

This Opinion Is Not a
Precedent of the TTAB

Mailed: October 30, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Judith Gurley Plastic Surgery, LLC

v.

David J. Witchell Salon & Spa, Inc.

Cancellation No. 92078349

Annette P. Heller, of Heller & Associates, for Judith Gurley Plastic Surgery, LLC.

Frank J. Bonini, Jr. of Bonini IP Law LLC, for David J. Witchell Salon and Spa, Inc.

Before Heasley, Thurmon, and O'Connor, Administrative Trademark Judges.

Opinion by Thurmon, Administrative Trademark Judge:

David J. Witchell Salon & Spa, Inc. ("Respondent") owns a Principal Register registration for the mark EVERYONE WILL NOTICE BUT NO ONE WILL KNOW, in standard characters, for "hair and skin salon services; beauty spa services, namely, cosmetic body care," in International Class 44.¹ Judith Gurley Plastic Surgery, LLC

¹ Registration No. 5845907 issued on the Principal Register on Aug. 27, 2019, based on an application filed Nov. 14, 2016 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b),

“Petitioner”) seeks cancellation of this registration, alleging common law priority and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on alleged prior common law use of the mark NO ONE WILL KNOW ... EVERYONE WILL NOTICE for medical, cosmetic, and plastic surgery services.² Respondent denied most allegations in the petition, most often by “den[ying] that Petitioner has a ‘mark’”³ Respondent raised three affirmative defenses—non-exclusivity of use, abandonment and fraud—but at trial, Respondent pursued only one defense, that Petitioner’s claimed common law mark fails to function as a mark.⁴ This defense is grounded in the “non-exclusivity” defense asserted in the Answer and for that reason, we find it is supported by Respondent’s answer.

The issues before us, therefore, are priority and likelihood of confusion under Petitioner’s Section 2(d) claim, and Respondent’s defense. Having carefully considered the record and the parties’ arguments, we find Petitioner has carried its burden of proving common law priority and likelihood of confusion. We find no merit to Respondent’s defense. For these reasons, we grant the petition to cancel.

alleging a bona fide intention to use the mark in commerce. Registrant’s Statement of Use claimed use anywhere and in commerce at least as early as March 16, 2016.

² 1 TTABVUE (Petition to Cancel). When we cite to the record, we refer to TTABVUE, the Board’s docketing system, by docket entry and page number of the downloaded document (e.g., 26 TTABVUE 14).

³ 9 TTABVUE 2-3 (Answer).

⁴ 27 TTABVUE 9-15.

I. The Record

The record consists of the pleadings and, pursuant to Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b), the prosecution file for Respondent's subject registration. The record also includes evidence submitted by the parties. Petitioner submitted the following:

- Two testimonial declarations of Kelly M. Spann, an attorney representing Petitioner;⁵ and,
- A Testimonial Declaration of Dr. Judith Gurley, owner of Petitioner.⁶

Respondent submitted the following evidence:

- A Notice of Reliance on Printed Publications, Discovery Responses and Trademark Filings;⁷
- A Testimonial Declaration of Frank J. Bonini, Jr., Respondent's counsel;⁸ and,
- A Testimonial Declaration of David J. Witchell, a co-owner of Respondent.

II. The Claim and the Defense

Petitioner's Section 2(d) claim is its sole ground for cancellation. Respondent pled three "affirmative defenses" in its Answer, but presented only the failure to function as a mark defense at trial. The remaining defenses set out in the Answer are impliedly waived or forfeited because Respondent did not pursue them at trial. *In re*

⁵ 20 TTABVUE; 22 TTABVUE. Both declarations present testimony and exhibits concerning Internet use.

⁶ 21 TTABVUE.

⁷ 23 TTABVUE.

⁸ 24 TTABVUE. The declaration provides as exhibits Internet screenshots. There are ninety-two such exhibits, and the declaration provides the URLs and dates the sites were accessed. As such, it meets our requirements for such evidence, but as we note below, simply providing such screenshots without any context is of limited probative value.

