

This Opinion Is Not a  
Precedent of the TTAB

Mailed: October 23, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Allergan, Inc.*

*v.*

*Gems Style Inc.*  
—————

Opposition No. 91241842  
—————

Kenneth L. Wilton and Lauren M. Gregory of Seyfarth Shaw LLP  
for Allergan, Inc.

Gems Style Inc., pro se.  
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Before Cataldo, Bergsman and Heasley, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Gems Style Inc. (Applicant) seeks registration on the Principal Register of the mark GS GEMS STYLE HAIR BOTOX, in standard character form, for the goods listed below:

Hair care kits comprising non-medicated hair care preparations; Non-medicated hair straightening preparations; Non-medicated hair shampoos and conditioners; Non-medicated hair coloring preparations; Non-medicated hair spray and hair gels; Non-medicated hair lotions; Non-medicated hair oil; Non-medicated hair conditioners; Non-medicated hair restoration lotions; Non-

medicated hair treatment preparations for cosmetic purposes, in International Class 3.<sup>1</sup>

Applicant disclaims the exclusive right to use “Style Hair Botox.”

Allergan, Inc. (Opposer) opposed registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark for hair care preparations so resembles Opposer’s registered mark BOTOX, in typed drawing form, for the goods listed below as to be likely to cause confusion:<sup>2</sup>

- “Pharmaceutical preparations, namely, ophthalmic muscle relaxants,” in Class 5;<sup>3</sup>

- “Pharmaceutical preparations for the treatment of neurological disorders,” in Class 5;<sup>4</sup> and

- “Pharmaceutical preparations for the treatment of neurological disorders, muscle dystonias, smooth muscle disorders, autonomic nerve disorders, headaches, wrinkles, hyperhidrosis, sports injuries, cerebral palsy, spasms, tremors and pain,” in International Class 5.<sup>5</sup>

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<sup>1</sup> Serial No. 87681252, filed November 12, 2017, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s claim of first use of the mark anywhere and in commerce as of May 1, 2014.

<sup>2</sup> Effective November 2, 2003, Trademark Rule 2.52, 37 C.F.R. § 2.52, was amended to replace the term “typed” drawing with “standard character” drawing. A typed mark is the legal equivalent of a standard character mark. See *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012) (“until 2003, ‘standard character’ marks formerly were known as ‘typed’ marks.”).

<sup>3</sup> Registration No. 1692384, registered June 9, 1992; second renewal.

<sup>4</sup> Registration No. 1709160, registered August 18, 1992; second renewal.

<sup>5</sup> Registration No. 2510675, registered November 20, 2001; renewed.

In addition, Opposer pleaded Applicant's mark is likely to dilute the distinctiveness of Opposer's "famous BOTOX® Mark" under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c).

Applicant, in its Answer, admitted Opposer's mark "has become famous."<sup>6</sup> Applicant denied the remaining salient allegations in the Notice of Opposition. Applicant also asserted purported affirmative defenses that are actually amplifications of why there is no likelihood of confusion or dilution.

#### I. Preliminary Issue

Applicant, in some of its notices of reliance, includes extended argument as to the probative value of the evidence it introduced. *See* 27-30 and 32-37 TTABVUE.<sup>7</sup> Trademark Rule 2.122(g), 37 C.F.R. § 2.122(g), provides that for "evidence offered by notice of reliance, the notice must indicate generally the relevance of the evidence and associate with one or more issues in the proceeding." Essentially, a notice of reliance is a cover sheet for evidence, notifying opposing parties that the offering party intends to rely on the material introduced thereunder. TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 704.02 (2020). A notice of reliance is not a vehicle to discuss the probative value of the evidence.

The brief is a party's opportunity to present, in a systematic and coherent manner, and in a form which is permanent and can be referred to, a discussion of the facts

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<sup>6</sup> Applicant's Answer ¶4 (5 TTABVUE 2) ("Applicant admits the allegations contained in Paragraphs 1, 2, 3, 4, and 5.").

<sup>7</sup> Citations to the briefs refer to TTABVUE, the Board's online docketing system. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). Specifically, the number preceding TTABVUE corresponds to the docket entry number, and any number(s) following TTABVUE refer to the page number(s) of the docket entry where the cited materials appear.

in light of the law, its strongest affirmative arguments, and a rebuttal of adversary's arguments.

TBMP § 801.01. Accordingly, we have not considered the extended arguments regarding the probative value of Applicant's evidence set forth in Applicant's notices of reliance. Notices of reliance may not be used to avoid the page limitations for briefs. *Cf. Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1705-1753-54 (TTAB 2013) (appendices may not be used as a subterfuge to avoid the page limitation), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.).

In addition, Applicant, in its brief, referred to its pretrial disclosure identifying nine licensed hair stylists "who could testify about Applicant's mark in case it was necessary."<sup>8</sup> Because Applicant did not introduce any testimony from those potential witnesses, there is no testimony on which Applicant may rely.

Along the same line, Applicant, in its brief, referred to Applicant's responses to Opposer's interrogatory Nos. 1 and 2.<sup>9</sup> Because Opposer did not introduce Applicant's responses to Opposer's interrogatories into evidence during Opposer's testimony period, those interrogatory responses are not in the record for us to consider.

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<sup>8</sup> Applicant's Brief, pp. 23-24 (43 TTABVUE 24-25).

<sup>9</sup> Applicant's Brief, pp. 24-26 (43 TTABVUE 25-26). Ordinarily, only an inquiring party may introduce into the record an answer to an interrogatory. *See* Trademark Rule 2.120(k)(5), 35 C.F.R. § 2.120(k)(5) ("Written disclosures, an answer to an interrogatory, or an admission to a request for admission, may be submitted and made part of the record only by the receiving or inquiring party...."). Therefore, it would have been improper for Applicant to introduce its responses to Opposer's interrogatories.

## II. The Record

The record includes the pleadings, and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Applicant's application for the mark GS GEMS STYLE HAIR BOTOX. In addition, the parties introduced the evidence listed below:

- A. Opposer's testimony and evidence.
  - 1. Testimony declaration of Colleen McKenna, Opposer's Vice President of Marketing, Facial Aesthetics;<sup>10</sup>
  - 2. Notice of reliance on excerpts from 20 third-party websites showing the third parties rendering hair care services and cosmetic medical treatment services, including BOTOX injections;<sup>11</sup>
  - 3. Notice of reliance on a copy of Applicant's Serial No. 87519959 for the mark BOTOX for hair care preparations;<sup>12</sup>
  - 4. Rebuttal notice of reliance on 60 third-party registrations for marks registered for both hair care preparations and pharmaceuticals;<sup>13</sup> and
  - 5. Rebuttal notice of reliance on Internet websites of third-party retailers that sell both hair care preparations and prescription pharmaceuticals.<sup>14</sup>
- B. Applicant's evidence.
  - 1. Notice of reliance on a copy of Opposer's abandoned application Serial No. 79002971 for the mark BOTOX for cosmetics, in International Class 3, and excerpts from three applications filed by Applicant;<sup>15</sup>
  - 2. Notice of reliance on Internet materials purporting to show the number of hair salons in the United States;<sup>16</sup>

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<sup>10</sup> 20 TTABVUE.

