

ESTTA Tracking number: **ESTTA702014**

Filing date: **10/13/2015**

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

Proceeding	91222461
Party	Defendant Lions Gate Entertainment Inc.
Correspondence Address	JILL M. PIETRINI, PAUL A. BOST SHEPPARD MULLIN RICHTER & HAMPTON LLP 1901 AVENUE OF THE STARS , STE 1600 LOS ANGELES, CA 90067-6055 UNITED STATES pbost@smrh.com, lthompson@smrh.com, jpietrini@smrh.com, lmartin@smrh.com, mdanner@smrh.com, rwalsh@smrh.com
Submission	Reply in Support of Motion
Filer's Name	Paul A. Bost
Filer's e-mail	pbost@smrh.com, jpietrini@smrh.com, lmartin@smrh.com, mdanner@smrh.com, lthompson@smrh.com
Signature	/Paul A. Bost/
Date	10/13/2015
Attachments	Reply Brief ISO Motion to Dismiss - Kheel v. LG.pdf(76489 bytes)

notice of opposition and those materials properly of record.

Opposer's motion repeatedly – and misleadingly – edits a sentence from Applicant's office action response – namely, “When viewed in their entirety, it is patently obvious that POPI and the Cited Marks POPPY'S and POPPY (Stylized) are completely different in sound, appearance, and meaning” – in support of her position. As set forth in greater detail below, Opposer's parsing of this sentence is unreasonable. More importantly, the proper pronunciation of Applicant's mark – and any alleged misrepresentations of Applicant regarding the same – was irrelevant and immaterial to the examining attorney's likelihood-of-confusion analysis.

Lastly, most, if not all, of Opposer's allegations of fraud are based on a faulty premise, that is, that Applicant was required to disclose certain information or a complete printout of its website to the examining attorney or that Applicant represented to the examining attorney that it was providing a full and complete printout of its website. Absent this faulty premise, Opposer's fraud claim cannot stand.

II. OPPOSER HAS NOT PLEADED ANY MATERIAL FALSE STATEMENTS OR OMISSIONS MADE BY APPLICANT

Applicant's motion is fundamentally premised on the failure of Opposer's first amended notice of opposition to allege any material false statements or omissions made by Applicant. Despite Opposer's robust objections, this is not controversial. In fact, Opposer admits this uncontroversial black letter law: “a Notice of Opposition alleging ‘when and how the fraud allegedly occurred,’ ‘the content of the false representation,’ and identifying ‘what was obtained by reason of the asserted fraud’ is sufficient to survive a motion to dismiss.” (Opposer's Brief, p. 7, citing *Caymus Vineyards v. Caymus Medical*, 107 U.S.P.Q.2d 1519, 1523 (TTAB 2013).²

Caymus, which Opposer relies on extensively, is instructive as a contrast to Opposer's

² Opposer cites to the Westlaw reporting of *Caymus*, i.e, 2013 WL 6665451.

pleading at issue. In *Caymus*, the examining attorney, in an office action, had expressly required the counter-defendant to “indicate whether CAYMUS has any . . . geographical significance or any meaning in a foreign language.” *Id.* The counterclaimant in *Caymus* alleged, as a basis for its fraud claim, that the counter-defendant, in response to the examining attorney’s request, “with deceptive intent, failed to disclose material information known by it to the examining attorney,” that is, that counter-defendant “chose CAYMUS with actual knowledge at the time of registration that the word ‘Caymus’ had primarily geographic significance and that its grapes are grown and/or its wine is produced near or at the Caymus locale.” *Id.* (internal citations omitted)

As explained below, none of Applicant’s statements or alleged omissions pleaded by Opposer meets the standard for alleging fraud articulated in *Caymus*.

A. Applicant’s Statement that POPI and POPPY’S are Distinguishable in Sound Was Not False

In its opening brief, Applicant clearly explains that which needs no explaining – POPI and POPPY’S are distinguishable in sound, and Applicant’s statement of the same in its office action response cannot be deemed false.

In support of its position, Opposer seizes upon, and edits, one statement made by Applicant in its office action response, namely, “When viewed in their entirety, it is patently obvious that POPI and the Cited Marks POPPY’S and POPPY (Stylized) are completely different in sound, appearance, and meaning.” (Dkt. No. 11, Ex. A, p. 8.) Clearly, Applicant is making an omnibus statement as to the lack of similarity between, on one hand, its mark and, on the other hand, the marks cited by the examining attorney as a bar to registration, namely, Opposer’s POPPY’S mark and a third party’s POPPY (Stylized) mark. Opposer misleadingly edits this conclusory statement as follows so that it appears that Applicant is affirmatively claiming that its mark and Opposer’s are completely different in sound: “POPI and . . . POPPY .

