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Sent: 8/28/2017 3:41:43 PM

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86847381

MARK: I'M SMOKING HOT



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: FabFitFun, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

46js-224843

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant FabFitFun, Inc., has appealed the trademark examining attorney's¹ final refusal to register the applied-for mark, "I'M SMOKING HOT" under Trademark Act Section 2(d), 15 U.S.C. §1052(d) on the ground that there exists a likelihood of confusion with the registered mark, "SMOKIN'

¹ The Office reassigned this case to the undersigned trademark examining attorney after the appeal was instituted.

HOT SHOW TIME”, U.S. Registration No. 4883039. The Examining Attorney respectfully requests that the refusal be affirmed.

I. FACTS

On December 13, 2015, Applicant FabFitFun, Inc. filed U.S. Trademark Application Serial No. 86/847,381 to register the standard character mark, I’M SMOKING HOT for “Cosmetics and makeup; personal care products; fragrances; body shimmer powder; non-medicated lotions and gels for face and body care; non-medicated skin care preparations; essential oils; false eyelashes; fingernail decals; fingernail embellishments; hair care preparations; incense; nail care preparations; non-medicated bath preparations; non-medicated lip care preparations; non-medicated sun care preparations; non-medicated toiletries; perfumes; potpourri; room fragrances; shaving preparations; soaps for personal use” in International Class 3, alleging intent to use the applied-for mark in commerce pursuant to 37 C.F.R. §§2.2(l), 2.32(a)(5), and 2.34(a)(2).

On March 30, 2016, the examining attorney issued an Office Action refusing registration under Section 2(d) of the Trademark Act because Applicant’s mark is likely to be confused with the registered mark “SMOKIN’ HOT SHOW TIME”, U.S. Registration No. 4883039.

Applicant responded to the Office Action on September 26, 2016, and the examining attorney issued a final refusal on October 7, 2016. Applicant filed a Notice of Appeal on April 10, 2017. On April 14, 2017, Applicant filed a Request for Reconsideration, which the examining attorney denied on April 21, 2017.

II. ARGUMENT

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 of the Applicant and Registrant. See 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made using the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). *In re Davey Prods. Pty*, 2009 TTAB LEXIS 524 (TTAB Aug. 7, 2009); *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)).

Applicant's applied-for mark is similar to Registrant's mark in appearance, sound and overall commercial impression and the goods are closely related such that there is a likelihood of confusion under Section 2(d) of the Trademark Act.

A. The Marks Are Similar in Appearance, Sound, Meaning and Overall Commercial Impression

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)); TMEP §1207.01(b).

1. The Marks are Similar in Appearance

In this case, the marks are similar in appearance because the dominant elements of each mark are practically identical.

The terms “SMOKIN’ HOT” appear at the beginning of Registrant’s mark. It is well established that the first elements of a mark are dominant because they are the first words impressed upon a consumer encountering the mark. Consumers are generally more inclined to focus on the first word in any trademark or service mark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (“VEUVE . . . remains a ‘prominent feature’ as the first word in the mark and the first word to appear on the label”); *In re Integrated Embedded*, 102 USPQ2d 1504, 1513 (TTAB 2016) (“[T]he dominance of BARR in [a]pplicant’s mark BARR GROUP is reinforced by its location as the first word in the mark.”); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions). Thus, the dominant elements of registrant’s mark are the terms “SMOKIN’ HOT”.

Similarly, the dominant elements of Applicant’s applied-for mark are the terms “SMOKING HOT”. The Board has consistently found that possessive pronouns as well as combinations of a possessive pronoun and a verb appearing at the beginning of a mark are not dominant elements when comparing marks in a likelihood of confusion analysis. See, e.g., *Hot Stuff Foods, LLC v. Obsidian Group Inc.*, 2008 TTAB LEXIS 673 (TTAB Feb. 21, 2008) (finding a likelihood of confusion between the marks WE’RE HOT STUFFED! and HOT STUFF FOODS, HOTT STUFF PIZZA, HOT STUFF FOOD ON THE GO and HOT STUFF PIZZERIA and stating in conclusion that the marks are “very similar”).² See also *In re Kurek*, 2012 TTAB LEXIS 257 (TTAB June 26, 2012) (“the word ‘I’ in registrant’s mark is merely a pronoun with no

