

This Opinion is not a
Precedent of the TTAB

Mailed: June 19, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Combe Incorporated
v.
Dr. August Wolff GmbH & Co. KG Arzneimittel

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Opposition No. 91209708
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Robert R. Caliri of Olson & Cepuritis, Ltd.,
for Combe Incorporated.

Michael J. Striker of Striker, Striker & Stenby,
for Dr. August Wolff GmbH & Co. KG Arzneimittel.

—
Before Quinn, Zervas and Bergsman,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Dr. August Wolff GmbH & Co. KG Arzneimittel (“Applicant”) seeks registration on the Principal Register of the mark VAGISAN (in standard characters) for the goods set forth below:

Soaps, perfumery, essential oils, cosmetics, hair lotion, in
Class 3; and

Pharmaceutical preparations, namely, vaginal
moisturizers, vaginal anti-fungal preparations, vaginal

washes; sanitary preparations for medical use; diet pills, diet capsules, diet liquid medications, in Class 5.¹

Combe Incorporated (“Opposer”) opposed the registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark so resembles Opposer’s previously used and registered mark VAGISIL for identical or closely related goods as to be likely to cause confusion. Specifically, Opposer pleaded ownership of the registrations listed below:²

1. Registration No. 1104172 for the mark VAGISIL (typed drawing) for “pharmaceutical preparations – namely, medicated cremes,” Class 5;³
2. Registration No. 1424503 for the mark VAGISIL (typed drawing) for “cosmetics – namely, powders for feminine use,” in Class 3;⁴
3. Registration No. 2971826 for the mark VAGISIL (typed drawing) for “pharmaceuticals, namely, medicated premoistened towelettes for feminine use,” in Class 5;⁵

¹ Application Serial No. 78111922 was filed on February 24, 2012, under Section 66a of the Trademark Act, 15 U.S.C. § 1141f, seeking an extension of protection based on International Registration No. 095168 registered on October 10, 2008.

² Also, Opposer pleaded ownership of 3696951 for the mark VAGISIL SATIN (standard characters) for “medicated nonprescription topical creams, namely, anti-itch creams,” in Class 5. However, that registration was cancelled effective May 20, 2016 and, therefore, it will be given no further consideration.

³ Registered October 17, 1978; second renewal. Prior to November 2, 2003, “standard character” drawings were known as “typed” drawings. Effective November 2, 2002, Trademark Rule 2.52, 37 C.F.R § 2.52, was amended to replace the term “typed” drawing with “standard character” drawing. A typed mark is the legal equivalent of a standard character mark. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012) (“until 2003, ‘standard character’ marks formerly were known as ‘typed’ marks.”).

⁴ Registered January 13, 1987; second renewal.

⁵ Registered July 19, 2005; renewed.

4. Registration No. 3285997 (standard characters) for “vaginal pH testing kits containing testing swabs and color guides,” in Class 10;⁶
5. Registration No. 4073832 for the mark VAGISIL (standard characters) for “non-medicated feminine washes,” in Class 3;⁷
6. Registration No. 4205458 for the mark VAGISIL (standard characters) for “moisturizers for the skin at the external vaginal area,” in Class 3;⁸ and
7. Registration No. 4343995 for VAGISIL and design, shown below,



for the goods listed below:

“nonmedicated products for feminine use, namely, feminine soothing creams for the skin, moisturizers for the skin at the external vaginal area, feminine deodorant powders and sprays, and nonmedicated feminine hygiene washes,” in Class 3;

“medicated products for feminine use, namely, feminine anti-itch creams, and premoistened feminine wipes,” in Class 5; and

⁶ Registered August 27, 2007; Sections 8 and 15 affidavits accepted and acknowledged.

⁷ Registered December 20, 2011; Sections 8 and 15 affidavits accepted and acknowledged.

⁸ Registered September 11, 2012.

“vaginal pH screening kits containing pH test swabs and color guides,” in Class 10.⁹

Also, Opposer alleged that Applicant did not have a *bona fide* intent to use VAGISAN in commerce for the goods identified in its application at that the time Applicant filed for extension of protection under Section 66(a) of the Trademark Act.

Applicant, in its Answer, denied the salient allegations in the Notice of Opposition.

I. Preliminary Issues

During the testimony deposition of Angela Thevessen, an employee in Applicant’s export department, Applicant introduced a summary of the number of units of its VAGISAN products sold in all countries other than Germany between 1998 and 2015 (Exhibit 1). Opposer’s counsel made a standing objection to testimony and documents referring to international matters as being irrelevant and to documents that were not timely produced during discovery.¹⁰ Opposer, in its “Statement Of Evidentiary Objections,” renewed the objection to Thevessen Exhibit 1 on the ground that it was not produced during discovery.¹¹

⁹ Registered May 28, 2013. In the Notice of Opposition, Opposer pleaded ownership of application Serial No. 85622954 which issued as the above-noted registration. When an opposer pleads ownership of an underlying application, opposer may make of record the subsequently issued registration of that application without amending the pleading. *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1040 n.3 (TTAB 2014).

¹⁰ Thevessen Testimony Dep., pp. 7-8 and 12 (47 TTABVUE 10-11 and 15).

¹¹ 58 TTABVUE.

Opposer contends that Thevessen Exhibit 1 is responsive to Opposer's document request Nos. 5, 11, and 31 to which Applicant responded that no documents exist.¹²

The document requests are set forth below:

5. Documents sufficient to identify each product planned or considered to be sold, distributed or offered for sale under the VAGISAN Mark in the United States.

11. Documents sufficient to establish Applicant's intent to use the VAGISAN Mark in the United States on or in connection with Applicant's Goods before the application for registration of the mark was filed.

31. Documents sufficient to identify Applicant's actual or planned annual unit and dollar sales of Applicant's Goods under the VAGISAN mark in the United States.¹³

In response to Opposer's motion for summary judgment,¹⁴ Applicant submitted, on March 17, 2016, Thevessen Testimony Exhibit 1.¹⁵ The summary was created by Mrs. Koch, Applicant's controller, from the normally maintained books and records of Applicant.¹⁶ Applicant submitted the summary of sales in response to Opposer's motion for summary judgment to demonstrate that Applicant had the ability to sell its VAGISAN products in the United States¹⁷ and, thus, it is responsive to Opposer's

¹² 58 TTABVUE 3-4.

