

This Opinion is not a
Precedent of the TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

CME

Mailed: July 29, 2014

Opposition No. 91206915

MyBody, L.L.C.¹

v.

Eric Lucas

**Before Bucher, Wolfson and Hightower,
Administrative Trademark Judges.**

By the Board:

This case now comes up for consideration of Opposer's fully-briefed motion for summary judgment, filed February 20, 2014.

By way of background, Applicant seeks registration of the mark MY HERO, in standard characters, for "Cosmetic preparations" in International Class 3.² In the notice of opposition, Opposer alleges prior common law use of the mark  for anti-aging skin cream³ and that Applicant's use

¹ Opposer spells its name a number of different ways in its filings, e.g. MyBody, L.L.C, mybody, L.L.C. and myBody L.L.C.

² Application Serial No. 85383910, filed on April 13, 2012, based on Applicant's allegation of a *bona fide* intention to use the mark in commerce pursuant to Trademark Act Section 1(b), 15 U.S.C. § 1051(b).

³ In the ESTTA cover sheet to the notice of opposition, Opposer also lists its application Serial No. 85695722 for the mark MYHERO, in standard characters, for "Skin creams" in International Class 3, filed August 6, 2012, based on an allegation of use since January 28, 2011.

of the mark MY HERO for cosmetic preparations is likely to cause confusion. Opposer also alleges that Applicant lacked a *bona fide* intent to use the involved mark as of the filing date of the involved application. In his answer, Applicant denies the salient allegations in the notice of opposition and asserts various affirmative defenses. Opposer has moved for summary judgment only on the ground of priority and likelihood of confusion.

The Parties' Arguments

In support of its motion for summary judgment, Opposer argues that it has “indisputable prior rights” based on its first use in commerce of the mark MYHERO⁴ on January 28, 2011, which predates both the filing date of Applicant’s involved application and Applicant’s date of first use. Motion, p. 4. In support of this assertion, Opposer submits: (1) the declaration of one of its founders, David Watson, attesting that “Opposer has continuously and extensively used its MYHERO Mark throughout the United States since at least as early as January 28, 2011, and during that time has sold its jars of skin cream bearing Opposer’s MYHERO Mark through its website and through its resellers since that date” and that “Opposer has expended considerable time and resources to advertise and promote skin cream products offered under its MYHERO Mark since first using the MYHERO Mark on January 28, 2011”; Watson Declaration, ¶¶ 3-4; (2) a copy of its pleaded application, including two specimens demonstrating use of the

⁴ Opposer displays its mark in the color pink in a stylized format as myHERO. See Watson Declaration, Attachment A.

standalone mark MYHERO on packaging for Opposer's anti-aging serum, *see id.* at Attachment A; (3) Opposer's verified responses to Applicant's interrogatories⁵ identifying January 28, 2011, as the date of first use of Opposer's mark MYHERO, *see* Motion, Exhibit B, Opposer's Verified Response to Applicant's Interrogatory No. 7, and (4) Applicant's verified responses to Opposer's interrogatories identifying March 15, 2013, as the first use of Applicant's mark "in commerce" and "interstate commerce."⁶ Motion at Exhibit F, Applicant's Verified Responses to Opposer's Interrogatory Nos. 27-28.

With respect to likelihood of confusion, Opposer argues that "the marks are identical and are to be used in connection with very similar products." Motion at p. 5. In support of this position, Opposer cites Applicant's interrogatory responses indicating that Applicant uses its mark in connection with lotions, which Opposer asserts are "closely related to the skin creams developed and sold by Opposer under Opposer's Mark." *Id.* and Exhibit E, Applicant's Response to Opposer's Interrogatory No. 5. Opposer further argues that the parties' trade channels "will inevitably appeal to an overlapping segment of consumers" and even if the relevant consumers are

⁵ Opposer's interrogatory responses are verified by Therese Clark, a co-founder and Vice President of Creative Development of Opposer.

⁶ In connection with its reply brief, Opposer also filed a document titled "myHero Sales summary (1/1/2011 thru 2/18/2013) and bearing the headings "State," "Qty Sold" and "Revenue Dollars." Opposer, however, redacted all of the information in the document and failed to submit an unredacted version to the Board under seal, rendering the document devoid of any evidentiary value.

sophisticated, such consumers are not “immune from source confusion.”⁷
Motion at p. 7.

