

ESTTA Tracking number: **ESTTA846678**

Filing date: **09/18/2017**

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

Proceeding	86847381
Applicant	FabFitFun, Inc.
Applied for Mark	I'M SMOKING HOT
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Submission	Reply Brief
Attachments	REPLY BRIEF IM SMOKING HOT.pdf(247033 bytes)
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

<p>In re Application of:</p> <p style="text-align: center;">FabFitFun, Inc.</p> <p>Serial No: 86/847,381</p> <p>Filed: December 13, 2015</p> <p>Class: 3</p> <p>Mark: I'M SMOKING HOT</p>	<p>Examining Attorney:</p> <p style="text-align: center;">Nicole Passman</p> <p>Law Office: 125</p> <p>APPLICANT'S REPLY BRIEF</p>
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Pursuant to TMBP § 1203.02(c), Applicant FabFitFun, Inc. (“Applicant”) submits this reply brief to address certain points in the Examining Attorney’s Brief dated August 29, 2017 (“EA Brief”). For the reasons stated below and in Applicant’s opening brief, the refusal to register of Applicant’s mark I’M SMOKING HOT on the ground that it is likely to be confused with Registration No. 4,883,039 of SMOKIN’ HOT SHOW TIME for use with “Cosmetics; mascara” (the “Cited Mark”), owned by Coty US LLC (“Registrant”), should be reversed.

I. THE REFUSAL TO REGISTER SHOULD BE REVERSED

A. The Examining Attorney Has Not Met Her Burden of Demonstrating That Applicant’s Mark And The Cited Mark Are Confusingly Similar

The Office bears the burden of showing that a mark falls within the statutory bars of Section 2(d). J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (Fourth Ed.) § 19:75 at 19-230. To refuse registration under Section 2(d), the Examining Attorney “must present sufficient evidence and argument that the mark is barred from registration.” *Id.* § 19:128 at 19-383. Here, respectfully, the Examining Attorney has not met her burden.

1. The Marks are Dissimilar in Appearance, Sound, Connotation and Commercial Impression

(a) The Marks are Dissimilar in Appearance

The Examining Attorney argues that Applicant's mark I'M SMOKING HOT is practically identical to the Cited Mark SMOKIN' HOT SHOW TIME because the terms SMOKING HOT in Applicant's mark and SMOKIN' HOT in the Cited Mark are the "dominant elements" of the respective marks. (EA Brief at 3.) The Examining Attorney states that the dominant element in the Cited Mark is SMOKIN' HOT because those words "appear at the beginning" of the mark. *Id.* On that logic, the dominant element of Applicant's mark should be I'M, because I'M appears at the beginning of Applicant's mark. However, the Examining Attorney dismisses the location of I'M and contends that SMOKING HOT is the dominant element of Applicant's mark, rather than I'M, because "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." *Id.* The cases cited by the Examining Attorney to support this contention are distinguishable from this case.

In *Hot Stuff Foods, LLC v. Obsidian Group Inc.*, 2008 TTAB LEXIS 673 (TTAB Feb. 21, 2008) (non-precedential), the Board held that HOT STUFFED in the applicant's mark WE'RE HOT STUFFED! (Stylized) was the dominant element and similar to the dominant element HOT STUFF in the registrant's marks HOT STUFF FOODS, HOTT STUFF PIZZA, HOT STUFF FOOD ON THE GO and HOT STUFF PIZZERIA. *Hot Stuff Foods*, 2008 TTAB LEXIS 673 at *13. The reason that the Board found HOT STUFFED! the dominant element in the applicant's mark rather than WE'RE was because the word HOT in the applicant's stylized mark was displayed in larger font, and the word STUFFED included an exclamation mark, thus emphasizing those words more than WE'RE. *Id.* at *13-14. The Board also found HOT STUFF the dominant element in the registrant's mark because the remaining words in the registrant's marks were descriptive and thus less source-identifying for registrant's goods and services. *Id.* at *13. Here, Applicant's mark does not contain any font or design elements that emphasize

SMOKING HOT over I'M in Applicant's mark, and the words SHOW TIME in the Cited Mark are not descriptive or suggestive of Registrant's goods.

In *In re Kurek*, 2012 TTAB LEXIS 257 (TTAB June 26, 2012) (also non-precedential), the Board found the applicant's mark DON'T CARE SPORTS WEAR similar to the registrant's mark IDC I DON'T CARE WEAR. *In re Kurek*, 2012 TTAB LEXIS 257 at *6. In that case, the Board stressed that the "syntactic sequence DON'T CARE followed by WEAR" was the significant similarity between the marks. *Id.* In contrast, Applicant's mark I'M SMOKING HOT and the Cited Mark SMOKIN' HOT SHOW TIME do not share a similar syntactic sequence because SMOKING HOT in Applicant's mark is preceded by the additional wording I'M, whereas SMOKIN' HOT in the Cited Mark is succeeded with the additional wording SHOW TIME. The syntactic sequences of the respective marks are completely different. Furthermore, the Board noted that the pronoun "I" in the applicant's mark was "not a significant addition to the overall *sound* of the mark." *Id.* The Board did not discuss the visual *appearance* of the pronoun.

