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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
Correspondence Address	JILL M PIETRINI SHEPPARD MULLIN RICHTER & HAMPTON LLP 1901 AVENUE OF THE STARS, SUITE 1600 LOS ANGELES, CA 90067 UNITED STATES Email: jpietrini@smrh.com, baigboboh@smrh.com, ppost@smrh.com, shwang@smrh.com, mherrera@smrh.com, mdanner@smrh.com, rwalsh@smrh.com, lmartin@smrh.com
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Filer's Name	Jill M. Pietrini
Filer's email	jpietrini@smrh.com, baigboboh@smrh.com, ppost@smrh.com, shwang@smrh.com, mherrera@smrh.com, mdanner@smrh.com, rwalsh@smrh.com, lmartin@smrh.com
Signature	/Jill M. Pietrini/
Date	06/26/2017

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: FabFitFun, Inc. Serial No: 86/847,381 Filed: December 13, 2015 Class: 3 Mark: I'M SMOKING HOT	Examining Attorney: Leslie Friedman Law Office: 120 APPLICANT'S APPEAL BRIEF
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Commissioner for Trademarks
Attn: Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Commissioner:

Applicant FabFitFun, Inc. ("Applicant") hereby submits this brief in support of its appeal of the Examining Attorney's refusal to register Applicant's mark under Section 2(d) of the Lanham Act.

I. PRELIMINARY STATEMENT

Applicant seeks registration of its trademark I'M SMOKING HOT for beauty products in International Class 3. Pursuant to a Notice of Appeal filed on April 10, 2017, Applicant appealed the final refusal by the Examining Attorney whereby she refused registration of Applicant's mark on the grounds that Applicant's mark is likely to be confused with Registration No. 4,883,039 for SMOKIN' HOT SHOW TIME for use with "Cosmetics; mascara" in Class 3 (the "Cited Mark"), owned by Coty US LLC ("Registrant").

Applicant's mark is not likely to be confused with the Cited Mark because (1) the marks are not similar in appearance, sound, connotation or commercial impression, and (2) the Cited Mark is weak and diluted due to the number of similar marks in use for similar goods as those of Registrant.

II. STATEMENT OF FACTS

For the Board's convenience, the facts are summarized below.

A. Information About Applicant

Applicant's primary business consists of a personal subscription service, in which subscription members receive a seasonal gift box of carefully selected, new and innovative cosmetics, personal care products, and home products. (September 26, 2016, Office Action Response, TSDR Ex. A.) Applicant has branched out from its subscription services to launch its own line of cosmetics and beauty products, including its ISH makeup line. (*Id.* at Ex. B.) Applicant's mark ISH is an acronym for the phrase "I'M SMOKING HOT". (*Id.* at Ex. C.)

B. Procedural Background

On December 13, 2015, Applicant applied to register I'M SMOKING HOT for "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 on an intent-to-use basis.

On March 31, 2016, the Examining Attorney issued an Office Action citing the Cited Mark as a bar to registration. The Examining Attorney also required an amendment to the identification of goods. Applicant responded to the Office Action on September 26, 2016, amending its identification of goods and arguing against the 2(d) refusal.

On October 11, 2016, the Examining Attorney issued a Final Office Action in which she accepted Applicant's amendments, but continued the refusal to register based on a likelihood of confusion with the Cited Mark. The Examining Attorney argued that Applicant's mark and the Cited Mark are substantially similar, the goods offered thereunder are the same and/or related, and the trade channels are the same in that neither Applicant's application nor the cited registration contains any limitations.

Applicant did not, and does not, agree with the position taken by the Examining Attorney, and as such, on April 14, 2017, filed a Notice of Appeal of the final refusal. On that same day, Applicant also filed a Request for Reconsideration, arguing that there is no likelihood of confusion because Applicant's mark and the Cited Mark are dissimilar in the entirety in appearance, sound, connotation and commercial impression and the narrow scope of protection that should be afforded the Cited Mark. In support of Applicant's arguments, in both the Office Action Response and Request for Reconsideration, Applicant attached printouts of:

- (1) Applicant's website at <fabfitfun.com> (September 26, 2016, Office Action Response, TSDR Ex. A);
- (2) Applicant's website at <fabfitfun.com> and <ishbeauty.com> about Applicant's ISH makeup products (*Id.* at Ex. B);
- (3) Applicant's website at <ishbeauty.com> stating, "Show us why you're smoking hot and tag @imsmokinghot & #IMSMOKINGHOT for a chance to win amazing ISH" (*Id.* at Ex. C);
- (4) Online retailer Amazon.com advertising Registrant's SHOW TIME mascara (*Id.* at Ex. D);