² Although this decision is not precedential, the Trademark Trial and Appeal Board has stated that decisions designated as not precedential are not binding upon the Board but may be cited as persuasive authority. TBMP§ 101.03; TMEP§ 705.05

particular significance except to answer the question: who doesn't care?"). Similarly, here, the term "I'M" serves only to answer the question: who is smoking hot? In *In re Johnson*, 2013 TTAB LEXIS 177 (TTAB Apr. 2, 2013), the Board affirmed the Examining Attorney's refusal to register the mark "IT'S JUST A CANDLE" and design because of a likelihood of confusion with registrant's mark "JUST CANDLES". In that case, the Board stated that "the additional terms 'IT'S' -- the contraction of the pronoun 'it' and the verb 'is' -- and the indefinite article 'A' in Applicant's mark are insignificant as source-identifiers [*9] *and do not distinguish Applicant's mark from the cited registration in any meaningful way.*" (emphasis added). See also *Patrón Spirits Intl. AG v. Peter Noyes.*, Opposition No. 91215615 (TTAB October 28, 2016) (finding a likelihood of confusion between the marks IT'S PYRAT TIME and PYRAT); *In re Three Chefs Corp.*, 1972 TTAB LEXIS 165 (TTAB June 8, 1972)(affirming the examining attorney's refusal to register the mark "IT'S WISHBONE SWEET due to a likelihood of confusion with the mark WISHBONE). Therefore, when viewed as a whole, the term "I'M" in "I'M SMOKING HOT" is significantly less impactful to consumers encountering the mark.

Thus, the dominant elements of Applicant's applied-for mark are the terms "SMOKING HOT" which are virtually identical by all but one, insignificant, character (a consonant) to the dominant words in registrant's mark, "SMOKIN' HOT". The term "SMOKIN'" is merely a colloquial form of the term "SMOKING" and the removal of the letter "G" in the word SMOKIN' does not change the meaning of the term, as discussed further in the next section of this Brief. Applicant argues that "it is not enough... to simply note that [a]pplicant's mark shares a component with the Cited Mark." However, as discussed above, Applicant's mark does not merely share a component with the cited registration. Rather, the applied-for mark and registrant's mark share identical dominant features, by all but one, insignificant, character (a consonant), such that the differences between the marks become virtually negligible and cannot obviate the likelihood of confusion between the marks.

Although ultimately contending that examining attorney improperly dissected the cited mark, Applicant first correctly notes that the marks must be compared in their entireties and should not be dissected. No such improper dissection occurred here. A trademark examining attorney may weigh the individual components of a mark to determine its overall commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1322, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014) (“[Regarding the issue of confusion,] there is nothing improper in stating that . . . more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties.”) (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985))). Here, the examining attorney did not improperly dissect the marks. Rather, comparing the marks in their entireties and giving appropriate weight to the nearly identical dominant elements of the marks (which are identical in all but one insignificant consonant), the examining attorney concluded that despite the differences between the marks, the marks are confusingly similar.

Applicant cites several district court cases in support of its contention that the marks are dissimilar in appearance. First, *Fancaster, Inc. v. Comcast Corp.*, 832 F. Supp. 2d 380, 413 (D.N.J. Dec. 22, 2011) is easily distinguishable because there, the court found the marks dissimilar in appearance because both marks included a significant design element and the word elements of the marks had distinct meanings, neither of which are the case here. Second, in the case *Colgate-Palmolive Co. v. J.M.D. All-Star Imp. & Exp.*, 486 F. Supp. 2d 286, 289 (S.D.N.Y. May 4, 2007), the court considered a claim of trademark counterfeiting on a Motion for Summary Judgment. There, the court noted, “[w]hen counterfeit marks are involved, it is not necessary to consider the factors set out in *Polaroid Corp. v. Polarad Electronics Corp.*, 287 F.2d 492, 495 (2d Cir. 1961), which are used to determine whether a mark is a colorable imitation of a registered mark that creates a likelihood of confusion about its source, because “counterfeit marks are inherently confusing.” *Lorillard Tobacco Co. v. Jamelis Grocery, Inc.*, 378 F. Supp. 2d 448, 455 (S.D.N.Y. 2005).” *Id.* While just as in case of counterfeiting, the marks in issue here

