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

Proceeding	91177788
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 79/016,744
Mark: CONTOURS
Filing Date: September 2, 2005
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SURGICAL SPECIALTIES CORPORATION, Opposer, v. DIAMOND DERMABRASION SR PTY LTD., Applicant.	Opposition No.: 91177788

MOTION FOR SUMMARY JUDGMENT

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Opposer Surgical Specialties Corporation ("Opposer") hereby moves for summary judgment. This motion is based on the following brief and the supporting Declarations of Rui Avelar and Nathan B. Sabri, submitted herewith. Because there is no genuine issue as to any material fact, Opposer respectfully submits that it is entitled to entry of summary judgment in its favor in this opposition proceeding.

FACTUAL BACKGROUND

A. Opposer

Opposer develops and markets medical products that can be used in a wide variety of medical applications, including wound closure, ophthalmic applications, and cosmetic and aesthetic procedures. In February 2005, Opposer started using the CONTOUR THREADS trademark in connection with sutures that it developed and marketed for use in cosmetic and aesthetic procedures. (Declaration of Rui Avelar in Support of Surgical Specialties Corporation's Motion for Summary Judgment ("Avelar Decl."), ¶ 3.)

Opposer's sutures are designed to be used by physicians trained and practicing in the aesthetics field, including general practitioners, reconstructive and aesthetic plastic surgeons, dermatologists and maxillofacial surgeons, for cosmetic and aesthetic skin treatments, specifically a minimally invasive, non-surgical facelift procedure designed to rejuvenate the skin. Opposer has used both the CONTOUR and the CONTOUR THREADS trademarks in connection with these suture products. (*Id.* ¶ 5.)

In an effort to boost recognition of its CONTOUR brand among patients as well as doctors, starting in August 2005 Surgical Specialties arranged for the training of doctors to perform a procedure that came to be called the CONTOUR THREADLIFT and licensed those doctors to use the terms CONTOUR, THREADLIFT, and/or CONTOUR THREADLIFT in their marketing and promotional materials. (*Id.* ¶ 6.) Through this program, Surgical Specialties

licensed hundreds of doctors to use the CONTOUR, THREADLIFT, and CONTOUR THREADLIFT trademarks. As a result of this program and widespread licensed use of the CONTOUR, THREADLIFT, and CONTOUR THREADLIFT trademarks, the "CONTOUR" trademark is well-known to the public that is considering cosmetic or aesthetic procedures. (*Id.*)

B. Opposer's Trademark Applications And Registrations

Opposer filed an application with the United States Patent and Trademark Office to register CONTOUR as a trademark for "Sutures for use in cosmetic and aesthetic procedures to elevate, suspend, and approximate the soft tissues of the brows, cheeks, breasts, buttocks or body" on August 29, 2004. This application was assigned Application Serial No. 78475375, and a Notice of Allowance for this application issued on October 23, 2007. (Declaration of Nathan B. Sabri in Support of Surgical Specialties Corporation's Motion for Summary Judgment ("Sabri Decl."), ¶ 4, Ex. B.)

Opposer owns a federal trademark registration for CONTOUR THREADS for "Sutures for use in cosmetic and aesthetic procedures to elevate, suspend, and approximate the soft tissue of the brows, cheeks, breasts, buttocks or body." This application was filed on February 18, 2005, and registered on August 21, 2007. (*Id.* ¶ 5, Ex. C.)

Opposer owns a federal trademark registration for CONTOUR THREADLIFT for "Noninvasive and minimally invasive cosmetic and aesthetic surgery services." This was a use-based application filed on August 16, 2006. It registered on October 9, 2007. (*Id.* ¶ 6, Ex. D.) Opposer also owns a registration for CONTOUR THREADLIFT and design for the same services. This was also a use-based application filed on August 15, 2006. It registered on November 27, 2007. (*Id.* ¶ 7, Ex. E.)

C. Applicant

Applicant Diamond Dermabrasion Sr Pty Ltd. ("Applicant") filed an application with the United States Patent and Trademark Office to register the CONTOURS mark in International Classes 10 and 44 for use in connection with "Apparatus for cosmetic treatment of tissue and skin, namely, skin and tissue stimulating apparatus, namely, pneumatically powered air sources

using pulse on suction applied at a relatively high frequency to act on fat cells and break down the fat cells to stimulate skin and deep tissue; Apparatus for medical and therapeutic stimulation of body, namely, skin and tissue stimulating apparatus, namely, pneumatically powered air sources using pulse on suction applied at a relatively high frequency to act on fat cells and break down the fat cells to stimulate skin and deep tissue" and "Professional beauty care services and beauty salon services featuring skin rejuvenation services, oxygen infusion services, skin cleaning services, beauty treatment services, treatment of skin using dermabrasion; dermatology services; health spa services" based on an intent to use the mark in commerce. This application was filed on September 2, 2005, claiming priority from an Australian application filed on March 10, 2005. It has been assigned Application Serial No. 79/016,744. The mark was published for opposition on February 13, 2007 and Opposer filed its Notice of Opposition on June 11, 2007.

Opposer served written discovery requests on Applicant on December 28, 2007. This discovery included a request for admissions, interrogatories, and document requests. (*Id.* ¶ 2, Ex. A.) Applicant's responses to the discovery requests were due on February 1, 2008. TBMP § 403.03; 37 C.F.R. § 2.120(a). Applicant has not responded to or objected to any of the discovery requests. (*Id.* ¶ 3.)

D. Likelihood of Confusion

Applicant's products are designed to be used by reconstructive and aesthetic plastic surgeons, dermatologists and maxillofacial surgeons for cosmetic and aesthetic skin treatments, specifically a minimally invasive, non-surgical facelift procedure designed to rejuvenate the skin. (*Id.* ¶ 2, Ex. A (Request for Admissions ("RFA") Nos. 1-6).) Applicant also appears to be operating a chain of medical spas that offer various skin and body treatments (Avelar Decl., ¶ 7, Ex. B), and has applied to register the CONTOURS mark in connection with a wide variety of cosmetic and aesthetic services, including "[p]rofessional beauty care services and beauty salon services featuring skin rejuvenation services, oxygen infusion services, skin cleaning services,

beauty treatment services, treatment of skin using dermabrasion; dermatology services; health spa services." (App. Ser. No. 79/016,744.)

Opposer's products are also designed to be used by reconstructive and aesthetic plastic surgeons, dermatologists and maxillofacial surgeons for cosmetic and aesthetic skin treatments, specifically a minimally invasive, non-surgical facelift procedure designed to rejuvenate the skin, including facial treatments and lifts. (Avelar Decl., ¶ 7.) Moreover, Opposer licenses doctors to use its CONTOUR, THREADLIFT, and/or CONTOUR THREADLIFT marks in connection with their advertising for their own services. (*Id.* ¶ 6.)

These are related if not competing products and procedures. If a patient receives a cosmetic or aesthetic treatment using Applicant's CONTOURS product, that patient would no longer be interested in or have need for a procedure using Opposer's CONTOUR and CONTOUR THREADS products. (Avelar Decl., ¶ 8; Sabri Decl., ¶ 2, Ex. A (RFA Nos. 6-7).)

Patients will not be able to distinguish between a "CONTOURS" procedure using Applicant's CONTOURS product and a competing "CONTOUR" procedure using Opposer's CONTOUR and CONTOUR THREADS products, particularly when a single doctor may offer both procedures and use both marks in his or her advertisements. (Avelar Decl., ¶ 11.)

Doctors will also not be able to distinguish between the source of Applicant's CONTOURS product and Opposer's CONTOUR and CONTOUR THREADS products. Opposer began offering its CONTOUR THREADS products in January 2005. The product, and the then newly developed THREADLIFT procedure, received widespread press coverage, including segments on such nationally syndicated programs as The Today Show. As a result, doctors who perform cosmetic and aesthetic procedures are already quite familiar with Opposer's CONTOUR and CONTOUR THREADS products. (*Id.* ¶ 13.) If Applicant offers its CONTOURS product to the doctors who are already familiar with Opposer's CONTOUR and CONTOUR THREADS products, those doctors are likely to assume that the new CONTOURS product comes from the same source as the CONTOUR and CONTOUR THREADS products with which they are familiar. (*Id.*)

ARGUMENT

I. SUMMARY JUDGMENT IS APPROPRIATE WHERE THERE EXIST NO GENUINE ISSUES OF MATERIAL FACT

A. Legal Standard

Because the evidence of record in this proceeding establishes that there are no genuine issues of material fact as to the Opposer's priority or Opposer's pleaded grounds for opposition, Opposer should be granted summary judgment. Summary judgment is proper and should be granted whenever the pleadings, discovery, and affidavits show there to be "no *genuine issue* as to any *material fact* and that the moving party is entitled to a judgment as a matter of law." Fed. R. Civ. Proc. 56(c) (emphasis added); *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986); *Flatley v. Trump*, 11 U.S.P.Q.2d (BNA) 1284, 1287 (TTAB 1990).

A material fact is any that "might affect the outcome of the suit under the governing law." *Liberty Lobby*, 477 U.S. at 248. A genuine issue of material fact exists if there is evidence that would permit the fact finder (in this proceeding, the Board) to return a decision in favor of the nonmoving party (in this proceeding, Applicant). *See id.* Because there exists no evidence that would permit the Board to find that Applicant should prevail, there exist no genuine issues of material fact, and Opposer is entitled to summary judgment.

