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

Proceeding	91229847
Party	Defendant Alumier Europe Ltd
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

Christie Brinkley Skincare, LLC,)	Opposition No.: 91229847
)	
)	Mark: IR DEFENSE
Opposer,)	
)	Serial No.: 86/660,963
)	
v.)	Published: May 3, 2016
)	
Alumier Europe Ltd,)	
)	
Defendant/Applicant.)	

DEFENDANT’S MAIN TRIAL BRIEF

Defendant, through its attorney, Faustino A. Lichauco, submits its Main Trial Brief in opposition to the Notice of Opposition and hereby moves the Trademark Trial and Appeal Board to dismiss the opposition to registration of U.S. Application 86/660,963.

Date: April 11, 2019

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CERTIFICATE OF SERVICE

I: INDEX OF CASES

Estate of P.D. Beckwith, Inc. v. Comm'r of Patents, 252 U.S. 538, 40 S. Ct. 414. (1920)”

II: INTRODUCTION

In this case, Plaintiff, Christine Brinkley Skincare LLC (hereafter, “CBS”) is looking for a second bite at the apple. The Plaintiff is seeking a ruling that contradicts a factual finding by Examiner Mark Tratos during prosecution of their own application for “IR DEFENSE” (i.e., U.S. Application 86/726,961, hereafter the “CBS IR DEFENSE” application).

During prosecution, the Plaintiff submitted a declaration stating that “IR DEFENSE” had been used in commerce for some time before the filing date. The Plaintiff also submitted certain specimens to prove such use. These are the same specimens submitted to the Board.

Examiner Tratos, who examined the CBS IR DEFENSE application, concluded that the specimens did *not* show the use of “IR DEFENSE” in commerce. The Examiner took the position that the presence of other words with “IR DEFENSE” created a different commercial impression from “IR DEFENSE” by itself.

In addition, the examiner expressed grave doubts about the specimens’ authenticity, noting that the specimens showed obvious signs of having been digitally altered.

The Plaintiff did not contest any of these findings. Instead, the Plaintiff amended the application to be an “intent-to-use” application. This bypassed the need for specimens.

In doing so, the Plaintiff filed a declaration that superseded the initial declaration. In this second declaration, the Plaintiff stated that they only intended to use the “IR DEFENSE” mark at some indeterminate time in the future.

In surrendering on this issue, the Plaintiff did not disagree that “IR DEFENSE” had not in fact been used in commerce prior to the filing date. Thus, any member of the public who inspected the public record could reasonably have relied on the fact that Plaintiff believed that he had *not* actually used the mark prior to filing but only *intended* to do so in the future. They would have had no way of knowing that the Plaintiff secretly disagreed.

In reliance on the Plaintiff’s representations concerning his intent to use the mark, the examiner performed another search. This search covered the newly-permitted time interval in which Defendant’s own trademark application, the one now being opposed, could be found. Predictably, the examiner took the position that the CBS IR DEFENSE application, if granted, would result in a likelihood of confusion. Plaintiff’s application was

In response, the Plaintiff made no vigorous argument that their specimens showed use of the mark prior to Defendant’s filing date. Instead, they acquiesced in the Examiner’s findings. Their response presented arguments concerning a concurrent §2(e) refusal and ignored the §2(d) refusal.

In filing this opposition, the plaintiff relies on the same evidence that the examiner already identified as not being a use of the mark in commerce.

The question presented herein for the Board’s consideration is:

“Does the use of a mark that contains multiple words amount to the use in commerce of all possible combinations of those words?”

III: DESCRIPTION OF THE RECORD

The description of the record as set forth in the Plaintiff’s brief is accurate.

IV. LEGAL ARGUMENT

A. Plaintiff’s Standing

Plaintiff, Christine Brinkley Skincare LLC (hereafter, “CBS”) correctly notes that standing exists when an opposer has a “real interest in the proceeding beyond that of a mere intermeddler.” *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir.

1999). *Ritchie*'s real-interest test requires that the opposer "have a direct and personal stake in the outcome of the opposition."

As a basis for a "real interest," Plaintiff has drawn attention to ownership of U.S. Application 86/726,691 for "IR DEFENSE," which will hereafter be referred to as "CBS's IR DEFENSE" application for brevity.

Defendant submits that no harm would accrue to the Plaintiff as a result of registration because, based on the Plaintiff's own evidence, the application for "IR DEFENSE" is already worthless anyway.

According to the Plaintiff's own evidence and argument: (1) "IR DEFENSE" is merely descriptive of Defendant's recited goods, and (2) Defendant's recited goods are identical to Plaintiff's recited goods.