<sup>11</sup> 21 TTABVUE.

<sup>12</sup> 22 TTABVUE.

<sup>13</sup> 39 TTABVUE.

<sup>14</sup> 40 TTABVUE.

<sup>15</sup> 25 TTABVUE. Applicant did not have to introduce excerpts from Serial No. 87681252 the subject application because, as noted above, the application is automatically of record.

<sup>16</sup> 26 TTABVUE.

3. Notice of reliance on excerpts from the Code of Federal Regulations and the United States Code purporting to show that the third parties in Opposer's notice of reliance, supra, are not rendering their services in lawful commerce;<sup>17</sup>
4. Notice of reliance on excerpts from eight websites purportedly to show that hair stylists must obtain a state license to render their services;<sup>18</sup>
5. Notice of reliance on additional website excerpts from the 20 third-parties introduced by Opposer, as well as seven more, purportedly to show that hair salon services and medical spa services are separate and distinct operations;<sup>19</sup>
6. Notice of reliance on excerpts from eBay.com, the California State Board of Barbering and Cosmetology Act and Regulations, the Florida Board of Cosmetology Act, and FDA.gov purportedly to show that the goods of the parties are not related;<sup>20</sup>
7. Notice of reliance on excerpts from eBay.com and Amazon.com purportedly displaying Applicant's house mark to show that the parties' marks are not similar;<sup>21</sup>
8. Notice of reliance on Internet materials purportedly to show that Opposer's goods are expensive and Opposer's customers are sophisticated;<sup>22</sup>

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<sup>17</sup> 27 TTABVUE.

<sup>18</sup> 28 TTABVUE.

<sup>19</sup> 29 TTABVUE. Many of the excerpts in this notice of reliance are illegible. Trademark Rule 2.126(a)(2), 37 C.F.R. § 2.126(a)(2), provides that exhibits must be clear and legible. *See also RxD Media, LLC v. IP Application Dev. LLC*, 125 USPQ2d 1801, 1806 n.16 (TTAB 2018) ("Illegible evidence given no consideration."), *aff'd*, 377 F.Supp.3d 588 (E.D. Va. 2019), *appeal filed*, No. 19-1461 (4th Cir. Apr. 30, 2019); *Alcatraz Media*, 107 USPQ2d at 1753 n.6 (citing *Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1404 (TTAB 1998) ("It is reasonable to assume that it is opposer's responsibility to review the documents it submits as evidence to ensure that such submissions meet certain basic requirements, such as that they are legible.")). We will consider the exhibits in this notice of reliance if we can read them.

<sup>20</sup> 30 TTABVUE.

<sup>21</sup> 31 TTABVUE.

<sup>22</sup> 32 TTABVUE. Applicant also introduced a copy of the testimony declaration of Colleen McKenna. Applicant did not need to introduce the McKenna testimony declaration again because it was already of record. "When evidence has been made of record by one party in

9. Notice of reliance on Internet websites referring to “Hair Botox”;<sup>23</sup>
10. Notice of reliance on excerpts from eBay.com and Amazon.com, and Applicant’s Registration No. 5690042 for the mark GS GEMS STYLE, in standard character form, and Registration No. 5918975 for the stylized mark GS GEMS STYLE both for hair care preparations purportedly to show that the parties marks are not similar;<sup>24</sup>
11. Notice of reliance on Internet materials purportedly to show that the parties’ description of goods differ;<sup>25</sup>
12. Notice of reliance on Internet materials purportedly to show that parties’ products are offered in different channels of trade;<sup>26</sup>
13. Notice of reliance on Internet materials purportedly to show the consumers for Opposer’s products exercise a high degree of purchasing care;<sup>27</sup> and
14. Notice of reliance on documents filed in this proceeding purportedly to show that Opposer failed to prove there is a likelihood of confusion.<sup>28</sup>

### III. Entitlement to a Statutory Cause of Action<sup>29</sup>

To establish entitlement to a statutory cause of action under Sections 13 or 14 of the Trademark Act, a plaintiff must demonstrate a real interest in the proceeding and a reasonable belief of damage. *Australian Therapeutic Supplies Pty. Ltd. v.*

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accordance with these rules, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.” Trademark Rule 2.122(a), 37 C.F.R. § 2.122(a).

<sup>23</sup> 33 TTABVUE.

<sup>24</sup> 34 TTABVUE.

<sup>25</sup> 35 TTABVUE

<sup>26</sup> 36 TTABVUE.

<sup>27</sup> 37 TTABVUE.

<sup>28</sup> 38 TTABVUE.

<sup>29</sup> Our decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063-64, under the rubric of “standing.” Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 remain applicable.

*Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 at \*3 (Fed. Cir. 2020); *see also Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058 (Fed. Cir. 2014); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727 (Fed. Cir. 2012); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999).

Opposer established its entitlement to a statutory cause of action by properly introducing into evidence its pleaded registrations showing the status of the registrations and their title in Opposer.<sup>30</sup> *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (plaintiff's two prior registrations suffice to establish plaintiff's direct commercial interest and its standing); *N.Y. Yankees P'ship v. IET Prods. & Servs., Inc.*, 114 USPQ2d 1497, 1501 (TTAB 2015). Applicant, in its brief, did not challenge Opposer's entitlement to a statutory cause of action.

#### IV. Priority

Because Opposer's pleaded registrations are of record, and Applicant did not file a counterclaim to cancel the pleaded registrations, priority in the opposition proceeding is not at issue with respect to the marks and goods identified therein. *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1469 (TTAB 2016) (citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)).

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<sup>30</sup> Opposer attached to the Notice of Opposition copies of its pleaded registrations printed from the Trademark Status and Document Retrieval (TSDR) system showing the status of and title to the registrations. 1 TTABVUE 10-15.

V. Likelihood of Confusion

We base our determination under Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). “In discharging this duty, the thirteen *DuPont* factors ‘must be considered’ ‘when [they] are of record.’” *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019), quoting *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997) and *DuPont*, 177 USPQ at 567. “Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018), quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010). See also *M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”).

“Each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. See *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004);

*Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). See also *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

- A. The strength of Opposer’s BOTOX mark, including the fame of Opposer’s mark and the number and nature of similar marks in use on similar goods and services.

Opposer alleges that its BOTOX mark is famous<sup>31</sup> and argues in its brief that its mark is famous.<sup>32</sup> Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

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<sup>31</sup> Notice of Opposition ¶¶4 and 13 (1 TTABVUE 5-7).