¹³ 58 TTABVUE 3.

¹⁴ 29 TTABVUE.

¹⁵ 34 TTABVUE 32-33 and 48.

¹⁶ 24 TTABVUE 32; *see also* Thevessen Testimony Dep., p. 9 (47 TTABVUE 12).

¹⁷ 34 TTABVUE 8-15.

document request No. 11 (documents sufficient to establish Applicant's intent to use the VAGISAN Mark in the United States).¹⁸

Applicant created the summary of Applicant's sales outside of Germany, Thevessen Testimony Exhibit 1, to respond to Opposer's motion for summary judgment; it was not in existence when Applicant responded to Opposer's discovery. Applicant's submission of the sales summary in response to Opposer's motion for summary judgment serves as a supplement to its discovery response. *See Vignette Corp. v. Marino*, 77 USPQ2d 1408, 1411 (TTAB 2005) (given that discovery responses may be supplemented at any time, even during trial, or after receipt of a summary judgment motion, "to apply the preclusion sanction under Federal Rule 37(c)(1) here or in similar circumstances would amount to elevating form over substance since no practical distinction exists between consideration of information provided as part of a responsive brief to a summary judgment motion or information provided in supplemental responses to discovery that are submitted at the same time as a responsive brief"); *see also* Fed. R. Civ. P. 26(e) Advisory Committee Notes (1993 amendment to Rule 26(e)) ("no obligation to provide supplemental or corrective information that has been otherwise made known to the parties in writing or during the discovery process, as when a witness not previously disclosed is identified during the taking of a deposition...").

¹⁸ The relevance of the sales summary in response to document request Nos. 5 and 31 is dubious but we need not address that issue at this time.

As noted above, Opposer, in its statement of objections, did not renew the objection that Thevessen Exhibit 1 is irrelevant because it refers to activities outside of the United States. Nevertheless, we point out, in this instance, Applicant's international activities are probative of the facts that Applicant possesses the capability to manufacture and market the products at issue, as well as the capability and experience to export those products and, therefore, are relevant to the issue of whether Applicant had a *bona fide* intent to use its mark at the time it sought an extension of protection under Section 66 of the Trademark Act.

In view of the foregoing, Opposer's objections to Thevessen Exhibit 1 are overruled.

II. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant's application file. The record also includes the testimony and evidence listed below.

A. Opposer's testimony and evidence.

1. Because Opposer attached to its Notice of Opposition copies of its pleaded registrations and application Serial No. 85622954, which registered as Registration No. 4343995, printed from the USPTO electronic database showing both the status of and title to the registrations, those registrations

are made of record pursuant Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1);¹⁹

2. Notice of reliance on the following items:

- a. Pursuant to Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e) (“official records”), copies of specimens submitted with the USPTO showing Opposer’s VAGISIL mark used on packaging;²⁰
- b. Pursuant to Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e) (“official records”), copies of assignment documents recorded in the USPTO relating to Opposer’s pleaded registrations;²¹
- c. A copy of a news story printed in the January 30, 1974 *Syracuse Herald-Journal* referring to Opposer’s VAGISIL products;²²
- d. Opposer’s VAGISIL website (vagisil.com) printed April 2, 2015;²³
- e. Applicant’s responses to Opposer’s Interrogatory Nos. 2-4 and 9;²⁴ and
- f. Applicant’s responses to Opposer’s request for production of documents Nos. 7, 13, 14, 19, and 29-31 stating that no documents exist to those requests;²⁵

¹⁹ Thus, it was unnecessary for Opposer to introduce copies of its pleaded registrations a second time in its notice of reliance. *See* 39 TTABVUE 9-18.

²⁰ 39 TTABVUE 21-62.

²¹ 39 TTABVUE 64-109.

²² 39 TTABVUE 111.

²³ 39 TTABVUE 113-167.

²⁴ 39 TTABVUE 169-174.

²⁵ 39 TTABVUE 176-184.

3. Testimony deposition of Yolanda Payne, Opposer's Vice President of Marketing for Intimate Health, with attached exhibits;²⁶
4. Rebuttal notice of reliance on the following items:
 - a. Official records regarding Opposer's International Registration No. 1245696 showing citation of Applicant's VAGISAN mark as a bar to registration;²⁷
 - b. Official records from the UK trademark office regarding Opposer's VAGISIL application;²⁸
 - c. Official records from the UK trademark office regarding Applicant's opposition to the registration of Opposer's VAGISIL trademark;²⁹ and
5. Testimony deposition of Rebecca Lyons, a legal assistant at Opposer's counsel's law firm, with attached exhibits.³⁰

B. Applicant's testimony and evidence.

1. Notice of reliance on Applicant's VAGISAN website (vagisan.com) printed October 24, 2016;³¹
2. Opposer's response to Applicant's request for production of documents No. 3 stating that there are no documents responsive to this request for

²⁶ 41 TTABVUE. The portions of Ms. Payne's deposition designated as confidential are posted at 42 TTABVUE.

²⁷ 50 TTABVUE 6.

²⁸ 50 TTABVUE 17.

²⁹ 50 TTABVUE 26.

³⁰ 53 TTABVUE.

³¹ 43 TTABVUE.

documents relating to any instances of confusion between Opposer's VAGISIL trademark and any other trademark;³²

3. Testimony deposition of Olga Fuchs, an Administrator at Applicant's counsel's law firm, with attached exhibits;³³ and
4. Testimony deposition of Angela Thevessen, an employee in Applicant's export department, with attached exhibits.³⁴

III. Standing.

Because Opposer's pleaded registrations have been made of record, Opposer has established its standing in this proceeding. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

IV. Priority.

Because Opposer has properly made of record its pleaded registrations, and because Applicant has not filed a counterclaim to cancel any of Opposer's pleaded registrations, Section 2(d) priority is not an issue in the opposition as to the marks and the goods covered by the pleaded registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

³² 45 TTABVUE.

³³ 46 TTABVUE.

