

ESTTA Tracking number: **ESTTA418163**

Filing date: **07/06/2011**

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

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	Kiss My Face, LLC
Granted to Date of previous extension	07/06/2011
Address	11766 WILSHIRE BOULEVARDSUITE 850 LOS ANGELES, CA 900256567 UNITED STATES

Attorney information	David O. Johanson, Esq. Bingham McCutchen LLP One Federal Street Boston, MA 02110 UNITED STATES david.johanson@bingham.com Phone:617-951-8000
----------------------	--

**Applicant Information**

Application No	85138743	Publication date	03/08/2011
Opposition Filing Date	07/06/2011	Opposition Period Ends	07/06/2011
Applicant	ALOXI INTERNATIONAL CORPORATION 14144 Ventura Boulevard, Suite 110 Sherman Oaks, CA 91423 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 003. All goods and services in the class are opposed, namely: HAIR BLEACHING PREPARATIONS, NON-MEDICATED HAIR CARE PREPARATIONS, HAIR CLEANING PREPARATIONS, HAIR COLOR REMOVERS, HAIR COLORING PREPARATIONS, HAIR LIGHTENERS, HAIR COLORING RINSE, HAIR LIGHTENING BLEACH, HAIR RINSES, HAIR COLORANTS, ALL IN THE FORM OF LIQUID, GEL AND CREAM
--

**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)
Other	LACK OF BONA FIDE INTENT TO USE APPLICANT#S MARK

**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration	1513297	Application Date	04/28/1988
-------------------	---------	------------------	------------

No.			
Registration Date	11/22/1988	Foreign Priority Date	NONE
Word Mark	KISS MY FACE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1978/12/01 First Use In Commerce: 1978/12/01 PERSONAL CARE PRODUCTS--NAMELY, SHAMPOOS, SOAPS, CREME RINSES, SKIN TONERS AND SKIN LOTIONS		

U.S. Registration No.	2301324	Application Date	09/22/1997
Registration Date	12/21/1999	Foreign Priority Date	NONE
Word Mark	KISS MY FACE		
Design Mark	<b>KISS MY FACE</b>		
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1993/06/00 First Use In Commerce: 1993/06/00 non-medicated lip balms, cosmetics, namely, lipsticks, [ mascaras, ] foundations, conditioners, [ body mists, ] bath and body gels, facial creams, hand lotions, deodorants, soaps, shaving creams, skin lotions, skin toners and facial and body lotions		

U.S. Registration No.	1991868	Application Date	08/01/1994
Registration Date	08/06/1996	Foreign Priority Date	NONE
Word Mark	KISS MY FACE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1994/11/01 First Use In Commerce: 1994/11/01 retail shops featuring clothing, and personal care products, namely shampoos, soaps, creme rinses, powders, skin toners and skin lotions		

U.S. Registration No.	3590613	Application Date	07/28/2008
Registration Date	03/17/2009	Foreign Priority Date	NONE
Word Mark	KISS MY FACE MOISTURE SOAP		

Design Mark	<b>KISS MY FACE MOISTURE SOAP</b>		
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1986/06/00 First Use In Commerce: 1986/06/00 personal care products, namely, soaps		

U.S. Registration No.	3120791	Application Date	11/14/2005
Registration Date	07/25/2006	Foreign Priority Date	NONE
Word Mark	KISS MY FACE WOMEN'S		
Design Mark	<b>KISS MY FACE WOMEN'S</b>		
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 2005/01/18 First Use In Commerce: 2005/01/18 Personal Care Products, Namely, Toothpaste		

U.S. Registration No.	3120790	Application Date	11/14/2005
Registration Date	07/25/2006	Foreign Priority Date	NONE
Word Mark	KISS MY FACE WAKE UP		

Design Mark	<b>KISS MY FACE WAKE UP</b>		
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 2005/01/18 First Use In Commerce: 2005/01/18 Personal Care Products, Namely, Toothpaste		

