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

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| Proceeding no. | 92078349 |
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE
THE TRADEMARK TRIAL AND APPEAL BOARD**

Judith Gurley Plastic Surgery, LLC

Petitioner

v.

David J. Witchell Salon & Spa, Inc.,

Registrant

Cancellation No. 92078349

PETITIONER'S OPENING BRIEF

COMES NOW Petitioner, by and through counsel, and hereby submits its opening brief in support of granting Cancellation No. 92078349 on the ground that Registrant's Registration No. 5,845,907 will cause Petitioner to be damaged.

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Petitioner, by and through counsel, hereby moves for cancellation of Registration No. 5,845,907 due to likelihood of confusion and states as follows:

INTRODUCTION

Petitioner Judith Gurley Plastic Surgery, LLC is a Missouri limited liability company that provides medical services, plastic surgery services, and cosmetic and plastic surgery services for nearly twenty years. Petitioner has continuously used the mark NO ONE WILL KNOW...EVERYONE WILL NOTICE since it was adopted in 2007. Registrant David J. Witchell Salon & Spa, Inc owns U.S. Registration No. 5,845,907 for the mark EVERYONE WILL NOTICE BUT NO ONE WILL KNOW for hair and skin salon services; beauty spa services, namely, cosmetic body care in International Class 044 and was issued on the Principal Register on August 27, 2019 (“Registrant’s Mark). On February 16, 2019, Petitioner filed Trademark Application Serial Number 88/304473 for its mark NO ONE WILL KNOW...EVERYONE WILL NOTICE for medical services; plastic surgery services; cosmetic and plastic surgery in International Class 044 (“Petitioner’s Mark”). On November 20, 2020, the U.S. Trademark Examining Attorney (“Examining Attorney”) issued an office action citing Registrant’s Mark as a basis for denying registration of Petitioner’s Mark. Petitioner attempted to reach a co-existence agreement with Registrant based on the different services being offered by the parties, but Registrant refused. As such, Petitioner was forced to bring this cancellation to protect its rights.

PROCEDURAL AND FACTUAL BACKGROUND

On February 16, 2019, Petitioner filed Trademark Application Serial Number 88/304473 for its mark NO ONE WILL KNOW...EVERYONE WILL NOTICE for medical services; plastic surgery services; cosmetic and plastic surgery in International Class 044 (“Petitioner’s Mark”).

On November 20, 2020, the U.S. Trademark Examining Attorney (“Examining Attorney”) issued an office action citing Registrant’s Mark as a basis for denying registration of Petitioner’s Mark. Petitioner responded and the Examining Attorney issued a final office action on May 24, 2021. On October 31, 2021, Petitioner filed its Request for Reconsideration asking for suspension of the final office action pending the disposition of this cancellation proceeding. On November 2, 2021, Petitioner’s application was suspending pending disposition.

On October 26, 2021, Petitioner filed its Petition to Cancel Registrant’s Registration No. 5,845,907 due to its priority and the likelihood of confusion. On December 8, 2021, Respondent filed its Motion to Dismiss Petitioner’s Petition to Cancel. After briefing, on March 6, 2023, the Board entered its Order denying Respondent’s Motion to Dismiss and reset trial dates. On April 28, 2023, Respondent filed its Motion to Compel certain discovery from Petitioner. After briefing, on July 11, 2023, the Board entered its Order granting in part and denying in part Respondent’s Motin to Compel and resetting trial dates. On October 4, 5, and 7th, 2023, Petitioner filed its Testimony Declarations. On December 8th, 2023, Respondent filed its Notice of Reliance and Testimony Declarations.

Petitioner brought this action to protect its rights. Despite Petitioner’s contention that the two marks are not likely to cause confusion due to the types of services being offered, Registrant disagreed as well as the Examining Attorney. Therefore, due to Petitioner’s priority over the mark and Registrant & Examining Attorney’s contentions that the two marks are likely to cause confusion, Registrant’s Registration No. 5,845,907 should be cancelled.

STATEMENT OF THE ISSUE

The issue is whether Petitioner will be damaged by the continued registration of Registrant’s Mark EVERYONE WILL NOTICE BUT NO ONE WILL KNOW because it gives

color of exclusive statutory rights to Registrant in violation and derogation of the prior common law rights of Petitioner due to Petitioner's priority and the likelihood of confusion between the Petitioner's Mark NO ONE WILL KNOW...EVERYONE WILL NOTICE and Registrant's Mark EVERYONE WILL NOTICE BUT NO ONE WILL KNOW.

APPLICABLE LEGAL STANDARD

Likelihood of Confusion Standard.