The remaining cases cited by the Examining Attorney involve the pronoun "it" rather than the personal pronoun "I" and are thus distinguishable on this basis. *In re Johnson*, 2013 TTAB LEXIS 177 (TTAB Apr. 2, 2013) (non-precedential) (IT'S JUST A CANDLE & Design vs. JUST CANDLES); *Patrón Spirits Intl. AG v. Peter Noyes*, Opposition No. 91215615 (TTAB October 28, 2016) (non-precedential) (IT'S PYRAT TIME vs. PYRAT); *In re Three Chefs Corp.*, 175 USPQ (TTAB 1972) (IT'S WISHBONE SWEET vs. WISHBONE). The latter two cases do not substantively discuss the pronoun "it".

More importantly, as conceded by the Examining Attorney in discussing the words "Smokin' Hot" and "Smoking Hot", those words are suggestive of the products to be offered under Applicant's mark and those sold under the Cited Mark. The extensive third party use (whether classified as technical trademark use or promotional use) also supports this conclusion. The words SHOW TIME are arbitrary when used for Registrant's mark and are therefore, the

dominant words in the mark. Applicant's mark does not have any dominant part because it is a complete sentence that must be considered as a whole and not dissected.

Even if the term I'M in Applicant's mark is entitled to less weight, which it is not, the wording SHOW TIME has been improperly discounted in the Examining Attorney's analysis of the marks. *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1341 (Fed. Cir. 2015) (“While the Board may properly afford more or less weight to particular components of a mark for appropriate reasons, it must still view the mark as a whole.”), citing *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985). The Examining Attorney has failed to account for the significant addition of the arbitrary words SHOW TIME in the Cited Mark, which are entitled to more weight (or at least equal) in a comparison of the marks. Applicant submitted evidence of record that “Show time” means a time when a particular event, especially an entertainment event, is scheduled to begin. (April 14, 2017, Request for Reconsideration, TSDR Ex. L.) The wording SHOW TIME in the Cited Mark is certainly not generic or descriptive or even suggestive of Registrant's cosmetics and mascara products. Yet the Examining Attorney focused her attention on the SMOKIN' HOT element of the Cited Mark when comparing the marks. The addition of SHOW TIME to SMOKIN' HOT lends a completely different appearance to the Cited Mark than Applicant's mark.

(b) The Marks are Dissimilar in Sound

The Examining Attorney contends that I'M SMOKING HOT and SMOKIN' HOT SHOW TIME are similar in sound, because SMOKING in Applicant's mark and SMOKIN' in the Cited Mark are “phonetically identical and thus are indistinguishable when spoken.” (EA Brief at 7.) Applicant has previously discussed the phonetic differences between SMOKING and SMOKIN'. (Appeal Brief at pp. 12-13.) The Examining Attorney failed to address the differences in sound based on the marks as a whole. Consumers see the respective trademarks as I'M SMOKING HOT and SMOKIN' HOT SHOW TIME. The terms I'M in Applicant's mark and the distinct wording SHOW TIME in the Cited Mark have no similarity in sound, nor do the marks as a whole.

(c) The Marks are Dissimilar in Connotation and Commercial Impression

The Examining Attorney contends that Applicant's mark and the Cited Mark are similar in connotation and commercial impression because SMOKING HOT in Applicant's mark and SMOKIN' HOT in the Cited Mark both convey an impression of sexiness, allure and beauty. (EA Brief at 9.) In doing so, the Examining Attorney concedes that these words, when used for cosmetics, are suggestive. The Examining Attorney again discounts the additional wording I'M in Applicant's mark based on the same reasoning set forth in the Examining Attorney's visual comparison of the marks. (EA Brief at 10.) The Examining Attorney also discounts the additional wording SHOW TIME in the Cited Mark "especially because this wording appears last in the mark." *Id.* Applicant has submitted evidence of record that "Show time" means a time when a particular event, especially an entertainment event, is scheduled to begin. These words have no connection to cosmetics and are therefore arbitrary. As a result, the wording SHOW TIME is likely to have the more impact on consumers than the words SMOKIN' HOT of the Cited Mark.

The Examining Attorney takes a different tack and argues:

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.

(EA Brief at 10.)

