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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91209825
Party	Plaintiff Kiss My Face, LLC
Correspondence Address	CARRIE A JOHNSON FRASER CLEMENS MARTIN & MILLER LLC 28366 KENSINGTON LANE PERRYSBURG, OH 43551 UNITED STATES firm@fraser-ip.com, johnson@fraser-ip.com, boes@fraser-ip.com
Submission	Brief on Merits for Plaintiff
Filer's Name	Carrie A. Johnson
Filer's e-mail	firm@fraser-ip.com, johnson@fraser-ip.com, boes@fraser-ip.com
Signature	/caj/
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I. PRELIMINARY STATEMENT

Opposer, Kiss My Face, LLC (“Opposer”) owns the trademark KISS MY FACE, a mark recognized as signifying the source of a line of well-known all natural personal care products distributed in the U.S. widely and continuously since at least as early as 1981.¹ Opposer’s KISS MY FACE products have been at the forefront of the rise in popularity of “green” personal care products, which appeal to consumers seeking all natural products that are earth-friendly.

The KISS MY FACE brand has ascended to the top of the natural products channel and achieved impressive sales success. Indeed, Opposer’s gross sales of KISS MY FACE branded goods in the U.S. during the past five years topped ██████████ dollars, or an average of over ██████████ dollars in U.S. sales per year. (*See* Dkt. 23, Deposition of Jean Fufidio (Fufidio Dep.) at 11:20-13:3 and Ex. 2 to Fufidio Dep.)

There is a strong likelihood of confusion between the parties’ marks as applied to their respective goods, for the following reasons:

- The marks KISS MY FACE and TOUCH MY FACE are confusingly similar in appearance, sound, and overall commercial impression.
- The parties’ goods are identical – all natural facial masks, skin serums, soap – and travel in the same channels to the same class of consumers.
- Consumers of the parties’ all natural personal care products are not sophisticated and would at best exercise ordinary care.
- Opposer’s KISS MY FACE mark is famous as a result of the widespread use

¹ Opposer’s Director of Marketing, Ms. Jean Fufidio, testified that to her knowledge the mark KISS MY FACE has been in use on personal care products since at least 1981. *See* Dkt. 23, Deposition of Jean Fufidio at 6:25-7:8.) Opposer’s earliest federal registrations claim a date of first use of 1978. Opposer’s first use long predates Applicant’s first use of the mark TOUCH MY

of the mark in connection with personal care products for over three decades.

- Opposer has demonstrated a record of aggressive pursuit of unauthorized third-party uses of marks identical and confusingly similar to the mark KISS MY FACE.

In light of these considerations, it is clear that consumers are likely to mistakenly believe that Applicant's all natural TOUCH MY FACE personal products are made, sponsored, or approved by Opposer. The overwhelming balance of the relevant *du Pont* factors leads to the inescapable conclusion that there is a likelihood of confusion between the parties' marks. Thus, Opposer requests that the Board sustain this proceeding and refuse registration of Applicant's mark.

II. PROCEDURAL HISTORY

On June 27, 2012, Applicant filed trademark application Serial No. 85/663,155 for the mark TOUCH MY FACE for use in connection with "Facial masks; Non-medicated serums for use on skin." in Int'l Class 3. In the application, Applicant claimed a date of first use of the mark in commerce of August 8, 2002.

The PTO published application Serial No. 85/663,155 on November 20, 2012. Opposer commenced this proceeding by filing a Notice of Opposition on March 19, 2013. In the Notice of Opposition, Opposer alleged priority of use of the KISS MY FACE mark and a likelihood of confusion between its incontestably federally registered KISS MY FACE trademarks and Applicant's TOUCH MY FACE trademark, pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d).

III. RECORD EVIDENCE

FACE. Consequently, for the purpose of this proceeding, Opposer refers to a first use date of at

A. AUTOMATICALLY OF RECORD

The file of the subject application, Opposer's Notice of Opposition, and Applicant's Answer to Notice of Opposition are of record pursuant to 37 C.F.R. 2.122.

On October 2, 2014, the parties also filed a Stipulation of the Parties (Dkt. 18.), stipulating as to the authenticity and admissibility of the following documents and testimony:

1. Documents produced by either party during discovery in this proceeding;
2. Discovery depositions taken of Applicant's 30(b)(6) witnesses;
3. Opposer and Applicant's responses to interrogatories and requests for admission in this proceeding; and
4. The records from TSDR for the following U.S. Registrations:
 - a. U.S. Registration No. 4450642 KISS MY FACE and Design
 - b. U.S. Registration No. 4450641 KISS MY FACE and Design
 - c. U.S. Registration No. 4268625 KISS MY FACE PEACE and Design
 - d. U.S. Registration No. 4229593 KISS MY FACE
 - e. U.S. Registration No. 4200053 KISS MY FACE SHIMMER
 - f. U.S. Registration No. 3120784 KISS MY FACE WHITENING
 - g. U.S. Registration No. 3590613 KISS MY FACE MOISTURE SOAP
 - h. U.S. Registration No. 2706187 KISS MY FACE
 - i. U.S. Registration No. 2301324 KISS MY FACE
 - j. U.S. Registration No. 1991868 KISS MY FACE
 - k. U.S. Registration No. 1513297 KISS MY FACE

least as early as 1981.

B. OPPOSER'S EVIDENCE

Opposer introduced the following trial testimony:

1. Opposer filed a Notice of Reliance on November 20, 2014 (Opposer's "NOR") (Dkt. 19 and 20), indicating its intent to rely on the following evidence:
 - a. True and correct printouts of the dictionary definitions for the words "kiss" and "touch" from the Merriam-Webster online dictionary (Dkt. 19, Ex. 1).
 - b. True and correct copies of documents produced by Opposer during discovery in this proceeding showing KISS MY FACE facial care products (*Id.*, Ex. 2).
 - c. True and correct copies of documents produced by Opposer during discovery in this proceeding showing a variety of KISS MY FACE products (*Id.*, Ex. 3).
 - d. True and correct copies documents produced during discovery in this proceeding showing Opposer's Facebook page and Opposer's marketing materials (*Id.*, Ex. 4).
 - e. TSDR printouts for Opposer's U.S. Registrations (*Id.*, Ex. 5).
 - f. True and correct copies of excerpts of the transcripts of the 30(b)(6) discovery deposition² of Applicant, via its owner, Mr. Roby Mitchell and Applicant's employee, Ms. Jodi Bytheway (*Id.*, Exs. 6 and 7).
 - g. True and correct copies of Applicant's Response to Interrogatories, Document Requests, and Requests for Admission (*Id.*, Ex. 8).
 - h. True and correct copies of documents produced by Opposer during discovery in this proceeding showing Opposer's enforcement efforts (Dkt. 19 and 20, Opposer's NOR, Ex. 9).

² As indicated above, the parties stipulated that discovery depositions taken during this proceeding are admissible as evidence in the trial of this proceeding.

- i. True and correct copies of the of documents produced by Applicant during discovery in this proceeding showing the price of Applicant's TOUCH MY FACE goods and sales of said products from 2008 to 2013 (Dkt. 20, Opposer's NOR, Ex. 10).
2. The 30(b)(6) testimony deposition of Opposer, via Opposer's Chief Marketing Officer, Ms. Jean Fufidio, dated November 17, 2014, with accompanying Opposer's Exs. 1 through 6 and Applicant's Exs. A through F. (Dkt. 23 and 24).

C. APPLICANT'S EVIDENCE

Applicant filed Defendant's Notice of Reliance on January 19, 2015 ("Applicant's NOR") (Dkt. 25 and 26), indicating that it intends to rely upon the following as evidence in this proceeding:

1. True and correct printouts of the dictionary definitions of the words "kiss" and "touch" from the online dictionary, www.merriam-webster.com (Dkt. 25, Ex. 1).
2. True and correct copies of excerpts of the transcripts of the 30(b)(6) discovery deposition of Applicant, via Applicant's owner, Dr. Roby Mitchell (*Id.*, Ex. 2) and Applicant's employee, Ms. Jodi Bytheway (*Id.*, Ex. 3).
3. True and correct copies of documents produced by Applicant during the discovery period showing Applicant's TOUCH MY FACE products (*Id.*, Ex. 4).
4. True and correct copies of documents produced by Applicant during the discovery period showing Applicant's Facebook page, website and marketing materials (*Id.*, Ex. 5).
5. True and correct copies of the following discovery responses:
 - a. Applicant's Response to Kiss My Face's First Set of Interrogatories, Document Requests, and Requests for Admission (*Id.*, Ex. 6).
 - b. Applicant's Responses to Kiss My Face's Second Set of Interrogatories, Document