- (5) Registrant's specimen of use for Reg. No. 4,883,039 (*Id.* at Ex. E);
- (6) An online blog at <makeupandbeauty.com> showing a review of Registrant's SMOKIN' HOT SHOW TIME mascara (*Id.* at Ex. F);
- (7) The registration certificates and TESS printouts of at least 19 SMOKING HOT and SMOKIN' HOT marks registered for a variety of goods and services (*Id.* at Ex. G);
- (8) An online post from <bobbibrowncosmetics.com> advertising cosmetic company for Bobbi Brown's smokey eye mascara and entry for "Are You #SmokingHot?" sweepstakes (*Id.* at Ex. H);
- (9) Online magazine <vibe.com> announcing "MAC Cosmetics Launches Smoking Hot Temperature Rising Collection" (*Id.* at Ex. I);
- (10) Online retailer <drugstore.com> advertising cosmetic company Wet n Wild's lipstick called "Wet n Wild MegaLast Lip Color, Smokin' Hot Pink 90SD 0.11 oz (3.3 g)" (*Id.* at Ex. J);
- (11) Online retailer <amazon.com> advertising cosmetic company Too Faced's lipstick called "Too Faced SMOKIN HOT LASHES – Mascara & Eyeliner Set" (*Id.* at Ex. K);
- (12) Social media site Facebook for an online makeup, clothing, jewelry and accessories company called "Smokin Hot Makeup" located in Paris, Texas (*Id.* at Ex. L);
- (13) The UK website for online auction site eBay selling "Maybelline SMOKIN' HOT Mascara Eyeliner Color Tattoo Xmas Gift Set for Her/Women" (*Id.* at Ex. M);
- (14) The UK website for online retailer Amazon.com advertising "Barry M Cosmetics Eyeshadow Palette, Smokin Hot" (*Id.* at Ex. N);
- (15) Third party use evidence for mark SMOKIN' HOT BY ESSIE (April 14, 2017, Request for Reconsideration, TSDR (Ex. A);
- (16) Third party use evidence for mark LAYER'R SHOT DEODRANT, SMOKIN HOT, 135ML (*Id.* at Ex. B);
- (17) Third party use evidence for mark BARE ESCENTUALS EYE SHADOW - MINI SIZED 0.01OZ/0.28GRAMS (SMOKIN' HOT) (*Id.* at Ex. C);
- (18) Third party use evidence for mark E.L.F. NAIL POLISH, SMOKIN HOT, 0.34 FLUID OUNCE (*Id.* at Ex. D);

- (19) Third party use evidence for mark L.A. GIRL INSPIRING EYESHADOW PALETTE, YOU'RE SMOKIN' HOT!, 0.21 OUNCE (*Id.* at Ex. E);
- (20) Third party use evidence for mark FACES ULTIME PRO MATTE LIP CRAYON SMOKIN' HOT 11 2.8 GM (*Id.* at Ex. F);
- (21) Third party use evidence for mark E.L.F SUPER GLOSSY LIP SHINE .35 OZ/10 G SMOKIN' HOT (*Id.* at Ex. G);
- (22) Third party use evidence for mark POP BEAUTY SMOKIN' HOT EYESHADOW TRIO (*Id.* at Ex. H);
- (23) Third party use evidence for mark SMOKING HOT MOM (*Id.* at Ex. I);
- (24) *Oxford Dictionary* website <oxforddictionaries.com> displaying the definition of “I” (*Id.* at Ex. J);
- (25) *Oxford Dictionary* website <oxforddictionaries.com> displaying the definition of “AM” (*Id.* at Ex. K); and
- (26) *American Heritage Dictionary* website <ahdictionary.com> displaying the definition of “showtime” (*Id.* at Ex. L).

On April 21, 2017, the Examining Attorney denied Applicant’s Request for Reconsideration. The Examining Attorney stated that Applicant’s analysis and arguments were not persuasive nor did they shed new light on the issue. The Examining Attorney stated that she found Applicant’s submission of third party uses as evidence of the Cited Mark’s weakness entitled to little weight and a collateral attack on the registration (which it was not), and Applicant’s arguments as to the differences between the marks, the goods, and trade channels unpersuasive and of limited probative value.

The Examining Attorney’s refusal to register I’M SMOKING HOT is solely and exclusively based on the Examining Attorney’s contention that Applicant’s mark is likely to be confused with the Cited Mark. Accordingly, the only issue raised by this appeal is whether Applicant’s I’M SMOKING HOT mark is likely to be confused with the Cited Mark.

III. THE REFUSAL TO REGISTER SHOULD BE REVERSED

The refusal to register Applicant's mark should be reversed for the reasons set forth below.

A. The Standard for Determining Whether There is a Likelihood of Confusion

In determining whether a mark should be refused registration under Section 2(d), the Board must determine whether the mark at issue is likely to be confused with the Cited Mark. The following factors are to be considered by the Board in determining the issue of likelihood of confusion in an *ex parte* appeal of a final Section 2(d) refusal:

1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression.
2. The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
3. The similarity or dissimilarity of established, likely-to-continue trade channels.
4. The conditions under which and buyers to whom sales are made, i.e., "impulse" vs. careful, sophisticated purchasing.
5. The fame of the prior mark (sales, advertising, length of use).
6. The number and nature of similar marks in use on similar goods.
7. The nature and extent of any actual confusion.
8. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
9. The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).

