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**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451**

Goodman

Mailed: August 18, 2005

Cancellation No. 92043178

Club Amenities, LLC

v.

Pettenon Cosmetici snc

Before Quinn, Kuhlke and Walsh, Administrative Trademark
Judges.

By the Board:

Pettenon Cosmetici snc, respondent, owns Registration
No. 2665115 issued on December 24, 2002 on the Principal

ALTER EGO

Register for the mark for "hair
fixing foams, hair sprays, hair fluid gels, hair lotions,
hair creams, shampoos, hair oils, hair masks, hair powder,
stabilized hydrogen peroxide for hair, coloring creams,
permanents, curative lotions, namely, non-medicated hair
lotions; lotions to prevent hair-loss" in International
Class 3.¹

¹ Filed on April 10, 2000, claiming a date of first use in
commerce of May 1999.

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On April 9, 2004, Club Amenities, LLC, petitioner, filed a petition to cancel the registration. As grounds for the cancellation proceeding, petitioner alleges that respondent's mark, when used in connection with the recited goods, so resembles petitioner's previously used ALTER EGO mark for "goods in the beauty care industry" as to be likely to cause confusion, mistake, or to deceive.² Petitioner has also pleaded ownership of application Serial No. 76539224

ALTER-EGO

for the mark for "cosmetics; cosmetics and cleaning preparations, namely mousse, sunscreen, hair gel, skin soaps, body lotions, hair shampoo, conditioner, combined body and hair shampoos, hair spray, shaving cream, aftershave lotion, aftershave splash, deodorant, antiperspirant, perfumes and colognes and mouthwash" in International Class 3.

In its answer, respondent, denies the salient allegations in the petition to cancel and has asserted affirmative defenses.

² Petitioner also alleges ownership of now cancelled Registration No. 1864486, for the mark ALTER EGO THE PERSONAL CARE COMPANION, ("personal care" disclaimed) for "skin soaps, body lotions, hair shampoo, conditioner, combined body and hair shampoos, hair spray, shaving cream, aftershave lotion, aftershave splash, deodorant, antiperspirant, perfumes and colognes and mouthwash" in International Class 3; claimed date of first use in commerce of January 1993. The registration issued on November 28, 1994 and was cancelled on December 8, 2001 under Section 8.

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This case now comes up on the following motions:

- 1) respondent's motion to extend discovery by an additional sixty days, filed December 3, 2004;
- 2) petitioner's motion for summary judgment on the grounds of priority and likelihood of confusion, filed December 3, 2004;
- 3) respondent's motion to strike petitioner's reply brief as exceeding the page limit, filed April 8, 2005; and
- 4) petitioner's motion to accept its over-length brief, filed May 12, 2005.

The motions are fully briefed.

We turn first to respondent's motion to strike petitioner's reply brief and petitioner's motion to accept its over-length brief.

In support of its motion to strike, respondent essentially argues that striking petitioner's thirteen-page reply is appropriate because the reply brief exceeds the page limit by three pages.

In response, petitioner argues that the Board should deny the motion to strike or disregard the last three pages of the reply brief. Alternatively, petitioner requests that the Board accept its over-length brief or allow petitioner to conform the reply brief to the ten (10) page limit.

The Board will not consider briefs that exceed the page limitation, nor will the Board dissect a party's brief to bring it within the allowable page limit. *Saint Gobain Corp. v. Minn. Mining & Mfg. Co.*, 66 USPQ2d 1220, 1222 (TTAB

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2003). Inasmuch as petitioner's reply brief is beyond the page limit set by Trademark Rule 2.127(a), petitioner's reply brief filed in connection with the motion for summary judgment will not be considered. However, we will consider the rebuttal evidence submitted with petitioner's reply.

Accordingly, respondent's motion to strike is granted to the extent indicated above.

We now turn to petitioner's motion for summary judgment on the grounds of priority and likelihood of confusion.

In support of its motion for summary judgment, petitioner argues that it has priority because its commercial use of its ALTER EGO mark has been continuous and dates back to January 1993 which predates respondent's claimed date of first use in commerce of May 1999. With regard to likelihood of confusion, petitioner maintains that confusion is likely because the parties' marks are identical and the parties' goods are "identical, overlapping, similar and/or related" "beauty care products."