- Requests, and Requests for Admission to Applicant (*Id.*, Ex. 7).
- c. Opposer's Responses to Applicant's First Request for Production of Documents and Things (*Id.*, Ex. 8).
 - d. Opposer's Responses to Applicant's First Set of Interrogatories (*Id.*, Ex. 9).
6. TSDR printouts for Opposer's U.S. Registrations (*Id.*, Ex. 10):
- a. U.S. Registration No. 4450642 KISS MY FACE and Design
 - b. U.S. Registration No. 4450641 KISS MY FACE and Design
 - c. U.S. Registration No. 4268625 KISS MY FACE PEACE and Design
 - d. U.S. Registration No. 4229593 KISS MY FACE
 - e. U.S. Registration No. 4200053 KISS MY FACE SHIMMER
 - f. U.S. Registration No. 3120784 KISS MY FACE WHITENING
 - g. U.S. Registration No. 3590613 KISS MY FACE MOISTURE SOAP
 - h. U.S. Registration No. 2706187 KISS MY FACE
 - i. U.S. Registration No. 2301324 KISS MY FACE
 - j. U.S. Registration No. 1991868 KISS MY FACE
 - k. U.S. Registration No. 1513297 KISS MY FACE
 - l. U.S. Registration No. 4636349 ONE KISS IS ALL IT TAKES
 - m. U.S. Registration No. 3005002 FACE FACTOR
7. TSDR printout of the specimen submitted with the trademark application packet for U.S. Registration No. 4636349 ONE KISS IS ALL IT TAKES (*Id.*, Ex. 11).
8. TSDR printouts for third party federal registrations (*Id.*, Ex. 12).
9. Screen shot of list of TESS search results for "KISS and 003[IC]" (*Id.*, Ex. 13).
10. Screen shot of list of TESS search results for "TOUCH and 003[IC]" (*Id.*, Ex. 14).

11. Screen shot of list of TESS results for "FACE and 003[IC] and FACE[DS]" (*Id.*, Ex. 15).
12. True and correct copies of documents produced by Opposer during the discovery period showing KISS MY FACE products (*Id.*, Ex. 16).
13. True and correct copies of documents produced by Opposer during the discovery period showing Opposer's Facebook page and Opposer's marketing materials (Dkt. 26, Ex. 17).
14. Screen shot of Opposer's Facebook page promoting Opposer's "Kiss Across America" contest and describing the contest (*Id.*, Ex. 18).
15. True and correct copies of documents produced by Opposer during the discovery period showing Opposer's enforcement efforts, which have been filed separately by Opposer as CONFIDENTIAL (*Id.*, Ex. 19).

IV. MOTION TO STRIKE TESS SEARCH RESULTS ATTACHED TO APPLICANT'S NOTICE OF RELIANCE FROM EVIDENCE PURSUANT TO TBMP 707.02(c)

As indicated in the preceding section, Applicant has provided TESS search result printouts for various searches conducted by Applicant's counsel as exhibits 13, 14, and 15 to Applicant's Notice of Reliance. (Dkt. 25.)

Although the parties stipulated to the authenticity and admissibility of certain documents in this proceeding, the TESS search results in question were not subject to the Stipulation of the Parties (Dkt. 18).

Filing a printout of TESS search results is not sufficient to make third party registrations listed therein of record in an inter parties proceeding. *See In re JT Tobacconists*, 59 U.S.P.Q. 2d 1080 (T.T.A.B. 2001); and *In re Duofold Inc.*, 184 U.S.P.Q. 638 (T.T.A.B. 1974). The Trademark Trial and Appeal Board Manual of Procedure is clear:

Normally, third-party registrations are offered merely to show that they issued, and a plain copy of the registration is sufficient for that purpose.

On the other hand, a party may not make a third-party registration of record simply by introducing a list of third-party registrations that includes it; or by filing a trademark search report in which the registration is mentioned; or by filing a printout, from a private company's data base, of information about the registration; or by filing a notice of reliance together with a reproduction of the mark as it appeared in the Official Gazette for purposes of publication; or by referring to the registration in its brief or pleading.

TBMP 704.03(b)(1)(B).

Opposer therefore moves to strike exhibits 13, 14, and 15 to Applicant's Notice of Reliance from the record of evidence.

V. **STATEMENT OF FACTS- OVERVIEW OF OPPOSER'S LONGSTANDING KISS MY FACE BUSINESS**

Opposer began as Kiss My Face Corporation³, founded on a 200-acre organic farm in New York's Hudson Valley. Opposer's flagship product was an all-natural, olive-oil soap bearing the trademark KISS MY FACE in the late 1970s. Opposer's KISS MY FACE soap was so successful that Opposer's product offering expanded to include a wide range of all natural, organic personal care products, including facial products, hair products, body products, bath products, and oral care products. (Dkt. 23, Fufidio Dep. 7:9-9:9; Dkt. 19, Opposer's NOR Ex 2, Part 1, KMF10.)

By the 1980's Kiss My Face became known as an innovative company offering high-quality green and organic products. Opposer's commitment to the use of potent, pure and concentrated oils and organic botanicals in its KISS MY FACE products has made Opposer a leader in the natural products channel. (Dkt. 19, Opposer's NOR, Ex. 2, Parts 1 (all) and 2 at pages KMF86-95; Dkt. 19, Opposer's NOR, Ex. 3, Part 3, KMF13-17.)

A. OPPOSER'S EXTENSIVE KISS MY FACE PRODUCT LINE

Opposer's KISS MY FACE personal care product line now features more than 40 distinct types of products, including the following: body moisturizers, lip balms, bar soaps, moisture shaves, facial moisturizers, sun care products, hair care products, and oral care products. Opposer also offers an entire line of non-medicated goods specifically developed for facial care, including cleansers, toners, masks, acne gel, and serums geared towards specific skin types. All of Opposer's products are offered under the KISS MY FACE mark. Although sub-brands are often used on Opposer's product packaging, the KISS MY FACE mark is always the most prominent trademark on packaging. (Dkt. 19, Opposer's NOR, Exs. 2 and 3; Dkt. 23, Fufidio Dep. 7:9-9:9.)

Opposer offers a line of children's products and men's products, but considers its target customers to be women age 24-39 years old who like natural products that are healthy for the skin. (Dkt. 23, Fufidio Dep. 7:9-20 and 29:17-30:7.)

The retail price for KISS MY FACE goods is between \$6.99 and \$21.99, with KISS MY FACE facial products retailing in the high end of that price range at \$15.99 and \$21.99. (Dkt. 23, Fufidio Dep. 29:6-16.; Dkt. 19, Opposer's NOR, Ex. 2, Part 1, pp. KMF84.)

B. SALES SUCCESS OF KISS MY FACE PRODUCTS

Opposer has marketed and distributed KISS MY FACE products for sale in the U.S. widely and continuously since at least 1981. During the past five years, Opposer's gross sales of KISS MY FACE branded goods worldwide have totaled over ██████████ dollars, or an average of over ██████████ dollars a year. Ninety percent of those sales occur in the U.S., meaning Opposer's gross sales of KISS MY FACE branded goods in the U.S. for the past five years

³ Eventually, Kiss My Face Corporation reorganized into the current entity, Kiss My Face, LLC. When that happened, the intellectual property assets including common law and registered trademarks were assigned to Kiss My Face, LLC. (Dkt. 23, Fufidio Dep. at 6:11-24 and Ex. 1.)

exceeded [REDACTED] dollars, or an average of over [REDACTED] dollars in U.S. sales per year. (Dkt. 23, Fufidio Dep. 11:20-13:3 and Dkt. 24 Ex. 2.)

C. CHANNELS OF TRADE FOR OPPOSER'S KISS MY FACE PRODUCTS

KISS MY FACE all natural products are offered in 19 countries. (Dkt. 19, Opposer's NOR, Ex. 3, Part 3, KMF13-17.) In U.S. KISS MY FACE goods are distributed online via www.drugstore.com, www.amazon.com, www.kissmyface.com, and in national retail grocery and drug stores including Whole Foods, Kroger, Walgreen's, Target, Sprout, and Stop & Shop. (Dkt. 23, Fufidio Dep. 9:10-23.)

The parties' goods are described identically as "facial masks" in the Applicant's application U.S. Application Serial No. 85/663,155 and Opposer's U.S. Registration Nos. 4,229,593, 4,450,641, and 4,450,642. (Dkt. 19, Opposer's NOR, Ex. 5.)

Applicant's U.S. Application Serial No. 85/663,155 identifies one other good, which is broadly described as "non-medicated serums for use on skin". Opposer's Registration Nos. 1,513,297, 2,706,187, 2,301,324, 4,450,641, and 4,450,642 identify a number of goods that fall into the broad category of "non-medicated serum for use on skin", including: skin toners, skin lotion, facial gel, body gels, facial creams, hand lotions, skin lotions, skin toners, and non-medicated alpha-hydroxy acid lotions. (Dkt. 19, Opposer's NOR, Ex. 5.) Also, Opposer offers a non-medicated facial serum under its KISS MY FACE mark. (Dkt. 23, Fufidio Dep. at 8:9-10; Dkt. 19, Opposer's NOR, Ex. 2, Part 2, at KMF86.)

