People that ran on ABC network in the United States in the past and a documentary named Beautiful People, which is described at <http://www.beautifulpeopledocfilm.com>

Furthermore, The Opposer’s alleged marks are not famous. Opposer also failed to plead and provide specific facts to support any claim that the Opposer’s marks are famous. Opposer did not plead and/or provide facts to prove that the Opposer’s marks are famous to customers or to potential customers in the relevant market. Opposer also failed to plead and/or provide specific facts to prove that the Opposer’s marks have widespread renown and recognition by general public.

Opposer also failed to plead specific facts and/or provide detailed evidence to establish fame of the Opposer’s marks, such as detailed advertising figures, detailed sales figures, market share analyses, brand recognition surveys, and details regarding length of use. In response to Applicant’s discovery requests, the Opposer produced very little evidence to support any claims that Opposer’s alleged marks are famous.

Additionally, Opposer failed to plead specific facts to prove that the Opposer’s marks have been adjudicated as famous by a court of competent jurisdiction in the United States. Opposer, in fact, admitted (in answers to discovery) that Opposer’s alleged marks have not been adjudicated as famous.

Based on the analysis presented above, it is clear that there is no “false suggestion of a connection” in this Opposition.

Sixteenth Affirmative Defense

(No Use of Opposer’s Alleged Marks as Enforceable Common Law Trademarks)

As stated earlier, Opposer’s alleged marks are not inherently distinctive and do not have acquired distinctiveness. In fact, Opposer’s alleged marks are merely descriptive of the goods and services offered by the Opposer. Opposer’s alleged marks lack secondary meaning, as discussed earlier.

Since Opposer’s alleged marks are merely descriptive without secondary meaning, this means that the Opposer has never used Opposer’s alleged marks as enforceable common law marks.

Seventeenth Affirmative Defense
(Abandonment of Alleged Common Law Trademarks)

As stated earlier, the Opposer's alleged marks are merely descriptive without secondary meaning. In the alternative, if Opposer's alleged marks were considered to be common law trademarks – then the Opposer has failed to protect, police, and /or control its trademarks from widespread infringement, thereby resulting in an abandonment of its alleged common law rights in its alleged unregistered common law marks

Eighteenth Affirmative Defense
(Good Faith)

Applicant acted in good faith in selecting Applicant's mark that was applied for in Application Serial No. 85-196,831. As noted in Applicant's answers to Opposer's discovery, Applicant's President selected Applicant's mark by himself. Applicant's President did not select the Beautiful People Magazine mark to trick consumers in order to "cash in" on the Opposer's business or good will. In fact, Applicant's President did not know about the Opposer's company or Opposer's alleged marks until the Opposer filed the Notice of Opposition for Opposition No. 91203898.

Applicant also asserts that at all times alleged in the Notice of Opposition and during the Opposition proceeding, Applicant has acted in good faith towards Opposer and Applicant will continue to act in good faith toward the Opposer and Opposer's attorneys.

Nineteenth Affirmative Defense
(Lack of Causation of Harm to Any Alleged Famous Mark)

The Opposer's alleged marks, as stated earlier, are not famous. In the alternative, Applicant alleges that Opposer cannot establish that Applicant's use of Applicant's mark (now or in the future) will create a likelihood of impairment to the distinctiveness of any alleged famous mark owned by the Opposer. Additionally, Opposer cannot establish the requisite causation necessary to establish harm to any alleged famous mark under the Lanham Act or other applicable state and federal laws.

Twentieth Affirmative Defense
(Weak Mark)

Applicant alleges that Opposer's alleged marks are not inherently distinctive and do not have acquired distinctiveness. Opposer's marks are merely descriptive of the goods and services offered by the Opposer (as ruled by a trademark examiner at the USPTO). Opposer's marks do not have secondary meaning. As a consequence, Opposer's alleged marks are weak and cannot be enforced. Opposer's weak marks are not suitable for registration on the Principal Register and should have been filed on the Supplemental Register, the register reserved for descriptive marks.

Twenty First Affirmative Defense
(Analogous Use and Tacking)

Applicant used and promoted a legally equivalent mark, which was “Beautiful People Magazine” beginning on October 18, 2006. Although the goods and services were different than those in Applicant’s current application Serial No. 85,196,831 and the use in 2006 was deemed not to qualify as a official trademark use, such use by the Applicant of a legally equivalent mark in October of 2006 can be deemed as “analogous use” and used to establish priority via “tacking.”

In order to tack on prior use of one mark on to another, the marks must be legal equivalents. See *Van Dyne- Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866, 1869 (Fed. Cir. 1991). To meet the legal equivalents test, the marks must be indistinguishable from one another or create the same, continuing commercial impression such that the consumer would consider both as the same mark. *Van Dyne-Crotty, supra*. Intent to use applications can utilize analogous use and tacking. See *Dyneer Corp. v. Automotive Products PLC*, 37 USPQ2d 1251 (TTAB 1995) and *In Fair Indigo LLC v. Style Conscience* (T.T.A.B., November 21, 2007)

In this case, such analogous use of the mark “Beautiful People Magazine” by the Applicant in 2006 can be tacked onto the Applicant’s constructive use date, which is the filing date of Applicant’s current Intent to Use Application Serial No. 85,196,831.

Twenty Second Affirmative Defense
(Reservation)

Applicant reserves the right to assert any and all other affirmative defenses which it becomes aware of throughout discovery, testimony, and/or otherwise during the pendency of this matter. Such other affirmative defenses include, but are not limited to, collateral estoppel, *res judicata*, abandonment, mistake, and other defenses which Applicant may become aware of throughout the pendency of this matter.

Applicant also reserves the right to re-assert defenses of acquiescence and estoppel, if facts subsequently arise to support those defenses.

WHEREFORE, having fully answered, Applicant Beautiful People Magazine, Inc., by and through its president Joshua Domond, prays for judgment against the Opposer, and requests that the Trademark Trial and Appeal Board dismiss this Notice of Opposition with prejudice and enter judgment for the Applicant.

Dated: 06/27/2013

Respectfully submitted,
Joshua Domond
Joshua Domond
President
Beautiful People Magazine, Inc
PO Box 1157
Hallandale, Florida 33008
Phone: 305-305-5122

PROOF OF SERVICE BY MAIL

I, Joshua Domond, the undersigned, hereby declare as follows:

1. I am over 18 years and I am the President of the Applicant/Defendant in Opposition No. 91203898.
2. My address is PO Box 1157, Hallandale, Florida 33008.
3. On 06/27, 2013 at PO Box 1157, Hallandale, Florida 33008, I served a true copy of the attached document, entitled "Applicant's Fourth Amended Answer To Notice Of Opposition" by placing the documents in an addressed, sealed envelope clearly labeled to identify the person being served at the address shown below and placed this in the mail for deposit in the United States Postal Service on that date in accordance with ordinary business practices:

David K. Caplan
Kilpatrick Townsend & Stockton LLP
Attorneys for PeopleNetwork Aps AKA Beautiful People.com
9720 Wilshire Blvd, Penthouse Suite
Beverly Hills, CA 90212

4. An electronic copy was also emailed to Opposer's email at dcaplan@kmwlaw.com.
5. I declare that the foregoing is true and correct. Executed 06/27, 2013 at Hallandale, Florida.



Joshua Domond
President of Beautiful People Magazine, Inc.
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Hallandale, Florida 33008
Phone: 305-305-5122