B. Evidence of Record In This Opposition Proceeding

The evidence of record in this case establishes the undisputed facts that entitle Opposer to summary judgment. The types of evidence that may be submitted in support of a motion for summary judgment include "the pleadings, the discovery and disclosure materials on file, and any affidavits." Fed. R. Civ. Proc. 56(c). The evidence of record in this proceeding consists of the following:

1. The file wrapper for Application Serial No. 79/016,744;
2. Opposer's Notice of Opposition, and exhibits thereto;
3. Applicant's Answer to Notice of Opposition;

4. Opposer's Request for Admissions, First Set (attached as **Exhibit A** to the Sabri Declaration, submitted herewith);

5. Declaration of Nathan B. Sabri, submitted herewith; and

6. Declaration of Rui Avelar, submitted herewith.

The file wrapper for Application Serial No. 79/016,744, Opposer's Notice of Opposition, and Applicant's Answer thereto are automatically part of the evidentiary record in this Board proceeding. Fed. R. Civ. Proc. 56(c); 37 C.F.R. §2.122(b) (file of the application which is the subject of the opposition proceeding is automatically part of the record without action by any party).

The Declarations of Nathan B. Sabri and Rui Avelar, and the exhibits thereto, are of record in this case because they are being submitted with this motion. *Kellogg Co. v. Pack'Em Enters. Inc.*, 14 U.S.P.Q.2d (BNA) 1545, 1549-1550 & n.9 (TTAB 1990).

II. OPPOSER IS ENTITLED TO SUMMARY JUDGMENT BECAUSE THE EVIDENCE OF RECORD ESTABLISHES THAT THERE IS A LIKELIHOOD OF CONFUSION BETWEEN ITS MARKS AND APPLICANT'S MARK

A. Priority

In this case, there is no genuine issue of fact as to who has senior rights in their respective marks: Opposer's rights are senior to any rights claimed by Applicant. Opposer filed its intent-to-use application for CONTOUR on August 29, 2004. (Sabri Decl., ¶ 4, Ex. B.) An opposer may rely on the filing date of an intent-to-use application as a constructive date of first use. *Larami Corp. v. Talk To Me Programs, Inc.*, 36 U.S.P.Q.2d (BNA) 1840 (TTAB 1995) (Opposer can rely on date of filing of intent-to-use application as a constructive first use date even where registration has not yet been conferred); *Jimlar Corp. v. The Army and Air Force Exch. Serv.*, 24 U.S.P.Q.2d (BNA) 1216 (TTAB 1992) (The filing date of an opposer's intent-to-use application for his mark provides an opposer with a constructive use date, upon which it can rely.). Therefore, Opposer's constructive date of first use in the CONTOUR mark is August 29, 2004.

In contrast, Applicant has an effective filing date of March 10, 2005. Where an applicant for a mark is entitled to priority based on a foreign application, the effective filing date of the intent-to-use application is the date on which the application was first filed in the foreign country. *See* TMEP § 206.02; 15 U.S.C. § 1126(d). Applicant filed its intent-to-use application on September 2, 2005, but claimed priority from its Australian application, filed March 10, 2005. (App. Ser. No. 79/016,744.) Thus, Applicant may rely on its Australian March 10, 2005 filing date as its constructive date of first use. However, that date is long after Opposer's August 29, 2004 constructive date of first use in its CONTOUR mark.

Furthermore, Opposer filed a use-based application for CONTOUR THREADS on February 18, 2005 claiming use in commerce since at least as early as January 19, 2005. (Sabri Decl., ¶ 5, Ex. C.) Not only are each of these dates prior to Applicant's priority date of March 10, 2005, where an opposer owns a registration for a pleaded mark that is not subject to a counterclaim or cancellation proceeding, the priority requirement is met as a matter of law. *See* TBMP § 309.03(c)(a) ("[P]riority is not an issue in an opposition where opposer pleads (and later proves) that it owns a registration for its pleaded mark, provided that any counterclaim or separate petition to cancel the pleaded registration by the applicant is ultimately dismissed and the registration remains uncancelled."). Moreover, Opposer has submitted evidence in the form of Rui Avelar's Declaration attesting to the fact that Opposer began using the CONTOUR THREADS mark in commerce in January, 2005 (Avelar Decl., ¶ 13), nearly two months before Applicant's priority date.

As such, Opposer's CONTOUR and CONTOUR THREADS marks have priority over Applicant's CONTOURS mark.

B. Likelihood of Confusion

Opposer is entitled to summary judgment because the undisputed facts show that Applicant's CONTOURS designation so resembles Opposer's CONTOUR and CONTOUR THREADS marks as to be likely to cause confusion. *In re E.I. DuPont DeNemours & Co.*

establishes the factors to be examined by the Board in determining the likelihood of confusion between two marks. Those factors are as follows:

> (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.
>
> (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 minimis or substantial.
>
> (13) Any other established fact probative of the effect of use.

In re E.I. DuPont DeNemours & Co., 476 F.2d 1357, 1361, 177 U.S.P.Q. (BNA) 563 (CCPA 1973). The Board need only consider evidence on factors that are material or relevant in the particular case before it. J. McCarthy, *Trademarks and Unfair Competition*, § 24.43; *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1338 (Fed. Cir. 2001) ("[T]he Board need not

discuss every [*DuPont*] factor, but may focus its analysis on dispositive factors, such as similarity of the marks and relatedness of the goods."); *see also Shen Mfg. Co. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 1241 (Fed. Cir. 2004) (finding the relevant factors in the case to be: (1) the alleged fame of Shen's RITZ mark; (2) the similarity of the marks; and (3) the relatedness of the goods).

Because Applicant's CONTOURS mark is virtually identical to Opposer's CONTOUR mark and to the dominant CONTOUR portion of Opposer's CONTOUR THREADS mark, because Applicant has constructively admitted that its CONTOURS product is intended to be used for services that are related to and compete with services offered with Opposer's CONTOUR and CONTOUR THREADS product, and because Applicant has constructively admitted that it intends to offer its products in the same channels of trade, the *DuPont* factors require the conclusion that there is a significant likelihood of confusion precluding registration of Applicant's CONTOURS mark.

1. The CONTOURS Mark Is Virtually Identical To The CONTOUR Mark And The CONTOUR THREADS Mark In Sight And Sound And Conveys The Same Commercial Impression.

It is well-established that plural versions of terms are essentially identical to the same terms in the singular. *See, e.g., In re Pix of America, Inc.*, 225 U.S.P.Q. (BNA) 691 (TTAB 1985) (comparing NEWPORT to NEWPORTS for similar goods and stating, "As for the marks, except for the pluralization of applicant's mark which is almost totally insignificant in terms of the likelihood of confusion of purchasers, the marks are essentially identical in sound, appearance, and commercial impression."). Applicant's CONTOURS mark is simply a plural version of, and is thus essentially identical to, Opposer's CONTOUR mark.

Similarly, Applicant's CONTOURS mark is virtually identical to the CONTOUR portion of Opposer's CONTOUR THREADS mark. The CONTOUR portion of Opposer's CONTOUR THREADS mark is the dominant portion of the mark because the THREADS portion of the mark is at best suggestive of the product: sutures. In fact, Opposer was asked to and did disclaim THREADS from its CONTOUR THREADS mark because the Examining Attorney

considered it to be descriptive of sutures. (Sabri Decl., ¶ 5, Ex. C.) Thus, Applicant's CONTOURS mark is also essentially identical to Opposer's CONTOUR THREADS mark.

When marks are essentially identical, this factor strongly weighs in Opposer's favor in the likelihood of confusion analysis. *See, e.g., In re Opus One, Inc.*, 60 U.S.P.Q.2d (BNA) 1812 (TTAB 2001) (affirming Examining Attorney who found confusion likely in part because marks were identical); *see also In re Shell Oil Co.*, 992 F.2d 1204, 1207 (Fed. Cir. 1993) (noting that even when goods are not competitive or intrinsically related, use of identical marks can lead to assumption that there is common source).

2. The Goods And Services Described In The CONTOURS Application Are Related To And Compete With Those For Which Opposer's Marks Are In Use.

In Opposer's Request for Admissions, First Set, Opposer asked Applicant to admit that its CONTOURS products were designed to be used for cosmetic and aesthetic skin treatments, minimally invasive and non-surgical facelift procedures, and an alternative to minimally invasive non-surgical facelift procedures. (Sabri Decl., ¶ 2, Ex. A (RFA Nos. 5-7).) By failing to respond to the Request for Admissions, Opposer has constructively admitted these facts. TMEP §§ 407.03(a) and 407.04. Opposer's CONTOUR and CONTOUR THREADS marks are also intended to be used, and have been used, for cosmetic and aesthetic skin treatments, minimally invasive and non-surgical facelift procedures, and alternatives to minimally invasive non-surgical facelift procedures. (Avelar Decl., ¶ 5.) Accordingly, Applicant has admitted that it intends to use its CONTOURS mark on goods designed for the exact same treatments and procedures as Opposer's CONTOUR and CONTOUR THREADS goods.

If an identical designation is used on identical goods or services, there is a likelihood of confusion. *See Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 U.S.P.Q.2d (BNA) 1733 (TTAB 2001) ("Use of identical marks for virtually identical services would create a likelihood of confusion."); *see also Metro Traffic Control v. Shadow Network*, 104 F.3d 336, 339 (Fed. Cir. 1997) (agreeing with portion of TTAB decision that stated confusion was "so likely that it is virtually inevitable, because the parties are using the identical mark for the identical

services"); *Wynn Oil Co. v. Thomas*, 839 F.2d 1183, 1190-91 (6th Cir. 1988) ("Obviously, since both marks use absolutely identical language to sell a nearly identical service, the likelihood of confusion must be considered great."); J. McCarthy *Trademarks and Unfair Competition,* § 23:20.50 (noting that case law effectively presumes a likelihood of confusion when an identical designation is used on identical goods or services). Here, confusion is so likely that it is virtually inevitable.