10. The market interface between applicant and the owner of a prior mark:
(a) a mere “consent” to register or use; (b) agreement provisions designed to preclude confusion, i.e., limitations on continued use of the marks by each party; (c) assignment of mark, application, registration, and goodwill of the related business; and (d) laches and estoppel attributable to the owner of prior mark and indicative of lack of confusion.

11. The extent to which applicant has a right to exclude others from use of its mark on its goods.

12. The extent of potential confusion, i.e., whether de minimus or substantial.

13. Any other established fact probative of the effect of use.

In re E.I. Du Pont de Nemours & Co., 177 USPQ 563, 567 (CCPA 1973).

The *Du Pont* factors are not listed in order of merit. *Du Pont*, 177 USPQ at 567; *Kellogg Co. v. Pack’Em Enterprises, Inc.*, 951 F.2d 330, 333 (Fed. Cir. 1991). Each case must be decided on its own facts, taking into account those *Du Pont* factors that are most relevant to the particular case. *Du Pont*, 177 USPQ at 567. Clearly a fact-intensive inquiry, “[l]ikelihood of confusion . . . is an ultimate conclusion which must be reached on all the circumstances of the case at bar.” *Bongrain International (American) Corporation v. Delice de France, Inc.*, 811 F.2d 1479, 1486 (Fed. Cir. 1987). Accordingly, the Board has stated that “trademark law must necessarily be flexible responding to particular circumstances disclosed by particular fact circumstances.” *In re Sydel Lingerie Co., Inc.*, 197 USPQ 629, 630 (TTAB 1977).

The relevant *Du Pont* factors as applied to the pertinent facts support Applicant’s position that there is no likelihood of confusion between Applicant’s mark and the Cited Mark.

B. There is No Likelihood of Confusion Between Applicant's Mark and the Cited Mark

1. The Marks Are Dissimilar in Appearance, Sound, Connotation or Commercial Impression

When determining whether marks are similar, it is important to compare the marks in their entireties “as to appearance, sound, connotation and commercial impression.” *Du Pont*, 177 USPQ at 567. It is axiomatic that “likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark.” *See In re National Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985). The Examining Attorney’s finding that Applicant’s mark and the Cited Mark are substantially similar not only fails to compare Applicant’s mark and the Cited Mark in their entireties, but also fails to appreciate the significant differences in appearance, sound, connotation and commercial impression between the marks.

(i) The Marks are Dissimilar in Appearance

The Examining Attorney first erred by improperly dissecting the Cited Mark SMOKIN’ HOT SHOW TIME and only focusing on the SMOKIN’ HOT element when comparing it to Applicant’s mark I’M SMOKING HOT. *See Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242 (Fed. Cir. 2004). The Examining Attorney stated that Applicant’s mark and the Cited Mark are similar simply because they share the component SMOKIN’ HOT. (April 21, 2017 Reconsideration Letter, TSDR ps. 1-2.) It is not enough, however, to simply note that Applicant’s mark shares a component with the Cited Mark. It has long been recognized that marks must be compared in their entireties to determine likelihood of confusion, because likelihood of confusion depends on the overall impression of the marks. Thus, marks should not be dissected, and no feature of a mark should be ignored. *In re Hearst Corp.*, 982 F.2d 493, 494 (Fed. Cir. 1992), *reh'g en banc denied*, 1993 U.S. App. LEXIS 7705 (Fed. Cir. Apr. 7, 1993) (“Marks tend to be perceived in their entireties, and all components thereof must be given

appropriate weight.”). *See Murray Corp. of America v. Red Spot Paint & Varnish Co.*, 280 F.2d 158, 161 (CCPA 1960) (“[A]lthough appellee’s mark embodies appellant’s entire mark, when considering those marks in their entirety, as we must . . . we are of the opinion that the likelihood of confusion, mistake or deception contemplated by Section 2(d) of the Lanham Act does not exist.”); *see also General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627 (8th Cir. 1987) (“The use of identical, even dominant, words in common does not automatically mean that two marks are similar.”); *Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545-46 (1920) (“The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail.”).

For example, in *Shen Mfg.*, the Federal Circuit affirmed the Board’s holding that RITZ and PUTTING ON THE RITZ were not confusingly similar, because when properly considered in their entirety, “[t]he two marks also differ in terms of sound and appearance [and the applicant’s] mark contains other words in addition to ‘Ritz,’ making both its visual appearance and pronunciation longer.” 393 F.3d at 1242-43. The Federal Circuit disagreed with the opposer’s contention that RITZ was the only relevant elements of the respective marks. *Id.* at 1242.