If (1) and (2) are both true, then obviously "IR DEFENSE" must *also* be merely descriptive of Plaintiff's goods. If so, then Plaintiff's own mark is invalid anyway. If Plaintiff's mark is invalid anyway, then obviously it makes no difference to Plaintiff's mark whether Defendant's mark is permitted to register.

Of course, Plaintiff would have an interest in seeing that no merely descriptive marks be permitted registration. But so does everyone in the general public. Plaintiff has not demonstrated any personal stake above and beyond the interest of the public at large.

The same logic applies to all other marks that contain "IR DEFENSE" as formatives thereof. This includes all of Plaintiff's other marks.

Accordingly, because Plaintiff regards "IR DEFENSE" as merely descriptive, registration of Defendant's mark would not harm plaintiff any more than it would harm anyone in the general public. Therefore, Plaintiff has no "real interest" as that term has been defined.

In order to have standing to oppose registration, Plaintiff must demonstrate a real interest beyond that of the general public. In this case, no such real interest has been

demonstrated. Therefore, no standing exists insofar as the Plaintiff relies on §2(e) as a basis for opposing registration.

B. Plaintiff's Priority

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The Plaintiff's case relies almost entirely on the notion that use of a mark with multiple words is equivalent, as a matter of law, to use of a mark with any combination or sub-combination of those words.

As an example, Plaintiff has established prior use of the mark "RECAPTURE DAY+IR DEFENSE." Based on the Plaintiff's legal theory, this automatically establishes use of each combination of words within it. Thus, if the Plaintiff's legal theory is correct, the prior use of "RECAPTURE DAY+IR DEFENSE" would establish prior use of such marks as "IR DEFENSE," "DAY+IR," and "DAY+IR DEFENSE." In fact, the Plaintiff's legal theory would also mean that Plaintiff has used "+" by itself in commerce, "DEFENSE" by itself, and so on.

In fact, since there are five words, the use of "RECAPTURE DAY + IR DEFENSE" would automatically trigger prior use of 5! (i.e., 120) combinations of words, not counting the possible arrangements of those words.

The examiner has already discredited the Plaintiff's legal theory.

Upon filing the CBS IR DEFENSE application, Plaintiff submitted specimens showing the use of certain marks that contained the words "IR DEFENSE" embedded therein. These are the same marks relied upon in this opposition to establish use in commerce.

On Nov. 10, 2015, the examiner issued an action stating that the proffered specimens did not amount to use of the *mark* "IR DEFENSE" because, in each case, the addition of text other than "IR DEFENSE" caused the mark as a whole to convey a different commercial impression.

The examiner's conclusion that Plaintiff had never actually used "IR DEFENSE" in commerce was sound because it was based on long-standing Supreme Court precedent.

In *Beckwith*,¹ the mark at issue had the words "ROUND OAK" in conjunction with "MOISTAIR HEATING SYSTEM." The rejection was based on the theory that "MOISTAIR HEATING SYSTEM" was descriptive.

In reversing the Commissioner's decision, the Court held that "[t]he commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail. *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 545-46, 40 S. Ct. 414, 417. (1920)."

Accordingly, Defendant submits that the Plaintiff has only proven use of the marks that contain the words "IR DEFENSE." The law, however, does not apply to using words from the mark in commerce. The law requires using the mark itself in commerce. The mere fact that Plaintiff has used "IR DEFENSE" as a constituent element of another mark does not establish use of the mark "IR DEFENSE."

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Upon filing CBS's IR DEFENSE application, Andrew Surwilo, an officer of CBS, filed a declaration ("First Declaration") stating that CBS had been using the mark in commerce since November 00, 2014.² As evidence of such use, Plaintiff submitted specimens showing the use of several marks that had the words "IR DEFENSE" embedded therein. Specifically, Plaintiff relied on the presence of the words "IR DEFENSE" embedded in "RECAPTURE DAY+IR DEFENSE," "REFOCUS EYE+IR DEFENSE," and "UPLIFT+IR DEFENSE."

On May 6, 2016, Surwilo filed a second declaration ("Second Declaration"). The Second Declaration no longer asserted that CBS had already used the mark. Instead, it

¹ *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 40 S. Ct. 414. (1920)."

² File History of CBS IR DEFENSE application, Surwilo declaration of Aug. 11, 2015. The date given is indeed "November 00."

asserted that CBS only had intended to use the mark at some indeterminate time in the future.