³⁴ 47 TTABVUE. The portions of Ms. Thevessen's deposition designated as confidential are posted at 48 TTABVUE.

V. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont*”) (cited in *B&B Hardware, Inc. v. Hargis Ind., Inc.*, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015)); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *du Pont* factor that is relevant and for which there is evidence of record. *See M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See In re Chatam Int’l Inc.*, 380 F.2d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *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*, 116 USPQ2d 1406, 1409 (TTAB 2015), *appeal docketed*, No. 16-1507 (Fed. Cir. Jan. 21, 2016).

A. The fame of Opposer's VAGISIL mark and the number and nature of similar marks in use on similar goods.³⁵

In determining the strength of a mark, we consider both its inherent strength based on the nature of the mark itself and its commercial strength, based on the marketplace recognition value of the mark. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength.”); *Top Tobacco, L.P. v. North Atlantic Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006); *McCarthy on Trademarks and Unfair Competition* § 11:83 (4th ed. 2017) (“The first enquiry focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another's use.”). Market strength is the extent to which the relevant public recognizes a mark as denoting a single source. *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d at 1899. “[A] mark with extensive public recognition and renown deserves and receives more legal protection

³⁵ In testing for likelihood of confusion, “[t]he fame of the prior mark (sales, advertising, length of use)” is a factor, when of record, that must be considered in analyzing likelihood of confusion. *du Pont* at 567. Therefore, contrary to Applicant’s argument, fame for purposes of likelihood of confusion does not have to be pleaded and Opposer is not estopped from asserting that its mark is famous. Applicant’s Brief, p. 2 (61 TTABVUE 6).

than an obscure or weak mark. *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 22 USPQ2d at 1456.

Fame may be measured indirectly by the volume of sales of and advertising expenditures for the goods and services identified by the marks at issue, “the length of time those indicia of commercial awareness have been evident,” widespread critical assessments and through notice by independent sources of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Prods. Inc.*, 63 USPQ2d at 1305-1306 and 1309. Although raw numbers of product sales and advertising expenses sometimes may have sufficed to prove fame of a mark, raw numbers alone may be misleading. Some context in which to place raw statistics may be necessary (e.g., the substantiality of the sales or advertising figures for comparable types of products or services). *Bose Corp. v. QSC Audio Prods. Inc.*, 63 USPQ2d at 1309.

Finally, because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its

mark is famous to clearly prove it. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012) (citing *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007)).

Opposer argues, *inter alia*, that its VAGISIL marks are inherently strong because it owns seven registrations for VAGISIL, five of which are incontestable.³⁶ However, “the fact that opposer's federally-registered trademark] has achieved incontestable status means that it is conclusively considered to be valid, but it does not dictate that the mark is ‘strong’ for purposes of determining likelihood of confusion. *McCarthy On Trademarks and Unfair Competition* §§ 11:82 and 32:155 (4th ed. 2009).” *Safer v. OMS Inv., Inc.*, 94 USPQ2d 1031, 1036 (TTAB 2010).

Opposer also relies on the following evidence to demonstrate the strength and fame of its VAGISIL marks:

- Opposer has been using its VAGISIL marks since the 1970’s;³⁷
- Opposer’s VAGISIL products are sold nationwide by mass merchandisers such as Wal-Mart and Target, drug store chains and pharmacies such as CVS, WALGREEN’S, and RITE-AID, grocery stores such as Albertson’s, Kroger, STOP & SHOP, DOLLAR STORES, military outlets, and online through AMAZON.com and DRUGSTORE.com;³⁸

³⁶ Opposer’s Brief, p. 12 (57 TTABVUE 19).

³⁷ Payne Testimony Dep., pp. 6-7 (41 TTABVUE 9-10).

³⁸ Payne Testimony Dep. pp. 9-10 (41 TTABVUE 11-12).

- Opposer’s sales of its VAGISIL products between 2011 and 2015 have been substantial;³⁹
- VAGISIL anti-itch cream has a 50% market share;⁴⁰
- VAGISIL maximum anti-itch cream is the number one selling anti-itch cream;⁴¹
- VAGISIL powders have a 50% market share;⁴²
- VAGISIL medicated anti-itch wipes have a 90% market share;⁴³
- VAGISIL odor block wash is the number one selling vaginal wash;⁴⁴
- Opposer’s advertising expenditures promoting its VAGISIL products have been substantial;⁴⁵

³⁹ Payne Testimony Dep., pp. 33-38 and Exhibit 9 (42 TTABVUE 36-41, 76). Because Opposer’s sales have been designated as confidential, we may refer to them only in general terms.

⁴⁰ Payne Testimony Dep., pp. 31-32 (42 TTABVUE 31-32). It is not clear why Opposer’s market share is confidential and, therefore, we do not consider it as such. Trademark Rule 2.116(g), 37 C.F.R. § 2.116(g) (“The Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.”).

⁴¹ Payne Testimony Dep., p. 32 (42 TTABVUE 32).

⁴² Payne Testimony Dep., p. 32 (42 TTABVUE 32).

⁴³ Payne Testimony Dep., p. 32 (42 TTABVUE 32).

⁴⁴ Payne Testimony Dep., p. 33 (42 TTABVUE 33).

⁴⁵ Payne Testimony Dep., p. 38-43 and Exhibits 10 and 11 (42 TTABVUE 38-43, 77 and 78). Because Opposer’s advertising expenditures have been designated confidential, we may refer to them only in general terms.