In that same vein, Applicant’s mark I’M SMOKING HOT is different in visual appearance from the Cited Mark SMOKIN’ HOT SHOW TIME. Applicant’s mark contains the term I’M and does not contain any additional subject matter like the Cited Mark. For example, the Cited Mark contains the additional language SHOW TIME as well as a prominent apostrophe to make the word “SMOKIN’ colloquial which, like in *Shen Mfg.*, makes the “visual appearance . . . longer.” Even if the apostrophe and truncation of SMOKIN’ were not present, when focusing on the words themselves it is clear that the Examining Attorney’s cursory conclusion

that the respective marks are “substantially similar” failed to take these striking and prominent differences into account. The only common element between Applicant’s mark I’M SMOKING HOT and the Cited Mark SMOKIN’ HOT SHOW TIME is the terms SMOKING HOT and SMOKIN’ HOT. In contrast to the Cited Mark, Applicant’s mark contains the contraction I’M and spells the word SMOKING properly as “smoking”. As noted, the Cited Mark spells “smoking” as SMOKIN’. The Cited Mark does not contain I’M, but instead, contains the words SHOW TIME. . These are significant differences that render Applicant’s mark and the Cited Mark visually distinguishable. Courts have consistently held that minor differences in spelling can render marks sufficiently distinguishable from each other. *Fancaster v. Comcast*, 832 F. Supp.2d 380, 412 (D.N.J. 2011) (no likelihood of confusion between FANCASTER and FANCAST); *Colgate-Palmolive V. JMD All-Star Import*, 486 F. Supp.2d 286, 290-91 (S.D.N.Y. 2007) (no likelihood of confusion between COLGATE and COLDDATE); *Echo Drain v. Newsted*, 307 F. Supp.2d 1116, 1126 (C.D. Cal. 2003) (no likelihood of confusion between ECHODRAIN and ECHOBRAIN); *Icebreaker Ltd. v. Gilmar S.P.A.*, 911 F. Supp.2d 1099 (D. Or. 2012) (no likelihood of confusion between ICEBREAKER and ICEBERG); *Medi-Flex, Inc. v. Nice-Pak Products, Inc.*, 422 F. Supp.2d 1242 (D. Kan. 2006) (no likelihood of confusion between CHLORAPREP and CHLORASCUB); *Nature's Best, Inc. v. Ultimate Nutrition, Inc.*, 323 F. Supp.2d 429 (E.D.N.Y. 2004) (no likelihood of confusion between ISOPURE and ISOPREME). Thus, the word I’M (standing for I AM) in Applicant’s mark and the words SHOW TIME in the Cited Mark are entitled to equal consideration and weight as SMOKING HOT and SMOKIN’ HOT. Notably, I’M and SHOW TIME are not descriptive of the respective goods.

The Examining Attorney erred, by seemingly discounting Applicant's argument that the apostrophe, truncation of SMOKIN', and additional words in the Cited Mark makes the mark distinguishable from Applicant's mark. (*See* October 11, 2016, Office Action, TSDR p. 3-4.) As to the appearance of the marks, the Examining Attorney admits that Applicant's mark and the Cited Mark have "apparent differences" when viewed together. (*Id.* at 5.) This is because they are clearly different in appearance. However, the Examining Attorney's refusal to consider the additional words and different spellings of "smoking" in the respective marks ignores how consumers will view the respective marks. The Examining Attorney minimizes these differences and again dissects the marks to find a likelihood of confusion. (*See generally id.*) However, if the marks truly are in same "trade channels" as the Examining Attorney argues, then a consumer who sees the two marks in the marketplace, which appear dramatically and substantially different in appearance, would plainly conclude that the goods come from distinct sources. The impact of the appearance portion of the mark, both semantically and from a visual perspective, is that they are, in fact, distinguishable.

Thus, as the Examining Attorney herself concedes, the marks are different in appearance.

(ii) The Marks are Dissimilar in Sound

The Examining Attorney also erred by dismissing the significant differences in sound between Applicant's mark I'M SMOKING HOT and the SMOKIN' HOT SHOW TIME mark. (*Id. See also* March 31, 2016, Office Action; April 21, 2017, Reconsideration Letter.) Instead, the Examining Attorney limits her focus to two words (which are not even spelled the same), and minimizes the two other words used in the Cited Mark. (*See id.*) The TMEP stresses that "[s]imilarity of the marks in one respect – sight, sound or meaning – will not automatically result in a finding of likelihood of confusion even if the goods are identical or closely related." TMEP § 1207.01(b)(i). Furthermore, comparison of the similarity or dissimilarity of the marks must be

done “in their entirety.” See *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329 (Fed. Cir. 2000); *Al-Site Corp. v. VSI International, Inc.*, 174 F.3d 1308, 1330 (Fed. Cir. 1999) (comparing the number of syllables and the number of letters in MAGNAVISION and MAGNA.DOT to conclude that the marks created different commercial impressions).

