

ESTTA Tracking number: **ESTTA866737**

Filing date: **12/21/2017**

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

Proceeding	91231958
Party	Plaintiff Primavera Life GmbH
Correspondence Address	PATRICK J CONCANNON NUTTER MCCLENNEN & FISH LLP SEAPORT WEST155 SEAPORT BOULEVARD BOSTON, MA 02210 UNITED STATES Email: docket@nutter.com,pconcannon@nutter.com
Submission	Opposition/Response to Motion
Filer's Name	Patrick J. Concannon
Filer's email	pconcannon@nutter.com, docket@nutter.com
Signature	/PJC/
Date	12/21/2017
Attachments	Opposition to Motion to Extend and Reopen.pdf(396615 bytes)

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

In the matter of Trademark
Application Serial No. 86/873750
Mark: PRIMERA
Filed: January 13, 2016
Published for Opposition: July 5, 2016

In the matter of Trademark
Registration No. 3632484
Mark: PRIMAVERA
Filed: February 7, 2008
Registered: June 2, 2009

PRIMAVERA LIFE GMBH,

Opposer/Registrant,

v.

AMOREPACIFIC CORPORATION,

Applicant/Petitioner.

Consolidated Proceedings
Opposition No. 91231958
Cancellation No. 92065305

**OPPOSITION TO MOTION TO REOPEN EXPERT DISCLOSURES AND FOR A
NINETY-DAY EXTENSION OF TIME TO SERVE EXPERT DISCLOSURES AND TO
RESET ALL SUBSEQUENT DATES**

Opposer/Registrant Primavera Life GmbH, a company organized and existing under the laws of the Federal Republic of Germany and having its primary address at Am Fichtenholz 5, Sulzberg 87477, Germany, by and through its undersigned attorney, hereby opposes Applicant/Petitioner Amorepacific Corporation's "Motion to Reopen Expert Disclosures and for a Ninety-Day Extension of Time to Serve Expert Disclosures and to Reset All Subsequent Dates" ("Motion to Reopen & Extend").

**OPPOSER/REGISTRANT'S MEMORANDUM IN SUPPORT OF ITS OPPOSITION TO
APPLICANT/PETITIONER'S MOTION TO REOPEN & EXTEND**

I. FACTS

The facts relevant to Applicant/Petitioner's Motion to Reopen & Extend fall in two categories. First, the facts surrounding the expert disclosures period expiration and, second, the facts concerning the settlement negotiation history between the parties relating to these proceedings.

A. Facts Surrounding Expert Disclosures Period Expiration

Applicant/Petitioner's recitation of the facts fails to note that the expert disclosures period expiration date was September 5, 2017, as specified in the Board's May 17, 2017 order [TTABVUE 5] that consolidated the two proceedings and reset the deadlines. On September 21, 2017, Applicant/Petitioner moved to suspend the proceedings for settlement with Registrant/Opposer's consent [TTABVUE 9], but that was more than two weeks after the expiration of the expert disclosure period. Registrant/Opposer did not consent to the reopening of and extension of the expert disclosures period expiration – it assumed that the extension would apply to deadlines that had not already passed. So the expert disclosures period for these consolidated proceedings passed without Applicant/Petitioner's action on September 5, 2017 - nearly four months ago.

Apparently due to quirks inherent in the ESTTA consented motion filing interface, the Motions for Suspension for Settlement with Consent that Applicant/Petitioner filed on September 21, 2017 [TTABVUE 9] and on October 26, 2017 [TTABVUE 11] nevertheless each included the expert disclosures period expiration among the dates pushed out by thirty days. In any event, the November 4, 2017 expert disclosures period expiration date designated in the October 26, 2017 motion that was approved by the Board on that same day passed uneventfully.

Opposer/Registrant timely served its expert disclosures on October 3, 2017, as evidenced at Exhibit A. That might have prompted Applicant/Petitioner to do the same.

So Applicant/Petitioner now moves to reopen a deadline that it missed in September and, to the extent that deadline nevertheless is deemed to have been extended, missed “again” in November. The standard for reopening a missed deadline is excusable neglect.

Applicant/Petitioner does not cite to facts that evidence excusable neglect (there is none), nor does it even allege that its neglect was excusable.

B. Facts Concerning the Settlement Negotiation History Relating to These Proceedings

The parties’ dealings with each other concerning Applicant/Petitioner’s efforts to register the mark PRIMERA in the U.S. in relation to cosmetics and related products extend back to at least as early as 2010. Applicant/Petitioner filed Appl. No. 77/830858 for the mark PRIMERA in standard characters. Opposer/Registrant opposed that application (Opposition No. 91196106) and prevailed on the merits. A copy of the Board’s judgment sustaining Opposition No. 91196106 is attached at Exhibit B.

Opposer/Registrant was unpleasantly surprised to learn that Applicant/Petitioner, notwithstanding the prejudicial outcome of the earlier opposition, on January 13, 2016 again applied to register the PRIMERA mark in standard characters form with the Office in relation to substantially the same goods under Appl. No. 86/873750.

Applicant/Petitioner’s Motion to Reopen & Extend exaggerates the amount of settlement interaction between the parties. For example, it claims that the parties have responded to discovery, which is not the case.