In its brief, Opposer asserted that by 1976, advertising for the VAGISIL trademark had reached 95% of the women at least 16 times during the year citing the Payne Testimony Deposition Exhibit 1 (41 TTABVUE at 92). Opposer’s Brief, p. 15 (57 TTABVUE 22). Opposer is referring to an advertising flyer distributed to retailers stating that VAGISIL is “America’s #1 non-prescription product for feminine itching” and “major print advertising reaching 95% of all women at least 16 times during 1976.” These statements are hearsay. They are probative to show that Opposer made those statements in its advertising; not that they are true. Ms. Payne did not testify that those statements were true, nor did she testify that the statements in the advertising were true. Moreover, Ms. Payne did not testify as to how

- Opposer advertises or has advertised in nationwide magazines such as *People*, *Reader's Digest*, *TV Guide*, *Cosmopolitan*, *Ladies' Home Journal*, *True Story*, *McCall's*, *Glamour*, *Parade*, *Family Circle*, *Woman's Day*, *Ebony Essence*, and *Latina*;⁴⁶

- Opposer has advertised its VAGISIL products on the radio;⁴⁷

- Opposer advertises its VAGISIL products on television, including on ABC, NBC, CBS, and cable networks A&E and MTV;⁴⁸ and

- Opposer advertises through YouTube.⁴⁹

Opposer, in its brief, argues that VAGISIL is a famous mark.⁵⁰ While the record shows that Opposer has enjoyed commercial success and that its VAGISIL trademark is distinctive and commercially strong, we find that Opposer's commercial success does not make Opposer's VAGISIL trademark famous. We cannot on this record find that consumers have been so exposed to the mark VAGISAN, or that they are so aware of it, that it can be considered famous. The overall record simply falls short of a persuasive showing of fame especially because there is no testimony or evidence regarding the size of the market or the percentage of women who purchase intimate

Opposer reached the conclusion that its print advertising for the VAGISIL products reached 95% of all women at least 16 time.

⁴⁶ Payne Testimony Dep., pp. 8, 29-30, Exhibits 1 and 8 (41 TTABVUE 11, 32-33, 143, and 192).

⁴⁷ Payne Testimony Dep., pp. Exhibit 1 (41 TTABVUE 119, 128, 130, 137, 139, 141, 143, 144, 158, 160).

⁴⁸ Payne Testimony Dep., p. 8 (41 TTABVUE 11).

⁴⁹ Payne Testimony Dep., pp. 7-8, 9-11 (41 TTABVUE 10-12).

⁵⁰ Opposer's Brief, pp. 11-17 (57 TTABVUE 18-24).

feminine products so as to indicate in how many American homes Opposer's products may be found; there is no testimony or evidence regarding whether Opposer's advertising expenditures are large or small vis-à-vis other comparable products; and there are no examples of unsolicited media referring to the renown of Opposer's VAGISIL products.⁵¹ As indicated above, while Opposer's sales and market share are impressive and are indicative of commercial success, we can only speculate about the actual impact of Opposer's mark on the minds of consumers and, therefore, we find that Opposer has failed to show that its mark is famous.

Applicant contends that "[t]he sole similarity between the respective trademarks is the prefix VAGI- which is obviously and indisputably highly descriptive when applied to a vaginal product."⁵² In other words, Opposer is not entitled to the exclusive right to VAGI-formative marks in connection with feminine hygiene products. Applicant introduced the testimony deposition of Olga Fuchs, an Administrator at its counsel's law firm, who proffered third-party VAGI-formative registrations and evidence of third-party use of VAGI-formative marks.⁵³

⁵¹ We are not requiring evidence regarding the percentage of women who purchase the products, a comparison of advertising expenditures, or unsolicited media referring to the renown of Opposer's mark as elements of fame. The better practice would have been to introduce such evidence because, as indicated above, it is the duty of the party asserting that its mark is famous to clearly prove it.

⁵² Applicant's Brief, p. 3 (61 TTABVUE 7).

⁵³ 46 TTABVUE. While Opposer objected to the proffer of the third-party registrations during the deposition of Ms. Fuchs, contrary to Applicant's contention in its brief, Opposer did not renew the objection in Opposer's brief or Opposer's separate "statement of evidentiary objections." (58 TTABVUE).

Applicant introduced the following third-party registrations through Ms. Fuchs testimony deposition:⁵⁴

Mark	Reg. No.	Goods
VAGI-WAVE	4508456	Hygiene products for menses, namely, tampons and feminine hygiene pads
VAGITONE	5035663	Feminine hygiene vaginal moisturizer
VAGITOCIN	3830703	Pharmaceutical preparations for treatment of fragile and bleeding atrophic mucous membranes
VAGISTAT-3	3174689	Pharmaceutical preparation for the treatment of fungus infections in the female reproductive tract
VAGISTAT	1290700	(same)
VAGI-KOOL	4761447	A contoured therapeutic cold pack specifically designed to be used in the vaginal area of a woman's body
VAGI-HEX	4876321	Pharmaceutical preparations in tablet form for the treatment of vaginal conditions
VAGI-GARD	2250353	Feminine hygiene products, namely, topical treatment for yeast infections, medicated douches, medicated powder, medicated creams, lubricants, suppositories
VAGIFRESH	4723318	Non-medicated feminine hygiene wash
VAGIFIRM	5031761	Herbal supplements; herbal supplements for postpartum depression
VAGIFEM	2123814	Pharmaceutical, gynecological preparations for the treatment of menopausal disorders and applicators therefor, packaged together
VAGI-CURE	4042986	Vaginal ointments

⁵⁴ 46 TTABVue 36-59.

Mark	Reg. No.	Goods
VAGI-CARE	4254755	Vaginal ointments for providing relief from itch and irritation
VAGICAL	3369696	Pharmaceutical preparations for use in the prevention and treatment of disease or inflammation of the female reproductive tract

Also, Ms. Fuchs purchased products with a VAGI-formative mark listed below in August and September 2015:⁵⁵

- VAGI-CARE anti-itch cream from PersonalCare. The package advertised that the purchaser should “Compare to Vagisil®.”;⁵⁶
- VAGICARE moisturizer from HB Health & Beauty;⁵⁷
- VAGIFIRM dietary supplement;⁵⁸
- VAGI-CLEAR for the relief of vaginal itch, burning and discharge;⁵⁹
- VAGIFRESH moisturizing gel;⁶⁰
- VAGI-SILK vaginal lubricating inserts;⁶¹
- VAGI-CURE anti-itch cream;⁶²

⁵⁵ Fuchs Testimony Dep., p. 5 (46 TTABVUE 8).

⁵⁶ Fuchs Testimony Dep., Exhibit 8 (46 TTABVUE 21).

⁵⁷ Fuchs Testimony Dep., Exhibit 8 (46 TTABVUE 23).

⁵⁸ Fuchs Testimony Dep., Exhibit 8 (46 TTABVUE 24).