The Examining Attorney improperly gave insufficient weight to the SHOW TIME portion of the Cited Mark and the contraction of “smoking” to “smokin”, which, when they are properly considered, means that I’M SMOKING HOT and SMOKIN’ HOT SHOW TIME are not phonetic equivalents and clearly have significant aural differences. Applicant’s mark is I’M SMOKING HOT, consisting of only four syllables, while the Cited Mark is SMOKIN’ HOT SHOW TIME, consisting of *five* syllables and the significant addition of the totally different sounding words SHOW TIME and SMOKIN. *Shen Mfg.*, 393 F.3d at 124243 (RITZ and PUTTING ON THE RITZ not confusingly similar because “[t]he two marks also differ in terms of sound and appearance. . . . [the applicant’s] mark contains other words in addition to ‘Ritz,’ making both its visual appearance and *pronunciation longer.*”) (emphasis added).

Nonetheless, the Examining Attorney focuses her analysis on her position that the SMOKING HOT and SMOKIN’ HOT portions of the marks are phonetic equivalents. (March 31, 2016, Office Action, TSDR p. 2.) Even if one allows for the Examining Attorney’s improper dissection of the marks, as the Examining Attorney’s evidence shows, the differences between SMOKING and SMOKIN’ lead to significantly different pronunciations. (October 11, 2016, Office Action, TSDR Attachment ps. 1-5.) The evidence seems to be a printout of a forum where members of the public can give their opinions, much like Yahoo! Answers. This evidence states that “[i]f you are a normal American, then you pronounce words like king, ring, and sing just as they appear . . . [t]here are some dialects of English where the g can barely be heard in

progressives, but in contemporary English this is gone.” (*Id.* at 4.) Given that the Cited Mark and Applicant’s mark are both used in the United States during contemporary times, it is safe to conclude that “normal Americans” will be encountering the marks. Thus, when confronted with these marks in the marketplace, “normal Americans” *will* pronounce the “g” in Applicant’s mark and *will not* make a similar pronunciation in Registrant’s mark, because, simply, the Cited Mark does not contain a “g.” Such differences in pronunciation means that consumers will perceive either mark spoken by another consumer as distinct especially when considering the additional subject matter of I’M and SHOW TIME within the respective marks.

Finally, even if the Board finds that SMOKING HOT and SMOKIN’ HOT are phonetic equivalents, these words are diluted and significantly weakened by the third party use. *See supra* at pp. 19-21.

Therefore, it cannot be said that Applicant’s mark and the Cited Mark are similar in sound and pronunciation.

(iii) The Marks Are Dissimilar in Connotation and Commercial Impression

The Federal Circuit and the Board have repeatedly affirmed the importance of considering a mark’s connotation, meaning, and commercial impression when determining likelihood of confusion and have often found no likelihood of confusion in cases in which the parties’ marks project different overall commercial impressions, despite the existence of a matter common to both marks. *In re Electrolyte Labs., Inc.*, 929 F.2d 645, 646 (Fed. Cir. 1990) (no likelihood of confusion between the applied-for mark K+ and Design and the prior mark K+EFF & Design, both used for a dietary potassium supplement, where the element "K+" is the symbol of the potassium ion and the design portions of the marks are substantially different); *Top Tobacco LP v. North Atlantic Operating Co.*, 101 USPQ2d 1163, 1173 (TTAB 2011); *Red*

Carpet Corp. v. Johnstown American Enterprises Inc., 7 USPQ2d 1404, 1406 (TTAB 1988); *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1076 (TTAB 2011) (no likelihood of confusion between the applied-for mark ZU ELEMENTS and opposer's registered marks ELEMENT and ELEMENTALITY). Indeed, the Board has retreated from the application of “per se” rules regarding confusion, *e.g.*, if the marks are identical and used for what the Board considers to be related goods and services, they are per se confusingly similar. Again, each case must be determined by its own facts. *See id.*

In the case of composite marks, “the fundamental rule in this situation is that the marks must be considered in their entireties.” TMEP §1207.01(c)(ii), *citing Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1371 (Fed. Cir. 2015); *In re Shell Oil Co.*, 992 F.2d 1204, 1206 (Fed. Cir. 1993); *Massey Junior Coll., Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 1402 (CCPA 1974). The comparison of composite marks must be done on a case-by-case basis, without reliance on mechanical rules of construction. For example, in *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, the Court of Customs and Patent Appeals affirmed the Board’s decision that there was no likelihood of confusion between the applied-for mark PEAK PERIOD for personal deodorants and the registered mark PEAK for a dentifrice, stating that, “[w]e agree with the board that the mere presence of the word ‘peak’ in the trademark PEAK PERIOD does not by reason of that fact alone create a likelihood of confusion or deception.” *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432, F.2d 1400, 1402 (CCPA 1970). The mere fact that Applicant’s mark and the Cited Mark share the words SMOKING HOT and SMOKIN’ HOT, respectively, is insufficient to find a likelihood of confusion between the marks.

