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

Proceeding	91229847
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

*In re:*

Mark: IR DEFENSE  
Serial No.: 86660963  
Published: May 03, 2016  
TTAB No.: 91229847

Christie Brinkley Skincare, LLC, Opposer, vs. Alumier Europe Ltd, Applicant.
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**OPPOSER’S MAIN TRIAL BRIEF**

Opposer, through its attorney Christopher J. Day, submits its Main Trial Brief in support of its Notice of Opposition and hereby moves the Trademark Trial and Appeal Board (“TTAB”) for an order refusing to register U.S. Trademark App. Ser. No. 86660963.

Dated March 14, 2019.

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## II. INTRODUCTION.

Since at least as early as November 2014, Opposer has used the mark IR DEFENSE, separately and in connection with other marks, including RECAPTURE DAY + IR DEFENSE, RECAPTURE 360 + IR DEFENSE, CLOSE UP + IR DEFENSE, BRIGHTENING SERUM + IR DEFENSE, UPLIFT + IR DEFENSE and related marks (“Opposer’s IR DEFENSE Marks”) in commerce in connection with the promotion and sale of Opposer's goods and services, including cosmetics that provide protection against infrared radiation and non-medicated skin care preparations. In addition to Opposer’s common law rights in Opposer’s IR DEFENSE Marks, Opposer is the owner of the following U.S. Trademark Registration Applications, each of which is for “cosmetics that provide protection against infrared radiation; non-medicated skin care preparations that provide protection against infrared radiation:”

- App. Ser. No 86726961 for the mark IR DEFENSE
- App. Ser. No. 86740503 for the mark RECAPTURE 360 + IR DEFENSE
- App. Ser. No. 86726965 for the mark RECAPTURE DAY + IR DEFENSE

In this action, Opposer seeks an order refusing registration of U.S. Trademark Registration App. Ser. No. 86660963 for the mark IR DEFENSE for “beauty serums that provide protection against infrared radiation” under Section 2(d) of the Lanham Act, which prohibits the registration of a mark which “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive” Trademark Act Section 2(d), 15 U.S.C. § 1052(d). Alternatively, Opposer seeks an order refusing registration under Section 2(e)(1) of the Lanham Act, which prohibits registration on the the principal register for a mark that “when used on

or in connection with the goods of the applicant is merely descriptive.” Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1).

### **III. DESCRIPTION OF THE RECORD.**

The evidence of record consists of the following:

#### **A. Evidence Automatically of Record.**

Pursuant to Trademark Rule 2.122, 37 C.F.R. § 2.122, the record includes the pleadings and orders in this proceeding and the file history of the subject application.

#### **B. Evidence Submitted by Opposer.**

##### **Opposer’s Notice of Reliance (9 TTABVUE)**

1. Title and Status Copies of Opposer’s U.S. Trademark Registration App. Ser. No. 86740503 for the mark IR DEFENSE. (9 TTABVUE 7-10).
2. Title and Status Copies of Opposer’s U.S. Trademark Registration application: App. Ser. No. 86726965 for the mark RECAPTURE DAY + IR DEFENSE. (9 TTABVUE 11-14).
3. Title and Status Copies of Opposer’s U.S. Trademark Registration application: App. Ser. No. 86740503 for the mark RECAPTURE 360 + IR DEFENSE. (9 TTABVUE 15-17).
4. Dictionary/Thesaurus definition for PROTECTION as found in Webster's Third New International Dictionary, Unabridged, s.v., (9 TTABVUE 19).
5. Dictionary definition for IR as found in Webster’s Third New International Dictionary, Unabridged, s.v., (9 TTABVUE 20).
6. Dictionary definition for DEFENSE as found in Webster’s Third New International Dictionary, Unabridged, s.v., (9 TTABVUE 21).

7. Internet printout from <https://www.lovelyskin.com/blog/p/the-next-big-thing-infrared-sunscreen>, accessed on October 01, 2018 (9 TTABVUE 22-23).
8. Internet printout from <https://www.skinmedica.com/Products/Protect>, accessed on October 01, 2018 (9 TTABVUE 24-25).
9. Internet printout from <https://www.skinmedica.com/products/protect/totaldefenserepairsf50> accessed on October 01, 2018 (9 TTABVUE 26).
10. Internet printout from <https://www.kohls.com/product/prd-2078753/christie-brinkleyauthentic-skincare-recapture-day-ir-defense-anti-aging-cream-spf-30.jsp>, accessed on October 01, 2018 (9 TTABVUE 27-29).
11. Internet printout from <https://www.kohls.com/product/prd-2078840/christie-brinkleyauthentic-skincare-uplift-ir-defense-firming-neck-deacutecoletteacutetreatment.jsp?prdPV=5>, accessed on October 01, 2018 (9 TTABVUE 30-31).
12. Internet printout from <https://www.hsn.com/products/christie-brinkley-refocus-eye-irdefense-serum/7690918#template-product-detail-reviews>, accessed on October 01, 2018 (9 TTABVUE 32-34).