<sup>32</sup> Opposer’s Brief, pp. 1-2, 6-7, and 12-15 (41 TTABVUE 10-11, 15-16, and 21-24). As noted above, Applicant, in its Answer, admitted Opposer’s mark is famous. Applicant’s Answer ¶4 (5 TTABVUE 2).

Fame, the fifth *DuPont* factor, enables Opposer to expand the scope of protection afforded its pleaded marks by adducing evidence of “[t]he fame of the prior mark (sales, advertising, length of use).” Under the fifth factor, likelihood of confusion fame is not “an all-or-nothing measure.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (Fed. Cir. 2017). It “varies along a spectrum from very strong to very weak.” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003)).

To determine a mark’s place on the spectrum of from very strong to very weak, we consider its inherent or conceptual strength, based on the nature of the mark itself, and its commercial strength, based on its marketplace recognition. See *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength.”); *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017); *Top Tobacco, L.P. v. N. Atl. Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006) (market strength is the extent to which the relevant public recognizes a mark as denoting a single source); J.T. McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:80 (5th ed. Sept. 2020 update) (“The first enquiry is for conceptual strength and focuses on the inherent

potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another's use.”).

We may measure commercial strength (or fame) indirectly, by volume of sales and advertising expenditures and factors such as length of use of the mark, widespread critical assessments, notice by independent sources of the goods or services identified by the mark, and general reputation of the goods or services. *Weider Publ'ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1354 (TTAB 2014).

1. The inherent or conceptual strength of Opposer's BOTOX mark.

The RANDOM HOUSE UNABRIDGED DICTIONARY (2020) defines the word “Botox” as a trademark for “a purified form of botulinum, a neurotoxin causing botulism, injected in minute amounts especially to treat muscle spasms and relax facial muscles in order to reduce wrinkles.”<sup>33</sup> Thus, BOTOX is a coined term with no recognized meaning other than as a trademark and, therefore, it is an inherently or conceptually strong mark. *See Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 71 USPQ2d 1173, 1181 (Fed. Cir. 2004) (defining a fanciful mark as “a non-dictionary word concocted by the trademark holder for its product” and observing that such marks are typically strong); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1741 (TTAB 2014) (“Whether AKEA is a coined term or a

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<sup>33</sup> Dictionary.com accessed October 19, 2020. *See also* Merriam-Webster.com (a trademark “used for a preparation of botulinum toxin.”). The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *In re S. Malhotra & Co. AG*, 128 USPQ2d 1100, 1104 n.9 (TTAB 2018); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

Sardinian greeting, it is an inherently strong mark.”); *In re Ginc UK Ltd.* , 90 USPQ2d 1472, 1479 (TTAB 2007) (completely unique and arbitrary, if not coined, nature of mark in relation to goods entitles the registered mark to a broad scope of protection, and significantly increases the likelihood that the marks, when used in connection with the identical goods would cause confusion).

## 2. Commercial strength

At the outset of our analysis of the commercial strength of the BOTOX trademark, we note that the two dictionaries cited above identified BOTOX as a trademark. “When a trademark attains dictionary recognition as part of the language, we take it to be reasonably famous.” *B.V.D. Licensing Corp. v. Body Action Design, Inc.*, 846 F.2d 727, 6 USPQ2d 1719, 1720 (Fed. Cir. 1988). *See also B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1506 (TTAB 2007) (same).

Opposer introduced the evidence summarized below to establish the commercial strength of the BOTOX trademark:

- Opposer began using BOTOX to identify an injectable form of botulinum toxin at least as early 1990 and has continuously used it to identify various therapeutic applications;<sup>34</sup>
- Shortly after April 2002, Opposer began using its BOTOX injectable form of botulinum toxin to treat wrinkles and lines commonly referred to as frown lines;<sup>35</sup>

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<sup>34</sup> McKenna Testimony Decl. ¶¶5-7 (20 TTABVUE 3-4).

<sup>35</sup> McKenna Testimony Decl. ¶¶9 and 15 (20 TTABVUE 4-5).

- In 2013, the FDA approved BOTOX for treating “crow’s feet”;<sup>36</sup>
- In 2018, the FDA approved BOTOX for treating wrinkles across a person’s forehead;<sup>37</sup>
- BOTOX is the first and only neurotoxin approved for three facial treatments;<sup>38</sup>
- “From 2002 through 2018, [Opposer] has invested more than \$298 million in direct-to-consumer advertising of the BOTOX® Product” for cosmetic applications, including print, radio, television and Internet advertising;<sup>39</sup>
- “Since 2013, [Opposer] has spent on average nearly \$200 million each year marketing, advertising, and promoting its BOTOX® Product.”;<sup>40</sup>
- Opposer has advertised its BOTOX product in magazines such as ELLE, GLAMOUR, SELF, REDBOOK, InStyle, and PEOPLE;<sup>41</sup>
- “[F]rom 2002 to 2018, [Opposer’s] BOTOX® Product has been advertised in more than 100 magazines, equating to more than 1,500 insertions.”<sup>42</sup>
- Opposer’s Internet advertising includes its website (botoxcosmetic.com) and social media platforms such as a YouTube channel, Instagram, and Facebook. Opposer’s Instagram account for BOTOX Cosmetic has 772,000 followers. More than

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<sup>36</sup> McKenna Testimony Decl. ¶10 (20 TTABVUE 4).

<sup>37</sup> McKenna Testimony Decl. ¶11 (20 TTABVUE 5).

<sup>38</sup> *Id.*

<sup>39</sup> McKenna Testimony Decl. ¶¶15-16 (20 TTABVUE 5).

<sup>40</sup> McKenna Testimony Decl. ¶17 (20 TTABVUE 6).

<sup>41</sup> McKenna Testimony Decl. ¶18 (20 TTABVUE 6).

<sup>42</sup> McKenna Testimony Decl. ¶21 (20 TTABVUE 7).

85,000 people have “liked” and follow Opposer’s Facebook page for BOTOX Cosmetic;<sup>43</sup>

- From 1998 through 2018, Opposer has earned approximately \$20 billion in U.S. sales of its BOTOX products;<sup>44</sup>

- From 2014 through 2018, Opposer has averaged \$1.925 billion in U.S. revenue;<sup>45</sup>

- “In 2005, *Brand Week* magazine rated [Opposer’s] BOTOX® Product as being the number one placed brand in television programs and movies, notwithstanding that Opposer has never paid to place its BOTOX products in television or movies.”;<sup>46</sup>

- “BOTOX® Product has twice appeared on the front page of the *New York Times*, [and] has appeared on the covers of *Newsweek* and *People*.”;<sup>47</sup> and

- Opposer’s market research reports that as November 2019, “the total unaided brand awareness for the BOTOX® Product was 69% and the total aided brand awareness for the BOTOX® Product was 95%,” among “aesthetically oriented women, aged 30-65, who had never had any type of injectable before.”<sup>48</sup>

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<sup>43</sup> McKenna Testimony Decl. ¶19 (20 TTABVUE 6).