Neither parties' identification of goods is limited with respect to consumers or channels of trade.

D. ADVERTISING AND PROMOTION OF OPPOSER'S KISS MY FACE PRODUCTS

Opposer devotes significant resources towards marketing, advertising and promoting KISS MY FACE products in an effort to build brand awareness. Opposer spends about [REDACTED] annually to promote the KISS MY FACE brand. (Dkt. 27, Fufidio Dep. 19:5-10.)

Opposer's Chief Marketing Officer, Ms. Jean Fufidio explained: "Kiss My Face stands for [] really kissably soft, touchably soft skin." (*Id.* at 35:20-22.) To communicate to a consumer how his/her skin is going to feel or look after use of KISS MY FACE products, Opposer's advertisements use imagery that conveys the message of touchable, kissable skin. Opposer's advertising and marketing is "all about the emotional connection that women have with their significant other, or men have with their significant other, when they use the brand. It's that emotional connection with the brand and how it makes your skin feel." (*Id.* at 30:13-24; 32:7-33:3.) To communicate this message, Opposer's advertisements often show consumers hugging, kissing, and/or touching. (*Id.* at 34:10-22; 38:8-23, 45:9-20.)

Opposer drives awareness of the KISS MY FACE brand through a variety of media. Specifically, Opposer's marketing, advertising and promotional activities related to the KISS MY FACE brand consist of:

1. Online and Hard-Copy Magazines

Opposer works with a public relations company, which coordinates efforts with online and hard copy magazine editors in an effort to have KISS MY FACE products included or featured in articles. As a result of these efforts, from January through October 2014, it is estimated that the KISS MY FACE brand was viewed by over 500 million consumers in online and hard copy magazines. That level of consumer exposure to the KISS MY FACE brand is estimated to equal five million dollars of advertising. (Dkt. 23, Fufidio Dep. 20:2-21:3, and Dkt. 24 Fufidio Dep. Ex. 4.)

Opposer's KISS MY FACE products have consistently received commendations from nationally circulated, well-known magazines and websites, including the following:

- KISS MY FACE products have been featured in VOGUE and TEENVOGUE magazines. TEENVOGUE magazine ranked KISS MY FACE POTENT AND PURE one of their top five natural acne spot treatments. (Dkt. 23, Fufidio Dep. 22:4-24; Ex. 5 to Fufidio Dep.)
- WOMEN'S RUNNING and WOMEN'S HEALTH magazines have also featured KISS MY FACE bar soap as its readers' favorite olive oil bar soap. (Dkt. 23, Fufidio Dep. 22:25-23:9; 24:2-11; Ex. 5 to Fufidio Dep.)
- The online website Popsugar.com recommended KISS MY FACE soap to its readers. (Dkt. 23, Fufidio Dep. 24:14-22; Ex. 5 to Fufidio Dep.)
- KISS MY FACE products have been featured in O, THE OPRAH MAGAZINE - online and hard copy versions. (Dkt. 23, Fufidio Dep. 25:2-20; 26:18-21; Ex. 5 to Fufidio Dep.) O, THE OPRAH MAGAZINE subscription circulation is over two million, not counting "pass along" rate beyond the consumer who originally purchased the magazine. (Dkt. 23, Fufidio Dep. 25:21-25; Ex. 5 to Fufidio Dep.)
- REDBOOK rated KISS MY FACE sun screen the best natural sunscreen. Circulation of REDBOOK is over two million. (Dkt. 23, Fufidio Dep. 26:23-27:19; Ex. 5 to Fufidio Dep.)
- PREVENTION magazine named KISS MY FACE one of the top 10 best sunscreens for your skin. Circulation of PREVENTION magazine is over two million. (Dkt. 23, Fufidio Dep. 26:11-17; Ex. 5 to Fufidio Dep.)
- KISS MY FACE goods have also been featured in COSMOPOLITAN, SELF, GLAMOUR and INSTYLE magazines and received commendations from these magazines. (Dkt. 23, Fufidio Dep. 27:20-28:3 and Ex. 5 to Fufidio Dep.)

- KISS MY FACE olive oil soap has been featured in the LA WAVE newspaper. (Dkt. 23, Ex. 5 to Fufidio Dep.)

2. Internet and Social Media

Opposer also successfully promotes the KISS MY FACE brand on social media, including Facebook. As a result of Opposer's continued and ongoing efforts, support for Opposer's KISS MY FACE brand online is increasing at a rapid pace. From 2013 to 2014, Opposer's social media support increased by 30%. (Dkt. 23, Fufidio Dep. 21:3-8, Dkt. 24 Ex. 4.) Traffic is driven to Opposer's Facebook page via coupons for KISS MY FACE goods offered to consumers via links on that page and to consumers who "like" Opposer on its Facebook page. (Opposer's NOR Ex. 3 part 1, KMF53.)

Opposer's Facebook page, which prominently features the KISS MY FACE brand, has nearly 100,000 Facebook fans. (Dkt. 19, Opposer's NOR, Ex. 4, pp. KMF167-173; Dkt. 19, Opposer's NOR Ex. 3 part 1, p. KMF53; Dkt. 23, Fufidio Dep. 21:7-8; 28:4-11.)

Opposer also maintains an Internet web site located at www.kissmyface.com. The web site prominently features the KISS MY FACE brand and provides consumers with extensive information on KISS MY FACE products. The footer on the bottom of Opposer's website also provides consumers an opportunity to sign up for Opposer's newsletter, receive coupons, special offers, and new product updates. (Dkt. 19, Opposer's NOR, Ex. 2, part 2 and Ex. 3.) Opposer currently has about 95,000 email subscribers, who receive email and letters from Opposer two to three times a month about KISS MY FACE products. (Dkt. 23, Fufidio Dep. 28:13-25.)

3. Point of Sale

Opposer also offers coupons at point of sale and on samples of KISS MY FACE products. For example, in 2014, over 250,000 coupons were distributed to consumers. (Dkt. 23,

Fufidio Dep. 21:11-14 and Dkt. 24 Fufidio Dep. Ex. 4.)

4. Interactive Marketing

Opposer also invests in interactive marketing events. In the summer of 2014, Opposer engaged in an advertising campaign entitled “Kiss Across America”, which was a partnership with Swim Across America, a non-profit organization that raises funds for cancer research. Opposer’s KISS MY FACE sunscreen was the official sunscreen of the Swim Across America campaign. At Swim Across America events, KISS MY FACE sunscreen was displayed and given to consumers as samples or prizes. Opposer also offered a contest to consumers via its Facebook page, which invited consumers to submit photos or video clips showing the consumer kissing or hugging friends, family, or pets. (Dkt. 23, Fufidio Dep. p. 53:11-54:25; Dkt. 24, Confidential Ex. 4 to Fufidio Dep.) By its very nature, the Kiss Across America campaign drove consumers to Opposer’s Facebook page.

5. Consumer Study to Gauge Effectiveness of Advertising, Awareness, Impressions of KISS MY FACE Brand Among Consumers of Natural Products

In 2011 Opposer hired an independent third-party to conduct a survey of approximately 1,300 female consumers across the U.S. A 20-minute interview was conducted and participants were asked about their attitudes and usage of natural products. The study was conducted so that Opposer could understand consumers’ attitudes about natural personal care products and to understand how consumers react to KISS MY FACE as a brand. (Dkt. 23, Fufidio Dep. 14:20-15:24.)

Fifty-seven percent of consumers who participated in the study indicated an awareness of KISS MY FACE brand. (Dkt. 23, Fufidio Dep. 16:21-17:13, and Dkt. 24, Ex. 3 at p. 52-53.) When asked for reactions to the KISS MY FACE brand, participating consumers responded

“good quality”, “all natural”, “good smelling” and “earth friendly”. (Dkt. 23, Fufidio Dep. 18:15-19:4, and Dkt. 24, Ex. 3 at p. 59.)

E. FEDERAL REGISTRATION OF OPPOSER’S KISS MY FACE MARK

Opposer has invested heavily in protecting its KISS MY FACE brand, including federal registration of the mark KISS MY FACE. Opposer is the record owner of seven valid and subsisting federal registrations for the KISS MY FACE trademark registered on the Principal Register, as follows:

1. U.S. Registration No. 4,229,593 **KISS MY FACE**

Goods: Personal care products, namely, all purpose liquid, hand, bar and cosmetic soaps, non-medicated alpha-hydroxy acid lotions, bar soaps, bath and shower gels, body lotions, body creams, body balms, body wash, cosmetics, deodorants for personal use, exfoliating cleansers, facial cleansers, facial lotions, facial creams, and facial gels, **facial masks**, foaming soaps, non-medicated foot creams and foot scrubs, shampoos, hair conditioners, hair detanglers, hair styling gels, hand lotions and hand creams, liquid soaps, moisturizing shower gel, mouthwash, non-medicated lip balms, shaving creams, skin toners, non-medicated sun care products, and toothpaste and toothpaste gel in International Class 3. (**Emphasis** added.)