⁵⁹ Fuchs Testimony Dep., Exhibit 8 (46 TTABVUE 25). The owner of this mark also sells VAGI-SOOTHE for the relief of vaginal itch, burning and soreness. (46 TTABVUE 35).

⁶⁰ Fuchs Testimony Dep., Exhibit 8 (46 TTABVUE 26).

⁶¹ Fuchs Testimony Dep., Exhibit 8 (46 TTABVUE 27).

⁶² Fuchs Testimony Dep., Exhibit 8 (46 TTABVUE 29).

- VAGICREAM anti-itch cream;⁶³ and
- VAGISTATE-3 for the treatment of yeast infections.⁶⁴

We use the third-party registrations in the manner of a dictionary to show how a mark or, in this case, a portion of a mark is generally used. “Such third party registrations show the sense in which the word is used in ordinary parlance and may show that a particular term has descriptive significance as applied to certain goods or services.” *Institut National Des Appellations D'Origine v. Vintners Int'l Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992) (third-party registrations found to be “persuasive evidence”); *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 153 (CCPA 1978) (“we find no error in the citation of nine third-party registrations ‘primarily to show the meaning of * * * [‘zing’] in the same way that dictionaries are used.”); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1270 (TTAB 2009); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006) (“[T]hird-party registrations can be used in the manner of a dictionary definition to illustrate how a term is perceived in the trade or industry”). The registrations show that marks with a VAGI-prefix have been adopted and registered at least 14 times by 13 entities in connection with identical or closely related goods, presumably to mean something related to intimate feminine hygiene products (*i.e.*, vaginal).

⁶³ Fuchs Testimony Dep., Exhibit 8 (46 TTABVUE 31).

⁶⁴ Fuchs Testimony Dep., Exhibit 8 (46 TTABVUE 23).

Likewise, we consider the third-party products to determine how others use the VAGI-prefix. The third-party products are probative that other entities are selling intimate feminine hygiene products identified by marks incorporating the VAGI-prefix and, thus, relevant consumers have been exposed to the marks and products. *See Rocket Trademarks Pty Ltd., v. Phard S.p.A.*, 98 USPQ 2d 1066, 1072 (TTAB 2011). On the other hand, Applicant did not proffer any testimony regarding the extent of the use, promotion or sales of the third-party products identified by VAGI-formative marks or consumer awareness of them. Generally, without such evidence, we cannot assess whether the use has been so widespread as to have any impact on consumer perceptions. *See Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005) (“The probative value of third-party trademarks depends entirely upon their usage.”); *Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1729 (TTAB 2007). However, the number of third-party users is sufficient, even allowing for the possibility that some of the entities are out of business, are small enterprises, or have reached only a few people, to support our finding that the VAGI-prefix is used to create a trademark that suggests an intimate feminine product. *See In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1565 n.16 (TTAB 1996).

The strongly suggestive nature of the VAGI-prefix (*i.e.*, referring to intimate feminine products) means that Opposer’s mark VAGISIL cannot bar the registration of every mark beginning with a VAGI-prefix used in connection with intimate feminine hygiene products despite the commercial strength of Opposer’s mark. Marks

incorporating the VAGI-prefix, including Opposer's mark VAGISIL, will bar the registration of marks "as to which the resemblance to [Opposer's mark] is striking enough to cause one seeing it to assume that there is some connection, association or sponsorship between the two." *Anthony's Pizza & Pasta Int'l Inc. v. Anthony's Pizza Holding Co.*, 95 USPQ2d 1271, 1278 (TTAB 2009), *aff'd*, 415 Fed. Appx. 222 (Fed. Cir. 2010) (quoting *Pizza Inn, Inc. v. Russo*, 221 USPQ 281, 283 (TTAB 1983)); *see also Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674-75 (Fed. Cir. 2015) (the combination of third-party registrations and third-party uses, even though lacking evidence as to the extent of sales or promotional efforts, may be "powerful on its face" and must be considered when assessing the strength of plaintiff's mark); *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985) ("the public can be said to rely more on the non-descriptive portion of each mark.").

In this regard, Opposer stated that it has no documents referring to any reported instances of confusion between its VAGISIL trademark and any other trademark of any other party.⁶⁵

B. The similarity or dissimilarity and nature of the goods.

Applicant is seeking to register its VAGISAN mark for the goods listed below:

Soaps, perfumery, essential oils, cosmetics, hair lotion, in
Class 3; and

Pharmaceutical preparations, namely, vaginal
moisturizers, vaginal anti-fungal preparations, vaginal

⁶⁵ Opposer's response to Applicant's request for production of documents No. 3 (45 TTABVUE 3-4).

washes; sanitary preparations for medical use; diet pills, diet capsules, diet liquid medications, in Class 5.

Opposer has registered its VAGISIL mark for, *inter alia*, “moisturizers for the skin at the external vaginal area,” “non-medicated feminine washes,” and “cosmetics – namely, powders for feminine use.”

Applicant’s “vaginal moisturizers” and “vaginal washes” are identical to Opposer’s “moisturizers for the skin at the external vaginal area” and “non-medicated feminine washes.”

Applicant’s “cosmetics” are broad enough to encompass Opposer’s “cosmetics – namely, powders for feminine use.” See *In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”). Therefore, the goods in Class 3 are in part identical.

Under this *du Pont* factor, Opposer need not prove, and we need not find, similarity as to each and every product listed in the description of goods. It is sufficient for likelihood of confusion that relatedness is established for any item encompassed by the description of goods in a particular class in the application. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1588 n.1 (TTAB 2011), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014).

C. Established, likely-to-continue channels of trade.

Because the goods described in the application and Opposer's registrations are in part identical, we must presume that the channels of trade and classes of purchasers are the same. *See In re Viterra Inc.*, 101 USPQ2d at 1908 (legally identical goods are presumed to travel in same channels of trade to same class of purchasers); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011).

D. The conditions user which and buyers to whom sales are made, i.e., "impulse" vs. careful, sophisticated purchasing.

By virtue of the nature of the products at issue, intimate feminine hygiene products, women exercise a considerable degree of care in their purchasing decisions.

