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

Proceeding	91231958
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Trademark
Application Serial No. 86873750
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/Respondent,)	
)	
v.)	Consolidated Proceeding
)	Opposition No. 91231958 (parent)
)	Cancellation No. 92065305
AMOREPACIFIC CORPORATION,)	
)	
)	
Applicant/Petitioner.)	

**APPLICANT/PETITIONER’S RESPONSE IN OPPOSITION TO
OPPOSER/RESPONDENT’S MOTION FOR SUMMARY JUDGMENT**

Applicant/Petitioner Amorepacific Corporation (“Amorepacific”), by and through counsel, files this Response in Opposition to Opposer/Respondent Primavera Life GmbH’s (“PLG”) Motion for Summary Judgment (“Motion”) (16 TTABVUE), which was filed on January 17, 2018. For the reasons set out below, PLG’s Motion is premature and unwarranted as there are genuine issues of material fact and, thus, PLG is not entitled to judgment as a matter of law. *See* Fed. R. Civ. P. 56; TBMP § 528; 37 C.F.R. § 2.127(e)(1).

I. INTRODUCTION

Amorepacific opposes PLG’s Motion on the grounds that (1) there are genuine issue of material facts as to whether the non-precedential September 11, 2013 U.S. Trademark Trial and Appeal Board’s (“Board”) Order (“2013 Order”) (16 TTABVUE 22-46) in Opposition No. 91196106 (“Previous Proceeding”) applies to Amorepacific’s PRIMERA mark, Application Serial No. 86873750 (“Application”), because the goods at issue are different and have yet to be determined; (2) there are genuine issues of material fact regarding whether PLG ceased use of all goods and services in U.S. Trademark Registration No. 3632484 for the mark PRIMAVERA (“PLG Registration”) for a period of more than three years, which is *prima facie* evidence of abandonment; and, finally, (3) there are genuine issues of material fact regarding whether PLG abandoned the PRIMAVERA Mark in the PLG Registration through a naked license, which is a new abandonment claim based on PLG’s recent discovery responses. Accordingly, PLG’s Motion to end this Consolidated Proceeding is a waste of the parties’ and the Board’s time and resources. Indeed, Amorepacific’s substantiated abandonment claims in its Petition for Cancellation seriously undercut PLG’s purported rights in the PLG Registration, the basis of PLG’s Notice of Opposition, which therefore cannot be decided yet, apart from the fact that the 2013 Order does not apply to this Consolidated Proceeding. As PLG cannot demonstrate an

absence of any genuine issues of material fact, PLG is not entitled to judgment as a matter of law, and discovery in this Consolidated Proceeding should proceed. *See* Fed. R. Civ. P. 56; TBMP § 528; 37 C.F.R. § 2.127(e)(1).

II. PROCEDURAL HISTORY

PLG's Motion is premature and unwarranted as there are genuine issues of material fact and, further, discovery in this case has only begun. At the time PLG filed its Motion, the parties had just responded to written discovery requests on January 2 and 3, 2018 and PLG promised production of further documents. (Decl. of Ashley Joyce ("Joyce Decl.") ¶ 7. Ex. B.) Thus, PLG deliberately filed its Motion to stay the Consolidated Proceeding to avoid PLG's discovery obligations and thwart discovery from moving forward.

PLG filed its Notice of Opposition against the Application on December 27, 2016. (1 TTABVUE.) On January 25, 2017, Amorepacific filed its Petition for Cancellation of PLG's Registration (1 TTABVUE.) On February 6, 2017, Amorepacific filed its Answer to PLG's Notice of Opposition. (4 TTABVUE.) On March 6, 2017, PLG Answered Amorepacific's Petition for Cancellation. (4 TTABVUE.) On May 17, 2017, the Cancellation Proceeding was consolidated with the Opposition Proceeding (the Opposition Proceeding being the parent). (5 TTABVUE.)

Only since September 14, 2017 (7 & 8 TTABVUE) has Amorepacific's current counsel been involved in the case. Discovery has only just been served by both Amorepacific and PLG since September 5, 2017,¹ as the parties have continued to negotiate a global settlement. (Joyce

¹ On September 5, 2017 previous counsel for Amorepacific had served three sets of discovery on PLG, which included twenty-four Requests for Production of Documents, three Requests for Admission, and twenty-four Interrogatories. (Joyce Decl. ¶ 6.) On September 1, 2017, PLG had served six sets of discovery on Amorepacific, which totaled forty-three Requests for Production of Documents, thirty-four Requests for Admission, and seventy-seven Interrogatories. (*Id.*)

Decl. ¶ 5.) Neither party had taken any extension in the case until new counsel formally appeared for Amorepacific. The parties then agreed to file on September 21, 2017 and on October 26, 2017 two consented Motions for Suspension for Settlement for thirty (30) days to transition files from former counsel and to engage in ongoing settlement discussions. (9 & 11 TTABVUE.) The Board granted both thirty-day suspensions. (10 & 12 TTABVUE.) The parties also concurrently extended the discovery deadlines to the beginning of the new year. (Joyce Decl. ¶ 6.) On December 4, 2017, Amorepacific filed a 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 Expert Disclosures”) (13 TTABVUE), which PLG opposed, and that is currently pending for decision. (13-15 TTABVUE.)

On January 2, 2018, Amorepacific responded to PLG’s discovery requests and on January 3, 2018, PLG responded to Amorepacific’s discovery requests. (Joyce Decl. ¶ 7.) PLG also produced 327 documents, which consist primarily of delivery notes. (*Id.*) PLG has other documents left to produce, however, that are responsive to Amorepacific’s written discovery requests and that PLG stated would be forthcoming. (*Id.*; Ex. B.)

For all these reasons, PLG has now filed this untimely and inappropriate Motion to halt further discovery that Amorepacific is entitled to regarding its claims in this Consolidated Proceeding.

III. SUMMARY JUDGMENT STANDARD

In determining whether summary judgment is appropriate, the Board applies the legal standard of Federal Rule of Civil Procedure 56(c) to the evidence of record. *T.A.B. Sys. v. Pactel Teletrac*, 77 F.3d 1372, 1374 (Fed. Cir. 1996). Summary judgment may be granted only when the pleadings and evidence of record “show that there is no genuine issue as to any material fact

and that the moving party is entitled to a judgment as a matter of law.” *Action Temp. Servs., Inc. v. Labor Force, Inc.*, 870 F.2d 1563, 1565 (Fed. Cir. 1989) (citing *Celotex Corp. v. Catrett*, 477 U.S. 317, 322-26 (1986)). A party moving for summary judgment has the burden of demonstrating the absence of any genuine dispute as to a material fact, and that it is entitled to judgment as a matter of law. *T.A.B. Sys.*, 77 F.3d at 1374. *See also Celotex Corp.*, 477 U.S. 317. Specifically, the United States Court of Appeals for the Federal Circuit has defined a “material fact” as “one that may affect the decision, whereby the finding of that fact is relevant and necessary to the proceedings.” *Opryland USA Inc. v. Great Am. Music Show, Inc.*, 970 F.2d 847, 849-50 (Fed. Cir. 1992). Further, the Federal Circuit has stated that, “[a] genuine dispute is shown to exist if sufficient evidence is presented such that a reasonable fact finder could decide the question in favor of the non-moving party.” *Id.*

In opposition to a motion for summary judgment, the non-moving party’s evidence “is to be believed, and all justifiable inferences are to be drawn in [its] favor.” *Id.* The non-moving party is not required to present its entire case in response to a motion for summary judgment, but “must present sufficient evidence to show an evidentiary conflict as to the material fact in dispute.” *Id.* Further, the Board may only ascertain whether issues of material fact are present, and may not resolve factual issues. *Lloyd’s Food Prods., Inc. v. Eli’s, Inc.*, 987 F.2d 766, 25 U.S.P.Q. 2d 2027 (Fed. Cir. 1993); *Opryland USA*, 970 F.2d 847.

Accordingly, upon application of the proper legal standard, and in view of the material disputed facts discussed herein, this Consolidated Proceeding should be sustained and PLG’s Motion should be denied because the record demonstrates as a matter of law that there are questions of material fact as to (1) whether the 2013 Order applies to the Application; (2) whether PLG has abandoned the PRIMAVERA mark for certain goods and services in the PLG



Registration; and (3) whether PLG has abandoned the PRIMAVERA mark under the PLG Registration through a naked license. Therefore, summary judgment is not appropriate in this case, where several genuine issues of material fact exist and are supported by ample evidence.

IV. DISPUTED FACTS

PLG has not demonstrated an absence of any genuine dispute of material fact and, thus, has not met its burden. Contrary to PLG’s approach, merely declaring that something is an undisputed fact does not make it so.

A. Amorepacific Has Rights To Cosmetic Goods And Services In The United States.

Amorepacific is one of the world’s largest and preeminent beauty companies. (Joyce Decl. ¶ 4.) Amorepacific launched the PRIMERA brand in 1990 and in connection therewith, owns three U.S. trademark registrations and one application therefor covering the following goods and services:

Mark	Status	Goods/Services
PRIMERA (Stylized)  RN: 4274041 SN: 85216621 (“First Registration”)	Filed: Jan. 13, 2011 Registered: Jan. 15, 2013	(Class 3) skin lotions; creamy foundation; eye creams; cosmetic nourishing creams; cosmetic skin fresheners; make-up powder; cosmetics; cosmetic creams for skin care; hair shampoo; dentifrices
PRIMERA (Stylized)  RN: 4559010 SN: 86060318 (“Second Registration”)	Filed: Sept. 10, 2013 Registered: July 1, 2014	(Class 35) promoting the goods of others and rendering sales promotion advice in the field of cosmetics; sales promotion services for others in the field of cosmetics; wholesale store services in the field of cosmetics; retail store services in the field of cosmetics; wholesale store services in the field of cosmetic utensils; retail store services in the field of cosmetic utensils; wholesale store services in the field of health functional food with a red

Mark	Status	Goods/Services
		ginseng base; retail store services in the field of health functional food with a red ginseng base; wholesale store services in the field of health functional food with a green tea base; retail store services in the field of health functional food with a green tea base
PRIMERA RN: 4787755 SN: 77830858 ("Third Registration")	Filed: Sept. 21, 2009 Registered: Aug. 11, 2015	(Class 3) dentifrices
PRIMERA SN: 86873750 (Application)	Filed: Jan. 13, 2016	(Class 3) beauty masks; cosmetics; liquid bath soaps; shampoos

(*Id.* ¶ 4, 8; Ex. D.) Thus, in addition to the Application and the one subject to the 2013 Order, Amorepacific owns at least two other PRIMERA mark registrations for skin lotions, creamy foundation, eye creams, cosmetic nourishing creams, cosmetic skin fresheners, make-up powder, cosmetics, cosmetic creams for skin care, hair shampoo, and dentifrices, as well as for related cosmetic services. Accordingly, Amorepacific has rights to cosmetics and related goods and services in the United States.

B. The Goods In the Application Are Different Than In the Previous Proceeding.

The only PRIMERA application subject to the 2013 Order was Amorepacific’s Third Registration. In the Previous Proceeding, the following language was deleted from Amorepacific’s Third Registration: “Cosmetics and cosmetic preparations; nonmedicated 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,” leaving “dentifrices” or toothpaste for registration.

Amorepacific's newest Application involves: "beauty masks; cosmetics; liquid bath soaps; shampoos." Notably new to the Application is "Liquid bath soaps." Thus, PLG's statement that the goods at issue in the Previous Proceeding "comprise the same goods listed in the present Application" is incorrect. (16 TTABVUE 14.)

Further, in the 2013 Order, the Board made the factual finding that the goods in the application for the Third Registration were different from the goods in the First Registration (for "skin lotions; creamy foundation; eye creams; cosmetic nourishing creams; cosmetic skin fresheners; make-up powder; cosmetics; cosmetic creams for skin care; hair shampoo; dentifrices"). (16 TTABVUE 31.) But in the 2013 Order, the Board did not define "cosmetics," beyond "'make-up preparations,' 'foundation cream' and 'make-up powder,'" (16 TTABVUE 33), and provided no guidance on "beauty masks" or "shampoos" for the Third Registration, except for removing them from the application. (16 TTABVUE 45.) This is important as the PLG Registration is for "perfumery; cosmetics; essential oils for oil burners, essential oils for saunas; essential oils in airsprays, fragrance oil comprised of essential oils" in Class 3, "fragrance oil burners, oil diffuser" in Class 21, and "wholesale stores and retail store services featuring cosmetics, perfumery, soaps and essential oils, oil burners, [and] stone diffusers" in Class 35. Accordingly, there is a factual issue as to the scope of the goods at issue in this Consolidated Proceeding that the parties have not yet had the opportunity to determine through discovery.

C. PLG Abandoned The PRIMAVERA Mark For Certain Goods And Services In The PLG Registration.

In its written responses to Amorepacific's discovery requests, PLG claims its date of first use in commerce for the goods listed in the PLG Registration is 2003 and PLG's claimed date of first use in commerce for the related wholesale and retail services is November 2005. (Joyce

Decl. ¶ 7; Ex. A, Response to Interrogatory No. 4.) PLG, however, refuses to produce documents concerning its first use in the United States. (*Id.*; Ex. B, Response to Request for Production of Document and Things No. 11.) PLG also admitted that it is no longer using its PRIMERA mark in relation to “perfume oils for the manufacture of cosmetic preparations; fragrance oil burners; incense burners; wholesale store and retail store services featuring cosmetics, perfumery, hair lotions, soaps, and essential oils, oil burners, incense burners and stone diffusers.” (*Id.*; Ex. A, Response to Interrogatory No. 6.) Even PLG’s Chief Executive Officer admits that PLG has ceased use of “fragrance oil burners” and “incense burners” since at least May 29, 2015. (*See* Decl. of Titus Kaufmann in support of Motion, 16 TTABVUE 50-51, ¶¶ 9-11.) PLG also relies on “delivery notes,” “invoices,” and internal price lists to show that it is using the PRIMAVERA mark in the United States for the goods listed under the PLG Registration (*see* 16 TTABVUE 49-52, ¶¶ 4, 7, 9, & 12; 53-117, 121-42, & 148-274), but PLG has not shown that the purported sales are for each and every good in the PLG Registration. More importantly, these documents demonstrate sales generally, and not actual use of the PRIMAVERA mark in commerce.

PLG also provided “web page print outs” purportedly showing “Primavera Life’s having promoted and rendered the PRIMAVERA Services in U.S. commerce,” but the PRIMAVERA mark is not visible in Exhibit B, and even if the mark were visible, not all the goods and services under the PLG Registration are listed. (*See* 16 TTABVUE 49, ¶ 5; 118-21.) (Joyce Decl. ¶ 9.) Further, the PRIMAVERA mark is not shown on any product in Exhibit D, and no “fragrance oil burners” or “oil diffusers” are listed. (*See* 16 TTABVUE 50, ¶ 8; 143-47) (Joyce Decl. ¶ 10.) In addition, the alleged “images of product packaging for the PRIMAVERA Goods” that PLG relies upon do not have a date reflecting when such goods were available for sale. (16

TTABVUE 51, ¶ 11; 332-40.) (Joyce Decl. ¶ 10.) Thus, there are serious issue of material fact as to whether this evidence shows use of the PRIMAVERA mark in commerce (and with the intent to do) so since the PLG Registration issued. (16 TTABVUE 51, ¶ 13.)

From its discovery responses and Motion evidence alone, PLG has admitted to non-use of certain of the good and services in the PLG Registration. This is aside and part from Internet references that Amorepacific has showing that at least from 2008-12, PLG was not featuring cosmetics, oil for oil burners, oil for sauna, oil for airspray (through only 2011), fragrance oil burners, and oil diffusers on at least its main website. (Joyce Decl. ¶ 11; Ex. E.) This four-year period of time is *prima facie* evidence that PLG abandoned its rights at that time. What happened to PLG's rights thereafter and currently has yet to be exhausted through discovery. For these reasons, there are issues of material fact.

D. PLG Abandoned The PRIMAVERA Mark In The PLG Registration Through A Naked License.

PLG also provided in its discovery responses that it does not have knowledge or control of its channels of trade and “downstream retail settings” for the PRIMAVERA mark. (*Id.* ¶ 7; Ex. A, Response to Interrogatory No. 9.) PLG further admits that “promotional campaigns are carried out by distributors, the expenses for which are outside PLG's knowledge and control.” (*Id.*; Ex. A; Response to Interrogatory No. 12.) PLG also admits to having no documents advertising the PRIMAVERA mark in its control. (*Id.*; Ex. B; Response to Document Request No. 16.)

Thus, based on PLG's discovery responses, PLG does none of its own advertising in the United States and does not have any control over or knowledge of its U.S. retailers. While PLG may have an agreement with its distributor to handle the U.S. market, PLG has yet to produce that agreement or license (which it has agreed to produce). (*Id.* ¶ 7; Ex. B; Response to Request

for Production of Documents No. 9.) There is a strong inference that the agreement may be a naked license as PLG has no control of its PRIMERA mark in the United States. Amorepacific is entitled to review the subject agreement, which it has rightly sought in discovery, as it may provide an additional claim for cancellation of the PRIMAVERA mark on the ground of abandonment based on a naked (uncontrolled) license.

For these additional reasons, there are genuine issues of material fact.

V. ARGUMENT

A. There Are Genuine Issues of Material Fact As To Whether The 2013 Order Would Apply To The Application.

The doctrine of issue preclusion is applicable where: (1) the issue is identical; (2) the issues were actually litigated; (3) the determination of the issues was necessary to the resulting judgment; and (4) the party defending against preclusion had a full and fair opportunity to litigate the issue. *Jet, Inc. v. Sewage Aeration Sys.*, 55 U.S.P.Q.2d 1854, 223 F.3d 1360, 1366 (Fed Cir. 2000). Notably, however, “[a] prior trademark infringement action will not, by action of claim preclusion, bar the subsequent prosecution of a petition for cancellation of the defendant’s registered mark.” *Id.* Further, here, the 2013 Order does not apply to the goods at issue in the pending Application. Thus, the issues are not identical and genuine issues of fact must be resolved.

Determination here of whether issue preclusion applies must also take into account the fact that Amorepacific owns rights to offer cosmetics, shampoo, and related goods and services under the PRIMERA Mark in the United States in three U.S. Trademark Registrations. Indeed, in addition to the Application and the one subject to the 2013 Order, Amorepacific owns at least two other PRIMERA mark U.S. Trademark Registrations specifically for skin lotions, creamy foundation, eye creams, cosmetic nourishing creams, cosmetic skin fresheners, make-up powder,

cosmetics, cosmetic creams for skin care, hair shampoo, and dentifrices in Class 3 (First Registration), as well as for related cosmetic services in Class 35 (Second Registration) (both shown in the above chart). PLG *never* opposed the applications for Amorepacific's First or Second Registrations, and even the Examining Attorneys reviewing the applications for all of Amorepacific's PRIMERA marks *never* cited PLG's Registration against Amorepacific. Thus, both PLG and the United States Patent and Trademark Office have allowed the parties to have co-existing registrations in the cosmetics and related spaces. Accordingly, Amorepacific has rights to cosmetics and related goods and services in the United States and the Application must be analyzed in this context.

1. There Are Genuine Issues of Material Fact As To Whether The Goods In The Application Are The Same As Those In the Previous Proceeding.

The Application at issue here does not involve the same goods at issue in the Previous Proceeding. In the Previous Proceeding, the following language was deleted from Amorepacific's Third Registration: "Cosmetics and cosmetic preparations; nonmedicated 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," leaving "dentifrices" or toothpaste for registration. Amorepacific's newest Application involves: "Beauty masks; Cosmetics; Liquid bath soaps; Shampoos." (16 TTABVUE 23.) Notably new to the Application is "Liquid bath soaps."² Therefore PLG's statement that the goods at issue in the Previous Proceeding "comprise the same goods listed in the present Application" is false. (16 TTABVUE 14.)

² PLG takes issue with Amorepacific's response to Request for Admission No. 26, which asked Amorepacific to admit that Amorepacific's pending Application was at issue in the Prior Proceeding. Amorepacific's response was that the request was nonsensical as it was impossible for the current Application to be at issue in the Previous Proceeding. (16 TTABVUE 13-14; 277-78.) Amorepacific stands by this response.

The Federal Drug Administration's ("FDA") definition of cosmetics specifically excludes the product of soaps. *See* Federal Food, Drug and Cosmetic Act, 21 U.S.C. § 321 (excluding soap from the definition of "cosmetic"); *see also* 21 C.F.R. § 701.20 ("In its definition of the term cosmetic, the Federal Food, Drug, and Cosmetic Act specifically excludes soap. The term soap is nowhere defined in the act. In administering the act, the [FDA] interprets the term "soap" to apply only to articles that meet the following conditions: (1) The bulk of the nonvolatile matter in the product consists of an alkali salt of fatty acids and the detergent properties of the article are due to the alkali-fatty acid compounds; and (2) The product is labeled, sold, and represented only as soap."). Thus, Amorepacific at the least is entitled to a registration for liquid bath soaps for the PRIMERA mark.

Further, all of Amorepacific's U.S. Registrations involve different goods. The Board already made this observation in the 2013 Order when it determined that the goods in the application for the Third Registration were different from the goods in the First Registration. (*See* 16 TTABVUE 32 ("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.")) Accordingly, the Application at issue here involves different goods and the 2013 Order cannot apply, allowing the Board to determine the facts of this proceeding independently and separately from the Previous Proceeding.

2. There Are Genuine Issues of Material Fact As To Whether The Definition Of Cosmetics, Beauty Masks, and Shampoos Was Actually Litigated Before.

The parties did not litigate and the Board did provide definitions of "cosmetics," "beauty masks," and "shampoos" in the 2013 Order that are applicable here. The Board provided in the 2013 Order: "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.'" (16 TTABVUE 33.) Thus the Board limited its classification of "cosmetics" to "'make-up preparations,' 'foundation cream' and 'make-up powder'" and provided no guidance on "beauty masks" or "shampoos," except for removing them from the application for the Third Registration. (16 TTABVUE 45.)³ What are "beauty masks; cosmetics; liquid bath soaps; [and] shampoos" in the pending Application with regard to PLG's Registration has yet to be determined in this Consolidated Proceeding. *See Mayer/Berkshire Corp. v. Berkshire Fashions, Inc.* 76 U.S.P.Q.2d 1310, 424 F.3d 1229, 1233 (Fed. Cir. 2005) (vacating grant of summary judgment based on *res judicata* when the parties disputed "the extent to which Berkshire Fashions' application embraces a broader statement of goods than those before the district court; this aspect alone rendered summary judgment inapplicable, for the Board did not consider the separate goods in the Class 25 application, but stated that all "garments" were included in the district court judgment. Precedent and practice require a more detailed analysis.")

Further, in other cases involving "cosmetics," the Board has found that cosmetics cover an incredibly broad category of goods and should be determined on a case by case basis:

We agree with applicant's contention that the examining attorney's definition of 'cosmetics' is extremely broad and, we take additional judicial notice of the definition in Merriam-Webster's Collegiate Dictionary (11th ed, 2003) of "cosmetic" as, in relevant part, "of, relating to, or making for beauty esp. complexion: beautifying." In other words, 'cosmetics' are, in everyday parlance,

³ PLG takes issue with Amorepacific's response to Interrogatory No. 24 regarding Amorepacific's denial that the goods in the Application are not "cosmetics or closely related to cosmetics." Amorepacific stands by its objections and response that: "PLG has not defined 'cosmetics,' therefore rendering 'cosmetics' vague and ambiguous, such that Amorepacific is without information sufficient to form a belief as to the truth or falsity of Opposer's allegation, in paragraph 12 of the Notice of Opposition, that the goods in the Application are either cosmetics or closely related to cosmetics. Discovery is ongoing, and Amorepacific reserves its right to supplement its Response at a later date." (16 TTABVUE 15-16; 325-26.)

