

THIS OPINION IS
NOT A PRECEDENT
OF THE TTAB

Mailed: February 19, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Townsend Enterprises, Inc.

v.

Creative Resources, LLC

Opposition No. 91169559
to Application No. 78502047
filed on October 19, 2004

Opposition No. 91169560
to Application No. 78525940
filed on December 2, 2004

Susan Freya Olive, Olive & Olive, PA for opposer.

Paul F. Kilmer, Holland and Knight, for applicant.

**Before Grendel, Kuhlke, and Mermelstein, Administrative
Trademark Judges.**

Opinion by Mermelstein, Administrative Trademark Judge:

Applicant seeks registration of the marks BETTER SEX¹
and BETTER SEX.....NAKED² (both in standard characters)
for "prophylactics, namely condoms" in International Class
10. Townsend Enterprises opposed registration of both
applications, arguing that use of the opposed marks on the
identified goods would be likely to cause confusion in view

¹ Filed December 2, 2004, alleging a *bona fide* intent to use the
mark in commerce.

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of its prior use and registration of similar marks for related goods. Trademark Act § 2(d); 15 U.S.C. § 1052(d). Because the above-captioned oppositions involve the same parties, similar marks, and virtually identical issues, we decide both oppositions in this single opinion, taking account of the differences between the two proceedings as appropriate.³

Opposer filed a notice of reliance and submitted a brief. Applicant submitted neither evidence nor a brief.

We sustain the oppositions.

I. Record

The record consists of the pleadings and the following evidence submitted with opposer's notice of reliance.

- Opposer's unanswered requests for admission, served September 20, 2006, in both oppositions;
- Status and title copies, prepared by the USPTO, indicating current validity and opposer's ownership of
 - Registration No. 1641091 of the mark THE BETTER SEX VIDEO SERIES (typed) for "pre-recorded video tapes covering intimacy counseling of couples" in International Class 9.⁴ ("091 Registration.")

² Filed October 19, 2004, alleging a *bona fide* intent to use the mark in commerce.

³ Both oppositions were filed on the same day. It would have been better practice for opposer to have filed them as one proceeding. See TRADEMARK BOARD MANUAL OF PROCEDURE (TBMP) § 305 (2d ed. rev. 2004). Doing so would have avoided potential conflicts in schedules and evidence, and would have avoided duplication of effort by both the parties and the Board.

⁴ Issued April 16, 1991, alleging first use and use in commerce as of November 13, 1989. Section 8, 9, and 15 filings accepted, granted and acknowledged, respectively. Registrant disclaimed the exclusive right to use "VIDEO SERIES" and "SEX" apart from the mark as shown.

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- o Registration No. 3107809 of the mark BETTER SEX SYNERGY PLEASURE SYSTEM (standard characters) for "Electric and non-electric massage apparatus, vibrators, and instructional materials provided therewith; kits and gift packages containing one or more of electric and non-electric massage apparatus and vibrators, together with instructional materials and adult sexual aids for use therewith" in International Class 10.⁵ ("`809 Registration.")

II. Pleadings

In its notices of opposition, opposer alleges its use in commerce of marks including the words "BETTER SEX,"⁶ on goods including "prophylactics, namely condoms," and "informational and instructional materials, educational services, and entertainment products," and that such use predates the filing of the subject applications. Opposer alleges that it also provides "a wide variety of products for use with condoms in human sexual expression, ranging from lotions and lubricants to vibrators, books, games, and music." Opposer further asserts ownership of the '091 Registration; that "[a]pplicant's mark so resembles opposer's marks as to be likely to cause confusion..."; and that registration of the opposed application "is likely to interfere with Opposer's use and exploitation of its own

⁵ Issued June 20, 2006, alleging first use and use in commerce as of September 26, 2005.

⁶ BETTER SEX, BETTER SEX CONDOM SAMPLER, THE BETTER SEX VIDEO SERIES, BETTER SEX VIDEO, BETTER SEX UNIVERSITY, and the domain name www.bettersex.com.

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marks and is likely to diminish and dilute the goodwill associated with Opposer's ... marks."

By its answers, applicant denied (or denied for lack of knowledge) each of opposer's allegations.

III. Preliminary Matters

First, to the extent opposer intended to allege that registration of applicant's mark would result in dilution⁷ pursuant to Trademark Act § 43(c), 15 U.S.C. § 1125, we find that such allegation was not properly pleaded (opposer did not allege that its mark was famous), nor was it tried. Accordingly, we give the issue of dilution no further consideration.

Second, the notice of opposition alleges opposer's ownership of the '091 Registration, but does not mention the '809 registration (or the then-pending application from which it subsequently issued). Nonetheless, because opposer filed a copy of this registration during its trial period without objection from applicant, and opposer's ownership and the validity of both registrations was admitted by applicant, we deem the issue of likelihood of confusion with respect to the '809 Registration to have been tried by consent, Fed. R. Civ. P. 15(b)(2), and deem the pleadings amended accordingly.

⁷ "Registration and/or use of Applicant's mark ... is likely to ... diminish and dilute the goodwill associated with Opposer's ... marks...." Notice of Opp. ¶ 7.

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Finally, we note opposer's argument in its brief that it "has, in effect, established a family of BETTER SEX marks." Applicant's Br. at 9. Like dilution, this issue was neither pleaded nor tried. Although applicant has established registration and use of the words "BETTER SEX" as a component of several marks, it takes a good bit more to establish a "family" of marks, *see J&J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991) ("Simply using a series of similar marks does not of itself establish the existence of a family. There must be a recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods."), and there was nothing in the notices of opposition or opposer's trial evidence which would have put applicant on notice that this issue was being raised. As with dilution, we give this matter no further consideration.