U.S. Registration No.	3120784	Application Date	10/14/2005
Registration Date	07/25/2006	Foreign Priority Date	NONE
Word Mark	KISS MY FACE WHITENING		
Design Mark	<b>KISS MY FACE WHITENING</b>		
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 2001/11/05 First Use In Commerce: 2001/11/05 Personal Care Products, Namely, Toothpastes		

U.S. Registration No.	3120755	Application Date	08/22/2005
Registration Date	07/25/2006	Foreign Priority Date	NONE
Word Mark	KISS MY FACE TRIPLE ACTION		

Design Mark	<b>Kiss My Face Triple Action</b>
Description of Mark	NONE
Goods/Services	Class 003. First use: First Use: 2001/11/05 First Use In Commerce: 2001/11/05 Toothpaste

U.S. Registration No.	3005002	Application Date	11/19/2003
Registration Date	10/04/2005	Foreign Priority Date	NONE
Word Mark	FACE FACTOR		
Design Mark	<b>FACE FACTOR</b>		
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 2004/03/03 First Use In Commerce: 2004/03/03 Facial Cream		

U.S. Registration No.	3978448	Application Date	02/13/2008
Registration Date	06/14/2011	Foreign Priority Date	NONE
Word Mark	LICK MY FACE		

Design Mark	<b>LICK MY FACE</b>
Description of Mark	NONE
Goods/Services	Class 003. First use: First Use: 2011/04/13 First Use In Commerce: 2011/04/13 non-medicated grooming preparations for pets, namely, shampoos

U.S. Registration No.	2422646	Application Date	12/14/1998
Registration Date	01/23/2001	Foreign Priority Date	NONE
Word Mark	KISS ORGANICS		
Design Mark	<b>KISS ORGANICS</b>		
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1998/09/10 First Use In Commerce: 1998/09/10 non-medicated skin care preparations		

U.S. Registration No.	2695981	Application Date	09/22/1997
Registration Date	03/11/2003	Foreign Priority Date	NONE
Word Mark	KISS KIDS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1997/04/00 First Use In Commerce: 1997/04/00 personal care products, namely, [ conditioners, ] bath and body gels, [ shampoos, soaps, ] creme rinses Class 025. First use: First Use: 1997/04/00 First Use In Commerce: 1997/04/00 [ Clothing, namely, knitted tops, knitted shirts and T-shirts ]		



	soaps, non-medicated lip balms, personal care products, namely, facial creams, foot creams, hand creams, deodorants for personal use, hair conditioners, hair detanglers, hair styling gels, mouthwashes, breath fresheners, shampoos, shaving creams, toothpastes, non-medicated sun care preparations and non-medicated sunscreen preparations Class 004. First use: Candles
--	--

Attachments	75361218#TMSN.gif ( 1 page )( bytes ) 77532702#TMSN.jpeg ( 1 page )( bytes ) 78753495#TMSN.jpeg ( 1 page )( bytes ) 78753453#TMSN.jpeg ( 1 page )( bytes ) 78733434#TMSN.jpeg ( 1 page )( bytes ) 78697583#TMSN.jpeg ( 1 page )( bytes ) 78330056#TMSN.jpeg ( 1 page )( bytes ) 77395711#TMSN.jpeg ( 1 page )( bytes ) 75605277#TMSN.gif ( 1 page )( bytes ) 76244846#TMSN.gif ( 1 page )( bytes ) 85023142#TMSN.jpeg ( 1 page )( bytes ) Notice of OppositionKMA.pdf ( 11 pages )(464803 bytes )
-------------	--

### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/devon sparrow/
Name	Devon R. Sparrow
Date	07/06/2011



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

---

In re Application Serial No. 85/138,743	)
Published in the Official Gazette of March 8, 2011	)
Mark: KISS MY ASSISI	)
Application Filing Date: September 27, 2010	)
Kiss My Face, LLC,	)
Opposer,	)
v.	)
Aloxxi International Corporation,	)
Applicant.	)