Section 2(d) of the Lanham Act prohibits registration of a mark that consist of or is comprised of a mark that "so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the application, to cause confusion, or to cause mistake, or to deceive" 15 U.S.C. §1052(d). To prevail on its Section 2(d) claim, Petitioner must prove, by a preponderance of the evidence, that it (1) has priority with respect to its asserted mark vis-à-vis Respondent's mark and (2) that Respondent's use of its mark in connection with the good identified in its registration is likely to cause confusion, mistake, or deception as to the source or sponsorship of those goods. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000); *WeaponX Performance Prods. v. WeaponX Motorsports, Inc.*, 126 USPQ2d 1034, 1040 (TTAB 2018). In a Section 2(d) case, the Petitioner "must show proprietary rights in the mark that produces a likelihood of confusion." *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002)(citing *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981)). "These proprietary rights may arise from a prior registration, prior trademark or service mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights." *Id.* Petitioner's acquisition of proprietary rights in

its purported [NO ONE WILL KNOW...EVERYONE WILL NOTICE] mark must precede Respondent's actual or constructive use of its mark. *RxD Media, LLC v. IP Application Dev., LLC*, 125 USPQ2d 1801, 1808 (TTAB 2018). In the absence of competent evidence of actual use, Respondent may rely upon the filing date of the underlying application that matured into the involved registration for priority purposes. *Kemi Organics, LLC v. Gupta*, 126 USPQ2d 1601, 1604 (TTAB 2018).

Whether a likelihood of confusion exists is a question of law, determined on a case-by case basis, applying the relevant *DuPont* factors. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973). When any factor has been shown to be material and evidence has been introduced on such factor, then that factor must be considered by the Board. *See Octocom Systems, Inc. v. Houston Computers Services, Inc.* 918 F.2d 937 (Fed. Cir. 1990). Finally, if there are any doubts, they must be resolved in favor of the senior user. *Nina Ricci, S.A.R.L. v E.T.F. Enters., Inc.*, 889 F.2d 1070, 1074 (Fed. Cir. 1989). Likelihood of confusion is a question of law and opinions of law are not admissions of fact and thus cannot serve as admissions against interest. 19 TTABVUE 12-13; citing *Brooks v. Creative Arts By Calloway, LLC*, 93 U.S.P.Q.2d 1823, 1826 (TTAB 2009); *see also Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 U.S.P.Q. 151, 153-54 (CCPA 1978); TBMP §309.03(c)(2)(B); *Revco, D.S., Inc. v. Armour-Dial, Inc.*, 170 U.S.P.Q. 48, 49 (TTAB 1971).

ARGUMENT

Petitioner has Prior Rights to the NO ONE WILL KNOW...EVERYONE WILL NOTICE Trademark based on Registrant's Filing Date.

Registrant's asserted date of first use is March 16, 2016. Unless that or another date of first use is proven by Registrant, Registrant is only entitled to rely on the filing date of the underlying application that matured into its involved registration. *See JNF v. Hardwood Int'l*, 2022

USPQ2d 862, at *7 (TTAB 2022)(citing *Kemi Organics, LLC*, 126 USPQ2d at 1604).

Respondent's underlying application for the involved registration was filed on November 14, 2016. Respondent has not proved a date of first use earlier than this date. Thus, the operative date of Respondent's first use for purposes of priority is November 14, 2016. Section 7(c) of the Trademark Act, 15 U.S.C. §1057(c). Petitioner has shown it began using the Mark in commerce and acquired rights to it at least as early as 2007. Petitioner has provided evidence that Petitioner began using the Mark in 2007 and has continuously used the Mark to date. See 21 TTABVUE and 22 TTABVUE.

Looking at the evidence as a whole, as if each piece of evidence were part of a puzzle to be fitted together, the evidence collectively established by a preponderance of the evidence that Petitioner began using the Mark in 2007 in connection with its services and in commerce which is several years prior to Registrant's application date in November 14, 2016 as well as Registrant's asserted first date of use on March 16, 2016. Therefore, Petitioner has conclusively established priority of the Mark over Registrant.

Petitioner's Mark NO ONE WILL KNOW...EVERYONE WILL NOTICE is likely to be confused with Registrant's Mark EVERYONE WILL NOTICE BUT NOT ONE WILL KNOW

While it is Petitioner's contention that its Mark and Registrant's Mark are not confusingly similar based on the type of services offered by Petitioner, the US Trademark Examining Attorney issued a final Office Action in which the Examining Attorney cited Respondent's Registration No. 5,845,907 as a basis for refusing registration of Petitioner's Mark under Trademark Act §2(d). See US Serial No. 88304473. In particular, the Examining Attorney stated that the marks when compared in their entireties are confusingly similar and the compared services are related for likelihood of confusion purposes. Since Registrant was unwilling to give

consent to co-existing with Petitioner and Petitioner's use predated Registrant's first use date, Petitioner's only recourse to overcome the rejection was to file this Petition to Cancel.

Regardless of the parties' contentions, whether a likelihood of confusion exists is a question of law, determined on a case-by case basis, applying the relevant *DuPont* factors. While there has not been much produced by either party regarding likelihood of confusion between the two marks, the relevant and conclusive *DuPont* factors here are (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression and (2) similarity or dissimilarity and the nature of the goods or services as described in the registration with which a prior mark is in use and (3) third-party uses.