**Opposer’s Trial Testimony (10 TTABVUE)**

Witness	Title/Description	Location
Andrew Surwilo	Managing Member, Christie Brinkley Skincare, LLC	10 TTABVUE 2-12

**C. Evidence Submitted by Applicant.**

**Applicant’s Notice of Reliance (11 TTABVUE)**

File history documents from Opposer’s U.S. Trademark Registration App. Ser. No. 87726961 for the mark IR DEFENSE.

#### IV. LEGAL ARGUMENT.

Opposer has plead and proved standing, priority and likelihood of confusion. Opposer has further plead and proved a prima facie case that Applicant's IR DEFENSE mark, when applied to "Beauty serums that provide protection against infrared radiation" is primarily merely descriptive and therefore not entitled to registration on the Principal Register under Trademark Act Section 2(e)(1).

##### A. Opposer Has Standing.

Standing is a threshold issue that must be proven by a plaintiff in every *inter partes* case. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 1401 (2015). The plaintiff must show that it has a real interest in the proceeding beyond that of a mere intermeddler and that it has a reasonable basis for its belief of damage resulting from registration of the subject mark. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999).

Opposer has pled ownership of the Opposer's IR DEFENSE Marks in connection with cosmetics that provide protection against infrared radiation and non-mediated skin care preparations that provide protection against infrared radiation. In addition to Opposer's common law rights in the Opposer's IR DEFENSE Marks, Opposer is the owner of U.S. Trademark Registration App. Ser. Nos. 86726961 for the mark IR DEFENSE, 86726965 for the mark RECAPTURE DAY + IR DEFENSE, and 86740503 for the mark RECAPTURE 360 + IR DEFENSE. Each of Opposer's pending registration applications describes "cosmetics that provide protection against infrared radiation; non-mediated skin care preparations that provide protection against infrared radiation." And each of Opposer's pending registration applications has been placed on suspension, and Opposer has been notified the USPTO will assert a refusal to register Opposer's mark based on a likelihood of confusion with the subject application. In the Answer, Applicant admitted each of



Opposer's allegations relating to ownership and existence of Opposer's applications, as well as the potential 2(d) citations raised by each examining attorney. (4 TTABVUE)

Opposer has also pled a claim of likelihood of confusion with the subject application based on Opposer's prior use of the Opposer's IR DEFENSE Marks. (1 TTABVUE at ¶¶ 13-17); *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 44 (CCPA 1981) (plaintiff may show standing based on common law rights in mark that is distinctive, inherently or otherwise); *L. & J.G. Stickley Inc. v. Cosser*, 81 USPQ2d 1956, 1964 (TTAB 2007) (cancellation petitioner's standing based on prior common law use of elements contained in defendant's registered marks); *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) ("Opposer has established his common-law rights in the mark DESIGNED2SELL, and has thereby established his standing to bring this proceeding."); *Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1118 (TTAB 2009) (testimony that opposer uses its mark "is sufficient to support opposer's allegations of a reasonable belief that it would be damaged ..." where opposer alleged likelihood of confusion).

Based on the above, Opposer has pled and proved standing to bring this case.

**B. Opposer Has Priority.**

Section 2(d) prohibits registration on the basis of prior use of "a mark or trade name previously used in the United States by another and not abandoned." In this case, Opposer has priority of use.

Applicant filed the subject application on a 1(b) basis on June 12, 2015. Applicant submitted no evidence to support a priority date any earlier than the June 12, 2015 filing date of the subject application, therefore the earliest date on which Applicant can rely is June 12, 2015.

In contrast, the record includes undisputed evidence that Opposer has used Opposer's IR DEFENSE Marks, including IR DEFENSE, RECAPTURE DAY + IR DEFENSE, AND

RECAPTURE 360 + IR DEFENSE continuously since at least as early as October 30, 2014.