As evidentiary support, petitioner has submitted a declaration of Jan Ellis, president of petitioner who avers that petitioner has used its ALTER EGO mark since at least as early as January 1993; that petitioner continues to use the ALTER EGO mark to the present day; and that petitioner intends to continue using the mark in the future; that from the date of first use until the present, the ALTER EGO mark

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has appeared on the labels of all of petitioner's products sold under the mark; that petitioner uses the mark on all advertising materials, price lists and petitioner's Internet website; and that from 1993 through 1999, petitioner had approximately \$2,000,000 in gross sales of 190,000 gallon units as well as sales of several thousand units in smaller sizes. In further support of these points, petitioner has submitted copies of advertisements, price lists and photos of the goods, in particular, file wrapper specimens from petitioner's now cancelled Registration no. 1864486 for the mark ALTER EGO THE PERSONAL CARE COMPANION and file wrapper specimens from its current application Serial No. 76539224 for the mark ALTER-EGO; a copy of its now cancelled registration for the mark ALTER EGO THE PERSONAL CARE COMPANION, and the TESS printout of its current application Serial No. 76539224 for the mark ALTER-EGO, as well as a print-out from its website evidencing use of the mark ALTER-EGO. Petitioner also submitted the following additional rebuttal evidence with its reply: declaration of Deborah Westervelt, counsel for petitioner, and accompanying exhibits which consist of petitioner's discovery responses to respondent's interrogatories, petitioner's answers to respondent's document requests, and copies of some of the documents petitioner produced during discovery in connection with respondent's document requests; second declaration of

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Jan Ellis, president of petitioner, in which Ms. Ellis avers that petitioner has provided, in response to respondent's discovery requests, more than 400 invoices dating from 1995 to the present; that retail sizes of its ALTER EGO products are 2, 12, 16, and 32 ounce bottles; that, due to cost, the current catalog in use was printed in the 1999-2000 time frame; that on February 14, 2003 petitioner became aware of the cancellation of the ALTER EGO THE PERSONAL CARE COMPANION registration; and that until that time petitioner believed petitioner had an active registration for that particular mark. As additional support for this declaration, petitioner submitted, among other things, three invoices dated from 1996.

In opposing the motion, respondent maintains that petitioner's "self-serving" declaration is insufficient to establish prior continuous use of the mark ALTER EGO prior to respondent's first use in commerce; that the evidence "at best" shows use of the mark ALTER EGO THE PERSONAL CARE COMPANION and not ALTER EGO alone; that any rights to the term ALTER EGO standing alone occurred after respondent received its registration; that petitioner's attempt to revert back to a 1993 date of first use for ALTER EGO alone fails for lack of proof; that petitioner fails to provide evidence of continuous use of the mark ALTER EGO THE PERSONAL CARE COMPANION; that to the extent that petitioner

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had any trademark rights in ALTER EGO THE PERSONAL CARE COMPANION, they were abandoned as evidenced by petitioner's failure to file its Section 8 affidavit for the registration and its "delay for over twenty months" in applying for the "new ALTER EGO mark." With regard to likelihood of confusion, respondent maintains that the likelihood of confusion analysis must be based on respondent's ALTER EGO mark and petitioner's "alleged rights" in the ALTER EGO THE PERSONAL CARE COMPANION mark; that the marks are dissimilar and have a significantly different commercial impression due to different typeface and the fact that petitioner's mark is a slogan and respondent's mark is not; that the goods are sold in different channels of trade in that respondent sells its goods to hair stylists and hair salons while petitioner sells its goods in bulk sizes to public bathroom facilities such as gyms and club locker rooms; that petitioner's bulk products are dispensed from custom-made private label dispensers that prominently feature the name and logo of the establishment offering the products; that the purchasers of the goods are sophisticated; and that petitioner has not produced evidence of actual confusion, and therefore, the parties' marks can coexist.³

³ Respondent also argues that petitioner should be equitably estopped from "obtaining any relief in this proceeding" due to improper use of the federal registration symbol both prior to registration and after cancellation of its ALTER EGO THE PERSONAL CARE COMPANION mark. These allegations have not been pled. A

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Respondent has submitted the following evidence in support of its position: file wrapper of respondent's Registration No. 2665115 (application Serial no. 76022339), the involved ALTER EGO registration; file wrapper of petitioner's cancelled U.S. Trademark Registration Number 1864486 for the mark ALTER EGO THE PERSONAL CARE COMPANION; file wrapper of petitioner's application Serial no. 76539224 for the mark ALTER-EGO; copies of some documents produced by petitioner during discovery; and a letter sent by the Boca Raton Resort & Club with regard to respondent's inquiry regarding this third-party's use of petitioner's ALTER EGO products.