Similarity of the Marks

Petitioner agrees with Examining Attorney that the Marks when compared in their entireties for similarities in appearance, sound, connotation, and commercial impression are confusingly similar. *Stone Lion Capital Partners, LP v. Lion Capital, LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed.Cir. 2014)(quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Pansardin Maison Fondée En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed.Cir. 2005). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff'd per curiam*, 777 F. App'x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b). Marks may be confusingly similar in appearance where similar terms or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression. *See Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1495, 1 USPQ2d

1813, 1817 (Fed. Cir. 1987) (finding COMMCASH and COMMUNICASH confusingly similar); *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985) (finding CONFIRM and CONFIRMCELLS confusingly similar); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983) (finding MILTRON and MILLTRONICS confusingly similar); TMEP §1207.01(b)(ii)-(iii).

In this matter, as the Examining Attorney pointed out, the compared marks both contain the phrases “NO ONE WILL KNOW” and “EVERYONE WILL NOTICE”.

Furthermore, confusion is likely between two marks consisting of reverse combinations of the same elements if they convey the same meaning or create substantially similar commercial impressions. TMEP §1207.01(b)(vii); *see, e.g., In re Wine Soc’y of Am. Inc.*, 12 USPQ2d 1139, 1142 (TTAB 1989) (holding THE WINE SOCIETY OF AMERICA and design for wine club membership services including the supplying of printed materials likely to be confused with AMERICAN WINE SOCIETY 1967 and design for newsletters, bulletins, and journals); *In re Nationwide Indus. Inc.*, 6 USPQ2d 1882, 1884 (TTAB 1988) (holding RUST BUSTER for a rust-penetrating spray lubricant likely to be confused with BUST RUST for a penetrating oil)

This factor weighs in Petitioner’s favor.

Relatedness of the Services

Petitioner believes its services are different than Registrant’s and offered in different channels of trade. 23 TTABVUE 123. However, the Examining Attorney issued her Office Action citing Internet evidence alleging to establish that entities commonly provide cosmetic and plastic surgery, as well as beauty spa services, and market the services under the same mark. “Thus, applicant’s and registrant’s services are considered related for likelihood of confusion

purposes.” Citing *See, e.g. In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69 (TTAB 2009).

Should this Board agree with Examining Attorney, this factor weighs in Petitioner’s favor.

Third-Party Uses

The sixth *DuPont* factor requires consideration of any evidence pertaining to “the number and nature of similar marks in use on similar goods.” In an attempt to show that Petitioner’s mark has become generic, Respondent submits testimony of Frank J. Bonini, Jr., a patent attorney representing Respondent in this proceeding. 24 TTABVUE. Mr. Bonini testified about his search of the Internet which revealed third party uses of his client’s Mark [EVERYONE WILL NOTICE BUT NO ONE WILL KNOW] or similar. However, several of the documents produced do not show trademark usage of the phrase nor do they reveal date information. Additionally, nearly all the use shown depicts the Registrant’s Mark and not Petitioner’s Mark. Notably, Respondent does not cite to a single registration by any of these alleged users. The purpose of introducing evidence of third-party use is to show that customers have become so conditioned by a plethora of such similar marks that customers have been educated to distinguish between different such marks on the bases of minute distinctions. *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693 (Fed.Cir. 2018)(quoting *Palm Bay Imps., Inc.*, 73 USPQ2d at 1694). If the evidence established that the consuming public is exposed to third-party use of similar marks on similar goods and services, this evidence is relevant to show that the mark is ‘relatively weak and entitled to only a narrow scope of protection’ – not that the mark is incapable of registration as Respondent seems to argue. *Palm Bay Imps.*, 73 USPQ2d at 1693. Regardless, while giving some weight to the evidence of third-party use, the weight is limited given the absence of any corroborating facts bearing on the extent

of such use. *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1112 (TTAB 2207). That is to say, there are no specifics regarding the sales or promotional efforts surrounding the third-party marks. Thus, it cannot be concluded that consumers have become conditioned to recognize that several other entities use Petitioner's mark NO ONE WILL NOTICE...EVERYONE WILL KNOW for medical services, plastic surgery services, or cosmetic and plastic surgery services. *Id.* (citing *Carl Karcher Enterprises, Inc. v. Stars Restaurant Corp.*, 35 USPQ2d 1125, 1130-31 (TTAB 1995)). This factor weighs in favor of Petitioner or at least should be found to be neutral.

CONCLUSION

For the above reasons Petitioner has priority and shown there is a likelihood of confusion and, therefore, prays the Board grant Cancellation No. 92078349 cancelling U.S. Registration No. 5,845,907 pursuant to 15 U.S.C. §1064.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I, Annette P. Heller, attorney for Petitioner, hereby certify that a copy of this document was served on counsel of record, Frank J. Bonini, Jr. via email to fbonini@boninilaw.com this 15th day of March, 2024.

/aph76/
Annette P. Heller, Attorney for Petitioner