Evidence of Opposer's priority over Applicant's includes the following:

- Testimony from Andrew Surwilo, Managing Member of Opposer Christie Brinkley Skincare, LLC that, since at least as early as October 2014, and through the present date, Christie Brinkley Skincare, LLC has continuously sold skincare products and cosmetics in interstate commerce to customers throughout the United States. (10 TTABVUE at 4)
- Testimony from Andrew Surwilo, Managing Member of Opposer Christie Brinkley Skincare, LLC that, since at least as early as October 30, 2014, Opposer Christie Brinkley Skincare, LLC, has continuously used IR DEFENSE, RECAPTURE DAY + IR DEFENSE and RECAPTURE 360 + IR DEFENSE and related trademarks (collectively, the "IR DEFENSE Marks") in connection with cosmetics and non-medicated skincare products. (10 TTABVUE at 4)
- Testimony from Andrew Surwilo, Managing Member of Opposer Christie Brinkley Skincare, LLC that, each year from 2014 through the present, Opposer Christie Brinkley Skincare, LLC has made sales of cosmetics and skincare products under the IR DEFENSE Marks to a wide range of customers located throughout the United States. (10 TTABVUE at 5)
- Testimony from Andrew Surwilo, Managing Member of Opposer Christie Brinkley Skincare, LLC that, in 2014, Opposer Christie Brinkley Skincare, LLC's sales of IR DEFENSE skincare products exceeded \$269,000. (10 TTABVUE at 5)
- Testimony from Andrew Surwilo, Managing Member of Opposer Christie Brinkley Skincare, LLC that, in 2015, Christie Brinkley Skincare, LLC's sales of IR DEFENSE skincare products exceeded \$5,948,000. (10 TTABVUE at 5)
- Testimony from Andrew Surwilo, Managing Member of Opposer Christie Brinkley Skincare, LLC that, by 2017, Opposer Christie Brinkley Skincare, LLC's sales of IR DEFENSE skincare products exceeded \$26,000,000. (10 TTABVUE at 5)
- Testimony from Andrew Surwilo, Managing Member of Opposer Christie Brinkley Skincare, LLC that, since at least 2014, Christie Brinkley Skincare, LLC has operated a website at <https://trycbskin.com> through which it sells IR DEFENSE and other skincare products. (10 TTABVUE at 5)
- Representative copies of actual receipts and shipping documents, authenticated by testimony from Testimony from Andrew Surwilo, from Opposer's sales of IR DEFENSE skincare products dating early as October 30, 2014. (10 TTABVUE at 6-12)
- Internet evidence consisting of customer reviews posted on Kohl's website regarding Opposer's CHRISTIE BRINKLEY REFOCUS EYE + IR DEFENSE SERUM, many of which are dated prior to Applicant's priority date. (9 TTABVUE at 32-34)

Opposer has proved priority by a preponderance of the evidence. *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1108 (TTAB 2007) (priority established by proof of prior use).

**C. The Subject Mark Creates a Likelihood of Confusion.**

The Board's determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

In this case, Applicant's IR DEFENSE mark is identical to Opposer's IR DEFENSE mark, and is a component of Opposer's other IR DEFENSE Marks. In addition, Applicant's goods, namely "beauty serums that provide protection against infrared radiation" are merely a subset of Opposer's goods, namely "cosmetics that provide protection against infrared radiation and non-medicated skin care preparations." Because Applicant offered no evidence limiting its channels of trade or classes of purchasers, the Board must presume them to be identical. These factors—the only du Pont factors for which the record contains probative evidence—heavily weigh in favor of finding a likelihood of confusion. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

**1. Applicant's IR DEFENSE Mark is Confusingly Similar to Opposer's IR DEFENSE Marks.**

Applicant's IR DEFENSE mark is confusingly similar to Opposer's IR DEFENSE Marks.

When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d

1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *In re Bay State Brewing Co.*, 117 USPQ2d at 1960 ((citing *Spoons Rests., Inc. v. Morrison, Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd per curiam*, 972 F.2d 1353 (Fed. Cir. 1992)); *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1353 (TTAB 2015) (citing *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430 (TTAB 2013))).

Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. *See In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Greater weight is often given to this dominant feature when determining whether marks are confusingly similar. *See In re Nat'l Data Corp.*, 753 F.2d at 1058, 224 USPQ at 751.

In this case, Applicant's IR DEFENSE mark is identical to Opposer's IR DEFENSE mark, and is a component of Opposer's other IR DEFENSE Marks. The fact that the marks are virtually identical—and the dominant portion of each mark is in fact identical—weighs heavily in favor of finding a likelihood of confusion.

## **2. The Goods are Identical.**

With respect to Applicant's goods, the Board must make the determination regarding the similarity of the goods based on the goods as they are identified in the application or registration, not on any extrinsic evidence of actual use. *See, e.g., In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017); *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014). Likelihood of confusion must be found if

there is likely to be confusion with respect to any item within the identification of goods for a particular class. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015), *aff'd*, 123 USPQ2d 1744.

The subject application identifies Applicant's goods as "Beauty serums that provide protection against infrared radiation" in Int. Class 003. A "serum" is one type of cosmetic.<sup>1</sup> Opposer has testified and provided evidence that it sells cosmetics under the IR DEFENSE Marks, including IR DEFENSE, RECAPTURE DAY + IR DEFENSE and RECAPTURE 360 + IR DEFENSE (*e.g.*, Surwilo Declaration 10 TTABVUE p. 4).