It is clear from the Applicant/Petitioner's own Motions for Suspension for Settlement with Consent that Applicant/Petitioner filed on September 21, 2017 [TTABVUE 9] and also on October 26, 2017 [TTABVUE 11] that Applicant agreed to incremental thirty-day suspension periods (despite Applicant/Petitioner's request for longer suspension periods) to allow time for Applicant/Petitioner to make an acceptable offer. This reflects the reality that Opposer/Registrant was reluctant to prolong the proceedings and contradicts Applicant/Petitioner's implication that suspension was being granted casually and as a matter of course.

Applicant/Petitioner failed to mention in its account of the facts that within the same exchange of correspondence on November 29, 2017 during which Applicant/Petitioner agreed to extend the parties' respective discovery response deadlines, the undersigned at the same time indicated that Opposer/Registrant did not at that time consent to a further suspension of the proceedings. See Exhibit C. Nor has Opposer/Registrant otherwise indicated consent at any other time since. Nevertheless, Applicant/Petitioner filed its unilateral Motion to Reopen & Extend that glosses over Opposer/Registrant's conspicuously not consenting to suspension of any kind.

Opposer/Registrant disagrees with Applicant/Petitioner's conclusion that further suspension or extension of the proceedings would lead to savings of time and expense for both parties. Applicant/Petitioner filed this motion for purposes of delay, and further delays in reaching the merits of these consolidated proceedings will mean additional time and resources devoted to a matter that was resolved years ago as a result of a judgment on the merits.

II. MOTION TO REOPEN EXPERT DISCLOSURES PERIOD

The standard for justifying the reopening of a closed period is excusable neglect. *See* Fed. R. Civ. P. 6(b)(1)(B).

The elements that must be considered in determining whether neglect was excusable are “the danger of prejudice to the [non-movant], the length of the delay and its potential impact on judicial proceedings, the reason for the delay, including whether it was within the reasonable control of the movant, and whether the movant acted in good faith.” *Pioneer Inv. Servs. Co. v. Brunswick Assocs. Ltd. P’ship*, 507 U.S. 380, 395 (1993); adopted by the Board in *Pumpkin Ltd. v. The Seed Corps*, 43 U.S.P.Q.2d 1582 (T.T.A.B. 1997).

Opposer/Registrant will be harmed by further delays in these proceedings, which will require the devotion of time and resources. The requested ninety day extension clearly is excessive and especially prejudicial, but a further delay of *any time* under the circumstances is unacceptable to Opposer/Registrant and would be harmful and excessive. The reasons for the delay are Opposer/Registrant’s refusal to consent and failed settlement discussions – neither of which amounts to good cause let alone excusable neglect under *Pioneer*. Applicant/Petitioner cites no reason or event beyond its control that caused it to miss the deadline. There is none.

III. MOTION FOR 90-EXTENSION OF DEADLINES IN PROCEEDING

The Board must carefully scrutinize motions to extend time of this very nature. *Luemme, Inc. v. D. B. Plus Inc.*, 53 U.S.P.Q.2d 1758, 1760-61 (T.T.A.B. 1999). This particular motion does not stand up to that scrutiny. Applicant/Petitioner alleges that the parties have been in close communication, which is all the more reason for Applicant/Petitioner to interpret Opposer/Registrant’s failure to respond with consent as meaning just that – that Opposer/Registrant did not consent. The existence of settlement discussions does not in itself justify a unilateral motion to delay the proceedings. *Fairline Boats plc v. New Howmar Boats Corp.*, 59 U.S.P.Q.2d 1479, 1480 (T.T.A.B. 2000). Applicant/Petitioner fails to allege or demonstrate good cause. It is time for the parties to move the merits of the proceedings.

IV. Conclusion

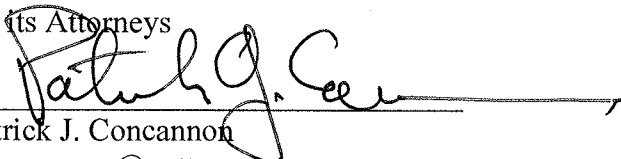
Opposer/Registrant asks that the Board deny the Motion to Reopen & Extend in all respects. There has been no showing of good cause, and certainly no showing of excusable neglect as is required to justify reopening the expert disclosure period. Opposer/Registrant is eager to move to the merits of the dispute without delay.

Respectfully submitted,

Dated: December 21, 2017

PRIMAVERA LIFE GMBH

By its Attorneys


Patrick J. Concannon
pconcannon@nutter.com

Nutter, McClennen & Fish, LLP
Seaport West, 155 Seaport Boulevard
Boston, MA 02210
Telephone: (617) 439-2177

CERTIFICATE OF SERVICE

I hereby certify that the foregoing "Motion to Reopen Expert Disclosures and for a Ninety-Day Extension of Time to Serve Expert Disclosures and to Reset All Subsequent Dates" was served by email upon Plaintiff at dctrademarks@dlapiper.com, ann.ford@dlapiper.com, john.nading@dlapiper.com, eunice.chung@dlapiper.com, alberto.zacapa@dlapiper.com on this 21th day of December 2017.