are practically identical, the holding of the Colgate court is inapplicable in this Proceeding in the light of applicable Board precedent. In *Icebreaker Ltd. v. Gilmar S.P.A.*, 911 F. Supp. 2d 1099, 1107 (D. Or. Nov. 26, 2012), the court found the marks had different meanings, which as discussed below in Section II (A)(3), is not the case here. In *Nature's Best, Inc. v. Ultimate Nutrition, Inc.*, 323 F. Supp. 2d 429, 433 (E.D.N.Y. June 30, 2004), the court found the marks ISOPURE and ISOPREME dissimilar because they have distinct commercial impressions, which is not the case here. Besides, seemingly without basis, the Nature's Best court also found the consumers of the nutritional supplement products at issue in that case to be "sophisticated" thereby failing to exhibit the rigor applied to a likelihood of confusion analysis by the Board. In *Medi-Flex, Inc. v. Nice-Pak Prods.*, 422 F. Supp. 2d 1242, 1250 (D. Kan. Apr. 7, 2006), the court found the marks dissimilar in appearance because the only common element between the marks was descriptive or generic wording. That is different from the facts presently before the Board. Notably, while Applicant argues that the terms "SMOKIN' HOT" or "SMOKING HOT" are weak (which, as discussed below in Section II(B) is not the case), Applicant does not contend these terms are descriptive and/or generic in the cosmetics field. That however would be required in order for the *Medi-Flex* findings to become relevant.

For these reasons, the applied-for mark is confusingly similar in appearance to Registrant's mark.

2. The Marks are Similar in Sound

Applicant's applied-for mark is also highly similar in sound to registrant's mark. Both marks contain nearly identical dominant wording that is indistinguishable in sound when spoken out loud. While the Applicant correctly points out that the word "SMOKIN" in registrant's mark is spelled differently from the term "SMOKING" in Applicant's mark, these words are phonetically identical and thus are indistinguishable when spoken.

Applicant contends that the terms “SMOKIN” and “SMOKING” sound different and thus the marks are distinguishable. However, it is well established that contractions of a term in a registered mark will not avoid a likelihood of confusion. For example, in *In re South Bend Toy Mfg. Co.*, 1983 TTAB LEXIS 215 (TTAB. Mar. 9, 1983), the Board affirmed the examining attorney’s refusal to register the mark LIL’ LADY BUGGY due to a likelihood of confusion with registrant’s mark, LITTLE LADY. In its analysis, the Board stated that “[c]ontractions of a term do not alter the essential identity of character and meaning between the full word and the contraction.” (citing *In re Strathmore Products, Inc.*, 136 USPQ 81, 82 (TTAB 1962)). *See also*

In re Tree of Star’s, Inc., 2000 TTAB LEXIS 595 (TTAB Aug. 24, 2000); *Hot Stuff Foods, LLC v. Obsidian Group Inc.*, 2008 TTAB LEXIS 673 (TTAB Feb. 21, 2008)(stating that “the pronunciation of marks by consumers cannot be controlled and there is no ‘correct’ way to pronounce a mark”). It is unsupported by the case law to argue the removal of the letter “G” from the term “SMOKING” makes the marks sound significantly different, let alone in a way that would be memorable to any consumer.

For these reasons, the applied-for mark is also confusingly similar in sound to registrant’s mark.

3. The Marks are Similar in Connotation and Commercial Impression

Furthermore, the applied-for mark is highly similar in meaning to and shares a nearly identical commercial impression with Registrant’s mark. Marks may be confusingly similar in appearance where similar terms or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression. *See Crocker Nat’l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff’d sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat’l Ass’n*, 811 F.2d 1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987) (finding COMMCASH and COMMUNICASH confusingly similar); *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985) (finding

CONFIRM and CONFIRMCELLS confusingly similar); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983) (finding MILTRON and MILLTRONICS confusingly similar); TMEP §1207.01(b)(ii)-(iii).