‘make-up,’ and are usually applied to the face. Clearly, the ‘false eyelashes’ identified in the cited registrations are ‘cosmetics.’ However, we do not agree that applicant’s medicated lotion is likely to be considered a ‘cosmetic.’ Moreover, even if applicant’s medicated lotion were to be considered a ‘cosmetic,’ the mere fact that applicant’s and registrant’s goods might belong to the broad category of cosmetics does not require the conclusion that they are related products. Such a relationship must be established in each case to avoid a *per se* rule for all cosmetics.

In re Daniel T. Phuoc, Serial No. 77356068, 2009 WL 1228530, at *4 (TTAB Apr. 29, 2009) (reversing the refusal of the subject mark under 2(d)) (non-precedential). Because the definition is so broad, in cases involving cosmetics the Board has allowed witness testimony to determine the scope of the goods, *Johnson & Johnson v. Valentino Gitto*, Opposition No. 91197584, 2014 WL 1390521 (TTAB Mar. 28, 2014) (non-precedential), and the Board has considered the presence or lack of consumer evidence to determine how consumers view cosmetics. *In re Wet Seal, Inc.* Serial No. 76338469, 2004 WL 1294386 (TTAB May 27, 2004) (non-precedential).⁴ Several cases have also taken issue with whether shampoo or soap, two of the goods in the Application, are cosmetics. *Id.* Thus, “cosmetics” cannot be a *per se* definition and requires a finding of what it means. *In re Daniel T. Phuoc*, 2009 WL 1228530, at *4. *See also Int’l Marco Polo Servs., Inc.*, Cancellation No. 28,605, 2002 WL 1602493 (TTAB July 18, 2002) (non-

⁴ In this case, the Board took issue with how consumers would view cosmetics: “We are not convinced that [the dictionary’s] single, expansive definition of ‘cosmetics,’ covering virtually every conceivable preparation that could be applied to any part of the body, accurately reflects the typical consumer’s perception of this term. There is no evidence that the specific products identified in these registrations, **that is, hair care preparations such as shampoos and hair conditioners, would be perceived by the typical purchasers of those goods as ‘cosmetics,’ or that such purchasers would believe that shampoos and hair conditioners are produced by the same companies that produce cosmetics or cosmetic accessories. Moreover, the specific exclusion of soap products from this definition, and thus the effective exclusion of shampoo, results in a truly artificial distinction between which products are, and which products are not, ‘cosmetics,’ and leaves us with further doubt that this definition accurately reflects the realities of the marketplace. Thus, we cannot find, at least based on this record, that hair care preparations and cosmetics are legally identical products.” *See In re Wet Seal, Inc.*, 2004 WL 1294386, at *4 (reversing refusal of the mark) (emphasis added.)**

precedential) (denying summary judgment because “there is a genuine issue of material fact regarding, at a minimum, whether ‘hotel services’ encompass ‘hotel reservation services’ so as to create the identity of issues necessary to apply the doctrine of collateral estoppel.”).

Such determinations by the Board are more instructive than PLG’s purported evidence showing how retailers other than the parties at issue advertise their cosmetics, beauty masks, and liquid soaps or list them in their registrations. (16 TTABVUE 14, 280-322.) *See In re Daniel T. Phuoc*, 2009 WL 1228530, at *4 (finding third-party registrations not probative of a relationship between applicant’s and registration’s goods when they do not include all the relevant goods at issue). Indeed, the Board must make that determination case by case. *Id.*

Finally, in the Previous Proceeding, Amorepacific did not serve any discovery on PLG, neither party engaged an expert to define cosmetics or the scope of goods at issue, and neither party took testimony depositions. Thus, the 2013 Order must be reviewed in this limited context.

In sum, there are factual issues as to the scope of the goods at issue in this Consolidated Proceeding that the parties have not yet had the opportunity to determine through discovery, particularly given Amorepacific’s rights to cosmetics and related goods and services under the PRIMERA mark. *Jet, Inc. v. Sewage Aeration Sys.*, Cancellation No. 25,587, 2003 WL 355736, at *6 (TTAB Feb. 13, 2003) (non-precedential) (denying motion for summary judgment on issue preclusion grounds when the identity of the issue litigated before was not the same).

B. There Are Genuine Issues of Material Fact As To Whether PLG Abandoned The PRIMAVERA Mark For Certain Goods And Services In The PLG Registration.

Section 14 of the Lanham Act provides that: “A petition to cancel a registration of a mark, stating the grounds relied upon, may . . . be filed as follows by any person who believes that he is or will be damaged . . . by the registration of a mark on the principal register . . . (3) [a]t any time if the registered mark . . . has been abandoned” 15 U.S.C. § 1064(3). A mark

shall be deemed to be “abandoned” “[w]hen its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be *prima facie* evidence of abandonment. ‘Use’ of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.” 15 U.S.C. § 1127.

PLG claims its date of first use of in commerce for the goods listed in the PLG Registration is 2003 and its claimed date of first use in commerce for the related wholesale and retail services is November 2005 (Joyce Decl. ¶ 7; Ex. A, Response to Interrogatory No. 4), but PLG refuses to produce documents concerning its first use in the United States. (*Id.*; Ex. B, Response to Request for Production of Document and Things No. 11.) PLG also admitted that it is no longer using its marks in relation to “perfume oils for the manufacture of cosmetic preparations; fragrance oil burners; incense burners; wholesale store and retail store services featuring cosmetics, perfumery, hair lotions, soaps, and essential oils, oil burners, incense burners and stone diffusers” (*Id.*; Ex. A, Response to Interrogatory No. 6.) Even PLG’s Chief Executive Officer admits that PLG has ceased use of “fragrance oil burners” and “incense burners” since at least May 29, 2015. (*See* 16 TTABVue 50-51, ¶¶ 9-11.) Thus, just from its discovery responses and Motion evidence alone, PLG has admitted to non-use of certain of the goods and services in the PLG Registration.

These admissions are aside and apart from Internet references showing that from 2008-12, PLG was not featuring cosmetics, oil for oil burners, oil for sauna, oil for airspray,⁵ fragrance oil burners, and oil diffusers on its main website. (*Id.* ¶ 11; Ex. E.) This four-year period of time

⁵ There is evidence that PLG may have resumed use of “oil for airspray” on its main website in 2011, but that is still three years of non-use from 2008, when PLG applied to register the PRIMAVERA mark in the PLG Registration, to 2011. The PLG Registration issued on June 2, 2009.

is *prima facie* evidence that PLG abandoned its rights at that time. 15 U.S.C. § 1127 (defining a “mark shall be deemed to be ‘abandoned’” “[w]hen its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be *prima facie* evidence of abandonment.”) “This *prima facie* showing of abandonment shifts the burden to respondent, who must show he used the mark or had an intent to resume use of the mark. *See Imperial Tobacco Ltd., Assignee of Imperial Group PLC v. Philip Morris, Inc.*, 899 F.2d 1575, 1579, 14 U.S.P.Q.2d 1390, 1393 (Fed. Cir. 1990) (presumption eliminates plaintiff’s burden to establish intent element of abandonment as an initial part of its case)). PLG’s statement that it “has been selling PRIMAVERA-branded cosmetics and essential oil products into the United States continuously since at least as early as 2009” cannot be taken at face value, (16 TTABVUE 11; 51, ¶ 12; & 191-275), particularly when PLG has admitted non-use of certain goods and services. Indeed, “[n]o proof could be more persuasive than respondent’s admission of nonuse.” *ShutEmDown Sports, Inc. v. Carl Dean Lacy*, 102 U.S.P.Q.2d 1036 (TTAB 2012). What happened to PLG’s rights after abandonment and currently has yet to be exhausted through discovery.

Further, PLG relies primarily on shipping documents such “delivery notes” and “invoices” as well as internal price lists to show its purported use of the PRIMAVERA mark in the PLG Registration in the U.S. (16 TTABVUE 49-52, ¶¶ 4, 7, 9, & 12; 53-117; 121-42; & 148-274.) First, PLG has not shown that the purported sales are for each and every good and service in the PLG Registration. Second, and more importantly, “delivery notes,” “invoices,” and internal price lists demonstrate only sales (or offer of sales) generally of a product, and not use of the PRIMARVERA mark in commerce. 15 U.S.C. § 1127 (defining “use” of a mark to mean the *bona fide* use of such mark made in the ordinary course of trade”) (emphasis

added.) Indeed, proper evidence of use of a mark in commerce requires evidence that the mark was used on a good subject to a sale. *See ShutEmDown Sports*, 102 U.S.P.Q.2d at 1036 (finding that invoices can be used to prove that things were actually sold, though not that they support use of a mark in commerce); *In re Dura Corp.*, 188 U.S.P.Q. 701, 1975 WL 20887 (TTAB 1975) (finding information or advertising sheets packed in box of parts do not qualify as an “affixation” “on the goods or on the containers in which the goods are shipped or on tags or labels affixed to the goods, or on displays associated with the goods” that indicates trademark usage of “TRAILMASTER”); *Application of Chicago Rawhide Mfg. Co.*, 173 U.S.P.Q. 8, 455 F.2d 563, 565 (C.C.P.A. 1972) (“We find nothing more than use of the mark on a carbon copy of an invoice which copy accompanies the goods ‘in containers in which the goods are shipped.’ Such does not constitute use on the goods as required by the clear and unambiguous language of section 45 of the Lanham Act.”).

Moreover, PLG provided “web page print outs” purportedly showing “Primavera Life’s having promoted and rendered the PRIMAVERA Services in U.S. commerce,” but the PRIMAVERA mark is not visible in Exhibit B, and even if the mark were visible, not all the goods and services under the PLG Registration are listed. (*See* 16 TTABVUE 50, ¶ 5; 118-120.) (Joyce Decl. ¶ 9.) Further, the PRIMAVERA mark is not shown on any product in Exhibit D, and no “fragrance oil burners” or “oil diffusers” are listed. (*See* 16 TTABVUE 50, ¶ 8; 143-47.) (Joyce Decl. ¶ 10.) In addition, the alleged “images of product packaging for the PRIMAVERA Goods” that PLG relies upon do not have a date reflecting when such goods were available for sale. (*See* 16 TTABVUE 51, ¶ 11; 332-40.) (Joyce Decl. ¶ 10.) Thus, this purported evidence of use does not show use of the PRIMAVERA mark in commerce, nor does it show the PLG has used the PRIMAVERA mark in commerce consistently and with the intent

to do so since the PLG Registration issued. (16 TTABVUE 19; 51, ¶ 13.)

PLG's statements and declaration claiming there was no "intent not to resume" use of the PRIMAVERA mark in the PLG Registration is also not sufficient to eliminate the above issues of material fact regarding PLG's purported use. *Imperial Tobacco Ltd.*, 14 U.S.P.Q.2d at 1390, 899 F.2d at 1581 ("An averment of no intent to abandon is little more than a denial in a pleading, which is patently insufficient to preclude summary judgment on the ground the facts are disputed. . . . [A] conclusory statement on the ultimate issue does not create a genuine issue of fact. The registrant must put forth evidence with respect to what activities it engaged in during the nonuse period or what outside events occurred from which an intent to resume use during the nonuse period may reasonably be inferred.") (internal citations omitted).

For these reasons, there are issues of material fact as to PLG's claims of purported continued use of the PRIMAVERA Mark on the goods and services under the PLG Registration.

C. There Are Genuine Issues of Material Fact As To Whether PLG Abandoned The PRIMAVERA Mark In The PLG Registration Through A Naked License.

A federal registration can be abandoned through naked licensing. Indeed, "[i]t is well established that permitting others to use one's mark without retaining control over the nature and quality of the goods or services produced under the mark works an abandonment of the mark." *First Nat'l Bank of Omaha v. Autoteller Sys. Serv. Corp.*, 9 U.S.P.Q.2d 1740, 1743 (TTAB 1988) (finding that a license agreement where no control of the mark is performed does not resume the use or intent to use the mark, such that Respondent should be deemed to have abandoned the mark); *Haymaker Sports, Inc. v. Turian*, 198 U.S.P.Q. 610, 613, 581 F.2d 257, 261 (C.C.P.A. 1978) ("Uncontrolled licensing of a mark results in abandonment of the mark by the licensor.") (citation omitted). "A licensor may license his mark if the licensing agreement provides for adequate control by the licensor over the quality of goods or services produced under the mark

by a licensee.” *Haymaker*, 198 U.S.P.Q. at 613, 581 F.2d at 261.

PLG does not have knowledge or control of its channels of trade and “downstream retail settings” for the PRIMAVERA Mark. (Joyce Decl. ¶ 7; Ex. A, Response to Interrogatory No. 9.) PLG’s PRIMAVERA “promotional campaigns are carried out by distributors, the expenses for which are outside PLG’s knowledge and control.” (*Id.*; Ex. A, Response to Interrogatory No. 12.) PLG also admits to having no documents advertising the PRIMAVERA mark in its control. (*Id.*; Ex. B, Response to Document Request No. 16.)

Thus, it is now a fact in this Consolidated Proceeding that PLG does none of its own advertising in the United States and does not have any control over or knowledge of its retailers in the United States. While PLG claims to have an agreement with its distributor to handle the U.S. market, PLG has yet to produce that agreement or license (which it has agreed to produce). (*Id.*; Ex. B, Response to Request for Production of Documents No. 9.) Accordingly, it appears that PLG does not control use of its mark in the United States. Amorepacific is entitled to review that agreement as it may provide an additional claim for cancellation of the PRIMAVERA mark in the PLG Registration on the grounds of abandonment based on a naked (uncontrolled) license. *Cleveland State Univ. v. Campuseai Consortium*, Cancellation No. 92053509, 2014 WL 2159248 (TTAB May 5, 2014) (non-precedential) (holding Respondent’s lack of responses to Petitioner’s discovery requests regarding use of the mark (such as licenses with third parties, control over the mark, revenues etc.) allowed Petitioner to infer that Respondent had no documents and therefore, established that the mark was abandoned); *First Nat’l Bank of Omaha*, 9 U.S.P.Q. 2d at 1741; *Haymaker Sports, Inc.*, 198 U.S.P.Q. at 613, 581 F.2d at 257. Accordingly, there are genuine issues of material fact as to Amorepacific’s abandonment claim.

VI. CONCLUSION

For the reasons set forth herein, there are genuine issues of material fact regarding whether the 2013 Order applies – namely whether the same goods are at issue and whether the Board’s determination of those goods in the 2013 Order is applicable here. Further, there are genuine issues of material fact as to PLG’s continued use of the goods and services under the PLG Registration since that registration issued, as well as whether PLG has abandoned the PRIMAVERA mark in the PLG Registration through a naked license. Indeed, Amorepacific’s well-founded abandonment claims in its Petition for Cancellation seriously undercut PLG’s purported rights in the PLG Registration, the basis of PLG’s Notice of Opposition, which therefore cannot be decided yet, apart from the fact that the 2013 Order does not apply. *Jet, Inc.*, 223 F.3d at 1366. Because so many genuine issues of fact remain and exist, Applicant respectfully requests that the Board deny PLG’s Motion in this Consolidated Proceeding, and allow the case to proceed. Amorepacific notes that its pending Motion to Reopen Expert Disclosures (13 TTABVUE) has not yet been decided, and respectfully requests a ruling on that motion and dates reset along the framework proposed therein.

Dated: February 16, 2018

Respectfully submitted,

By: /s/ Ann K. Ford
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CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing APPLICANT/PETITIONER'S RESPONSE
IN OPPOSITION TO OPPOSER/RESPONDENT'S MOTION FOR SUMMARY JUDGMENT
was served via email to counsel of record:

Patrick J. Concannon
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(617) 439-2177
(617) 439-9177 (fax)
pconcannon@nutter.com; docket@nutter.com

this 16th day of February, 2018.

/s/ Ann K. Ford

Ann K. Ford
Attorney for Applicant/Petitioner

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

In the matter of Trademark
Application Serial No. 86873750
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/Respondent,)	
)	
v.)	Consolidated Proceeding
)	Opposition No. 91231958 (parent)
)	Cancellation No. 92065305
AMOREPACIFIC CORPORATION,)	
)	
Applicant/Petitioner.)	
)	

**DECLARATION OF ASHLEY JOYCE IN SUPPORT OF APPLICANT/PETITIONER'S
RESPONSE IN OPPOSITION TO OPPOSER/RESPONDENT'S
MOTION FOR SUMMARY JUDGMENT**

I, Ashley Joyce, declare:

1. I am an attorney with the law firm of DLA Piper LLP (US), counsel for Amorepacific Corporation ("Amorepacific"), Applicant/Petitioner in this Consolidated Proceeding.

2. I have personal knowledge of the facts stated herein, and I could and would competently testify to such facts if called upon to do so.

3. I am over the age of 18 and under no disability.

4. Amorepacific is one of the world's largest and preeminent beauty companies.

5. Only since September 14, 2017 has Amorepacific's current counsel been involved in the case. Discovery has only just been served by both Amorepacific and Primavera Life GmbH ("PLG") since September 5, 2017, as the parties have continued to negotiate a global settlement.

6. Specifically, on September 1, 2017, PLG had served six sets of discovery on Amorepacific, which totaled forty-three Requests for Production of Documents, thirty-four Requests for Admission, and seventy-seven Interrogatories. On September 5, 2017 previous counsel for Amorepacific had served three sets of discovery on PLG, which included twenty-four Requests for Production of Documents, three Requests for Admission, and twenty-four Interrogatories. The parties extended the discovery deadlines to the beginning of the new year.

7. On January 2, 2018, Amorepacific responded to PLG's discovery requests and on January 3, 2018, PLG responded to Amorepacific's discovery requests. PLG also produced 327 documents, which consist primarily of delivery notes. PLG has other documents left to produce, however, that are responsive to Amorepacific's written discovery requests and that PLG stated would be forthcoming. **Exhibit A** attached hereto is a true and correct copy of PLG's Responses to Amorepacific's Interrogatories; **Exhibit B** attached hereto is a true and correct copy of PLG's Responses to Amorepacific's Requests for Production of Documents and Things; and **Exhibit C** attached hereto is a true and correct copy of PLG's Responses to Amorepacific's Requests for Admissions.

8. Amorepacific launched the PRIMERA brand in 1990 and in connection therewith, owns three U.S. trademark registrations and one application therefor. **Exhibit D** attached hereto

are true and correct copies of the United States Trademark Registrations and the TSDR and TESS printouts from the official website of the USPTO for Amorepacific's Application.

9. PLG offers "web page print outs" purportedly showing "Primavera Life's having promoted and rendered the PRIMAVERA Services in U.S. commerce," but the PRIMAVERA mark is not visible in Exhibit B to Mr. Kaufmann's Declaration, and even if the mark were visible, not all the goods and services under the PLG Registration are listed.

10. Further, the PRIMAVERA mark is not shown on any product in Exhibit D to Mr. Kaufmann's Declaration, and no "fragrance oil burners" or "oil diffusers" are listed. In addition, the alleged "images of product packaging for the PRIMAVERA Goods" that PLG relies upon do not have a date reflecting when such goods were purportedly available for sale.

11. True and correct copies of screenshots taken on December 21, 2017 from the Internet Archive WayBack Machine, located at <http://archive.org/web/>, are attached hereto as **Exhibit E**, showing that from at least 2008-2012, PLG was not featuring cosmetics, oil for oil burners, oil for sauna, oil for aerospray (from 2008-2011), fragrance oil burners, and oil diffusers on its main website located at <https://www.goddessofspring.com>.

12. **Exhibit F** attached hereto is a true and correct copy of *In re Daniel T. Phuoc*, Serial No. 77356068, 2009 WL 1228530 (TTAB Apr. 29, 2009), as obtained from Westlaw, <http://www.westlaw.com>, which I accessed on February 16, 2018.

13. **Exhibit G** attached hereto is a true and correct copy of *Johnson & Johnson v. Valentino Gitto*, Opposition No. 91197584, 2014 WL 1390521 (TTAB Mar. 28, 2014), as obtained from Westlaw, <http://www.westlaw.com>, which I accessed on February 16, 2018.

14. **Exhibit H** attached hereto is a true and correct copy of *In re Wet Seal, Inc.*, Serial No. 76338469, 2004 WL 1294386 (TTAB May 27, 2004), as obtained from Westlaw, <http://www.westlaw.com>, which I accessed on February 16, 2018.

15. **Exhibit I** attached hereto is a true and correct copy of *Int'l Marco Polo Servs., Inc.*, Cancellation No. 28,605, 2002 WL 1602493 (TTAB July 18, 2002), as obtained from Westlaw, <http://www.westlaw.com>, which I accessed on February 16, 2018.

16. **Exhibit J** attached hereto is a true and correct copy of *Jet, Inc. v. Sewage Aeration Sys.*, Cancellation No. 25,587, 2003 WL 355736 (TTAB 2003), as obtained from Westlaw, <http://www.westlaw.com>, which I accessed on February 16, 2018.

17. **Exhibit K** attached hereto is a true and correct copy of *Cleveland State Univ. v. Campuseai Consortium*, Cancellation No. 92053509, 2014 WL 2159248 (TTAB May 5, 2014), as obtained from Westlaw, <http://www.westlaw.com>, which I accessed on February 16, 2018.

18. I declare under penalty of perjury of the laws of the United States of America that the foregoing is true and correct, and that I executed this declaration on February 16, 2018, at Washington, District of Columbia.

/s/ Ashley Joyce
Ashley Joyce

Exhibit A

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

PRIMAVERA LIFE GMBH.)	
)	
Opposer,)	
)	
v.)	
)	Opposition No. 91231958
)	
AMOREPACIFIC CORPORATION)	Application No. 86/873750
)	
Applicant.)	

**OPPOSER’S RESPONSES TO APPLICANT’S INTERROGATORIES TO
OPPOSER (FIRST SET)**

Primavera Life GmbH (“Opposer”), in accordance with Rules 26 and 33 of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice of the Patent and Trademark Office, hereby serves the following Responses to Amorepacific Corporation’s (“Applicant”) “Responses to Interrogatories to Opposer (First Set)” (the “Interrogatories”).

GENERAL OBJECTIONS

The following General Objections are made with respect to each and every one of the Interrogatories:

Applicant also objects to each of the Interrogatories to the extent that they seek information in excess of Applicant’s obligations under the Federal Rules of Civil Procedure or are otherwise overly broad, unduly burdensome, oppressive, redundant, duplicative, vague, ambiguous, cumulative, and/or harassing.

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Applicant objects to each of the Interrogatories to the extent that they seek information protected from disclosure by the attorney-client privilege, the work product doctrine, or any other applicable privilege.

Applicant objects to the Interrogatories to the extent they seek trade secrets or other confidential or proprietary research, development, commercial, or business information. Applicant will produce such information, if requested and not otherwise objectionable, only pursuant to a Protective Order.

Amorepacific objects to the Interrogatories to the extent that they request the production or disclosure of information that is neither relevant to the subject matter involved in the pending proceeding nor reasonably calculated to lead to the discovery of admissible evidence.

Applicant has conducted a reasonable search for responsive information by identifying the persons it believes are most knowledgeable concerning the Interrogatories and has interviewed those persons to gather information responsive to the non-objectionable categories or portions of categories in each Interrogatory. Applicant bases its responses to the Interrogatories on this search and objects to the Interrogatories as overly broad and unduly burdensome to the extent that they purport to require Applicant to perform any additional search for information beyond this search. Should Applicant discover additional information regarding its responses to the Interrogatories, Applicant reserves the right to supplement or amend its responses accordingly.