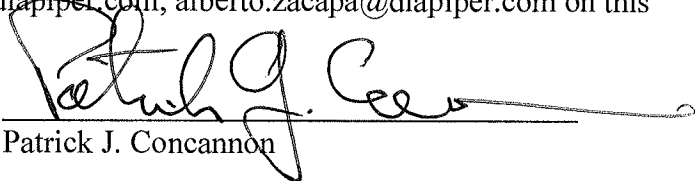

Patrick J. Concannon

Exhibit A

Patrick Concannon

From: Patrick Concannon
Sent: Tuesday, October 03, 2017 3:52 PM
To: Ford, Ann K.
Cc: 'john.nading@dlapiper.com'; 'dctrademarks@dlapiper.com';
'eunice.chung@dlapiper.com'; 'alberto.zacapa@dlapiper.com'
Subject: Primavera Life GmbH's Expert Disclosures for Consolidated U.S. Trademark Opposition
No. 91231958 & Cancellation No. 92065305
Attachments: Scan_20171003_154314764.pdf

Dear Ann:

I attach Primavera Life GmbH's expert disclosures in connection with the above-referenced proceedings.

Regards,
Pat Concannon



Patrick Concannon
Nutter McClennen & Fish LLP
155 Seaport Blvd / Boston, MA 02210
Direct / 617-439-2177
pconcannon@nutter.com
nutter.com



Patrick J. Concannon
Direct Line: 617-439-2107
Fax: 617-310-9107
E-mail: pconcannon@nutter.com

October 3, 2017

VIA EMAIL (ann.ford@dlapiper.com) ONLY

Ms. Ann K. Ford
DLA Piper LLP
500 8th Street, NW
Washington, DC 20004

**Re: Primavera Life GmbH's Expert Disclosures for Consolidated U.S.
Trademark Opposition No. 91231958 & Cancellation No. 92065305**

Dear Ann,

Pursuant to 37 C.F.R. § 2.120(a)(2), this letter addresses Primavera Life GmbH's expert testimony disclosure requirement for the above-referenced consolidated opposition and cancellation proceedings.

At this time, the Primavera Life GmbH does not plan to introduce testimony from any expert witness in these proceedings. This is without prejudice to Primavera Life GmbH's ability to change course as a result of facts revealed by pending discovery responses, or other developments, and accordingly to seek leave of the Board to allow its introduction of expert testimony at trial.

Sincerely yours,

Patrick J. Concannon

3694022.1

Exhibit B

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed:
September 11, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Primavera Life GmbH

v.

Amorepacific Corporation

Opposition No. 91196106
to application Serial No. 77830858
filed on September 21, 2009

Patrick J. Concannon and Kelly Donahue of Edwards Wildman
Palmer LLP for Primavera Life GmbH.

Terrence J. McAllister and Jeffrey J. Scepaniski of Ohlandt,
Greeley, Ruggiero & Perle, L.L.P. for Amorepacific
Corporation.

Before Seeherman, Lykos and Shaw, Administrative Trademark
Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Primavera Life GmbH has opposed the application of
Amorepacific Corporation to register PRIMERA, in standard
characters, as a trademark for:

Cosmetics and cosmetic preparations; non-
medicated nourishing creams for skin; skin milk

lotions; facial creams; cosmetic creams; toilet waters; make-up preparations; non-medicated skin care preparations; foundation cream; shampoos; beauty masks; make-up powder.¹

The application includes the statement that "the wording 'PRIMERA' has no meaning in a foreign language."

Opposer has brought this opposition on the ground of likelihood of confusion Section 2(d) of the Trademark Act. In particular, opposer has alleged that it is the owner of common law rights in and trademark registrations for the mark PRIMAVERA for perfumery, cosmetics and essential oils, as well as for related goods and services in Classes 21 and 35, and for skin cleansers, creams, perfume, bath oil, hair shampoo and hair spray; that since as early as March 31, 1997, and prior to any date on which applicant can rely, opposer has used the mark PRIMAVERA in connection with cosmetics, perfumery and essential oils; and that applicant's mark is confusingly similar to opposer's mark, and its goods either directly overlap or are closely related to opposer's goods, and applicant's goods will be offered in the same channels of trade to the same class of consumers, and therefore applicant's mark for its

¹ Application Serial No. 77830858, filed September 21, 2009, based on an asserted intent to use the mark in commerce (Section 1(b) of the Trademark Act). The identification of goods also includes dentifrices. In the notice of opposition, opposer states that it does not oppose the registration of the mark for such goods. ¶7.

Opposition No. 91196106

identified goods is likely to cause confusion or mistake or to deceive.

In its answer, applicant denied the salient allegations of the notice of opposition.

By operation of the rules, the record includes the pleadings and the file of the opposed application. Opposer made its pleaded registration No. 3632484 of record, pursuant to Trademark Rule 2.122(d)(1), by submitting as part of the notice of opposition a copy of this registration, taken from the electronic records of the U.S. Patent and Trademark Office, and showing its status and title. The registration is for PRIMAVERA in standard characters, for "perfumery; cosmetics; essential oils for personal use; essential oils for perfumed candles; essential oils for oil burners, essential oils for saunas; essential oils in airsprays, fragrance oil comprised of essential oils; perfume oils for the manufacture of cosmetic preparation."²

² This registration issued on June 2, 2009. The registration also includes goods in Class 21 and services in Class 35.

