

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

wbc

Mailed: November 18, 2013

Opposition No. 91212361

Cosmetic Warriors Limited

v.

Sir Killian Mathew Wells

Wendy Boldt Cohen, Interlocutory Attorney:

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2), the parties to this proceeding conducted a discovery conference on November 12, 2013.¹ Participating in the conference were opposer's attorney John A. Clifford, applicant Sir Killian Mathew Wells, and Board interlocutory attorney Wendy Boldt Cohen.

The Board reminded the parties of the automatic imposition of the Board's standard protective order in this case. The standard form protective order is online at <http://www.uspto.gov/trademarks/process/appeal/guidelines/stndagmnt.jsp>. The Board reminded the parties that they may

¹ Opposer requested Board participation on or about November 5, 2013.

negotiate an amended protective agreement, subject to Board approval.

The Board further reminded the parties that neither the exchange of discovery requests nor the filing of a motion for summary judgment (except on the basis of *res judicata* or lack of Board jurisdiction) could occur until the parties made their initial disclosures as required by Fed. R. Civ. P. 26(f).

The parties indicated that they have engaged in settlement negotiations. The parties are reminded that the Board encourages settlement. To that end, the Board is generous with periods of extension or suspension to facilitate settlement discussions, although the Board does not get involved in the substantive settlement negotiations.

Although applicant is interested, opposer has indicated that it is not currently interested in pursuing accelerated case resolution (ACR). The parties are directed to review the Board's website regarding ACR at <http://www.uspto.gov/web/offices/com/sol/notices/acrognoticerule.pdf>. If the parties later agree to pursue ACR after some disclosures and discovery, they should notify the Board by not later than two months from the opening of the discovery period.

Stipulations/Filings

Opposition No. 91212361

The parties agreed to service by e-mail, with Trademark Rule 2.119(b)(6) being applicable to such service. The parties were reminded that by making this stipulation the parties may not avail themselves of the additional five days contemplated by Trademark Rule 2.119(c), afforded to parties when service is made by first-class or express mail. See *MacDonald's Corp. v. Cambridge Overseas Development Inc.*, 106 USPQ2d 1339, 1340 (TTAB 2013). The parties email addresses are as follows:

E-mail service upon opposer's counsel shall be made at each of the following email addresses:

jclifford@merchantgould.com; aavery@merchantgould.com; and dockmpls@merchantgould.com.

E-mail service upon applicant shall be made at the following email address: pr@indfernorecords.com.

The parties are urged to file all submissions through the Board's Electronic System for Trademark Trials and Appeals (ESTTA) database, available online at:

<http://estta.uspto.gov>. Throughout this proceeding, the parties should review the Trademark Rules of Practice and the Trademark Board Manual of Procedure ("TBMP"), online at: <http://www.uspto.gov/trademarks/process/appeal/index.jsp>.

The Board expects all parties appearing before it to comply with the Trademark Rules of Practice and where applicable,

Opposition No. 91212361

the Federal Rules of Civil Procedure, online at:

<http://www.law.cornell.edu/rules/frcp/>.

Pleadings

The Board has reviewed the pleadings in this case. In the notice of opposition, opposer has adequately pleaded its standing. See, e.g., *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); TBMP § 309.03(b) (3d ed. rev.2 2013). That is, the statements in paragraphs 1-7 of the notice of opposition allege facts which, if proven, would show a personal interest in the outcome of the proceeding and a reasonable basis for a belief of damages. See *Universal Oil Prod. Co. v. Rexall Drug & Chem. Co.*, 463 F.2d 1122, 1123, 174 USPQ 458, 459 (CCPA 1972).

Likelihood of Confusion

Opposer adequately set forth a claim of likelihood of confusion with its alleged prior use and registrations of LUSH in typed form and design marks under Trademark Act § 2(d), 15 U.S.C. § 1052(d), in paragraphs 8-13 of the notice of opposition. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); TMEP § 1207.01 *et seq.* To the extent opposer relies on its registrations, priority will not be an issue in this

case if opposer makes of record status and title copies of its pleaded registrations. See Trademark Rule 2.122(d)(2); *King Candy Co. v. Eunice King's Kitchen, Inc.*, *supra*.

Dilution

With respect to the dilution claim set for in paragraph 14 of the notice of opposition, opposer has alleged its "mark was famous prior to any first use" by applicant and will cause "dilution by blurring." This claim is insufficiently pleaded under Trademark Act § 43(c). While opposer has claimed fame prior to applicant's use, opposer has failed to alleged that its marks became famous before the constructive use date of applicant's intent-to-use applications (i.e., the filing date of applicant's application).² See *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1174 (TTAB 2001); *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540, 1542 (TTAB 2001). The Board **sua sponte strikes paragraph 14** from the notice of opposition. See TBMP § 506.01.

