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

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| Proceeding | 91206915 |
| Party | Defendant<br>Eric Lucas |
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| Date | 03/22/2014 |
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Application Serial No.: 85/597,114
Published in the Official Gazette on August 28, 2012

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| MYBODY, L.L.C.,<br><br>Opposer,<br>vs.<br><br>ERIC LUCAS,<br><br>Applicant. | **Opposition No. 91206915**<br><br>Memorandum in Opposition to Opposer's Motion for Summary Judgment |

Applicant submits this memorandum in opposition to Opposer's Motion for Summary Judgment.

## INTRODUCTION

Opposer's characterizations of the grounds on which it maintains it is entitled to summary judgment are misleading and self-serving. Opposer seeks Summary Judgment that Applicant's applied-for mark (Serial No. 85/597,114) MY HERO for lotion is confusingly similar to Oppposer's pink colored logo "myHERO" for an anti-aging serum which Opposer deceptively (and solely for purposes of this opposition) has now identified as a skin cream after the United States Patent and Trademark Office refused registration of the logo and after Applicant applied for federal registration of his mark. Opposer's Motion must be denied because there are material issues of fact as to whether Opposer has established priority of use, whether there is a likelihood of confusion between Applicant's MYHERO mark and Opposer's pink colored myHERO logo, and whether Opposer's anti-aging serum is really a medicinal treatment according to FDA standards requiring it to be re-classified for purposes of determining the true market differences between the products at issue, the actual target consumer, and the consumer sophistication. Notably, Opposer's memorandum of law fails to properly address, and in most cases, fails to address at all, these material questions fact. Instead, Opposer has elected to set forth bald statements as evidence and in doing so fails to carry its stringent burden on its motion.

Indeed, throughout its memorandum, Opposer habitually ignores inconvenient facts, such as its own conflicting arguments it raised in response to previous Office Actions, the nature of its medicinal anti-aging serum (now curiously referred to as a skin cream), the self-described targeting of the anti-aging serum to a limited marketing channel and consumer, and the readily-apparent difference in consumer impression between the marks themselves. Given the multiple deficiencies in its arguments and the lack of evidentiary proofs, it is clear that Opposer has not presented the clear and convincing evidence required to overcome its evidentiary hurdle on summary judgment.

Applicant's motion opposition, however, does not rest solely on the fact that Opposer has not demonstrated the required lack of genuine issues of fact for trial. Applicant not only provides the applicable standard (which Opposer failed to set forth or demonstrate), but also provides this tribunal with information from Opposer's own discovery responses as well as its own submissions to the USPTO from its original failed attempt to register the logo that is more than sufficient to defeat summary judgment.

In light of Opposer's deficient submissions and Applicant's proofs, Opposer's motion must be denied.

## BACKGROUND AND PROCEDURAL POSTURE

On April 13, 2012, Eric Lucas ("Applicant"), filed to register the mark "MYHERO" based upon a bona fide intent to use the mark in commerce. Declaration of Damon L. Ward, Exhibit 1 (Application). On August 8, 2012, Applicant received notice that the USPTO determined that Applicant's mark appeared entitled to registration. Ward Decl., Exhibit 2 (Notice of Publication).

On September 10, 2012, Opposer initiated this proceeding in an effort to prevent Applicant from completing the trademark application process *after* the United States Patent and Trademark Office refused registration of MYHERO for Opposer's anti-aging serum and *after* Applicant received Publication Confirmation in the Official Gazette subsequent to a determination that Applicant's mark may be registered. See Opposition, Exhibit 3 (Refusal re: Opposer's serial # 85132776).

On February 20, 2014, Opposer brought its motion for summary judgment. In support of its motion on the inextricably intertwined alleged grounds of priority and likelihood of confusion, however,

Opposer submits only the following broad and conclusory statements said to be supported by generalized and non-specific discovery responses:

1. My Body LLC is an Arizona limited liability company with a business address at 5080 North 40th Street, Suite 375, Phoenix, Arizona 85018 ("Opposer"), operates a business that develops and markets skin care and related products. . . .