As mentioned above, Applicant's primary business consists of a personal subscription service, in which subscription members receive a seasonal gift box of carefully selected, new and innovative cosmetics, personal care products, and home products. (September 26, 2016, Office Action Response, TSDR Ex. A.) Applicant has branched out from its subscription services to launch its own line of cosmetics and beauty products, including its ISH makeup line. (*Id.* at Ex. B.) Applicant's mark ISH is an acronym for the phrase "I'M SMOKING HOT" and Applicant's website at <ishbeauty.com> states, "Show us why you're smoking hot and tag @imsmokinghot & #IMSMOKINGHOT for a chance to win amazing ISH." (*Id.* at Ex. C.) Accordingly, Applicant's mark I'M SMOKING HOT conveys the statement "I am sexy". In other words, it projects an impression of sexiness, allure and beauty. The use of I'M in Applicant's mark also focuses the viewer's attention on the self, that is, the individual wearing Applicant's products.

The Cited Mark SMOKIN' HOT SHOW TIME does not convey this meaning. Registrant offers a mascara product called SHOW TIME. (*Id.* at Ex. D.) Registrant uses its mark SMOKIN' HOT SHOW TIME for a mascara product that offers extra volumizing power as shown in its specimen of use. (*Id.* at Ex. E.) The specimen shows the words SMOKIN' HOT above the words SHOW TIME and the words "Volumizing Mascara" next to SHOW TIME, along with the house brand NYC (which stands for New York City where Registrant is located). Thus, the house brand is NYC; SHOW TIME is the brand name; and SMOKIN' HOT is the style name for one of the products in the SHOW TIME line of products. Furthermore, the words "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.) Applicant's mark I'M SMOKING HOT does not convey any association with a scheduled event or an entertainment event. Thus, the commercial impression conveyed by Registrant's mark is for a

mascara called SHOW TIME, 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. This is not the connotation and commercial impression of Applicant's mark. *See Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107, 1108 (CCPA 1972) (no likelihood of confusion between the applied-for mark ALL CLEAR! and the registered mark ALL, both for household cleaning products).

Despite the clear differences in connotation and commercial impression between Applicant's mark and the Cited Mark, the Examining Attorney has continued her refusal to register the mark. For example, the Examining Attorney stated in the October 11, 2016 Office Action:

Here, applicant's mark does begin with I'M, but consumers would not see I'M as highly source indicating. Indeed, I'M, much like possessive pronouns, e.g., MY, YOUR, or basic articles, such as A or THE, is there simply to as [sic] a carrier for the rest of the mark. These types of idiomatic prefixes do not significantly change the meaning or impression of the overall mark. *See In re Thor Tech Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009) (finding WAVE and THE WAVE "virtually identical" marks; "[t]he addition of the word 'The' at the beginning of the registered mark does not have any trademark significance."); *In re Narwood Prods. Inc.*, 223 USPQ 1034, 1034 (TTAB 1984) (finding THE MUSIC MAKERS and MUSIC-MAKERS "virtually identical" marks; the inclusion of the definite article "the" is "insignificant in determining likelihood of confusion").

(October 11, 2016, Office Action, TSDR p. 4.) However, the cases cited by the Examining Attorney merely state that the definite article "THE" does not hold trademark significance. The Examining Attorney incorrectly extrapolated this holding to the I'M part of Applicant's mark, which is a contraction of the words I and AM. The word "I" is a first person singular pronoun and the word "AM" is the first person singular conjugation of the verb "be". (See April 14, 2017, Request for Reconsideration, TSDR Exs. J-K.) The contraction I'M is not merely a definite article or a possessive pronoun. It is the combination of a possessive pronoun and a verb. The Examining Attorney has provided no support for the position that I'M does not hold

trademark significance and should be disregarded. The element I'M should thus be afforded equal weight in Applicant's mark I'M SMOKING HOT.

In addition, the Examining Attorney also stated:

Consumers are generally more inclined to focus on the first word in any trademark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *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).

(October 11, 2016, Office Action, TSDR p. 4.) Accepting the Examining Attorney's arguments, consumers are more likely to focus on the I'M element in Applicant's mark, lessening any likelihood of confusion with the Cited Mark, which does not contain I'M or I AM.

The Examining Attorney maintained the refusal because consumers “could very well refer to the product as SMOKING HOT.” (April 21, 2017, Request for Reconsideration, TSDR p. 1-2.) However, the Examining Attorney provides no factual or legal support for such conclusory statement, which on its face, is an improper dissection of the marks. A mark like SMOKIN' HOT SHOW TIME, in which the allegedly common terms SMOKIN' HOT act as a modifier of the subject SHOW TIME, would not necessarily be referred to as simply “SMOKIN' HOT.” This would communicate nothing to another consumer for the same reason one does not refer to CRACKER BARREL by its modifier CRACKER, or RED ROBIN by RED. Such modifiers are meaningless without their subject. Along those same lines, SMOKIN' HOT is meaningless without SHOW TIME. The consumer would need to refer to the Cited Mark in its entirety in order to communicate what product they are referencing. Thus, the connotation and commercial impression rely on the entirety of the mark to be used in commerce.