Applicant opposes the motion, asserting that there are genuine disputes of material fact regarding Opposer’s priority in the mark MYHERO. Specifically, Applicant argues that (1) Opposer has not established use analogous to trademark use because it has “failed to supply any *evidence* of prior use sufficient to create an association in the minds of the purchasing public between the mark and Opposer’s goods,” Response, p. 8 (emphasis in original); (2) Opposer has not established secondary meaning in its pleaded mark, *see id.* at pp. 9-10; (3) “any commercial impression ... arises from Opposer’s use of the combined pink heart/mybody design and mark ... with the myHERO logo on [Opposer’s] packaging and advertising,” *id.* at p. 10; (4) Opposer has failed to prove “nationwide priority of use,” *id.*; and (5) because Opposer’s mark is unregistered, “common law principles regarding geographic concurrent use govern determination of the scope of priority.” *Id.* at p. 11.

Turning to likelihood of confusion, Applicant argues that the marks are distinguishable because Opposer displays its mark as myHERO in the color pink whereas Applicant’s mark is MY HERO in standard characters. *Id.* at p.

⁷ Opposer has submitted its verified responses to Applicant’s interrogatories wherein Opposer identifies the trade channels for its product as “medical offices, health spas, beauty spas, Internet, department stores, specialty stores, online retailers, consumer sales, and via its website.” Motion at Exhibit B, Opposer’s Verified Response to Applicant’s Interrogatory No. 4. The evidence also demonstrates that Applicant intends to offer its products for sale on the Internet at www.myherolotion.com. See Motion at Exhibit E, Applicant’s Response to Opposer’s Interrogatory No. 8.

14. Applicant also contends that the marks create different commercial impressions as “Applicant’s mark conveys the impression that its lotion will promote the general purposes of lotion in heroic fashion [which is] in stark and differing contrast ... [to Opposer’s mark] conjur[ing] up images of a savior rescuing the consumer’s face from the harsh reality of aging.” *Id.* at p. 15.

With respect to the similarities between the parties’ goods, Applicant asserts that Opposer does not market its product as a skin cream, but as an anti-aging serum, and that this product is different from Applicant’s cosmetic preparations because Applicant’s products do not “reverse’ or counter the signs or effects of aging.” *Id.* at p. 16. Applicant further contends that there is a genuine dispute of material fact regarding whether Opposer’s product is a drug under the Federal Food Drug and Cosmetic Act (“FD&C Act”), which it argues would necessitate that the goods in Opposer’s pleaded application be re-classified in International Class 5. *See id.* at pp. 18-19. In addition, Applicant argues that the parties’ target consumers are different because Opposer’s products are “marketed predominantly to women” whereas Applicant’s products “are directed to children as well as adults ... looking to moisten [their] bod[ies] after a swim.” *Id.* at p. 16.

Lastly, Applicant submits printouts from two websites demonstrating that Opposer sells its product for \$213.75,⁸ and based on this evidence argues that

⁸ There is no evidence in the record with respect to the price point of Applicant’s product.

consumers of Opposer's product are sophisticated and unlikely to be confused by the parties' respective marks.⁹ *See id.* at Exhibit 4 (lovelyskin.com) and Exhibit 6.

Summary Judgment Standard

Summary judgment is only appropriate where there are no genuine disputes as to any material facts, thus allowing the case to be resolved as a matter of law. Fed. R. Civ. P. 56(a). The party seeking summary judgment bears the burden of demonstrating the absence of any genuine dispute of material fact, and that it is entitled to a judgment under the applicable law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Sweats Fashions, Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1796 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *See Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). Evidence on summary judgment must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir.

⁹ Exhibit 4 includes additional web pages, but these pages are not self-authenticating because they do not include the entire URL of the websites and the pages are not otherwise authenticated by the declaration of Damon Ward, which incorrectly identifies Exhibit 4 as "a true and correct copy [of] the Notice of Taking [the] Deposition of myBody, LLC" when in fact the exhibit consists of web pages displaying Opposer's goods for sale. Accordingly, we have not considered these additional web pages.

1993); *Opryland USA*, 23 USPQ2d at 1472. The Board may not resolve genuine disputes as to material facts; it may only ascertain whether genuine disputes as to material facts exist. *See Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1542.

Standing

The Watson declaration and specimens of use attached to Opposer's pleaded application establish Opposer's prior common law rights in the MYHERO mark for anti-aging skin creams, and that Opposer has a reasonable belief that it would be damaged by the registration of Applicant's mark. Accordingly, there are no genuine disputes of any material fact regarding Opposer's standing. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Priority

For Opposer to prevail on its claim of likelihood of confusion based on common law rights in the MYHERO mark, "the mark must be distinctive, inherently or otherwise, and [Opposer] must show priority of use." *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1634 (TTAB 2007) (citing *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981)). Applicant assumes in its opposition brief that Opposer's mark is not inherently distinctive, but Applicant has not submitted any evidence that Opposer's MYHERO mark is merely descriptive of or generic for anti-aging

skin creams. Accordingly, we find that there are no genuine disputes of material fact regarding the distinctiveness of the mark MYHERO.