---

**NOTICE OF OPPOSITION**

Opposer, Kiss My Face, LLC (“Opposer”) believes that it will be damaged by the issuance of a registration for the mark KISS MY ASSISI (“Applicant’s Mark”), with respect to the goods in international class 3, namely, “*hair bleaching preparations, non-medicated hair care preparations, hair cleaning preparations, hair color removers, hair coloring preparations, hair lighteners, hair coloring rinse, hair lightening bleach, hair rinses, hair colorants, all in the form of liquid, gel and cream,*” as applied for in Application Serial No. 85/138,743, as filed by Aloxxi International Corporation (“Applicant”), and hereby opposes the same.

As grounds for this Opposition, Opposer alleges as follows:

1. Applicant is, upon information and belief, a corporation organized and existing under the laws of California, with a principal place of business at 14144 Ventura Boulevard, Suite 110, Sherman Oaks, California 91423.
2. Opposer is a limited liability company organized and existing under the laws of the State of Delaware, with a principal place of business at 11766 Wilshire Boulevard, Suite 850, Los Angeles, California 90025-6567.
3. Since at least as early as 1978, Opposer's affiliate and predecessor-in-interest, Kiss My Face Corporation, has used the KISS MY FACE family of trade names and trademarks (the "KISS MY FACE Marks") to promote and reference its line of personal care products.
4. Since it was established in or about 1980, and pursuant to an agreement with Kiss My Face Corporation, Opposer has operated a business under the KISS MY FACE Marks.
5. On or about November 8, 2010, Kiss My Face Corporation assigned the title and interest to the KISS MY FACE Marks, along with the accompanying goodwill in such Marks, to Opposer. The assignment was recorded with the U.S. Patent and Trademark Office on November 16, 2010.
6. Since their initial use of the KISS MY FACE Marks, Opposer and its predecessor-in-interest have made substantial investments in advertising and promoting the goods and services it provides under the KISS MY FACE Marks, with the result that consumers have come to know and recognize Opposer's Marks, and associate the same with Opposer and/or the goods and services provided by Opposer. Opposer, together with its predecessor-in-interest, has built

up extensive goodwill in connection with the provision of its personal care products and services under its Marks.

7. Opposer is the owner of the following United States Trademark Registrations:

Reg. Number	Mark	Goods in International Class 3 (except as otherwise noted)	Status	Date of First Use	Reg. Date
1513297	KISS MY FACE	Non-medicated hair care preparations, namely shampoos	Registered	December 1, 1978	November 22, 1988
2301324	KISS MY FACE	Non-medicated lip balms, cosmetics, namely, lipsticks, foundations, conditioners, bath and body gels, facial creams, hand lotions, deodorants, soaps, shaving creams, skin lotions, skin toners and facial and body lotions	Registered	June, 1993	December 21, 1999
1991868	KISS MY FACE	Retail shops featuring clothing, and personal care products, namely shampoos, soaps, creme rinses, powders, skin toners and skin lotions (International Class 42)	Registered	November 1, 1994	August 6, 1996
3590613	KISS MY FACE MOISTURE SOAP	Personal care products, namely, soaps	Registered	June, 1986	March 17, 2009
3120791	KISS MY FACE WOMEN'S	Personal care products, namely, toothpaste	Registered	January 18, 2005	July 25, 2006
3120790	KISS MY FACE WAKE UP	Personal care products, namely, toothpaste	Registered	January 18, 2005	July 25, 2006
3120784	KISS MY FACE WHITENING	Personal care products, namely, toothpastes	Registered	November 5, 2001	July 25, 2006
3120755	KISS MY FACE TRIPLE ACTION	Toothpaste	Registered	November 5, 2001	July 25, 2006
3005002	FACE FACTOR	Facial cream	Registered	March 3, 2004	October 4, 2005
3978448	LICK MY FACE	Non-medicated grooming preparations for pets, namely, shampoos	Registered	April 13, 2011	June 14, 2011
2422646	KISS ORGANICS	Non-medicated skin care preparations	Registered	September 10, 1998	January 23, 2001
2695981	KISS KIDS	Personal care products, namely, bath and body gels, creme rinses	Registered	April, 1997	March 11, 2003
1902308	KISS AND GO!	Non-medicated hair care preparations, namely shampoos	Registered	September 28, 1992	July 4, 1995
2706187	KISS MY FACE	Clothing, namely, t-shirts (International Class 25)	Registered	March, 1980	April 15, 2003