<sup>44</sup> McKenna Testimony Decl. ¶29 (20 TTABVUE 9).

<sup>45</sup> *Id.*

<sup>46</sup> McKenna Testimony Decl. ¶20 (20 TTABVUE 6-7).

<sup>47</sup> McKenna Testimony Decl. ¶21 (20 TTABVUE 7).

<sup>48</sup> McKenna Testimony Decl. ¶¶22-23 (20 TTABVUE 7). Although McKenna’s testimony was clear, specific, and uncontradicted and proffered against a background where Applicant, in its Answer, had admitted that Opposer’s BOTOX mark is famous, the testimony regarding Opposer’s market research has little probative value. We have no explanation of how the figures in the report were derived, what questions were asked, what information Opposer provided respondents on which they based their responses, and no information regarding the study’s methodology.

We find BOTOX to be a famous mark for purposes of our likelihood of confusion analysis and, thus, Opposer's BOTOX mark falls on the very strong side of the spectrum of from commercially very strong to very weak. In conjunction with the inherent or conceptual strength of the mark, BOTOX is a very strong mark entitled to a broad scope of protection or exclusivity of use.

B. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion

Applicant asserts that the parties have been simultaneously using their marks without any reported instances of actual confusion.<sup>49</sup> Opposer concedes that it "has not offered any evidence of actual consumer confusion in this proceeding."<sup>50</sup> The absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by the parties of their marks for a significant length of time in the same markets. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to occur. *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred); *Red Carpet Corp. v. Johnstown Am. Enters. Inc.*, 7 USPQ2d 1404, 1406-1407 (TTAB 1988); *Central Soya Co., Inc. v. N. Am. Plant*

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<sup>49</sup> Applicant's Brief, p. 30 (43 TTABVUE 31).

<sup>50</sup> Opposer's Reply Brief, p. 18 (42 TTABVUE 24).

*Breeders*, 212 USPQ 37, 48 (TTAB 1981) (“[T]he absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring.”).

Opposer’s BOTOX mark is a famous mark and, therefore, it has extensive public recognition and renown. *See Bose*, 63 USPQ2d at 1305; *Recot*, 54 USPQ2d at 1897; *Kenner Parker Toys*, 22 USPQ2d at 1456. On the other hand, Applicant did not introduce any testimony or other evidence regarding its marketing, promotional, or advertising activities, nor did it introduce any testimony or other evidence regarding the extent of its sales. There is essentially no testimony or other evidence regarding Applicant’s commercial activity. While Applicant introduced excerpts from eBay.com advertising the sale of Applicant’s hair care products under the mark at issue,<sup>51</sup> there is no follow-up testimony or evidence as to whether Applicant made any sales or how many potential consumers viewed the eBay webpage.

Because of the lack of testimony and other evidence regarding the extent of Applicant’s commercial activity under its mark at issue, there is no evidence that there has been a reasonable opportunity for confusion to occur. Accordingly, this *DuPont* factor is neutral.

C. The similarity or dissimilarity of the marks.

We now turn to the *DuPont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567. “Similarity in any one of these elements may

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<sup>51</sup> 30 TTABVUE 7-8; 31 TTABVUE 5-6.

be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. Sept. 13, 2019); *accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

In comparing the marks, we are mindful that “[t]he proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Cai*, 127 USPQ2d at 1801 (quoting *Coach Servs.*, 101 USPQ2d at 1721).

The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d at 1740; *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012). Because Applicant is seeking to register its mark for non-medicated hair care preparations such as shampoo, conditioners, colorings, sprays and gels for cosmetic purposes, with no restrictions as to channels of trade, classes of consumers, or price, the average consumer is an ordinary consumer.

Applicant is seeking to register GS GEMS STYLE HAIR BOTOX and Opposer’s mark is BOTOX. The marks are similar, in part, because they both include the term BOTOX and they are different because Applicant’s mark includes GS GEMS STYLE.

Applicant uses the BOTOX as part of the unitary term HAIR-BOTOX on its label reproduced below:<sup>52</sup>



Applicant's use of the trademark BOTOX in Applicant's mark GS GEMS STYLE HAIR BOTOX make it appear that the hair care product is a BOTOX product specifically for hair (i.e., a hair Botox).

While there is no explicit rule that we must find marks similar where an applicant's mark contains an opposer's entire mark, the fact that Applicant's mark subsumes Opposer's entire mark increases the likelihood of confusion. *See, e.g., China Healthways Inst. Inc. v. Xiaoming Wang*, 491 F.3d 1337, 83 USPQ2d 1123, 1125 (Fed. Cir. 2007) (applicant's mark CHI PLUS is similar to opposer's mark CHI both for electric massagers); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1271 (TTAB 2009) (applicant's mark VANTAGE TITAN for medical magnetic resonance imaging

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<sup>52</sup> Serial No. 87681252 (TSDR 7).

diagnostic apparatus confusingly similar to TITAN for medical ultrasound diagnostic apparatus); *Broadcasting Network Inc. v. ABS-CBN Int'l*, 84 USPQ2d 1560, 1568 (TTAB 2007) (respondent's mark ABS-CBN is similar to petitioner's mark CBN both for television broadcasting services); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002, 2004 (TTAB 1988) (applicant's mark MACHO COMBOS for food items confusingly similar to MACHO for restaurant entrees).

Furthermore, the use of the house mark GEMS STYLE may increase and not decrease the similarity of the marks by suggesting that Applicant is the source of or affiliated with Opposer's BOTOX products. *See In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1367 (TTAB 2007) (affirming refusal to register CLUB PALMS MVP based on prior registration of MVP, finding consumers "likely to believe that the CLUB PALMS MVP casino services is simply the now identified source of the previously anonymous MVP casino services"); *In re Chica, Inc.*, 84 USPQ2d 1845, 1848-49 (TTAB 2007) (CORAZON BY CHICA is similar to CHICA because "BY CHICA' will simply be viewed as the identification of the previously anonymous source of the goods sold under the mark COROZON."); *In re Pierce Foods Corp.*, 230 USPQ 307, 309 (TTAB 1986) (in dicta, stating that even if Applicant's proposed amendment to its drawing was accepted, "Applicant's institutional purchasers, aware of registrant's CHICKEN BAKE coating mix, may well believe that applicant's PIERCE CHIK'N BAKE pre-seasoned chicken is a product produced under license from registrant or otherwise sponsored or produced by registrant."); *In re Riddle*, 225 USPQ 630, 632 (TTAB 1985) (RICHARD PETTY'S ACCU TUNE for automotive service centers is similar to

ACCU-TUNE for automotive testing equipment because consumers are likely to believe that Richard Petty endorsed or was in some way associated with both the goods and services); *In re Christian Dior, S.A.*, 225 USPQ 533, 534 (TTAB 1985) (finding LE CACHET DE DIOR similar to CACHET where the addition of the DIOR house mark did not distinguish marks because there was no evidence that the similar term CACHET was highly suggestive or merely descriptive).