Prosecution proceeded with the examiner relying on the Second Declaration. This resulted in the citation of Defendant's "IR DEFENSE" application in a §2(d) rejection.

Defendant submits that the Second Declaration superseded the First Declaration because one cannot intend to use a mark if one has already used it.

In this opposition, Plaintiff has submitted yet another declaration by Surwilo executed on Oct. 1, 2018, ("Third Declaration"). This Third Declaration alleges use as early as Oct. 2014, thus contradicting both the Second Declaration and the First Declaration (which alleged first use in Nov. 2014).

Stepping back for a moment to place things in perspective, the same affiant has submitted three separate sworn statements, all of which contradict each other on a rather important point: i.e., whether as of the filing date, CBS had already used the mark or was merely intending to do so, and if so, when. It hardly seems that an affiant who has made three contradictory sworn statements is entitled to very much credibility.

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To support the Third Declaration, Plaintiff has provided a number of invoices.

However, the invoices only show sales of such products as "RECAPTURE DAY+IR DEFENSE," "UPLIFT+IR DEFENSE," and "REFOCUS EYE + IR DEFENSE." These are the same marks that the examiner identified as not making the same commercial impression as "IR DEFENSE" (see 11/10/2015 Action). These invoices do not establish that the mark "IR DEFENSE" was used.

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To support the Third Declaration, Plaintiff has provided a number of invoices.

For example, the invoice on 2/26/2016 to Nick Nastasi of Jersey City, NJ (Surwilo Declaration, Page 10) refers only to "RECAP 360 IR DAY CREAM" and drops "DEFENSE" completely. It also refers to "RECAP 360 NIGHT TREATMENT" and

drops “IR DEFENSE” altogether. It also refers to “REFOCUS EYE SERUM,” thus dropping completely the use of “IR DEFENSE.”

Thus, the invoice to Nastasi does not show the use of “IR DEFENSE” at all. At best, it shows the use of “IR.”

The sale to Nick Nastasi was not an isolated incident. On 3/1/2016, Plaintiff sold certain products to Mary Anne Garrett of Ben Wheeler, Texas (Surwilo Declaration, page 11). Plaintiff identified these products as “RECAP 360 DAY IR DAY.” The mark in question, however, is “IR DEFENSE,” not “IR DAY.” Plaintiff identified another product in this package as “RECAP 360 NIGHT” and another as “REFOCUS EYE SERUM.” In both cases, “IR DEFENSE” has been omitted completely.

Plaintiff may rebut by pointing out that the terms used in the invoices are mere abbreviations.

However, the choice of how to abbreviate a mark reveals something about what is regarded as the most important part of the mark for identifying goods. In choosing to eliminate “IR DEFENSE” for the purpose of abbreviation, Plaintiff reveals that “IR DEFENSE” is regarded as not particularly useful for identifying Plaintiff’s goods. This is consistent with the fact that the typical abbreviation for, for example, “application” is “appln” and not “tion.”

It should also be noted that the absence of any evidence showing the use of the mark “IR DEFENSE” rather than merely the words “IR DEFENSE” embedded in another mark is consistent with Surwilo’s declaration of 5/6/2016 in which he represented that the Plaintiff only had an *intent* to use the mark “IR DEFENSE” at some indeterminate time in the future.

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Defendant draws attention to certain evidence of record that would appear to undermine Surwilo’s credibility.

On 5/6/2016, in connection with the CBS IR DEFENSE application, Surwilo filed a declaration stating that he was not aware of any other entity that had the right to use “IR DEFENSE” in such a way as to cause confusion with Plaintiff’s use of the mark.

However, by 5/6/2016, there had already been a suspension notice issued in Application 86/726,095 for “RECAPTURE DAY + IR DEFENSE,” which the Plaintiff has made of record. In this suspension letter, which issued on 12/14/2015, the examiner cited 86/660,963, which is the application at bar.

Defendant further draws attention to the file history of U.S. Application 86/740,503 for “RECAPTURE 360+ IR DEFENSE,” which Plaintiff has made of record. In that case a similar suspension letter issued on 11/13/2015, well before Surwilo’s declaration on 5/6/2016.

Based on Surwilo’s position within the company, Defendant submits that Surwilo knew or should have known of Defendant’s application by at least as early as 11/13/2015. If he had overlooked the 11/13/2015 suspension letter, he would have learned it from the one that followed on 12/14/2015. Both of these were several months before Surwilo submitted a declaration on 5/6/2016 to cause the “IR DEFENSE” application to transition from a §1(a) application into a §1(b) application.