First Use: 12/01/1978; First Use in Commerce: 12/00/1978

Filed: 03/08/2012

Registered: 10/23/2012

2. U.S. Registration No. 2,301,324 **KISS MY FACE**

Goods: Non-medicated lip balms, cosmetics, namely, lipsticks, [mascaras,] foundations, conditioners, [body mists,] bath and body gels, facial creams, hand lotions, deodorants, soaps, shaving creams, skin lotions, skin toners and facial and body lotions in International Class 3.

First Use: 06/00/1993; First Use in Commerce: 06/00/1993

Filed: 09/22/1997

Registered: 12/21/1999

3. U.S. Registration No. 1,513,297 **KISS MY FACE**

Goods: Personal care products- namely, shampoos, soaps, crème rinses, skin toners and skin lotions in International Class 3.
First Use: 12/01/1978/ First Use in Commerce: 12/01/1978
Filed: 04/28/1988
Registered: 11/22/1988

4. U.S. Registration No. 4,450,642 **KISS MY FACE and Design**



Goods: Personal care products, namely, all purpose soaps, moisturizing soaps, alpha-hydroxy acid face and body lotions, bar soaps, bath and shower gels, body lotions, body creams, body balms, body wash, cosmetics, tinted lip gloss, lip tint, tinted moisturizers, deodorants for personal use, exfoliating cleansers, facial cleansers, facial lotions, facial creams, facial gels, **facial masks**, foaming soaps, non-medicated foot creams, foot scrubs, shampoos, hair conditioners, hair detanglers, hair styling gels, hand lotions, hand creams, liquid soaps, moisturizing shower gel, mouthwash, non-medicated lip balms, shaving creams, moisturizing shaving creams, skin toners, non-medicated sun care preparations, sun tanning preparations, toothpaste, and toothpaste gels in International Class 3. (**Emphasis** added.)

First Use: 09/00/1978; First Use in Commerce 09/00/1978
Filed: 04/16/2013
Registered: 12/17/2013

5. U.S. Registration No. 4,450,641 **KISS MY FACE and Design**



Goods: Personal care products, namely, all purpose soaps, moisturizing soaps, alpha-hydroxy acid face and body lotions, bar soaps, bath and shower gels, body lotions, body creams, body balms, body wash, cosmetics, tinted lip gloss, lip tint, tinted moisturizers, deodorants for personal use, exfoliating cleansers, facial cleansers, facial lotions, facial creams, facial gels, **facial masks**, foaming soaps, non-medicated foot creams, foot scrubs, shampoos, hair conditioners, hair detanglers, hair styling gels, hand lotions, hand

creams, liquid soaps, moisturizing shower gel, mouthwash, non-medicated lip balms, shaving creams, moisturizing shaving creams, skin toners, non-medicated sun care preparations, sun tanning preparations, toothpaste, and toothpaste gels in International Class 3. (**Emphasis** added.)

First Use: 09/00/1978; First Use in Commerce 09/00/1978
Filed: 04/16/2013
Registered: 12/17/2013

6. U.S. Registration No. 2,706,187 **KISS MY FACE**

Goods: Clothing, namely t-shirts in International Class 25.
First Use: 03/00/1980; First Use in Commerce: 03/00/1980
Filed: 4/23/2001
Registered: 4/15/2003

7. U.S. Registration No. 1,991,868 **KISS MY FACE**

Services: Retail shops featuring clothing, and personal care products, namely shampoos, soaps, creme rinses, powders, skin toners and skin lotions in International Class 35.
First Use: 11/01/1994; First Use in Commerce: 11/01/1994
Filed: 08/01/1994
Registered: 08/06/1996

Opposer is also the record owner of four additional valid and subsisting federal registrations for marks that include the words KISS MY FACE, registered on the Principal Register, as follows:

1. U.S. Registration No. 4,268,625 **KISS MY FACE PEACE and Design**



Goods: All purpose soaps, bar soaps, bath and shower gels, body lotions, body washes, cosmetics, foaming soaps, hand lotions, body creams and body balms, liquid soaps, non-medicated lip balms, personal care products, namely, facial creams, foot creams, hand creams, deodorants for personal use, hair conditioners, hair detanglers, hair styling gels, mouthwashes, breath fresheners, shampoos, shaving creams, toothpastes, non-medicated sun care preparations and non-medicated sunscreen preparations in International Class 3.

First Use: 05/01/2010; First Use in Commerce: 05/01/2010
Filed: 04/26/2010
Registered: 01/01/2013

2. U.S. Registration No. 4,200,053 **KISS MY FACE SHIMMER**

Goods: Non-medicated tinted lip balms in International Class 3.
First Use: 03/20/2012; First Use in Commerce: 03/20/2012
Filed: 10/18/2011
Registered: 08/28/2012

3. U.S. Registration No. 3,120,784 **KISS MY FACE WHITENING**

Goods: Personal Care Products, Namely, Toothpastes in International Class 3.
First Use: 11/05/2001; First Use in Commerce: 11/05/2001
Filed: 10/14/2005
Registered: 07/25/2006

4. U.S. Registration No. 3,590,613 **KISS MY FACE MOISTURE SOAP**

Goods: Personal care products, namely, soaps in International Class 3.
First Use: 06/00/1986; First Use in Commerce: 06/00/1986
Filed: 07/28/2008
Registered: 03/17/2009

F. OPPOSER'S SUCCESSFUL ENFORCEMENT EFFORTS

The KISS MY FACE brand is an extremely valuable company asset. Accordingly, Opposer employs two people to oversee and manage trademark issues pertaining to the KISS MY FACE brand, both of whom work closely with outside counsel to prevent infringement of the KISS MY FACE mark and enforce Opposer's rights in the KISS MY FACE mark when necessary. (Dkt. 23, Fufidio Dep. 4:22-5:11)

Opposer has aggressively pursued unauthorized third-party use of its well-known KISS MY FACE mark in the past, as necessary. Opposer has produced evidence of considerable enforcement efforts, including the following efforts with respect to Class 3 personal care products and related goods:

<u>THIRD PARTY USE</u>	<u>GOODS</u>	<u>ACTION TAKEN</u>	<u>OUTCOME</u>
U.S. App. Ser. No. 85/901,863 WATER MY FACE	Facial moisturizers in Class 3	Opposition No. 91214547	Opposition sustained in favor of Opposer.
U.S. App. Ser. No. 85/636,031 LICK MY FACE	Goods including personal care products and moisturizers in Class 3	Opposition No. 91208333	Opposition sustained in favor of Opposer.
U.S. App. Ser. No. 86/171,906 KISS MY GRITS	Lip scrub in Class 3	Opposition No. 91218622	Pending
U.S. App. Ser. No. 85/924,877 KISS MY LIPS!	Lip balm; cosmetics in Class 3	Demand Letter	U.S. App. Ser. No. 85/924,877 abandoned.
Scented Co. Common Law Mark KISS MY LIPS!	Lip balm	Demand Letter	Scented Co. ceased use of KISS MY LIPS! FACE on lip balm.
U.S. App. Ser. No. 85/571,796 KISS MY TULIPS	Indoor and outdoor on-medicated skin tanning preparations in Class 3	Demand Letter	U.S. App. Ser. No. 85/571,796 expressly abandoned.
U.S. App. Ser. No. 86/222,393 KISS MY BUDDHA	Lotions for improving grips in sports activities in Class 3	Demand Letter	Applicant amended its description of goods and class number to “Non-medicated, topically-applied lotions for improving hand grip in sports activities” in Class 28.
U.S. App. Ser. No. 85/389,168 KISS MY COUTURE	Sun tanning preparations and other personal care products in Class 3	Opposition No. 91205250	U.S. App. Ser. No. 85/389,168 abandoned.