Google Tech. Holdings LLC, 980 F.3d 858, 862-63 (Fed. Cir. 2020) (holding that arguments not presented to the Patent Trial and Appeal Board were forfeited, while noting that the loss of such rights has been identified as “waiver” in prior decisions); *see also Peterson v. Awshucks SC, LLC*, Can. No. 92066957, 2020 TTAB LEXIS 520, *2-3 at n.3 (party “did not present any evidence or argument with respect to these asserted defenses at trial, so they are deemed waived”).⁹

III. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action must be established in every inter partes case. *See Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 1304-05 (Fed. Cir. 2020). A party in the position of plaintiff may petition to cancel a registration when it demonstrates (i) an interest falling within the zone of interests protected by the statute and (ii) a reasonable belief in damage that is proximately caused by registration of the mark. *Meenaxi Enter., Inc. v. Coca-Cola Co.*, 38 F.4th 1067, 1070-71 (Fed. Cir. 2022); *Corcamore*, 978 F.3d at 1304.

In other words, Petitioner must demonstrate a real interest in the proceeding and a reasonable belief of damage from continued registration of Respondent’s mark. *Australian Therapeutic Supplies Pty. v. Naked TM, LLC*, 965 F.3d 1370, 1373-74 (Fed. Cir. 2020); *see also Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d

⁹ This opinion cites to the Federal Reporter series and United States Patents Quarterly (USPQ) series for decisions of the federal courts. For decisions of this Board, this opinion cites primarily to the USPQ, but for more recent Board decisions that lack USPQ pagination in the LEXIS database, citations are directly to the LEXIS database rather than to the USPQ. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 101.03 (2024) for acceptable citation forms to TTAB cases.

1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727 (Fed. Cir. 2012). Demonstrating a real interest in cancelling the registration of a mark satisfies the zone-of-interests requirement, and “[i]n most settings, a direct commercial interest satisfies the ‘real interest’ test.” *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1377 (Fed. Cir. 2002).

Petitioner meets these requirements based on its claim of common law rights in its mark and the fact that the USPTO refused registration of Petitioner’s mark under Section 2(d) of the Act, based on Respondent’s registration.¹⁰ These facts show that Petitioner has an interest in its mark and that the continued registration of Respondent’s mark may cause harm to Petitioner. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Yazhong Investing Ltd. v. Multi-Media Tech. Ventures, Ltd.*, 126 USPQ2d 1526, 1532 (TTAB 2018); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036, 1041 (TTAB 2012). Petitioner’s interest in canceling the challenged registration is real and shows that it is not a mere intermeddler. Respondent does not dispute Petitioner’s entitlement to bring this cause of action.

¹⁰ App. Ser. No. 88304473 for NO ONE WILL KNOW... EVERYONE WILL NOTICE for “medical services, plastic surgery services; cosmetic and plastic surgery” in International Class 44, filed on February 16, 2019, claiming first use anywhere and in commerce since at least as early as 2007. Respondent submitted parts of the record from Petitioner’s suspended trademark application, including a Response to Office Action that begins with a reference to the Section 2(d) refusal based on Respondent’s registration. 23 TTABVUE 22.

IV. Section 2(d) Claim

To prevail on its Section 2(d) claim, Petitioner must prove, by a preponderance of the evidence, that it has priority in the use of its pleaded mark NO ONE WILL KNOW ... EVERYONE WILL NOTICE and that Respondent's use of its EVERYONE WILL NOTICE BUT NO ONE WILL KNOW mark in connection with the services identified in its registration is likely to cause confusion, mistake, or deception as to the source or sponsorship of those services. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000).

A. Priority

“To establish priority, the petitioner must show proprietary rights in the mark that produce a likelihood of confusion. 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.” *Herbko*, 308 F.3d at 1162, 64 USPQ2d at 1378 (internal citation omitted).