. . . are completely different in . . . sound.” (Opposer’s Brief, pp. 1, 2, 9.) Opposer’s edit distorts the plain purpose of Applicant’s statement, which, again, was to summarize its position that its mark, on one hand, and those cited by the examining attorney, on the other hand, were distinguishable.

Applicant nowhere represents in its office action that POPI is not pronounced “poppy.” More importantly, any such representation would have been irrelevant and immaterial to the examining attorney’s assessment of the similarity of the marks at issue. Specifically, the examining attorney, in the office action precipitating Applicant’s office action response, specifically remarked that the proper pronunciation of the mark was irrelevant to the likelihood-of-confusion analysis: “There is no correct pronunciation of a mark because it is impossible to predict how the public will pronounce a particular mark. [Citations omitted.] The marks in question could clearly be pronounced the same.”³ Thus, even if the Board credits Opposer’s edited quotation from Applicant’s office action response as an affirmative representation that POPI is not pronounced as “poppy,” any such representation is, as a matter of law, immaterial.

Further, Applicant did not, as a matter of law, “deliberately omit[] relevant portions” of its website, i.e., website pages noting that its mark is pronounced “poppy.” Opposer relies on *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 U.S.P.Q.2d 1731 (TTAB 2012) for this argument. *Swiss Watch* does not support Opposer’s argument. On the contrary, in *Swiss Watch*, the examining attorney required the registrant’s submission of “a copy of the standards used to determine whether others may use the certification mark with their goods or services.” *Id.* at 1745. In response, the registrant submitted to the examining attorney

³ Attached hereto as **Exhibit A** is the examining attorney’s August 25, 2014 office action. Opposer expressly cites and refers to this office action in its first amended notice of opposition. (Dkt. No. 9, ¶¶ 6-9.)

precisely what it represented it was submitting, namely, “a copy of its standards as well as an abstract of the Swiss Ordinance on which these standards are based.” *Id.* Thus, defendant “made no false statements to the examining attorney, and a false statement is one of the critical elements in proving fraud.” *Id.* at 1746.

Here, the examining attorney did not request, much less require, Applicant’s submission of a full printout of its website. Likewise, Opposer cannot identify any other authority requiring Applicant’s submission of a full printout of its website. Furthermore, Applicant never represented to the examining attorney that it was providing him with a full printout of its website, but, instead, only “true and correct printouts from Applicant’s authorized licensee and online merchandise retailer Chivas Skin Care advertising ‘POPI’ products.” (Dkt. No. 11, Ex. A, p. 5.) Even if Applicant purposefully did not submit printouts of pages from its website advising as to how POPI is pronounced (which is certainly not the case),⁴ any such omission is not actionable as Applicant was not obligated to produce and never represented it was going to produce a full printout of its website.

Furthermore, Applicant’s alleged misrepresentation is entirely irrelevant to Opposer’s mark – POPPY’S – but, instead, concerns a third party mark – POPPY (Stylized). Thus, again, even if the Board credits Opposer’s edited quotation from Applicant’s office action response as an affirmative representation that POPI is not pronounced as “poppy,” any such representation is not related to Opposer’s mark - - but to a mark owned by an unrelated third party.

Finally, the Board should reject Opposer’s argument that Applicant deceived the examining attorney by “creating the false impression that the mark was pronounced popeye” by

⁴ Applicant’s licensee’s website is edited and changes periodically. Applicant does not know if the website, at the time it submitted a printout from it to the examining attorney, informed customers that POPI is pronounced “poppy.”

noting the mark was derived from the names of the characters “Piper” and “Polly” from Applicant’s show *Orange is the New Black*. (Opposer’s Brief, p. 9.) First, as explained above, even if this constituted some sort of representation as to how Applicant’s mark was pronounced (it does not), any such representation is immaterial and irrelevant in light of the examining attorney’s mandate to not consider the “correct pronunciation” of the mark. Second, when viewed in context, Applicant clearly referred to the derivation of its mark not to explain how it is pronounced, but to explain its meaning and connotation, particularly as compared to those of the marks cited by the examining attorney. *See* Dkt. No. 11, Ex. A, p. 5 (“Registrants’ marks POPPY (Stylized) and POPPY’S contain absolutely no association with the [*Orange is the New Black*] Series.”)