Accordingly, Opposer has proved by a preponderance of the evidence that it sells cosmetics under the mark IR DEFENSE, which are which are identical to goods identified in the subject application.

The identical nature of the Opposer's and the Applicant's goods weighs heavily in favor of finding a likelihood of confusion.

### **3. The Trade Channels and Classes of Purchasers are Identical.**

Because there are no limitations or restrictions as to trade channels or classes of purchasers in the subject application, the Board must presume that Applicant's goods are marketed in all normal trade channels for the identified goods and to all normal classes of purchasers of them. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012).

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<sup>1</sup> *See, e.g.*, the definition of "serum" at merriam-webster.com, which defines "serum" as "a usually lightweight cosmetic preparation especially for use on the face." The Board may take judicial notice of definitions from dictionaries, including online dictionaries that exist in printed format or have regular fixed editions. *E.g., In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1355 n.10 (TTAB 2015).

Opposer's goods are marketed in all normal trade channels for cosmetics, to all normal classes of purchasers of cosmetics, which are the identical trade channels and classes of purchasers in which Applicant markets its goods, and therefore Applicant's customers are also the same types of customers to whom Opposer markets its goods.

The fact that the trade channels and classes of purchasers of both Applicant's and Opposer's goods are identical weighs heavily in favor of finding a likelihood of confusion.

**D. The Subject Mark is Primarily Merely Descriptive and Must Be Refused Registration under Section 2(e)(1).**

Under Trademark Act Section 2(e)(1),

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it ... (e) Consists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them....

A term is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of the specified goods or services. *See In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001) (“‘1-888-M-A-T-R-E-S-S’ ... immediately conveys the impression that a service relating to mattresses is available by calling the telephone number.”); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). It is not necessary that the term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the goods or services

for which registration is sought, the context in which it is being used or is intended to be used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of such use. *See In re Omaha Nat'l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859, 1861 (Fed. Cir. 1987); *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). In other words, the Board must evaluate whether someone who knows what the goods are will understand the mark to convey information about them. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002)).

Applicant's IR DEFENSE mark immediately conveys knowledge of a significant quality, function, feature or purpose of the identified goods, namely "Beauty serums that provide protection against infrared radiation."

Applicant, by way of the disclaimer statement of "IR" in the subject application has already conceded the descriptive nature of the term IR as it applies to the goods. Moreover, the record contains evidence that IR is a common abbreviation for "infrared." (Dictionary definition for IR from Webster's Third New International Dictionary, Unabridged, s.v, found at 9 TTABVUE at 20).

The record contains evidence that "DEFENSE" is defined as a "means or method of defending or protecting oneself, one's team, or another" (Dictionary definition for DEFENSE from Webster's Third New International Dictionary, Unabridged, s.v, found at 9 TTABVUE at 21).

The record contains evidence that "PROTECTION" is defined as a "means or method of defending" (Dictionary definition for PROTECTION as found in Webster's Third New International Dictionary, Unabridged, s.v, found at 9 TTABVUE at 19).

Applicant described its goods as “beauty serums that provide protection against infrared radiation.” By Applicant’s own identification, the purpose and function of the goods is to provide “protection against infrared radiation.” “IR defense” immediately conveys this purpose and function—indeed, based on the dictionary definitions, protection and defense are synonymous. “IR defense” is nothing more than an alternative way of stating “protection against infrared radiation.”

## **V. SUMMARY.**

The evidence of record establishes that Opposer has standing and priority. There is overwhelming evidence that the marks sound identical, look similar and have the same meaning, and Opposer’s goods are identical to Applicant’s goods. Because Applicant offered no admissible evidence limiting its channels of trade or classes of purchasers, the Board must also presume the channels of trade and customers to be identical. Each of these factors—the only *du Pont* factors for which the record contains probative evidence—heavily weigh in favor of finding a likelihood of confusion.

Separately, the record contains overwhelming evidence that Applicant’s IR DEFENSE mark is primarily merely descriptive of beauty serums that provide protection against infrared radiation. Because Applicant’s mark does nothing more than immediately describe a purpose feature or function of Applicant’s goods, Applicant’s mark is not entitled to registration on the principal register.



Accordingly, Opposer respectfully requests the Board enter an order refusing registration of the subject application.

Dated March 14, 2019.

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#### **CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing Opposer's Main Trial Brief has been served via email, on Applicant at the email address below, on March 14, 2019:

lichauco@orpatent.com; crews@orpatent.com; cardente@orpatent.com; info@orpatent.com

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