2. As of January 28, 2011, Opposer adopted and has continually and extensively used the mark "MYHERO" in connection with the sale of its skin cream products since that date. . . .

3. Opposer has expended considerable time and resources to advertise and promote the skin cream producs offered under its "MYHERO" mark. . . .

4. Opposer has identified channels of trade where Opposer's goods have been sold, are sold, and intend to be sold as: medical offices, spas, beauty spas, department stores, specialty stores, online retailers, consumer sales, and via its website . . . .

Opposer's Statement of Material Facts, pp. 1-2.

However, Opposer fails to identify that (1) Opposer has never marketed, promoted, or sold its product as a "skin cream;" rather only doing so as an anti-aging serum; Ward Decl., Exhibit 4 (Advertising) (2) Opposer has improperly identified the anti-aging serum in International Class 003 when, as a medicinal product pursuant to FDA regulations, it should be classified in International Class 005 as a drug Ward Decl., Exhibit 5 (Opposer's application for anti-aging serum); (3) Opposer's product contains retinol and contains statements demonstrating it is a drug Ward Decl., Exhibit 6 (Ingredient Advertising); Exhibit 7 (FDA Compliance & Regulatory Information), and Exhibit 8 (Warning Letters); (4) Opposer represented to USPTO that the anti-aging serum was target marketed to the aging and mature women Ward Decl., Exhibit 9 (Opposer's Response to Office action); (5) Opposer has never used the myHERO logo on any identified cosmetic skin creams, only its anti-aging serum, and only first claimed to be using it for "skin creams" in Opposer's most recent Application dated August 6, 2012--14 months *after* its anti-aging serum application was refused registration and abandoned and four months *after* Applicant made its application.

## ARGUMENT

### I. STANDARD FOR SUMMARY JUDGMENT

Summary judgment is proper if, drawing all reasonable inferences in favor of the nonmoving party, there is no genuine issue of material fact and the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a); Celotex Corp. v. Catrett, 477 U.S. 317, 322-23 (1986). The moving party bears the burden of showing that the material facts in the case are undisputed. Id. at 322; Whisenhunt v. Sw. Bell Tel., 573 F.3d 565, 568 (8th Cir. 2009). The Board must view the evidence, and the inferences that may be reasonably drawn from it, in the light most favorable to the nonmoving party. Weitz Co., LLC v. Lloyd's of London, 574 F.3d 885, 892 (8th Cir. 2009); Carraher v.Target Corp., 503 F.3d 714, 716 (8th Cir. 2007); See Capital Speakers Inc. v. Capital Speakers Club of Washington D.C. Inc., 41 U.S.P.Q.2d 1030, 1034 (TTAB 1996) (Board accepted nonmovant's version of the facts for purposes of deciding motion); Commodore Electronics Ltd., 26 U.S.P.Q.2d at 1505 (on opposer's motion for summary judgment applicant's evidence of statement of use filed in connection with another of its applications covering many of same goods as in opposed application created inference of bona fide intent to use present mark despite absence of any documents regarding its intent to use present mark). See also Opryland USA Inc. v. The Great American Music Show Inc., 23 U.S.P.Q.2d 1471, 1472 (Fed. Cir. 1992) (not required to present entire case but just sufficient evidence to show an evidentiary conflict as to the material fact in dispute). A factual dispute is genuine if sufficient evidence is presented such that a reasonable fact finder could decide the question in favor of the non-moving party. Sweats Fashions Inc. v. Pannill Knitting Co., 4 U.S.P.Q.2d 1793, 1795 (Fed. Cir. 1987). The burden resting on the non-moving party is to show that specific facts exist creating a genuine issue for trial. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 256 (1986); Wingate v. Gage County Sch. Dist. No. 34, 528 F.3d 1074, 1078-79 (8th Cir. 2008).

Summary judgment is a drastic remedy and the Board is only to resolve any doubts as to the existence of genuine issues of fact against the moving party. Enter. Bank v. Magna Bank of Mo.,

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