B. Applicant’s Statement that its Mark “POPI Does Not Connote All Natural, Green and Environmentally Friendly Products” Was Not False

Opposer argues that Applicant’s statement at issue – that “POPI does not connote all natural, green and environmentally friendly products” – is a factual representation, not a legal argument. However, Opposer’s argument itself belies its own position. Namely, Opposer claims that the connotation of Applicant’s mark derives from the qualities of the products it offers thereunder, not its association with *Orange is the New Black*. Applicant believes otherwise. Clearly, these dueling beliefs as to the connotation of Applicant’s mark constitute opposing legal arguments, not representations of fact that can be deemed either true or false.⁵ By arguing that Applicant’s mark has a connotation different than that ascribed to it by Applicant, Opposer proves Applicant’s point.

⁵ A mark’s connotation may be derived from a variety of sources or combination thereof. “Evidence of meaning can include standard dictionary definitions. In determining the meaning and connotation which the trademark projects, it is proper to look to the context of use, such as material on labels, packaging, advertising and the like.” 4 McCarthy on Trademarks and Unfair Competition § 23:26 (4th ed.).

Also, Opposer's argument is based upon a false premise, that is, that Applicant was required to provide the examining attorney with a full printout of its website showing the ingredients to its licensed products or that Applicant represented to the examining attorney it was providing a full printout of its website showing the ingredients to its licensed products. As explained above, neither is true.

Curiously, Opposer takes issue with Applicant's argument that the connotation of Opposer's mark is informed by the fact that the term "poppy" is the name of a flower. The Board should disregard Opposer's hyperbolic objections. First, this argument – and, more broadly, the connotation of Opposer's mark – is irrelevant to disposition of this motion. Opposer's fraud claim is not based on Applicant's arguments as to the connotation of Opposer's mark, but the connotation of Applicant's mark. Second, Applicant did not "improperly slip" this argument into its motion to dismiss. (Opposer's Brief, p. 13.) Such an allegation is nonsensical given the issue before the Board, namely, whether Applicant's belief as to the connotation of its mark constitutes a false representation of fact.⁶

C. Applicant Never Distinguished its Mark from Opposer's Based on Opposer's Maternal Status

Opposer next argues that Applicant committed fraud by telling the "Examining Attorney that the two marks were 'distinguishable . . . in connotation and commercial impression' under the *Dupont* Test, **because** of the fact that Registrant's website made reference to (i.e., marketed itself as) all-natural products made by a mom, while all-the-while withholding the material fact that Lionsgate's website similarly marketed its soap as all-natural products made by a mom –

⁶ For the reasons stated in Applicant's request for judicial notice, the dictionary definitions, or lack thereof, of POPI and POPPY are proper subjects of judicial notice. However, the Board need not consider them in order to dismiss Opposer's fraud claim relating to Applicant's argument as to the connotation of its mark, which is, on its face, not false.

facts that would have added to the likelihood of confusion, but which Applicant (falsely) used to *distinguish* the marks by highlighting these facts about Registrant while concealing these shared material facts about itself.” (Opposer’s Brief, pp. 18-19) (emphases, capitalizations, and punctuation in original)

Opposer’s argument above is based upon a number of false premises. Once again, Opposer is laboring under the incorrect belief that Applicant was required to provide a full printout of its website or that it represented it was providing a full printout of its website. Also, Applicant never raised any argument – much less made any factual representations – regarding its or Opposer’s maternal status. Applicant merely quoted a portion of Opposer’s website that happened to mention that Opposer was “a mom.” Furthermore, Applicant was well within its right to *argue* that the connotation of Opposer’s mark derived from the nature of her products, whereas the connotation of Applicant’s mark derived from the *Orange is the New Black* television show. In the course of making this argument, Applicant did not make any misrepresentations or conceal any material facts.

Odd as such a belief may be, Opposer is entitled to believe and argue that the connotation of Applicant’s POPI mark is not derived from its affiliation with the *Orange is the New Black* television show, but, instead, is derived from the ingredients of the products offered thereunder or the maternal status of Applicant’s licensee. Opposer’s belief that these facts are relevant to the connotation of Applicant’s mark, though, does not impose on Applicant an obligation to disclose such purported facts to the examining attorney.