<u>THIRD PARTY USE</u>	<u>GOODS</u>	<u>ACTION TAKEN</u>	<u>OUTCOME</u>
U.S. App. Ser. No. 85/825,221 KISS BY KERONE	Personal care products and cosmetics in Class 3	Opposition No. 91216331	Opposition sustained in favor of Opposer.
KAS Direct, LLC Common Law Mark KISSY FACE	Lip balm	Demand Letter	KAS Direct, LLC. ceased use of KISSY FACE on lip balm.
U.S. App. Ser. No. 78/534,887 KISS MY BASS	Personal hygiene products for men and women, namely, cologne, lotion, after-shave, anti-perspirant, deodorant, hand cream, hand soap and bath soap in Class 3.	Opposition No. 91169326	Opposition sustained in favor of Opposer.
U.S. App. Ser. No. 78/657,383 KISS MY ASH	Clothing items, namely, hats, shorts, and polo shirts and t-shirts in Class 25.	Opposition No. 91171928	Opposition sustained in favor of Opposer.
U.S. App. Ser. No. 85/138,743 KISS MY ASSISSI	Hair bleaching preparations, non-medicated hair care preparations, hair cleaning preparation, hair color removers, hair coloring preparations, hair lighteners, hair coloring rinse, hair lightening bleach, hair rinses, hair colorants, all in the form of liquid, gel and cream in Class 3.	Opposition No. 91200578	Opposition sustained in favor of Opposer.
U.S. App. Ser. No. 77/585,463 LUSCIOUS LICK-ABLES “KISS MY PEPPERMINT” BB BEST BALMS	Lip balm in Class 3.	Opposition No. 91190868	Opposition sustained in favor of Opposer.
U.S. App. Ser. No. 77/315,139	Aromatherapy body care products, namely, body lotion, shower gel, cuticle cream, shampoo, conditioner, non-medicated lip balm, soap, body	Opposition No. 91184808	Opposition sustained in favor of Opposer.

<u>THIRD PARTY USE</u>	<u>GOODS</u>	<u>ACTION TAKEN</u>	<u>OUTCOME</u>
KISS MY LIPS	polish, body and foot scrub and non-medicated foot cream; Cosmetics, namely, lip primer; Lip balm in Class 3.		
U.S. App. Ser. No. 77/231,208 KISS MY BUM	Medicated foaming rinse-free cleanser, medicated balm, medicated spray-on cleaner and ointments, and pre-moistened antiseptic and medicated wipes and pads all for diaper rash prevention relief in Class 5.	Opposition No. 91183926	Opposition sustained in favor of Opposer.
U.S. App. Ser. No. 77/142,078 LICK MY FACE	Non-medicated grooming preparations for dogs, namely, mouth rinse, toothpaste and breath freshener in Class 3.	Opposition No. 91182031	Opposition sustained in favor of Opposer.
U.S. App. Ser. No. 77/142,079 LICK MY FACE I LOVE MY DOGGIE	Non-medicated grooming preparations for dogs, namely, mouth rinse, toothpaste and breath freshener in Class 3.	Opposition No. 91182032	Opposition sustained in favor of Opposer.
U.S. App. Ser. No. 78/907,899 KISS MY SASS!	Lip balm in Class 3.	Opposition No. 91177675	Opposition sustained in favor of Opposer.
U.S. App. Ser. No. 79/004,269 KISS MY...	Clothing items in Class 25.	Opposition No.	Opposition sustained in favor of Opposer.
U.S. App. Ser. No. 76/423,256 KISS MY LIPS	Lip Gloss in Class 3.	Opposition No.	U.S. App. Ser. No. 76/423,256 abandoned, opposition dismissed without prejudice.
U.S. Registration No. 2,616,120	Blush, eye makeup, eye shadows, eyebrow pencils, foundation,	Opposition No.	Dismissed without prejudice due to

<u>THIRD PARTY USE</u>	<u>GOODS</u>	<u>ACTION TAKEN</u>	<u>OUTCOME</u>
KISS	makeup, colored lipstick, perfume, glue remover for use with artificial fingernails; nail treatments, namely, nail strengtheners, nail polish sealers, and nail polish protector; calcium nail strengthener, cuticle oil, cuticle removers, nail polish top coat and nail polish base coat; nail polish kits containing polish for nails and/or paints for nail decoration and design; adhesive strengtheners that adhere artificial nails to the natural nail, adhere silk and fiber glass wraps to natural and artificial nails, adhere acrylic overlays and gel overlays, polish, fingernail art, namely, sticker design, glitter, rhinestones, paint or polish, or any printed matter that can be adhered to the nail to beautify the natural or artificial nail; acrylic fingernail sculpturing kits containing acrylic powders in various colors, acrylic liquid, primers, artificial nail forms, adhesive, nail files, acrylic sculpting brush, sanding block and dish to hold acrylic components; decals for use in decorating fingernails; nail art, namely, water decals, sticker design, glitter, rhinestones, paint or polish, or any printed matter that can be adhered to the nail which decorates and beautifies the nail; cuticle removing preparations in Class 3 and Nail brushes in Class 21.	91121709	settlement.
U.S. App. Ser. No. 85/594,431 KISS MY WAX and Design	Lip balm in Class 3.	Opposition No. 91207794	Opposition sustained in favor of Opposer.

(Dkt. 19 and 20, Opposer’s NOR, Ex. 9; Dkt. 25, Applicant’s NOR, Ex. 9, p. 4-5 and Ex. 10,

U.S. Registration No. 2,616,120)

VI. STATEMENT OF FACTS- APPLICANT'S USE OF THE MARK TOUCH MY FACE

A. SELECTION OF THE MARK TOUCH MY FACE

Applicant selected the mark TOUCH MY FACE because it represents an expression of the experience after the first use of TOUCH MY FACE products. Applicant became aware of Opposer via a trademark clearance search. (Dkt. 19, Opposer's NOR, Ex. 8, Interrogatory Resp. Nos. 1-2.)

On June 27, 2012, Applicant filed trademark application Serial No. 85/663,155 for the mark TOUCH MY FACE for use in connection with "Facial masks; Non-medicated serums for use on skin." in Int'l Class 3.

B. OFFERING, PROMOTION, AND SALES OF TOUCH MY FACE GOODS HAVE BEEN MINIMAL

In interrogatory responses, Applicant indicated that TOUCH MY FACE goods have been sold in the geographic regions "Amarillo, Texas, and perhaps Lubbock, Texas" (Dkt. 19, Opposer's NOR, Ex. 8, Interrogatory Resp. No. 7.) Applicant also testified that its TOUCH MY FACE goods are also sold in pharmacies, health food stores, and via Applicant's CEO/President, Roby Mitchell's⁴ "office practice [which] consults individuals on health and nutrition and offers products to facilitate health." (Dkt. 19, Opposer's NOR, Ex. 8, Interrogatory Resp. No. 12; Dkt. 25, Applicant's NOR, Ex. 2, June 30, 2014 Mitchell Dep. 8:4-10:14.)

The only media Applicant uses to advertise or promote products under the mark TOUCH MY FACE are Facebook and Applicant's website at www.DrFitt.com. (Dkt. 19, Opposer's

⁴ Roby Mitchell is not a licensed physician. Despite this fact, Applicant's product is marketed with a potentially misleading display of "Roby Mitchell, M.D." on the front-facing label of its TOUCH MY FACE products. (Dkt. 19, Opposer's NOR, Ex. 6, June 30, 2014 Mitchell Dep. 7:12-24; Dkt. 25, Applicant's NOR, Ex. 4.)

NOR, Ex. 8, Interrogatory Resp. Nos. 8, 10, 13-14; Dkt. 25, Applicant's NOR, Ex. 3, Bytheway Dep. 7:14-9:5.)

Applicant's annual expenditures for advertising and marketing of its TOUCH MY FACE goods from 2008 to 2013 were approximately \$100 per year. (Dkt. 19, Opposer's NOR, Ex. 8, Interrogatory Resp. No. 24.)

Applicant claims that it has sold TOUCH MY FACE goods since 2002; however, the only product offered under the mark TOUCH MY FACE by Applicant from 2002-2011 was a facial mask. (Dkt. 19, Opposer's NOR, Ex. 6, Mitchell Dep. 13:20-14:4.) Applicant did not offer a second product under the mark TOUCH MY FACE – a skin serum – until 2012. (Dkt. 19, Opposer's NOR, Ex. 7, Bytheway Dep. 13:23-24.) After this proceeding was initiated, in approximately 2013, despite Opposer's objection to Applicant's use of the mark TOUCH MY FACE, Applicant expanded its offering of goods to include TOUCH MY FACE soap. (Dkt. 19, Opposer's NOR, Ex. 6, Mitchell Dep. 5:2-6; Dkt. 25, Applicant's NOR, Ex. 5, p. PYR000104-105.)

Applicant has not produced sales records that isolate the sales of TOUCH MY FACE products. As mentioned above, a facial mask was the only TOUCH MY FACE product offered by Applicant until 2012. During discovery, Applicant's representative estimated that 2002 to 2012, less than 50 units of TOUCH MY FACE facial masks were sold per year. (Dkt. 19, Opposer's NOR, Ex. 7, Bytheway Dep. 14:3:10; 16:25-17:8.)

Despite the fact that Opposer and Applicant offer identical all-natural personal care products, given Applicant's limited promotion and sales of TOUCH MY FACE goods, it is not surprising that Opposer did not learn of Applicant until it applied for federal registration of the mark TOUCH MY FACE.

C. TARGET CONSUMERS FOR TOUCH MY FACE AND KISS MY FACE GOODS ARE IDENTICAL

The target consumers of TOUCH MY FACE goods are women who have an interest in beauty and making their skin look better. (Dkt. 19, Opposer's NOR, Ex. 6, June 24, 2014 Mitchell Dep. 5:11-18.)