As Applicant notes in its appeal brief, the terms “SMOKING HOT” “projects an impression of sexiness, allure and beauty.” This is the case regardless of whether or not the terms are considered with the word “I’M” at the beginning. Similarly, the terms “SMOKIN’ HOT” in the mark “SMOKIN’ HOT SHOW TIME” also convey an impression of sexiness, allure and beauty. Applicant contends that registrant’s mark “does not convey this meaning” because “SMOKIN’ HOT is the style name for one of the products in the SHOW TIME line of products”. Even if this was the case, the analysis is the same. Just as in the case of the applied-for mark, the terms “SMOKIN’ HOT” in the context of “SMOKIN’ HOT SHOW TIME” convey the impression that registrant’s goods will make the consumer look sexy and alluring.

Applicant also contends that the terms “SHOW TIME” in registrant’s mark creates a distinct commercial impression because the applied-for mark “does not convey any association with a scheduled event or an entertainment event... and the use of “SMOKIN’ HOT in Registrant’s mark is intended to convey an “extra” or “deluxe” version of Registrant’s SHOW TIME mascara”. However, “the average purchaser normally retains a general rather than a specific impression of trademarks”. *See Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973). 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 terms of their overall commercial impression that confusion as to the source of the goods offered under the respective 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); *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)). Thus, it is highly unlikely that an average consumer will draw this distinction. In *In re Great Lakes Canning, Inc.*, 1985 TTAB LEXIS 75, 6-7 (Trademark Trial & App. Bd. June 28, 1985), the Board affirmed the examining

attorney's refusal to register the mark "CAYNA" because of a likelihood of confusion with the mark "CANNA" for similar goods. In considering the commercial impression of the marks the Board stated "[c]onsidering the similarities between the marks in sound and appearance, and taking into account the normal fallibility of human memory over a period of time (a factor that becomes important if a purchaser encounters one of these products and some weeks, months, or even years later comes across the other), we believe that the marks create substantially similar commercial impressions. *Id.* Similarly here, the addition of the words "SHOW TIME" at the end of Applicant's applied-for mark is unlikely to alter a consumer's perception of the mark, especially because this wording appears last in the mark.

Additionally, if anything, the terms "SHOW TIME" enhances the impression that registrant's goods will make the consumer look sexy and feel confident and beautiful by suggesting that a user of registrant's products will be ready for anything the moment she or he uses the products. In other words, as soon as a user applies registrant's products the spotlights can appear and he or she will be smoking hot, or more colloquially, smokin' hot.

Moreover, as discussed in Section II(A)(1), the word "I'M" in the applied-for mark does not create a commercial impression distinct from that of Registrant's mark. *See e.g., In re Johnson*, 2013 TTAB LEXIS 177 (TTAB Apr. 2, 2013); *In re Kurek*, 2012 TTAB LEXIS 257 (TTAB June 26, 2012) Furthermore, and contrary to Applicant's contention, the slight difference in spelling of the word "SMOKING" and "SMOKIN'" in the applied-for mark and the registered mark, respectively, does not create different commercial impressions.

For these reasons, the applied-for mark is also confusingly similar in connotation and overall commercial impression to Registrant's mark.

B. The "Evidence" Submitted by Applicant Does Not Demonstrate that the Cited Mark is Weak

Applicant contends that Registrant's mark is weak which weighs against a finding of likelihood of confusion. In support, Applicant submitted various website printouts as well as Registration Certificates that purportedly indicate that Registrant's mark is weak. Even a cursory review of the "evidence" submitted by Applicant shows this is not the case.

A determination of the probative value of evidence of third party use requires a two-fold inquiry. First, the evidence must demonstrate actual use of a term as a trademark in the marketplace on related goods or services. Second, the evidence should demonstrate that the public is aware of such use. *See Tiffany & Co. v. Classic Motor Carriages, Inc.*, 10 USPQ2d 1835, 1840-41 (TTAB 1989).; *See also Nat'l Cable Television Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1580 (Fed. Cir. 1991)

First, and significantly, Registrant's mark is the *sole* registration on the Principal or Supplemental Register that includes the terms "SMOKIN' HOT" or "SMOKING HOT" for cosmetics or any goods or services even remotely related thereto.