Petitioner does not have a registration, and instead relies on alleged common law rights in its mark. To establish prior common law rights, Petitioner must show use of a distinctive mark, inherently or otherwise, in the United States, before the earliest priority date of Respondent. *See* 15 U.S.C. § 1052(d) (mark may be denied registration if it “so resembles ... 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 applicant, to cause confusion, or to cause mistake, or to deceive”); *Vidal*

v. Elster, 602 U.S. 286, 290-91 (2024) (quoting *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 142 (2015)); *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981) (plaintiff must establish proprietary rights, either inherently or by acquisition of secondary meaning in, pleaded common-law mark); *Arsa Distrib., Inc. v. Salud Natural Mexicana S.A. de C.V.*, Opp. No. 91240240, 2022 TTAB LEXIS 347, at *19-20; *Exec. Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1180 (TTAB 2017) (“[B]ecause unregistered marks are not entitled to the presumptions established under Trademark Act Section 7(b)-(c), it is [plaintiff’s] burden to demonstrate that it owns a trademark that was used prior to [defendant’s] first use or constructive use of its mark and not abandoned.”).

Petitioner claims priority based on common law use of the mark NO ONE WILL KNOW ... EVERYONE WILL NOTICE. The first question we must address is whether the mark is inherently distinctive. If it is, then the first use of the mark, if followed by other uses in a reasonably continuous manner, will establish Petitioner’s priority date. If, on the other hand, the mark is merely descriptive, Petitioner’s priority date would be the date by which the mark acquired distinctiveness. “As to any marks that are not inherently distinctive, Opposer must establish that the designations acquired distinctiveness prior to Applicant’s constructive use date.” *Perma Ceram Enters. Inc. v. Preco. Indus. Ltd.*, 1992 WL 156544, *4 (TTAB 1992); see also *Shenzhen IVPS Tech. Co. Ltd. v. Fancy Pants Prods., LLC*, 2022 WL 16646840, *16 n.52 (TTAB 2022).

Though Respondent argues that Petitioner owns no rights in its asserted mark, Respondent does not argue the mark is merely descriptive.¹¹ We find Petitioner's mark is inherently distinctive, as it does not directly describe, but only suggests, a feature or quality of Petitioner's services. Petitioner's mark is at least as distinctive as Respondent's mark, which registered on the Principal Register without a showing of acquired distinctiveness. Petitioner, therefore, obtained common law rights from the first use that was followed by a reasonably continuous pattern of use of the mark. *See, e.g., Lowell Int'l Co. v. Quimby*, 69 F. App'x 462, 465 (Fed. Cir. 2003) ("Only actual, active use of the mark ensures that such an association can be made in the consumer's mind and 'notifies other firms that the mark is so associated.'").

In support of Petitioner's Section 2(d) claim, Dr. Gurley testified that Petitioner has used this mark "continuously since at least as early as 2007 ..."¹² An example of such a use, an advertisement from 2007, follows.

¹¹ Respondent never mentions descriptiveness in its brief, nor does it mention inherent distinctiveness. 27 TTABVUE. "If a party fails to reference a pleaded claim or affirmative defense in its brief, the Board will deem the claim or affirmative defense to have been waived." TBMP § 801.01. *See also Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 (TTAB 2013) ("Insofar as petitioner has not argued the descriptive or geographically descriptive claims in its brief, we find, in accordance with the Board's usual practice, that those claims have been waived.").

¹² 21 TTABVUE 2. Petitioner also submitted a similar use of its mark dating back to 2002. There is no evidence, testimonial or documentary, of any uses of this mark between 2002 and 2007. Petitioner does not argue for priority dating to 2002, an understandable position given the extended gap between uses. As explained below, the record shows numerous uses of the mark by Petitioner beginning in 2007.



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¹³ *Id.* at 8. The distortion in the image is in the record. It appears to be a result of a partially folded page.

As reflected in this image, the uses of the mark in the record do not exactly match the mark Petitioner asserts in this case. In the actual uses, the mark is NO ONE WILL KNOW. EVERYONE WILL NOTICE. Petitioner claims in this proceeding that its mark is NO ONE WILL KNOW ... EVERYONE WILL NOTICE, which differs in punctuation from the version