In addition to the above products, Applicant's CONTOURS application also seeks to cover "Professional beauty care services and beauty salon services featuring skin rejuvenation services, oxygen infusion services, skin cleaning services, beauty treatment services, treatment of skin using dermabrasion; dermatology services; health spa services" in International Class 44. (App. Ser. No. 79/016,744.) These services are complementary and related to the services performed using Opposer's CONTOUR and CONTOUR THREADS products, namely, cosmetic and aesthetic skin treatments, minimally invasive and non-surgical facelift procedures, and alternatives to minimally invasive non-surgical facelift procedures. (Avelar Decl., ¶ 7.) In addition, they are complementary and related to services for which Opposer has registered the CONTOUR THREADLIFT mark, namely, "Noninvasive and minimally invasive cosmetic and aesthetic surgery services." (Sabri Decl., ¶¶ 6-7, Exs. D,E.) Opposer's use of the CONTOUR and CONTOUR THREADS mark expanded naturally to include these CONTOUR THREADLIFT services when it started offering training services and licensing doctors to use the CONTOUR, THREADLIFT, and/or CONTOUR THREADLIFT marks. (Avelar Decl., ¶ 6.) Therefore, the services covered in the subject application are also similar to, and in direct competition with, the services the Opposer and its licensees offer under the CONTOUR, CONTOUR THREADS, and/or CONTOUR THREADLIFT marks, rendering confusion "virtually inevitable." *See Metro Traffic Control*, 104 F.3d 336 at 339.

Thus, this factor also strongly weighs in Opposer's favor in the likelihood of confusion analysis.

3. The Channels Of Trade Are Identical.

Opposer has promoted and intends to promote its CONTOUR THREADS and CONTOUR marks via the same channels of trade and to identical consumers to which Applicant intends to market its CONTOURS products and services, so this factor weighs in favor a finding of likelihood of confusion. *DuPont*, 476 F.2d at 1361. In its Request for Admissions, Opposer asked Applicant to admit that its products were designed to be used by reconstructive plastic surgeons, aesthetic plastic surgeons, dermatologists, and maxillofacial surgeons. (Sabri Decl., ¶ 2, Ex. A (RFA Nos. 1-4.)) These items are now deemed admitted due to Applicant's failure to respond. TMEP §§ 407.03(a) and 407.04. Because Opposer's products are also designed to be used by reconstructive plastic surgeons, aesthetic plastic surgeons, dermatologists, and maxillofacial surgeons (Avelar Decl., ¶ 5), the intended consumers of Applicant's goods are identical to the intended consumers of Opposer's goods. When products are used in identical channels of trade, the likelihood of confusion increases. *See Kilo Foods, Inc. v. Land O'Lakes, Inc.*, 1996 TTAB LEXIS 87 (TTAB June 6, 1996) (granting motion for summary judgment and refusing registration where virtually identical marks traveled in identical channels of trade).

Because Applicant is using a CONTOURS mark that is virtually identical to Opposer's CONTOUR and CONTOUR THREADS marks for products that are intended to be marketed through identical channels of trade, and to be used for competing services, this factor also strongly favors a finding of likelihood of confusion.

4. Applicant's Products And Services Include Impulse Purchases.

Applicant has applied to register the CONTOURS mark for a variety of spa treatments and cosmetic and aesthetic procedures, including "[p]rofessional beauty care services and beauty salon services featuring skin rejuvenation services, oxygen infusion services, skin cleaning services, beauty treatment services, treatment of skin using dermabrasion, dermatology services, health spa services." (App. Ser. No. 79/016,744.) These services, as well as the cosmetic and aesthetic skin treatments and minimally invasive and non-surgical facelift procedures in connection with which Applicant's CONTOURS product is intended to be used (Sabri Decl., ¶ 2,

Ex. A (RFA Nos. 5-6)) are typical of the services offered by medical spas, a growing industry. (Avelar Decl., ¶ 11.)

Medical spas offer an ever-increasing array of non-invasive or minimally invasive cosmetic and aesthetic procedures in an environment where patients are pampered and may receive services ranging surgical facelift procedures to eyebrow shaping. (*Id.*) These medical spas are stark contrasts to the sterile environments used by doctors performing more traditional and invasive surgical procedures. (*Id.*) Some of the new procedures are more surgical in nature, and some are more akin to a skin rejuvenation or refreshening procedure involving "dermabrasion" or "peels" (*Id.* ¶ 10) and many of these procedures are designed to be done in a short period of time and at relatively low costs, including in the form of "lunchtime facelifts" and Botox injections. (*Id.*)

As consumers have been deluged with an increasing number of options of medical spas and procedures, they have become less able to distinguish between options and are more likely to seek the newest procedure advertised on television, on the Internet, or recommended by a friend. (*Id.*) As a result, and given the relatively low prices charged by many doctors and medical spas, consumers are beginning to view cosmetic and aesthetic procedures as impulse items – something to make them look younger and better with minimal investment of time and money. (*Id.*)

This is as true of the services included in Applicant's application as it is of the medical spa industry in general, which means that consumers of Applicant's services are not likely to take great care in seeking Applicant's services or services offered by doctors or medical spas using its CONTOURS product. Thus, this factor also weighs in favor of a likelihood of confusion. *See The B.V.D. Licensing Corp. v. Rodriguez*, 83 U.S.P.Q. 2d (BNA) 1500 (TTAB 2007) (noting that products subject to impulse buying have a higher risk of confusion and citing *Recot, Inc. v. Becton*, 214 F.3d 1322 (Fed. Cir. 2000)).

5. The Fame Of The Prior Mark.

Opposer's CONTOUR and CONTOUR THREADS marks are well-known to the public seeking cosmetic and aesthetic treatments because procedures using the CONTOUR and CONTOUR THREADS products have been performed on national television programs such as The Today Show, and Opposer has licensed hundreds of doctors to use the CONTOUR, THREADLIFT and/or CONTOUR THREADLIFT marks in their own promotional materials. (Avelar Decl., ¶ 6.) The widespread use of these marks is evidenced by the fact that there are in excess of 14,000 "hits" when one searches for "CONTOUR THREAD" on Google. Many of these are links to websites where doctors are offering the CONTOUR THREADLIFT procedure, demonstrating that the term CONTOUR is widely marketed to patients and the general public, and is not merely a term used among physicians. (*Id.* ¶ 6, Ex. A.).

Thus, this fact weighs in Opposer's favor. *See ProQuest Information & Learning Co. v. Island*, 83 U.S.P.Q.2d (BNA) 1351 (TTAB 2007) (noting that cited mark was "quite well-known in . . . the fields where applicant has indicated he intends" to use his mark, and stating, "Accordingly, this critical factor weighs strongly in favor of finding a likelihood of confusion herein.")

6. The Extent Of Potential Confusion.

The heavily overlapping channels of trade, types of services, and types of consumers make the risk of confusion in this case substantial. Both parties' products are designed to be used in competing procedures and patients will not be able to distinguish between a "CONTOURS" procedure using Applicant's CONTOURS products and a competing "CONTOUR" procedure using Opposer's CONTOUR and CONTOUR THREADS products. (Avelar Decl., ¶¶ 8,11.) The fact that both marks have been used and/or are intended to be used in connection with promoting cosmetic and aesthetic treatment services to the public will only exacerbate the confusion, as patients may make an appointment for a "CONTOURS" procedure without realizing that there are two types of "CONTOUR" procedures available. (*Id.* ¶ 11.) Moreover, if a doctor purchases both CONTOUR products from Opposer and a CONTOURS

product from Applicant, that doctor may use both the CONTOUR trademark and the CONTOURS trademark in his or her advertising. This will further confuse the public. (*Id.* ¶ 12.)

Doctors who purchase the parties' CONTOUR/CONTOURS products are also likely to be confused. Opposer began offering its CONTOUR THREADS products in January 2005. The product, and the then newly developed THREADLIFT procedure, received widespread press coverage, including segments on such nationally syndicated programs as The Today Show. (*Id.* ¶ 13.) As a result, doctors who perform cosmetic and aesthetic procedures are already quite familiar with Opposer's CONTOUR and CONTOUR THREADS products. (*Id.*) If Applicant offers its CONTOURS product to the doctors who are already familiar with Opposer's CONTOUR and CONTOUR THREADS products, those doctors are likely to assume that the new CONTOURS product comes from the same source as the CONTOUR and CONTOUR THREADS products with which they are familiar. (*Id.*)

Thus, this factor favors a likelihood of confusion.

7. The Remaining *DuPont* Factors Are Either Neutral Or Irrelevant.

For example, a showing of actual confusion is not necessary to establish a likelihood of confusion. *Herbko Intern., Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 U.S.P.Q.2d (BNA) 1375 (Fed. Cir. 2002). This is because courts have recognized that reliable evidence of actual confusion is almost impossible to secure. *See, e.g., Plus Prods. v. Physicians Formula Cosmetics, Inc.*, 198 U.S.P.Q. (BNA) 111 (TTAB 1978). Indeed, this factor has no relevance here, where the application at issue was filed on an intent to use basis and the mark has yet to be used in the marketplace. In such a situation there can be no evidence of actual confusion. *See e.g., Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 228, 51 U.S.P.Q.2d (BNA) 1882, 1897 (2d Cir. 1999) ("[I]f the junior mark has not yet appeared on the market, there has been no opportunity for confusion to manifest itself in the marketplace.... In such a case, the 'actual confusion' factor simply drops out of the picture because it can have no relevance.") Because

there has been no opportunity for actual confusion, this factor is irrelevant to a finding of likelihood of confusion.