Q. Would you agree with me Ms. Payne that women are careful in treating their own health, in particular intimate parts of their body?

A. For the most part most women, yes.

Q. So would you agree with me that women would as an extension of that be careful in the selection of what products they would use to treat a health issue, particularly one that is related to an intimate part of their body?

A. Yes.⁶⁶

⁶⁶ Payne Testimony Dep., p. 60 (41 TTABVUE 63).

Opposer promotes itself as “Intimate Health Experts” “here to be your expert partner in intimate health.”⁶⁷ Questions from potential purchasers are referred to Opposer’s “medical expert.”⁶⁸ Opposer presents “intimate-health tutorial videos” by its gynecologist, Dr. Adelaide Nardone.⁶⁹ Likewise, Applicant promotes its VAGISAN product as being “designed to promote female well-being and help maintain the health of the female genital area.”⁷⁰ In fact, Applicant, on its website discusses “intimate health” issues.⁷¹

We find that consumers and potential consumers of the products at issue, intimate feminine hygiene products, exercise a considerable degree of consumer care and, therefore, this *du Pont* factor weighs against finding that there is a likelihood of confusion.

E. The similarity or dissimilarity of the marks.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *du Pont*, 177 USPQ at 567. In comparing the marks, we are mindful that where, as here, the goods are in part identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Coach Servs., Inc. v. Triumph Learning*

⁶⁷ Opposer’s website (vagisil.com) (38 TTABVUE 117).

⁶⁸ Opposer’s website (vagisil.com) (38 TTABVUE 114).

⁶⁹ *Id.* See also 38 TTABUE 118.

⁷⁰ Applicant’s website (vagisan.com) (43 TTABVUE 5); see also 43 TTABVUE 7).

⁷¹ Applicant’s website (vagisan.com) (43 TTABVUE 18-33).

LLC, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enter. Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Prod. Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

“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*, 101 USPQ2d at 1721 (quoting *Leading Jewelers Guild Inc. v. LJOH Holdings LLC*, 82 USPQ2d 1901, 1905 (TTAB 2007); see also *San Fernando Electric Mfg. Co. v. JFD Elec. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d mem.*, 972 F.2d 1353 (Fed. Cir. 1992).

Applicant is seeking to register VAGISAN and Opposer has registered VAGISIL. The VAGI–prefix is the common element of the marks. As discussed above, the VAGI–prefix is a suggestive term engendering the commercial impression related to intimate feminine hygiene products. Where the common portion of the marks is weak, consumers may distinguish the marks based on otherwise minor differences in the remaining portions of the mark. *In re National Data Corp.*, 224 USPQ at 752.

A merely descriptive or highly suggestive term falls within the general category of inherently weak marks, and the scope of protection extended to these marks has been so limited as to permit the subsequent use or registration of a substantially

identical notation for different goods or of a composite mark comprising this term plus other matter, whether such matter be equally suggestive or even descriptive, for substantially similar goods. Thus the addition of other matter to a merely descriptive or highly suggestive designation may result in the creation of a mark which is distinguishably different therefrom so as to avoid confusion in trade. *Land-O-Nod Co. v. Paulison*, 220 USPQ 61, 66 (TTAB 1983); *see also Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694 (CCPA 1976) (“It is obvious that the suffixes of the parties’ marks are highly suggestive. Because marks, including any suggestive portions thereof, must be considered in their entirety, the mere presence of a common, highly suggestive portion is usually insufficient to support a finding of likelihood of confusion.”); *Sure-Fit Prods. Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 117 USPQ 295, 297 (CCPA 1958) (“Where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. The essence of all we have said is that in the former case there is not the possibility of confusion that exists in the latter case.”); *In re Hartz Hotel Serv. Inc.*, 102 USPQ2d 1150, 1154 (TTAB 2012) (“Unlike a situation involving an arbitrary or fanciful mark, the addition of other matter to a laudatory or suggestive word may be enough to distinguish it from another mark.”).

The other portions of the two marks, SAN and SIL, are not similar. In view of the highly suggestive nature of the VAGI-prefix, we find that Applicant’s addition of the

term “SAN” to the VAGI-prefix is sufficient to render the resulting mark VAGISAN, considered in its entirety, distinguishable from Opposer’s mark VAGISIL.

F. Any other established fact probative of the effect of use.

Opposer introduced official records from the United Kingdom Trademark Office regarding Applicant’s opposition to the registration of Opposer’s VAGISIL trademark⁷² as evidence that Applicant has “taken the position that a likelihood of confusion exists between Opposer’s VAGISIL Marks and Applicant’s VAGISAN Mark.”⁷³ We do not find this evidence persuasive.

First, information concerning an applicant's foreign activities, including foreign trademark applications or registrations, is not relevant to the issue of likelihood of confusion in an opposition proceeding. *See Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1612 (TTAB 1991); *Oland's Breweries [1971] Limited v. Miller Brewing Company*, 189 USPQ2d 481, 483 n. 2 (TTAB 1975), *affirmed*, 192 USPQ 266 (CCPA 1976) (“Rights in and to a trademark including the right of registration in this country are created by prior adoption and use in commerce which may lawfully be regulated by Congress. Use and/or promotion of a mark confined to a foreign country including, of course, Canada, is immaterial to the ownership and registration thereof in the United States.”); and *Johnson & Johnson v. Salve S.A.*, 183 USPQ 375, 376 (TTAB 1974) (“foreign use of a mark creates no rights in such mark in the United States, and any information or evidence pertaining

⁷² 50 TTABVUE 26.

⁷³ Opposer’s Brief, p. 22 (57 TTABVUE 29).

to foreign use is thus immaterial to a party's right to register its mark in the United States.”).

[T]he issue of likelihood of confusion is determined on the basis of circumstances surrounding use of involved marks in the United States; that is, use in commerce which may lawfully be regulated by Congress. Where, as here, a mark is not in actual use in the United States, likelihood of confusion is resolved on the basis of the goods upon which the mark is used, as identified in the application or registration, and of the logical inferences as to trade channels, etc., which may be drawn from the essential nature of such goods.