Petitioner submitted similar evidence showing other uses of the mark from 2007 and thereafter.¹⁴ Most of these uses are dated and are similar to the one shown above. Dr. Gurley testified about each of the uses, and further testified that the mark has appeared on her website “since at least January of 2009 to current.”¹⁵ Respondent did not cross-examine Dr. Gurley or offer any evidence or argument to refute Petitioner’s evidence that it has used the mark in the United States since 2007, well before Respondent’s earliest possible priority date. The testimony and corroborating documentary evidence are sufficient to establish common law priority. *See, e.g., W. Fla. Seafood, Inc. v. Jet Rests., Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994) (we must consider all probative evidence in evaluating priority); *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1053 (TTAB 2017) (“The presence of business records would strengthen the case that these transactions occurred in the ordinary course of trade, and the absence of such records does the opposite.”); *Exec. Coach Builders, Inc. v. SPV Coach Co., Inc.*, 123 USPQ2d 1175, 1180 (TTAB 2017) (“Oral testimony is strengthened by corroborative documentary evidence.”).

Respondent does not contest Petitioner’s prior uses of the mark, but instead argues that Petitioner’s mark fails to function as a mark, and for that reason,

we see in the record evidence. Respondent did not present any arguments based on this difference, and we find the two variations are essentially identical.

¹⁴ *Id.* at 8-41. The testimony and exhibits show multiple uses of the mark in advertising similar to the example above for each year from 2007 to 2013. There are also exhibits from 2015.

¹⁵ *Id.* at 3.

Petitioner did not acquire any common law trademark rights.¹⁶ Respondent is correct to the extent that it argues Petitioner must use its mark in the manner of a trademark. In that sense, the NO ONE WILL KNOW ... EVERYONE WILL NOTICE mark must be used in a manner that will create “a separate and distinct commercial impression, which thereby performs the trademark function of identifying the source of the goods [or services] to the customers.” *In re Chemical Dynamics, Inc.*, 839 F.2d 1569, 5 USPQ2d 1828, 1829-30 (Fed. Cir. 1988). We recently addressed this issue in connection with a mark used to identify a children’s book, where we noted

For ENGIRLNEER in the seal design to function as a source indicator for books, it must not function merely as part of the title of the book or the name of a character in the book. This is because a “title of a book [as a single work] ... does not perform a trademark function. That is, it does not identify the source of the book, but serves merely to identify the material found therein, i.e., the work of the author. In so doing it is nothing more than a descriptive designation therefor.” *In re Scholastic Inc.*, 223 USPQ 431, 431 (TTAB 1984) (“*Scholastic I*”). See also *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 64 USPQ2d at 1378; *In re Cooper*, 117 USPQ at 398. In addition, the name of a fictitious character appearing in a portion of a title and in the text of a book may not function as a trademark if it is not used in the manner of a trademark to identify the goods and distinguish them from those of others. *In re Caserta*, 46 USPQ2d at 1089 (addressing the name of a fictitious character FURR-BALL FURCANIA appearing only as part of the title and in the text of comic strips and comic magazines); see also *Scholastic I*, 223 USPQ 431 (TTAB 1984) (THE LITTLES, as used in the title of each book, would be viewed as identifying the main character in the book and not as a trademark for books).

DeVivo v. Ortiz, 2020 TTAB LEXIS 15, *22-23.¹⁷

¹⁶ 27 TTABVUE 8 (“Petitioner cannot establish its alleged prior use rights because Petitioner’s alleged mark fails to function as a mark”).

¹⁷ While this decision focused on uses in connection with a book, the Board’s analysis of what it means for an identifier to “function as a mark” is instructive here. The factual circumstances are different, but we find Petitioner’s mark functions as a mark for the same reasons set out in the excerpt, namely that the mark is “used in the manner of a trademark to identify the goods and distinguish them from those of others” See also *B&B Hardware*,