With respect to priority, the evidence demonstrates that Applicant did not commence use of its involved mark until after it filed the involved application. *See* Motion, Exhibit F, Applicant's Verified Response to Interrogatory Nos. 27 and 28 (identifying March 15, 2013 as the date of first use "in commerce" and "interstate commerce"). Accordingly, the earliest date upon which Applicant may rely for priority is the filing date of its involved application, which is April 13, 2012. *See Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1022-23 (TTAB 2009).

We need not consider whether Opposer has demonstrated use of the mark MYHERO analogous to trademark use because the evidence of record establishes Opposer's prior and continuous use of the mark MYHERO for skin cream since January 28, 2011. The Watson declaration setting forth Opposer's date of first use is clear and convincing and uncontradicted by Applicant. *See, e.g. National Bank Book Co. v. Leather Crafted Products, Inc.*, 218 USPQ 826, 828 (TTAB 1993) (acknowledging that oral testimony may be sufficient to prove the first use of a party's mark when it is based on personal knowledge, it is clear and convincing, and it has not been contradicted); *GAF Corp. v. Amatol Analytical Serves., Inc.*, 192 USPQ 576, 577 (TTAB 1976) ("It is established that ownership of a trademark and of a trademark registration *as well as use of a mark* may be established by the oral testimony of a single

witness where such testimony is clear, consistent, convincing, circumstantial and uncontradicted”) (emphasis added). Moreover, the Watson declaration is corroborated by Opposer’s verified responses to Applicant’s interrogatories identifying January 28, 2011 as the date that Opposer’s mark was first used in commerce. *See* Motion, Exhibit B, Opposer’s Verified Response to Interrogatory No. 7.

Applicant’s assertion that Opposer cannot establish priority because it has not demonstrated nationwide use is without merit as nationwide use is not necessary to confer priority in an *inter partes* proceeding. *See L. & J.G. Stickley Inc. v. Cosser*, 81 USPQ2d 1956, 1965 (TTAB 2007) (recognizing that a plaintiff may establish priority based on intrastate commerce). Even if it were, however, the Watson declaration establishes Opposer’s use of the MYHERO mark throughout the United States. *See* Watson Declaration, ¶ 3. Similarly, no consideration will be given to Applicant’s arguments regarding “geographic concurrent use” as the Board considers geographic limitations only in the context of a concurrent use registration proceeding, which is not at issue here. *See* Trademark Rule 2.133(c).

In view of the foregoing, Opposer has carried its burden on summary judgment of establishing that there are no genuine disputes of material fact regarding its prior rights in the mark MYHERO.

Likelihood of Confusion

In analyzing the issue of likelihood of confusion, we consider all of the facts in evidence relevant to the factors enumerated in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See Giersch*, 90 USPQ2d at 1025. Here, the relevant factors for consideration are the similarities between the parties' marks and goods, the relevant trade channels and the sophistication of the purchasers. We address each factor in turn below.

1. The Similarities Between the Marks

The parties' marks are phonetically identical and "because Applicant applied to register its mark in standard character format, its display is not limited to any particular font style, size, or color, and we therefore must consider that [A]pplicant's mark might be used in any stylized display or color scheme, including one that is similar or identical to [the] lettering style used by [O]pposer." *Weirder Pub's, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1355 (TTAB 2014) (citing Trademark Rule 2.52(a)); *see also Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011). Accordingly, the only difference between the marks to consider is the space in Applicant's mark between the words "MY" and "HERO," which is insignificant both with respect to the appearance and commercial impression of the marks. *See Giersch*, 90 USPQ2d at 1025 ("[T]he spaces that respondent places between the words [in its mark] do not create a

distinct commercial impression from petitioner's presentation of his mark as one word); *Stock Pot, Inc. v. Stockpot Restaurant, Inc.*, 220 USPQ 52, 54 (TTAB 1983), *aff'd* 737 F.2d 1576, 22 USPQ 665 (Fed. Cir. 1984) (“There is no question that the marks of the parties [STOCKPOT AND STOCK POT] are confusingly similar. The word marks are phonetically identical and visually almost identical.”). Thus, there is no genuine dispute of material fact that the marks are similar in appearance, pronunciation, meaning and commercial impression.

2. The Similarities Between the Parties’ Goods

Turning to the similarities between the parties’ goods, we compare Opposer’s anti-aging skin cream with the goods identified in the involved application, namely, “Cosmetic preparations.” *See Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); (the nature and scope of a party’s goods or services must be determined on the basis of the goods or services recited in the application or registration); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000). We also take judicial notice of the definition of “cosmetic” as “a substance (such as a cream, lotion, or powder) that you put on your face or body to improve your appearance.”¹⁰ Merriam-Webster Online Dictionary,

¹⁰ The Board may take judicial notice of dictionary definitions. *Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1515 n.13 (TTAB 2009); *see also University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

<http://www.merriam-webster.com/dictionary/cosmetic> (last visited June 18, 2014).