Opposer also submitted as part of its notice of opposition its Registration No. 1055372 for PRIMAVERA, in standard characters, for "skin cleansers, toning lotion, night cream, moisturizing cream, perfume bathoil, hair shampoo and hair spray." This registration issued on January 4, 1977, and was renewed in 1997. At the time opposer filed the notice of opposition, in 2010, Office records listed the status of the registration as active (although it would have been due for renewal in 2007). As is standard Board practice, we have checked the status of the

Opposition No. 91196106

Opposer has also submitted, under notices of reliance, specimens submitted by opposer as part of its pleaded and proved Registration No. 3632484; applicant's responses to opposer's requests for admission, the pertinent admissions being that applicant has not used its mark in commerce and has not advertised or promoted any product or service under the mark in commerce, and that applicant's products will be sold directly to consumers of all types;³ certain third-party registrations listing both cosmetics and shampoo; status and title copies of two additional (and unpleaded) registrations owned by opposer, Nos. 3252000 and 3051081, for marks that include the term PRIMAVERA;⁴ a printout from the USPTO TESS database with the search results for

registration at this time, and Office records show that it was cancelled on June 30, 2012. Therefore, we have not considered this registration in determining opposer's likelihood of confusion claim. We also point out that opposer has not discussed this registration in its brief, and is obviously not relying on it.

³ Opposer submitted applicant's response to the requests for admission in its entirety, even though applicant denied most of the requests. Requests that are denied have no probative value, and, in fact, the rules do not provide for submission of such denials by notice of reliance. See Trademark Rule 2.120(j)(3)(i); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1957 (TTAB 2008).

⁴ It is clear that opposer does not rely on these registrations as a basis for its likelihood of confusion claim, and therefore there is no issue as to whether the question of likelihood of confusion with respect to these registrations was tried by express or implied consent of the parties. It was not.

PRIMAVERA in Class 3,⁵ and the electronic record for one of the third-party registrations shown in that TESS search summary, No. 4113379, for a mark that includes the term PRIMAVERA; a printout from the USPTO TESS database with the search results for marks containing the term PRIMERA,⁶ and the electronic record of one of the applications shown in that search, namely, an additional application, Serial No. 85216621, owned by applicant for PRIMERA in lower case font for various cosmetics, skin and eye creams, shampoo and dentifrices; and excerpts from third-party internet websites which show both opposer's and applicant's goods offered for sale.

Applicant has made of record, by notices of reliance, dictionary definitions for PRIMAVERA and the results of dictionary searches for PRIMERA; internet printouts showing recipes in which the word PRIMAVERA has been used; webpages showing listings of restaurants having PRIMAVERA as part of the restaurant name; applicant's Registration No. 4274041 for PRIMERA in stylized lower case font for various skin lotions and creams, cosmetics, shampoo and dentifrices,

⁵ TESS search summaries cannot be made of record by notice of reliance. However, applicant has treated this document as being of record, brief, p. 7, and we therefore deem it to be stipulated into the record.

⁶ As noted in footnote 5, this document cannot be made of record by notice of reliance, but because applicant has treated it as being of record, we deem it to be stipulated into the record.

Opposition No. 91196106

which issued on January 15, 2013--this is the registration resulting from application Serial No. 85216621 that opposer made of record; and third-party registrations, as well as a third-party application, for PRIMAVERA and PRIMERA marks for goods and services unrelated to those at issue herein.

Neither party took any testimony depositions. Both filed briefs, and opposer filed a reply brief.

Standing

Opposer has established its standing by making its registration No. 3632484 for PRIMAVERA of record. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Affirmative Defenses

In its answer applicant did not assert any affirmative defenses. Thus, the first question we will consider is what is essentially an affirmative defense argued by applicant in its brief. Applicant points to its Registration No. 4274041 for PRIMERA in stylized format,

primera

and argues that because opposer acquiesced to the registration of that mark, there is no confusion between applicant's subject mark and opposer's mark. The

application that resulted in this registration was filed on January 13, 2011, after the filing of the notice of opposition on August 16, 2010, and the filing of the answer on October 26, 2010, so applicant could not have pleaded an affirmative defense based on this application/registration in its answer. However, opposer submitted a copy of the then-application under a notice of reliance, and in its brief anticipated that applicant might assert a prior registration or Morehouse defense.⁷ In the circumstances, we deem the pleadings amended to assert both acquiescence and a Morehouse defense. Fed. R. Civ. P. 15(b).

The Morehouse defense is "an equitable defense, to the effect that if the opposer can not be further injured because there already exists an injurious registration, the opposer can not object to an additional registration that does not add to the injury." *O-M Bread Inc. v. United States Olympic Committee*, 65 F.3d 933, 36 USPQ2d 1041 (Fed. Cir. 1995). As the Court explained in Morehouse:

[A]s a matter of law, the opposer cannot be damaged, within the meaning of section 13 of the statute, by the issuance to the applicant of a second registration where applicant already has an existing registration of the same mark for the same goods. Implicit in this are corollaries that if opposer cannot procure the cancellation

⁷ *Morehouse Mf. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969).

of the existing registration it cannot prevent the granting of the second registration; that there is no added damage from the second registration of the same mark if the goods named in it are in fact the same, and that if there is no added damage there is no ground for sustaining the opposition.