D. TOUCH MY FACE PRODUCTS ARE NOT EXPENSIVE GOODS

Applicant's TOUCH MY FACE products cost about \$21.75-\$40.00. (Dkt. 20, Opposer's NOR, Ex. 10.)

VII. QUESTION PRESENTED

The sole issue before the Board pursuant to Section 2(d) of the Lanham Act is whether Applicant's mark TOUCH MY FACE, when applied to Applicant's goods, is likely to cause confusion, mistake or deception as to source or sponsorship with Opposer's valid and subsisting federal registrations.

VIII. ARGUMENT

A. STANDING AND PRIORITY

There is no dispute that Opposer owns the KISS MY FACE mark. Opposer's KISS MY FACE registrations are prima facie evidence of the validity of the registered KISS MY FACE mark for the goods and services specified therein. 15 U.S.C. § 1057(b), 15 U.S.C. § 1115(a), 15 U.S.C. § 1115(b).

Moreover, Applicant has not filed a counterclaim or any affirmative defense concerning the validity of Opposer's KISS MY FACE mark in this proceeding and, therefore, is precluded from challenging Opposer's ownership of the mark. *McCarthy*, § 20:65 at 20-118 ("In opposition proceedings, applicant cannot challenge the validity of Opposer's registration except in the context of a counterclaim for cancellation"). Thus, Opposer is the undisputed owner of federal

rights in the KISS MY FACE mark in connection with the goods and services identified in the KISS MY FACE Registrations.

Opposer's unchallenged rights in its KISS MY FACE mark long predate any rights Applicant can claim in the TOUCH MY FACE mark. Applicant's Application Serial No. 8/566,315 for the TOUCH MY FACE mark was filed on June 27, 2012, claiming a date of first use of August 12, 2002. Several of Opposer's registrations for the mark KISS MY FACE were filed before Applicant filed its application to federally register the mark TOUCH MY FACE and claim a date of first use that predates the Applicant's date of first use, including:

- Opposer's Registration No. 2,301,324 for the mark KISS MY FACE for "non-medicated lip balms, cosmetics, namely, lipsticks, [mascaras,] foundations, conditioners, [body mists,] bath and body gels, facial creams, hand lotions, deodorants, soaps, shaving creams, skin lotions, skin toners and facial and body lotions", was filed on September 22, 1997, and claims first use and first use in commerce since June 1993.
- Opposer's Registration No. 1,513,297 for the mark KISS MY FACE for "personal care products – namely shampoos, soaps. Crème rinses, skin toners and skin lotions", was filed on April 28, 1988, and claims first use and first use in commerce since December 1, 1978.

These registrations and others owned by Opposer are prima facie evidence of Opposer's continuous use of the mark for these goods, prior to Applicant's use or application. *McCarthy*, § 16:20 at 16-37 (citing *Rolley, Inc. v. Younghusband*, 97 U.S.P.Q. 252 (9th Cir. 1953); *J. C. Hall Co. v. Hallmark Cards, Inc.*, 144 U.S.P.Q. 435 (C.C.P.A. 1965)).

Applicant has offered no evidence to refute Opposer's priority based on its registrations or its actual use in commerce. Applicant cannot dispute the constructive first use dates established by Opposer's above-enumerated registrations. Thus, Opposer has conclusively established its priority.

Finally, under the Lanham Act, "[a]ny person who believes that he would be damaged by the registration of a mark" may file an opposition. 15 U.S.C. § 1063(a). This threshold standing requirement is an essential element of proof in any opposition proceeding and is satisfied where the opposer possesses a "real interest" in the proceeding. *Compuclean Mktg. & Design v. Berkshire Prods. Inc.*, 1 U.S.P.Q.2d 1323 (T.T.A.B. 1986)(citing cases). As the owner of the KISS MY FACE mark and federal registration for the mark KISS MY FACE, Opposer has standing to challenge an application for a mark confusingly similar to the KISS MY FACE mark. 15 U.S.C. § 1063; 15 U.S.C. § 1052(d).

B. THERE IS A STRONG LIKELIHOOD OF CONFUSION BETWEEN THE PARTIES' MARKS

Pursuant to Section 2 of the Lanham Act, 15 U.S.C. §1052:

No trademark by which the goods of an applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it...
(d) consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office ... as to be likely, when applied to the good of the applicant to cause confusion, or to cause mistake or to deceive 15 U.S.C.A. §1052.

Likelihood of confusion is determined on a case-by-case basis by application of the following thirteen factors identified in *In re E.I. duPont de Nemours & Co.*, 177 U.S.P.Q. 563 (C.C.P.A. 1973):

(1) Similarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;

- (2) Similarity and nature of the goods and services;
- (3) Similarity of established, likely to continue channels of trade;
- (4) Conditions under which and to whom sales are made, i.e. “impulse” vs. careful, considered purchases;
- (5) Fame of the prior mark (sales, advertising, length of use);
- (6) Number and nature of similar marks in use on similar goods;
- (7) Nature and extent of any actual confusion;
- (8) Length of time and conditions under which there has been concurrent use without evidence of actual confusion;
- (9) Variety of goods on which a mark is used;
- (10) Market interface between applicant and the owner of a prior mark (consent; agreement re: confusion; assignment);
- (11) Extent to which applicant has a right to exclude others from use of its mark on the goods;
- (12) Extent of potential confusion, i.e. de minimis or substantial; and
- (13) Any other established fact probative of the effect of use.

Only those *duPont* factors that are shown to be material or relevant in the particular case are properly considered in adjudicating likelihood of confusion. *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 16 U.S.P.Q.2d 1783 (Fed. Cir. 1990). Here, the relevant factors are: (1) Similarity and nature of the goods and services and of established, likely to continue channels of trade; (2) Similarity of the marks in their entireties as to appearance, sound, connotation and commercial impression; (3) Conditions under which and to whom sales are made, i.e. “impulse” vs. careful, considered purchases; and (4) Fame of the KISS MY FACE mark; (5) Absence of evidence of third party uses.

The balance of the relevant *duPont* factors leads to the inescapable conclusion that there is a likelihood of confusion between the marks at issue herein.

1. The parties’ products and trade channels are identical or highly related. (2nd and 3rd *duPont* FACTORS)

The second *Du Pont* factor requires “consideration of the similarity or dissimilarity of the goods or services as described in an application.”⁵ *In re Dixie Restaurants*, 41 U.S.P.Q.2d 1531, 1534 (Fed. Cir. 1997); *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 16 U.S.P.Q.2d 1783, 1787 (Fed. Cir. 1990) (“the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application”). This factor favors rejection of Applicants’ application if the goods or services at issue “are related in some manner,” or if “the circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances that could give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties’ goods or services.” *In re Melville Corp.*, 18 U.S.P.Q.2d 1386 (T.T.A.B. 1991); *In re International Telephone & Telegraph Corp.*, 197 U.S.P.Q. 910, 911 (T.T.A.B. 1978).

In the case at bar, the identity or similarity and relatedness of the parties’ respective goods is apparent from the wording of the identifications of goods in Applicant’s application and the Opposer’s issued registrations. *See Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 U.S.P.Q.2d 1001 (Fed. Cir. 2002) (requiring such a comparison where the evidence is available).

Namely, Applicant claims rights to the TOUCH MY FACE mark on “Facial masks; Non-medicated serums for use on skin.” *See App. Ser. No. 85/663,155.*

⁵ Opposer addresses the second *duPont* factor, similarity of goods or services, before the first factor, similarity of the marks themselves, because as discussed below, a finding that the marks at issue would be used on similar goods or services affects the analysis of whether the marks are sufficiently similar as to make consumer confusion likely. *See, e.g., In re Johnson Products Co., Inc.*, 220 U.S. P.Q. 539, 540 (T.T.A.B. 1983).

With respect to the first good identified in Applicant's application – "facial masks" – Opposer's registrations also identify the identical goods "facial masks". (Opposer's NOR, Dkt. 19, Ex. 5, U.S. Reg. Nos. 4,229,593, 4,450,641, and 4,450,642.)

With respect to the second good identified in Applicant's application – "non-mediated serums for use on skin" – Opposer's registrations also identify a number of goods within the broad category of "non-medicated serum for use on skin", including: skin toners, skin lotion, facial gel, body gels, facial creams, hand lotions, skin lotions, skin toners, and non-medicated alpha-hydroxy acid lotions. (Opposer's NOR, Dkt. 19, Ex. 5, U.S. Reg. Nos. 1,513,297, 2,706,187, 2,301,324, 4,450,641, and 4,450,642.) Not only do Opposer's registrations identify goods that fall within the broad category of non-medicated skin serums, Opposer actually offers a non-medicated facial serum under its KISS MY FACE mark. (Dkt. 23, Fufidio Dep. at 8:9-10; Dkt. 19, Opposer's NOR, Ex. 2, Part 2, at KMF86.)