8. Opposer is also the owner of pending U.S. Application Serial No. 85023142, for the mark KISS MY FACE PEACE (and Design), for *“all purpose soaps, bar soaps, bath and shower gels, body lotions, body washes, cosmetics, foaming soaps, hand lotions, body creams and body balms, liquid soaps, non-medicated lip balms, personal care products, namely, facial*

*creams, foot creams, hand creams, deodorants for personal use, hair conditioners, hair detanglers, hair styling gels, mouthwashes, breath fresheners, shampoos, shaving creams, toothpastes, non-medicated sun care preparations and non-medicated sunscreen preparations,”* in class 3, which was filed on a Section 1(b) intent-to-use basis.

9. Notwithstanding Opposer’s prior rights in and to the Marks, on or about September 27, 2010, Applicant filed a federal intent-to-use registration application with the U.S. Patent and Trademark Office (the “PTO”) for the mark KISS MY ASSISI for use in connection with “*hair bleaching preparations, non-medicated hair care preparations, hair cleaning preparations, hair color removers, hair coloring preparations, hair lighteners, hair coloring rinse, hair lightening bleach, hair rinses, hair colorants, all in the form of liquid, gel and cream*” in international class 3 (the “Applicant’s Goods”). The PTO assigned Serial No. 85/138,743 to this filing.

10. Upon information and belief, Applicant’s KISS MY ASSISI application was filed with the PTO with knowledge of Opposer’s prior use of and rights in the KISS MY FACE Marks for the same or similar or related goods and services. Applicant’s knowledge of Opposer’s rights in its Marks is further supported by the fact that both parties are in the same industry in the United States.

11. Applicant’s use of a confusingly similar mark in connection with the same or similar or related goods is likely to cause significant confusion as to source, sponsorship, and affiliation and will falsely suggest a connection with Opposer.

**GROUND I – LIKELIHOOD OF CONFUSION**

12. Opposer hereby incorporates by reference the allegations of Paragraphs 1 through 11 hereof as if fully set forth herein.

13. Registration by Applicant of the Applicant's Mark for use in connection with the Applicant's Goods would seriously damage Opposer and should be refused because use and/or registration of the Applicant's Mark is likely to cause confusion in the minds of the public and deceive purchasers. The public, upon seeing Applicant's Mark in connection with Applicant's Goods, would believe that such goods originate with, or have some connection with, the Opposer. Opposer avers that Applicant's use of said mark interferes with Opposer's use of its Marks, and will and does impede Opposer in the free use of said Marks, and that registration of the Applicant's Mark by Applicant for use in connection with the Applicant's Goods will seriously damage the Opposer under 15 U.S.C. §1052(d).

14. Applicant's Mark, when used in connection with the Applicant's Goods, is also likely to cause confusion, deception, and mistake with Opposer's Marks because Applicant's Mark is very visually and audibly similar to Opposer's Marks. Specifically, Applicant's Mark, "KISS MY ASSISI," is identical to the dominant "KISS MY" portion of the Opposer's KISS MY FACE trade names and trademarks. The parties' respective KISS MY FACE Marks on the one hand, and KISS MY ASSISI mark on the other, are also highly similar in sight, sound and overall connotation. Further, the Opposer's use of "FACE" in its marks, does not serve to distinguish the marks, because Applicant's Mark uses the identical terms KISS MY, and KISS MY is featured in both parties' marks.