Applicant's responses to the Interrogatories are hereby made without in any way waiving or intending to waive, but rather, to the contrary, by preserving and intending to preserve:

- i. All questions as to the competence, relevance, materiality, and admissibility as evidence for any purpose of the information or the subject matter thereof, in any aspect of this or any other court action or judicial or administrative proceeding or investigation;
- ii. The right to object on any ground to the use of any such information, or the subject matter thereof, in any aspect of this or any other court action or judicial or administrative proceeding or investigation;
- iii. The right to object at any time for any further response to this or any other request for information or production of documents; and
- iv. The right at any time to supplement this response.

Applicant objects to the Interrogatories to the extent that they purport to require immediate production of any documents. Applicant will produce any necessary documents at such time and place as agreed upon by counsel.

Subject to and without waiving the foregoing General Objections, all of which are specifically incorporated as if set forth fully verbatim in response to each of the individual Interrogatories set forth in the Interrogatories, Applicant responds further to each individually numbered Interrogatory as follows:

INTERROGATORIES

INTERROGATORY NO. 1: Describe each instance of which Opposer is aware in which any person has been in any way confused, mistaken, or deceived as to the origin or sponsorship of any goods or services sold or offered for sale in connection with the Applicant's mark that is the subject of this proceeding.

RESPONSE: Subject to and without waiving the General Objections, Opposer answers that it knows of none, which is to be expected given that apparently Applicant has not

used the designation PRIMERA in U.S. commerce.

INTERROGATORY NO. 2: Describe the facts and circumstances concerning your selection of each of Opposer's Marks.

RESPONSE: Subject to and without waiving the General Objections, Opposer answers that there was a poster showing a fresco with a depiction of the Roman goddess Primavera hanging in the house of the founders. When the idea of the company came up, the founders independently from each other came up with this image and this name for the company's branding. For Opposer's founders, Primavera, the Roman goddess of spring, was the ideal symbol for nature, power of spring (start of life cycle of the new year), abundance, senses/sensuality, and health. The goddess takes blossoms from her never empty horn of plenty and adorns and breathes life into the bushes and plants in general. She gives life and beauty; she is part of nature itself. She is almost floating, light, ethereal like essential oils. She does not show her face, we cannot hold her – volatile like essential oils. At the same time, she is joyful, amiable, elegant, noble, and rich. Opposer's logo image, based on a 2000-year-old fresco from Pompeii that inspired the founders, shows the goddess Primavera surrounded by fresh green and with a golden oval.

INTERROGATORY NO. 3: Describe all translated meanings of Opposer's Marks.

RESPONSE: Subject to and without waiving the General Objections, Opposer answers that "Primavera" is the name of the Roman goddess of Spring. Opposer believes also that it is the Italian and Spanish word for "Spring".

INTERROGATORY NO. 4: Identify all goods and services under which Opposer has made any Use in Commerce of any of Opposer's Marks.

RESPONSE: Subject to and without waiving the General Objections, Opposer answers,

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“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, fragrance oil burners; oil diffusers, incense burners; and wholesale store and retail store services featuring cosmetics, perfumery, hair lotions, soaps and essential oils, oil burners, incense burners and stone diffusers”.

INTERROGATORY NO. 5: For each good or service that you have made any Use in Commerce of Opposer’s Marks, state the earliest date of such Use in Commerce.

RESPONSE: Subject to and without waiving the General Objections, and particularly Opposer’s objection that the requested dates are far prior to any date upon which Applicant can rely for priority purposes, Opposer answers that Opposer first sold its perfumery, cosmetics, essential oils for personal use; essential oils for oil burners, essential oils for perfumed candles, essential oils for saunas, essential oils in airsprays, fragrance oil comprised of essential oils, fragrance oil burners, oil diffusers, and incense burners under the PRIMAVERA mark in U.S. commerce at least as early as fifteen years prior to the execution date of these responses. Opposer first promoted and rendered wholesale store and retail store services featuring cosmetics, perfumery, hair lotions, soaps and essential oils, oil burners, incense burners, and stone diffusers under the PRIMAVERA mark in U.S. commerce at least as early as November 2005.

INTERROGATORY NO. 6: For each good or service that you have made any Use in Commerce of Opposer’s Marks, state the latest date of such Use in Commerce.

RESPONSE: Subject to and without waiving the General Objections, Opposer answers “Perfumery, cosmetics, essential oils for personal use; essential oils for saunas, essential oils in airsprays, fragrance oil comprised of essential oils, oil diffusers; essential oils for oil burners; essential oils for perfumed candles” all are presently being Used in

Commerce. Opposer is no longer using Opposer's Marks in relation to the remaining goods and services are as follows: "perfume oils for the manufacture of cosmetic preparations; fragrance oil burners; incense burners; wholesale store and retail store services featuring cosmetics, perfumery, hair lotions, soaps and essential oils, oil burners, incense burners and stone diffusers."

INTERROGATORY NO. 7: For each good or service that you have made any Use in Commerce of Opposer's Marks, state all date ranges for which there was no Use in Commerce.

RESPONSE: Subject to and without waiving the General Objections, Opposer answers that Opposer has continuously Used in Commerce Opposer's Marks in relation to the goods identified as being used presently in Opposer's response to Interrogatory 6 above. The dates of non-use of the remaining goods are as specified in Opposer's response to Interrogatory 6 above.

INTERROGATORY NO. 8: Identify all website(s) under ownership or control of Opposer displaying any of Opposer's Marks.

RESPONSE: Subject to and without waiving the General Objections, Opposer answers: primavera.de, primavera.mobi, primaveradam.com, primavera-das-fest.de, primavera-duftshop.de, primavera-feiert.de, primaverafriends.com, primaverafriends.de, primaveralife.asia, primavera-life.at, primavera-life.biz, primaveralife.com, primavera-life.com, primaveralife.de, primavera-life.de, primavera-life.eu, primaveralife.hk, primaveralife.org, primavera-life.org, primaveralife.tw, primaveralife-intl.com, primaveralive.de, primavera-proair.at, primavera-proair.ch, primaveraproair.com, primavera-proair.com, primaveraproair.de, primavera-proair.de, primaverashop.com, primavera-shop.com, primavera-shop.de, primavera-shop.eu

INTERROGATORY NO. 9: Describe all channels of trade in the United States through which Opposer has provided goods or services in connection with any of Opposer's Marks.

RESPONSE: Subject to and without waiving the General Objections, Opposer answers: Online shop www.primaveralife.com/shop/; U.S. distributor Nordblom American Institute of FootZonology, Inc. ("Nordblom"), 178 Mill Creek Road, Livingston, MT 59047; Goddess of Spring, LLC via www.goddessofspring.com/; various other downstream retail settings (the specifics of which are known by Nordblom and are outside Opposer's knowledge and control).

INTERROGATORY NO. 10: Describe all classes of customers (for example, age, gender, socioeconomic group) that comprise the intended market for goods or services provided in connection with each of Opposer's Marks.

RESPONSE: Subject to and without waiving the General Objections, Opposer answers that the products sold bearing Opposer's Marks are used by people in all market segments and demographic groups, and are for everyday use.

INTERROGATORY NO. 11: Identify the geographic regions in the United States in which Opposer has or has caused to be promoted any goods or services in connection with any of Opposer's Marks.

RESPONSE: Subject to and without waiving the General Objections, Opposer answers that Opposer has caused to be promoted goods or services under Opposer's Marks in the Northeast, Mid-Atlantic, Southeast, South, Southwest, Midwest, Plains states, Mountain states, West and Pacific Northwest.

INTERROGATORY NO. 12: Describe the nature and amount of all expenditures incurred by you in connection with the promotion of any goods or services under

Opposer's Marks.

RESPONSE: Subject to and without waiving the General Objections, Opposer answers that promotional campaigns are carried out by distributors, and the nature of the promotions and amount expended on promoting the products in question are outside Opposer's knowledge and control.

INTERROGATORY NO. 13: Identify all agreements concerning Opposer's Marks by date, parties to the agreement, and the subject matter of the agreement.

RESPONSE: Subject to and without waiving the General Objections, Opposer answers that there exists an agreement that relates to the Opposer's Marks with U.S. distributor Nordblom American Institute of FootZonology, Inc.

INTERROGATORY NO. 14: Identify all persons with whom Opposer has communicated regarding the protection or enforcement of trademark rights associated with Opposer's Marks.

RESPONSE: Subject to and without waiving the General Objections, Opposer answers: U.S. counsel Patrick Concannon.

INTERROGATORY NO. 15: Describe the connotation of Opposer's Marks.

RESPONSE: Subject to and without waiving the General Objections, O Opposer directs Applicant to Opposer's response to Interrogatory 2 above, which is responsive to this question.

INTERROGATORY NO. 16: Identify by mark and owner all third-party marks that Opposer believes to be confusingly similar with Opposer's Marks.

RESPONSE: Subject to and without waiving the General Objections, Opposer answers: The mark PRIMERA, as applied-for by Amorepacific Corporation.

INTERROGATORY NO. 17: Identify by mark and owner all third-party marks that

Opposer has asserted in any document to be confusingly similar with Opposer's Marks.

RESPONSE: Subject to and without waiving the General Objections, Opposer answers:
Against the mark PRIMERA as applied-for by Amorepacific Corporation.

INTERROGATORY NO. 18: Describe the connotation of the mark "Goddess of Spring."

RESPONSE: Subject to and without waiving the General Objections, Opposer answers that the Roman goddess of spring is the symbol for nature, power of spring (start of life cycle of the new year), abundance, senses/sensuality, and health. The goddess takes blossoms from her never empty horn of plenty and lavishes them of the bushes and plants in general. She gives life and beauty, is part of nature itself. She is almost floating, light, and ethereal - like essential oils. She does not show her face, we cannot hold her - volatile like essential oils. In the same time joyful, amiable, elegant, noble, and rich.

INTERROGATORY NO. 19: Describe the relationship between the mark "Goddess of Spring" and Opposer's Mark.

RESPONSE: Subject to and without waiving the General Objections, Opposer again refers to Applicant to Opposer's response to Interrogatory 2 above.

INTERROGATORY NO. 20: Describe the relationship between Opposer's Mark and the English word "Spring."

RESPONSE: Subject to and without waiving the General Objections, Opposer answers that apart from Opposer's belief that "primavera" is the Italian and Spanish word for "Spring", there is no relationship.

INTERROGATORY NO. 21: Describe how "PRIMAVERA celebrates the springtime" as Opposer claims in its advertising literature.

RESPONSE: Subject to and without waiving the General Objections, Opposer again

refers to Applicant to Opposer's response to Interrogatory 2 above.

INTERROGATORY NO. 22: Describe how Opposer's products and services are related to "the season of budding green, sprouting vitality and renewed possibilities" as Opposer quotes in its advertising literature.

RESPONSE: Subject to and without waiving the General Objections, Opposer again refers Applicant to Opposer's response to Interrogatory 2 above. Opposer's Marks to some degree are suggestive of these qualities.

INTERROGATORY NO. 23: Describe how Opposer's products and services are related to going "outside in the springtime, you enjoy the fact that everything smells so wonderfully," as Opposer quotes in its advertising literature.

RESPONSE: Subject to and without waiving the General Objections, Opposer answers that Opposer is not aware having used "*outside in the springtime, you enjoy the fact that everything smells so wonderfully*", but it objects to the question as irrelevant and ambiguous and believes that there is nothing to explain.

INTERROGATORY NO. 24: Describe how Opposer's products and services are related to the "smells [of springtime] stimulate the body and mind," as Opposer quotes in its advertising literature.

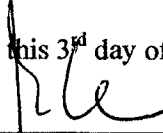
RESPONSE: Primavera is not aware having used "*smells [of springtime] stimulate the body and mind*". Again, Opposer objects to the question as irrelevant and ambiguous and believes that there is nothing to explain.

[verification on next page]

VERIFICATION

I, Titus Kaufmann, am Chief Executive Officer of Primavera Life GmbH. I have read the foregoing interrogatories and the answers to those interrogatories, which are true according to the best of my knowledge, information, and belief. I declare under penalty of perjury that the foregoing is true and correct.

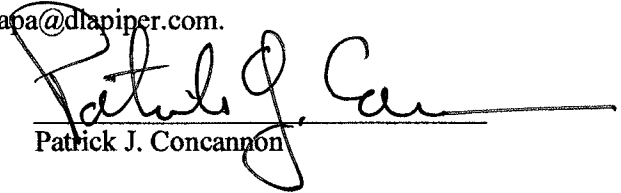
Dated this 3rd day of January, 2018.



Signature

CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing OPPOSER'S RESPONSES TO APPLICANT'S INTERROGATORIES TO OPPOSER (FIRST SET) have been transmitted on January 3, 2018 to Applicant's counsel for record at dctrademarks@dlapiper.com, ann.ford@dlapiper.com, john.nading@dlapiper.com, eunice.chung@dlapiper.com, alberto.zacapa@dlapiper.com.



Patrick J. Concannon

Exhibit B

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

PRIMAVERA LIFE GMBH)	
)	
Opposer,)	
)	
v.)	Opposition No. 91231958
)	
AMOREPACIFIC CORPORATION)	Application No. 86/873750
)	
Applicant.)	
)	

**OPPOSER’S RESPONSES TO APPLICANT’S
REQUESTS FOR PRODUCTION OF DOCUMENTS AND THINGS TO OPPOSER
(FIRST SET)**

Pursuant to Trademark Rule of Practice 2.120, Trademark Trial and Appeal Board Manual of Procedure § 406, and Federal Rules of Civil Procedure 26 and 34, Primavera Life GmbH (“Opposer”) responds to Amorepacific Corporation’s (“Applicant”) Applicant’s Requests for Production of Documents and Things to Opposer (First Set) as follows.

GENERAL OBJECTIONS

A. Opposer responds to each of Applicant’s Requests for Production of Documents and Things to Opposer (First Set) subject to the general objections set forth herein. These limitations and objections form a part of the response to each Request. These limitations and objections may be specifically referred to in a response to certain Requests for the purpose of clarity. However, the failure to incorporate specifically a general objection is not a waiver of such objection.

B. Opposer objects to the definition of “Opposer,” “you,” and “your” in Paragraph 1 on page 1 of Applicant’s Requests for Production of Documents and Things to Opposer

(First Set), as the terms are overly broad and unduly burdensome. For its responses and objections, Amorepacific takes the terms “Applicant,” “you,” and “your” to mean Primavera Life GmbH, the opposer in the above-captioned proceeding.

C. Opposer objects to the terms “all,” “any,” “each,” “describe,” “identify,” “relating,” and “state” as the terms are vague and ambiguous, overly broad and unduly burdensome, and incorporate multiple subparts into the Requests.

D. Opposer objects to the definition of “things” in Paragraph 4 on page 3 of Applicant’s Requests for Production of Documents and Things to Opposer (First Set) as the term is vague and ambiguous and overly broad and unduly burdensome.

E. Opposer objects to Applicant’s Requests for Production of Documents and Things to Opposer (First Set) to the extent that they purport to impose obligations or actions beyond those required by the Rules of Practice in Trademark Cases (i.e., 37 C.F.R. Part 2), the Trademark Trial and Appeal Board Manual of Procedure (“TBMP”), and the Federal Rules of Civil Procedure. Opposer responds to the Requests only to the extent required thereby and subject to the above-stated objection.

F. Opposer objects to Applicant’s Requests for Production of Documents and Things to Opposer (First Set) to the extent that they seek production or disclosure of privileged information. Opposer will not produce or disclose documents or information considered to be the subject of attorney-client privilege, the work product doctrine, or any other applicable claim, law, or rule of privilege or immunity (“privileged information”) in response to the Requests, and Opposer responses exclude all privileged information.

G. Opposer objects to Applicant’s Requests for Production of Documents and Things to Opposer (First Set) to the extent that they seek the production or disclosure of

confidential information and documents, including trade secret information (“confidential information”).

H. Opposer objects to Applicant’s Requests for Production of Documents and Things to Opposer (First Set) to the extent that they request the production or disclosure of information that is neither relevant to the subject matter involved in the pending proceeding nor reasonably calculated to lead to the discovery of admissible evidence.

I. Opposer objects to Applicant’s Requests for Production of Documents and Things to Opposer (First Set) to the extent that they seek information or documents from an indefinite period of time.

J. Opposer objects to Applicant’s Requests for Production of Documents and Things to Opposer (First Set) to the extent that they are vague and ambiguous and overly broad and unduly burdensome.

K. Opposer objects to Applicant’s Requests for Production of Documents and Things to Opposer (First Set) to the extent that they contain two or more subparts and should therefore be considered two or more separate Requests as stated under the Rules of Practice in Trademark Cases, the TBMP, and the Federal Rules of Civil Procedure.

L. In making these objections, Opposer does not waive or intend to waive (a) any objection as to competency, relevancy, materiality, or admissibility of any information that may be produced or disclosed in response to Applicant’s Requests for Production of Documents and Things to Opposer (First Set); (b) any right to object on any ground to the use of any information that may be produced or disclosed in response to the Requests, or the subject matter thereof, at any subsequent proceeding, including the hearing for this or any other action; and (c) all rights to object on any ground to any Request or any other discovery request.

M. Opposer's failure to object on a particular ground or grounds shall not be construed as a waiver of its rights to object on any additional ground.

N. Opposer reserves the right to amend or supplement its responses as additional information is learned during further investigation and discovery.

Subject to and without waiving the foregoing objections, Opposer responds to the Requests as follows:

REQUEST NO. 1.

All Documents concerning Opposer's selection of the Opposer's Marks.

RESPONSE NO. 1.

Opposer objects to this request as overly broad and unduly burdensome. Opposer also objects to Request No. 1 to the extent that it calls for the production of materials protected from discovery by the attorney-client privilege, work product doctrine, and/or any other applicable privilege or immunity. Subject to and without waiving these objections, Opposer will produce representative non-privileged documents responsive to Request No. 1.

REQUEST NO. 2.

All Documents referring to any inquiries conducted by or for Opposer concerning Opposer's Marks.

RESPONSE NO. 2.

Opposer objects to this request as unclear, ambiguous, excessively broad and excessively burdensome. Opposer also objects to Request No. 2 to the extent that it calls for the production of materials protected from discovery by the attorney-client privilege, work product doctrine, and/or any other applicable privilege or immunity.

REQUEST NO. 3.

All Documents referring to Opposer's Use in Commerce of Opposer's Marks.

RESPONSE NO. 3.

Opposer objects to this request as overly broad, unduly burdensome and seeking irrelevant information/documents to the extent that it requests documents referring to Opposer's Use of Opposer's Marks long prior to any date upon which Applicant might rely for priority purposes. Opposer also objects to Request No. 3 to the extent that it calls for the production of materials protected from discovery by the attorney-client privilege, work product doctrine, and/or any other applicable privilege or immunity. Subject to and without waiving these objections, Opposer will produce representative non-privileged documents responsive to Request No. 3.

REQUEST NO. 4.

All Documents evidencing or referring to any marketing surveys conducted by or for Opposer concerning Opposer's Marks.

RESPONSE NO. 4.

Opposer also objects to Request No. 4 to the extent that it calls for the production of materials protected from discovery by the attorney-client privilege, work product doctrine, and/or any other applicable privilege or immunity. Subject to and without waiving these objections, Opposer notes that it does not have any documents within its control that are responsive to Request No. 4.

REQUEST NO. 5.

Documents sufficient to identify all goods and services provided by Opposer in connection with any of Opposer's Marks.

RESPONSE NO. 5.

Opposer objects to this request as overly broad and unduly burdensome. Opposer also objects to Request No. 5 to the extent that it calls for the production of materials protected from discovery by the attorney-client privilege, work product doctrine, and/or any other applicable privilege or immunity. Subject to and without waiving these objections, Opposer will produce representative non-privileged documents responsive to Request No. 5.

REQUEST NO. 6.

All Documents referring to the importation into the United States by any person of Opposer's products bearing Opposer's Mark alone or in combination with other words or designs.

RESPONSE NO. 6.

Opposer objects to this request as overly broad, unduly burdensome and seeking irrelevant information/documents to the extent that it requests documents referring to Opposer's importation of products bearing Opposer's Marks long prior to any date upon which Applicant might rely for priority purposes. Opposer also objects to Request No. 6 to the extent that it calls for the production of materials protected from discovery by the attorney-client privilege, work product doctrine, and/or any other applicable privilege or immunity. Subject to and without waiving these objections, Opposer will produce representative non-privileged documents responsive to Request No. 6.

REQUEST NO. 7.

Documents sufficient to identify Opposer's annual sales of Opposer's goods and services, separated by each good and service provided, in connection with Opposer's Marks from the date of first sale to the present.

RESPONSE NO. 7.

Opposer objects to this request as overly broad, unduly burdensome and seeking irrelevant information/documents to the extent that it requests documents that identify to Opposer's sales of goods and services in connection with Opposer's Marks long prior to any date upon which Applicant might rely for priority purposes. Opposer also objects to Request No. 7 to the extent that it calls for the production of materials protected from discovery by the attorney-client privilege, work product doctrine, and/or any other applicable privilege or immunity. Subject to and without waiving these objections, Opposer will produce representative non-privileged documents responsive to Request No. 7.

REQUEST NO. 8.

Documents sufficient to identify the retail prices of Opposer's goods and services in connection with Opposer's Marks from the date of first sale to the present.

RESPONSE NO. 8.

Opposer objects to this request as overly broad and unduly burdensome. Opposer also objects to Request No. 8 to the extent that it calls for the production of materials protected from discovery by the attorney-client privilege, work product doctrine, and/or any other applicable privilege or immunity. Subject to and without waiving these objections, Opposer will produce representative non-privileged documents responsive to Request No. 8.

REQUEST NO. 9.

All Documents referring to any agreements of any kind between Opposer and any third party concerning the use of any of Opposer's Marks.

RESPONSE NO. 9.

Opposer objects to this request as unclear, overly broad and unduly burdensome. Opposer also objects to Request No. 9 to the extent that it calls for the production of materials protected from discovery by the attorney-client privilege, work product doctrine, and/or any other applicable privilege or immunity. Subject to and without waiving these objections, Opposer will produce representative non-privileged documents responsive to Request No. 9.

REQUEST NO. 10.

All Documents referring to allegations of intellectual property infringement against Opposer with respect to any of Opposer's Marks.

RESPONSE NO. 10.

Opposer objects to this request as overly broad and unduly burdensome. Opposer also objects to Request No. 10 to the extent that it calls for the production of materials protected from discovery by the attorney-client privilege, work product doctrine, and/or any other applicable privilege or immunity. Subject to and without waiving these objections, Opposer notes that it does not have any documents within its control that are responsive to Request No. 10.

REQUEST NO. 11.

Documents sufficient to show the Opposer's first Use in Commerce for each of Opposer's Marks in connection with all goods and services provided under such marks.

RESPONSE NO. 11.

Opposer objects to this request as overly broad, unduly burdensome and seeking irrelevant information/documents to the extent that it requests documents that relate to Opposer's use of Opposer's Marks long prior to any date upon which Applicant might rely

for priority purposes. Opposer also objects to Request No. 11 to the extent that it calls for the production of materials protected from discovery by the attorney-client privilege, work product doctrine, and/or any other applicable privilege or immunity.

REQUEST NO. 12.

Documents sufficient to show an example of each design in which Opposer's Marks have been used, including current use.

RESPONSE NO. 12.

Opposer objects to this request as unclear, overly broad and unduly burdensome. Opposer also objects to Request No. 12 to the extent that it calls for the production of materials protected from discovery by the attorney-client privilege, work product doctrine, and/or any other applicable privilege or immunity. Subject to and without waiving these objections, Opposer will produce representative non-privileged documents responsive to Request No. 12.