Applicant argues that “Hair Botox” “is a term widely recognized by the general consumer public in the United States and by the social media” that has a distinct meaning from BOTOX alone.<sup>53</sup> According to Applicant, “Hair Botox” is a unique and inseparable concept, widely recognized by relevant consumers.<sup>54</sup> Applicant supports its argument by introducing excerpts from third-party websites using the term “Hair Botox” for hair care treatments.<sup>55</sup> For example,

- All Things Hair website (allthingshair.com) (September 21, 2019)

Hair Botox vs. Keratin Treatment: What’s the Difference?

Hair botox and keratin treatments are two of the most common treatments used in salons for those seeking smoother, straighter hair. ...

What is Hair Botox?

Hair botox is a hair treatment designed to eliminate frizz, as it smooths and “turns back the time” on your hair clock. A great option if you’re keen to avoid using too many harsh chemicals on your hair, it’s a deep conditioning ...<sup>56</sup>

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<sup>53</sup> Applicant’s Brief, p. 7 (43 TTABVUE 8).

<sup>54</sup> Applicant’s Brief, p. 33 (43 TTABVUE 34).

<sup>55</sup> 33 TTABVUE.

<sup>56</sup> 33 TTABVUE 26-27.

- Healthline website (healthline.com) (May 23, 2017)

### What Is Botox for Hair?

#### Overview

When you think wrinkles, you may think of onabotulinumtoxin A (Botox), a common prescription medication that some people use to smooth wrinkles. But what about Botox for your hair?

Hair on your head loses fullness and elasticity as it ages, just like your skin. New hair products market themselves as Botox for hair because they're supposed to help fill the hair, make it smooth, and reduce frizz.

#### Does Botox for hair contain Botox?

[Cut off] ... Just like Botox works by relaxing the muscles and smoothing skin, "hair Botox" works by filling in individual fibers of hair to help give it fullness and make it smooth.<sup>57</sup>

#### How does hair Botox work?

Hair Botox is actually a deep conditioning treatment that coats hair fibers with a filler, such as keratin. The treatment fills in any broken or thin areas on each hair strand to make hair appear more full and lustrous.

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#### What happens during application?

Botox for your hair doesn't use injections of any kind. Instead, it's a conditioning agent that's applied directly to your strands of hair. You can go to a hair salon to have the treatment or purchase the products to apply at home.<sup>58</sup>

- Softer Hair website (softerhair.com)

### Introduction to Botox Hair Treatment

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<sup>57</sup> Applicant did not provide a full excerpt.

<sup>58</sup> 33 TTABVUE 35-37.

Right now, there is a new revolutionary hair treatment out on the market that's been garnering a lot of attention. It's called Hair Botox, and can actually reverse damage to the hair cortex and hair cuticles while straightening, hydrating, and bringing your hair back to life. The way that Botox procedure can wind back the clock for your facial wrinkles, Hair Botox can transform hurt and abused hair back to its natural form. With this moisture-injecting procedure, your hair will become healthy, radiant and much more manageable.

Don't let the name fool you, though – Unlike Botox injections, this version of the miracle treatment is a little different. It contains no Botulinum and is applied to the hair to work a brand of magic similar to Keratin treatment, where it penetrates the cuticles and fills in the gaps and breakages. It easily mends tears in the hair follicles, creating a sleeker, shinier, and tougher strands.

What is Hair Botox?

Hair Botox contains a protein-rich formula that fixes the imperfections in each individual strand of hair with active ingredients. This mixture of proteins, caviar oil, collagen, vitamins, antioxidants, natural acids, and healing agents promise to moisturize, nourish, and restore hair from inside out. Hair becomes softer, frizz-free, and further damage to the hair shaft is prevented.<sup>59</sup>

- Hair botox treatments are advertised at Stella Luca salons in Orlando, Florida (stellaluca.com),<sup>60</sup> Palm Beach Beauty Lounge in Palm Beach, Florida (pbbeautylounge.com),<sup>61</sup> Bell Arte Hair Studio in Tampa, Florida (belleartosalon.com),<sup>62</sup> A Touch of Rose Dominican Salon in Miami, Florida

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<sup>59</sup> 33 TTABVUE 44-45.

<sup>60</sup> 33 TTABVUE 57-59.

<sup>61</sup> 33 TTABVUE 60-61.

<sup>62</sup> 33 TTABVUE 85-89.

(groupon.com),<sup>63</sup> and Avant-Garde Salon & Spa in Miami, Florida (avantgardesalonandspa.com).<sup>64</sup>

Opposer argues that the above-noted third-party use is of limited probative value because Internet evidence is admissible only to show what was printed, not the truth of the matter asserted.<sup>65</sup> While Opposer makes a valid point, the above-noted evidence shows that authors are writing about “Hair Botox,” their readers are reading about “Hair Botox,” and salons are advertising “Hair Botox” treatment services. Thus, it is reasonable to infer that at least some segment of the public, as well as a segment of the hair care industry, perceives “Hair Botox” as a hair care treatment.

Because a segment of the consuming public and a segment of the hair care industry perceive “Hair Botox” to be a hair care treatment, Applicant, in its application, disclaimed the exclusive right to use “Hair Botox” and argues, in essence, that GS GEM STYLE is the dominant part of Applicant’s mark, thereby distinguishing it from Opposer’s BOTOX mark.<sup>66</sup> However, Opposer’s registrations for BOTOX are entitled to all the presumptions of Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), including their validity and Opposer’s exclusive right to use the registered marks in commerce on the goods specified in the registrations. *See Giant Food, Inc. v. Nation’s Foodservices, Inc.*, 701 F.2d 1564, 218 USPQ 390, 393 (Fed. Cir. 1983). Even assuming a segment of the consuming public and hair care industry

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<sup>63</sup> 33 TTABVUE 99-101.

<sup>64</sup> 33 TTABVUE 102-105.

<sup>65</sup> Opposer’s Reply Brief, p. 9 (42 TTABVUE 15).

<sup>66</sup> Applicant’s Brief, pp. 12-13 (43 TTABVUE 6).

perceives “Hair Botox” to be a type of hair care treatment, because Opposer’s registered mark is both conceptually and commercially strong, consumers and potential consumers mistakenly may believe that “Hair Botox” treatments are related to, sponsored by, or somehow associated with the famous BOTOX pharmaceutical with which they are familiar.