In addition, the Examining Attorney stated that consumers would see Applicant's mark as an extension of Registrant's product line. (*Id.* at 2.) However, the record is similarly devoid of

any evidence supporting such a position. It is clear from Registrant's mark and the specimen of use thereof that the deletion of "g" and addition of an apostrophe is crucial to the commercial impression of its mark. Thus, it follows that Registrant would not expand its product line or create other products under what would be akin to a house mark and suddenly be compelled to add the "g" and remove the apostrophe. Furthermore, it is highly unlikely that a consumer would, after being accustomed to seeing SMOKIN' HOT SHOW TIME in the marketplace, then come across I'M SMOKING HOT and somehow think it is an extension of the Registrant's SHOWTIME brand. This is because the colloquial nature of Registrant's mark is important to its image, an image that is demonstrably different than Applicant's mark.

In sum, Applicant's mark and the Cited Mark are quite different in appearance, sound, connotation, and commercial impression.

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

The Federal Circuit has held that "[o]ne of the relevant factors in the likelihood of confusion examination is the 'number and nature of similar marks in use on similar goods and services.'" *Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 768 (Fed. Cir. 1993). Evidence of third party registration and use is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection. *See Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1373-74 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338-40 (Fed. Cir. 2015); *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016); *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1373 (Fed. Cir. 2005). When the marks in question are so common or so widely used by others, consumers are conditioned to distinguish among them based on even slight differences in the marks. *Id.* at

1694; *see also* TMEP § 1207.01. Indeed, the relative strength or weakness of a mark is “a very important element” in determining likelihood of confusion. *See* J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION (Fourth Ed.) § 23:48 at 23-203 (“If the common element of conflicting marks is a word that is ‘weak’ then this reduces the likelihood of confusion.”). The Board and courts routinely hold that, “[t]he greater the number of identical or more or less similar marks already in use on different kinds of goods, the less is the likelihood of confusion between any two specific uses of the weak mark.” *First Sav. Bank, F.S.B. v. First Bank Sys.*, 101 F.3d 645, 653-54 (10th Cir. 1996).

In its Office Action Response and Request of Reconsideration, Applicant presented evidence of *many* third party marks that employ the term SMOKIN HOT for beauty products:

- 19 Registration Certificates and TESS Printouts of at least 19 SMOKING HOT and SMOKIN’ HOT marks (September 26, 2016, Office Action Response, TSDR Ex. G.);
- Printout from <bobbibrowncosmetics.com> advertising cosmetic company Bobbi Brown’s smokey eye mascara and entry for “Are You #SmokingHot?” sweepstakes (September 26, 2016, Office Action Response, TSDR Ex. H.)
- Printout from online magazine <vibe.com> announcing “MAC Cosmetics Launches Smoking Hot Temperature Rising Collection” (*Id.* at Ex. I);
- Printout from online retailer <drugstore.com> advertising cosmetic company Wet n Wild’s lipstick called “Wet n Wild MegaLast Lip Color, Smokin’ Hot Pink 90SD 0.11 oz (3.3 g)” (*Id.* at Ex. J);
- Printout from online retailer <amazon.com> advertising cosmetic company Too Faced’s lipstick called “Too Faced SMOKIN HOT LASHES – Mascara & Eyeliner Set” (*Id.* at Ex. K);
- Printout from social media site Facebook for an online makeup, clothing, jewelry and accessories company called “Smokin Hot Makeup” located in Paris, Texas (*Id.* at Ex. L);
- Printout from the UK website for online auction site eBay selling “Maybelline SMOKIN’ HOT Mascara Eyeliner Color Tattoo Xmas Gift Set for Her/Women” (*Id.* at Ex. M);

- Printout from the UK website for online retailer Amazon.com advertising “Barry M Cosmetics Eyeshadow Palette, Smokin Hot” (*Id.* at Ex. N).
- Third party use evidence for mark SMOKIN’ HOT BY ESSIE (April 14, 2017, Request for Reconsideration, TSDR Ex. A);
- Third party use evidence for mark LAYER’R SHOT DEODRANT, SMOKIN HOT, 135ML (*Id.* at Ex. B);
- Third party use evidence for mark BARE ESCENTUALS EYE SHADOW - MINI SIZED 0.01OZ/0.28GRAMS (SMOKIN’ HOT) (*Id.* at Ex. C);
- Third party use evidence for mark E.L.F. NAIL POLISH, SMOKIN HOT, 0.34 FLUID OUNCE (*Id.* at Ex. D);
- Third party use evidence for mark L.A. GIRL INSPIRING EYESHADOW PALETTE, YOU’RE SMOKIN’ HOT!, 0.21 OUNCE (*Id.* at Ex. E);
- Third party use evidence for mark FACES ULTIME PRO MATTE LIP CRAYON SMOKIN’ HOT 11 2.8 GM (*Id.* at Ex. F);
- Third party use evidence for mark E.L.F SUPER GLOSSY LIP SHINE .35 OZ/10 G SMOKIN’ HOT (*Id.* at Ex. G);
- Third party use evidence for mark POP BEAUTY SMOKIN’ HOT EYESHADOW TRIO (*Id.* at Ex. H);
- Third party use evidence for mark SMOKING HOT MOM (*Id.* at Ex. I);

These third party uses of SMOKIN HOT demonstrate that the phrases “Smokin Hot” and “Smoking Hot” are commonly used in the cosmetics and beauty industry. In other words, the Cited Mark is diluted through use by many cosmetics manufacturers and are not entitled to a wide scope of protection. Consumers for these products are much more likely to rely on the house brand, such as Applicant’s ISH brand, Registrant’s NYC brand, or other house brands like ESSIE, BARE ESCENTUALS, or E.L.F. to inform their purchasing decisions. This lessens any likelihood of confusion between Applicant’s mark and the Cited Mark.