A party is entitled to summary judgment when it has demonstrated that there are no genuine issues as to any material fact and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). All doubts as to whether or not particular factual issues are genuinely in dispute must be resolved against the moving party, and the evidence of record and any inferences that may be drawn from the underlying facts must be viewed in the light most favorable to the nonmoving party. *Olde Tyme Foods Inc. v.*

party may not defend against summary judgment based on an unpleaded defense. See TBMP Section 528.07(b) (2d ed. rev. 2004). Therefore, this defense to petitioner's motion for summary judgment has not been considered.

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Roundy's Inc., 961 F.2d 200, 202 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

When the moving party's motion is supported by evidence sufficient, if unopposed, to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely disputed facts which must be resolved at trial. The nonmoving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional affidavit evidence showing the existence of a genuine issue of material fact for trial. Fed. R. Civ. P. 56(c).

In order to prevail, petitioner must establish not only a valid ground for cancellation, but must also prove its standing. See e.g., *Medinol Ltd. v. Neuro Vasx, Inc.*, 67 USPQ2d 1205 (TTAB 2003). Petitioner has proven its standing by its president Jan Ellis' statements in her first declaration averring to petitioner's use of the mark ALTER EGO on hair care products identical or related to respondent.⁴

⁴ Respondent has not contested petitioner's standing, and respondent acknowledges that petitioner sells "toiletries" and "shampoo" in its response brief. Respondent's submission with its response brief of the file wrapper of petitioner's pending application Serial No. 76539224 for the mark ALTER-EGO is further proof of petitioner's allegation of standing in view of the Office action citing respondent's ALTER EGO registration against

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In view thereof, and because petitioner's likelihood of confusion claim is not frivolous, we find that petitioner has established its standing to petition to cancel respondent's registration. See, e.g., *Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Turning first to priority, we find that petitioner has met its burden of establishing prior and continuous use of ALTER EGO as a trademark for beauty products as of 1993 with continuous use to the present. The Ellis declaration establishes that petitioner first used the ALTER EGO mark in commerce in 1993, continues to use the mark to the present, and intends to use the mark in the future. The invoices dated from 1996 establish use of the mark well before the May 1999 date of first use in commerce by respondent, and petitioner's responses to respondent's interrogatories further support the prior and continuous use of petitioner's ALTER EGO mark.

Petitioner has established continuous use of the mark ALTER EGO both alone and as part of the composite mark ALTER EGO THE PERSONAL CARE COMPANION. We find little merit with regard to respondent's arguments that petitioner's prior use

petitioner's application to register its ALTER-EGO mark under Section 2(d) of the Trademark Act.

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was for the mark ALTER EGO THE PERSONAL CARE COMPANION rather than ALTER EGO. The advertisements, price lists and invoices establish use of the mark ALTER EGO alone as well as use of the mark ALTER EGO THE PERSONAL CARE COMPANION. With respect to petitioner's use of the mark ALTER EGO THE PERSONAL CARE COMPANION, the terms ALTER EGO are in large type and are more prominently displayed than the terms THE PERSONAL CARE COMPANION; therefore, ALTER EGO is a separable element.⁵ Thus, petitioner's prior use of ALTER EGO THE PERSONAL CARE COMPANION creates the same continuing commercial impression as petitioner's present use in that purchasers would recognize ALTER EGO as a separable element of the mark.

Lastly, with regard to respondent's claim that petitioner has abandoned its rights in the ALTER EGO and/or ALTER EGO THE PERSONAL CARE COMPANION marks, we note that respondent has not come forward with any proof of non-use, but rather has done nothing more than make a cursory allegation of an unspecified period of non-use based on petitioner's failure to file a Section 8 Declaration of Use and subsequent cancellation of petitioner's Registration No. 1864486 for the mark ALTER EGO THE PERSONAL CARE COMPANION.