Id. at 377.⁷⁴

Second, to the extent Applicant’s conduct in the foreign proceeding may be construed as an admission against interest, contrary positions in other proceedings are “merely illuminative of shade and tone in the total picture confronting the decision maker.” *See Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1283 (Fed. Cir. 1984) (quoting *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 154 (CCPA 1978).

Finally, Section 17 of the Trademark Act, 15 U.S.C. § 1067, gives the Director of the USPTO the authority to direct the Board “to determine and decide the respective rights of registration” in an opposition to registration. This duty may not be delegated by adoption or conclusions reached by parties on different records. Suffice it to say that each case must be decided on its own merits based on the evidence of record.

⁷⁴ Accordingly, the fact that Opposer’s International registration for VAGISIL was provisionally refused registration due to Applicant’s Israeli registration of VAGISAN is not relevant to the issue of likelihood of confusion before us. 50 TTABVUE 6.

Citigroup, Inc. v. Capital City Bank Group, Inc., 94 USPQ2d 1645 (TTAB 2010), *aff'd* 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011).

G. Balancing the factors

As noted above, when Opposer adopted and began using a mark featuring the VAGI-prefix, it ran “up against the well-settled principle that ‘a proprietary right cannot be acquired in a nonarbitrary term or a term that has been so commonly used in the trade that it cannot function as the distinguishing feature of any one party’s mark.’” *In re LC Trademarks, Inc.*, 121 USPQ2d 1197, 1205 (TTAB 2016) (quoting *Cambridge Filter Corporation v. Servodyne Corporation*, 189 USPQ 99, 103 (TTAB 1975). In *Cambridge Filter Corp.*, opposer opposed the registration of UNI-CAP and UNI-FLO based on opposer’s prior use of marks comprising –cap and –flow suffixes. The Board held that “opposer has not acquired a proprietary right or secondary meaning in the suffix ‘CAP’ or ‘FLO’ in the air filter field and that the inclusion in each of the parties’ marks here involved of the ‘CAP’ and ‘FLO’ suffix cannot serve, per se, as a basis upon which to predicate a holding of conflict among the marks.” *Id.* at 103-104.

Thus, despite the fact that Applicant’s mark is commercially strong, the goods are in part identical and presumed to move in the same channels of trade, because of the inherent weakness of the VAGI-prefix, the considerable degree of purchaser care, and dissimilarity of the marks VAGISAN and VAGISIL, we find that Applicant’s mark VAGISAN is not likely to cause confusion with Opposer’s mark VAGISIL.

VI. Whether Applicant had a *bona fide* intent to use its mark at the time Applicant filed for extension of protection under Section 66(a) of the Trademark Act?

“Because a bona fide intent to use the mark in commerce is a statutory requirement of a valid intent-to-use trademark application under [Trademark Act] Section 1(b) [15 U.S.C. § 1051(b)], the lack of such intent is a basis on which an opposer may challenge an applicant's mark.” *M.Z. Berger & Co. v. Swatch AG*, 787 F.3d 1368, 114 USPQ2d 1892, 1897 (Fed. Cir. 2015). Applicant's intent must be “firm,” “demonstrable” with “objective evidence of intent” and “more than a mere subjective belief.” *Id.* at 1897-98. We have long held, and the Federal Circuit recently affirmed, that our “determination of whether an applicant has a bona fide intention to use the mark in commerce is to be a fair, objective determination based on all the circumstances.” *Id.*; *Lane Ltd. v. Jackson International Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1506 (TTAB 1993).

An opposer bears “the initial burden of demonstrating by a preponderance of the evidence that applicant lacked a bona fide intent to use the mark on the identified goods.” *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1587 (TTAB 2008). An opposer may meet this burden by establishing that there is an “absence of any documentary evidence on the part of [Applicant] regarding such intent.” *Commodore*, 26 USPQ2d at 1507.

If an opposer meets its burden, the applicant may “elect to try to rebut the opposer[s]’ prima facie case by offering additional evidence concerning the factual

circumstances bearing upon its intent to use its mark in commerce.” *Id.* at 1507 n.11. However, an applicant's “mere statement of subjective intention, without more, would be insufficient to establish applicant's bona fide intention to use the mark in commerce.” *Lane*, 33 USPQ2d at 1355.

Angela Thevessen, an employee in Applicant’s export department, testified to the following facts:

- Applicant is a manufacturer of medicinal products, medical devices, and cosmetic products;⁷⁵
- Applicant started in Germany;⁷⁶
- Applicant first sold its VAGISAN branded products in 1998;⁷⁷
- Applicant launched its VAGISAN moisturizing cream in 2008;⁷⁸
- Applicant is the market leader in Germany;⁷⁹
- Prior to filing its application in the USPTO, Applicant sold its VAGISAN products in Germany, Belgium, Bulgaria, Estonia, Finland, Iran, Jordan, Croatia, Lithuania, Latvia, Poland, Switzerland, Serbia, Montenegro, Slovenia, and the Czech Republic;⁸⁰

⁷⁵ Thevessen Testimony Dep., p. 7 (47 TTABVUE 10).

⁷⁶ Thevessen Testimony Dep., p. 8 (47 TTABVUE 11).

⁷⁷ Thevessen Testimony Dep., pp. 7 and Exhibit 1 (47 TTABVUE 10 and 44).

⁷⁸ Thevessen Testimony Dep., p. 8 (47 TTABVUE 11).

⁷⁹ Thevessen Testimony Dep., p. 8 (47 TTABVUE 11).

⁸⁰ Thevessen Testimony Dep., p. 8 and Exhibit 1 (47 TTABVUE 11 and 44).

- Applicant expands sales to countries outside of Germany by finding business partners or distributors able to sell intimate feminine hygiene products.⁸¹

We usually search for one partner who gets exclusive distributorship, and then I take care of getting - - gathering information of the market, which competitors are there, what are our possibilities, our options, is the market lucrative for us, how big is it, how many inhabitants? I teach the partner in our brands and products. I develop a marketing strategy for the market.⁸²

- At the end of 2011, Applicant's managing directors decided to enter the U.S. market⁸³ "[b]ecause the U.S. is by far one of the most lucrative, wonderful markets in the world."⁸⁴

- Because Applicant's VAGISAN moisturizing cream may be considered a Class B medical device, entering the U.S. market is a complex undertaking.⁸⁵

We started in 2013, the process of getting to know how regulatory process in the U.S. market is like because it is different than in Europe. We decided in 2011 that we want to conquer the U.S. market, but if you go into a lucrative market like the U.S., you really have to prepare that well, and that is why we wanted to gain some experience in smaller countries, countries which are not so - - when you make a mistake, it is not so bad as it would be in the U.S., and that is why it took us a while.⁸⁶

⁸¹ Thevessen Testimony Dep., p. 6 (47 TTABVUE 9).