² "Fame for dilution purposes is difficult to prove. ... The party claiming dilution must demonstrate by the evidence that its mark is truly famous." *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1180 (TTAB 2001). In other words, the requirement for proving "fame" for dilution purposes under Trademark Act § 43(c) is considerably more stringent than the proof of "fame" in a likelihood of confusion analysis. Moreover, while proof of the fame or renown of the plaintiff's mark is optional in a likelihood of confusion case, it is a statutory requirement in a dilution analysis.

Although the electronic cover sheet of the notice of opposition indicates that opposer intends to also pursue claims of deceptiveness and false suggestion of a connection under Trademark Act § 2(a), 15 U.S.C. § 1052(a), the text of the notice of opposition fails to assert or properly plead these grounds.

Deceptiveness

Regarding opposer's deceptiveness claim, a mark is deceptive where: (1) the term in the mark is misdescriptive of the character, quality, function, composition or use of the services; (2) prospective purchasers likely to believe that the misdescription actually describes the services; and (3) the misdescription is likely to affect a significant portion of the relevant consumers' decision to purchase. *See In re Spirits Int'l, N.V.*, 563 F.3d 1347, 90 USPQ2d 1589 (Fed. Cir. 2009); TMEP § 1203.02(b). Pleading of a deceptiveness claim requires an allegation of "facts from which it may be inferred that opposer has a reasonable belief that it would be damaged by use of applicant's allegedly deceptive mark and facts that, if proved, would establish that purchasers would be deceived in a way that would affect materially their decision to purchase applicant's

goods."³ *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711, 1712 (TTAB 1993). Because there appears to be no basis for asserting that LUSH misdescribes the goods listed in the application, a deceptiveness claim would appear to be inappropriate herein.

False Suggestion of a Connection

To state a claim of false suggestion of a connection under Trademark Act Section 2(a), opposer must allege facts from which it may be inferred (1) that applicant's mark points uniquely and unmistakably to opposer as an entity -- i.e., that applicant's mark is opposer's identity or "persona;" (2) that purchasers would assume that goods and/or services rendered under applicant's mark are connected with opposer; and (3) either (a) that opposer was the prior user of applicant's mark, or the equivalent thereof, as a designation of its identity or "persona", or (b) that there was an association of the mark with opposer prior in time to applicant's use.⁴ See *id.* Unless opposer can in good faith assert that LUSH points uniquely and unmistakably to opposer,

³ A deceptiveness claim under Section 2(a) is not an alternative means of raising a likelihood of confusion claim under Trademark Act § 2(d), 15 U.S.C. § 1052(d).

⁴ A false suggestion claim under Section 2(a) is not an alternative means of raising a likelihood of confusion claim under Trademark Act § 2(d).

Opposition No. 91212361

i.e., that LUSH is opposer's identity or persona, there would appear to be no basis for a false suggestion claim herein.

In its answer applicant denied the salient allegations of the notice of opposition and raised a variety of affirmative defenses. Applicant's second and fourth "affirmative defenses" are not affirmative defenses but rather, amplifications of its denials. *See Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995).

Applicant's first affirmative defense claims opposer has failed to state a claim for which relief can be granted. For the reasons already noted herein, opposer has adequately pleaded its standing and its claim of likelihood of confusion. Accordingly, applicant's **first affirmative defense is hereby sua sponte stricken**. *See* TBMP § 506.01.

Applicant's third affirmative defense appears to be a defense of unclean hands which is insufficiently pleaded. The allegations of the affirmative defense are merely conclusory in nature without providing facts which constitute a basis therefor, and which provide fair notice thereof. *See Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 5 USPQ2d 1067 (TTAB 1987); *Heisch v. Katy Bishop Productions Inc.*, 45 USPQ2d 1219 (N.D. Ill. 1997); TBMP § 311.02(b). In

view thereof, the Board ***sua sponte strikes the third affirmative defense.*** See TBMP § 506.01.

Opposer is allowed until **twenty days** from the mailing date set forth in this order to file an amended notice of opposition wherein it repleads its ground(s) for dilution, deceptiveness and/or false suggestion of a connection under Trademark Act Section 2(a), failing which the opposition will proceed solely on a claim of priority and likelihood of confusion under Trademark Act Section 2(d). See Fed. R. Civ. P. 15(a); TBMP § 507.02. If opposer files an amended notice of opposition, applicant is allowed until thirty days from the date of service of the amended notice of opposition to file an answer, or otherwise respond to the amended notice.

Dates are reset as follows:

Initial Disclosures Due	1/19/2014
Expert Disclosures Due	5/19/2014
Discovery Closes	6/18/2014
Plaintiff's Pretrial Disclosures	8/2/2014
Plaintiff's 30-day Trial Period Ends	9/16/2014
Defendant's Pretrial Disclosures	10/1/2014
Defendant's 30-day Trial Period Ends	11/15/2014
Plaintiff's Rebuttal Disclosures	11/30/2014
Plaintiff's 15-day Rebuttal Period Ends	12/30/2014

The Board thanks the parties for their participation.