Further, Applicant also offers all natural soap under its TOUCH MY FACE mark. All natural olive oil soap was Opposer's flagship KISS MY FACE product and is still offered today by Opposer. (Dkt. 19, Opposer's NOR, Ex. 6, Mitchell Dep. 5:2-6; Dkt. 25, Applicant's NOR, Ex. 5, p. PYR000104-105.)

The fact that the products at issue here are the same only increases the likelihood of confusion as to the source of the parties' respective goods. *See AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1541 (11th Cir. 1986) ("That the products involved are similar is evidence tending to prove the existence of a likelihood of confusion."); *Exxon Corp. v. Tex. Motor Exch. of Houston, Inc.*, 628 F.2d 500, 505 (5th Cir.1980) ("The greater the similarity between the products and services, the greater the likelihood of confusion.").

Because the description of goods in the Application and Opposer's registrations are identical and are not restricted whatsoever, it is presumed that the channels of trade and classes of purchasers are the same.⁶ See *Genesco Inc. v. Martz*, 66 U.S.P.Q.2d 1260, 1268 (T.T.A.B. 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (T.T.A.B. 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers").

Accordingly, the second and third *duPont* factors heavily favor Opposer.

2. Similary of the marks KISS MY FACE and TOUCH MY (1st *duPont* factor)

This *duPont* factor examines "the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression." *In re duPont*, 476 F.2d at 136. The focus is on the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 U.S.P.Q. 106 (TTAB 1975). When assessing the similarity of the parties' marks, it is important to keep in mind that "[t]o the average buyer, the points of similarity are more important than the minor points of difference." J. Thomas McCarthy, 3 *McCarthy on Trademarks and Unfair Competition*

⁶ The record evidence also establishes that the parties' channels of trade and classes of purchasers are the same. Both parties promote their respective goods as "natural" and "all natural". (Dkt. 25, Applicant's NOR, Ex. 5, p. PYR000008, PYR0000012; Dkt. 19, Opposer's NOR, Ex. 3, Part 3, KMF13-17.) Both TOUCH MY FACE and KISS MY FACE products are sold online and in retail drug stores **without a prescription**. (Dkt. 25, Applicant's NOR, Ex. 3, Bytheway Dep. 15:24-16:4 and Ex. 8, Interrogatory Resp. Nos. 8, 12-14; Dkt. 23, Fufidio Dep. 9:10-23.)

§23.41 at 23-125 (4th Ed. 2012).

Further, “when marks would appear on virtually identical goods or services, the degree of similarity to support a conclusion of likelihood of confusion declines.” *Century 21 Real Estate Corp. v. Century Life of Am.*, 23 U.S.P.Q.2d 1698, 1700 (Fed. Cir. 1992). As discussed above, the marks at issue in this proceeding are unquestionably used on identical or substantially similar goods.

Also, the fact that Opposer often uses its KISS MY FACE mark enclosed in a dark blue box and has registered the mark in that format is of no consequence. Opposer has registered its KISS MY FACE mark as a standard character mark without stylization or design. (Opposer’s NOR, Dkt. 19, Ex. 5, Reg. Nos. 4,229,593, 2,706,187, 2,301,324, 1,991,868, and 1,513,297.) Opposer is not limited as to the form in which its KISS MY FACE mark is presented to the public on product packaging. *Citigroup Inc. v. Capital City Bank Group Inc.*, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011). (“If the registrant ... obtains a standard character mark without claim to ‘any particular font style, size or color,’ the registrant is entitled to depictions of the standard character mark regardless of font, style, size, or color.”).

Here, the marks KISS MY FACE and TOUCH MY FACE are similar in appearance, sound and commercial impression. The marks are audibly and visually identical to the extent that both marks include the words MY FACE.

Further, both TOUCH MY FACE and KISS MY FACE are structurally similar because each consists of three distinct words, with the words MY FACE as the second and third word in the marks. Also, the word KISS and TOUCH are visually similar in length, with the word KISS having four letters and TOUCH having five letters.

Despite the fact that KISS and TOUCH are not identical words, they create the same

commercial impression on consumers because both convey a sense of affection or endearment. The similar meaning of the words KISS and TOUCH is evident in the first and second entries in the Merriam-Webster dictionary definition for the word “kiss”, both of which include the word “touch”:

kiss

1: to **touch** with the lips especially as a mark of affection or greeting <kissed his wife good-bye>

2: to **touch** gently or lightly <wind gently kissing the trees>

(**Emphasis** added). (Dkt. 19, Opposer’s NOR, Ex. 1.)

Based upon the common definition of the words KISS, it is apparent that consumers are likely to consider KISS and TOUCH to be interchangeable, or at a minimum that KISS is a type of TOUCH.

The fact that KISS and TOUCH are words that convey the same or similar meaning is no surprise to Opposer, who’s Chief Marketing Operating Officer, Ms. Jean Fufidio, testified that the brand KISS MY FACE stands for “kissably soft, touchably soft skin.” (Dkt. 23. Fufidio Dep. 35:20-22.) To communicate this message, Opposer’s advertisements often show consumers hugging, kissing, touching, and showing skin on skin. (Dkt. 23, Fufidio Dep. 34:10-22; 38:8-23, 45:9-20.)

When asked whether KISS MY FACE and TOUCH MY FACE have the same meaning Ms. Fufidio replied “I think that they do...[b]ecause in the world that we live in, when you see [KISS MY FACE] photos, you’re not necessarily seeing a kiss. In some cases, you’re seeing a kiss. In some cases you’re seeing a touch. So we’ve created this image around the brand where it’s not just about kissing.” (Dkt. 23, Fufidio Dep. 44:24-45:8.)

Ms. Fufidio also testified that the message conveyed by KISS MY FACE advertising is “all about the emotional connection that women have with their significant other, or men have with their significant other, when they use the brand. It’s that emotional connection with the brand and how it makes your skin feel.” (Dkt. 23. Fufidio Dep. 30:13-24; 32:7-33:3.)

When asked why he selected the TOUCH MY FACE brand, Mr. Roby Mitchell, Applicant’s President/CEO, gave in essence the same testimony – indicating that he selected the mark TOUCH MY FACE as a “result of the feedback that [he] got from clients and from personal experience with the product...It would make women want to use those words to their husbands.” (Dkt. 19, Opposer’s NOR, Ex. 6, June 30, 2014 Mitchell Dep. 4:9-20.)

The inescapable conclusion is that both Opposer and Applicant aim to convey the same message- their product is so effective others will want to feel your skin affectionately, whether that is via a touch or a kiss.

Given this common imagery and the in-part identical nature of the marks at issue, it is likely that consumers would perceive the marks TOUCH MY FACE and KISS MY FACE as related to one another. This is especially true because the marks are used on identical and virtually identical all natural goods, potentially offered side-by-side on store shelves.

Accordingly, this factor heavily favors Opposer.

3. The relevant purchasers are not sophisticated (4th *duPont* factor)

“When the products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care.” *Recot, Inc. v. M.C. Becton*, 54 U.S.P.Q.2d 1895, 1899 (Fed. Cir. 2000) (likelihood of confusion increases with impulse purchase).

The retail price for the KISS MY FACE facial care goods is between \$15.99 and \$21.99.

(Dkt. 23, Fufidio Dep. 29:6-16.; Dkt. 19, Opposer's NOR, Ex. 2, Part 1, pp. KMF84.)

Applicant's TOUCH MY FACE products are similar in cost- retailing for about \$21.75-\$40.00.

(Dkt. 20, Opposer's NOR, Ex. 10.)

Even if Applicant argues that its TOUCH MY FACE goods, in some cases, cost more than Opposer's KISS MY FACE goods, no price restrictions appear in Applicant's identification of goods. It must therefore be presumed that Applicant's goods include all types - including goods in the price range of \$15.99-\$21.99 and the Board must consider all price points in analyzing this factor. *See Canadian Imperial Bank*, 1 U.S.P.Q.2d 1813, 1815-16 (Fed Cir. 1987). Moreover, the purchasers of the goods at issue must be presumed to include not only knowledgeable consumers, but also general consumers who, with little care or prior knowledge, might purchase such products.

In sum, because the customers are less sophisticated, and because the goods are inexpensive, consumers are less likely to distinguish between KISS MY FACE and TOUCH MY FACE all natural skincare products.

4. The fame of Opposer's KISS MY FACE mark (5th *duPont* factor)

The fifth *duPont* factor plays a dominant role in cases featuring a famous or strong mark. *Bose Corp. v. QSC Audio Products, Inc.*, 63 U.S.P.Q.2d 1303 (Fed. Cir. 2002) (*quoting Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 22 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1992)). Fame for likelihood of confusion purposes arises "as long as a significant portion of the relevant consuming public...recognizes the mark as a source indicator." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). Famous or strong marks enjoy a wide latitude of legal protection since they are more likely to be remembered and associated in the public mind than weaker marks. *Recot, Inc. v.*

M.C. Becton, 54 U.S.P.Q.2d 1894, 1897 (Fed. Cir. 2000).

