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TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

BLUE BOX, LLC, Opposer, v. KNOWNPALMSPRINGS, INC., Applicant.	)	Opposition No. 124,729 Mark: ARCHITECTURE OF BEAUTY

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513, on

June 14, 2002
Date

Jeffrey L. Van Hoosear

APPLICANT KNOWNPALMSPRINGS INC.'S RESPONSE TO OPPOSER'S MOTION FOR SUMMARY JUDGMENT

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

ATTN: BOX TTAB - NO FEE

I. INTRODUCTION

This is a trademark opposition brought by Opposer, Blue Box, LLC ("Opposer"), against Applicant, knownpalmsprings, inc. ("Applicant"). Opposer claims that Applicant's mark ARCHITECTURE OF BEAUTY, when used on or in connection with Applicant's goods, as identified in U.S. Trademark Application Serial No. 78/057,809, namely, cosmetics, namely, foundation, concealer, loose powder, pressed powder, cheek color, bronzer, eye pencils, lip pencils, mascara, lipstick, lip gloss, perfume, toilette water, cologne, body lotion, body oil,

shaving lotion (hereinafter referred to as "Applicant's Goods"), is likely to cause confusion or mistake as to source with Opposer's mark shown in Application Serial No. 78/044,358 for the mark ARCHITECTURE FOR THE FACE in connection with essential oils for personal use, perfume, cologne, after shave lotion and balm, skin and body cleansers, skin and body moisturizing and conditioning lotions and creams, cuticle creams, facial scrubs, hand and foot lotions and creams, facial masks for cosmetic use, bubble bath, lipstick and lip gloss, nail enamel and top and base coats, sunscreens, suntanning creams and lotions and gels, mascara, eyeliners, blusher, rouge, makeup, makeup remover, hair conditioners and shampoos, scalp moisturizers, nonmedicated topically creams and lotions to protect the skin from wind and sun and environmental pollution, aromatherapy oils and lotions and creams, cosmetic serums for the face, pore refining creams and lotions, skin firming creams and lotions, wrinkle smoothing creams and lotions, creams and lotions topically applied to diminish the appearance of fine lines and wrinkles on the face and skin, breast firming creams and lotions, skin toning creams and lotions, and creams and lotion to improve the elasticity of the skin (hereinafter referred to as "Opposer's Goods").

Opposer's assertion that there is no material fact as to a of likelihood of confusion is unfounded; it is clear that the parties' respective marks are so significantly different in overall appearance and commercial impression as to create an issue of fact. Moreover, the consumers of both parties' goods are likely to be discerning and careful consumers. Accordingly, there is a genuine issue of material fact as to a likelihood of confusion, and a grant of summary judgment for Opposer is not appropriate in this action.

II. FACTUAL BACKGROUND

Applicant filed an intent-to-use application with the U.S. Patent and Trademark Office ("USPTO") on April 11, 2001 seeking registration of the mark ARCHITECTURE OF BEAUTY (in block letters) for Applicant's Goods based upon its intention to use the mark in the United States. The application was assigned Serial No. 78/057,809 and was published for opposition on October 16, 2001. There were no Office Actions issued against this application. Accordingly, no prior-pending applications or registrations, including Opposer's application, were cited as a reference or a bar to registration by the USPTO Examining Attorney.

On November 4, 2001, Opposer filed a Notice of Opposition with the Trademark Trial and Appeal Board (the "Board"), claiming that Applicant's Goods are identical to Opposer's Goods and that Applicant's mark incorporates "Opposer's mark ARCHITECTURE, which is distinctive and unique to Opposer." Applicant's mark is ARCHITECTURE OF BEAUTY. Opposer's mark applied for is not "ARCHITECTURE." Opposer's application is for the mark ARCHITECTURE FOR THE FACE.

III. BRIEF SUMMARY OF THE ARGUMENT

Opposer's assertion that there is no material issue of material fact that a likelihood of confusion must necessarily exist due to the common component "architecture" is unfounded. Opposer's only allegation in its Notice of Opposition as to how the marks could be considered confusingly similar is that "Applicant's mark incorporates Opposer's mark ARCHITECTURE." Notice of Opposition ¶ 6. However, it is clear that Opposer's mark is not ARCHITECTURE, as Opposer continuously states, but is ARCHITECTURE FOR THE FACE. As argued in more detail

below, Opposer's entire mark is what must be compared with Applicant's mark, not a single component of Opposer's choosing. By simply looking at the two marks, it is clear that the marks differ in overall appearance and commercial impression. Furthermore, Opposer ignores the fact that Applicant's Goods will be purchased by sophisticated consumers after very careful consideration and investigation. Applicant asserts that there is a genuine issue of material fact involved in this determination. Accordingly, this matter is not appropriate for a summary judgment decision.

IV. SUMMARY JUDGMENT STANDARD AND BURDEN OF PROOF

Summary judgment should be granted only where it is shown that there is no genuine issue of material fact, and the moving party is entitled to judgment as a matter of law. F.R.C.P. Rule 56(c). Summary judgment is only an appropriate method of disposing of an opposition in which there is no genuine issue of material fact on the question of likelihood of confusion. Kellogg Co. v. Pack'Em Enterprises, Inc., 14 U.S.P.Q. 2d 1545 (T.T.A.B. 1990). As the Federal Circuit stated in Pure Gold, Inc. v. Syntex (U.S.A.), Inc., 222 U.S.P.Q. 741, 743 (Fed. Cir. 1984):

> The basic purpose of summary judgment procedure is one of judicial economy -- to save the time and expense of a full trial when it is unnecessary because the essential facts necessary to decision of the issue can be adequately developed by less costly procedures, as contemplated by the **FRCP** rules here involved, with a net benefit to society.

As the moving party, Opposer has the clear burden of demonstrating that it is entitled to summary judgment. Celotex Corp. v. Catrett, 477 U.S. 317, 324-25 (1986). This general principle of summary judgment applies under Federal Rule of Civil Procedure 56 to inter-party proceedings

before the Board. See, e.g., Sweats Fashions, Inc. v. Pannill Knitting Co., 833 F.2d 1560, 4 U.S.P.Q.2d 1793, 1797 (Fed. Cir. 1987).

V. THERE IS A GENUINE ISSUE OF MATERIAL FACT ON THE QUESTION OF LIKELIHOOD OF CONFUSION

Likelihood of Confusion Test

15 U.S.C. § 1052(d), Section 2(d) of the Trademark Act, allows for registration of a mark unless the mark "so resembles a mark 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 cause mistake, or to deceive."

There is no rigid test for analyzing likelihood of confusion. However, T.M.E.P. § 1207.01 lists thirteen factors as relevant in determining the registrability of a mark over an allegedly confusingly similar mark. Of those thirteen factors, the most important factors in this matter at this time (due to the Motion before the Board) are: (1) the differences in the marks when viewed in their entireties as to overall appearance and commercial impression; (2) the dissimilarity and nature of the goods as described in the applications; and (3) the conditions under which, and the buyers to whom sales are made, i.e., impulse vs. careful, sophisticated purchasing. See Application of E.I. DuPont DeNemours & Co., 476 F.2d 1357, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973).

In this matter, Opposer cannot carry its burden to prove that there is no issue of material fact to be determined in regard to the elements of "likelihood of confusion." In applying the factors summarized above in this matter, it must be concluded that Opposer is not entitled to summary judgment.

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