Assuming that the two suspension letters made Surwilo aware of Defendant’s pending application by no later than 12/14/2015, one can infer one of two facts from the 5/6/2016 declaration: (1) Surwilo did not regard Defendant’s use of the mark as one that would cause a likelihood of confusion with Plaintiff’s use of the mark; or (2) Surwilo deliberately concealed his knowledge of Defendant’s mark from the examiner.

If (1) is true, then the opposition should be dismissed since by Surwilo’s own admission, Defendant’s use of the mark would pose no likelihood of confusion. If (2) is true, then the possibility of perjury exists and all of Surwilo’s three declarations should be regarded as tainted.

C. Likelihood of Confusion

In a declaration submitted by Surwilo on 5/6/2016, Surwilo represented to the examiner that he was not aware of any third party using the mark in a way that would cause likelihood of confusion with Plaintiff's mark. This declaration was executed after the 12/14/2015 suspension letter in US Application 86/726,095 and the 11/13/2015 suspension letter that issued in US Application 86/740,503, both of which belong the Plaintiff. Therefore, by the time the 5/6/2016 declaration was executed, Surwilo was already aware of Defendant's application for "IR DEFENSE."

Since Surwilo went ahead and filed the declaration anyway, it seems obvious that he must have regarded Defendant's application as *not* posing a serious threat of confusion with Plaintiff's use of the same mark. Any other conclusion would raise the possibility of perjury.

Accordingly, by Plaintiff's own representations to the Office, no likelihood of confusion exists.

D. Descriptiveness of Mark

On page 13 of the Plaintiff's Brief, the plaintiff alleges that "IR DEFENSE" is merely descriptive and therefore does not comply with 2(e)(1).

However, this is not the story that the Plaintiff has given the examiner during prosecution of Plaintiff's own application for "IR DEFENSE."

The Plaintiff's allegations on page 13 of the Brief contradict what the Plaintiff has argued in connection with attempting to obtain registration of "IR DEFENSE" in Application 86/726,961.

Defendant draws particular attention to the opposer's argument made in a response filed on June 12, 2017 in 86/726,961. In that response, opposer faced a section 2(e)(1) rejection of the same mark. The opposer at the time provided three pages of well-reasoned arguments indicating that "IR DEFENSE" complies with 2(e)(1).

Relevant portions of the opposer's arguments are pasted below:

Applicant's mark is not merely descriptive in nature, and therefore should not be refused registration on the Principal Register. Applicant's product cannot immediately be identified simply by viewing the subject mark. The combination of IR and DEFENSE is a unique juxtaposition, to the best knowledge of Applicant. Furthermore, the terms IR and DEFENSE each have many different meanings and connotations both inside and outside of the cosmetics industry, so that a prospective consumer must give thought and consideration to what the goods are. The IR DEFENSE trademark functions as an identifier of source of the goods, is not barred by Section 2(e) and should be allowed to proceed to registration.

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The applicable standard to apply when determining whether a mark is merely descriptive and unable to indicate origin or source is not a guess by the prospective customer. In such case, Applicant offers that because there is no meaning of "IR DEFENSE" in the industry or in any dictionary, the mark as a whole cannot be found merely descriptive for the goods. As indicated, an "amount of thought" and "imagination" is necessary to determine the features, function or purpose of Applicant's goods. The joining of these two words does not indicate to prospective consumer the type of product being marketed under the IR DEFENSE trademark.

Defendant incorporates the foregoing arguments by reference as a basis for asserting that Defendant's mark complies with §2(e).

VI SUMMARY

The Opposer's case rests entirely on the supposed legal principle that use of a mark that combines several words is enough to establish use of each word or combination of words within the mark.

The Opposer takes the position that use of “REFOCUS EYE+IR DEFENSE” establishes priority for such marks as “EYE+IR,” “EYE” alone, “IR” alone, “+” alone, “EYE+,” “DEFENSE” alone, and of course, “IR DEFENSE.” The Opposer has cited no legal precedent or statute to support this notion.

The Opposer has already tried and failed to advance his theory. The examiner, however, realized that the Opposer’s theory had no legal merit. Having failed before the examiner, the Opposer now comes the Board with the same legal theory.

The Opposer’s legal theory remains flawed. This is why it is not even mentioned in the “Summary” on page 15 of the Plaintiff’s brief.

Accordingly, Defendant requests that the Board dismiss the opposition and allow the mark to register.

Date: April 11, 2019

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this paper was served upon the party of record at the following email address of record on April 11, 2019:

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