“The critical inquiry in determining whether a designation functions as a mark is how it would be perceived by the relevant public.” *Major League Baseball Players Ass’n v. Chisena*, Opp. Nos. 91240180, 91242556, and 91243244, 2023 TTAB LEXIS 117, *45-46 (citing *U. S. Pat. & Trademark Off. v. Booking.com B.V.*, 591 U.S. 549, 560-61, 2020 USPQ2d 10729 (2020)). In determining how a designation would be perceived by the relevant public, the Board looks to specimens of use, where available, and other evidence of record showing how the designation is actually used in the marketplace. *In re Vox Populi Registry Ltd.*, 25 F.4th 1348, 1351 (Fed. Cir. 2022). In the present case, the question is whether the mark serves to identify and distinguish Petitioner and the services it offers. In the advertisement provided above, consistent with Petitioner’s other advertisements of record, the NO ONE WILL KNOW. EVERYONE WILL NOTICE phrase is being used as a mark. It is set apart from other textual material, appearing next to and in similar prominence as the Dr. Judith Gurley Plastic Surgery and logo designation. The NO ONE WILL KNOW. EVERYONE WILL NOTICE phrase appears in a larger font than informational matter below it, and does not directly identify or describe the services Petitioner provides.

Given the evidence of record—testimonial and documentary—we find Petitioner has established common law priority in the mark NO ONE WILL KNOW ...

Inc. v. Hargis Industries, Inc., 575 U.S. 138, 142 (2015) (“The principle underlying trademark protection is that distinctive marks—words, names, symbols, and the like—can help distinguish a particular artisan’s goods from those of others.”).

EVERYONE WILL NOTICE for cosmetic plastic surgery and related medical procedures.

B. Likelihood of Confusion

Our determination under Trademark Act Section 2(d) involves an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, hereinafter referred to as “*DuPont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). A likelihood of confusion analysis often focuses on the similarities between the marks and the similarities between the goods or services. *See 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). We must consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

Respondent takes the same approach to the likelihood of confusion element of Petitioner’s Section 2(d) claim, by arguing that there is no likelihood of confusion “because Petitioner does not have any rights in what Petitioner alleges as a ‘mark’ and there is therefore no right in any ‘mark’ to be confused with.”¹⁸ Again, Respondent

¹⁸ 27 TTABVUE 15.

fails to address the merits of the likelihood of confusion issue and relies entirely on its fails-to-function arguments. We have no choice but to deem this a concession by Respondent on the issue of likelihood of confusion because Respondent provided no arguments or evidence on any of the *DuPont* factors and failed to address the substance of this critical claim element. Despite Respondent's lack of argument, we will evaluate the first two *DuPont* factors, as those were addressed by Petitioner.¹⁹

1. Similarity of the Marks

We consider the marks in their entireties as to appearance, sound, connotation and commercial impression. *See, e.g., Palm Bay Imps., Inc. v. Veuve Clicquot Pansardin Maison Fondée En 1772*, 396 F.3d 1369, 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 (Fed. Cir. 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.").

"The 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." *Coach Servs. Inc. v. Triumph Learning, LLC*, 668 F.3d 1356,

¹⁹ Because of Registrant's apparent concession that confusion is likely, "we offer only a brief explanation of our conclusion." *In re Morinaga Nyugyo K.K.*, 2016 WL 5219811, *1-2 (TTAB 2016).

101 USPQ2d 1713, 1721 (Fed. Cir. 2012). The focus is on the recollection of the average purchaser, who normally “retains a general rather than a specific impression of marks.” *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018).

Petitioner’s mark is NO ONE WILL KNOW ... EVERYONE WILL NOTICE, while Respondent’s registered mark is EVERYONE WILL NOTICE BUT NO ONE WILL KNOW. These marks are variations on the same message, namely that everyone will notice that a customer looks different after receiving the services, but that no one will know the customer received such services. The marks are essentially identical in connotation and commercial impression.²⁰

The marks are not as similar visually or in sound, simply because they are reverse forms of the message. Switching the order of the phrases creates a visual and aural difference. But given the essentially identical messages conveyed by the two marks, we find it likely that consumers will forget which mark was in which order, so that even the visual difference apparent when the marks are seen side-by-side will quickly fade in consumers’ minds, as the core message remains. *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, and AMERICAN WINE SOCIETY 1967 and design for newsletters, bulletins, and journals, likely to cause confusion). For this reason, we

²⁰ Respondent uses the word “but” in its mark in the same way Petitioner uses the ellipsis in its mark. Both uses create a pause between the two component phrases of each mark. We don’t find this small difference significant, as consumers are more likely to recall the two phrases in each mark.

find the reduced visual similarity will have less impact on consumers than the essentially identical meaning of these two marks. Overall, we find the marks are similar.