In addition to the above, Applicant also provided extensive evidence of *use* of the third party marks. (September 26, 2016, Office Action Response, TSDR Exs. H-N; April 14, 2017,

Request for Reconsideration, TSDR Exs. A-I.) Within these exhibits is evidence of public recognition. For example, the evidence of use for Smokin Hot Makeup shows that the products associated with the mark have received more than 3,500 Likes on Facebook captured on September 20, 2016. (September 26, 2016, Office Action Response, TSDR Ex. L.) Another example of the consumer recognition of these marks is the evidence of use of the SMOKIN HOT Shadow Palette for cosmetics that has more than 65 reviews. (*Id.* at Ex. N.) The evidence for the remaining marks similarly show the public recognition of those marks through links to social media pages (April 14, 2017, Request for Reconsideration, TSDR Exs. A, I), numerous consumer reviews (Exs. A, D, E), or the use of language such as “only X left in stock” (Exs. C, E, F, G). Thus, the evidence of third party use shows use recognized by the public.

Furthermore, and similar to the evidence presented by the appellants in *Juice Generation* and *New Millennium Sports*, the existence of such extensive third party use for beauty products 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.

Nevertheless, the Examining Attorney found such “evidence” unpersuasive. (April 21, 2017, Reconsideration Letter, TSDR p. 6.) However, instead of explaining why the multitude of third party marks are unpersuasive, save for two of them, the Examining Attorney stated that she “presumed” that Applicant was attempting to mount a collateral attack on the Cited Mark. (*Id.*) Applicant has done no such thing or attempted any such thing. Applicant’s argument is simple: the Cited Mark is weak because of the amount of third party registrations and uses in the marketplace. Applicant did not argue, indicate, or hint that Registrant has not policed its mark.

Applicant is simply arguing based on the law (as is explicitly allowed to do in under TMEP § 1207.01(d)(iii)) that evidence of third party registration and use is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection. *See* TMEP § 1207.01(d)(iii); *New Millennium Sports*, 797 F.3d at 1373-74; *Juice Generation*, 794 F.3d at 1338-40. The Examining Attorney's argument that Applicant is mounting a collateral attack on the Cited Mark is unsupported and a red-herring.

Even if the Examining Attorney did address all the third party marks cited, it cannot be denied that the use of Smokin' Hot or Smoking Hot has become common in the beauty industry. Notably at least fifteen of the third party marks presented by Applicant are for cosmetics or related to the beauty industry. It is unclear how the Examining Attorney can state that the third party marks are irrelevant or do not dilute the Cited Mark when they are used for *identical or at least related goods*. Further, the Examining Attorney dismissed Applicant's extensive briefing on the suggestiveness of SMOKIN' HOT as a modifier of the subject SHOW TIME. Such analysis is crucial to this factor. *See Juice Generation*, 794 F.3d 1334, 40 ("Third party registrations are relevant to prove that some segment of the composite marks which both contesting parties use has a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak." (internal citation omitted)). Instead, the Examining Attorney seems to have relied on the conclusory position that the mark is not diluted. Such a conclusion ignores the Federal Circuit precedent in *New Millennium Sports*, *supra* and *Juice Generation*, *supra*.

In sum, Registrant's mark is weak and not entitled to a wide scope of protection. This weighs in favor of a finding of no likelihood of confusion with the Cited Mark.

IV. CONCLUSION

In conclusion, there is no likelihood of confusion between Applicant's mark and the Cited Mark because (1) the marks are not similar in appearance, sound, connotation or commercial impression and (2) the Cited Mark is weak and diluted due to the significant number of third party SMOKIN HOT marks and uses for cosmetics and related goods.

For these reasons, Applicant requests the Board to reverse the decision of the Examining Attorney refusing registration of Applicant's mark under Section 2(d) and allow the mark I'M SMOKING HOT to be published for opposition.

Applicant requests oral argument for this appeal, as shown by the accompanying Request for Oral Argument.

Respectfully submitted,

Dated: June 26, 2017

/Jill M. Pietrini/
Jill M. Pietrini
Susan Hwang
SHEPPARD MULLIN RICHTER & HAMPTON LLP
1901 Avenue of the Stars, Suite 1600
Los Angeles, California 90067-6017
(310) 228-3700

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I hereby certify that this correspondence 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 26th day of June, 2017.

/LaTrina A. Martin/
LaTrina A. Martin

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