Similarly, although neither Applicant's mark nor Opposer's marks is intended to be used on a wide variety of goods and services (the ninth *DuPont* factor), the products on which the marks are intended to be used and/or have been used are designed for competing services. (*See* Sabri Decl., ¶ 2, Ex. A (RFA Nos. 5-6) (Applicant's products are designed to be used for cosmetic and aesthetic skin treatments and minimally invasive, non-surgical facelift procedures); Avelar Decl. ¶¶ 5, 7-8.) The fact that the products covered by the applications are already offered for use in connection with competing services moots the ninth *DuPont* factor.

The tenth *DuPont* factor ("market interface") is irrelevant to the analysis because there are no agreements between Opposer and Applicant with respect to use in the marketplace of the CONTOURS mark, and neither laches nor estoppel applies. (Avelar Decl., ¶ 14.)

8. Consideration Of The *DuPont* Factors As a Whole Requires A Finding Of Likelihood Of Confusion.

In sum, each of the relevant *DuPont* factors supports a finding of likelihood of confusion and weighs in Opposer's favor:

- The marks are virtually identical in appearance, sound, and commercial impression.
- The goods and services are at least similar and related, and certain services are identical and directly competing.
- The products and services are offered to identical consumers through the same channels of trade.
- The goods and services include "impulse" purchases, for which there is a greater risk of confusion.
- Opposer's mark has been heavily advertised and is very well-known, even to the general public.

The remainder of the factors are either not relevant or are neutral at best. Therefore, under clear authority, the Board must find that there is a likelihood of confusion between

Opposer's CONTOUR and CONTOUR THREADS marks and Applicant's CONTOURS mark, and registration of Applicant's mark should be denied. *Herbko*, 308 F.3d at 1166 (holding that the Board correctly found a likelihood of confusion where "each of the relevant DuPont factors for which there is record evidence favors a determination that the marks are likely to cause confusion").

CONCLUSION

By the undisputed evidence of record in this proceeding, Opposer has established that it has priority and that Applicant's mark is likely to cause confusion with Opposer's CONTOUR and CONTOUR THREADS marks. There are no genuine issues of material fact on these matters. Accordingly, Opposer respectfully requests that summary judgment be granted in its favor and that the Board refuse registration of Applicant's CONTOURS mark.

Respectfully submitted,

Dated: February 27, 2008 By: _____

Jennifer Lee Taylor
Nathan B. Sabri
Attorney for Opposer
Surgical Specialties Corporation

Morrison & Foerster LLP
425 Market Street
San Francisco, California 94105-2482
Telephone: (415) 268-6538
Facsimile: (415) 268-7522

PROOF OF SERVICE BY MAIL

I am employed with the law firm of Morrison & Foerster LLP, whose address is 425 Market Street, San Francisco, California, 94105; I am not a party to the within cause; I am over the age of eighteen years and I am readily familiar with Morrison & Foerster's practice for collection and processing of correspondence for mailing with the United States Postal Service and know that in the ordinary course of Morrison & Foerster's business practice the document described below will be deposited with the United States Postal Service on the same date that it is placed at Morrison & Foerster with postage thereon fully prepaid for collection and mailing.

I further declare that on February 27, 2008, I served copies of:

MOTION FOR SUMMARY JUDGMENT

DECLARATION OF RUI AVELAR IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT

DECLARATION OF NATHAN B. SABRI IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT

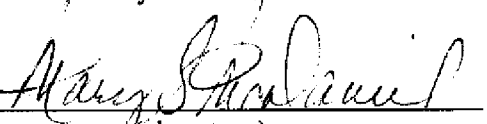
on the following by placing a true copy thereof enclosed in a sealed envelope addressed as follows for collection and mailing at Morrison & Foerster LLP, 425 Market Street, San Francisco, California, 94105, in accordance with Morrison & Foerster's ordinary business practices:

Mr. Terrence J. McAllister
Ohlandt, Greeley, Ruggiero & Perle, LLP
One Landmark Square, 10th Floor
Stamford, CT 06901-2682

I declare under penalty of perjury under the laws of the State of California that the above is true and correct.

Executed at San Francisco, California, this 27th day of February 2008.

Mary S. McDaniel
(typed)


(signature)

sf-2474185

TRADEMARK
Docket No. 60202-6003.501

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

Surgical Specialties Corporation Opposer v. Diamond Dermabrasion Sr Pty Ltd, Applicant	Opposition No. 91177788 Serial No.: 79/016,744

DECLARATION OF NATHAN B. SABRI IN SUPPORT OF SURGICAL SPECIALTIES CORPORATION'S MOTION FOR SUMMARY JUDGMENT

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Sir:

I, Nathan B. Sabri, declare as follows:

1. I am an associate with the law firm of Morrison & Foerster LLP, counsel of record for Opposer Surgical Specialties Corporation ("Opposer") in the above-entitled opposition proceeding. I make this declaration in support of Opposer's motion for summary judgment.

2. Opposer served written discovery requests on Applicant on December 28, 2007. This discovery included requests for admissions, interrogatories, and document requests. Attached as Exhibit A is a true and correct copy of Opposer's Request for Admissions, First Set, as well as the proof of service, both served on December 28, 2007.

3. Diamond Dermabrasion did not respond or object to any of Opposer's discovery requests, including the attached Request for Admissions.

4. Attached hereto as Exhibit B is a true and correct copy of Opposer's application to register CONTOUR, Application Serial No. 78/475,375, as well as the Notice of Allowance that issued on October 23, 2007.

5. Attached hereto as Exhibit C is a true and correct copy of Opposer's registration for CONTOUR THREADS, Registration No. 3,282,397, as well as a printout from the federal database, available at www.uspto.gov, showing status info for Registration No. 3,282,397.

6. Attached hereto as Exhibit D is a true and correct copy of Opposer's registration for CONTOUR THREADLIFT, Registration No. 3,307,321, as well as a printout from the federal database, available at www.uspto.gov, showing status info for Registration No. 3,307,321.

7. Attached hereto as Exhibit E is a true and correct copy of Opposer's registration for CONTOUR THREADLIFT and Design, Registration No. 3,344,266, as well as a printout from the federal database, available at www.uspto.gov, showing status info for Registration No. 3,344,266.

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct.

Executed on this 27th day of February, 2008 in San Francisco, California.

By: _____
Nathan B. Sabri

EXHIBIT A

TRADEMARK
Docket No. 60202-6003.501

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

In the Matter of Application Serial No. 79/016,744
Mark: CONTOURS

SURGICAL SPECIALTIES CORPORATION, Opposer, v. DIAMOND DERMABRASION SR PTY LTD., Applicant.	Opposition No.: 91177788

REQUEST FOR ADMISSIONS, FIRST SET

Surgical Specialties Corporation ("Opposer"), in accordance with Rule 2.120 of the Trademark Rules of Practice and Rules 26 and 36 of the Federal Rules of Civil Procedure, hereby propounds the following requests for admission to be answered by Diamond Dermabrasion SR Pty Ltd. ("Applicant"), in writing under oath within the time specified by the Trademark Rules of Practice and the Rules of Federal Civil Procedure.

These requests seek admissions as of the date of response and, as to those requests addressed to matters falling within Rule 26(e)(1) and (2) of the Federal Rules of Civil Procedure, shall be deemed to be continuing, requiring Applicant to serve upon Opposer such further admissions promptly after Applicant has acquired additional knowledge or information relating to those requests in any way.

DEFINITIONS

As used herein, the following terms shall have the following meanings:

A. "Surgical Specialties" or "Opposer" means Surgical Specialties Corporation, and its affiliated and associated companies, and its officers, directors, employees, attorneys, agents and representatives, and any predecessor, successor, parent, or subsidiary entity, either domestic or foreign.

B. "CONTOUR Mark" is the mark contained in Application Serial No. 78/475,375.

C. "CONTOUR THREADS Mark" is the mark contained in Application Serial No. 78/570,451.

D. "Diamond Dermabrasion" or "Applicant" means Diamond Dermabrasion SR Pty Ltd., and its officers, directors, employees, attorneys, agents and representatives, and any predecessor, successor, parent or subsidiary entity, either domestic or foreign.

E. "CONTOURS Designation" is the designation sought to be registered by Applicant through Application Serial No. 79/016,744.

F. "Use" means trademark use.

G. "Any" or "each" should be understood to include and encompass "all"; "or" should be understood to include and encompass "and"; and "and" should be understood to include and encompass "or."

REQUESTS

REQUEST NO. 1:

Admit that Applicant's products are designed to be used by reconstructive plastic surgeons.

REQUEST NO. 2:

Admit that Applicant's products are designed to be used by aesthetic plastic surgeons.

REQUEST NO. 3:

Admit that Applicant's products are designed to be used by dermatologists.

REQUEST NO. 4:

Admit that Applicant's products are designed to be used by maxillofacial surgeons.

REQUEST NO. 5:

Admit that Applicant's products are designed to be used for cosmetic and aesthetic skin treatments.

REQUEST NO. 6:

Admit that Applicant's products are designed to be used for minimally invasive, non-surgical facelift procedures.

REQUEST NO. 7:

Admit that Applicant's products are designed to be an alternative to minimally invasive, non-surgical facelift procedures.

REQUEST NO. 8:

Admit that Applicant was aware of the use of the CONTOUR Mark and CONTOUR THREADS Mark prior to its filing for the CONTOURS Designation.

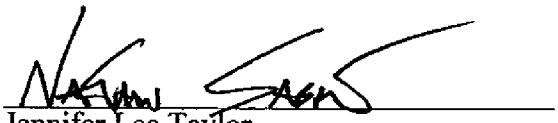
REQUEST NO. 9:

Admit that each of the documents produced in response to Opposers' First Request for Production of Documents to Diamond Dermabrasion is genuine.