15. Applicant's Mark, when used in connection with the Applicant's Goods, is also likely to cause confusion, deception, and mistake with Opposer's Marks because Applicant's Mark is used on and with goods (namely, "*hair bleaching preparations, non-medicated hair care preparations, hair cleaning preparations, hair color removers, hair coloring preparations, hair lighteners, hair coloring rinse, hair lightening bleach, hair rinses, hair colorants, all in the form of liquid, gel and cream*") that are similar or related to certain of the goods and services provided under Opposer's KISS MY FACE trade names and trademarks, namely, "*hair shampoo and conditioner, hair detanglers, hair creme rinse, hair styling gels, and hair masque,*" and retail stores selling such products (collectively, the "Opposer's Goods and Services").

16. Applicant's Mark, when used in connection with the Applicant's Goods, is also likely to cause confusion, deception, and mistake with Opposer's Marks as the parties' respective marks are both intended for use in connection with similar goods. Moreover, the goods and services provided by the parties in connection with their respective marks are both likely to be offered in the same and/or similar channels of trade, and to the same and/or similar customers, and therefore are likely to be mistakenly viewed by Opposer's customers and potential customers as a natural expansion of Opposer's products and services.

17. If Applicant is permitted to register and use its KISS MY ASSISI mark, as specified in its application, confusion in trade and in the minds of the public resulting in injury to the Opposer would likely result. Persons familiar with Opposer's Marks, the associated goods for which are known as "natural," would likely purchase Applicant's goods under the impression that products were made and sold by Opposer, or at least believe that Applicant's products were sanctioned, authorized, licensed by or related to Opposer. Furthermore, any defect, objection or

fault found with Applicant's products marketed under its mark would likely reflect upon and injure the reputation Opposer has established with respect to the goods sold under its aforementioned KISS MY FACE marks.

18. Registration of Applicant's Mark for use in connection with the Applicant's Goods would be prima facie evidence of rights of Applicant under 15 U.S.C. § 1057(b), to the detriment of Opposer's rights in its KISS MY FACE trade names and trademarks.

19. Pursuant to 15 U.S.C. §1063(a), as amended, Opposer believes it will be damaged by the registration sought by Applicant because such registration will support and assist Applicant in the infringing use of the Applicant's Mark sought to be registered, and will give colorable exclusive statutory rights to Applicant in violation and derogation of prior and superior statutory and common law rights of Opposer.

## **GROUND II - DILUTION**

20. Opposer hereby incorporates by reference the allegations of Paragraphs 1 through 19 hereof as if fully set forth herein.

21. Because of the high degree of distinctiveness of Opposer's KISS MY FACE trade names and trademarks, the length of time and extent to which Opposer, together with its predecessor-in-interest, has used its KISS MY FACE trade names and trademarks, the extensive advertising and publicity Opposer's KISS MY FACE trade names and trademarks have received, the national and global trading areas in which the Opposer's KISS MY FACE trade names and trademarks are used, and the high degree of recognition of the Opposer's KISS MY FACE trade names and trademarks in the personal care industry, Opposer's KISS MY FACE trade names and trademarks are famous trade names and marks pursuant to 15 U.S.C. §1125(c)(1).

22. Registration of Applicant's Mark for use in connection with Applicant's Goods would lessen the capacity of Opposer's famous Marks to identify and distinguish Opposer's Goods under its KISS MY FACE marks and, as such, would cause dilution of the Marks in violation of 15 U.S.C. §§ 1125(c) and 1127.

23. Due to fact that Applicant's Mark evokes a popular vulgar and profane phrase, namely, "KISS MY ASS," the Registration of Applicant's Mark for use in connection with Applicant's Goods would cause tarnishment of the KISS MY FACE Marks in violation of 15 U.S.C. §§ 1125(c) and 1127.

24. Pursuant to 15 U.S.C. § 1063(a), as amended, Opposer believes it will be damaged by the registration sought by Applicant for use in connection with the Applicant's Goods because such registration will support and assist Applicant in the infringing and diluting use of its KISS MY ASSISI mark sought to be registered, and will give colorable exclusive statutory rights to Applicant in violation and derogation of prior and superior statutory and common law rights of Opposer.