- 1. The Third Party "Evidence" Submitted by Applicant Does Not Show Use of the Terms "SMOKING HOT" or "SMOKIN' HOT" in Commerce By Third Parties**
 - a. The Registration Certificates Relied Upon by Applicant are not Germane to this Proceeding**

Nevertheless, Applicant submits nineteen Registration Certificates to demonstrate use of the terms "SMOKIN' HOT" or "SMOKING HOT" by third parties.³, contending this is "evidence of *many* third party marks that employ the term "SMOKIN HOT" for beauty products". These Registration Certificates are for goods *entirely unrelated* to Applicant's and Registrant's goods. The Registrations submitted by

³ September 26, 2016 Response to Office Action in TSDR at pp. 80-130

Applicant are for goods and services including, for example, gaming machines in the nature of electric slot and bingo machines⁴, catering services⁵, and electronic cigarette batteries⁶, to name a few.

Asserting a mark is weak, “as an abstract proposition, is not only unpersuasive but essentially meaningless.” See *Nat’l Cable Television Ass’n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1580 (Fed. Cir. 1991) (citing *Eclipse Assocs. Ltd. v. Data Gen. Corp.*, 894 F.2d 1114, 1119, 13 USPQ2d 1885, 1888–89 (9th Cir.1990)). In summary, the nineteen registrations relied upon by Applicant do not constitute any evidence of any pertinent third party use by anyone.

b. The Alleged Third Party Uses do not Exist and/or are Irrelevant to this Proceeding

Applicant also asserts that the record includes “at least fifteen” examples of third party use of the mark “SMOKIN’ HOT” or “SMOKING HOT”. This is simply not the case. First, the website printout from Bobbi Brown does not show use of the terms “SMOKING HOT” as a trademark. Instead, the terms “SMOKING HOT” appear in connection with the question “ARE YOU #SMOKINGHOT?” to advertise a contest to win Bobby Brown’s Smokey Eye Mascara⁷.

Second, the website printout that includes the terms “Smokin’ Hot Mom” appears to advertise fitness and health related services which is unrelated to Applicant’s and Registrant’s cosmetic goods.⁸ Besides, the dominant element of the combination “Smokin’ Hot Mom” is clearly “Hot Mom” with the word “Smokin’” merely being an attribute amplifying that “hot mom[s]” can become smoking hot moms when using the advertised fitness and health related services. (neither of which have any relevance to the goods at issue before the Board).

⁴ September 26, 2016 Response to Office Action in TSDR at p. 108

⁵ September 26, 2016 Response to Office Action in TSDR at p. 105

⁶ September 26, 2016 Response to Office Action in TSDR at p. 115

⁷ September 26, 2016 Response to Office Action in TSDR at p. 132

⁸ April 14, 2017 Request for Reconsideration in TSDR at p. 35

Third, Applicant included a magazine article discussing a new line of MAC products as “evidence” of use of the terms “SMOKING HOT TEMPERATURE RISING” in connection with various cosmetics. The article, however, clearly indicates that this collection had not yet launched, stating “the new line of bronze powders, bold blushes, and glittery nails *will be* available nationwide May 23 at all MAC locations”. (emphasis added). The article is dated May 15, 2013.⁹

Additionally, Applicant included a website printout from Amazon.com for “TOO FACED SMOKIN HOT LASHES”, which states that the product is “Currently Unavailable. We don’t know when or if this item will be back in stock”, and includes only Amazon product review stating that “I wouldn’t recommend this product to anyone” clearly indicating, if anything, that this product is not popular and likely unavailable because it is no longer sold.¹⁰

Applicant also attached a website printout from the United Kingdom version of Ebay for a Maybelline gift set that is not available to United States consumers, and thus is not credible evidence.¹¹ The website printout states, in bold, “Does not ship to United States”, and therefore, this “evidence” is irrelevant because it does not show use of the term in U.S. commerce.¹²

Similarly, the website printout for a Barry M Cosmetics Eyeshadow Palette is from the United Kingdom version of the Amazon website and there is no indication that this product is available to U.S. consumers.¹³

⁹ September 26, 2016 Response to Office Action in TSDR at p. 132

¹⁰ September 26, 2016 Response to Office Action in TSDR at p. 150

¹¹ September 26, 2016 Response to Office Action in TSDR at p. 164

¹² *Id.*

¹³ September 26, 2016 Response to Office Action in TSDR at p. 173

Furthermore, the website printout from Essie is a mere advertisement which does not offer any means to purchase the goods. Thus, that website printout does not constitute relevant evidence of third party use.