REQUEST NO. 13.

All Documents concerning Opposer's awareness of Applicant's mark that is the subject of this proceeding.

RESPONSE NO. 13.

Opposer objects to this request as unclear, overly broad and unduly burdensome. Opposer also objects to Request No. 13 to the extent that it calls for the production of materials protected from discovery by the attorney-client privilege, work product doctrine, and/or any other applicable privilege or immunity. Subject to and without waiving these objections, Opposer responds that no documents responsive to Request No. 13 exist that are not responsive to other document requests.

REQUEST NO. 14.

All Documents supporting Opposer's contention in Paragraph 14 of the Notice that Applicant's PRIMERA mark in the Application is likely to cause confusion, mistake, or deception.

RESPONSE NO. 14.

Opposer objects to this request as overly broad and unduly burdensome. Opposer also objects to Request No. 14 to the extent that it calls for the production of materials protected from discovery by the attorney-client privilege, work product doctrine, and/or any other applicable privilege or immunity. Subject to and without waiving these objections, Opposer will produce representative non-privileged documents responsive to Request No. 14.

REQUEST NO. 15.

All Documents supporting Opposer's contention in Paragraph 5 that Opposer has nationwide common law trademark rights.

RESPONSE NO. 15.

Opposer objects to this request as unclear, overly broad and unduly burdensome. Opposer also objects to Request No. 15 to the extent that it calls for the production of materials protected from discovery by the attorney-client privilege, work product doctrine, and/or any other applicable privilege or immunity. Subject to and without waiving these objections, Opposer will produce representative non-privileged documents responsive to Request No. 15.

REQUEST NO. 16.

All Documents supporting Opposer's contention in Paragraph 6 that Opposer has expended time and effort in advertising its goods and services under PRIMAVERA.

RESPONSE NO. 16.

Opposer objects to this request as unclear, overly broad and unduly burdensome. Opposer also objects to Request No. 16 to the extent that it calls for the production of materials protected from discovery by the attorney-client privilege, work product doctrine, and/or any other applicable privilege or immunity. Subject to and without waiving these objections, Opposer responds that it does not have responsive documents within its control.

REQUEST NO. 17.

All Documents supporting Opposer's contention in Paragraph 11 that the mark PRIMERA is "highly similar" to Opposer's PRIMAVERA mark.

RESPONSE NO. 17.

Opposer objects to this request as overly broad and unduly burdensome. Opposer also objects to Request No. 14 to the extent that it calls for the production of materials protected from discovery by the attorney-client privilege, work product doctrine, and/or any other applicable privilege or immunity. Subject to and without waiving these objections, Opposer will produce representative non-privileged documents responsive to Request No. 17.

REQUEST NO. 18.

All Documents supporting Opposer's contention in Paragraph 12 that the parties' relevant goods and services "target the same audiences."

RESPONSE NO. 18.

Opposer objects to this request as unclear, overly broad and unduly burdensome. Opposer also objects to Request No. 18 to the extent that it calls for the production of materials protected from discovery by the attorney-client privilege, work product doctrine, and/or any other applicable privilege or immunity. Subject to and without waiving these

objections, Opposer will produce representative non-privileged documents responsive to Request No. 18.

REQUEST NO. 19.

All Documents referring to allegations of intellectual property infringement by Opposer against any third party with respect to any of Opposer's Marks.

RESPONSE NO. 19.

Opposer objects to this request as unclear, overly broad and unduly burdensome. Opposer also objects to Request No. 19 to the extent that it calls for the production of materials protected from discovery by the attorney-client privilege, work product doctrine, and/or any other applicable privilege or immunity. Subject to and without waiving these objections, Opposer notes that it does not have any documents within its control that are responsive to Request No. 19.

REQUEST NO. 20.

All Documents identified in Opposer's initial disclosures in this consolidated proceeding.

RESPONSE NO. 20.

Opposer objects to this request as overly broad and unduly burdensome. Opposer also objects to Request No. 20 to the extent that it calls for the production of materials protected from discovery by the attorney-client privilege, work product doctrine, and/or any other applicable privilege or immunity. Subject to and without waiving these objections, Opposer will produce representative non-privileged documents responsive to Request No. 20.

REQUEST NO. 21.

All Documents identified in Opposer's responses to Applicant's Interrogatories to Opposer (First Set).

RESPONSE NO. 21.

Opposer objects to this request as overly broad and unduly burdensome. Opposer also objects to Request No. 21 to the extent that it calls for the production of materials protected from discovery by the attorney-client privilege, work product doctrine, and/or any other applicable privilege or immunity. Subject to and without waiving these objections, Opposer will produce representative non-privileged documents responsive to Request No. 21.

REQUEST NO. 22.

Documents sufficient to show all third-party marks of which Opposer is aware that are similar to any of Opposer's Marks.

RESPONSE NO. 22.

Opposer objects to this request as unclear, overly broad and unduly burdensome. Opposer also objects to Request No. 21 to the extent that it calls for the production of materials protected from discovery by the attorney-client privilege, work product doctrine, and/or any other applicable privilege or immunity. Subject to and without waiving these objections, Opposer responds that it does not have responsive documents within its control.

REQUEST NO. 23.

Documents sufficient to show all third-party marks of which Opposer is aware that are similar to Applicant's PRIMERA mark that is the subject of this proceeding.

RESPONSE NO. 23.

Opposer objects to this request as unclear, overly broad and unduly burdensome. Opposer also objects to Request No. 22 to the extent that it calls for the production of materials protected from discovery by the attorney-client privilege, work product doctrine, and/or any other applicable privilege or immunity. Subject to and without waiving these objections, Opposer responds that it does not have responsive documents within its control.

REQUEST NO. 24.

All Documents that Opposer intends to introduce at trial in this consolidated proceeding.

RESPONSE NO. 24.

Opposer objects to this request as unclear, overly broad and unduly burdensome. Opposer also objects to Request No. 24 to the extent that it calls for the production of materials protected from discovery by the attorney-client privilege, work product doctrine, and/or any other applicable privilege or immunity. Subject to and without waiving these objections, Opposer responds that there are no documents responsive to this request that are not responsive to other document requests.

PRIMAVERA LIFE GMBH

By its attorneys,



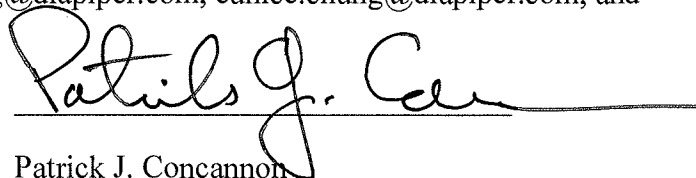
Patrick J. Concannon
pconcannon@nutter.com
Nutter McClennen & Fish LLP
155 Seaport Boulevard
Boston, MA 02210
(617) 439-2177

Dated: January 3, 2018

[certificate of service on next page]

CERTIFICATE OF SERVICE

I hereby certify that on this 3rd day of January, 2018, a copy of the foregoing OPPOSER'S RESPONSES TO APPLICANT'S REQUESTS FOR PRODUCTION OF DOCUMENTS AND THINGS TO OPPOSER (FIRST SET) have been transmitted via email to Applicant's counsel for record at dctrademarks@dlapiper.com, ann.ford@dlapiper.com, john.nading@dlapiper.com, eunice.chung@dlapiper.com, and alberto.zacapa@dlapiper.com.



Patrick J. Concannon

3769106.1

Exhibit C

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

<hr/>		
PRIMAVERA LIFE GMBH,)	
)	
Opposer,)	
v.)	Opposition No.: 91231958
)	Applications Serial No. 86/873750
AMOREPACIFIC CORPORATION,)	
)	
Applicant.)	
<hr/>)	

**OPPOSER'S RESPONSES TO APPLICANT'S
REQUESTS FOR ADMISSIONS TO OPPOSER (FIRST SET)**

Pursuant to Trademark Rule of Practice 2.120, Trademark Trial and Appeal Board Manual of Procedure § 407, and Federal Rules of Civil Procedure 26 and 36, Opposer Primavera Life GmbH responds to Applicant Amorepacific Corporation's First Set of Requests for Admissions as follows, for purposes of this action only and subject to all pertinent objections to admissibility that may be interposed at trial.

OBJECTIONS TO DEFINITIONS AND INSTRUCTIONS

Opposer objects to Applicant's "Instructions" and "Definitions" to the extent that they seek to impose obligations on Opposer beyond those contained in the applicable rules of procedure. Opposer responds in accordance with Trademark Rule of Practice 2.120, Trademark Trial and Appeal Board Manual of Procedure § 407, and Federal Rules of Civil Procedure 26 and 36.

RESPONSES TO REQUESTS FOR ADMISSION

REQUEST NO. 1.

Admit that documents produced by Opposer in this proceeding are genuine business records of Opposer kept in the ordinary course of business.

RESPONSE NO. 1.

Opposer cannot truthfully admit or deny the statement in question because it has yet to produce any documents in this proceeding. Opposer anticipates that some documents that it will produce in this proceeding will be genuine business records of Opposer kept in the ordinary course of business and others will not be. Opposer objects to the vagueness of this requested admission.

REQUEST NO. 2.

Admit that documents produced by Opposer in this proceeding are authentic under Rule 901 of the Federal Rules of Evidence.

RESPONSE NO. 2.

Opposer cannot truthfully admit or deny the statement in question because it has yet to produce any documents in this proceeding. Opposer objects to the vagueness of this requested admission.

REQUEST NO. 3.

Admit there is no likelihood of confusion between Opposer's Marks and Applicant's PRIMERA mark that is the subject of this proceeding.

RESPONSE NO. 3.

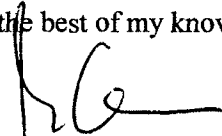
Denied.

[verification on next page]

VERIFICATION

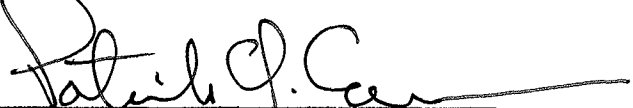
I, Titus Kaufmann, Chief Executive Officer of Primavera Life GmbH, hereby state under penalties of perjury that the above answers are true to the best of my knowledge and belief.

Dated: January 2nd, 2018



Titus Kaufmann

As to objections,



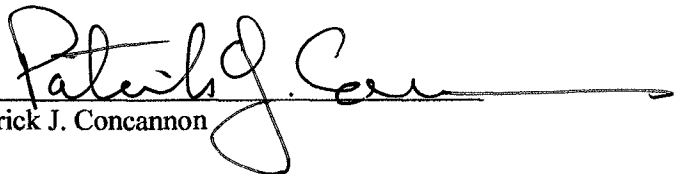
Patrick J. Concannon
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Seaport West
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(617) 439-2177
(617) 439-9177 (fax)
E-mail: pconcannon@nutter.com

Counsel for Primavera Life GmbH

Dated: January 3, 2018

CERTIFICATE OF SERVICE

I hereby certify that pursuant to CFR 2.101(b), on January 3, 2018, a true and correct copy of the foregoing OPPOSER'S RESPONSES TO APPLICANT'S REQUESTS FOR ADMISSIONS TO OPPOSER (FIRST SET) was served on Applicant Amorepacific Corporation's counsel of record via email at dctrademarks@dlapiper.com, ann.ford@dlapiper.com, john.nading@dlapiper.com, eunice.chung@dlapiper.com, alberto.zacapa@dlapiper.com.



Patrick J. Concannon

3768449.1

Exhibit D

United States of America
United States Patent and Trademark Office

PRIMERA

Reg. No. 4,787,755

AMOREPACIFIC CORPORATION (REPUBLIC OF KOREA CORPORATION)
181, 2GA, HANGANG-RO, YONGSAN-GU
SEOUL, REPUBLIC OF KOREA 140-777

Registered Aug. 11, 2015

Int. Cl.: 3

FOR: DENTIFRICES, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).

TRADEMARK

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

PRINCIPAL REGISTER

OWNER OF REPUBLIC OF KOREA REG. NO. 0475161, DATED 8-16-2000, EXPIRES 8-16-2020.

THE ENGLISH TRANSLATION OF "PRIMERA" IN THE MARK IS "FIRST".

SER. NO. 77-830,858, FILED 9-21-2009.

TEJBIR SINGH, EXAMINING ATTORNEY



Michelle K. Lee

Director of the United States
Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

Requirements in the First Ten Years*

What and When to File:

First Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. See 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

Second Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.* See 15 U.S.C. §1059.

Requirements in Successive Ten-Year Periods*

What and When to File:

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.*

Grace Period Filings*

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

***ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the United States Patent and Trademark Office (USPTO). The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. See 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. See 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.

NOTE: A courtesy e-mail reminder of USPTO maintenance filing deadlines will be sent to trademark owners/holders who authorize e-mail communication and maintain a current e-mail address with the USPTO. To ensure that e-mail is authorized and your address is current, please use the Trademark Electronic Application System (TEAS) Correspondence Address and Change of Owner Address Forms available at <http://www.uspto.gov>.

United States of America
United States Patent and Trademark Office

primera

Reg. No. 4,274,041

AMOREPACIFIC CORPORATION (REPUBLIC OF KOREA CORPORATION)
181, 2-KA, HANGANG-RO, YONGSAN-KU
SEOUL, REPUBLIC OF KOREA

Registered Jan. 15, 2013

Int. Cl.: 3

FOR: SKIN LOTIONS; CREAMY FOUNDATION; EYE CREAMS; COSMETIC NOURISHING CREAMS; COSMETIC SKIN FRESHENERS; MAKE-UP POWDER; COSMETICS; COSMETIC CREAMS FOR SKIN CARE; HAIR SHAMPOO; DENTIFRICES, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).

TRADEMARK

PRINCIPAL REGISTER

OWNER OF REPUBLIC OF KOREA REG. NO. 0874543, DATED 7-29-2011, EXPIRES 7-29-2021.

THE MARK CONSISTS OF THE WORD "PRIMERA" IN A STYLIZED FONT.

THE ENGLISH TRANSLATION OF "PRIMERA" IN THE MARK IS "FIRST".

SER. NO. 85-216,621, FILED 1-13-2011.

SAMUEL E. SHARPER JR., EXAMINING ATTORNEY



David J. Kyros

Director of the United States Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

Requirements in the First Ten Years*

What and When to File:

First Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. See 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

Second Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.*
See 15 U.S.C. §1059.

Requirements in Successive Ten-Year Periods*

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Grace Period Filings*

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**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or
reminder of these filing requirements.**

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United States of America
United States Patent and Trademark Office

primera

Reg. No. 4,559,010

Registered July 1, 2014

Int. Cl.: 35

SERVICE MARK

PRINCIPAL REGISTER

AMOREPACIFIC CORPORATION (REPUBLIC OF KOREA CORPORATION)
181, 2-GA, HANGANG-RO, YONGSAN-GU
SEOUL, REPUBLIC OF KOREA

FOR: PROMOTING THE GOODS OF OTHERS AND RENDERING SALES PROMOTION
ADVICE IN THE FIELD OF COSMETICS; SALES PROMOTION SERVICES FOR OTHERS
IN THE FIELD OF COSMETICS; WHOLESALE STORE SERVICES IN THE FIELD OF COS-
METICS; RETAIL STORE SERVICES IN THE FIELD OF COSMETICS; WHOLESALE STORE
SERVICES IN THE FIELD OF COSMETIC UTENSILS; RETAIL STORE SERVICES IN THE
FIELD OF COSMETIC UTENSILS; WHOLESALE STORE SERVICES IN THE FIELD OF
HEALTH FUNCTIONAL FOOD WITH A RED GINSENG BASE; RETAIL STORE SERVICES
IN THE FIELD OF HEALTH FUNCTIONAL FOOD WITH A RED GINSENG BASE;
WHOLESALE STORE SERVICES IN THE FIELD OF HEALTH FUNCTIONAL FOOD WITH
A GREEN TEA BASE; RETAIL STORE SERVICES IN THE FIELD OF HEALTH FUNCTIONAL
FOOD WITH A GREEN TEA BASE, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

OWNER OF REPUBLIC OF KOREA REG. NO. 248445, DATED 1-4-2013, EXPIRES 1-4-2023.

OWNER OF U.S. REG. NO. 4,274,041.

THE MARK CONSISTS OF THE WORD "PRIMERA" IN A STYLIZED FONT.

THE ENGLISH TRANSLATION OF "PRIMERA" IN THE MARK IS "FIRST".

SER. NO. 86-060,318, FILED 9-10-2013.

REGINA DRUMMOND, EXAMINING ATTORNEY



Michelle K. Lee

Deputy Director of the United States
Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL
TRADEMARK REGISTRATION**

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reminder of these filing requirements.**

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[TSDR](#) [ASSIGN Status](#) [TTAB Status](#) *(Use the "Back" button of the Internet Browser to return to TESS)*

PRIMERA

Word Mark	PRIMERA
Translations	The English translation of "PRIMERA" in the mark is "FIRST".
Goods and Services	IC 003. US 001 004 006 050 051 052. G & S: Beauty masks; Cosmetics; Liquid bath soaps; Shampoos
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	86873750
Filing Date	January 13, 2016
Current Basis	44E
Original Filing Basis	44E
Published for Opposition	July 5, 2016
Owner	(APPLICANT) Amorepacific Corporation CORPORATION REPUBLIC OF KOREA Cheonggyecheon-ro 100 Jung-gu Seoul REPUBLIC OF KOREA
Attorney of Record	Sofia Jeong,
Prior Registrations	4274041;4559010;4787755
Type of Mark	TRADEMARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

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STATUS **DOCUMENTS**

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Mark: PRIMERA

PRIMERA

US Serial Number: 86873750

Application Filing Date: Jan. 13, 2016

Filed as TEAS Plus: Yes

Currently TEAS Plus: Yes

Register: Principal

Mark Type: Trademark

TM5 Common Status

Descriptor:



LIVE/APPLICATION/Opposition Pending

The pending trademark application has been examined by the published for opposition, at which time one or more opposites they have not yet been decided.

Status: An opposition after publication is pending at the Trademark Trial and Appeal Board. For further information, Trademark Trial and Appeal Board web page.

Status Date: Dec. 27, 2016

Publication Date: Jul. 05, 2016

Mark Information

Mark Literal Elements: PRIMERA

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Translation: The English translation of "PRIMERA" in the mark is "FIRST".

Related Properties Information

Claimed Ownership of US Registrations: [4274041](#), [4559010](#), [4787755](#)

Foreign Information

Foreign Registration Number: 1100059

Foreign Registration Date: Apr. 14, 2015

Foreign Application/Registration Country: KOREA, REPUBLIC OF

Foreign Expiration Date: Apr. 14, 2025

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *.* identify additional (new) wording in the goods/services.

For: Beauty masks; Cosmetics; Liquid bath soaps; Shampoos

International Class(es): 003 - Primary Class

U.S Class(es): 001, 004, 006, 050, 051

Class Status: ACTIVE

Basis: 44(e)

Basis Information (Case Level)

Filed Use: No	Currently Use: No	Amer
Filed ITU: No	Currently ITU: No	Ame
Filed 44D: No	Currently 44D: No	Amer
Filed 44E: Yes	Currently 44E: Yes	Amer
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: Amorepacific Corporation

Owner Address: Cheonggyecheon-ro 100 Jung-gu
Seoul KOREA, REPUBLIC OF

Legal Entity Type: CORPORATION

State or Country Where Organized: KOREA, REPUBLIC OF

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Sofia Jeong,

Docket Number: 231076.18

Attorney Primary Email Address: trademarks@troutmansanders.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: ANN K FORD

DLA PIPER LLP (US)
500 8TH STREET NW
WASHINGTON, DISTRICT OF COLUMBIA UNITED STATES 20004

Phone: (415) 477-5730

Fax: (415) 477-5710

Correspondent e-mail: trademarks@troutmansanders.com
sofia.jeong@troutmansanders.com
grace.hong@troutmansanders.com

Correspondent e-mail Authorized: Yes

Domestic Representative

Domestic Representative Name: Sofia Jeong,

Phone: (415) 477-5730

Fax: (415) 477-5710

Domestic Representative e-mail: trademarks@troutmansanders.com

Domestic Representative e-mail Authorized: Yes

Prosecution History

Date	Description	Proceeding Number
Feb. 24, 2017	ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED	
Feb. 24, 2017	TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED	
Dec. 27, 2016	OPPOSITION INSTITUTED NO. 999999	231958
Jul. 25, 2016	EXTENSION OF TIME TO OPPOSE RECEIVED	
Jul. 05, 2016	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Jul. 05, 2016	PUBLISHED FOR OPPOSITION	
Jun. 15, 2016	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Jun. 01, 2016	LAW OFFICE PUBLICATION REVIEW COMPLETED	68123
May 25, 2016	APPROVED FOR PUB - PRINCIPAL REGISTER	
May 24, 2016	TEAS/EMAIL CORRESPONDENCE ENTERED	68123
May 24, 2016	CORRESPONDENCE RECEIVED IN LAW OFFICE	68123
May 19, 2016	ASSIGNED TO LIE	68123
May 05, 2016	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
May 02, 2016	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
May 02, 2016	NON-FINAL ACTION E-MAILED	6325
May 02, 2016	NON-FINAL ACTION WRITTEN	92834
Apr. 28, 2016	ASSIGNED TO EXAMINER	92834
Jan. 19, 2016	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jan. 16, 2016	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information**TM Staff Information**

TM Attorney: ROSEN, AMANDA ROBYN

Law Office Assigned: LAW OFFICE 121

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Jun. 01, 2016

Assignment Abstract Of Title Information - Click to Load**Proceedings - Click to Load**

Exhibit E



Primavera®



www.GoddessOfSpring.com

**100% pure and unaltered Essential Oils and Natural Products
The World's Finest Therapeutic Grade**

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PRIMAVERA means "spring" in Italian and PRIMAVERA, the goddess of spring, is a symbol of the fullness of life and the perfection of nature. PRIMAVERA was founded in Bavaria, Germany in 1986, and has stood for high-quality products and confidence for 18 years. Our product range contain Essential Oils, Natural Cosmetics, Incense, Diffusers and Air Sprays. Currently, our products are distributed in 25 countries.

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Things which give us pleasure enrich our lives with a special quality. Pure, natural Essential Oils have a balancing effect on the human psyche while stimulating the defensive powers of the body. PRIMAVERA has over 300 Essential Oils available.



[Essential Oil Blends and Floral Waters](#)

Fragrances and aromas have a general influence on our enjoyment of life. Just a few drops of a blend can clean the air and harmonize the atmosphere of a room.



[Pure Plant-Based Oils](#)



[Fennel Shui Blends and Airsprays](#)

Pure Plant-Based Oils

The secret of beauty and of radiating a positive air is to take care of yourself and indulge yourself quite consciously. Pure, natural, cold-pressed Base Oils and Infused Oils are ideal for enhancing your physical well-being, and they have been an integral part of care rituals since time immemorial.



Natural Body Care Products

Experience the fragrant possibilities of PRIMAVERA Natural Cosmetics for your beauty program. The ACTIVE, RELAX, HARMONY, EMOTIONS and BASIC lines cover all areas of life: if you need a refreshing pick-me-up, long for relaxation or simply want to spoil yourself.



Feng Shui Blends and Aisprays

The tradition of Feng Shui teaches that natural environment is comprised of 5 transformational elements. PRIMAVERA Feng Shui Blends are masterfully formulated to bring out these 5 elements' beneficial qualities of Energy, Harmony, Tai Chi, Happiness and Purification.



Spa Face Products

PRIMAVERA's new Natural Balance product line includes Exfoliating Cleansers, Balancing Toning Mists, Face Creams and Seed Oil capsules, containing purifying and softening botanicals to clarify, moisturize and balance the skin, and to boost cell regeneration naturally.