Regardless of whether Opposer's anti-aging skin cream may be classified as a drug under the FD&C Act,¹¹ its skin cream is a topical substance applied to the skin promoted to improve a user's appearance. *See* Watson Declaration, Attachment A (including Opposer's product label describing Opposer's product as "restoring the skin's youthful luminosity and resilience ... dramatically reduc[ing] the appearance of fine lines and wrinkles ... [and] creat[ing] an instantaneous tightening and wrinkle reducing effect in around five minutes after application."). As such, Opposer's product is encompassed within the broad definition of a cosmetic preparation whether or not it may also be categorized as a drug. *See Jean Patou, Inc. v. Theon, Inc.*, 9 F.3d 971, 975, 29 USPQ2d 1771, 1774 (Fed. Cir. 1993) (recognizing that a product may "reasonably be categorized as either a cosmetic or pharmaceutical" based on "its various properties and uses"). Accordingly, the parties' products are related. This is true even though the parties' products may have different intended uses. Moreover, the classification of goods in Opposer's pleaded application is not relevant as Opposer is relying on its common law rights and the classification of goods is a purely administrative determination unrelated to determining whether there is a likelihood of confusion. *See id.*; *see also Nat'l Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212,

¹¹ We note that there is no evidence in the record that a prescription is required to purchase Opposer's goods.

1216, n.5 (TTAB 1990). Accordingly, there is no genuine dispute of material fact as to the similarity of the parties' goods.

3. The Similarity of the Parties' Trade Channels

Applicant argues that the parties' trade channels are different because Opposer predominantly markets its anti-aging preparations to women and Applicant's cosmetic preparations are directed to children and adults. But Applicant's own argument demonstrates the overlap in the parties' trade channels as women are a segment of the adult population. Moreover, because Applicant's application does not include a trade channel restriction, we must presume that Applicant's goods are or will be sold in all normal channels of trade to all of the usual customers for cosmetic preparations, which includes Opposer's identified trade channels of health and beauty spas, department stores, specialty stores and online retailers. *See Hewlett-Packard*, 62 USPQ2d at 1005; *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787-88 (Fed. Cir. 1987); *see also* Motion at Exhibit B, Opposer's Verified Response to Interrogatory No. 4(b). As such, there is no genuine dispute of material fact regarding the similarity of the parties' trade channels.

4. The Sophistication of the Relevant Purchasers

The evidence demonstrates that Opposer's anti-aging serum is a costly product priced around \$213.75 suggesting that consumers might exercise care and prudence before making a purchasing decision. This possibility,

however, does not raise a genuine dispute of material fact that would preclude the entry of summary judgment. For purposes of this motion, we will assume, as Applicant urges, that Opposer's consumers are sophisticated, but because of the substantial similarity between the parties' marks even careful and discriminating purchasers would assume that the parties' related goods emanate from a single source.

5. Conclusion with Respect to Likelihood of Confusion

Weighing all of the likelihood of confusion factors together, and after careful consideration of all of the evidence of record and the parties' arguments, we find that there are no genuine disputes of material fact that a likelihood of confusion exists between the parties' marks.

Affirmative Defenses

In response to Opposer's motion, Applicant has not asserted, much less established, any of the affirmative defenses he raised in his answer to the notice of opposition. Accordingly, such defenses are deemed waived.¹² *See Miller v. Miller*, 105 USPQ2d 1615, 1616 n.3 (TTAB 2013); *Baroness Small Estates Inc. v. American Wine Trade Inc.*, 104 USPQ2d 1224, 1225 n.2 (TTAB 2012).

Conclusion

¹² The "affirmative defenses" in paragraphs 14-17 of Applicant's answer are not proper affirmative defenses, but are mere amplifications of Applicant's denials. Moreover, the affirmative defenses in paragraphs 18-19 of Applicant's answer are merely conclusory in nature and are not supported by any facts.

Based on the record herein and the applicable law, we find that there are no genuine disputes as to any material facts supporting Opposer's claim that Applicant's mark MY HERO, when used on "cosmetic preparations," is likely to cause confusion with Opposer's prior use of the mark MYHERO (in a stylized format in the color pink) for an anti-aging serum, and that Opposer has established its standing and ipriority and likelihood of confusion as a matter of law. Moreover, Applicant has waived his affirmative defenses. Accordingly, Opposer's motion for summary judgment is **GRANTED**. Judgment is entered against Applicant and the notice of opposition is sustained.