⁵ Jan Ellis avers in her second declaration that for more than ten years "'Alter Ego is screen printed an average of 5 times alone [on each bottle] while the tagline The Personal Care Companion is on the bottle once in small print and not depicted as part of the name.'"

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Speculation without supporting evidence is not sufficient to withstand a motion for summary judgment. *Pure Gold v. Syntext (U.S.A.), Inc.*, 730 F.2d 624, 627, 222 USPQ 741 (Fed. Cir. 1984). Even if respondent had made a prima facie showing of three years of nonuse at some point in time prior to August 20, 2003, petitioner's filing of its new application to register the ALTER-EGO mark (76539224) on that date would tend to negate any prima facie showing by establishing petitioner's clear intent to resume use. *Cf. General Cigar Co. Inc. v. G.D.M. Inc.* 45 USPQ2d 1481, 1490 (S.D.N.Y. 1997) ("party's filing of trademark application and conducting sales from the time of filing to the present established rights to the mark.").

Accordingly we find that there is no genuine issue of material fact that petitioner has established its priority.

Turning to the issue of likelihood of confusion, we are guided by the factors set forth in the case of *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). Our determination of likelihood of confusion is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion, which would include the similarity of the marks and the similarity of the goods.⁶

⁶ Our primary reviewing Court has held that only those du Pont factors shown to be material or relevant in the particular case and which have evidence submitted thereon are to be considered.

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Turning first to the similarity of the marks, we find that the marks at issue are ALTER EGO and ALTER EGO and not ALTER EGO and ALTER EGO THE PERSONAL CARE COMPANION as respondent maintains. Thus, the analysis that follows is based on a comparison of respondent's ALTER EGO mark and petitioner's ALTER-EGO mark.

Although respondent attempts to distinguish the respective marks by arguing that the marks are different due to the use of "stylized typeface" rather than "block letters," when considered in their entirety, the marks are identical in sound and connotation, virtually the same in appearance, and essentially identical in overall commercial impression. Thus, there is no genuine issue that the parties' ALTER EGO marks are essentially identical.

Turning to the relatedness of the goods, both parties sell hair shampoos and hairspray and related hair care products. Therefore, we find that the parties' goods are identical and/or related.

Turning next to channels of trade, in view of the legal identity of, and/or close relationship between, the parties' respective goods, we find as well that the trade channels and the classes of purchasers for the respective goods are identical and/or overlapping.⁷

⁷ Despite respondent's arguments to the contrary, the evidence reflects that petitioner sells in both retail (2, 12, 16 and 32 ounce sizes) and bulk sizes as evidenced by the second

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Turning next to sophistication of purchasers, respondent has argued, without evidentiary support, that the purchasers are sophisticated. However, even assuming such is the case, even sophisticated persons would be susceptible to source confusion, particularly under circumstances where, as here, the goods are closely related and are sold under essentially identical marks. See *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962).

Turning last to actual confusion, we find that this factor favors neither party and is therefore, neutral.⁸

In summary, considering the essentially identical marks, the identical and related nature of the goods, and the overlapping channels of trade, we find that there are no genuine issues of material fact that confusion is likely to result.⁹

In view thereof, we find that petitioner has carried its burden of proof and that no genuine issues of material fact remain as to petitioner's standing, priority or the ground of likelihood of confusion. Therefore, petitioner is entitled to judgment as a matter of law.

declaration of Jan Ellis and petitioner's price lists. Moreover, there is no limitation as to channels of trade in respondent's registration.

⁸ Although petitioner submitted some rebuttal evidence of actual confusion with its reply to counter respondent's argument in its responsive brief, we do not find the evidence of actual confusion sufficient to say that the du Pont factor focusing on instances of actual confusion weighs solidly in petitioner's favor.

⁹ Respondent's motion to extend discovery is moot.

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Accordingly, petitioner's motion for summary judgment is granted and judgment is entered against respondent. The petition to cancel is granted, and U.S. Registration No. 2665115 will be cancelled in due course.