REQUEST NO. 10:

Admit that each of the documents produced in response to Opposers' First Request for Production of Documents to Diamond Dermabrasion was in Applicant's possession.

Dated: December 28, 2007

By: 

Jennifer Lee Taylor
Nathaniel B. Sabri
Attorneys for Opposer
Surgical Specialties Corporation

Morrison & Foerster LLP
425 Market Street
San Francisco, CA 94105
Tel (415) 268.7000
Fax (415) 268.7522

PROOF OF SERVICE BY MAIL

I am employed with the law firm of Morrison & Foerster LLP, whose address is 425 Market Street, San Francisco, California 94105-2482; I am not a party to the within cause; I am over the age of eighteen years and I am readily familiar with Morrison & Foerster's practice for collection and processing of correspondence for mailing with the United States Postal Service and know that in the ordinary course of Morrison & Foerster's business practice the documents described below will be deposited with the United States Postal Service on the same date that it is placed at Morrison & Foerster with postage thereon fully paid for collection and mailing.

I further declare that on the date hereof I served copies of:

FIRST REQUEST FOR PRODUCTION OF DOCUMENTS; REQUEST FOR ADMISSIONS, FIRST SET; and **INTERROGATORIES, FIRST SET**

on the following by placing true copies thereof enclosed in a sealed envelope addressed as follows for collection and mailing at Morrison & Foerster LLP, 425 Market Street, San Francisco, California 94105-2482, in accordance with Morrison & Foerster's ordinary business practices:

Terrence J. McAllister
Ohlandt, Greeley, Ruggiero & Perle, LLP
One Landmark Square, 10th Floor
Stamford, CT 06901-2682

I declare under penalty of perjury under the laws of the State of California that the above is true and correct.

Executed at San Francisco, California, this 28th day of December 2007.

Mary Susan McDaniel
(typed)

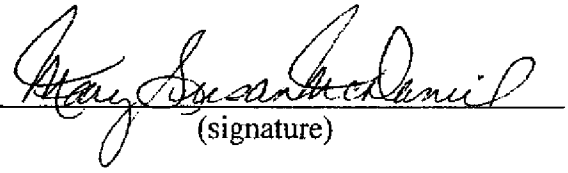

(signature)

EXHIBIT B

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2008-02-27 15:19:47 ET

Serial Number: 78475375 Assignment Information Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark

CONTOUR

(words only): CONTOUR

Standard Character claim: Yes

Current Status: Opposition period completed, a Notice of Allowance has been issued.

Date of Status: 2007-10-23

Filing Date: 2004-08-29

The Notice of Allowance Date is: 2007-10-23

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 109

Attorney Assigned:
ALI STEPHANIE MARIE

Current Location: 700 -Intent To Use Section

Date In Location: 2007-10-23

LAST APPLICANT(S)/OWNER(S) OF RECORD

---

1. Surgical Specialties Corporation

Address:
Surgical Specialties Corporation
100 Dennis Drive
Reading, PA 19606
United States

Legal Entity Type: Corporation
State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

International Class: 010
Class Status: Active
Sutures for use in cosmetic and aesthetic procedures to elevate, suspend, and approximate the soft tissues of the brows, cheeks, breasts, buttocks or body
Basis: 1(b)
First Use Date: (DATE NOT AVAILABLE)
First Use in Commerce Date: (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2007-10-23 - Notice of allowance - mailed

2007-09-08 - Extension Of Time To Oppose Process - Terminated

2007-03-12 - Extension Of Time To Oppose Received

2007-02-13 - Published for opposition

2007-01-24 - Notice of publication

2006-12-16 - Law Office Publication Review Completed

2006-12-15 - Assigned To LIE

2006-12-05 - TEAS Change Of Correspondence Received

2006-12-01 - Approved for Pub - Principal Register (Initial exam)

2006-10-06 - Amendment From Applicant Entered

2006-09-25 - Communication received from applicant

2006-09-25 - PAPER RECEIVED

2006-09-26 - TEAS Change Of Correspondence Received

2006-08-01 - Final refusal mailed

2006-07-31 - Final Refusal Written

2006-05-11 - Amendment From Applicant Entered

2006-04-20 - Communication received from applicant

2006-04-20 - PAPER RECEIVED

2006-01-11 - Attorney Revoked And/Or Appointed

2006-01-11 - TEAS Revoke/Appoint Attorney Received

2005-10-18 - NON-FINAL ACTION E-MAILED

2005-10-18 - Non-Final Action Written

2005-10-01 - LIE Checked Susp - To Atty For Action

2005-03-29 - Letter of suspension e-mailed

2005-03-29 - Suspension Letter Written

2005-03-28 - Assigned To Examiner

2004-09-07 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record
Jennifer Lee Taylor

Correspondent
Jennifer Lee Taylor
Morrison & Foerster LLP
425 Market Street
San Francisco CA 94105-2482
Phone Number: 415 268 6538
Fax Number: 415 268 7522

U.S. Patent and Trademark Office (USPTO)

NOTICE OF ALLOWANCE

NOTE: If any data on this notice is incorrect, please fax a request for correction to the Intent to Use Unit at 571-273-9550. Please include the serial number of your application on ALL correspondence with the USPTO.

ISSUE DATE: Oct 23, 2007

Jennifer Lee Taylor
Morrison & Foerster LLP
425 Market Street
San Francisco CA 94105-2482

ATTORNEY REFERENCE NUMBER
602026003000

**** IMPORTANT INFORMATION: 6 MONTH DEADLINE ****

You filed the trademark application identified below based upon a bona fide intention to use the mark in commerce. You must use the mark in commerce and file a Statement of Use (a.k.a. Allegation of Use) before the USPTO will register the mark. You have SIX (6) MONTHS from the ISSUE DATE of this Notice of Allowance (NOA) to file either a Statement of Use, or if you are not yet using the mark in commerce, a Request for Extension of Time to File a Statement of Use ("Extension Request"). If you file an extension request, you must continue to file a new request every six months until the Statement of Use is filed. Applicant may file a total of five (5) extension requests. FAILURE TO FILE A REQUIRED DOCUMENT DURING THE APPROPRIATE TIME PERIOD WILL RESULT IN THE ABANDONMENT OF YOUR APPLICATION.

Please note that both the "Statement of Use" and "Extension Request" have many legal requirements including fees. Therefore, we encourage use of the USPTO forms, available online at http://www.uspto.gov/teas/index.html (under "File a PRE-registration form"), to avoid the possible omission of important information. Please note that the Trademark Electronic Application System (TEAS) provides line-by-line help instructions for completing the Extension Request or Statement of Use forms online. If you do not have access to the Internet, you may call 1-800-786-9199 to request the printed form(s).

The following information should be reviewed for accuracy.

SERIAL NUMBER: 78/475375
MARK: CONTOUR (STANDARD CHARACTER MARK)

OWNER: Surgical Specialties Corporation
100 Dennis Drive
Reading, PENNSYLVANIA 19606

This application has the following bases, but not necessarily for all listed goods/services:
Section 1(a): NO Section 1(b): YES Section 44(e): NO

GOODS/SERVICES BY INTERNATIONAL CLASS

010—Sutures for use in cosmetic and aesthetic procedures to elevate, suspend, and approximate the soft tissues of the brows, cheeks, breasts, buttocks or body
FIRST USE DATE: NONE; USE IN COMMERCE DATE: NONE

ADDITIONAL INFORMATION MAY BE PRESENT IN THE USPTO RECORDS

EXHIBIT C

Int. Cl.: 10

Prior U.S. Cls.: 26, 39 and 44

United States Patent and Trademark Office

Reg. No. 3,282,397
Registered Aug. 21, 2007

TRADEMARK
PRINCIPAL REGISTER

CONTOUR THREADS

SURGICAL SPECIALTIES CORPORATION (DELAWARE CORPORATION)
100 DENNIS DRIVE
READING, PA 19606

FOR: SUTURES FOR USE IN COSMETIC AND AESTHETIC PROCEDURES TO ELEVATE, SUSPEND, AND APPROXIMATE THE SOFT TISSUES OF THE BROWS, CHEEKS, BREAST, BUTTOCKS OR BODY, IN CLASS 10 (U.S. CLS. 26, 39 AND 44).

FIRST USE 1-19-2005; IN COMMERCE 1-19-2005.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "THREADS", APART FROM THE MARK AS SHOWN.

SER. NO. 78-570,451, FILED 2-18-2005.

STEPHANIE ALI, EXAMINING ATTORNEY

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2008-02-27 15:26:01 ET

Serial Number: 78570451 Assignment Information Trademark Document Retrieval

Registration Number: 3282397

Mark

CONTOUR THREADS

(words only): CONTOUR THREADS

Standard Character claim: Yes

Current Status: Registered.