This is conjecture. The words SHOWTIME have nothing to do with looking sexy or feeling confident. They instead connote the state of being ready for an event.

The Examining Attorney's analysis does not explain how Applicant's mark I'M SMOKING HOT conveys an impression that a user "will be ready for anything" or that Applicant's mark conveys the impression that "spotlights can appear" once a user applies the products. These impressions are not conveyed by Applicant's mark because Applicant's mark

lacks the wording SHOW TIME. In other words, the notion of an event or a moment in time experienced by a consumer, as suggested by the Examining Attorney, is completely lacking in Applicant's mark. Instead, Applicant's mark is a complete sentence about how a consumer may believe she looks when using Applicant's products.

In sum, the Examining Attorney has failed to demonstrate that I'M SMOKING HOT and SMOKIN' HOT SHOW TIME are similar in appearance, sound, connotation or commercial impression.

B. The Cited Mark is Weak Because Numerous Other SMOKIN' HOT Marks Exist

Applicant submitted 16 examples of third party use of SMOKING HOT. (See Summary thereof in Applicant's Appeal Brief, pp.19-20). The Examining Attorney contends that more than half of the evidentiary references are irrelevant because they (1) allegedly do not use SMOKING HOT as a trademark, (2) offer products or services that are not cosmetics or cosmetics-related, (3) advertise products to be available for sale in two weeks, (4) advertise products that are currently unavailable, (5) are based outside the US, or (6) merely constitute advertising because they do not offer a means to purchase the goods. (EA Brief at 13-15.)

In doing so, the Examining Attorney improperly discounted the third party references of use. The Examining Attorney states that *Juice Generation* and *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. v. New Millennium Sports, S.L.U.*, 797 F.3d 1363 (Fed. Cir. 2015) involved much more extensive evidence of third party use than Applicant's evidence of use. (EA Brief at 15.) However, those cases did not discuss the specifics of the third party use, including whether the references constituted advertisements, needed to feature a means to purchase the goods, needed to show technical trademark use, or whether the references could not be considered because they featured about-to-be-launched products or out-of-stock products. Further, the Federal Circuit in *Juice Generation* and *Jack Wolfskin* did not set a minimum number of third party uses that must be submitted to be considered. Thus, the Examining Attorney's reasoning for discounting most of Applicant's third party uses is unsupported by the

binding authority. At most, if the two third party references comprising non-U.S. websites¹ and the two third party references advertising non-cosmetics goods and services² are not considered, that still leaves more than ten third party uses of SMOKING HOT for cosmetics products.

Applicant's evidence of third party use shows, at the very least, that beauty products in the cosmetics and beauty products industry have come to use the term extensively on similar goods for its suggestive meaning, thus weakening the strength of the Cited Mark. *See New Millennium Sports*, 797 F.3d at 1373-74; *Juice Generation*, 794 F.3d at 1338-40.

The Examining Attorney also erred in concluding that Applicant's evidence of third party use does not demonstrate public awareness of third party use. (EA Brief at 17.) The Examining Attorney contends that Applicant failed to submit evidence such as "actual sales of the third party marks, when each mark was adopted or customer familiarity with the marks." (EA Brief at 16), citing *Spin Concepts, Inc. v. Capital Rest. Group, Inc.*, 2015 TTAB LEXIX 174 (TTAB June 3, 2015) (non-precedential) (citing *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1798 (TTAB 2002)). The Examining Attorney argues that Applicant should go even further and must submit evidence of the identity of individuals behind the "likes" on social media, the geographic location of these individuals, whether items that are "liked" were ever purchased, and whether any of the "likes" originated from fake profiles.³ (EA Brief, p. 15). The

¹ Printout from the UK website for online auction site eBay selling "Maybelline SMOKIN' HOT Mascara Eyeliner Color Tattoo Xmas Gift Set for Her/Women" (September 26, 2016, Office Action Response at Ex. M); and Printout from the UK website for online retailer Amazon.com advertising "Barry M Cosmetics Eyeshadow Palette, Smokin Hot" (September 26, 2016, Office Action Response at Ex. N). However, Maybelline was a U.S. based company and is now owned by the U.S. arm of L'Oreal. Therefore it is highly unlikely that Maybelline's SMOKIN HOT mascara was only in the U.K.

² Printout from social media site Facebook for an online makeup, clothing, jewelry and accessories company called "Smokin Hot Makeup" located in Paris, Texas (September 26, 2016, Office Action Response at Ex. L); and third party use evidence for mark SMOKING HOT MOM (April 14, 2017, Request for Reconsideration, at Ex. I).