D. Applicant Statement that POPI “is Spelled Completely Differently From Poppy or Poppy’s Lending A Different Visual Impression To Applicant’s Mark” Was Not False

This claim, like Opposer’s other fraud claims, is both factually and legally untenable on the pleadings. Opposer argues that Applicant committed a material misrepresentation in its

office action response when it argued its POPI mark and Opposer's POPPY'S mark are spelled differently and, thus, have different visual impressions because Applicant did not disclose to the examining attorney that it was using the word "poppy" in promotional literature.⁷

Opposer's fraud claim is again based on the false premise that Applicant was required to provide the examining attorney with a full printout of its website or that Applicant represented it was providing a full printout of its website. Likewise, Opposer incorrectly posits that Applicant was obliged to disclose to the examining attorney that it used the word "poppy" in promotional material for the goods offered under the POPI mark. Applicant was under no such obligation, and Opposer has not identified any authority otherwise.

Opposer's position is particularly meritless given that the visual impressions of the marks is determined based on comparing the marks as depicted in their respective application and registration, and cannot be determined based on extrinsic evidence. *See Blue Cross and Blue Shield Assoc. v. Harvard Comm. Health Plan Inc.*, 17 U.S.P.Q.2d 1075, 1077 (TTAB 1990), *citing Denney v. Elizabeth Arden Sales Corp.*, 120 U.S.P.Q. 480, 481 (CCPA 1959) ("It need hardly be said that 'in determining the applicant's right to registration, only the mark as set forth in the application may be considered.") Thus, Applicant's use of the word "poppy" in its marketing materials is ultimately immaterial to the examining attorney, who is constrained to compare the marks as they appear in their respective application and registration, not in commerce.

III. CONCLUSION

⁷ Although ultimately irrelevant to the issue before the Board, Applicant notes again that it has not done the necessary research to determine if its licensee was even using the word "poppy" on its website at the time it submitted its office action response.

For the reasons stated above and in its motion to dismiss, the Board should dismiss
Opposer's fraud claim with prejudice and without leave to amend.

Respectfully submitted,

Dated: October 13, 2015

/s/Paul A. Bost
Jill M. Pietrini
Paul A. Bost
SHEPPARD MULLIN RICHTER & HAMPTON LLP
1901 Avenue of the Stars, Suite 1600
Los Angeles, California 90067-6017
Telephone: (310) 228-3700
Facsimile: (310) 228-3701

*Attorneys for Applicant
Lions Gate Entertainment Inc.*

CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that this correspondence is being transmitted electronically to Commissioner of Trademarks, Attn: Trademark Trial and Appeal Board through ESTTA pursuant to 37 C.F.R. §2.195(a), on this 13th day of October, 2015.

/s/Lynne Thompson _____
Lynne Thompson

CERTIFICATE OF SERVICE

I hereby certify that this correspondence is being deposited with the United States Postal Service, postage prepaid, first class mail, in an envelope addressed to:

Ilana Makovoz, Esq.
MAKOVOZ LAW GROUP
9350 Wilshire Blvd., Suite 203
Beverly Hills, CA 90212

on this 13th day of October, 2015.

/s/Lynne Thompson _____
Lynne Thompson

SMRH:473343279.2

EXHIBIT A

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 86346513 MARK: POPI	*86346513*
CORRESPONDENT ADDRESS: JILL M. PIETRINI SHEPPARD MULLIN RICHTER & HAMPTON, LLP 1901 AVENUE OF THE STARS STE 1600 LOS ANGELES, CA 90067-6055	CLICK HERE TO RESPOND TO THIS LETTER: http://www.uspto.gov/trademarks/teas/response_forms.jsp
APPLICANT: Lions Gate Entertainment Inc.	
CORRESPONDENT'S REFERENCE/DOCKET NO : 01RS-172016 CORRESPONDENT E-MAIL ADDRESS:	

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE:

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SUMMARY OF ISSUES that applicant must address:

- Section 2(d) Refusal - Likelihood of Confusion

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 2988454 and 4537279. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registrations.

Applicant's mark is "POPI" for "Cosmetics; cosmetic preparations for body care; nail polish; nail decals; bath crystals; bath gel; bath oil; bath salts; body lotion; cream soaps; fragrances; moisturizing creams; shaving soap; soaps for personal use" in International Class 3. The first registrant's mark (Reg. No. 2988454) is "POPPY" for "hair and scalp conditioner" in International Class 3. The second

registrant's mark (Reg. No. 4537279) is "POPPY'S" for a variety of items in International Class 3, including bath soaps, hand soaps, liquid soaps for hands, face and body, and soaps for personal use.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination.