Additionally, the Facebook website printout Applicant includes as “evidence” of use of the terms “SMOKIN HOT” in connection with what appears to be retail store services advertises various clothing items on the Facebook page, but does not advertise a single cosmetic good or related goods.¹⁴ In addition, this Facebook website printout is a mere advertisement for goods and does not include any means to order the clothing items and thus is not relevant evidence of use.

In sum, while Applicant contends to have provided “extensive evidence” of third party use, more than half of the evidence submitted by the Applicant does not in fact constitute any evidence of third party use by any one.

In *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334 (Fed. Cir. 2015) and *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. v. New Millennium Sports, S.L.U.*, 797 F.3d 1363 (Fed. Cir. 2015), both cited by and heavily relied upon by Applicant, not only did the Applicant in those cases submit substantially more, and importantly, actual, evidence of relevant third party use, the third party evidence cited in these cases involved the very same goods and services in question. *See In re Klick, Inc.*, 2016 TTAB LEXIS 86 (TTAB Mar. 4, 2016).

2. Third Party “Evidence” Does Not Demonstrate Public Awareness of Third Party Use

Moreover, the probative value of third party evidence depends on “the degree to which the public is aware of such use” *In re Shaw*, 2013 TTAB LEXIS 252 (TTAB May 14, 2013)(citing *Tiffany & Co. v. Classic Motor Carriages, Inc.*, 10 USPQ2d 1835, 1840-41 (TTAB 1989)). Applicant contends that “within

¹⁴ September 26, 2016 Response to Office Action in TSDR at pp. 154-161

these exhibits is evidence of public recognition”. Yet again, a cursory review of the exhibits demonstrates this is not the case. Applicant points to the more than 3,500 Likes on Facebook received by the entity “Smokin Hot Makeup”. As discussed above, however, this website printout does not advertise any cosmetic or related goods and is a mere advertisement. Thus, it is not relevant evidence of use. Besides, Applicant’s contention raises the question how significant 3,500 likes on a post really is in a social network of 200 million US based users. Applicant is also silent as to (i) the identity of the individuals behind the 3,500 likes, (ii) how many of these likes originate from US-based users or (iv) whether any of the items were purchased or (v) whether any of them originated from fake profiles operated by so called “bots”.

Further, Applicant contends that the website printout from Essie and the website printout from Smokin’ Hot Mom (both of which are not evidence of third party use, as discussed above) “show public recognition of those marks through links to social media pages”. While both of these website printouts appear to include icons for social media pages such as Facebook, it is entirely whether these social media pages are (i) maintained, (ii) regularly updated, (iii) how many “followers” these entities may have on these social medial pages, if any, or (iv) even if these links are functioning at all. Simply put, as presented here, these links to social media pages are not evidence of public awareness of use of these marks.¹⁵ “They give no indication as to actual sales, when each mark was adopted or customer familiarity with the marks”. *Spin Concepts, Inc. v. Capital Rest. Group, Inc.*, 2015 TTAB LEXIS 174 (Trademark Trial & App. Bd. June 3, 2015)(citing *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1798 (TTAB 2002)). Applicant also points to the numerous reviews received by consumers for the Barry M Cosmetics Eyeshadow Palette to show consumer recognition of this product. As discussed above, this product is sold on the United Kingdom version on Amazon website. Similarly,

¹⁵April 14, 2017 Request for Reconsideration in TSDR at pp. 9 and 35

Applicant contends that the “numerous consumer reviews” included in Exhibits A, D and E show use recognized by the public. However, these attachments contain no (consumer) reviews at all.