Date of Status: 2007-08-21

Filing Date: 2005-02-18

Transformed into a National Application: No

Registration Date: 2007-08-21

Register: Principal

Law Office Assigned: LAW OFFICE 109

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 650 -Publication And Issue Section

Date In Location: 2007-08-21

LAST APPLICANT(S)/OWNER(S) OF RECORD

---

1. Surgical Specialties Corporation

Address:
Surgical Specialties Corporation
100 Dennis Drive
Reading, PA 19606
United States
Legal Entity Type: Corporation

State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

International Class: 010
Class Status: Active
Sutures for use in cosmetic and aesthetic procedures to elevate, suspend, and approximate the soft tissues of the brows, cheeks, breast, buttocks or body
Basis: 1(a)
First Use Date: 2005-01-19
First Use in Commerce Date: 2005-01-19

ADDITIONAL INFORMATION

Disclaimer: "THREADS"

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2007-08-21 - Registered - Principal Register

2007-06-05 - Published for opposition

2007-05-16 - Notice of publication

2007-04-03 - Law Office Publication Review Completed

2007-04-03 - Assigned To LIE

2007-03-11 - Approved for Pub - Principal Register (Initial exam)

2007-01-13 - Teas/Email Correspondence Entered

2007-01-12 - Communication received from applicant

2007-01-12 - TEAS Response to Office Action Received

2007-01-03 - Non-final action mailed

2006-12-31 - Non-Final Action Written

2006-12-05 - TEAS Change Of Correspondence Received

2006-11-14 - Amendment From Applicant Entered

2006-10-10 - Communication received from applicant

2006-11-13 - Petition Granted - Response Received

2006-11-13 - Assigned To Petition Staff

2006-10-10 - Petition To Revive-Received

2006-10-10 - PAPER RECEIVED

2006-09-26 - TEAS Change Of Correspondence Received

2006-03-22 - Non-final action mailed

2006-03-21 - Non-Final Action Written

2006-01-11 - Attorney Revoked And/Or Appointed

2006-01-11 - TEAS Revoke/Appoint Attorney Received

2005-12-15 - LIE Checked Susp - To Atty For Action

2005-05-13 - LETTER OF SUSPENSION E-MAILED

2005-05-13 - Suspension Letter Written

2005-05-12 - Teas/Email Correspondence Entered

2005-05-09 - Communication received from applicant

2005-05-09 - TEAS Response to Office Action Received

2005-03-29 - Non-final action e-mailed

2005-03-29 - Non-Final Action Written

2005-03-28 - Assigned To Examiner

2005-03-02 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record
Jennifer Lee Taylor

Correspondent
Jennifer Lee Taylor
Morrison & Foerster LLP
425 Market Street
San Francisco CA 94105-2482
Phone Number: 415 268 6538
Fax Number: 415 268 7522

EXHIBIT D

Int. Cl.: 44

Prior U.S. Cls.: 100 and 101

United States Patent and Trademark Office

Reg. No. 3,307,321

Registered Oct. 9, 2007

SERVICE MARK
PRINCIPAL REGISTER

CONTOUR THREADLIFT

SURGICAL SPECIALTIES CORPORATION (DELAWARE CORPORATION)
100 DENNIS DRIVE
READING, PA 19606

FOR: NONINVASIVE AND MINIMALLY INVASIVE COSMETIC AND AESTHETIC SURGERY SERVICES, IN CLASS 44 (U.S. CLS. 100 AND 101).

FIRST USE 8-0-2005; IN COMMERCE 8-0-2005.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NO. 3,064,776.

SER. NO. 78-953,411, FILED 8-16-2006.

PATRICIA EVANKO, EXAMINING ATTORNEY

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2008-02-27 15:23:44 ET

Serial Number: 78953411 Assignment Information Trademark Document Retrieval

Registration Number: 3307321

Mark

CONTOUR THREADLIFT

(words only): CONTOUR THREADLIFT

Standard Character claim: Yes

Current Status: Registered.

Date of Status: 2007-10-09

Filing Date: 2006-08-16

Transformed into a National Application: No

Registration Date: 2007-10-09

Register: Principal

Law Office Assigned: LAW OFFICE 117

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 650 -Publication And Issue Section

Date In Location: 2007-10-09

LAST APPLICANT(S)/OWNER(S) OF RECORD

---

1. Surgical Specialties Corporation

Address:
Surgical Specialties Corporation
100 Dennis Drive
Reading, PA 19606
United States
Legal Entity Type: Corporation

State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

International Class: 044
Class Status: Active
Noninvasive and minimally invasive cosmetic and aesthetic surgery services
Basis: 1(a)
First Use Date: 2005-08-00
First Use in Commerce Date: 2005-08-00

ADDITIONAL INFORMATION

Prior Registration Number(s):
3064776

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2007-10-09 - Registered - Principal Register

2007-07-24 - Published for opposition

2007-07-04 - Notice of publication

2007-06-19 - Law Office Publication Review Completed

2007-06-19 - Assigned To LIE

2007-05-21 - Approved for Pub - Principal Register (Initial exam)

2007-05-19 - Teas/Email Correspondence Entered

2007-05-18 - Communication received from applicant

2007-05-18 - TEAS Response to Office Action Received

2007-01-11 - Non-final action mailed

2007-01-10 - Non-Final Action Written

2007-01-09 - Assigned To Examiner

2006-09-13 - Assignment Of Ownership Not Updated Automatically

2006-08-24 - Notice Of Pseudo Mark Mailed

2006-08-23 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record
Jennifer Lee Taylor

Correspondent
JENNIFER LEE TAYLOR
MORRISON & FOERSTER LLP
425 MARKET STREET
SAN FRANCISCO, CA 94105-2482
Phone Number: 415 268 6538
Fax Number: 415 268 7522

EXHIBIT E

Int. Cl.: 44

Prior U.S. Cls.: 100 and 101

United States Patent and Trademark Office

Reg. No. 3,344,266

Registered Nov. 27, 2007

SERVICE MARK
PRINCIPAL REGISTER

SURGICAL SPECIALTIES CORPORATION (DELAWARE CORPORATION)
100 DENNIS DRIVE
READING, PA 19606

FOR: NONINVASIVE AND MINIMALLY INVASIVE COSMETIC AND AESTHETIC SURGERY SERVICES, IN CLASS 44 (U.S. CLS. 100 AND 101).

FIRST USE 8-0-2005; IN COMMERCE 8-0-2005.

OWNER OF U.S. REG. NO. 3,064,776.

THE MARK CONSISTS OF THE WORD CONTOUR ITALICIZED WITH THE WORD THREADLIFT BELOW IN A STYLIZED FORM WITH A FANCIFUL LETTER "T".

SER. NO. 78-952,833, FILED 8-15-2006.

PATRICIA EVANKO, EXAMINING ATTORNEY

Thank you for your request. Here are the latest results from the TARR web server.

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Serial Number: 78952833 Assignment Information Trademark Document Retrieval

Registration Number: 3344266

Mark

(words only): CONTOUR THREADLIFT

Standard Character claim: No

Current Status: Registered.

Date of Status: 2007-11-27

Filing Date: 2006-08-15

Transformed into a National Application: No

Registration Date: 2007-11-27

Register: Principal

Law Office Assigned: LAW OFFICE 117

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 650 -Publication And Issue Section

Date In Location: 2007-11-27

LAST APPLICANT(S)/OWNER(S) OF RECORD

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1. Surgical Specialties Corporation

Address:
Surgical Specialties Corporation
100 Dennis Drive
Reading, PA 19606
United States
Legal Entity Type: Corporation

State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

International Class: 044
Class Status: Active
noninvasive and minimally invasive cosmetic and aesthetic surgery services
Basis: 1(a)
First Use Date: 2005-08-00
First Use in Commerce Date: 2005-08-00

ADDITIONAL INFORMATION

Color(s) Claimed: Color is not claimed as a feature of the mark.

Description of Mark: The mark consists of the word CONTOUR italicized with the word THREADLIFT below in a stylized form with a fanciful letter "I".

Design Search Code(s):
26.11.21 - Rectangles that are completely or partially shaded
26.17.09 - Bands, curved; Bars, curved; Curved line(s), band(s) or bar(s); Lines, curved

Prior Registration Number(s):
3064776

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2007-11-27 - Registered - Principal Register

2007-09-11 - Published for opposition

2007-08-22 - Notice of publication

2007-08-07 - Law Office Publication Review Completed

2007-08-03 - Approved for Pub - Principal Register (Initial exam)

2007-08-01 - Amendment From Applicant Entered

2007-08-01 - Communication received from applicant

2007-08-01 - Assigned To LIE

2007-07-13 - PAPER RECEIVED

2007-01-11 - Non-final action mailed

2007-01-10 - Non-Final Action Written

2007-01-09 - Assigned To Examiner

2006-09-13 - Assignment Of Ownership Not Updated Automatically

2006-08-19 - Notice Of Design Search Code Mailed

2006-08-18 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

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TRADEMARK
Docket No. 60202-6003.501

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

Surgical Specialties Corporation Opposer v. Diamond Dermabrasion Sr Pty Ltd, Applicant	Opposition No. 91177788 Serial No.: 79/016,744

DECLARATION OF RUI AVELAR IN SUPPORT OF SURGICAL SPECIALTIES CORPORATION'S MOTION FOR SUMMARY JUDGMENT

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Sir:

I, Rui Avelar, declare as follows:

1. I am Chief Medical Officer of Angiotech Pharmaceuticals, Inc ("Angiotech") and have held this position since 2006. I make this declaration in support of Surgical Specialties Corporation's Motion for Summary Judgment. If called as a witness, I could and would testify to the facts stated herein.

2. Surgical Specialties Corporation ("Surgical Specialties") is a subsidiary of American Medical Instruments Holdings, Inc. ("AMIH"). AMIH is a subsidiary of Angiotech Pharmaceuticals (US), Inc. and Angiotech Pharmaceuticals (US), Inc. is a subsidiary of Angiotech. Angiotech Pharmaceuticals (US), Inc. acquired AMIH in 2006; thereby giving Angiotech ownership of Surgical Specialties and its businesses.

3. Surgical Specialties develops and markets medical products that can be used in a wide variety of medical applications and procedures. Recently, Surgical Specialties has

developed products for use in wound closure, ophthalmic applications, and cosmetic and aesthetic procedures. Starting in February 2005, Surgical Specialties used the CONTOUR and CONTOUR THREADS trademarks in connection with sutures that it developed and marketed for use in cosmetic and aesthetic procedures. Angiotech refers to this as the "Contour Aesthetics division." After the acquisition of AMIH in 2006, I was the acting President of the Contour Aesthetics division, which continued to be operated by Surgical Specialties.