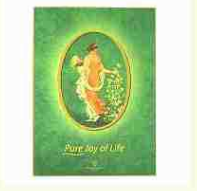
[AromaBalm](#)

PRIMAVERA AromaBalm protects and nourishes your skin. Made with 100% natural ingredients with no vaseline, synthetic preservatives or emulsifiers. AromaBalm contains a variety of precious, gentle, ingredients like Almond, Wheat Germ, Rose Hip, Evening Primrose and Bee Wax.



[Gift Sets & Ideas](#)

Looking for that perfect gift? PRIMAVERA offers a range of gift ideas that are both rare and unique. From delightfully packaged gift sets to elegant water fountains - PRIMAVERA has something to suit anyone's mood.



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[Essential Oils](#)

Things which give us pleasure enrich our lives with a special quality. Pure, natural Essential Oils have a balancing effect on the human psyche while stimulating the defensive powers of the body. PRIMAVERA has over 300 Essential Oils available.



[Essential Oil Blends and Floral Waters](#)

Fragrances and aromas have a general influence on our enjoyment of life. Just a few drops of a blend can clean the air and harmonize the atmosphere of a room.



Pure Plant-Based Oils

The secret of beauty and of radiating a positive air is to take care of yourself and indulge yourself quite consciously. Pure, natural, cold-pressed Base Oils and Infused Oils are ideal for enhancing your physical well-being, and they have been an integral part of care rituals since time immemorial.



Natural Body Care Products

Experience the fragrant possibilities of PRIMAVERA Natural Cosmetics for your beauty program. The ACTIVE, RELAX, HARMONY, EMOTIONS and BASIC lines cover all areas of life: if you need a refreshing pick-me-up, long for relaxation or simply want to spoil yourself.



Feng Shui Blends and Airsprays

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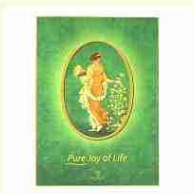
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[Essential Oil Blends and Floral Waters](#)

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[Pure Plant-Based Oils](#)



[Natural Body Care Products](#)

Pure Plant-Based Oils

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Natural Balance and Everyday Moisture

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Diffusers Gift Sets & Ideas

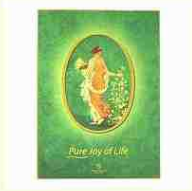
Looking for that perfect gift? PRIMAVERA offers a range of gift ideas that are both rare and unique. From delightfully packaged gift sets to elegant water fountains - PRIMAVERA has something to suit anyone's mood.





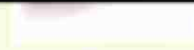
**Natural Balance and
Everyday Moisture**

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Brochures, Catalogs and Posters

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**Diffusers
Gift Sets & Ideas**

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**Aroma Fountains
and Stone Diffusers**

Would you like to fill your favorite place with fragrance? Adding gentle, yet continual fragrance to the air guarantees a good atmosphere in every respect.





Primavera®



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**100% pure and unaltered Essential Oils and Natural Products
The World's Finest Therapeutic Grade**

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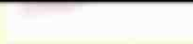


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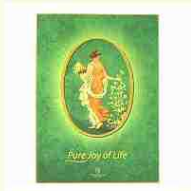
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Organic Airsprays

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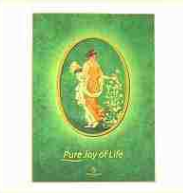
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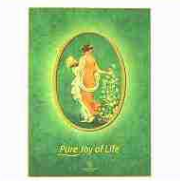
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Exhibit F

2009 WL 1228530 (Trademark Tr. & App. Bd.)

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

In re Daniel T. Phuoc

Serial No. 77356068

April 29, 2009

*1 [Daniel M. Cisko](#) of Cisko & Thomas for Daniel T. Phuoc

Sani Philippe Khouri

Trademark Examining Attorney

Law Office 110

([Chris A.F. Pedersen](#), Managing Attorney)

Before [Quinn](#), [Walters](#) and [Wellington](#)

Administrative Trademark Judges

Opinion by [Walters](#)

Administrative Trademark Judge:

Daniel T. Phuoc has filed an application to register the standard character mark REVIVE WITH ‘THI’ on the Principal Register for “medicated lotions for hand, body and foot,” in International Class 5.¹

The examining attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, [15 U.S.C. 1052\(d\)](#), on the ground that applicant's mark so resembles the standard character mark THI² and the design mark shown below,³ previously registered for “adhesives for affixing false eyelashes; cosmetics; false eyelashes,” in International Class 3,” that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.

Applicant has appealed. Both applicant and the examining attorney have filed briefs. We reverse the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *See In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

In considering the evidence of record on these factors, we keep in mind that “[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

We turn, first, to a determination of whether applicant's mark and the registered marks, when viewed in their entireties, are similar in terms of appearance, sound, connotation and commercial impression. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715 (TTAB 2008). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

*2 Both of the cited registered marks consist of the word THI, one in standard character form and the other in stylized lettering. The stylization of the registered design mark is minimal and we find that it is not a distinguishing factor. Moreover, applicant seeks to register his mark in standard character format and, thus, applicant could conceivably display his mark in any lettering style, including that of the word THI in registrant's design mark. *See e.g.*, 37 C.F.R. §

2.52(a); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988) (when registering mark in block letters, registrant remains free to change the display of its mark at any time); and *Sunnen Products Co. v. Sunex Int'l Inc.*, 1 USPQ2d 1744 (TTAB 1987) (styling of letters is irrelevant to the issue of confusion where applicant seeks to register mark without any special form of lettering or design).

Applicant contends that the beginning phrase in his mark “revive with ...” sufficiently distinguishes his mark from the registered marks. Applicant argues that “revive” is emphasized in the commercial impression of the mark because it is the first word and because it “suggests the product heals and restores something that is damaged, unlike the impression of the registered mark.” Applicant makes the following additional argument in his brief:

[T]he phrase REVIVE WITH THI has a rhyming quality and the term as a whole gives a separate impression apart from the two individual words revive and thi included in the phrase. The fact that REVIVE WITH THI has a somewhat internal rhyming quality adds a certain phonetic distinction that THI alone does not.

The cited registered marks consist of the single word THI, which applicant has incorporated into his mark. There is no indication in the record that THI is other than an arbitrary word in English or in the context of either applicant's or registrant's goods. Applicant submitted a list of twenty-one marks that include the term THI from the USPTO database; however, the list includes both applications and registrations, the majority of these are abandoned or cancelled/expired, the goods are not listed, and the marks contain substantial additional matter. The list is not the appropriate manner for making registrations or applications of record in an appeal and it is not sufficient to make the full records of the listed registrations or applications of record. *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1366 (TTAB 2007); and *In re Duofold, Inc.*, 184 USPQ 638, 640 (TTAB 1974). The listed applications establish nothing other than that they were filed with the USPTO. Normally, a list of registrations is not admissible, but in this case, the examining attorney did not object to its submission, so we consider the list to be of record; however, given its deficiencies, it is of no probative value. Thus, this evidence does not establish that the cited registered marks are weak.

*3 The phrase “revive with ...” in applicant's mark pertains directly to the word THI in the mark and it suggests that THI will “restore” the skin or emotional state of the user of applicant's product. As such, THI is the focus of applicant's mark, REVIVE WITH ‘THI.’ We do not agree with applicant that there is any rhyme or internal rhythm to the mark as a whole that is likely to be perceived by prospective purchasers. Applicant's mark is likely to be perceived as a derivative of, or somehow related to, the registered mark THI, if used in connection with related or similar goods or services. While the marks are different in sound and appearance due to the addition of the phrase “revive with ...” in applicant's mark, we find that the connotations and commercial impressions of the respective marks are substantially similar and, thus, the marks in their entireties are substantially similar.

The *du Pont* factor of the similarities of the marks favors a finding of likelihood of confusion.

Turning to consider the goods involved in this case, we note that the question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than what the evidence shows the goods or services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also, *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991).

Further, it is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some

way associated with the same producer or that there is an association between the producers of each parties' goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein; and *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002).

Applicant's goods are identified as “medicated lotions for hand, body and foot” and the goods in the two cited registrations are identified as “adhesives for affixing false eyelashes; cosmetics; false eyelashes.” The examining attorney submitted a definition from the website www.dictionary.cambridge.org of “cosmetics” as “substances put on the face or body that are intended to improve its appearance or quality,” and argues, essentially, that applicant's and registrant's goods are related because they both fall within this definition of “cosmetics.” In support of this position, the examining attorney submitted ten usebased third-party registrations that are allegedly for “cosmetic-type goods and medicated lotions.” The third-party registrations consist of: five registrations that include lotion and medicated lotion; one registration that includes skin care products and medicated lotion; two registrations for distributorship services for various goods including cosmetics and medicated lotion; one registration for lotion and medicated lotion and the manufacture for others of cosmetics and skin care products; and one registration for medicated lotion and polymers for the manufacture of cosmetics and skin care products.

*4 We agree with applicant's contention that the examining attorney's definition of “cosmetics” is extremely broad and, we take additional judicial notice of the definition in *Merriam-Webster's Collegiate Dictionary* (11th ed, 2003) of “cosmetic” as, in relevant part, “of, relating to, or making for beauty *esp.* of the complexion: beautifying.” In other words, “cosmetics” are, in everyday parlance, “make-up,” and are usually applied to the face. Clearly, the “false eyelashes” identified in the cited registrations are “cosmetics.” However, we do not agree that applicant's medicated lotion is likely to be considered a “cosmetic.” This is supported by the fact that the PTO identifications of goods in the third-party registrations separately identify “medicated lotions/skin care products” and “cosmetics.” Moreover, even if applicant's medicated lotion were to be considered a “cosmetic,” the mere fact that applicant's and registrant's goods might belong to the broad category of cosmetics does not require the conclusion that they are related products. Such a relationship must be established in each case to avoid a *per se* rule for all cosmetics.

We find that the third-party registrations are not probative of a relationship between applicant's and registrant's goods because these registrations do not include both medicated lotions and either cosmetics, false eyelashes or adhesives for such. Six of the registrations are limited to medicated and non-medicated lotions/skin care products and do not include cosmetics. The registration for medicated lotions and polymers for manufacturing cosmetics and skin care products establishes only that such products may contain polymers manufactured at the same facility. The registration that includes the service of manufacturing cosmetics and skin care products for others and the two registrations for distributorship services do not specify whether the finished or distributed products are identified by the same marks, and we cannot reach this conclusion from the identification of services.

In this case, the examining attorney has not met the required burden of proof because the record is entirely devoid of evidence that the involved goods are related and we cannot draw any such conclusion based only on the language of the respective identifications of goods.

Therefore, despite the similarities in the marks, we find the lack of any evidence that consumers would perceive a relationship between applicant's and registrant's identified goods to be dispositive. We conclude that that examining attorney has failed to establish a likelihood of confusion.

Decision: The refusal under Section 2(d) of the Act is reversed.

- 1 Serial No. 77356068, filed December 19, 2007, based on an allegation of a bona fide intention to use the mark in commerce. On May 7, 2008, applicant filed an amendment to allege use and a specimen of use, which were accepted by the examining attorney. Applicant alleges first use and use in commerce as of April 5, 2008.
- 2 Registration No. 3284656, issued August 28, 2007. The registration is owned by Taylor Pham.
- 3 Registration No. 3284659, issued August 28, 2007. The registration is owned by Taylor Pham and includes the following description of the mark: “The mark consist of the word “THI” in lowercase letters, with the lowercase “I” dotted by the design of a leaf.”

2009 WL 1228530 (Trademark Tr. & App. Bd.)

Exhibit G

2014 WL 1390521 (Trademark Tr. & App. Bd.)

THIS OPINION IS NOT A PRECEDENT OF THE T.T.A.B.

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

JOHNSON & JOHNSON

v.

VALENTINO GITTO

Opposition No. 91197584
to [application Serial No. 79061192](#)

March 28, 2014

*1 [Darren S. Cahr](#), [Jeffrey T. Baravetto](#) and [Mita K. Lakhia](#) of Drinker Biddle & Reath LLP for Johnson & Johnson
Valentino Gitto, pro se

Before [Seeherman](#), [Cataldo](#) and Masiello

Administrative Trademark Judges

Opinion by [Cataldo](#)

Administrative Trademark Judge:

Applicant, Valentino Gitto, an individual citizen of France, has applied to register on the Principal Register the mark



for the following goods and services:

soaps; perfumes, essential oils, cosmetics, hair lotions; dentifrices; make-up removing preparations; beauty masks; shaving products, namely, shaving balm, shaving cream, shaving gel, and shaving mousse

(International Class 3); and

medical services; hygienic and beauty care for human beings or animals; plastic surgery; nursing homes with medical care; beauty salons; hairdressing salons

(International Class 44).¹

Opposer, Johnson & Johnson, opposes registration on the ground that it is the owner of the mark POSITIVELY AGELESS, previously used and registered in standard characters on the Principal Register for the following goods:

skin care preparations, namely, skin cleansers, skin moisturizers, skin creams and serums, eye creams

(International Class 3).²

In its notice of opposition, opposer alleges that it has used its registered mark in connection with the above-listed goods since prior to any date upon which applicant may rely for purposes of priority of use of its involved mark; that applicant's mark, when used in connection with applicant's goods and services so resembles opposer's mark for its recited goods as to be likely to cause confusion, to cause mistake, or to deceive; and that opposer will be damaged by the registration thereof.³

Applicant, in his answer, admits opposer's ownership of its pleaded registration and otherwise generally denies the allegations in the notice of opposition.

The record in this case consists of the pleadings and the file of the involved application. *See Trademark Rule 2.122(b); 37 C.F.R. § 2.122(b)*. During its testimony period, opposer timely filed notices of reliance, thereby introducing a copy of its pleaded Registration No. 3605906 showing status and title in opposer; official records obtained from the Trademark Electronic Search System (TESS) showing search results for marks containing the words ““positive” and “age;” and applicant's answers to opposer's first set of interrogatories. In addition, opposer filed the testimony deposition, with accompanying exhibits, of William Collins, opposer's brand manager for its Aveeno Facial Care products.⁴

*2 Applicant did not take testimony or offer any evidence during his assigned testimony period, or object to any of opposer's testimony or evidence.⁵ Only opposer filed a brief on the case.

Opposer's Standing

Because opposer has properly made its pleaded registration of record,⁶ we find that opposer has established its standing to oppose registration of applicant's mark. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Priority of Use

Because opposer's pleaded registration is of record, Section 2(d) priority is not an issue in this case as to its POSITIVELY AGELESS mark for the goods covered thereby. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Likelihood of Confusion

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue, even those not specifically discussed in this decision. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Fame of Opposer's Mark

We begin our likelihood of confusion analysis with the fifth *du Pont* factor, which requires us to consider evidence of the fame of opposer's mark and to give great weight to such evidence if it exists. *See Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot Inc. v. Becton*, 214 F.3d 1322, 54 F.2d 1894 (Fed. Cir. 2000); and *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

Fame of an opposer's mark or marks, if it exists, plays a “dominant role in the process of balancing the *DuPont* factors,” *Recot*, 214 F.3d at 1327, 54 USPQ2d at 1456, and “[f]amous marks thus enjoy a wide latitude of legal protection.” *Id.* This is true as famous marks are more likely to be remembered and associated in the public mind than a weaker mark, and are thus more attractive as targets for would-be copyists. *Id.* Indeed, “[a] strong mark ... casts a long shadow which competitors must avoid.” *Kenner Parker Toys*, 963 F.2d at 353, 22 USPQ2d at 1456. A famous mark is one “with extensive public recognition and renown.” *Id.*

*3 *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1305. As we have stated in previous decisions, in view of the extreme deference that is accorded to a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of a plaintiff asserting that its mark is famous to clearly prove it. *See Leading Jewelers Guild v. JLOW Holdings, LLC*, 82 USPQ2d 1901 (TTAB 2007).

Upon careful review of the record in this case, we are not persuaded by opposer's claim that its POSITIVELY AGELESS mark is famous. In support of its claim, opposer has submitted confidential testimony and evidence regarding its dollar sales and advertisements from 2007 through 2013.⁷ Opposer further has submitted evidence of advertisements placed in *Allure* magazine, and such digital media as Buzz Agent, WebMD, Total Beauty, SheKnows, Facebook and YouTube.⁸ In addition, opposer has submitted evidence in the form of the results of its search of the USPTO's TESS database indicating that the only two live marks containing the root terms “positive” and “age” are its registration and the involved application.⁹

The testimony and evidence demonstrate that opposer has enjoyed considerable financial success in sales of goods under its POSITIVELY AGELESS mark and has expended considerable effort in marketing the goods identified under that mark. However, such evidence falls short of demonstrating the extent to which such success translates into widespread recognition of the POSITIVELY AGELESS mark among the general public. For instance, there is no testimony or evidence regarding how opposer's sales relate to sales of comparable products by its competitors such that we may place its raw sales numbers into relevant context. In addition, opposer's annual sales and marketing figures are rather low, compared to annual sales or advertising figures for other marks we have found to be famous. *See, for example, Motion Picture Association of America, Inc. v. Respect Sportswear Inc.*, 83 USPQ2d 1555 (TTAB 2007) (opposer's member companies annually sold 2.8 billion movie tickets and DVDs and spent 4 billion dollars on advertisements and promotion.).

Accordingly, we find on this record that the evidence is insufficient to establish that opposer's POSITIVELY AGELESS mark is famous for purposes of our likelihood of confusion determination. Nevertheless, we find that the evidence is sufficient to show that opposer's POSITIVELY AGELESS mark has achieved at least some degree of recognition and strength in the skin care market and that the mark is therefore entitled to a broader scope of protection than might be accorded a mark with less recognition.

The Marks

*4 We consider the first *du Pont* factor, i.e., whether applicant's mark and opposer's mark are similar or dissimilar when viewed in their entireties in terms of appearance, sound, connotation and commercial impression. *See Palm Bay Imports, Inc. v. Veuve Clicquot*, 73 USPQ2d at 1691.

In this case, applicant's mark



POSITIVE
ageing

and opposer's POSITIVELY AGELESS mark are highly similar in that both consist of variations of the root terms "positive" and "age." As a result, POSITIVELY AGELESS and POSITIVE AGEING are highly similar in appearance and sound. The slight stylization of applicant's mark does not impart a significant difference in appearance and the rendering of the letter "t" in "positive" as a plus "+" sign simply reinforces the term "positive." As a result, we find that the stylization in applicant's mark does not significantly distinguish it from that of opposer. Opposer's mark suggests a desirable timeless quality while that of applicant suggests beneficial and healthy ageing. These connotations, while not exactly the same, nonetheless are similar inasmuch as both suggest benefits to users' appearance or wellbeing as they age.

As a result, we find that applicant's mark is highly similar in appearance and sound, and similar in connotation to opposer's mark and, overall, conveys a highly similar commercial impression.

The Goods and Services

Turning next to our consideration of the similarities or dissimilarities between opposer's goods and applicant's goods and services, we note that it is well established that the goods and/or services of the parties need not be similar or competitive, or even offered through the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods and/or services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and/or services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. See *Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *In re International Telephone & Telephone Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue, of course, is not whether purchasers would confuse the goods and/or services, but rather whether there is a likelihood of confusion as to the source thereof. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

As recited in its pleaded registration, opposer's goods are identified as:

skin care preparations, namely, skin cleansers, skin moisturizers, skin creams and serums, eye creams

*5 and applicant's goods and services are identified as:

soaps; perfumes, essential oils, cosmetics, hair lotions; dentifrices; make-up removing preparations; beauty masks; shaving products, namely, shaving balm, shaving cream, shaving gel, and shaving mousse; and

medical services; hygienic and beauty care for human beings or animals; plastic surgery; nursing homes with medical care; beauty salons; hairdressing salons.

Turning to our consideration of the similarity between the parties' goods, opposer's witness, Mr. Collins, offered the following testimony: ¹⁰

Q. Do you believe that any of the products listed there sold under the Positive Ageing brand would be likely to cause confusion with your products -?

A. Yes.

Q. - sold as Positively Ageless?

A. Yeah. I think a couple of these categories are ones that are either something we have current presence in, cosmetics we have our tinted moisturizer that has a cosmetic application and purpose, as well as soaps versus cleansers. They're providing the same sort of end benefit to the consumer. Consumers would shop those in the same way.

Q. Can you talk a bit about how the brand has expanded in the past? What you started with and what products you expanded into the Positively Ageless line just to demonstrate what we're talking about?

A. Yep. So we began with cleansers, facial moisturizers and treatment products, and we have expanded into the body care category as well as the hand care category with our skin strengthening - our Aveeno Positively Ageless Skin Strengthening Body Lotion and Aveeno Positively Ageless Skin Strengthening Hand Cream, and so that was an idea and a concept that consumers are not only facing antiaging needs when they're dealing with their facial care, but they're also seeing other problem areas, if you will, on other parts of their body.

Q. And one more quick question on this. Can you please describe what "cosmetics" means in your market and whether or not what you're selling are cosmetics?

A. Yep. Yeah. So cosmetics are products that would help change the appearance of a user's skin, find a way to make them feel more beautiful, help them to highlight a particular area on their face, whether it's their eyes or their lips, or to provide coverage. The one product in our Aveeno Positively Ageless line that would be similar is our tinted moisturizer. That product does provide a bit of a foundation. So often consumer would say, I don't want to use a foundation because it's heavy, but I need that coverage and I need that even tone that you get from a slight tint, and so part of the reason we went into the tinted moisturizer was to provide that benefit for consumers.

With regard to the similarity between applicant's services and opposer's goods, Mr. Collins offered the following testimony regarding a third-party's business model, product line and activities under a single mark: ¹¹

*6 Q. I've got for you initially what is marked as Opposer's Exhibit No. 21, which is an Internet printout. Can you please describe for us what this is?

A. Yep. This is a printout of the products for the Bliss line, which is a brand of skin care products, hair products, as well as spa services that are offered across those different lines. So Bliss has done a nice job of building up - they had spas to begin with, and consumers would go there and experience their products. They have leveraged that to sell different products like I said, in the categories I mentioned from skin care to hair and makeup, and use that spa entry point as a way to get consumers to use products elsewhere, and to my knowledge they're sold - I believe they're sold at ULTA and other channels that we would compete with.

From an Aveeno Positively Ageless perspective we see them as a competitor. We know that there are consumers that buy both of these - both of these platforms, both of these products, and so someone is making a decision between do I buy this or do I buy Aveeno Positively Ageless?

Q. So they've tied together, sort of, services being provided to the consumer with -?

A. Correct.

Q. - goods being sold to the consumer?

A. Correct.

Q. And so they provide hairdressing beauty salon services -?

A. Yep.

Q. - and beauty care services?

A. Yes.

Q. Plus they also sell the products?

A. Yes.

Q. And in your experience does that mean that people are going to tie those things together in the public mind and expect that the same products are sold across the various different channels of trade?

A. Yes. Yes. And I think that, like you said, they would have an experience, whether it's a facial or a peel that they have as a spa treatment, then they would look for the products that the beautician or the woman who was doing this - person who's doing this service might use, and then obviously part of the business model is for them to recommend that product. If you like the feel of this, if you like the experience that you had, if you like the benefit that you're seeing on your skin, here's this product that I think you should use, and then here's where you can get it.

Q. So do you believe that if someone were to try to use or register the mark Positive Ageing in connection with beauty salon services that that would still be a problem for you?

A. I do.

Q. And explain why.

A. I think, again, the consumer would have the perception that it's giving them the same skin benefit that Positively Ageless would be giving them, and there's the opportunity of confusion, so if they have used Positively Ageless in the past, they go to a salon that gives them a service and recommends Positive Ageing, I think there's definite confusion that would occur there, and a consumer would not always be able to distinguish what's unique or different about those two names.