160 USPQ at 717. Thus, the Morehouse defense requires "that the prior and proposed marks be essentially the same. O-M Bread, 36 USPQ2d at 1045.

Applicant's registration is for the mark PRIMERA in a particular stylized form, while the mark applicant seeks to register is PRIMERA in standard character form. As opposer points out, if applicant were to obtain a registration for PRIMERA in standard characters, that registration would give applicant the right to use the mark without limitation as to a particular font or style. Citigroup Inc. v. Capital City Bank Group Inc., 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011) (a registrant that obtains a standard character mark "is entitled to depictions of the standard character mark regardless of font, style, size, or color").⁸

⁸ It should be noted that the Board decision that resulted in the appeal to the Federal Circuit dealt with virtually the same circumstances. There, the applicant attempted to assert a Morehouse defense in seeking to register its mark in standard character format based on its prior registrations of the words in stylized form. The Board found that, because the standard character mark was not limited to any special or particular form, the marks in the application and the prior registrations were "not essentially the same marks for purposes of the prior

Further, the identification of goods in the present application is broader than that in the prior registration. For example, applicant now seeks to register its mark for "toilet water"; the prior registration does not include any kind of perfume product. (We point out that one of the items listed in opposer's registration is "perfumery.") Therefore, the mark PRIMERA in standard characters that is the subject of applicant's current application is different from the mark in its prior registration, and the goods are different as well. In addition, the Morehouse defense requires that the plaintiff not be able to cancel the prior registration. In the present case, applicant's prior registration issued on January 15, 2013, and therefore it is subject to all the grounds that may be invoked to cancel a registration. Therefore, opposer could still procure the cancellation of this registration on the ground of likelihood of confusion, the same ground that it has asserted in this proceeding. We find the Morehouse or prior registration defense is not available to applicant.

The equitable defense of acquiescence is somewhat more complicated in that it involves more elements, but we need

registration defense." *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645, 1652 (TTAB 2010). The Board's analysis of the Morehouse defense was not discussed in the Federal Circuit decision.

Opposition No. 91196106

not engage in an extended discussion of them, as the difference between the mark and goods in the subject application and the mark and goods in the prior registration is enough to defeat that claim as well.

Applicant's affirmative defenses are dismissed, and we turn to the likelihood of confusion ground on which opposer has brought this opposition. This ground has two elements, priority and likelihood of confusion.

Priority

Because of opposer's ownership of its registration, priority is not in issue with respect to the goods listed in the registration. *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Likelihood of confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

We turn first to the du Pont factor of the "similarity or dissimilarity and nature of the goods or services as

Opposition No. 91196106

described in an application or registration or in connection with which a prior mark is in use." 177 USPQ at 567. The goods as identified in opposer's registration include "perfumery" and "cosmetics." The goods identified in applicant's application include "cosmetics and cosmetic preparation" and "toilet waters," as well as additional items that would be encompassed by the term "cosmetics," e.g., "make-up preparations," "foundation cream" and "make-up powder." These goods of applicant and opposer are legally identical. Opposer has also submitted evidence to show relatedness of its goods and the other goods in applicant's identification, but we need not discuss that evidence, as the fact that some of applicant's identified goods are identical to some of opposer's identified goods is sufficient for us to find that this du Pont factor weighs in favor of opposer. See *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods in the application).

Because the identifications in opposer's registration and applicant's application have no restrictions on channels of trade, we must presume that the goods travel in

all channels of trade appropriate for such goods. Further, because at least some of the parties' goods are legally identical, we must presume that these goods travel in the same channels of trade, to the same classes of consumers. This du Pont factor, too, favors opposer.

The next factor we consider is the strength of opposer's mark. There is no evidence of third-party use of other PRIMAVERA marks. Although opposer has submitted a copy of a third-party registration for the following mark



for various hair products, a registration is not evidence of use of the mark or that the public is familiar with it.⁹ See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). Thus, applicant's assertion that "opposer does not enjoy exclusivity in its PRIMAVERA mark for cosmetics and highly related goods," brief p. 18, is not supported by the record. On the contrary, on this record there is no

⁹ Opposer also submitted a printout of results from a search of the TESS database that lists three additional registrations; such a search summary is not sufficient to make the registrations listed therein of record. We also point out that the summary does not include the goods covered by these registrations. Therefore, this mere listing has no probative value.

Opposition No. 91196106

evidence of any third-party use of marks consisting of or containing the term PRIMAVERA.

Third-party registrations can be used in the same manner as dictionaries are employed, namely, to show the meaning of a mark or a portion of a mark. See *Mead Johnson & Co. v. Peter Eckes*, 195 USPQ 187 (TTAB 1977). However, in this case, a single third-party registration for hair products (and, we note, one in which "di Primavera" appears in a very subordinate manner), does not show that PRIMAVERA has a particular significance in connection with cosmetics and perfumery, such that opposer's mark should be considered a weak mark that is entitled to a limited scope of protection.

Rather, opposer's mark, which means SPRING, appears to be an arbitrary mark for opposer's goods, and arbitrary marks are strong marks. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) ("VEUVE is an arbitrary term as applied to champagne and sparkling wine, and thus conceptually strong as a trademark").