In order to determine whether a mark has achieved sufficient “public recognition and renown” to warrant a finding of fame under the fifth *duPont* factor, direct evidence of fame is not required. Rather, indirect evidence, such as length of use of the mark, sales volume and marketing expenditures typically suffices. *Bose Corp. v. QSC Audio Products, Inc.*, 63 U.S.P.Q.2d 1303 (Fed. Cir. 2012) (Opposer’s ACOUSTIC WAVE and WAVE marks famous based on sales figures and advertising expenditures).

Here there is compelling evidence that the KISS MY FACE mark is very strong in the natural products channel. Opposer has long-standing use of the mark KISS MY FACE since at least 1981 in connection with its line of all natural personal care products. Furthermore, as the subject of six incontestable registrations, the oldest dating back 27 years, the validity and distinctiveness of the KISS MY FACE mark has been established. 15 U.S.C. § 1065. (Dkt. 19, Opposer’s NOR, Ex. 5, U.S. Reg. Nos. 2,301,324, 1,513,297, 1,991,868, 3,120,784, and 3,590,613.)

The KISS MY FACE brand has ascended to the top of its market category and achieved significant sales success, principally due to the extensive marketing of the brand with consumers. Net sales of KISS MY FACE goods in the United States have been very substantial, exceeding [REDACTED] dollars during the past five years. (Dkt. 24, Ex. 2.)

Opposer has also invested considerable advertising expenses to advertise, promote and market its KISS MY FACE products nationwide, averaging [REDACTED] dollars in advertising and marketing budget per year. Opposer’s 2011 brand awareness study confirmed that Opposer’s marketing and advertising efforts have been successful, with an impressive fifty-seven percent of consumers indicating an awareness of the KISS MY FACE brand. (Dkt. 23, Fufidio Dep. 14:20-

15:24, 16:21-17:13; Dkt. 24, Ex. 3; Dkt. 27 Fufidio Dep. 19:5-10.)

As noted in the Statement of Facts section above, KISS MY FACE products have received commendations from nationally distributed, well-known magazines and newspapers including VOGUE, TEENVOGUE, WOMEN'S RUNNING, WOMEN'S HEALTH, O, THE OPRAH MAGAZINE, REDBOOK, PREVENTION, COSMOPOLITAN, INSTYLE, GLAMOUR, and THE LA WAVE.

The Federal Circuit has consistently accepted statistics of sales and advertising as indicia of fame. *Bose Corp.*, 63 U.S.P.Q. 2d at 1306. Likewise, brand awareness studies and awards and commendations from well-known publications may be considered when determining fame. *See L'Oréal S.A. and L'Oréal USA, Inc. v. Robert Victor Marcon*, 102 U.S.P.Q.2d 1434 (TTAB 2012) (Considering sales figures, advertising expenditures, brand awareness study, and awards or commendations from COSMOPOLITAN, ELLE, GLAMOUR, GOOD HOUSEKEEPING, SHAPE and VOGUE as evidence of the fame of the L'ORÉAL PARIS mark).

The Federal Circuit has stated repeatedly that there is no excuse for even approaching the well-known trademark of a competitor inasmuch as “[a] strong mark...casts a long shadow which competitors must avoid.” *Kenner Parker Toys, Inc.*, 22 USPQ2d at 1456)⁷

5. Third-party use in the record (6th *duPont* factor)

“One of the relevant factors in the likelihood of confusion examination is the ‘number and nature of similar marks in use on similar goods.’” *Lloyd's Food Products v. Eli's, Inc.*, 25 U.S.P.Q.2d 2027, 2029 (Fed. Cir. 1993), *quoting, In re E.I. du Pont*, 177 U.S.P.Q. at 567.

Applicant has provided printouts of TESS search results for searches conducted by

⁷ Even if the Board finds that Opposer has fallen short of establishing that the mark KISS MY FACE is famous, as a matter of law, the fame of a registered mark can never support a junior party; this *duPont* factor can only support the senior party. *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 22 U.S.P.Q. 2d at 1456.

Applicant's counsel. (Dkt. 25, Applicant's NOR, Ex. 13, 14, 15.) These documents are not subject to the Stipulation of the Parties (Dkt. 18). A TESS summary is insufficient to make the listed registrations of record. *In re Duofold Inc.*, 184 U.S.P.Q 638 (T.T.A.B. 1974. As such, Opposer has moved to Strike exhibit 13, 14, and 15 to Applicant's Notice of Reliance from the record of evidence.

Even if a TESS list itself were able to be considered, the mere listing of marks – many of which are the subject of abandoned applications or cancelled or expired registrations – without any accompanying indication of the associated goods and/or services, has virtually no probative value. Further, expired or cancelled registrations are of no value. *See Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 U.S. P.Q. 23 1307 (Fed. Cir. 1989) (“[A] cancelled registration does not provide constructive notice of anything.”).

Applicant has also submitted as evidence TSDR printouts for numerous third-party federal registrations. (Dkt. 25, Applicant's NOR, Ex. 12) These documents provide no context as to the manner in which the marks within the TSDR printouts or TESS results are used. As such, little weight, if any, should be given to the evidence of third party registrations and TESS search results by the Board. *See AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 1404 (C.C.P.A. 1973)(“The existence of [third party] registrations is not evidence of what happens in the market place or that customers are familiar with them nor should the existence on the register of confusingly similar marks aid an applicant to register another likely to cause confusion, mistake or to deceive.”); *Smith Bros. Mft. Co. v. Stone Mft. Co.*, 476 F.2d 1004, 177 U.S.P.Q. 462, 463 (C.C.P.A. 1973)(the purchasing public is not aware of registrations reposing in the U.S. Patent and Trademark Office); *Productos Lacteos S.A. de C.V. v. Paeteria La Michoacana Inc.*, 98 U.S. P.Q.2d 1921 (T.T.A.B. 2011) (“Absent evidence of actual use, third-party registrations

have little probative value because they are not evidence that the marks are in use on a commercial scale or that the public has become familiar with them.”).

Although there is no probative evidence that detracts from the strength of the KISS MY FACE mark, there is an abundance of evidence demonstrating the strength of the KISS MY FACE mark. The KISS MY FACE mark is the subject of numerous registrations on the Principal Register, which creates a presumption that Opposer’s KISS MY FACE mark is valid and distinctive. *Lane Capital Mgmt. Inc. v. Lane Capital Mgmt., Inc.*, 52 U.S.P.Q.2d 1094, 1098 (2d Cir. 1999).

Opposer has reinforced the strength of its mark by an established record of aggressive pursuit of unauthorized third-party use of marks identical and confusingly similar marks, as necessary. (Dkt. 19 and 20, Opposer’s NOR, Ex. 9; Dkt. 25, Applicant’s NOR, Ex. 9, p. 4-5.) The evidence of record indicates that Opposer has successfully prevented a third-parties from use and registration of the KISS MY FACE mark and that it is presently involved in numerous other actions challenging third-party uses of marks it considers to be confusingly similar to the mark KISS MY FACE. (*Id.*)

In sum, the record is void of significant, probative evidence of third party uses of marks that are identical to or confusingly similar to the mark KISS MY FACE. On the other hand, there is abundant evidence of the strength of the KISS MY FACE mark. This factor is therefore neutral.

IX. CONCLUSION

The overriding concerns in any trademark *inter partes* proceeding are to prevent buyer confusion as to the source of the goods, and to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer, who had a legal duty to select a mark which

was dissimilar to trademarks already in use. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 U.S.P.Q.2d 1687, 1690 (Fed. Cir. 1992). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1267, 62 U.S.P.Q.2d 1001, 1003 (Fed. Cir. 2002).

For the reasons stated herein, Opposer respectfully urges the Board to sustain this Opposition proceeding and to refuse registration of Applicant's Application Serial No. 85/663,155.

Respectfully submitted,

Dated: May 1, 2015

/s/ Carrie A. Johnson
Carrie A. Johnson
FRASER CLEMENS MARTIN & MILLER LLC
28366 Kensington Lane
Perrysburg, Ohio 43551
Email: johnson@fraser-ip.com, firm@fraser-ip.com
Attorney for Opposer

CERTIFICATE OF SERVICE

I certify that on May 1, 2015, the foregoing Opposer's Trial Brief was served on counsel for the Applicant via U.S. Mail addressed as follows:

Burdett, Morgan, Williamson & Boykin, LLP
Attention: Christian D. Stewart, Esq.
3423 Soncy Road, Suite 300
Amarillo, Texas 79119

/s/ Carrie A. Johnson
Carrie A. Johnson
FRASER CLEMENS MARTIN & MILLER LLC
28366 Kensington Lane
Perrysburg, Ohio 43551
Attorney for the Opposer