Similarly, Applicant states that “use of the language such as “only X left in stock’ ... shows use recognized by the public”. Applicant contends that such language demonstrates public awareness of use of the mark. Yet, there is no indication of the initial stock available for sale by the retailer, the time period over which this product has even been available or who the alleged purchasers of the items are.

In short, the third party website printouts submitted by Applicant do not demonstrate public recognition of third party use of marks containing the terms “SMOKIN’ HOT” or “SMOKING HOT”. To demonstrate public awareness, Applicant could have, for example, submitted declarations regarding actual sales, made test purchases to show use of third party marks or provided evidence of visitor traffic to the websites, including geographic location of visitors to the websites. Significantly, in *Juice Generation*, applicant submitted over twenty uses or registrations for the same phrase for similar goods and services. *In re Klick, Inc.*, 2016 TTAB LEXIS 86 (TTAB Mar. 4, 2016) In this case, Applicant’s “evidence” of third party use amounts to a mere a fraction of the material submitted in *Juice Generation* and as shown above, does not constitute any real evidence at all.

Therefore, the “evidence” submitted by Applicant does not show that the terms “SMOKIN’ HOT” and “SMOKING HOT” are weak.

C. Applicant’s Goods Are Related to Registrant’s Goods

Applicant’s applied-for goods (as amended) are as follows: “cosmetics and makeup; personal care products, namely, body lotion, body butter, shower gel, soap, body polish, body and foot scrub, and non-medicated skin creams; fragrances; body shimmer powder; non-medicated lotions and gels for face and body care; non-medicated skin care preparations; essential oils; false eyelashes; fingernail decals;

fingernail embellishments; hair care preparations; incense; nail care preparations; non-medicated bath preparations; non-medicated lip care preparations; non-medicated sun care preparations; non-medicated toiletries; perfumes; potpourri; room fragrances; shaving preparations, soaps for personal use” in International Class 3. Registrant’s goods are “cosmetics” and “mascara” in International Class 3.

Applicant appears to concede that Applicant’s goods are related to Registrant’s goods.

Nevertheless, as discussed below, the goods of Applicant and Registrant are highly related and identical in part.

The goods of the parties need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i).

The respective goods need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

Absent restrictions in an application and/or registration, the identified goods are presumed to travel in the same channels of trade to the same class of purchasers. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted and broad identifications are presumed to encompass all goods of the type described. *See, e.g., Sw. Mgmt., Inc. v.*

Ocinomled, Ltd., 115 USPQ2d 1007, 1025 (TTAB 2015); *In re N.A.D., Inc.*, 57 USPQ2d 1872, 1874 (TTAB 2000).

In this case, the identifications set forth in the application and registration are identical with respect to “cosmetics” and have no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these goods travel in all normal channels of trade, and are available to the same class of purchasers. See *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012). Accordingly, the goods of Applicant and the registrant are considered related for purposes of the likelihood of confusion analysis.

Moreover, Applicant’s various personal care products, incense, and room fresheners are related to registrant’s cosmetics. The record contains third-party website evidence from Chirp, Lush, and Elco¹⁶, showing that the same entity commonly provides cosmetics, incense and room fresheners under the same mark. Additionally, the record contains third party website evidence from Revlon, Orglamix, Bloom and Mary Kay, showing that the same entity commonly provides cosmetics, skin care and fragrance products under the same mark.¹⁷

Therefore, Applicant’s goods are related to registrant’s goods for likelihood of confusion purposes.

III. DOUBT RESOLVED IN FAVOR OF THE REGISTRANT

The overriding concern is not only to prevent purchaser confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. See *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir.

¹⁶ February 26, 2016 Office Action in TSDR at pp. 6-12

¹⁷ October 7, 2016 Office Action in TSDR at pp. 15-46

1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); see *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

IV. CONCLUSION

The applied-for mark and Registrant's mark are similar in sound, appearance, connotation and commercial impression and Applicant's goods are related to Registrant's goods. Additionally, Registrant's mark is not weakened by third party use. Therefore, consumers are likely to be confused as to the source of the goods.

In light of the foregoing, the examining attorney respectfully requests that the Board affirm the refusal to register the applied-for mark under Section 2(d) of the Trademark Act.

Respectfully submitted,

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