2. Similarity of the Services

Petitioner's common law rights are limited to the actual services with which it uses its mark. As we noted above, Petitioner has shown use with a variety of medical, cosmetic, and plastic surgery procedures, the same services identified in the uses of the mark Petitioner submitted into the record. By contrast, for Respondent, the following principle applies:

The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods [or services] set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods [or services], the particular channels of trade or the class of purchasers to which the sales of goods [or services] are directed.

Octocom Sys., Inc. v. Hous. Comput. Servs. Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *see also Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014).

Respondent's Registration identifies, among other services, "cosmetic body care."²¹ Petitioner's advertisement, featured above, includes the following services (among others): facials, pumpkin peel facial, and massage. While some of Petitioner's services are surely only performed by a licensed physician (e.g., cosmetic and reconstructive surgery), we find the services listed above are types of "cosmetic body care" provided

²¹ Registration No. 5845907.

by spas like the one operated by Respondent. We further note that some of the third-party evidence submitted by Respondent appears to show businesses that offer some of the specific services provided by Petitioner and other types of cosmetic spa services, like those identified in the challenged Registration.²²

C. Conclusion: Petitioner Has Proven Its Section 2(d) Claim

Petitioner has satisfied both elements of its Section 2(d) claim.

V. Respondent's Defense

Respondent argues that Petitioner's claimed mark fails to function as a trademark "because widespread use of the same or nearly identical matter in the field of cosmetic and plastic surgery has resulted in the matter's inability to distinguish the goods and services offered under the mark by Petitioner."²³ Considering all of the arguments and evidence of record, we find that Respondent has not shown that Petitioner's mark **NO ONE WILL KNOW ... EVERYONE WILL NOTICE** fails to function as a mark.

²² See, e.g., 24 TTABVUE 70-77 (documents identifying The Spa at Mecca and listing "facials and peels," "massage," and "botox"). This document is from the Internet Archive and Respondent provided no testimonial foundation for submission of such records. We treat this evidence as hearsay, as we explain below, and give it little weight. The evidence shows on its face that a spa like the one Respondent operates offers some of the same cosmetic services provided by Petitioner.

Evidence that other companies offer the goods of both parties under the same mark tends to show that consumers will perceive the goods as related. See, e.g., *Naterra Int'l, Inc. v. Bensalem*, 92 F.4th 1113, 1117 (Fed. Cir. 2024); *In re Detroit Athletic Co.*, 903 F.3d 1297, 1306 (Fed. Cir. 2018).

²³ 27 TTABVUE 12. We construe Respondent's fails to function arguments as both (1) a challenge to priority, because, as we explained above, a proposed mark must actually function as a mark to develop common law rights; and, (2) as an affirmative defense grounded on evidence of third-party use of a similar phrase on the Internet. The latter approach accounts for the vast majority of Respondent's arguments.

We noted above that Petitioner’s mark is inherently distinctive and has been used in commerce in the United States since 2007. We found the mark functions as a trademark in the way it has been used by Petitioner.

The question here is whether Respondent has presented sufficient evidence—here, the evidence consists entirely of Internet screenshots from third-party websites—to show that Petitioner’s mark fails to function as a mark. First and foremost, this evidence shows uses of **Respondent’s** mark, **EVERYONE WILL NOTICE BUT NO ONE WILL KNOW**. Ironically, Respondent’s third-party evidence shows the version Respondent uses rather than Petitioner, as the examples below illustrate.



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²⁴ *Id.* at 19.

²⁵ *Id.* at 22.

This difference runs through all the evidence Respondent submitted. If the evidence shows a term that fails to function as a trademark, it must be Respondent's mark. Or perhaps Respondent believes evidence of one is as good as evidence of the other. It is, at the least, another striking weakness of Respondent's attempted proof.