Citigroup Inc. v. Capital City Bank Grp., Inc., 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods, and similarity of the trade channels of the goods. *See In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

A) Similarity of the Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *see In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods offered under applicant's and registrant's marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *Edom Labs., Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012); TMEP §1207.01(b). The focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

i. Reg. No. 2988454 – POPPY

Here, the applied-for mark, "POPI" is highly similar in sound and appearance to registrant's mark, "POPPY". The marks appear almost identical in wording, except the applicant's mark ends with an "I" instead of a "Y" and contains one less "P". These differences have little, if any trademark significance and do not otherwise affect the overall similarity of the marks in terms of overall commercial impression. There is no correct pronunciation of a mark because it is impossible to predict how the public will pronounce a particular mark. *See In re Viterra Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012); *Centraz Indus. Inc. v. Spartan Chem. Co.*, 77 USPQ2d 1698, 1701 (TTAB 2006); TMEP §1207.01(b)(iv). The marks in question could clearly be pronounced the same; such similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*,

8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv).

Therefore, the similarity of the marks favors a determination of likelihood of confusion.

ii. Reg. No. 4537279 – POPPY’S

The applied-for mark, “POPI” is also highly similar in sound and appearance to registrant’s mark, “POPPY’S”. The marks appear almost identical in wording, except the applicant’s mark ends with an “I” instead of a “Y” and contains one less “P”. These differences have little, if any trademark significance and do not otherwise affect the overall similarity of the marks in terms of overall commercial impression. Again, there is no correct pronunciation of a mark because it is impossible to predict how the public will pronounce a particular mark, and the marks in question could clearly be pronounced the same (disregarding the apostrophe and letter “s”). See *id.*

Further, the ending of the registered mark includes an apostrophe and letter “s.” This additional matter has little, if any, trademark significance and does not otherwise affect the overall similarity of the marks in terms of commercial impression. See *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009) (noting that “[t]he absence of the possessive form in applicant’s mark . . . has little, if any, significance for consumers in distinguishing it from the cited mark”); *In re Curtice-Burns, Inc.*, 231 USPQ 990, 992 (TTAB 1986) (finding the marks McKENZIE’S and McKENZIE “virtually identical in commercial impression”); *Winn’s Stores, Inc. v. Hi-Lo, Inc.*, 203 USPQ 140, 143 (TTAB 1979) (noting that “little if any trademark significance can be attributed to the apostrophe and the letter ‘s’ in opposer’s mark”).

Therefore, the similarity of the marks favors a determination of likelihood of confusion.

B) Relatedness of Goods

i. Reg. No. 2988454 – POPPY

The identified goods in this application—cosmetics, cosmetic preparations for body care, nail polish, nail decals, bath crystals, bath gel, bath oil, bath salts, body lotion, cream soaps, fragrances, moisturizing creams, shaving soap, and soaps for personal use—and the goods in the registrant’s cited registration—hair and scalp conditioner—are all highly related beauty and body care products. The attached Internet evidence consists of manufacturers/sellers of cosmetics, cosmetic preparations for body care, nail polish, nail decals, bath crystals, bath gel, bath oil, bath salts, body lotion, cream soaps, fragrances, moisturizing creams, shaving soap, and soaps for personal use that also manufacture/sell hair and scalp conditioner. Please see the attached evidence from the following websites:

- L’Oreal Paris
 - <http://www.lorealparisusa.com/en/Products/Hair/Hair-Care.aspx?category=Shampoo-Conditioner>
 - <http://www.lorealparisusa.com/Products/Makeup/Nails/Nail-Polish/Colour-Riche-Nail.aspx?shade=After-Hours>
 - <http://www.lorealparisusa.com/en/search-results.aspx#!/search/lotion>
 - <http://www.lorealparisusa.com/en/Products/Skin-Care/Cleansers-Makeup-Removers/Go-360-Clean-Deep-Facial-Cleanser-for-Sensitive-Skin.aspx>
- Dove