Q. And what about a hairdresser?

*7 A. Um-hum.

Q. How would confusion work in your mind that way?

A. Yep. Again, the same - the same sort of service. If someone is going to a beauty salon for a hair service, they make a recommendation for something that is going to address their ageing needs through a product called Positive Ageing, it would be easy for them to say there are other products that I've used in the past on different parts on my face that are Positively Ageless, and I might associate those two as the same thing, and some of the investment and the uniqueness that we have tried to develop through the Aveeno team would be - is going to be lost or would be less, kind of discredited. They would be getting credit for our work.

Q. And what about someone who was selling Positive Ageing products or services in connection with dermatological care or some other kind of medical care in connection with skin care -?

A. Yeah.

Q. - would that be confusing?

A. Yes. And I think it would not only be confusing for the consumer, but it also could be confusing for some of the dermatologists because we have invested and detailed to them the Positively Ageless platform and the benefits of those products. There's obviously been communication to them about the benefits of Positively Ageless, and so the dermatologists could be confused about what product it would be as well as the recommendation that they would make to the - to their patient. Their patient may not understand that there's a difference there between Positive Ageing and Positively Ageless.

The testimony and evidence of record establishes that, at least, opposer's skin cleansers and (tinted) skin moisturizers are related to applicant's soaps and cosmetics. Furthermore, as identified, applicant's soaps and opposer's skin cleansers can be considered to be the same product; they are at least closely related inasmuch as both are used for the same purpose, namely, to clean the user's skin. Opposer's testimony and evidence further establish that opposer's skin care products are related to applicant's cosmetics and hair lotions inasmuch as spas and beauty salons use and sell both while providing their services. The testimony and evidence establishes in addition that applicant's beauty salons, hairdressing salons and beauty care for human beings are related to opposer's skin care products inasmuch as beauty salons and spas offering skin and beauty care also market skin and beauty products. Thus, we find that opposer's goods and applicant's goods and services are related for purposes of our likelihood of confusion determination.

Because we find that certain of applicant's goods and services are related to opposer's goods, we need not also determine the similarity or dissimilarity of opposer's goods to the other goods and services identified in applicant's application. Similarity as to *any* of the goods or services identified in the application and pleaded registration will suffice as a basis for finding the respective goods and services to be similar for purposes of the second *du Pont* factor. *See, for example, Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

Channels of Trade

*8 Because there are no recited restrictions as to the channels of trade or classes of purchasers of the goods and services identified in the involved application or the goods identified in opposer's pleaded registration, we must assume that the goods and services are available in all the normal channels of trade to all the usual purchasers for such goods and services. *See Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.”). *See also Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) (“Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.”). As such, the parties' goods and services are presumed to be marketed to the general public through all normal trade channels therefor.

Regarding the opposer's trade channels and classes of consumers for goods under its Positively Ageless mark, Mr. Collins offered the following testimony: ¹²

Q. But you're also, I would imagine, interested in being able to get to the consumer from a variety of different channels of trade, too?

A. Yep. So as part of Johnson & Johnson Consumer Companies, Inc. we have relationships with major retailers throughout the country, and so that - consumers are not only looking for skin care solutions in one place.

Q. And do people sometimes buy these things in spas or -?

A. Um-hum.

Q. - from - and do some dermatologists sell -?

A. Yep.

Q. Sell these kinds of products as well?

A. Yes. So a lot of the - for example, a spa or salon, a place where you would get a facial, those types of things, obviously there's a connection there for the benefit that you're looking for and products that would address those benefits, and so we compete with the brands and the products that are offered in those - locations and are always looking for ways for us to expand there. ...

Applicant has indicated that the trade channels for his goods and services will include beauty salons, spas, and “aesthetic doctors” and that he plans to market his goods and services at trade shows, through mailers, the Internet and direct solicitation. ¹³ As discussed above, opposer markets its goods through magazines and various Internet and digital media outlets. ¹⁴ As a result, the evidence of record establishes that applicant's goods and services as well as opposer's goods are or will be offered and advertised through some of the same channels of trade.

Summary

*9 In view of the foregoing, we find that opposer has established its standing to bring this proceeding; its priority of use; that its POSITIVELY AGELESS mark is strong; that its goods are related to applicant's goods and services and are or will be marketed through some of the same channels of trade; and that the similarities between applicant's mark and opposer's mark far outweigh the differences between them.

DECISION: The opposition is sustained on the ground of likelihood of confusion, and registration to applicant is refused.

¹ Application Serial No. 79061192 was filed on September 19, 2008 seeking an extension of protection under Section 66(a) of the Trademark Act based upon International Registration No. 0982863, issued on September 19, 2008.

² Registration No. 3605906 issued on April 14, 2009.

³ On the ESTTA cover sheet accompanying the notice of opposition, opposer lists deceptiveness and false suggestion of a connection under Section 2(a) as additional grounds for opposition. However, opposer did not pursue these grounds at trial and, accordingly, they are deemed waived.

⁴ We will refer to those portions of Mr. Collins' testimony designated as “confidential” only in general terms.

⁵ Applicant did not attend the testimony deposition of Mr. Collins.

- 6 TTABVue 21, at 4-7. The citations to “TTABVue” throughout the decision are to the Board's public online database that contains the proceeding file, available on the USPTO website, www.USPTO.gov. The first number represents the docket entry number listed in the electronic case file and the second represents the page number(s).
- 7 TTABVue 25 at 21, 89.
- 8 *Id.* at 18-19, 77-86.
- 9 TTABVue 23 at 4.
- 10 TTABVue 25 at 12-18.
- 11 *Id.*
- 12 TTABVue 25 at 15-18.
- 13 TTABVue 22 at 14.
- 14 TTABVue 25 at 21, 89

2014 WL 1390521 (Trademark Tr. & App. Bd.)

Exhibit H

2004 WL 1294386 (Trademark Tr. & App. Bd.)

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

IN RE WET SEAL, INC.

Serial No. 76338469

May 27, 2004

*1 [Morris A. Thurston](#) of Latham & Watkins LLP for Wet Seal, Inc.

[Jason Turner](#), Trademark Examining Attorney

Law Office 108

(David Shallant, Managing Attorney)

Before [Hairston](#), [Bucher](#) and [Holtzman](#)

Administrative Trademark Judges

Opinion by [Holtzman](#)

Administrative Trademark Judge:

Wet Seal, Inc. has appealed from the final refusal of the trademark examining attorney to register the mark SEAL for the following goods, as amended:¹

Cosmetics, mascara, eye liners, eye brow pencils, eye shadow, artificial eyelashes, face powder, dusting powder, powder compacts containing make-up, rouge, liquid rouge, foundation, concealer, lipstick, lip liner, lip gloss and makeup remover; nail polish, nail polish remover, cuticle softener and cuticle cream; colognes, perfumes and toilet waters; toothpaste, mouthwash and tooth gel; sun screen, sun block and suntanning preparations; antiperspirants, deodorants; aftershave lotions, shaving lotions and cream, shaving foam, after-shave balm, astringents, skin toner and skin tonic; body, hand and face lotions and creams; skin cleansers, soaps, bubble bath, toilet soap, bath and shower gels, bath oils, bath salts, bath crystals, body powders and talc, body spray and essential oils for personal use. Class 3.

Handbags, purses, backpacks, briefcases, cosmetic bags and toiletry cases sold empty, vanity cases sold empty, wallets and change purses. Class 18.

Cosmetic accessories, namely, cosmetic brushes, facial sponges for applying make-up and applicators for applying make-up; hair brushes. Class 21.

The trademark examining attorney has refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to applicant's goods, so resembles the following seven registered marks, all owned by different entities, as to be likely to cause confusion.²

HYDRO SEAL

For Non-medicated moisturizing component as used in ingredient complex in fragrance and toiletry products, namely — foam bath, shower gel, body lotion, fragrance spray, hand cream, moisturizing gel, exfoliating body scrub.³ Class 3.

HEAT SEAL

For hair care products, namely conditioners, gels, and sprays.⁴ Class 3.

SILKEN SEAL

For hair care preparations; namely, shampoos, conditioners, styling gels, hair sprays and hair glossers.⁵ Class 3.

SEAL 'N PROTECT

For Hair conditioner.⁶ Class 3.

SEALSKIN

For preparation for filling the skin pores with an innocuous material to keep out certain irritants.⁷ Class 3.

SEAL PAK

For fanny packs, hip packs, and waist packs.⁸ Class 18.

SEALCO

For mail order services in the field of luggage.⁹ Class 42.

When the refusal was made final, applicant appealed. Briefs have been filed. An oral hearing was not requested.

*2 Here, as in any likelihood of confusion analysis, we look to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), giving particular attention to the factors most relevant to the case at hand, including the similarity of the marks and the relatedness of the goods or services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). In particular, the Court stated that “[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and the differences in the marks.”

When the relevant factors in this case are considered, we find there is no likelihood of confusion.

THE MARKS

The Examining Attorney contends that applicant's mark is similar to each registered mark in sound, appearance, connotation and overall commercial impression. Specifically, the examining attorney argues that “[t]he registrants' marks all contain the applicant's exact mark in its entirety”; that “[t]he only differences are the registrants' additional matter consisting of the terms ‘CO,’ ‘HEAT,’ ‘PAK,’ ‘SILKEN,’ ‘N’ PROTECT,’ ‘SKIN’ and ‘HYDRO’”; and that “[t]he disclaimed terms ‘PAK’ and ‘SILKEN’ and the other arguably descriptive or generic terms such as ‘HEAT,’ ‘SKIN’ and ‘CO’ [are] considered of lesser trademark significance than ‘SEAL.’” (Brief, p. 4.)

We disagree with the examining attorney's analysis of these marks and instead find that when considered in their entireties, each of the cited marks is dissimilar to applicant's mark in sound, appearance, meaning and commercial impression.

It is true that applicant's mark “SEAL” is fully encompassed by each of the registered marks, HYDRO SEAL, HEAT SEAL, SILKEN SEAL, SEAL ‘N PROTECT, SEALSKIN, SEALCO and SEAL PAK (stylized). However, that is where the similarities end. There are obvious differences in sound. Applicant's mark consists of a one-syllable word while each of the registered marks is at least two syllables. There are also differences in appearance. Applicant's mark is the single word SEAL while the registered marks all consist of the word SEAL either preceded or followed by another term.

Further, the additional term in each cited mark, whether suggestive (as in “HYDRO” and “HEAT”), or even descriptive (“SEAL ‘N PROTECT,” “CO,” “SKIN”) or disclaimed (“SILKEN” and “PAK”), imparts a meaning to “SEAL” that is different from the meaning conveyed by SEAL alone. It is well settled that “[n]o part of the mark can be ignored in comparing the marks as a whole.” *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1282 (Fed. Cir. 1984).

*3 The marks for goods in Class 3, HYDRO SEAL, HEAT SEAL and SILKEN SEAL, SEAL ‘N PROTECT, and SEALSKIN, each suggests one or more specific functions of the skin or hair care products the mark identifies: HYDRO SEAL suggests that registrant's moisturizing component of hand cream seals moisture into the skin; HEAT SEAL for hair conditioner suggests that a heating process is used to seal protection into the hair; SILKEN SEAL suggests shampoo and hair conditioner that imparts a lasting silky feel or texture to the hair; SEAL ‘N PROTECT describes hair conditioner that seals out and protects against harmful elements; and SEALSKIN for a skin pore-filling material suggests both protection from skin irritants and the resulting smooth texture of the skin.

Unlike the specific functions of the respective skin and hair products suggested by the combined terms in these marks, the single word SEAL in applicant's mark suggests only some vague, nonspecific function of applicant's various cosmetic products and accessories. As a further distinction, the word SEAL may even project a whimsical image that is entirely unrelated to any function of the identified goods.

The connotation of applicant's mark also differs from the connotation of the cited marks for the respective goods in Class 18 and services in Class 42. Applicant's mark SEAL suggests the texture or composition of its handbags and purses. The mark SEAL PAK, however, suggests a function of registrant's fanny packs and waist packs, in particular, the tight closure of the packs and security of the items contained therein. The mark SEALCO for mail order services in the field of luggage suggests a company name rather than any intrinsic characteristic of the service.

THE GOODS AND SERVICES

Not only are the marks dissimilar, but there is insufficient evidence in each case to establish that the respective goods and services are closely related.¹⁰

CLASSES 3 AND 21

Registration Nos. 2424116, 1680023, and 1216213

As to these registrations, the examining attorney argues that applicant's goods, broadly identified as “cosmetics,” encompass the hair care products identified in Registration Nos. 2424116 (HEAT SEAL for hair care products, namely conditioners, gels, and sprays), 1680023 (SILKEN SEAL for hair care preparations, namely shampoos, conditioners, styling gels, hair sprays and hair glossers), and 1216213 (SEAL 'N PROTECT for hair conditioners); and that applicant's cosmetic sponges and applicators are companion items to the registrants' “cosmetic” products.

The dictionary listing submitted by the examining attorney defines “cosmetics” as “a preparation (except soap) to be applied to the human body for beautifying, preserving, or altering the appearance of a person (as for theatricals) or for cleansing, coloring, conditioning, or protecting the skin, hair, eyes, or teeth.”

*4 We are not convinced that this single, expansive definition of “cosmetics,” covering virtually every conceivable preparation that could be applied to any part of the body, accurately reflects the typical consumer's perception of this term. There is no evidence that the specific products identified in these registrations, that is, hair care preparations such as shampoos and hair conditioners, would be perceived by the typical purchasers of those goods as “cosmetics,”¹¹ or that such purchasers would believe that shampoos and hair conditioners are produced by the same companies that produce cosmetics or cosmetic accessories.¹²

Moreover, the specific exclusion of soap products from this definition, and thus the effective exclusion of shampoo, results in a truly artificial distinction between which products are, and which products are not, “cosmetics,” and leaves us with further doubt that this definition accurately reflects the realities of the marketplace.

Thus, we cannot find, at least based on this record, that hair care preparations and cosmetics are legally identical products. Nor is the evidence sufficient to show that hair care preparations are so closely related to cosmetics that purchasers would naturally expect these products to emanate from the same source.¹³

Registration No. 782185

The examining attorney contends that the astringent product offered under applicant's mark SEAL “is seen to include” registrant's “preparation for filling skin pores with an innocuous material to keep out certain irritants” which is offered under the mark SEALSKIN (brief, p. 8). The dictionary entry submitted by the examining attorney defines “astringent” as “having the property of drawing together the soft organic tissue: contracting, constricting.”

The relationship between these two products is unclear. Although both products are used on the skin, the examining attorney has not explained, and it is simply unclear from the definition alone, how a product that performs by contracting and constricting soft organic tissue would, as the examining attorney claims, “include” a material that fills skin pores. By its very nature, at least based on this definition, an astringent would appear to be a distinctly different product with a distinctly different function and effect.

Registration No. 2528395

As to this registration, the examining attorney maintains that applicant's shower gels, body lotions and hand creams offered under the mark SEAL are related to registrant's moisturizing component as used in an ingredient complex in those same products offered under the mark HYDRO SEAL.

While there may be an inherent relationship between these products, we have no evidence that the products would be encountered in the same channels of trade by the same purchasers. It is not unreasonable to assume that the moisturizing component of an ingredient complex of, for example, hand cream would be marketed to manufacturers of the hand cream while the hand cream containing the component would be sold to ultimate consumers. There is nothing in the record to indicate that the purchasers of shower gel, body lotion and hand cream with a moisturizing component of an ingredient complex would ever be exposed to or be aware of a separate mark for a component of those products, or that the mark for a component would even be used in the retail market or appear on the end product at all.

CLASS 18

Registration No. 1749402

*5 The examining attorney argues, without evidence, that the handbags, purses, backpacks, briefcases, cosmetic bags and toiletry cases, vanity cases, wallets and change purses offered under applicant's SEAL mark are related to the goods in Registration No. 1749402 (SEAL PAK stylized) for fanny packs, hip packs, and waist packs.

Fanny packs and waist packs on the one hand and handbags and purses on the other are broadly related goods. However, there is simply no evidence that these goods are so closely related that, notwithstanding the differences in the marks used thereon and, in particular, the different suggestive meanings of the marks in relation to the respective goods, purchasers would mistakenly believe that these goods emanate from, or are associated with, the same source.

CLASS 42

Registration No. 1884104

The examining attorney contends that registrant's mail order services in the field of luggage offered under the mark SEALCO would encompass the specific travel bags, including handbags and purses, identified in the application for SEAL. The dictionary entries submitted by the examining attorney define "handbag" as a "traveling bag"; and define "luggage" as "suitcases, travelling [sic] bags, and other articles containing a traveler's belongings."

Applicant's goods and registrant's services are obviously different in kind. On the other hand, it is true that goods, on the one hand, and services that deal with those goods, on the other, may be found to be related. However, the examining attorney has not shown that to be the case with respect to the particular goods and services at issue here. Registrant's services deal with luggage. A handbag is not luggage, it does not serve the same function as luggage, and it is not an effective substitute for luggage.

Moreover, it is not relevant that luggage and handbags can both be described as "traveling bags." Registrant's mail order services are not for traveling bags, but specifically for luggage. There is no evidence that mail order services or other retail outlets for luggage also typically include the sale of handbags. See, e.g., [4 McCarthy on Trademarks and Unfair Competition § 24:25 \(4th ed. 2004\)](#) (stating that "[w]here the services consist of retail sales services, likelihood of confusion is found when another mark is used on goods which are commonly sold through such a retail outlet").

Conclusion

Considering in each case the cumulative effects of the differences in the marks and the differences in the essential characteristics of the goods and services, and, at least with respect to Registration No. 2528395, the differences in the channels of trade and classes of purchasers for applicant's and registrant's goods, we find that there is no likelihood of confusion as to any of the cited registrations.

Decision: The refusal to register is reversed.

- 1 Application Serial No. 76338469, filed November 14, 2001, asserting a bona fide intention to use the mark in commerce.
- 2 An initial refusal to register under Section 2(e)(1) of the Trademark Act was subsequently withdrawn.
- 3 Registration No. 2528395; issued January 8, 2002; owned by Avon Products, Inc.
- 4 Registration No. 2424116; issued January 3, 2001; owned by John Paul Mitchell Systems.
- 5 Registration No. 1680023; issued March 24, 1992; renewed; owned by Avlon Industries, Inc. The word "SILKEN" is disclaimed.
- 6 Registration No. 1216213; issued November 9, 1982 on the Supplemental Register; renewed; owned by Dowbrands, Inc.
- 7 Registration No. 782185; issued December 22, 1964; renewed; owned by Kravitz, Rubin and Kravitz, Annabelle S. dba Cadet Laboratories Partnership.
- 8 Registration No. 1749402; issued January 26, 1993; renewed; owned by Cascade Designs, Inc. The term "PAK" is disclaimed.
- 9 Registration No. 1884104; issued March 14, 1995; Section 8 affidavit accepted; owned by Skyway Luggage Company dba Sealco Corporation.
- 10 The examining attorney's only evidence consists of dictionary definitions of certain identified goods. We take judicial notice of these definitions, all of which were submitted for the first time with the examining attorney's appeal brief.
- 11 In fact, it is more likely that such products would be referred to as "toiletry" items.
- 12 Applicant originally included shampoo and hair conditioner in its identification of goods and subsequently deleted those goods in response to the examining attorney's refusal to register. The examining attorney argues that applicant's inclusion of these goods in its original application is evidence that these items would be considered a natural expansion of applicant's cosmetic products. We fail to see how goods that have been deleted from an intent-to-use application would be considered evidence of an expansion, natural or otherwise.
- 13 The examining attorney points to the case of [Cosmetically Yours, Inc. v. Clairol Incorporated](#), 165 USPQ 515 (CCPA 1970) in support of his position that hair care preparations and cosmetics are closely related products. In that case, the Court specifically noted that the record before the Board showed that a number of leading cosmetic companies market both hair preparations and facial cosmetics. There is no such evidence in this case. We are required to decide each case based on its own facts and record, not the facts and record in a different case.

2004 WL 1294386 (Trademark Tr. & App. Bd.)

Exhibit I

2002 WL 1602493 (Trademark Tr. & App. Bd.)

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

INTERNATIONAL MARCO POLO SERVICES, INC.

v.

MARCO POLO HOTELS MANAGEMENT LIMITED

Cancellation No. 28,605

July 18, 2002

*1 Before [Hairston](#), Wendel, and [Bucher](#)
Administrative Trademark Judges

By the Board:

On March 16, 1999, International Marco Polo Services, Inc. (hereinafter, IMPS) filed a petition to cancel Registration No. 2,218,258 for the mark for “hotel reservation services; providing facilities for conventions, exhibitions, banquets, social functions, and special occasions” on the ground that discovery served in an earlier Board proceeding gave notice to respondent Marco Polo Hotels Management Limited (hereinafter, MPHM) of IMPS’¹ prior use of the mark MARCO POLO’S for “hotel reservation services”, and thus MPHM’s registration was fraudulently obtained.



In lieu of filing an answer, respondent MPHM filed a motion to dismiss under [Fed. R. Civ. P. 12\(b\)\(6\)](#). In its motion, respondent MPHM essentially contends that IMPS has failed to state a claim for relief because in the earlier Board proceeding the Board held that IMPS had never used the mark MARCO POLO’S for hotel services, and thus IMPS is collaterally estopped from relying on its use of the mark in bringing the claim that respondent knew of IMPS’ use of the mark MARCO POLO’S for hotel reservation services. The motion has been fully briefed.

As a procedural matter, although respondent MPHM entitled its filing a “motion to dismiss,” both parties submitted matters outside the pleadings and have briefed not just the legal sufficiency of the pleadings but the issue of whether judgment should be entered on the basis of collateral estoppel. Upon review, it is clear that respondent’s motion to dismiss has been treated by the parties as a motion for summary judgment. *See* [Fed. R. Civ. P. 56](#); TBMP §503.04. Ordinarily, the parties to the proceeding will be notified that the motion to dismiss is being treated as a motion for summary judgment, and they will be given reasonable opportunity to present all material made pertinent to such a motion by [Fed. R. Civ. P. 56](#). Where, as here, the parties themselves clearly have treated a motion to dismiss as a motion for summary judgment, and the nonmoving party has responded to the motion on that basis, such notice may be unnecessary. *See Selva & Sons*,

Inc. v. Nina Footwear, Inc., 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983); TBMP §503.04. Accordingly, the Board will treat respondent MPHMs motion to dismiss as a motion for summary judgment.

Before turning to the motion for summary judgment, we set out the relevant chronology, including the earlier Board proceeding between the parties.

*2 On October 20, 1992, Registration No. 1,726,344 issued to IMPS for the mark MARCO POLO'S used in connection with "casino services" and "restaurant, bar and hotel services".

On July 20, 1995, MPHMs filed a petition to cancel Registration No. 1,726,344 on the grounds of abandonment and fraud, which the Board instituted as Cancellation No. 24,018. MPHMs later amended its petition to allege nonuse as an additional basis of cancellation for some of the services specified in the registration.

While its petition to cancel IMPS' MARCO POLO'S mark was pending, on May 16, 1997 MPHMs filed a trademark application for THE MARCO POLO and design for, *inter alia*, hotel reservation services, and on January 19, 1999, the application matured into Registration No. 2,218,258 (the subject of this proceeding).

On February 4, 1999, application Serial No. 75/486,489², in which IMPS seeks registration of the mark MARCO POLO for "hotel reservation services", was refused registration on the basis of likelihood of confusion with MPHMs Registration No. 2,218,258.