With the foregoing in mind, we now turn to the factor of the similarity or dissimilarity of the marks. We compare the marks in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay*

Opposition No. 91196106

Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 73 USPQ2d at 1691. Opposer's registration is for the mark PRIMAVERA in standard characters, and applicant's mark is PRIMERA in standard characters. Thus, there is no visual difference between the marks in terms of particular stylizations. The visual similarities between the marks, however, are obvious: both begin with the letters PRIM and end with the letters ERA. Opposer's mark has the additional letters "AV" between these beginning and ending letters, but the presence or absence of these two letters in the middle of a mark that is otherwise identical is not likely to be noticed.

When it comes to the sound of the marks, the additional letters in opposer's mark do make a difference, because they make opposer's mark a four-syllable mark in which the "V" is emphasized. However, because the goods as identified could be taken from store shelves by consumers, as opposed to their orally requesting them from a clerk, the difference in the pronunciation of the marks is not as significant to our analysis as the appearance of the marks.

With respect to the connotations of the marks, applicant asserts that the marks "are strikingly distinct in meaning." Brief, p. 11. Applicant has submitted dictionary definitions of "primavera" as meaning "served

Opposition No. 91196106

with a mixture of fresh vegetables (as zucchini, snow peas, and broccoli)—usually used postpositively <pasta primavera>,"¹⁰ and "prepared with an assortment of lightly cooked, fresh, usually young vegetables in a light cream sauce => spaghetti primavera."¹¹ These definitions show that the origin of the term is Italian, meaning "spring (the season)." Applicant has also submitted evidence of the use of "primavera" in the name of recipes, e.g., "Giobbi's Primavera Pasta," www.foodandwine.com, and "Pasta Primavera," www.cookingchanneltv.com, and printouts from the internet search site yellowpages.com that list restaurants in certain states that have the word "Primavera" in their name. In addition, applicant has submitted excerpts from dictionary websites stating that, for a search of the word "Primera," no results were retrieved, thereby indicating that "Primera" is not an English word.¹²

¹⁰ www.merriam-webster.com

¹¹ American English Dictionary, www.collinsdictionary.com. It also has the definition of "a central American tree, *Cybistax donnell-smithii*, of the bignonia family, having showy, tubular yellow flowers." Dictionary. Com, based on the Random House Dictionary, © 2013.

¹² As indicated above, applicant's application includes the statement that "the wording 'PRIMERA' has no meaning in a foreign language." However, we note that applicant's registration for PRIMERA in stylized form contains the translation statement, "The English translation of 'PRIMERA' in the mark is 'first'."

Applicant relies heavily on the differences in meaning of the marks to show that confusion is not likely, citing three cases in which the Court or the Board found no likelihood of confusion when one of the marks at issue was a common English word, and the other was not. However, we do not believe that these three cases, or the statements made in them, require the same conclusion in the present case. In *In re General Electric Company*, 304 F.2d 688, 134 USPQ 190 (CCPA 1962), the applied-for mark was VULKENE for electrical wires and cables. The cited mark was VULCAN in stylized form for electrical building wires. It is clear from the opinion that a strong factor in the Court's decision was the fact that the goods that would overlap would be purchased by licensed electricians and electrical contractors, and that such consumers "would buy their electrical supplies with a reasonable amount of care and with considerable professional know-how as to what they are buying." 134 USPQ at 191. As for the marks, the Court stated that VULCAN is "a name well-known to the American people" and, therefore, "[a]nyone confronted with it, in other words, would recognize it as something already known—it would not impress itself on his consciousness as anything new or strange, but rather as something familiar." *Id.* at 192. VULKENE was found to be an arbitrary and

Opposition No. 91196106

coined word, that would be immediately recognized as consisting of "one syllable from a common word, 'vulcanize,' and a common ending on the names of many now well-known chemical compounds in everyday use, such as kerosene, neoprene, and, of recent date, polyethylene." Id.¹³

In *National Distillers and Chemical Corporation v. William Grant & Sons, Inc.*, 505 F.2d 719, 184 USPQ 34 (CCPA 1974), the Court found no likelihood of confusion between DUVET for French brandy and liqueurs and DUET for cocktails because of the differences in the marks. It treated DUET as a suggestive mark, with a meaning indicating that there were two drinks in the can or that the can contains drinks for two people. As for DUVET, the Court did not believe that purchasers of alcoholic beverage would think that DUVET is an English word, even though it was found in Webster's Third New International Dictionary, unabridged. "[I]t is not a familiar English word."¹⁴ 184 USPQ at 35. Therefore, the Court stated that "DUET is a familiar word; DUVET is not. DUET has clear and obvious meaning; DUVET does not." Id.

¹³ We point out that this decision issued in 1962.

¹⁴ This decision issued in 1974, obviously before "duvet" became popular in the United States as a term for comforters.

The third case cited by applicant is Faberge, Incorporated v. Dr. Babor GmbH & Co., 219 USPQ 848 (TTAB 1983).¹⁵ The Board found no likelihood of confusion between cosmetics products that were in part identical because of differences in the marks BABE and BABOR. The Board found that "BABE is a well known and universally used word of the English language," *id.* at 850, while BABOR had no meaning.