Returning to the two examples provided above, we can see that this message has been used in the context of certain cosmetic procedures, such as dermal fillers, which appear to be the same services offered by Petitioner.²⁶ And at least for the type of use shown on the right, we can tell this was intended for circulation to prospective customers. That is a step in the right direction, but again the lack of supporting testimony means we are left to guess at what was actually done with this item. Was it ever really used? If so, how many copies were distributed? When? For how long? These are the kinds of questions that must be answered to determine whether this particular item had any impact on consumers. We do not mean to suggest that it is improper for counsel to surf the Internet looking for such uses, but that practice, standing alone, results in the sort of evidence before us in this case. Counsel may do some investigating, but when it comes to trial, evidence of third-party uses may need supporting testimony to put the documentary evidence into context.

Submitting Internet screenshots without any explanatory or contextual testimony complies with the admissibility rules at the Board, but probativity and admissibility are two very different concepts. We explained in *Safer, Inc. v. Oms Invs.*, 94 USPQ2d 1031 (TTAB 2010) the rule change that broadened the utility of the Notice of Reliance,

²⁶ This evidence further supports our finding that the services are similar or related.

while also noting some of the pitfalls in relying on such evidence without context or explanation.

By this change, the Board is expanding the types of documents that may be introduced by notice of reliance to include not only printed publications in general circulation, but also documents such as websites, advertising, business publications, annual reports, studies or reports prepared for or by a party or non-party, if, and only if, they can be obtained through the Internet as publicly available documents. This approach facilitates the introduction of matter for the limited purpose of demonstrating what the documents show on their face. We underscore that a printout from a webpage may have more limitations on its probative value than traditional printed publications. A party may increase the weight we will give such website evidence by submitting testimony and proof of the extent to which a particular website has been viewed. Otherwise, it might not have much probative value.

Id. at 1039. The records Respondent submitted include nothing but the bare screenshots. This evidence establishes that such a screen image existed on the date Respondent's counsel accessed the sites. That is all the evidence establishes, and it falls far short of showing that a phrase is in such widespread use that it cannot function as a trademark when used in the manner of a mark.

Petitioner points out that over half of all the screenshots Respondent submitted relate to a single product, the Juvederm product offered by Allergan.²⁷ For other websites, Applicant admittedly provided multiple screenshots, purportedly to show

²⁷ 28 TTABVUE 7. Respondent's arguments that one or more of these third parties is the senior user, 27 TTABVUE 8, are not well taken. *See, e.g., Avia Grp. Int'l Inc. v. Faraut*, Can. No. 19382, 1992 TTAB LEXIS 62, *4, 25 USPQ2d 1625, 1627 (“[T]he issue in a [cancellation] proceeding such as this is what rights petitioner has in its pleaded marks vis-a-vis the defendant, not what rights anyone else may have in it.”).

continuity of use by the third party.²⁸ Other screenshots appear to show materials targeted at medical professionals rather than ordinary consumers. We expect this targeted marketing is somewhat common in medical fields, but again, we have no evidence to confirm that expectation, and therefore, cannot rely upon it. Still other websites are not based in the United States.²⁹

In conclusion, we reject Respondent's defense based on lack of probative evidence of record. Respondent's evidence shows that some unknown number of uses of Respondent's mark, or slight variations of that mark, were found on the Internet in early December, 2023.³⁰ That is hardly a sufficient basis to reject Petitioner's claim of common law trademark rights.³¹

Decision: The petition to cancel is **granted**.

²⁸ 27 TTABVUE 7; see, e.g., 24 TTABVUE 69-77, 423-37 (two exhibits are pages from Mecca Spa NJ); 51-68, 406-22 (two exhibits are pages from Finn Plastic Surgery website); 107-10, 438-41 (two exhibits are pages from Dr. Sarhaddi website).

²⁹ 24 TTABVUE 8; see, e.g., id. 45, 399 (two exhibits are pages from website based in New Zealand); 748 (exhibit described as being pages from Facebook page based in Malaysia).

³⁰ We found, in our likelihood of confusion analysis, that these marks, though inverses of each other, create the same connotation and commercial impression. For that reason, evidence showing either version could be probative, but in this case, even if the evidence showed uses of Petitioner's mark, it would still fail to support the defense for the other reasons given above.

³¹ We note, too, that Respondent did not cite authority for the application of this defense to a claim of common law trademark rights. We need not resolve that issue here, as we find the evidence is insufficient.