4. Based upon my work with the Contour Aesthetics division of Surgical Specialties, I am familiar with the cosmetic and aesthetic surgery business, including the types of doctors who offer cosmetic and aesthetic surgery procedures, the channels of trade through which these doctors advertise their services and through which these doctors purchase products, the alternative procedures available for minimally invasive and non-surgical facelift procedures, and the types of products offered by Surgical Specialties's competitors.

5. Surgical Specialties's CONTOUR and CONTOUR THREADS sutures were designed to be used by physicians trained and practicing in the aesthetics field, including general practitioners, reconstructive and aesthetic plastic surgeons, dermatologists and maxillofacial surgeons, for cosmetic and aesthetic skin treatments, specifically a minimally invasive, non-surgical facelift procedure designed to rejuvenate the skin.

6. In an effort to boost recognition of its CONTOUR brand among patients as well as doctors, starting in August 2005 Surgical Specialties arranged for the training of doctors to perform a procedure that came to be called the CONTOUR THREADLIFT and licensed those doctors to use the terms CONTOUR, THREADLIFT, and/or CONTOUR THREADLIFT in their marketing and promotional materials. Through this program, Surgical Specialties licensed hundreds of doctors to use the CONTOUR, THREADLIFT, and CONTOUR THREADLIFT trademarks. As a result of this program and widespread licensed use of the CONTOUR, THREADLIFT, and CONTOUR THREADLIFT trademarks, the "CONTOUR" trademark is well-known to the public that is considering cosmetic or aesthetic procedures. A search on

Google for "CONTOUR THREAD" locates over 14,000 "hits," many of which are links to websites where doctors are offering the CONTOUR THREADLIFT® procedure, demonstrating that the term CONTOUR has been widely marketed to patients and is not merely a term that is used among physicians. A copy of a search on Google for "CONTOUR THREAD" is attached hereto as Exhibit A.

7. I have reviewed Diamond Dermabrasion's website at www.diamondincorporated.com and its application to register CONTOURS as a trademark. From my review of its website, I understand that Diamond Dermabrasion's products are also designed to be used for cosmetic and aesthetic skin treatments and that its products can be used for minimally invasive or non-invasive and non-surgical procedures designed to rejuvenate the skin, including facial treatments and lifts. Diamond Dermabrasion also appears to be operating a chain of medical spas that offer various skin and body treatments. Printouts of excerpts from Diamond Dermabrasion's website are attached hereto as Exhibit B.

8. I view Diamond Dermabrasion as a competitor of Surgical Specialties as the Diamond Dermabrasion CONTOURS product appears to offer an alternative to the minimally invasive, non-surgical facelift procedure designed to rejuvenate the skin that doctors are able to perform with Surgical Specialties's CONTOUR and CONTOUR THREADS products. Thus, if a patient receives a cosmetic or aesthetic treatment using the Diamond Dermabrasion CONTOURS product, that patient would no longer be interested in or have need for a procedure using Surgical Specialties's CONTOUR and CONTOUR THREADS products.

9. The cosmetic and aesthetic procedures field has been undergoing significant changes and growing rapidly over the past several years. In contrast with the limited number of invasive surgical options available in the past, there is now an ever-increasing array of non-invasive or minimally invasive cosmetic and aesthetic procedures. Some of these procedures are more surgical in nature, and some are more akin to a skin rejuvenation or refreshening procedure involving "dermabrasion" or "peels." Many of these procedures are designed to be done in a

short period of time and at relatively low costs, including in the form of "lunchtime facelifts" and Botox injections.

10. The changes in the field have led to an entirely new form of business: the medical spa – a location where patients are pampered and may receive services ranging surgical facelift procedures to eyebrow shaping. These medical spas are stark contrasts to the sterile environments used by doctors performing more traditional and invasive surgical procedures. As consumers have been deluged with an increasing number of options of medical spas and procedures, they have become less able to distinguish between options and are more likely to seek the newest procedure advertised on television, on the Internet, or recommended by a friend. As a result, and given the relatively low prices charged by many doctors and medical spas, consumers are beginning to view cosmetic and aesthetic procedures as impulse items – something to make them look younger and better with minimal investment of time and money.

11. In light of the changing nature of the cosmetics and aesthetic procedure field, and the overall growth of the medical spa industry, and given that both parties' products are designed to be used in competing procedures, confusion will inevitably result if Diamond Dermabrasion commences use of its CONTOURS mark. Patients will not be able to distinguish between a "CONTOURS" procedure using Diamond Dermabrasion's CONTOURS product and a competing "CONTOUR" procedure using Surgical Specialties's CONTOUR and CONTOUR THREADS products. The fact that both marks have been used and/or are intended to be used in connection with promoting cosmetic and aesthetic treatment services to the public will only exacerbate the confusion, as patients may make an appointment for a "CONTOUR" procedure without realizing that there are two types of "CONTOUR" procedures available.

12. Moreover, if a doctor purchases both CONTOUR products from Surgical Specialties and a CONTOURS product from Diamond Dermabrasion, that doctor may use both the CONTOUR trademark and the CONTOURS trademark in his or her advertising. This will further confuse the public.

13. In addition to confusing the public in general, I believe that it is likely that the doctors that purchase both parties' products may be confused. Surgical Specialties began offering its CONTOUR THREADS products in January 2005. The product, and the then newly developed THREADLIFT procedure, received widespread press coverage, including segments on such nationally syndicated programs as The Today Show. As a result, doctors who perform cosmetic and aesthetic procedures are already quite familiar with Surgical Specialties's CONTOUR and CONTOUR THREADS products. If Diamond Dermabrasion offers its CONTOURS product to the doctors who are already familiar with Surgical Specialties's CONTOUR and CONTOUR THREADS products, those doctors are likely to assume that the new CONTOURS product comes from the same source as the CONTOUR and CONTOUR THREADS products with which they are familiar.

14. Surgical Specialties first became aware of Diamond Dermabrasion's application to register CONTOURS as a trademark when that application was published for opposition in the Official Gazette. Surgical Specialties and Diamond Dermabrasion have not entered into any agreements regarding Diamond Dermabrasion's CONTOURS trademark.

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine and imprisonment pursuant to Section 1001 of Title 18 of the U.S. Code and that such willful false statements may jeopardize the validity of the application or any registration resulting therefrom, declares that all of the above statements made of my own knowledge are true and all statements made on information and belief are believed by me to be true.

Executed on this 26th day of February, 2008 in Vancouver, British Columbia, Canada.

By: [signature]
Rui Avelar

EXHIBIT A

Web Results 1 - 10 of about 14,300 for "contour thread" (0.14 seconds)

contour thread lift

For over 30 years, Surgical Specialties Corporation has consistently provided surgeons with innovative products of the highest quality. ...
www.contourthreads.com/ - 3k - Cached - Similar pages

Contour Thread Lift

Contour Thread Lift ... Quick Links. Find your **Contour Thread Lift** doctor. Research > **Contour Thread Lift**. Research a cosmetic surgery procedure ...
www.cosmeticsurgery.com/[illegible]/cosmetic-surgery/Contour-Thread-Lift/ - 24k - Cached - Similar pages

Contour Thread Lift - A Board Certified Plastic Surgeon Resource

Contour thread lift is one of the latest developments in plastic surgery, and the noninvasive, short recovery procedure is expected to become one of the ...
www.aboardcertifiedplasticsurgeonresource.com/facelift/Contour-thread.html - 38k - Cached - Similar pages

Thread Lift - Facial Cosmetic Procedures - Contour Thread™ Lift

Thread Lift - Facial Cosmetic Procedures - **Contour Thread™** Lift - Cosmetic & Plastic Surgery - Marc J. Salzman, MD, FACS - Dr. Salzman routinely performs ...
www.[illegible].com/[illegible].php - 30k - Cached - Similar pages

Contour thread lift: is it worth it? Contour thread lift reviews ...

Get the latest unbiased **Contour thread** lift reviews, **Contour thread** lift pictures, and expert tips you need to know about **Contour thread** lift before you ...
www.realself.com/plastic_surgery/face-lift/contour_thread_lift.html - [illegible]k - Cached - Similar pages

Contour Thread Lift Overview - NewImage.com

Contour thread lift as an alternative to full face lift — NewImage.com.
www.newimage.com/cosmetic-plastic-surgery/face/contour-thread-lift-overview.aspx - 31k - Cached - Similar pages

COMPARISON OF CONTOUR THEADLIFT AND A FACELIFT
CONTOUR THREAD. FACELIFT. ANESTHETIC. LOCAL. SEDATION OR GENERAL. DISCOMFORT. LESS. MORE. SCARS. NONE. YES. TIME TO DO. <1HR. >1.5 HRS. LOCATION. OFFICE ...
www.[illegible].com/contourthreads/comparison_contourthreads.html - 62k -
Cached - Similar pages

BE Medical Spa - Contour Thread Lift™
Performed by Peter G. Kamhout, MD, at Be Medical Spa, the **Contour Thread** Lift is a simple, office based, outpatient non-surgical facelift procedure. ...
bemedicalspa.com/content/view/15/28/ - 18k - Cached - Similar pages

Contour Thread Lift News
The average fee for a **Contour thread** browlift and necklift are $2500 each. Faces generally run $4000 for both the jawline and cheek pad areas when done ...
contourthreadlift.blogspot.com/ - 35k - Cached - Similar pages

Well Past 50: The Weblog of Boomerful.com: Contour Thread Lift ...
At Well Past 50 we get more comments on our video and blog entry regarding my **Contour Thread** Lift than any other topic on the site. ...
wellpast50.blogs.com/well_past_50/2007/01/contour_thread_.html - 28k
Cached - Similar pages