On March 16, 1999, IMPS filed the instant petition to cancel MPHMs Registration No. 2,218,258 (instituted as Cancellation No. 28,605) on the ground that, because discovery conducted in Cancellation No. 24,018 notified MPHMs of IMPS' prior use of MARCO POLO'S for the same services, MPHMs registration was fraudulently obtained.

In Cancellation No. 24,018, on March 30, 1999, the Board granted summary judgment to MPHMs on the issue of IMPS' nonuse of the mark MARCO POLO'S in connection with casino and hotel services.

MPHMs motion for summary judgment in Cancellation No. 28,605 on the basis of collateral estoppel followed, and the Board suspended proceedings pending the outcome of Cancellation No. 24,018.

On June 29, 2001, the Board issued its final decision in Cancellation No. 24,018 granting cancellation of IMPS' Registration No. 1,726,344 for the mark MARCO POLO'S on the ground of nonuse for casino and hotel services, and on the ground of abandonment for casino, hotel, restaurant and bar services.

The Board now takes up the question of whether MPHMs is entitled to summary judgment on the grounds that the Board's finding in Cancellation No. 24,018 that IMPS never used the mark MARCO POLO'S in connection with "hotel services" precludes consideration of the claim now brought by IMPS, namely that Registration No. 2,218,258 was obtained fraudulently insofar as MPHMs possessed "full knowledge of [IMPS'] prior rights" in connection with "hotel reservation services."

In support of its argument that IMPS is collaterally estopped from bringing its petition to cancel, MPHMs asserts that the petition to cancel is based "solely on [IMPS'] claim of alleged priority of use of the mark MARCO POLO'S... in connection with hotel services"; that, in its order issued March 30, 1999 in Cancellation No. 24,018, the Board found that IMPS "had failed to introduce any evidence whatsoever demonstrating use of the mark MARCO POLO'S in connection with hotel services; that the issue of IMPS' non-use was fully litigated; that the Board held that IMPS "has never used the mark MARCO POLO'S in connection with hotel services"; that IMPS' "exclusive reliance on [its] alleged prior use of the mark in connection with those services as grounds for the instant action is fatally misplaced"; and that, because the principle of collateral estoppel bars relitigation of "whether and to what extent" IMPS has used the mark in connection

with hotel services, the petition to cancel should be dismissed in its entirety. In support of its motion, MPH M submitted a copy of the Board's order of March 30, 1999 in Cancellation No. 24,018.

*3 In opposing MPH M's motion, IMPS asserts that its petition to cancel has “been mischaracterized”. Specifically, IMPS asserts that “the instant petition to cancel ... is not based upon the right to use the mark MARCO POLO'S for hotel services, but rather for hotel reservation services”; that IMPS admitted in the earlier cancellation proceeding that it did not use MARCO POLO'S as a trade name for a specific hotel; that, as demonstrated by discovery responses served by IMPS in the earlier cancellation proceeding, IMPS “contended specifically throughout that proceeding that it used the mark without interruption throughout the entire critical period for hotel reservation services”; that there is nothing in the record for this proceeding asserting that IMPS claims rights to hotel services or that IMPS is attempting to relitigate any issue regarding hotel services; and that MPH M should be directed to answer the petition to cancel. In support of its response, IMPS relies on its petition to cancel and its discovery responses served in Cancellation No. 24,018.

The burden is on the party moving for summary judgment to show the absence of any genuine issue of material fact, and that it is entitled to judgment as a matter of law. See *Fed. R. Civ. P. 56(c)*; and *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S. Ct. 2548 (1986). The evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor.³ See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

Under the doctrine of issue preclusion (collateral estoppel), once an issue is actually and necessarily determined by a court of competent jurisdiction, that determination is normally conclusive in a subsequent suit involving the parties to the prior litigation. *International Order of Job's Daughters v. Lindeburg & Co.*, 727 F.2d 1087, 220 USPQ 1017 (Fed. Cir. 1984). The underlying rationale is that a party who has litigated an issue and lost should be bound by that decision and cannot demand that the issue be decided over again. *Mother's Restaurant Incorporated v. Mama's Pizza, Inc.*, 723 F.2d 1566, 221 USPQ 394 (Fed. Cir. 1983).

In order for issue preclusion to apply, the following requirements must be met: 1) the issue to be determined must be identical to the issue involved in the prior litigation; 2) the issue must have been raised, litigated and actually adjudged in the prior action; 3) the determination of the issue must have been necessary and essential to the resulting judgment; and 4) the party precluded must have been fully represented in the prior action. *Polaroid Corp. v. C & E Vision Services Inc.*, 52 USPQ2d 1954 (TTAB 1999); *Mother's Restaurant, supra*.

*4 There is no dispute between the parties, and no genuine issue of material fact exists, as to the applicability of the last three factors. In Cancellation No. 24,018, the use by IMPS of the mark MARCO POLO'S to identify “hotel services” was an issue actually litigated, the issue was essential to the resulting judgment by the Board granting cancellation based on non-use, and IMPS was fully represented in that cancellation proceeding. We turn to the remaining factor, namely whether the issue in the present proceeding as to IMPS' use of the mark MARCO POLO'S to identify “hotel reservation services” is identical to the issue litigated in the prior proceeding, namely whether IMPS used the mark MARCO POLO'S to identify “hotel services”.

Upon careful consideration of MPH M's motion, and resolving all reasonable inferences in IMPS' favor, we find that MPH M has not carried its burden of establishing the absence of any genuine issue of material fact. Specifically, the Board finds that there is a genuine issue of material fact regarding, at a minimum, whether “hotel services” encompass “hotel reservation services” so as to create the identity of issues necessary to apply the doctrine of collateral estoppel.

In view of the foregoing, respondent's motion for summary judgment is hereby denied.

Proceedings herein are resumed and respondent is allowed until thirty days from the mailing date stamped on this order to file an answer to the petition to cancel.

Discovery is open, and the close of discovery and trial dates are set as follows:

DISCOVERY to close: **November 1, 2002**

30-day testimony period for party in position of plaintiff to close: **January 30, 2003**

30-day testimony period for party in position of defendant to close: **March 31, 2003**

15-day rebuttal testimony period for plaintiff to close: **May 15, 2003**

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. [Trademark Rule 2.125](#).

*5 Briefs shall be filed in accordance with [Trademark Rule 2.128\(a\) and \(b\)](#). An oral hearing will be set only upon request filed as provided by [Trademark Rule 2.129](#).

1 Because the parties agree as to the close relationship and common interests of the two entities, and for the purposes of clarity in describing the intertwined proceedings, two related companies will be designated as IMPS. International Marco Polo Services, Inc., petitioner herein, is a successor to Marco Polo's International Marketing, Inc. (petition to cancel, par. 3) and related to Gemini, Inc. dba Lady Luck & Casino & Hotel, respondent in Cancellation No. 24,018. Both entities are under the common ownership and control of President Andrew H. Thompkins (petition to cancel, par. 6).

2 Application Serial No. 75/486,489 is presently in suspended status in Law Office 103.

3 The parties are reminded that evidence submitted in connection with a motion for summary judgment is of record only for purposes of that motion. *See* TBMP §528.05(a). If this case goes to trial, the summary judgment evidence will not form part of the evidentiary record to be considered at final hearing unless it is properly introduced in evidence during the appropriate trial period. *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).

2002 WL 1602493 (Trademark Tr. & App. Bd.)

Exhibit J

2003 WL 355736 (Trademark Tr. & App. Bd.)

DIPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

JET, INC.

v.

SEWAGE AERATION SYSTEMS

Cancellation No. 25,587

February 13, 2003

*1 Before Cissel, [Quinn](#) and [Hairston](#)
Administrative Trademark Judges

By the Board

This case now comes up on the following motions:

1. Respondent's motion (filed December 12, 2001) for summary judgment;
2. Petitioner's motion (filed December 13, 2001) to determine the sufficiency of responses to requests for admissions and to compel;
3. Respondent's consented motion (filed December 31, 2001) for an extension of time to file a response to petitioner's motion to compel;
4. Respondent's consented motion (filed February 5, 2002) for an extension of time to respond to petitioner's motion for summary judgment; and
5. Respondent's motion (filed February 8, 2002) to strike the declaration of Edward I. Condren.

Respondent's consented motions for an extension of time to file responses are granted. Respondent's motion to strike the declaration of Professor Condren is denied because petitioner maintains that its first contact with Professor Condren was on December 31, 2001 (after respondent had filed its summary judgment motion), petitioner supplemented its response (on January 29, 2002) to respondent's interrogatory seeking the identity of experts by identifying Professor Condren, and respondent has not demonstrated any prejudice caused by the testimony of Professor Condren.¹

Before turning to the remaining motions, i.e., the motion for summary judgment and the combined motion to determine the sufficiency of responses and to compel, we provide a brief description of the procedural history of this case.

On October 9, 1996, petitioner filed its petition to cancel, alleging that respondent's mark AEROB-A-JET registered as Registration No. 1,739,664,² is likely to be confused with Registration No. 727,404³ for the mark:



and Registration No. 881,991⁴ for the mark JET. In an answer (filed December 16, 1996), respondent denied the salient allegations of the petition to cancel and inter alia asserted an affirmative defense of collateral estoppel based on a prior judgment in a civil action.

On April 28, 1999, the Board granted respondent's motion to dismiss under the doctrine of res judicata in view of the Sixth Circuit's decision in *Jet, Inc. v. Sewage Aeration Systems*, 49 USPQ2d 1355 (6th Cir. 1999), which involved a claim of trademark infringement. [The Sixth Circuit upheld the District Court's finding of no likelihood of confusion between JET and AEROB-A-JET.] Petitioner appealed the Board's decision to the Federal Circuit, and on August 23, 2000, a majority panel of the Federal Circuit reversed and remanded the case to the Board for further proceedings. The Federal Circuit inter alia found that the Board based its decision on the doctrine of claim preclusion and concluded that “the overall transactional facts are simply too distinct to allow claim preclusion from an infringement action to bear on a subsequent cancellation claim.” The Federal Circuit therefore held that “an earlier infringement action does not bar, under the doctrine of claim preclusion, a later petition to cancel.” *Jet Inc. v. Sewage Aeration Systems*, 55 USPQ2d 1854 (Fed. Cir. 2000).

*2 However, the Federal Circuit also stated “the particular facts of certain cases may allow for the issue of issue preclusion to bar relitigation of the ‘likelihood of confusion’ question,” and offered the following:

Upon remand, the Board will have the opportunity to consider whether issue preclusion prevents the question of “likelihood of confusion” between the JET mark and AEROB-A-JET from being relitigated before the Board. The doctrine of issue preclusion (also sometimes known as “collateral estoppel”), which serves to bar the revisiting of “issues” that have been already fully litigated, requires four factors:

- (1) identity of the issues in a prior proceeding;
- (2) the issues were actually litigated;
- (3) the determination of the issues was necessary to the resulting judgment; and,
- (4) the party defending against preclusion had a full and fair opportunity to litigate the issues.

A reading of the Sixth Circuit's opinion reveals that “likelihood of confusion” between JET and AEROB-A-JET was actually litigated and necessary to the judgment, and that Jet had a full opportunity to present its arguments on the question. See *Jet*, 165 F.3d at 421-24, 49 USPQ2d at 1357-59 (discussing likelihood of confusion). With respect to factor (1) --whether the “likelihood of confusion” analysis in an infringement action is the same as that in a cancellation proceeding--we note that this circuit has held that even state court findings of fact relating to the likelihood of confusion between the same marks will allow issue preclusion to operate, if the issues are indeed identical.

Here, the Board will be free to consider whether the issue decided in the infringement litigation is sufficiently the same as that involved in the cancellation proceeding to determine that Jet should not now be allowed to relitigate the “likelihood of confusion” between JET and AEROB-A-JET.

We now turn to respondent's summary judgment motion, in which respondent maintains that “[t]he doctrine of issue preclusion applies and prevents Jet from now asserting likelihood of confusion between JET and AEROB-A-JET” and that summary judgment is appropriate between the marks JET AERATION and AEROB-A-JET based on an analysis of the relevant factors set forth in *In re E.I. Du Pont De Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).⁵ In arguing that issue preclusion applies here, respondent relies on the above-quoted “standard” articulated by the Federal Circuit, arguing that the Federal Circuit specifically stated that likelihood of confusion was “actually litigated and necessary to the judgment, and that Jet had a full opportunity to present its arguments on the question.” On the fourth factor noted by the Federal Circuit, i.e., the identity of issues in the prior proceeding and the present proceeding, respondent construes the Federal Circuit's decision as finding that the issue of likelihood of confusion between JET and AEROB-A-JET is identical in this proceeding and the prior proceeding; and that JET has admitted that “the issue of likelihood of confusion between the JET and AEROB-A-JET marks was actually litigated in the prior civil action.”

*3 With respect to petitioner's claim of likelihood of confusion between JET AERATION and AEROB-A-JET, respondent looks to several of the factors recited in *In re E.I. Du Pont De Nemours & Co.*, *supra*. Respondent maintains that the most relevant factor to consider is the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression; and that there is “a different commercial impression in the eyes of the ordinary purchaser.”

In response to respondent's arguments in favor of claim preclusion, petitioner argues:

There are two aspects to the determination of whether the ‘issues’ are in substance the same in both the federal court litigation and in this proceeding. First, the legal issues in both proceedings must be the same. Second the controlling facts must be identical in both.

Petitioner relies on the declaration of its president, David MacLauren,⁶ to first point out that the controlling facts are not identical in the two proceedings. Mr. MacLauren declares that at the time of the federal litigation, respondent marketed its AEROB-A-JET products for use in anaerobic septic tanks and septic systems,⁷ but after the litigation concluded, respondent began marketing its AEROB-A-JET products for use in “aerobic treatment systems.”⁸ He points out that his company “uses its Jet and Jet Aeration trademarks only on aerobic treatment systems and related products, and not for septic tanks and systems.” Second, Mr. MacLauren contends that since the litigation concluded, respondent “began using marketing materials to specifically market its products for use in Jet, Inc.'s plants.”⁹, ¹⁰ Third, Mr. MacLauren states that since the time of the previous litigation, “SAS has changed the way it uses its Aerob-A-Jet trademark ... [by] greatly expand[ing] its direct marketing to homeowners and business owners through use of a web site.”¹¹ Thus, petitioner concludes that while respondent previously “sold its aerators exclusively through a network of distributors and contractors who in turn recommended them to homeowners and other end users ... [respondent's] web site reflects an entirely new way of promoting its AEROB-A-JET products, directly to homeowners and other customers.”

Petitioner has also submitted a declaration from Sylvia Davis, an attorney representing petitioner in this case, who *inter alia* states that she “reviewed all of the documents produced by Registrant in relation to the previous federal litigation ... and the documents submitted by Registrant in this proceeding” and “found no references in Registrant's marketing materials produced at the time of the prior litigation promoting use of the AEROB-A-JET product with ‘aerobic treatment’ systems.” She also states that she “found no reference in those marketing materials to use of the AEROB-A-JET in Jet, Inc.'s aerobic treatment systems specifically.” Additionally, Ms. Davis states that respondent's

marketing materials produced in this proceeding and its web site materials “show that, since the close of the prior litigation, Registrant has expanded the marketing of its AEROB-A-JET product to use as a replacement part for ‘aerobic treatment’ systems, including the JET aerobic treatment system specifically.”¹² Petitioner also relies on (a) the testimony of Jerard Hoage, president of respondent, in his October 9, 2001 deposition, who inter alia testified that respondent's web site was created in 1999, and (b) copies of email messages directed to respondent from various individuals seeking information about the AEROB-A-JET product which, according to petitioner, “provide evidence of how non-expert homeowners are now relying on their own Internet research, in addition to recommendations of local contractors, in their decision-making process.”

*4 In view of the foregoing, petitioner concludes that “the development of the Internet and SAS's new marketing strategy that relies on that medium for direct marketing to end users have had a material impact on the level of sophistication and degree of care exercised by customers since the infringement litigation was concluded.”

Petitioner also argues that the legal issues are not identical in the two proceedings. Petitioner explains that the likelihood of confusion analysis in this cancellation action is different from the likelihood of confusion analysis in the infringement action. It astutely observes:

The likelihood of confusion legal analysis in a trademark infringement action necessarily focuses on how the marks at issue are actually being used in commerce. The likelihood of confusion analysis in a Board cancellation proceeding, on the other hand, may have to go beyond that in some cases, because a registration may cover a broader description of goods than were at issue in the federal litigation. Or, the type of marketing channels or customers may be important factors in a court's decision in an infringement action, whereas the registrant's registration does not contain any limitations in that regard, providing the registrant with rights that exceed those recognized by the court.

Petitioner concludes that “the way [petitioner] markets its AEROB-A-JET product” has changed since the time of the federal litigation.

With respect to respondent's arguments that there is no likelihood of confusion between JET AERATION and AEROB-A-JET, petitioner inter alia maintains that there “mere addition of the at-best descriptive term AERATION and the addition of a design, can only make the JET AERATION mark, as a whole, even more dissimilar from AEROB-A-JET.”

In reply, respondent inter alia challenges what it calls petitioner's “fiction of changed circumstances.” Respondent points out that “[t]he Sixth Circuit recognized that the parties' marks are used on goods in direct competition that are distributed in the same channels of trade” and concludes:

It is clear from the Sixth Circuit's decision that, as between JET and AEROB-A-JET, it matters not how similar the goods are or whether they are marketed to the same consumers in the same channels of trade. The marks JET and AEROB-A-JET themselves are simply too different in their overall commercial impressions for a reasonable jury to find a likelihood of confusion. As the Sixth Circuit concluded, “[c]onsidering the impression make [sic] by the marks as a whole, JET and AEROB-A-JET are not confusingly similar.” Nothing about the Internet or how Sewage Aeration Systems may or may not market its AEROB-A-JET product for use in “aerobic treatment plants” changes this.

We begin our consideration of the merits of respondent's motion by noting that respondent, as the party moving for summary judgment, has the burden of establishing the absence of any genuine issue of material fact and that it is entitled to judgment as a matter of law. See [Fed. R. Civ. P. 56](#). A genuine dispute with respect to a material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question in favor of the non-moving party. See [Opryland USA Inc. v. Great American Music Show, Inc.](#), 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts

as to whether any particular factual issues are genuinely in dispute must be resolved in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ 1542 (Fed. Cir. 1992).

Issue Preclusion - JET and AEROB-A-JET

*5 In determining whether issue preclusion applies in this case, we consider the four factors articulated by the Federal Circuit in the appeal of our grant of summary judgment in this case, namely,

- (1) identity of the issues in a prior proceeding;
- (2) the issues were actually litigated;
- (3) the determination of the issues was necessary to the resulting judgment; and,
- (4) the party defending against preclusion had a full and fair opportunity to litigate the issues.

Because the Federal Circuit has stated “‘likelihood of confusion’ between JET and AEROB-A-JET was actually litigated and necessary to the judgment, and that Jet had a full opportunity to present its arguments on the question,” we only address the first factor, i.e., whether there is an identity of issues in the two proceedings.

In this cancellation proceeding, we determine the issue of likelihood of confusion only as to the mark depicted in the registration for the goods identified therein, regardless of the context of actual usage. See *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* Section 32:98 (4th Ed. 2001). If there are no limitations or restrictions as to trade channels or classes of purchasers in either petitioner's or respondent's identification of goods, the Board presumes that the parties' respective goods are sold in all normal trade channels and to all normal classes of purchasers for such goods, regardless of what the evidence might show the parties' actual trade channels and classes of customers to be. See, e.g., *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). However, in an infringement action, the context of actual use of the marks is relevant and may be crucial. See *Jim Beam Brands Co. v. Beamish & Crawford Ltd.*, 937 F.2d 729 (2d Cir. 1991). Thus, the standards and factual inquiries by which likelihood of confusion is judged in a cancellation proceeding “can be different” from those in an infringement action. *Levy v. Kosher Overseers Association of America Inc.*, 104 F.3d 38, 41 USPQ2d 1456 (2d Cir. 1997).

To determine whether the issues are the same in the two proceedings, we look to whether the District Court considered all normal trade channels and all normal classes of purchasers for the goods in respondent's registration. The Sixth Circuit stated without explanation or discussion of the District Court's findings of fact that “it is clear from the record that both parties use similar marketing channels and that there is a possibility of overlap.” Because the Sixth Circuit has provided only limited information about the facts underlying its affirmance of the District Court's opinion, we look to what the District Court said in this regard.¹³

*6 The District Court, in defining the purchasing public, stated “the parties agree that their products are not sold directly to consuming homeowners in a typical transaction” and that “the products are sold to the regional distributors who in turn sell them to contractors and subcontractors.”¹⁴ Of course, because respondent's web site was not on line until 1999,¹⁵ the district court's opinions are silent regarding use of the web site -- accessible by homeowners -- as a part of respondent's marketing channels.

At the present time, however, respondent has a web site. We find support for petitioner's contention that homeowners are accessing the web site and communicating directly with respondent (a) in the emails that petitioner has included

with its response to the summary judgment motion,¹⁶ and (b) in the deposition testimony of Mr. Hoage, president of respondent. In particular, Mr. Hoage has testified as follows:

Q. Back to my question, then, though. Have you ever had a conversation with a homeowner regarding use of the retrofit kit?

A. Well, that's possible. I don't recall any specific homeowner that I could mention at this time.

Q. I'm not asking for names. I just want to know whether, in fact, you've ever talked to a homeowner regarding the retrofit kit.

A. I don't -- it's possible.

Q. Have you ever shipped the retrofit kit directly to a homeowner?

A. I suppose that's possible, if he's capable or he says he can install it. If he's capable of this excavation, and so forth, it's possible that he could have gotten one.

Q. Well, I'm asking, in fact, if you've ever shipped the retrofit kit directly to a homeowner.

A. I say it's possible.

We also note that the web site does not limit inquiries or sales to distributors, contractors or subcontractors, and does not refer homeowners who access the web site to distributors, contractors or subcontractors for the purchase of respondent's AEROB-A-JET products. And significantly, respondent does not challenge petitioner's contention that goods bearing the AEROB-A-JET mark are being marketed directly to homeowners through respondent's web site.¹⁷

As mentioned above, we must consider all normal trade channels and all normal classes of purchasers for respondent's goods, which at this time includes marketing through the web site. The evidence offered by petitioner persuades us that there is no genuine issue of material fact that homeowners do access the web site, and they do communicate directly with respondent about the purchase of an AEROB-A-JET product for home use. It follows, then, that homeowners are making purchasing decisions, even if in the typical transaction, they do not purchase an AEROB-A-JET product directly from respondent, but rather through distributors, contractors and subcontractors. [*N.b.*, Mr. Hoage has testified, "it's possible" that respondent has "shipped [a] retrofit kit directly to a homeowner."] Because the District Court and the Sixth Circuit did not consider respondent's web site as part of respondent's trade channels or that homeowners were making purchasing decisions themselves, we find that there is *not* an identity of issues in the infringement case and in this cancellation proceeding. Therefore, the doctrine of issue preclusion does not apply and does not prevent the question of likelihood of confusion between JET and AEROB-A-JET from being relitigated in this cancellation proceeding.¹⁸

*7 Petitioner has also argued that there has been a change of circumstances due to respondent's use of marketing materials to specifically market its products for use in petitioner's units and that respondent now promotes AEROB-A-JET products for use in aerobic treatment plants and systems. Because we have concluded that the issues in this proceeding are not identical to the issues in the infringement action, we need not address petitioner's arguments.

Du Pont Analysis - JET AERATION and AEROB-A-JET

We now turn to respondent's argument that there is no genuine issue of material fact that the marks AEROB-A-JET and JET AERATION, when used on the parties' respective goods, do not cause a likelihood of confusion. We have carefully considered the arguments and the evidence submitted by the parties. At a minimum, we find that there are

genuine issues of material fact regarding the similarity or dissimilarity of the commercial impressions of the marks, taken in their entirety.¹⁹

Thus, in view of the foregoing, we deny respondent's motion for summary judgment in its entirety.