IV. Factual Findings

By its proper submission of status and title copies of its registrations, opposer has established that such registrations are currently subsisting and owned by opposer. Trademark Rule 2.122(d)(2).

The matters set out in opposer's requests for admission are conclusively established by virtue of applicant's failure to respond to them. Fed. R. Civ. P. 36(a)(3),

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36(b). We find the following admissions⁸ particularly relevant:

3. Opposer is the owner of Federal Registration 1,641,091 for THE BETTER SEX VIDEO SERIES, registered in 1991.
4. Opposer is the owner of Federal Registration 3,107,809 for BETTER SEX SYNERGY PLEASURE SYSTEM.
5. The registrations cited in Request for Admission numbers 3 and 4 above are presently subsisting and are presumptively valid.
10. Opposer uses the mark BETTER SEX CONDOM SAMPLER in connection with prophylactics, namely condoms.
11. Opposer uses the term BETTER SEX in connection with a number of sexual health products, including BETTER SEX GEL LUBRICANT, BETTER SEX MASSAGE OIL and BETTER SEX POTIONS.
12. Opposer uses the mark THE BETTER SEX VIDEO SERIES in connection with pre-recorded videotapes concerning intimacy counseling of couples, including human sexual relations.
13. Opposer uses the mark BETTER SEX UNIVERSITY in connection with the provision of articles, research, statistics, tips and the like regarding intimacy and sexual health.
14. Opposer's BETTER SEX VIDEO SERIES includes instruction on condom use.
15. Condoms are typically used in regard to sexual health, including the prevention of contraception and the transmission of sexually transmitted disease.
17. The thin, protective design of a condom is such to emulate the feeling of nakedness.

⁸ Requests for admission served in Opp. No. 91169559. The requests for admission in 91169560 are essentially the same, but for the requests directed to the significance of the term "naked."

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18. Condoms are often marketed with emphasis on the product's ability to not interfere with the feeling of nakedness.
19. Condoms are designed so that the individual wearing it maintains a feeling of nakedness.
20. The term "naked" frequently is used in connection with condoms.
25. Applicant's goods bearing Applicant's proposed Mark would be sold through many of the same channels of commerce as those through which Opposer's goods bearing Opposer's Marks are sold.
26. The goods and/or services that Applicant seeks to provide under Applicant's Mark are substantially similar to the goods and/or services provided by Opposer under Opposer's Marks.
27. Applicant's proposed mark is substantially similar to Opposer's marks.
33. Opposer has been using the mark BETTER SEX in commerce since long prior to October 19, 2004.
47. Applicant has not sold any goods under Applicant's Mark.

V. Analysis

A. Standing and Priority

Opposer made its pleaded registrations of record, thus establishing its standing to oppose registration of applicant's mark. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Moreover, because opposer's pleaded registrations are of record, priority is not an issue in this case as to the marks and goods covered by them. *King*

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Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). With respect to opposer's asserted common-law rights, applicant admits that opposer uses its marks in commerce and has done so since prior to applicant's constructive use date, likewise establishing both standing and priority.

B. Likelihood of Confusion

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

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

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Applicant admitted that its marks are "substantially similar to opposer's marks." Even in the absence of the admission, we would find them similar in significant part because of applicant's appropriation of the dominant portion of opposer's marks. While we must consider the marks in their entirety, most of opposer's marks include the words "BETTER SEX" plus descriptive wording, which is less likely to create a strong commercial impression. See *In re N.A.D. Inc.*, 57 USPQ2d 1872, 1873 (TTAB 2000) ("These descriptive, if not generic, words have little or no source-indicating significance.") Accordingly, we find that "BETTER SEX" is the dominant portion of opposer's marks, and that this term is identical applicant's BETTER SEX mark, and the dominant portion⁹ of applicant's BETTER SEXNAKED mark.

Likewise, applicant admitted that its identified goods are "substantially similar" to the goods in connection with which opposer uses its marks. Further, applicant has admitted to opposer's use of the mark BETTER SEX CONDOM SAMPLER in connection with identical goods, and that the videotapes sold under its registered mark, THE BETTER SEX VIDEO SERIES, in fact include instruction on condom use, which is clearly within the scope of the goods in the registration. Applicant's other registration, for BETTER

⁹ Applicant's admissions also establish that "NAKED" is suggestive of condoms, and therefore entitled to relatively less weight in our analysis.

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SEX SYNERGY PLEASURE SYSTEM, covers goods including massagers, vibrators, and adult sexual aids, all items which can be used in conjunction with or at the same time as condoms. Finally, applicant has again admitted to opposer's use of marks including "BETTER SEX" in connection with "massage oil" and "sex gel lubricant," which can also be used with condoms.

Finally, applicant further admitted that the channels of trade for the respective goods are identical or overlapping, as both are sold through retail outlets and over the Internet.

In sum, we find that opposer has made a *prima facie* case under Trademark Act § 2(d), which applicant has not rebutted. Thus, we conclude that the record supports a finding of a likelihood of confusion as between applicant's BETTER SEX and BETTER SEX.....NAKED MARKS and opposer's registered and previously-used trademarks.

Decision: The oppositions are sustained pursuant to Trademark Act § 2(d).