ESTTA Tracking number: **ESTTA916904**

Filing date: **08/21/2018**

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

Proceeding	92062923
Party	Plaintiff Topiclear, Inc.
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Date	08/21/2018
Attachments	Reply Brief for Petitioner - Topiclear v. K&N.pdf(279896 bytes)

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

TOPICLEAR, INC.,	]	
	]	
Petitioner,	]	Cancellation No. 92062923
	]	
vs.	]	Reg. No. 4,818,656
	]	
K & N DISTRIBUTORS,	]	
	]	
Respondent.	]	
_____	]	

PETITIONER'S REPLY BRIEF

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INTRODUCTION AND ARGUMENT

In actuality, this is a fairly straightforward proceeding and the issues are few. Much of Respondent's arguments as set forth in its brief are nothing more than a smokescreen to detract from the real issues in this case.

Petitioner's priority and standing were admitted by the Respondent and thus priority is not an issue in this proceeding.

Additionally, Respondent has conceded that the cosmetic goods of the two parties are similar and in some cases identical[1]

Respondent does not contest the fact that the channels of trade for the goods of the respective parties move in the same manner. In fact, the goods of the parties were found being marketed together in the same beauty supply stores.[2]

The only remaining issue then is the similarity of the two marks.

Determination of the issue of likelihood of confusion under Section 2(d) 15 U.S.C. §1052(d) must be based on an analysis of all of the relevant probative evidence in the record as set forth in the keystone case, *In re E.I. DuPont de Nemours & Co.* 177 USPQ 563 (CCPA 1973) cited by the Supreme Court in

[1] 48 TTABVUE p. 12
[2] 38 TTABVUE p. 38 and 39 TTABVUE Exhibit 15

B&B Hardware, Inc. v. Hargis Indust., Inc., 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015).

In any likelihood of confusion analysis, the two key considerations should be the similarities between the marks themselves and the similarities between the goods. See *In re Chatam International Inc.*, 71 USPQ2d 1944 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 192 USPQ 24, 29 (CCPA 1976).

With respect to the similarity of the marks, they must be considered in their entireties as to appearance, sound, connotation and commercial impression. *Stone Lion Capital Partners, v. Lion Capital LLP,* 110 USPQ2d 1157 (Fed. Cir. 2014) and *du Pont, supra* at page 567. In comparing the marks, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether they are sufficiently similar in terms of their overall commercial impression, such that confusion as to the source of the goods is likely to result. *San Fernando Electric Mfg. Co. v. JFD Elec. Components Corp.*, 196 USPQ 1 (CCPA 1977). The focus should be on the recollection of the average consumer, who retains a general rather than a specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980).

The Respondent contends that the word "CLAIR" in its trademark is actually a woman's name[3]. In actuality, "CLAIR" is the French word for "clear" as in Petitioner's mark TOPICLEAR" and as noted in Respondent's own registration, here sought to be cancelled, "CLAIR" was recited as meaning "CLEAR".

In its brief, Respondent has raised objections to sales and advertising figures and exhibits of the Petitioner.[4] These figures, as explained by Petitioner's witness, Mr. Graterol, were from its related company International Beauty Exchange[5]. The witness stated clearly that this company manages all distribution of the Petitioner's Topiclear products, receives revenue from their sale and works under a license. All of the sales and financial records which were available to Mr. Graterol emanated from a CPA firm for International Beauty Exchange, of which Mr. Graterol is Vice-President of Sales for this company. Respondent is certainly aware of this fact from a companion proceeding[6] and accordingly, Mr. Graterol would have had full access to the records that were objected to.

[3] 44 TTABVUE p. 31-32 and 48 TTABVUE p. 9
[4] 48 TTABVUE p. 4
[5] 38 TTABVUE p. 48-50
[6] See International Beauty Exchange v. K&N Distributors Cancellation # 92063647

Respondent argues that the marks have been used in "peaceful coexistence" and that there is no admissible evidence of actual confusion[7]. Petitioner need not prove any actual confusion and the tribunal will normally rely on its own common sense. *Lambda Electronics Corp. v. Lambda Technology, Inc.*, 211 USPQ 75, 87 (S.D. N.Y. 1981). If there is a substantial overlap between the channels of trade of the parties, as is the case here, even absent proof of actual confusion, the likelihood of the same must be presumed.

The admissibility of trade dress testimony and exhibits was also raised by the Respondent.[8] The packaging of the products of the Respondent are so similar in appearance as to show the true intent of the Respondent to copy not only Petitioner's mark, but also its trade dress in order to confuse the consumer as to the source of the goods and to capture the goodwill of the Petitioner. Respondent argues that trade dress is irrelevant to the issues in this proceeding. Trade dress is very relevant to the extent that it sheds light on the circumstances surrounding

[7] 48 TTABVUE p. 6 *et seq.*
[8] 48 TTABVUE Appendix p. 3

the adoption and use of the TROPIC CLAIR PLUS mark and packaging of the Respondent. When there is evidence of Respondent's intent to adopt a mark that suggests to the consumer a successful mark already in use by another, the TTAB should take into account that intent in determining likelihood of confusion issues. *Monsanto Co. v. CIBA-GEIGY Corp.,* 191 USPQ 173 (TTAB 1976). Also note *Roger & Gallet S.A. v. Venice Trading Co., Inc.,* 1 USPQ2d 1829 (TTAB 1987). This is also believed to be in keeping with *E.I. DuPont* which included the consideration of "any other established fact probative of the effect of use".

On pages 8 and 9 of its Brief[9], Respondent attempts to differentiate its mark, TROPIC CLAIR PLUS from Petitioner's TOPICLEAR trademark. It has long been held that adding a term or word to a registered mark generally does not obviate the similarity between the compared marks, nor does it overcome a likelihood of confusion under Section 2(d). See *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.* 188 USPQ 105,106 (CCPA 1975); *In re Toshiba Med. Sys. Corp.* 91 USPQ2d 1266, 1269 (TTAB 2009) and *In re El Torito Rests., Inc.* 9 USPQ2d 2002, 2004 (TTAB 1988)

[9] 48 TTABVUE p.8-9

A recent example of the manner in which the United States Patent and Trademark Office treats marks of this kind involves the exact word ”PLUS”. In the prosecution of application number 87652939 involving “PURE BEAUTY” the Examining Attorney held that the mere addition of the word “PLUS” did not avoid conflict with the prior registered mark “PURE BEAUTY”.

Courts often hold that small changes such as adding words or hyphens are insufficient to distinguish marks. *Union Carbide Corp. v. Ever-Ready Inc.,* 188 USPQ 623 (7th Cir. 1976).

Respondent also suggests[10] that Petitioner’s mark is week due to a small number of third party marks that were submitted in Respondents Notice of Reliance[11]. This notice includes 8 prior citations for the words CLEAR or CLAIR and 3 showing TROPIC or TOPIC.

As stated in *E.I. du Pont,* in testing for likelihood of confusion, the number and nature of similar marks in use on similar goods must be considered. Eight citations for CLEAR or CLAIR and three for TOPIC or TROPIC is hardly a sufficient number to consider. Further, these third party registrations

[10] 48 TTABVUE p.6-7
[11] 42 TTABVUE

are not evidence of use of the marks or that consumers have been exposed to them. *AMF Inc. v. American Leisure Products, Inc.* 177 USPQ 268 (CCPA 1973).

For the reasons advanced above and those set forth in Petitioner's main Brief, the Board is respectfully requested to grant the Petition to cancel the registration of the Respondent.

August 21, 2018

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CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing Reply Brief for the Petitioner was served electronically upon counsel for the Respondent on August 21, 2018, addressed to:

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