All of these cases relied on the fact that one of the marks was a common, familiar word, while the other was not, and that "the familiar is readily distinguishable from the unfamiliar." *National Distillers*, 184 USPQ at 35. First, we point out that, as the Board stated in *Faberge*, "a familiar versus an unfamiliar mark is not enough in and of itself to dictate a common result in every case." 219 USPQ at 851. Second, and more importantly, in all of the cited cases one of the marks was found to be a "familiar" word. We cannot make such a finding in this case. Although *PRIMAVERA* is found in the dictionary, that is not sufficient to make it a "familiar" word. In fact, in *National Distillers*, "duvet" was found in the dictionary, but the Court rejected the mere listing in a dictionary as

¹⁵ Applicant also cited, as a "See also," *Ralston Purina Co. v. On Cor Frozen Foods, Inc.*, 223 USPQ 979 (Fed. Cir. 1984), but it is clear that applicant is not actually relying on this case and, in any event, it is distinguishable for many reasons, including the differences in the parties' goods.

showing that consumers would be familiar with the word or its meaning. Applicant has also submitted evidence that PRIMAVERA is used to indicate a style of serving pasta, and that the term appears in telephone directory listings of restaurants. However, we cannot conclude from this evidence that PRIMAVERA is a familiar term to purchasers of perfumery and cosmetics, such that when they see it on such goods, they will immediately recognize it as the same word that is used for a pasta dish. On the contrary, the dictionary definitions show that this word comes from Italian, and many consumers are likely to regard it merely as a foreign word, and certainly not as a common word in the manner of DUET or BABE. Further, since applicant's mark PRIMERA also is a foreign word (at least according to applicant's statement in its companion registration), many consumers may simply regard both marks as foreign words with unknown and possibly, because of the similarity of the words, similar meanings. As for the restaurant listings, the minimal number of restaurants that have PRIMAVERA in their names (e.g., one in Ohio, one in Wisconsin, one in Florida, two in Illinois, even only twelve in the entire state of New York) does not show that PRIMAVERA is a term that would be understood by consumers as a "common word."¹⁶

¹⁶ We also note that in some of the listings PRIMAVERA appears

Thus, we find that consumers would not understand PRIMAVERA to be a common word, and therefore would not distinguish the marks based on their meanings.

Finally, because the marks both have a similar construction and can appear to be foreign words, they convey similar commercial impressions.

Because the similarities of the marks outweigh their differences, and because the differences, viewed in the context of the goods, are not sufficient to distinguish the marks, we find that this du Pont factor favors opposer.

The next factor we consider is the conditions under which and buyers to whom sales are made, i.e., "impulse" vs. careful, sophisticated purchasers. The products as identified in the respective registration and application are cosmetic items that are sold to the general public. Therefore, the consumers cannot be considered to be sophisticated, or to have any particular expertise. Further, the perfumery and cosmetics items in both the registration and application that are legally identical can be relatively inexpensive, and subject to frequent

with foreign words, and therefore consumers would be likely to view the word as a foreign term as well, e.g., Cocina Primavera in Beverly Hills, CA; Primavera Ristorante in Coronado, CA; La Primavera in La Puente, CA; La Primavera Trattoria in West Orange, NJ; and La Primavera in Hicksville, NY and in New York City.

replacement, such that they are likely to be purchased without careful study of the trademark applied to the product. *Alberto-Culver Co. v. F.D.C. Wholesale Corp.*, 16 USPQ2d 1597, 1602-03 (TTAB 1990); *Helene Curtis Industries, Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). This du Pont factor favors a finding of likelihood of confusion.¹⁷

Applicant points to the fact that two sets of registrations issued to different registrants for the marks PRIMAVERA and PRIMERA, i.e., PRIMAVERA (stylized) for fresh fruits and vegetables, and PRIMERA for fresh nuts; and PRIMAVERA for real estate investment and real estate management,¹⁸ and PRIMERA for real estate management.¹⁹

¹⁷ Applicant argues that consumers of cosmetics should not be held to a lesser standard of care, relying on a statement made in *Faberge, Inc. v. Dr. Babor GmbH & Co.*, supra. The Board made it very clear that "each case depends on its particular fact situation for its determination" in finding that "purchasers of cosmetic products would have no difficulty in distinguishing between the well-known, easily recognized word "BABE" and applicant's unfamiliar "BATOR." As discussed supra, we do not consider PRIMAVERA to be in the same category as BABE in terms of being a "well-known, easily recognized word." Given the similarity between PRIMAVERA and PRIMERA, and the fact that PRIMAVERA is not a readily recognized English word, the general public is not likely, when making a replacement purchase of the particular cosmetic, to make a careful study of the marks to detect a relatively minor and buried difference.

¹⁸ This registration was cancelled in April 2012.

¹⁹ Applicant also points to a third set of PRIMAVERA/PRIMERA marks, namely a registration for PRIMERA for commercial water heaters and boilers and an application for PRIMAVERA for taps for washstands, bidets and sinks; showers and shower fittings; and the like. An application has no evidentiary value except to show that it has been filed. In any event, even if the registration

Opposition No. 91196106

Applicant has submitted them to show that the examining attorneys who considered the applications resulting in the registrations did not believe that there was a likelihood of confusion. We give no probative value to those registrations. Each application must be decided on its own set of circumstances. We do not know whether, in the other applications, the examining attorney was persuaded because of differences in the goods, or the sophistication of the relevant purchasers, or the weakness of the earlier registered mark, or even by a consent agreement. Based on the record before us in this proceeding, we find that opposer has shown that applicant's mark, if used on the goods that have been opposed, is likely to cause confusion with opposer's registered mark.