25. For the reasons set forth herein, pursuant to 15 U.S.C. § 1063(a), as amended, Opposer believes that registration by Applicant of the Applicant's Mark for use in connection with the Applicant's Goods would seriously damage Opposer and should be refused because use and/or registration of the Applicant's Mark is likely to cause dilution of Opposer's famous KISS MY FACE trade names and trademarks and customer confusion as to source, origin, affiliation, or sponsorship between Applicant and Opposer and/or their respective goods and services.



**GROUND III - LACK OF BONA FIDE INTENT TO USE APPLICANT'S MARK**

26. Opposer hereby incorporates by reference the allegations of Paragraphs 1 through 25 hereof as if fully set forth herein.

27. Between the month-long period between August 25, 2010 and September 25, 2010, Applicant filed with the U.S. Patent and Trademark Office over 100 intent-to-use trademark registration applications, all of which identify hair color, hair color removers, hair lighteners, hair bleach, hair coloring rinse, hair rinses, and related hair care preparations.

28. Pursuant to the Senate Report on the Trademark Law Revision Act of 1988, the Opposer believes that the very large number of intent-to-use applications filed by the Applicant in such a short time span constitutes "an excessive number of intent-to-use applications in relation to the number of products the Applicant is likely to introduce under the applied-for marks during the pendency of the applications," and as such evidences the Applicant's lack of a bona fide intention to use the Applicant's Mark, in violation of 15 U.S.C. § 1051(b). Sen. Comm. on the Judiciary, Report on S. 1883, S. Rep. No. 100-515, at 23 (1988).

29. For the reasons set forth herein, pursuant to 15 U.S.C. § 1063(a), as amended, Opposer believes that registration by Applicant of the Applicant's Mark for use in connection with the Applicant's Goods would seriously damage Opposer and should be refused because the Applicant's Application is invalid due to the Applicant's lack of a bona fide intention to use its mark in connection with the Applicant's Goods.

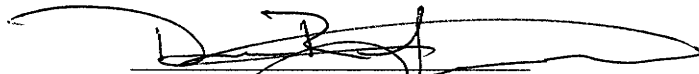
WHEREFORE, Opposer, Kiss My Face, LLC, believes and avers that it will be damaged by said registration and prays that registration of the KISS MY ASSISI mark for use in connection with the goods shown in Application Serial No. 85/138,743, filed by Applicant, be refused, and that this Opposition be sustained.

The filing fee for this Notice of Opposition in the amount of \$300.00 is enclosed, for Opposer's opposition to registration of the mark KISS MY ASSISI in one class.

Please recognize as attorneys for Opposer in this proceeding David O. Johanson, Rachelle A. Dubow, Joshua M. Dalton, Lawrence T. Stanley, and Devon R. Sparrow (members of the Bar of the Commonwealth of Massachusetts) and the firm of Bingham McCutchen LLP, One Federal Street, Boston, Massachusetts 02110.

All correspondence should be addressed to David O. Johanson, Esq., of Bingham McCutchen LLP, One Federal Street, Boston, Massachusetts 02110.

Respectfully submitted,



David O. Johanson  
Rachelle A. Dubow  
Devon R. Sparrow  
BINGHAM McCUTCHEEN LLP  
One Federal Street  
Boston, MA 02110  
(617) 951-8000

Dated: July 6, 2011


Attorneys for Opposer,  
KISS MY FACE, LLC

**CERTIFICATE OF SERVICE**

This is to certify that one copy of the Notice of Opposition, was mailed on July 6, 2011 by first-class mail, postage prepaid to Opposer's counsel in an envelope addressed as follows:

THOMAS I. ROZSA  
ROZSA LAW GROUP LC  
18757 BURBANK BLVD STE 220  
TARZANA, CALIFORNIA 91356-3346

Dated July 6, 2011

  
Eileen M. Sullivan  
Trademark Paralegal