⁸² Thevessen Testimony Dep., pp. 6-7 (47 TTABVUE 9-10).

⁸³ Thevessen Testimony Dep., pp. 11-12 (47 TTABVUE 14-15).

⁸⁴ Thevessen Testimony Dep., p. 16 (48 TTABVUE 5). Although designated as confidential, we do not consider Applicant's characterization of the U.S. market as "lucrative" and "wonderful" to be confidential. Trademark Rule 2.116(g), 37 C.F.R. § 2.116(g) ("The Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.").

⁸⁵ Thevessen Testimony Dep., p. 25 (47 TTABVUE 21).

⁸⁶ Thevessen Testimony Dep., p. 26 (47 TTABVUE 22).

- When Applicant enters the U.S. market, it will begin slowly.

I think in the beginning we would start very slow, and then we would - - whenever we conquer a market, we go very slowly into the market, and then year after year we increase, so we would start with 200,000 pieces.⁸⁷

- Applicant has not sold VAGISAN products in the United States;⁸⁸
- Applicant has not advertised the sale of VAGISAN products in the United States;⁸⁹
- Applicant does not have a written or formal marketing plan for the VAGISAN products in the United States;⁹⁰
- As of the filing date of the application, Applicant had not entered into any contracts to sell its VAGISAN products in the United States;⁹¹ and
- “In the beginning of 2012,” Applicant had discussions with a U.S. company “extremely interested in selling our Vagisan.”⁹² Applicant has been in contact with two U.S. companies regarding distributing VAGISAN products but Applicant has put its search for a distributor on hold because of this opposition.⁹³

⁸⁷ Thevessen Testimony Dep., pp. 35-36 (47 TTABVUE 31-32).

⁸⁸ Thevessen Testimony Dep., p. 34 (47 TTABVUE 30).

⁸⁹ Thevessen Testimony Dep., p. 34 and 35 (47 TTABVUE 30 and 31).

⁹⁰ Thevessen Testimony Dep., p. 35 (47 TTABVUE 31); *see also* Applicant’s response to Opposer’s document request Nos. 7 and 29-31 (39 TTABVUE 177 and 182). In addition, Applicant has not conducted any market research for entering the U.S. market. Applicant’s response to Opposer’s interrogatory No. 4 (39 TTABVUE 171);

⁹¹ Thevessen Testimony Dep., p. 41 (47 TTABVUE 37); *see also* Applicant’s response to Opposer’s interrogatory Nos. 2-3 (39 TTABVUE 170-171) and document request No. 19 (39 TTABVUE 179-180).

⁹² Thevessen Testimony Dep., p. 16 (48 TTABVUE 5).

⁹³ Thevessen Testimony Dep., p. 30 (47 TTABVUE 30).

Opposer argues that because Applicant has not introduced “any evidence, documentary or otherwise, showing that it has an intent to use the VAGISAN Mark in the United States at the time it filed its VAGISAN Application,” Applicant “had only an intent to reserve the mark for possible use at some unspecified time in the future, not a firm intent to use the mark.”⁹⁴ Applicant argues, to the contrary, that because it had already sold VAGISAN products in numerous countries outside of Germany, it “possessed the *ability* to sell the VAGISAN product in the United States at the time of filing its trademark application.”⁹⁵

In our analysis of whether Applicant had the requisite intent-to-use, we have considered the fact that since 1998 Applicant has been in the business of making and selling intimate feminine hygiene products in Germany and in other countries. The Board has previously found that an applicant's capacity to market or manufacture the identified goods is evidence supporting that an applicant has a *bona fide* intent to use. *See Swatch AG v. M. Z. Berger & Co.*, 108 USPQ2d 1463, 1477 (TTAB 2013), *aff'd* 114 USPQ2d 1892; *Wet Seal, Inc. v. FD Mgmt., Inc.*, 82 USPQ2d 1629, 1643 (TTAB 2007).

Moreover, shortly after the filing its application, Applicant met with a U.S. company to discuss distributing its VAGISAN products in the United States. This meeting was sufficiently contemporaneous with the filing date to support Applicant's *bona fide* intent to use the mark. *Swatch AG v. M. Z. Berger & Co.*, 108 USPQ2d at

⁹⁴ Opposer's Brief, p. 28 (57 TTABVUE 35).

⁹⁵ Applicant's Brief, p. 11 (61 TTABVUE 15).

1474, *aff'd* 114 USPQ2d 1892; *Lane Ltd. v. Jackson Int'l Trading Co.*, 33 USPQ2d at 1355 (documentary evidence created nine to eleven months after the application was filed held sufficiently contemporaneous evidence of intent).

Finally, even if Applicant did not have a formal or written business plan for entering the U.S. market, it had the ability to manufacture and market the products at issue and it had demonstrated the ability to export the products into other countries to set the stage for its expansion into the U.S market. In this regard, Ms. Thevessen testified that Applicant would enter the U.S. market by finding a partner who would distribute the products and that they would start on a small scale and expand.

We have carefully considered all of the parties' arguments and evidence in the record, even if not specifically discussed herein. Viewing all circumstances objectively, Applicant's actions reveal a *bona fide* intention to use the mark in a real and legitimate commercial sense on the identified goods at the time it filed the application. *Compare L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1443 (TTAB 2012) (applicant's generalized and non-specific references to licensing and outsourcing as strategies for distribution, lack of contacts with potential distributors, "no record evidence that applicant is now or ever was in the business of producing aloe vera drinks or any other foods or beverage product" fails to "corroborate applicant's bald allegation that he has a bona fide intent to use the mark in commerce.").

Decision: The opposition is dismissed.