³ Specifically for the printout from social media site Facebook for the online makeup, clothing, jewelry and accessories company called "Smokin Hot Makeup" located in Paris, Texas (September 26, 2016, Office Action Response, TSDR at Ex. L), the Examining Attorney stated that the evidence of 3,500 "likes" was irrelevant because the number was low, and that Applicant failed to provide information on (i) the identity of the individuals behind the 3,500 likes, (ii) how many of these likes originate from US-

Examining Attorney also argues that Applicant must prove whether the social media pages containing the third party uses are maintained, regularly updated, the number of followers of the pages, and if links on the pages are functioning.⁴ The Examining Attorney cites no authority for these requirements placed on Applicant. Quite the contrary, the Federal Circuit has already rejected the argument that the applicant must prove specifics regarding the extent of sales or promotional efforts surrounding third party marks and what impact the uses have made in the minds of the purchasing public. *Juice Generation*, 794 F.3d at 1339.

Ultimately, the Examining Attorney argued:

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.

(EA Brief at 17.)

Applicant has no ownership or control over any of these third parties, and thus obtaining information such as how often a third party's social media page is updated or maintained, and the amount of sales made on each website, is unduly burdensome and overreaching, and realistically could only be obtained by a subpoena issued in an inter parties proceeding or court action. Furthermore, information such as "the identity of the individuals behind the 3,500 likes" on a third party's social media page is difficult to obtain, if not illegal without proper authorization. *Juice Generation* and *Jack Wolfskin* merely stated that the applicants in question had submitted evidence of third party use, but did not discuss the specifics of such evidence, and certainly do not require of Applicant the information identified by the Examining Attorney.

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". (EA Brief at 15.)

⁴ For the printout for SMOKIN' HOT BY ESSIE (April 14, 2017, Request for Reconsideration, TSDR Ex. A) and the printout for Smokin' Hot Mom (April 14, 2017, Request for Reconsideration, TSDR Ex. I), the Examining Attorney stated that Applicant did not submit evidence whether the social media for these websites are (i) maintained, (ii) regularly updated, (iii) how many "followers" these entities may have on these social media pages, if any, or (iv) even if these links are functioning at all. (EA Brief at 16.)

Notwithstanding, Applicant directs the Board's attention to the U.S. Amazon website printouts submitted by Applicant. The Amazon website printout for E.L.F. NAIL POLISH, SMOKIN HOT, 0.34 FLUID OUNCE indicates in the upper left hand corner near the product title that the product received at least 34 customer reviews. (April 14, 2017, Request for Reconsideration, TSDR Ex. D). The Amazon website printout for L.A. GIRL INSPIRING EYESHADOW PALETTE, YOU'RE SMOKIN' HOT!, 0.21 OUNCE indicates in the upper left hand corner near the product title that the product received at least 6 reviews. (April 14, 2017, Request for Reconsideration, TSDR Ex. E) The Amazon.com website printout for the (then currently unavailable) "Too Faced SMOKIN HOT LASHES – Mascara & Eyeliner Set" indicates in the upper left hand corner near the product title that it received one customer review in 2013 and displays the customer review further down below. (September 26, 2016, Office Action Response, TSDR Ex. K). The Too Faced SMOKIN HOT LASHES customer reviewer stated, "I was really really excited to try this mascara but even using all of the pro-tips and applying multiple layers doesn't work. I get better results from the other brands I've tried. I wouldn't recommend this product to anyone." *Id.*

The evidence that customers reviewed these third party products is evidence of public awareness of the subject third party use. Consumers could not write or post a review without knowing of the product reviewed. By way of example, the Too Faced SMOKIN HOT LASHES customer reviewer expressly stated that she was excited about trying "this" mascara" and that she has tried "other brands". *Id.* This indicates that customers are familiar with and exposed to various third party uses of a term through retail websites such as the ones that Applicant has submitted.

In sum, Applicant's evidence of third party use demonstrates that the Cited Mark is weak and not entitled to a wide scope of protection, and further that the words "Smokin' Hot" are suggestive of cosmetic products. This weighs in favor of a finding of no likelihood of confusion with the Cited Mark.

II. CONCLUSION

For the above reasons, Applicant requests the Board to reverse the decision of the Examining Attorney refusing registration of Applicant's mark on the basis that it is likely to be confused with the Cited Mark. Applicant is filing concurrently herewith an Amended Request for Oral Argument on this appeal.

Respectfully submitted,

Dated: September 18, 2017

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CERTIFICATE OF ELECTRONIC FILING

I hereby certify that **APPLICANT'S REPLY BRIEF** is being submitted electronically to: Commissioner for Trademarks, Attn: Trademark Trial and Appeal Board, through ESTTA pursuant to 37 C.F.R. §2.195(a), on this 18th day of September, 2017.

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SMRH:484079752.1