We next turn to petitioner's combined motion to determine the sufficiency of certain responses to its requests for admissions and motion to compel. Specifically, petitioner complains that it has not received proper responses or answers to Requests for Admissions Nos. 3 and 4, Interrogatory Nos. 4 and 8 and Document Request No. 15. We address each request and interrogatory in turn below.

Requests for Admissions Nos. 3 and 4

Federal Rule 36(a) states that “[t]he matter is admitted unless ... the party to whom the request is directed serves ... a written answer or objection addressed to the matter ...”; that “[i]f objection is made; the reasons therefore shall be stated”; and that “[t]he answer shall specifically deny the matter or set forth in detail the reasons why the answering party cannot truthfully admit or deny the matter.”

Respondent has objected to the requests on the basis that they are ambiguous to the extent the requests seek to distinguish between “aerobic treatment plants” and “septic tanks” and has denied the requests. According to respondent, “[t]hese are not mutually exclusive, as an aerobic treatment plant could include a septic tank.” We find that respondent has complied with Federal Rule 36(a) by objecting to the requests on the ground of ambiguity and setting forth a denial. We will not substitute our judgment for respondent's judgment regarding the meaning of the terms “aerobic treatment plants” and “septic tanks.”

Interrogatory No. 4

Respondent maintains that “[u]pon reasonable investigation Registrant provided a responsive answer based upon the information presently available.” Because respondent represents that it made a “reasonable investigation,” we conclude that respondent's response is sufficient. See 8A Charles Alan Wright, Arthur R. Miller & Mary Kay Kane, *Federal Practice & Procedure: Civil* §2174 (2d ed. 1994)(“As a general rule a party in answering interrogatories must furnish information that is available to it and that can be given without undue labor and expense”; but “[i]n order to justify sustaining an objection to an interrogatory on this ground, it must be shown that the research required is unduly burdensome and oppressive.”)

Interrogatory No. 8 and Document Request No. 15

*8 As justification for the discovery sought by Interrogatory No. 8 and Document Request No. 15, petitioner states that it “seeks to demonstrate that the facts at issue in this litigation are different from those at issue in the prior litigation.” Because we have determined that the decision in the infringement action does not have issue preclusive effect in our proceeding, we do not grant petitioner the relief it requests.

In view of the above, petitioner's combined motion to determine the sufficiency of responses and motion to compel discovery is denied.

The testimony periods are reset as indicated below. In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. [Trademark Rule 2.125](#).

DISCOVERY TO CLOSE:

CLOSED

30-day testimony period for party in position of plaintiff to close: April 20, 2003

30-day testimony period for party in position of defendant to close: June 19, 2003

15-day rebuttal testimony period to close: August 3, 2003

Briefs shall be filed in accordance with [Trademark Rule 2.128\(a\) and \(b\)](#). An oral hearing will be set only upon request filed as provided by [Trademark Rule 2.129](#).

1 Petitioner points out that if respondent believed it was prejudiced by the testimony of Professor Condren, respondent could have sought to cure that prejudice by requesting additional time to respond to the motion for summary judgment to enable it to depose Professor Condren. We agree.

2 Registration No. 1,739,664 registered on December 15, 1992 in connection with “sewage aeration unit comprising an electric motor and electronic monitoring sensor to oxygen enrich sludge to enhance decomposition,” and claims first use and first use in commerce in January, 1971. The registration was renewed on February 4, 2003.

3 Registration No. 727,404 registered on February 13, 1962 in connection with “sewage treatment and disposal units for private residence and semipublic use,” and claims first use on August 1, 1955 and first use in commerce on March 8, 1956. The registration was renewed on January 31, 2002.

4 Registration No. 881,991 registered on December 9, 1969 in connection with “sewage treatment and disposal units, and parts thereof,” and claims first use on August 1, 1955 and first use in commerce on March 8, 1956. The registration was renewed on January 12, 2001.

5 The JET AERATION mark was not part of the district court proceeding, thus respondent does not rely on issue preclusion for its arguments regarding JET AERATION.

6 Ostensibly to establish his expertise in the field, Mr. MacLauren states, “I have ... remained with the company for ... forty-five years ... and have devoted my life to the business.”

7 In anaerobic treatment, “waste is not actively treated by any type of mechanical process. Instead, waste is slowly digested by naturally occurring bacteria.”

8 Aerobic treatment systems “actively treat the waste, using mechanical aerobic processes.” Petitioner’s systems “do not contain septic tanks or septic systems, and they are not referred to by those terms.”

9 JET and JET AERATION systems remain in use for more than twenty or twenty-five years. See McLauren Declaration at paragraph 13.

10 In support thereof, Mr. MacLauren has attached a copy of an undated “promotional piece” which states on p. 2:
Aerob-A-Jet Vacuum
Bubble Retrofit Kit
For: Jet
Norweco
Singular
Hoot
Concrete Tanks

11 Mr. MacLauren also stated that the printouts found at Exhibit 4 were from petitioner’s web site. They do not include the web address or the date on which they were printed. Because respondent has not contested the validity or authenticity of the printouts, we have considered them.

- 12 Due to this expansion in marketing, petitioner maintains that “several potential scenarios for confusion exist today that did not exist at the time of the prior litigation,” namely:
A homeowner installs a JET unit. Based on SAS's new marketing materials, she later decides to replace or supplement the JET aerator with an AEROB-A-JET aerator. The homeowner eventually sells the house to someone who is advised that this sewage is handled by a wastewater treatment system in his backyard. Later, problems arise with the unit and when he inspects the situation, he sees an AEROB-A-JET aerator installed in a JET unit. He assumes everything comes from the same manufacturer, since he has one unit, and he was not around when the original homeowner purchased the product. If the new homeowner is having an unfavorable experience with a failing wastewater treatment unit, he will form a negative impression of the JET unit, and he is more likely to choose another brand when it comes time to purchase a replacement.
A person buys a house and is informed by the seller that the house comes with a JET brand aerobic treatment plant for sewage, as part of a general discussion about the background of the home. Years later, the new homeowner determines that the plant's aerator is in need of replacement due to deteriorating performance with the passage of time. As more and more consumers are doing in recent years, she researches the issue on the Internet and finds SAS's web site touting the AEROB-A-JET aerator for use in aerobic treatment units. Since she recalls that she has a JET aerobic treatment system, she may believe that the AEROB-A-JET unit is sold by the same company that built her unit, and she may order the AEROB-A-JET aerator on that basis.
- 13 The parties, in their papers filed in connection with the summary judgment motion, did not include a copy of the District Court's opinions of November 22, 1996 or May 30, 1997. Thus, the Board initiated a phone conference with the parties on January 22, 2003 and requested a copy of the District Court's opinion. The May 30, 1997 opinion was provided to the Board on January 22, 2003 and the November 22, 1996 opinion was provided to the Board on January 27, 2003. The May 30, 1997 order incorporated the factual findings and legal conclusions contained in the November 22, 1996 opinion.
- 14 The district court's opinion of May 30, 1997 states that the parties provided the following stipulation of facts:
Plaintiff and Defendant both sell the products at issue in this lawsuit to regional distributors, who in turn sell them to contractors and subcontractors (e.g., plumbing contractors, concrete contractors, etc.). Only on rare occasion do Plaintiff and Defendant sell their products directly to homeowners.
The AEROB-A-JET product is normally sold by Defendant to distributors at a price of \$500. They are normally installed by a contractor or subcontractor at a cost that ranges between approximately \$800 to \$900. Plaintiff Jet Inc. normally sells its aerator to distributors at prices that range from \$359 to \$685. Plaintiff's aerator is normally installed at home as part of a complete system, [sic] including installation, will vary widely depending on the nature of the installation and the price charged by the independent in stalling [sic] contractor. The cost of the total installed system is approximately \$2,600 or higher.
From these stipulated facts, the court concluded:
First the parties agree that their products are not sold directly to consuming homeowners in a typical transaction. Rather these products are sold to the regional distributors who in turn sell them to contractors and subcontractors. *Thus the purchasers consist of skilled consumers.* (Emphasis added.)
- 15 In respondent's verified response to Interrogatory No. 10 of petitioner's second set of interrogatories, respondent states that “[t]he website first went online approximately February 9 of 1999.”
- 16 Representative samples of the emails received by respondent are as follows:
1. From David Meiners (dated October 31, 2000): “I have an existing home jet pump system. The original aerobic motor and control were made by Jet Aeration of Cleveland, Ohio. The motor is their model 660. Can I replace it with you [sic] model 100?”
2. From Gerald Kordelski (dated October 10, 2000): “I currently have a 1200 gallon ‘Jet Aeration System’ which uses an aspirator tube on the shaft of a 1/3 hp electric motor to provide oxygen for the aerobic digestion of wastes. ... Given the size of this tank, how does your Model 100 compare to this & does the State of Ohio Health Department consider it an acceptable alternative for the typical aeration motor?? Also provide me with a cost break down of your products (Model 100, all-weather housing, self-monitoring controller, & basic GFI controller. Thank you for your consideration.”
3. From John Storpe (dated May 28, 2001): “I am interested in purchasing your system for my home septic system. I currently use a Jet Aeration system and plan to replace it. I will be using the same tank, but would like to replace the motor and aeration system with your system. Please send me any recommendations you have as to which model would be most suited for this. Availability in my area or if I should order directly from you. Any additional information you may need to assure I purchase the proper unit. I will be installing this unit my self [sic]. Tank and power are already installed. Please include prices with recommendations. My Jet Aeration Unit is DOWN! So I will be needing this unit SOON!”

- 17 Rather, respondent maintains in its reply that “it matters not how similar the goods are or whether they are marketed to the same consumers in the same channels of trade,” noting that the Sixth Circuit concluded that “[c]onsidering the impression made by the marks as a whole, JET and AEROB-A-JET are not confusingly similar.” Respondent adds that “[n]othing about the Internet or how Sewage Aeration Systems may or may not market its AEROB-A-JET product for use in ‘aerobic treatment plants’ changes this.” We disagree. If homeowners are now making purchasing decisions using respondent’s web site, at a minimum it would appear that the level of purchaser care is different. Of course, this affects the likelihood of confusion analysis.
- 18 This decision is interlocutory in nature. Thus, an appeal may not be taken until after a final decision in this case issues. See *Copelands’ Enterprises Inc. v. CNV Inc.*, 887 F.2d 1065, 12 USPQ2d 1562 (Fed. Cir. 1989).
- 19 The fact that we have identified and discussed only a few genuine issues of material fact as sufficient bases for denying the motion for summary judgment should not be construed as a finding that these issues are necessarily the only issues which remain for trial.

2003 WL 355736 (Trademark Tr. & App. Bd.)

Exhibit K

2014 WL 2159248 (Trademark Tr. & App. Bd.)

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

CLEVELAND STATE UNIVERSITY

v.

CAMPUSEAI CONSORTIUM

Cancellation No. 92053509

May 5, 2014

*1 [Jude A. Fry](#) and [Colleen F. Goss](#) of Fay Sharpe LLP for Cleveland State University
[Michael C. DeJohn](#) for CampusEAI Consortium

Before [Lykos](#), Adlin and Hightower

Administrative Trademark Judges

Opinion by Adlin

Administrative Trademark Judge:

CampusEAI Consortium (“respondent”) owns a Supplemental Register registration for the mark UNIVERSITY OF CLEVELAND, in standard characters and with UNIVERSITY disclaimed, for “educational services, namely, providing seminars, workshops, classes, and lecture in the fields of postsecondary and higher education in the field of information technology” in International Class 41 (the “Registration”).¹ In its second amended petition to cancel the Registration, Cleveland State University (“petitioner”) alleges prior use and registration of: (1) the mark CLEVELAND STATE UNIVERSITY, in standard characters, with STATE UNIVERSITY disclaimed and a claim of acquired distinctiveness as to the entire mark under Section 2(f); and (2) the mark shown below



also with STATE UNIVERSITY disclaimed, and a claim of acquired distinctiveness as to CLEVELAND STATE UNIVERSITY 1964. Both marks are registered for “... educational services, namely, providing courses at the undergraduate and graduate university level and distributing course material therewith”² As grounds for cancellation, petitioner alleges that use of respondent's mark in connection with respondent's services would be likely to cause confusion with, and dilute, petitioner's marks, and that respondent has abandoned the mark in its Registration. In its answer, respondent denies the salient allegations in the second amended petition for cancellation, and asserts several affirmative defenses which it failed to pursue or prove and which are therefore waived and will be given no further

consideration. *Miller v. Miller*, 105 USPQ2d 1615, 1616 n.3 (TTAB 2013); *Baroness Small Estates Inc. v. American Wine Trade Inc.*, 104 USPQ2d 1224, 1225 n.2 (TTAB 2012).

The Record

The record consists of the pleadings; the file of the involved Registration; petitioner's notice of reliance ("NOR") (TTABVue Dkt. # 18) on Internet printouts and respondent's responses to petitioner's interrogatories, document requests and requests for admission; and the testimonial deposition of Robert Spademan (TTABVue Dkt. #'s 19-21), petitioner's Assistant Vice-President-Marketing ("Spademan Tr.") and the exhibits thereto.

*2 Respondent took no testimony and submitted no evidence.³ Both parties filed trial briefs but respondent's was 35 days late and in its order of February 13, 2014 the Board denied respondent's motion to reopen its time to file its brief. We have therefore not considered respondent's trial brief, but point out that even if we had, the brief would not have changed the outcome because respondent introduced no evidence and its brief is therefore necessarily comprised of mere argument.

Standing

Petitioner made its pleaded registrations of record by attaching to its second amended petition for cancellation printouts obtained from the Office's TARR database showing the registrations' current status and title. Trademark Rule 2.122(d) (1). The registrations establish petitioner's standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000).

Abandonment

The Trademark Act provides for the cancellation of a registration if the registered mark has been abandoned. See Section 14 of the Trademark Act, 15 U.S.C. §1064. Under Section 45 of the Act, 15 U.S.C. §1127, a mark is considered abandoned when "its use has been discontinued with intent not to resume such use," and "[n]onuse for 3 consecutive years shall be prima facie evidence of abandonment." That is, "[i]f plaintiff can show three consecutive years of nonuse, it has established a *prima facie* showing of abandonment, creating a rebuttable presumption that the registrant has abandoned the mark without intent to resume use." *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036, 1042 (TTAB 2012). Furthermore, "[u]se' of a mark means the bona fide use of such mark made in the ordinary course of trade, and not merely to reserve a right in a mark." 15 U.S.C. §1127.

Because registrations are presumed valid under the law, a party seeking to cancel a registration on the ground of abandonment bears the burden of proof to establish its case by a preponderance of the evidence. See *On-Line Careline, Inc. v. America Online, Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1476 (Fed. Cir. 2000); and *Cerveceria Centroamericana, S.A. v. Cerveceria India, Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989). If petitioner makes a *prima facie* case of abandonment, the burden of production, i.e., of going forward, then shifts to the respondent to rebut the *prima facie* showing with evidence. *Id.* "The burden of persuasion remains with the plaintiff to prove abandonment by a preponderance of the evidence." *ShutEmDown Sports*, 102 USPQ2d at 1042.

*3 Here, petitioner's abandonment claim is based on respondent's responses to petitioner's written discovery requests, stating that respondent has no:

- documents related to the use of its involved mark in association with its services;
- documents bearing its mark which relate to its services and which are viewed by customers or prospective customers;
- documents related to the marketing, advertising, offer of sale, use and/or promotion of services offered under its mark;

- advertisements, promotional materials, packaging, labeling or other materials or documents related to its involved mark;
- invoices for sales of services sold under its involved mark;
- documents that report on, describe, refer to, and/or relate to respondent's use of its involved mark;
- documents it will rely upon to establish use of its mark in the United States;
- documents showing respondent's annual advertising, marketing, and promotional expenses for services related to its involved mark;
- contracts, agreements, licenses or consents related to its involved mark, or documents related thereto;
- documents concerning quality control exercised by respondent over the use of its involved mark by third parties;
- documents identifying providers of services on respondent's behalf under the involved mark;
- documents identifying recipients of services by or on behalf of respondent under its involved mark; or
- documents which refer to or reflect any research, trademark maintenance program, advertising campaign, Internet strategy, and/or marketing program for respondent's services bearing respondent's mark.

In addition, respondent's total revenues for services offered under its involved mark are “0,” and those services have only been offered in India. Petitioner's NOR Ex. A (Responses to Interrogatory Nos. 11 and 13) and B (Responses to Document Request Nos. 2, 3, 5, 8, 12, 13, 16, 20, 22, 23, 29, 30 and 34).

This evidence establishes a *prima facie* case of abandonment. Indeed, respondent filed the involved application on October 16, 2008, which is over five years ago, and respondent effectively concedes that it has no documents since that date (and at trial introduced no documents at all) related to its use or marketing of its mark, offers for sale under its mark or materials bearing the mark which were viewed by customers or potential customers. Respondent also concedes that it has no documents identifying providers or recipients of services offered under the involved mark. It has no invoices, which is consistent with it having no revenue for services offered under the involved mark. Respondent indicates that its services have only been offered in India, which, standing alone, effectively means that respondent has not offered its services in the United States. These facts establish that for at least the past three years, respondent has not used its mark for the identified services.

*4 Indeed, this case is in many ways similar to *ShutEmDown Sports*. There, the respondent owned a registration for 113 items of clothing, 109 of which it admitted to never offering under the mark. With respect to the remaining four items of clothing which respondent claimed to offer (in contrast to respondent in this case, which has not introduced any evidence of use whatsoever), respondent claimed to have spent “\$200+” annually on promotion, and to have annual sales of “\$100.” However, “respondent kept no documents” relating to his alleged operating expenses and had no documents relating to his sales, and respondent “does not have a bank account; has no tax returns; did not keep copies of sales receipts, invoices and/or bills of service for goods using the mark for the last three years; has no sales documents used in selling or distributing goods; has no copies of any advertisements or promotional materials or other media advertising.” *ShutEmDown Sports*, 102 USPQ2d at 1041. As a result, despite respondent's claim to have sold four items identified in his registration, the Board found that petitioner had established a *prima facie* case of abandonment.

As there, we find here that petitioner has established a *prima facie* case of abandonment. *Id.* at 1043. In short, respondent's lack of any revenue, of even a claim to having used its mark in the United States and of any documents or testimony relating to use or promotion of the involved mark establish that the mark has not been used for at least three years. And we find that respondent, who like the respondent in *ShutEmDown Sports* introduced no testimony or other evidence, has not rebutted petitioner's *prima facie* case. In fact, as in *ShutEmDown Sports*, respondent in this case “did not provide a shred of evidence to corroborate his alleged use of the mark in commerce.” *Id.* And as in *ShutEmDown Sports*, respondent's “uncorroborated interrogatory responses that he used the mark,” albeit in this case only in India, “are insufficient to rebut the presumption of abandonment resulting from the lack of any advertising, sales, or customers” *Id.*

In the December 20, 2012 order which denied petitioner's motion for summary judgment on its abandonment claim, we noted that *petitioner* introduced two documents which respondent produced during discovery, “each of which consists of a Memorandum of Understanding between a college located in India and Campus EAI, the exclusive vendor of respondent, for the provision of information technology training on different short term courses and information technology related programs to be delivered by the faculty appointed by respondent.” December 20, 2012 order at 8. We found on summary judgment that the documents “appear to demonstrate use of respondent's mark in commerce, i.e., the provision of educational services between a U.S. entity and a foreign country by way of an exclusive vendor, and inasmuch as these documents conflict with respondent's other discovery responses evidencing apparent non-use of respondent's mark,” there was a genuine dispute of material fact sufficient to deny summary judgment. *Id.* at 8-9.

*5 These two documents do not rebut petitioner's *prima facie* case, for two reasons. First, it is settled that evidence submitted in connection with a motion for summary judgment is of record only for consideration of that motion, and to be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. See *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1465 n.2 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911, 913 n.4 (TTAB (1983); *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712, 716 n.2 (TTAB 1981). Here, the documents were not introduced into evidence during the trial, are not of record and may not be considered.⁴ Second, the standards applicable to motions for summary judgment are quite different from the standards applicable to evaluating evidence properly introduced at trial. On summary judgment, “[i]ssues of fact are not to be tried ... rather, all that is to be determined is whether issues of fact exist which should be tried.” *Dyneer Corp. v. Automotive Products plc*, 37 USPQ2d 1251, 1254 (TTAB 1995). Moreover, “all doubts as to whether or not particular factual issues are genuinely in dispute must be resolved against the moving party and, similarly, all inferences to be drawn from the undisputed facts must be viewed in the light most favorable to the nonmoving party.” *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1389 (TTAB 1994). At trial, we must evaluate the evidence differently. In fact, even if respondent had introduced the documents at trial, which it did not, there is no testimony or other evidence establishing the nature, scope or location of any use of the involved mark, much less any evidence establishing whether or when respondent itself or any party acting on respondent's behalf used the involved mark for the services identified in the Registration. While the documents themselves were found sufficient to defeat petitioner's motion for summary judgment, without any accompanying explanatory evidence they would not be sufficient, even if of record, to overcome petitioner's *prima facie* case. It is one thing to establish the existence of a genuine dispute of material fact sufficient to deny summary judgment, and quite another to rebut a *prima facie* case of abandonment at trial. Rebutting a *prima facie* case of abandonment at trial is simply impossible without any evidence of record, as in this case.

Conclusion

Petitioner has established a *prima facie* case of abandonment by establishing that respondent has not used the involved mark for at least three years. Having failed to take any testimony or to submit any other evidence, respondent is unable to rebut petitioner's *prima facie* case.

***6 Decision:** The petition to cancel is granted on the ground of abandonment. Registration No. 3735435 will be cancelled in due course.⁵

1 Supplemental Register Registration No. 3735435, issued January 5, 2010 from an application filed October 16, 2008 and amended to allege first use dates of September 20, 2005.

2 Registration Nos. 3671697, issued August 25, 2009 from an application filed June 18, 2008, and 3694718, issued October 13, 2009 from an application filed June 19, 2008, respectively. The identification of services for both registrations, in its entirety, is: “lending libraries; publication of books; publication of electronic books and journals on-line; educational services, namely, providing courses at the undergraduate and graduate university level and distributing course material therewith; extension, continuing and community educational services, namely, conducting classes, public lectures, workshops, seminars, conferences and exhibitions in the fields of engineering, law, business, arts and humanities, natural and physical sciences, architecture, journalism, education, international and public affairs, public health, social work, behavioral sciences, and mathematics and distributing course material therewith; educational research; entertainment services, namely, arranging and conducting athletic events and tournaments, exhibitions, conferences, live performances and festivals.”

3 In its December 20, 2012 order, the Board sanctioned respondent for violating a prior order relating to discovery. Pursuant to the sanctions order, petitioner was permitted to introduce by notice of reliance alone documents produced by respondent during discovery. In addition, respondent was required to “advise petitioner in writing” in the event it had no documents responsive to petitioner's document requests and respondent was precluded from introducing or relying on information or documents requested in discovery but not produced as required by the sanctions order. Petitioner does not rely on any documents which respondent produced during discovery, but we will consider responses to petitioner's document requests which indicate that respondent does not have any documents responsive to particular requests.

4 Petitioner did not have the opportunity to cross-examine any witnesses about the documents at the summary judgment stage. [American Meat Institute, 211 USPQ at 716 n.2.](#)

5 Having granted the petition to cancel, there is no need to consider petitioner's claims of priority and likelihood of confusion or dilution.

2014 WL 2159248 (Trademark Tr. & App. Bd.)