Because BOTOX is a famous trademark, it is incumbent upon Applicant [and others] to avoid using it. The Trademark Act’s tolerance for similarity between competing marks varies inversely with the commercial strength of Opposer’s mark. As the commercial strength increases, the Trademark Act’s tolerance for similarities in competing marks falls. For this reason, the Court of Appeals for the Federal Circuit emphasizes:

When an opposer’s trademark is a strong, famous mark, it can never be “of little consequence”. The fame of a trademark may affect the likelihood purchasers will be confused inasmuch as less care may be taken in purchasing a product under a famous name.

*Specialty Brands v. Coffee Bean Distribs.*, 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984); *see also B.V.D. Licensing v. Body Action Design*, 6 USPQ2d at 1722 (Nies, J. now C.J., dissenting) (“a purchaser is less likely to *perceive* differences from a famous mark.”) (emphasis in original). In accord with these principles, the Federal Circuit stated:

[T]here is “no excuse for even approaching the well-known trademark of a competitor . . . and that all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially where the established mark is one which is famous. . . .”

*Nina Ricci, S.A.R.L. v. E.T.F. Enters.*, 889 F.2d 1070, 12 USPQ2d 1901 (Fed. Cir. 1989) (quoting *Planters Nut & Chocolate Co. v. Crown Nut Co.*, 305 F.2d 916, 134 USPQ 504 (CCPA 1962)).

While the marks are not identical, because Opposer's BOTOX mark is famous, Applicant's mark GS GEM STYLE HAIR BOTOX, in its entirety, is more similar to Opposer's BOTOX mark than it is dissimilar in appearance, sound, connotation, and commercial impression.

D. The similarity or dissimilarity and nature of the goods.

As noted above, Applicant is seeking to register its mark for non-medicated hair care preparations and the description of goods for Opposer's registrations include "pharmaceutical preparations for the treatment of... wrinkles."

To prove that the goods are related, Opposer introduced excerpts from 20 third-party websites where the third parties market both pharmaceutical preparations, such as Botox, and haircare services under the same mark.<sup>67</sup> For example,

- Déja Vu Med Spa & Salon (dejavumedspaandsalon.com) advertises hair care services and medical treatment, including Botox injections;<sup>68</sup>

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<sup>67</sup> 21 TTABVUE. Opposer, in its brief, referred to Applicant's abandoned application Serial No. 87519959 for the mark BOTOX for hair care preparations (2 TTABVUE 7). Opposer's Brief, p. 21 (41 TTABVUE 30). In that application, the Examining Attorney cited six third-party websites for "entities that produce anti-wrinkle products also produce hair care products." (22 TTABVUE 18). However, because Opposer did not include copies of those websites in its notice of reliance, they are not of record for us to consider.

<sup>68</sup> 21 TTABVUE 11-13 and 16-22.

- OUBEAUTY Medical Spa (oubeauty.com) advertises medical outpatient cosmetic services, such as Botox injections, and hair care and grooming services;<sup>69</sup> and

- Le Jolie Medi Spa (lejoliespa.com) advertises medical treatment services, including Botox injections, and hair salon services.<sup>70</sup>

The website excerpts do not show the same entities using the same marks to identify hair care products and pharmaceutical preparations; the websites show the same entities advertise their offering hair care services and medical cosmetic treatment services.

Opposer also introduced copies of 60 third-party registrations based on use for hair care preparations and pharmaceutical preparations.<sup>71</sup> Third-party registrations based on use in commerce that individually cover a number of different goods may have probative value to the extent that they serve to suggest that the listed goods are of a type that may emanate from the same source. *In re Country Oven, Inc.*, 2019 USPQ2d 443903, \*8 (TTAB 2019) (citing, inter alia, *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002)); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786 (TTAB 1993). We list below representative registrations, with relevant portions of the identifications:

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<sup>69</sup> 21 TTABVUE 26-41.

<sup>70</sup> 21 TTABVUE 42-48.

<sup>71</sup> 39 TTABVUE 5-256.

<b>Mark</b>	<b>Reg. No.</b>	<b>Goods</b>
EBLOUIR	6001563	Hair conditioner and shampoo; pharmaceutical preparations for skin care
DR. WU	6016656	Hair care preparations for cosmetic use; pharmaceutical preparations for skin care; pharmaceutical skin lotions
TENA	5955694	Hair shampoo and conditioners; pharmaceutical preparations for skin care
DAYWITH	5850562	Hair shampoo; pharmaceutical preparations for skin care
QIVARO	5987158	Dry shampoos, shampoos, and hair conditioners and lotions; pharmaceutical preparations for skin care and syrups for pharmaceutical purposes for the treatment of skin conditions

Applicant argues that the descriptions of goods are so different (i.e., non-medicated hair care preparations versus pharmaceutical preparations), the use of the goods is so different, the nature and the purpose of the goods are so different, and the goods are noncompetitive and have nothing in common with respect to their essential character or consumer appeal.<sup>72</sup> In essence, Opposer's goods have nothing to do with hair.<sup>73</sup> As discussed above, Applicant contends that consumers and people in the hair care industry recognize that "Hair Botox" is a product that is separate and distinct from a pharmaceutical preparation.

In determining whether the goods are related, it is not necessary that the goods of the parties be similar or competitive in character to support finding the goods are related; it is sufficient for such purposes that Opposer establish that the goods are related in some manner or that conditions and activities surrounding marketing of these goods are such that they would or could be encountered by same persons under

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<sup>72</sup> Applicant's Brief, pp. 36-38 (43 TTABVUE 37-39).

<sup>73</sup> Applicant's Brief, pp. 6 and 13-14 (43 TTABVUE 7 and 14-15).

circumstances that could, because of similarities of marks used with them, give rise to the mistaken belief that they originate from or are in some way associated with the same producer. *Coach Servs.*, 101 USPQ2d at 1722; *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1410 (TTAB 2010). The issue is not whether purchasers would confuse the parties' goods, but rather whether they are likely to confuse the source of the goods. *See Recot*, 54 USPQ2d at 1898 (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); *In re I-Coat Co., LLC*, 126 USPQ2d 1730, 1737 (TTAB 2018) (“the test is not whether consumers would be likely to confuse these goods, but rather whether they would be likely to be confused as to their source.”); *In re Cook Med. Tech. LLC*, 105 USPQ2d 1377, 1380 (TTAB 2012).