These are the only du Pont factors that the parties have discussed or on which they have submitted evidence. To the extent that any others are relevant, we have treated them as neutral.

Finally, to the extent that there is any doubt on the issue of likelihood of confusion, we must resolve such doubt in favor of opposer. A new entrant presenting a new mark for registration has an obligation to avoid confusion

had issued, for the reasons discussed above, it would not change the result herein.

Opposition No. 91196106

with established marks in the same market. *Bridgestone Americas Tire Operations LLC v. Federal Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1063 (Fed. Cir. 2012), citing *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001 (Fed. Cir. 2002) ("This court resolves doubts about the likelihood of confusion against the newcomer because the newcomer has the opportunity and the obligation to avoid confusion with existing marks.") and *Planters Nut & Chocolate Co. v. Crown Nut Co.*, 305 F.2d 916, 924-25, 134 USPQ 504 (CCPA 1962) ("all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer").

Decision: The opposition is sustained with respect to the following goods:

Cosmetics and cosmetic preparations; non-medicated nourishing creams for skin; skin milk lotions; facial creams; cosmetic creams; toilet waters; make-up preparations; non-medicated skin care preparations; foundation cream; shampoos; beauty masks; make-up powder.

As noted previously, opposer has not opposed the application with respect to "dentifrices." However, in view of the evidence showing that applicant provided a translation of PRIMERA in its Registration No. 4274041 that "the English translation of 'primera' in the mark is 'first,'" and that in the subject application it stated that

Opposition No. 91196106

"the wording 'primera' has no meaning in a foreign language," the application must be remanded for further examination. See Trademark Rule 2.131. Therefore, upon the expiration of the appeal period, the application will be remanded to the examining attorney to determine whether a correction to the translation statement is necessary and, if that issue is satisfactorily resolved, the application, solely for "dentifrices," will be forwarded for publication.

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

14-1255

AMOREPACIFIC CORPORATION,
Appellant,

v.

PRIMAVERA LIFE GMBH,
Appellee.

Appeal from the United States Patent and Trademark Office, Patent Trial and Appeal Board in No.
91196106.

MANDATE

In accordance with the judgment of this Court, entered March 21, 2014, and pursuant to Rule 41(a) of the Federal Rules of Appellate Procedure, the formal mandate is hereby issued.

FOR THE COURT

/s/ Daniel E. O'Toole

Daniel E. O'Toole
Clerk of Court

cc: Terrence Joseph McAllister
Lawrence R. Robins
United States Patent and Trademark Office

NOTE: This order is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

AMOREPACIFIC CORPORATION,
Appellant,

v.

PRIMAVERA LIFE GMBH,
Appellee.

14-1255
(Serial No. 91196106)

Appeal from the United States Patent and Trademark
Office, Patent Trial and Appeal Board.

ORDER

The parties having so agreed, it is
ORDERED that the proceeding is DISMISSED under
Fed. R. App. P. 42 (b). Each side shall bear its own costs.

FOR THE COURT

March 21, 2014

/s/ Daniel E. O'Toole
Daniel E. O'Toole
Clerk of Court

ISSUED AS A MANDATE: March 21, 2014

cc: Clerk's Office, United States Patent and Trademark
Office
Terrence Joseph McAllister
Lawrence R. Robins

Exhibit C

Patrick Concannon

From: Patrick Concannon
Sent: Wednesday, November 29, 2017 6:56 AM
To: Ford, Ann K.
Cc: Docket; Amorepacific Team
Subject: Re: US TTAB Consolidated Proceeding No. 91231958 (parent) - Consented Motion - Primavera Life GmbH v. Amorepacific Corporation

Hi Ann

Primavera Life consents to mutual 30-day extensions of the parties' respective discovery response deadlines.

As for further suspension of the proceedings, I don't have instructions on that for now.

Regards,
Pat



Patrick Concannon
Nutter McClennen & Fish LLP
Direct / 617-439-2177

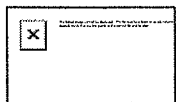
On: 28 November 2017 14:54, "Ford, Ann K." <Ann.Ford@dlapiper.com> wrote:

Hi Pat,

We are checking in to see if you have heard back from your client as it is now the late afternoon here and the evening in Europe. As you know, our deadline is coming up on **November 30 (the day after tomorrow)** and we will have to coordinate with our client based in Korea (**who are 14 hours ahead**) to prepare our responses so we are basically out of time, waiting for your response. Out of professional courtesy can you give us a 1 or 2-week extension while waiting for your client's confirmation?

We look forward to hearing from you. Thank you.

Best,
Ann



Ann K. Ford
DLA Piper LLP (US)
500 8th Street, NW
Washington, DC 20004
202.799.4140 T
202.799.5140 F
202.538.0717 M
ann.ford@dlapiper.com
www.dlapiper.com