- <http://www.dove.us/Products/Hair/Advanced-Hair-Series/Oxygen-Moisture-Conditioner.aspx>
- <http://www.dove.us/Products/Lotions/Body-Lotions/Dove-Cream-Oil-Intensive-Body-Lotion.aspx>
- <http://www.dove.us/Products/Bar-Body-Wash/Body-Wash/Dove-Sensitive-Skin-Nourishing-Body-Wash-with-NutriumMoisture.aspx?shop=1>
- <http://www.dove.us/Products/DermaSeries/Intense-Repairing-Body-Cream.aspx>
- <http://www.dove.us/Products/Men-Care/Body-Washes/Extra-Fresh-Body-Face-Wash.aspx>
- <http://www.dove.us/Products/Expert-Shave/Exfoliating-Pre-Shave-Scrub.aspx>
- <http://www.dove.us/Products/Expert-Shave/Smoothing-Shave-Cream.aspx>
- Old Spice
 - <http://www.oldspice.com/en-US/product.aspx?id=2542>
 - <http://www.oldspice.com/en-US/products/product/181/old-spice-fresh-collection-body-wash-fiji/>
 - <http://www.oldspice.com/en-US/products/product/261/old-spice-red-zone-body-spray-champion/>
 - <http://www.oldspice.com/en-US/product.aspx?id=2482>
 - <http://www.oldspice.com/en-US/product.aspx?id=2378>
- Sephora
 - <http://www.sephora.com/conditioner-hair>
 - <http://www.sephora.com/mascara-eyes-makeup>
 - <http://www.sephora.com/nail-polish-nail-lacquer>
 - <http://www.sephora.com/body-wash-shower-gel>
 - <http://www.sephora.com/body-lotion-body-oil>
 - <http://www.sephora.com/perfume>
 - <http://www.sephora.com/shaving-cream-unscented-P225342?skuId=1140821>

This evidence establishes that the same entity commonly manufactures the relevant goods, the goods are also commonly sold under the same mark, and are commonly provided through the same trade channels and used by the same classes of consumers in the same field of use. Therefore, applicant's and registrant's goods are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Evidence obtained from the Internet may be used to support a determination under Trademark Act Section 2(d) that goods are related. *See, e.g., In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009); *In re Paper Doll Promotions, Inc.*, 84 USPQ2d 1660, 1668 (TTAB 2007).

ii. Reg. No. 4537279 – POPPY'S

Part of the identified goods in this application—soaps for personal use—are identical to the goods in the registrant's cited registration. Most of the other goods in the application—cosmetics, bath gel, bath oil, body lotion, cream soaps, fragrances, moisturizing creams, and shaving soap—are highly related to some of the goods identified in registrant's cited registration—bath soaps, hand soaps, and liquid soaps for hands, face and body—are highly related beauty and skin care products. The attached Internet evidence consists of manufacturers/sellers of cosmetics, bath gel, bath oil, body lotion, cream soaps, fragrances, moisturizing creams, and shaving soap that also manufacture/sell bath soaps, hand soaps, and liquid soaps for hands, face and body. In addition to the evidence from Dove and Old Spice listed above, please see

the attached evidence from the following websites:

- Neutrogena
 - <http://www.neutrogena.com/category/cosmetics/face.do?nType=3#productLine>
 - <http://www.neutrogena.com/category/body++bath/body+cleansers.do?nType=1>
 - <http://www.neutrogena.com/category/body++bath/body+moisturizers.do?nType=1>
 - <http://www.neutrogena.com/category/body++bath/body+wash.do?nType=1>
 - <http://www.neutrogena.com/category/body+-+bath/bar+soap.do?nType=1>
 - <http://www.neutrogena.com/category/men/men-s+shaving.do?nType=1>
- Dial
 - <http://www.dialsoap.com/category/body-wash>
 - <http://www.dialsoap.com/category/bar-soap>
 - <http://www.dialsoap.com/category/hand-soap/liquid-hand-soap>
 - <http://www.dialsoap.com/category/lotion>
 - <http://www.dialsoap.com/products/speed-foam-active-sport-foaming-gel-body-wash>
- Jergens
 - <https://www.jergens.com/products/oils/shea-beauty-oil.aspx>
 - <https://www.jergens.com/products/cleansers/extra-moisturizing-liquid-hand-wash.aspx>
 - <https://www.jergens.com/products/cleansers/mild-soap.aspx>
 - <https://www.jergens.com/products/natural-glow/foaming-daily-moisturizer.aspx>
 - <https://www.jergens.com/products/crema/en-US/hydrating-coconut-milk.aspx>

This evidence establishes that the same entity commonly manufactures the relevant goods, the goods are also commonly sold under the same mark, and are commonly provided through the same trade channels and used by the same classes of consumers in the same field of use. Therefore, applicant's and registrant's goods are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

For the foregoing reasons, registration is refused under Trademark Act Section 2(d).

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

RESPONSE GUIDELINES

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. §2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. *See* TMEP §§705.02, 709.06.

/Eric Sable/
Examining Attorney
Law Office 117

571-272-4653
Eric.Sable@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.