Despite the obvious differences between the descriptions of goods, because BOTOX is a famous mark entitled to a broad scope of protection, some entities render both hair care services and medical cosmetic treatment services under the same mark so consumers may encounter both sets of products in the same marketing milieu, and the third-party registrations show that hair care products and pharmaceutical preparations may emanate from the same source, we find that the Applicant's hair care products are related to Opposer's pharmaceutical preparations. *See Recot*, 54 USPQ2d at 1898 (in analyzing whether FIDO LAY dog treats are related to FRITO LAY human snacks, the court held “even if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the

mind of the consuming public as to the origin of the goods.”). *See also Bose*, 63 USPQ2d at 1310 (“when a product reaches the marketplace under a famous mark, special care is necessary to appreciate that products not closely related may nonetheless be confused as to source by the consumer because of the fame of the mark.”).

E. Established, likely-to-continue channels of trade and classes of consumers.

The website excerpts Opposer introduced show third parties market both medical cosmetic treatment services, including pharmaceutical preparations such as Botox, and haircare services, including the sale of non-medicated hair care preparation, under the same mark.<sup>74</sup> The websites advertise the sale and use of name brand hair care products. For example,

- OUBEAUTY Medical Spa (oubeauty.com) advertises that it sells Pureology, Rene Furterer, Redken, and Enjoy hair care products;<sup>75</sup>

- Le Joulie Medi Spa (lejoliespa.com) advertises its featured salon products, such as AWAPHUI, PAUL MITCHELL, and TEATREE;<sup>76</sup>

- Revive Salon & Med Spa (revivesalonandspa.com) features a photograph of its salon displaying hair care products for sale.<sup>77</sup> Revive advertises itself as a L’Oreal

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<sup>74</sup> 21 TTABVUE.

<sup>75</sup> 21 TTABVUE 39-40.

<sup>76</sup> 21 TTABVUE 45-46.

<sup>77</sup> 21 TTABVUE 50.

Professional Salon featuring L’Oreal Professional, Kerastase and UNITE hair care and styling lines;<sup>78</sup>

- Dita Day Spa (ditadayspa.com) features a photograph of display shelf of haircare products for sale.<sup>79</sup> Dita advertises that features the entire range of L’Oreal professional hair color and treatment products;<sup>80</sup>

- La Vie En Rainey Med Spa & Salon (lavieenrainey.com) advertises for its hair and color services, it uses “Goldwell, the future of color.”;<sup>81</sup>

- Medspa At Villagio (medspaatvillagio.com) advertises its “quality hair products include L’Oreal and Goldwell Hair Colors ... and retail to assist in enhancing your features.”;<sup>82</sup>

- Aura Day Spa & Salon (auradayspaandsalon.com) advertises its use of AG Hair Cosmetics and Goldwell Color products;<sup>83</sup>

- MacMed Spa Salon & Medical (macmedspa.com) advertises its use of ThermaFuse products;<sup>84</sup> and

- Daired’s Salon & Spa (daireds.com) advertises its use of AVEDA, KERASTASE, KEVIN MURPHY, and SCHWARKOPF hair care products.<sup>85</sup>

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<sup>78</sup> 21 TTABVUE 56.

<sup>79</sup> 21 TTABVUE 64 and 69.

<sup>80</sup> 21 TTAVUE 70.

<sup>81</sup> 21 TTABVUE 117.

<sup>82</sup> 21 TTABVUE 157.

<sup>83</sup> 21 TTABVUE 179.

<sup>84</sup> 21 TTABVUE 219.

<sup>85</sup> 21 TTABVUE 227.

Because the same entities offer cosmetic medical treatments, including Botox injections, and hair care services promoting the sale or use of specific hair care products, we find Opposer offers its pharmaceutical preparations for treating wrinkles in some of the same channels of trade to some of the same classes of consumers as non-medicated hair care preparations.

Applicant contends that the trade channels and classes of consumers do not overlap because,

... based on the statutory limitation that Opposer's marks [sic], such as pharmaceutical preparations, according to the (FDA) (U.S. Title 21- Food and Drugs Chapter II – Drug Enforcement Administration Department of Justice Part 1306 Prescriptions), must only be sold at a pharmacy's prescription section by medical prescription, prescribed by a qualified physician, and also, the person who dispatches the Opposer's good at the pharmacy's prescription section must be a licensed technician in pharmacy or a doctor, while the good sold under Applicant's mark is sold over the counter, online, and directly to the licensed Hair Stylists at the licensed Beauty Salon, and is not sold at pharmacy's prescription section, and is not regulated by the FDA.<sup>86</sup>

While BOTOX injection requires professional administration,<sup>87</sup>

As the BOTOX® Product has become increasingly popular, patients have sought out injections not only at traditional doctors' offices, but also at aesthetic medical centers and so-called "med spas," which offer both non-surgical aesthetic treatments and traditional day spa services such

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<sup>86</sup> Applicant's Brief, p. 6 (43 TTABVUE 7).

<sup>87</sup> "Because the BOTOX® Product is an injectable pharmaceutical preparation, it may be injected by doctors (including primary care physicians, dermatologists, and plastic surgeons) and dentists, as well as physician assistants and registered nurses. In some states, licensed practical nurses, aestheticians, and medical assistants are authorized to inject the BOTOX® Product under physician supervision." McKenna Testimony Decl. ¶25 (20 TTABVUE 8).

as massage, skin care, and salon services for hair and nails.<sup>88</sup>

Thus, the evidence shows aesthetic medical centers and “med spas” offering both hair care products, including hair care preparations, and cosmetic medical treatment services, including BOTOX injections, to the same consumers.

In addition, Applicant contends the purchasers of both Applicant’s products and Opposer’s products are “professional buyers.”<sup>89</sup> Specifically, “the purchasers (end customers) of Applicant’s mark are the licensed hair stylists at the licensed beauty salon.”<sup>90</sup> Because Applicant’s description of goods is not limited to non-medicated hair care products sold only to licensed hair stylists or licensed beauty salons, we cannot consider Applicant’s contention. We cannot resort to extrinsic evidence to restrict the parties’ goods. *See Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987) (quoting *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983)) (“likelihood of confusion ... must be resolved ... on consideration of the goods named in the application and in opposer’s registration and, in the absence of specific limitations in the application or registration, on consideration of the normal and usual channels of trade and methods of distribution.”); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986) (evidence that relevant goods are expensive wines sold to discriminating purchasers

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<sup>88</sup> McKenna Testimony Decl. ¶26 (20 TTABVUE 8).

<sup>89</sup> Applicant’s Brief, p. 14 (43 TTABVUE 15). *See also* Applicant’s Brief, p. 16 (43 TTABVUE 17).

<sup>90</sup> Applicant’s Brief, p. 7 (43 TTABVUE 8). *See also* Applicant’s Brief, p. 14 (43 TTABVUE 15).

must be disregarded given the absence of any such restrictions in the application or registration). In fact, Applicant introduced evidence advertising the unrestricted sale of its products on eBay.<sup>91</sup>

The evidence Applicant introduced (e.g., notice of reliance on evidence that hair stylists must obtain a state license to render their services,<sup>92</sup> evidence that hair salon services and medical spa services purportedly are separate and distinct operations,<sup>93</sup> Internet materials purportedly to show that parties' products are offered in different channels of trade;<sup>94</sup> and the number of hair salons in the United States<sup>95</sup>) does not rebut or minimize the fact Opposer's BOTOX pharmaceutical preparation for the treatment of wrinkles is offered in some of the same channels of trade and to some of the same classes of consumers as non-medicated hair care preparations.