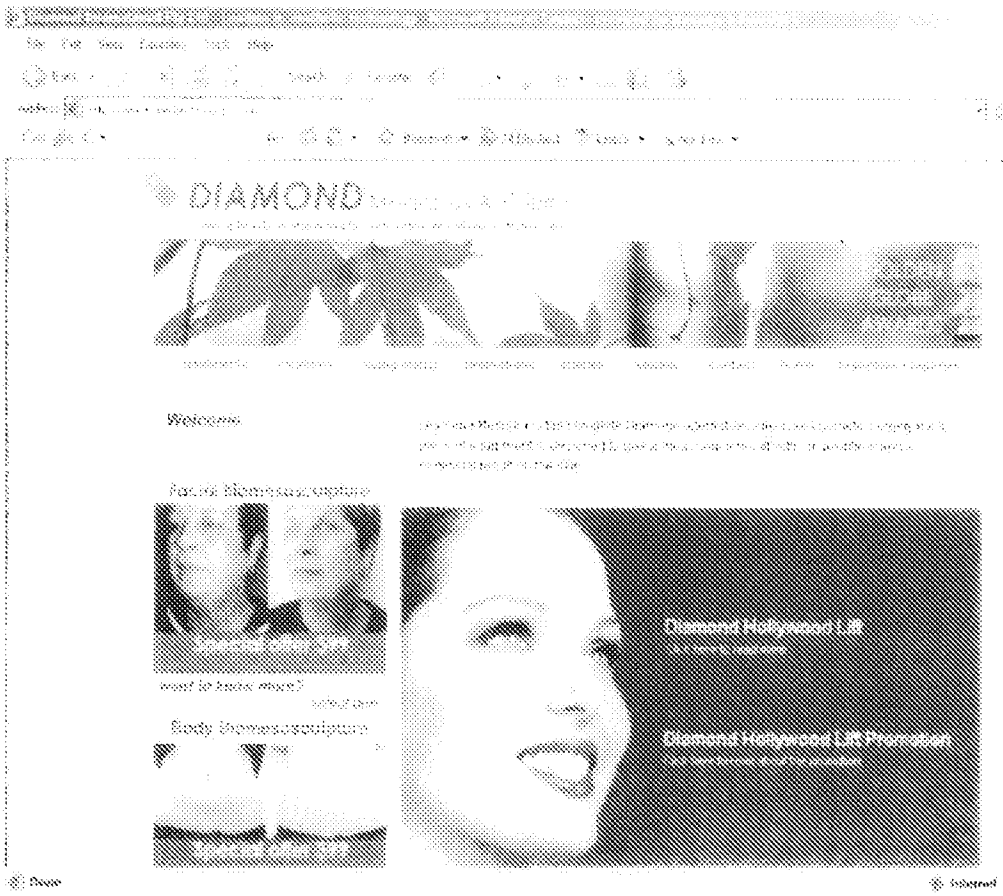
1 2 3 4 5 6 7 8 9 10 Next

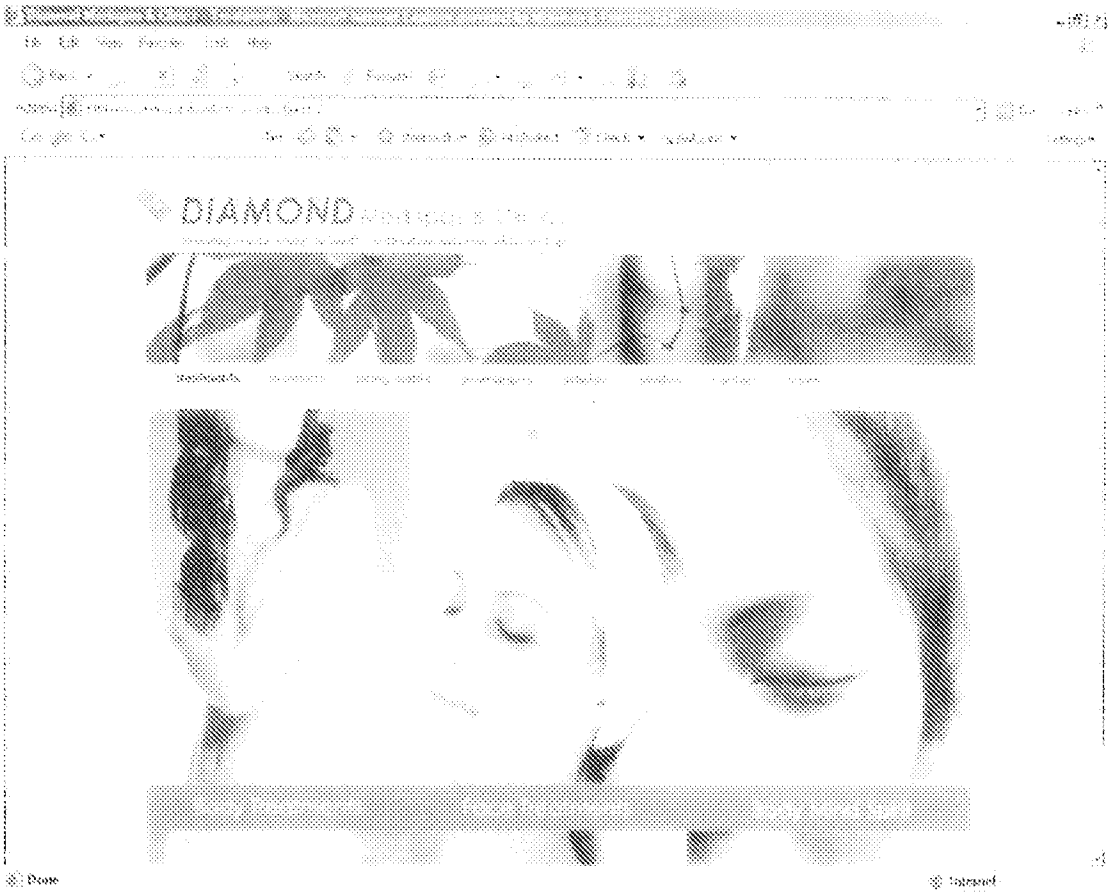
"contour thread" Search

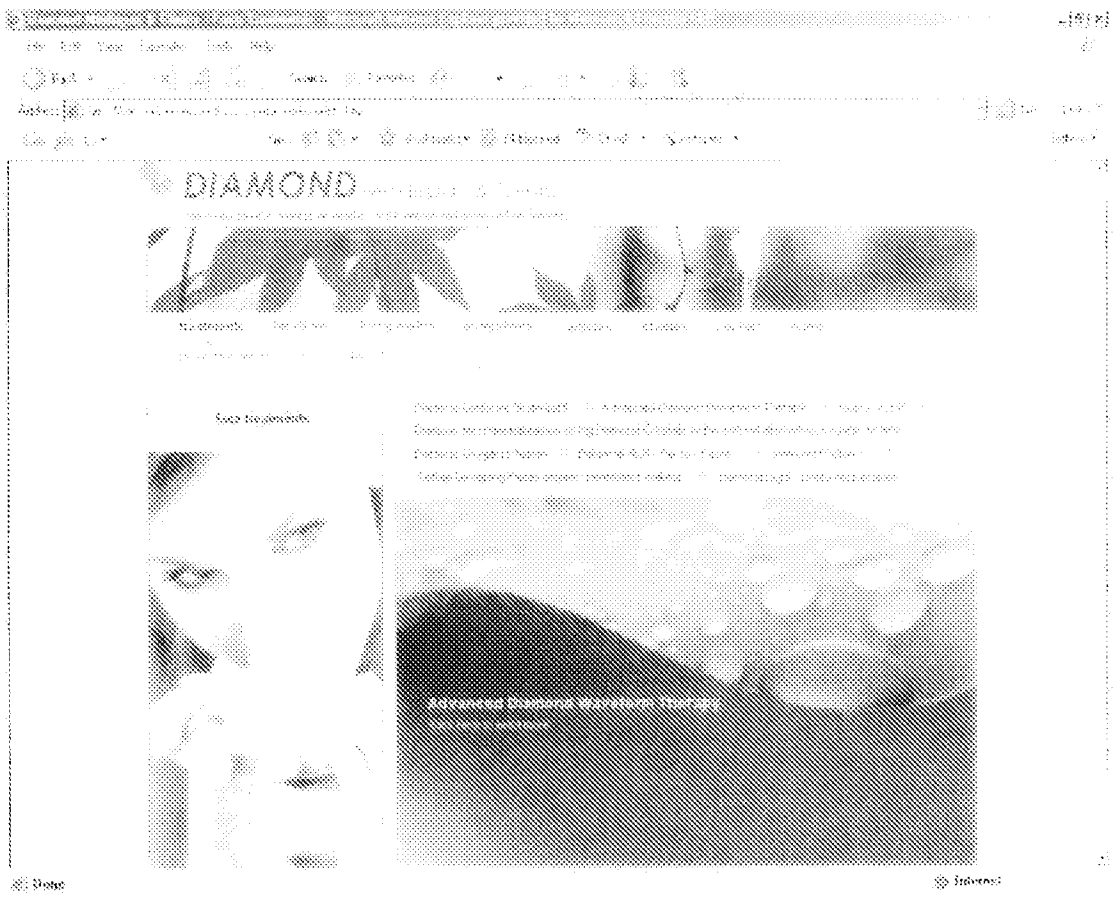
Search within results | Language Tools | Search Tips | Dissatisfied? Help us improve | Try Google Experimental

EXHIBIT B

DIAMOND


DIAMOND
Welcome
Facial Biometrics capture
Body Biometrics capture
Diamond Hollywood Lift
Diamond Hollywood Lift Progressive


DIAMOND


DIAMOND