F. The conditions under which and buyers to whom sales are made.

This *DuPont* factor considers “[t]he conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing.” 177 USPQ at 567. This factor encompasses the degree of consumer care. In analyzing this *DuPont* factor, we focus on the description of goods in the application and registrations rather than real-world conditions, because “the question of registrability of an applicant's mark must be decided on the basis of the goods set forth in the application.” *Stone*

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<sup>91</sup> 31 TTABVUE 5

<sup>92</sup> 28 TTABVUE.

<sup>93</sup> 29 TTABVUE.

<sup>94</sup> 36 TTABVUE.

<sup>95</sup> 26 TTABVUE.

*Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys., Inc. v. Houston Comp. Servs.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)). This is so regardless of what the record reveals as to the actual marketing conditions. *Id.* As noted above, we cannot resort to extrinsic evidence to restrict the parties' goods. *See Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 1 USPQ2d at 1815 (quoting *CBS, Inc. v. Morrow*, 218 USPQ at 199).

Because Applicant's description of goods is for non-medicated hair care preparations without any restrictions or limitations as to channels of trade, classes of consumers or price, Applicant's goods include all types of non-medicated hair care preparations. Therefore, we may not consider Applicant's argument that its non-medicated hair care products are expensive and that its customers are sophisticated purchasers.<sup>96</sup> *See Bercut-Vandervoort & Co.*, 229 USPQ at 764 (evidence that relevant goods are expensive wines sold to discriminating purchasers must be disregarded given the absence of any such restrictions in the application or registration). *See also Stone Lion Capital Partners*, 110 USPQ2d at 1163-64 (recognizing Board precedent requiring consideration of the "least sophisticated consumer in the class"); *In re Sailerbrau Franz Sailer*, 23 USPQ2d 1719, 1720 (TTAB 1992) (finding that not all purchasers of wine may be discriminating because while some may have preferred

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<sup>96</sup> Applicant's Brief, p. 7 (43 TTABVUE 8). *See also* 31 TTABVUE 5 (eBay webpage advertising Applicant's four-part set of products, including GS GEM STYLE HAIR BOTOX, for \$576).

brands, “there are just as likely to be purchasers who delight in trying new taste treats.”).

As noted above, the relevant average purchaser is an ordinary consumer. This ordinary consumer may purchase Applicant’s hair care products and request a BOTOX injection at a cosmetic medical treatment facility or spa. In this regard, Opposer markets its BOTOX pharmaceutical preparations to ordinary consumers inasmuch as Opposer “has advertised its BOTOX® Product for cosmetic indications in popular and widely-circulated magazines, including *Elle*, *Glamour*, *Self*, *Redbook*, *InStyle*, and *People*.”<sup>97</sup> “Botox on its own is a highly sought-after treatment and can be a very beneficial addition to your practice to increase patient acquisition. However, because of its popularity many providers offer the neurotoxin injectable.”<sup>98</sup> “People are searching for BOTOX in their city every minute of the day.”<sup>99</sup>

Ordinary consumers may go to a spa offering cosmetic medical treatment services and request BOTOX injections to improve their aesthetic facial appearance simply because of the renown of the BOTOX product, without giving it much thought other than the desire to look good. *See Stone Lion Capital Partners*, 110 USPQ2d at 1163-64 (requiring consideration of the “least sophisticated consumer in the class”).

As noted above, although a BOTOX injection requires professional administration,

As the BOTOX® Product has become increasingly popular, patients have sought out injections not only at traditional doctors’ offices, but also at aesthetic medical centers and

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<sup>97</sup> McKenna Testimony Decl. ¶18 (20 TTABVUE 6).

<sup>98</sup> Med Aesthetics Group, Marketing Botox (medaestheticsgroup.com) (32 TTABVUE 41).

<sup>99</sup> *Id.* at 32 TTABVUE 43.

so-called “med spas,” which offer both non-surgical aesthetic treatments and traditional day spa services such as massage, skin care, and salon services for hair and nails.<sup>100</sup>

The prerequisites for injecting BOTOX appear to be minimal. The customer goes to a spa, requests a consultation to determine if he/she is a candidate for a BOTOX injection and, if appropriate, a treatment plan begins.<sup>101</sup>

Applicant’s argument that the relevant consumers exercise a high degree of care is based, in part, on the false premise that the relevant consumers are limited or restricted to medical professionals and professional hairdressers.<sup>102</sup> Applicant is discounting the role the patients of the aesthetic medical centers and “med spas” play. As discussed above, Opposer advertises in popular and widely-circulated magazines, including *Elle*, *Glamour*, *Self*, *Redbook*, *InStyle*, and *People*<sup>103</sup> so that ordinary consumers will request BOTOX treatments at their local aesthetic medical center or “med spa.” Thus, ordinary consumers drive the demand for BOTOX injections.

We find this *DuPont* factor to be neutral.

#### G. Conclusion

Opposer’s BOTOX mark is both conceptually and commercially strong and, as noted above, it is a famous mark for purposes of our likelihood of confusion analysis.

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 1894, and

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<sup>100</sup> McKenna Testimony Decl. ¶26 (20 TTABVUE 8). *See also* Applicant’s Brief, p. 14 (43 TTABVUE 15).

<sup>101</sup> 21 TTABVUE.

<sup>102</sup> Applicant’s Brief, pp. 13-15 (43 TTABVUE 14-16).

<sup>103</sup> McKenna Testimony Decl. ¶18 (20 TTABVUE 6).

“[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.

*Bose Corp.*, 63 USPQ2d at 1305. Because Opposer’s BOTOX mark is famous, the marks are similar, the goods are related, and the parties offer their goods in some of the same channels to some of the same classes of consumers, we find that Applicant’s mark GS GEM STYLE HAIR BOTOX for non-medicated hair preparations is likely to cause confusion with Opposer’s registered BOTOX mark for “pharmaceutical preparations for the treatment of . . . wrinkles.”

Because we found that Applicant’s mark is likely to cause confusion with Opposer’s mark, we do not reach Opposer’s dilution claim. “Like the federal courts, the Board has generally used its discretion to decide only those claims necessary to enter judgment and dispose of the case. . . . [T]he Board’s determination of registrability does not require, in every instance, decision on every pleaded claim.” *Multisorb Tech., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013).

**Decision:** The opposition is sustained on the ground of priority and likelihood of confusion and registration to Applicant is refused.