

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

Mailed: 3/16/04

Paper No. 20
ejs

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Von Eric Lemer Kalaydjian

Serial No. 75854349

Michael R. Diliberto of Kleinberg & Lerner, LLP for Von Eric Lemer Kalaydjian.

Richard S. Donnell, Trademark Examining Attorney, Law Office 106 (Mary Sparrow, Managing Attorney).

Before Simms, Seeherman and Chapman, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Von Eric Lemer Kalaydjian, a U.S. citizen, has appealed from the final refusal of the Trademark Examining Attorney to register AMAZON as a trademark for "cosmetic preparations, namely, sun screens, sun blocks, skin tanning

oils and lotions, wind screens and sunburn relief lotions."¹ Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the mark AMAZONN FLORA and design, shown below, previously registered for "cosmetic products for the face and body, namely, eye cream, face cream, face gel, face and body soap,"² as to be likely to cause confusion or mistake or to deceive.



¹ Application Serial No. 75854349, filed on November 22, 1999, and asserting first use on July 29, 1999 and first use in commerce on September 1, 1999. The mark shown in the original drawing of the application was AMAZON COSMETIC AND TAN PRODUCTS, and applicant submitted a disclaimer of COSMETIC AND TAN PRODUCTS; the drawing was amended on November 11, 2001 by Examiner's Amendment to delete the descriptive phrase; thus, the disclaimer has also been deleted.

² Registration No. 2503377, issued November 6, 2001.

Applicant and the Examining Attorney have filed briefs. Applicant requested an oral hearing, but subsequently withdrew that request.

As a preliminary matter, we note that applicant has filed his brief in triplicate, along with triplicate filings of over 600 pages of exhibits. First, only a single copy of a brief is required in an ex parte appeal. Second, although an applicant may occasionally attach a copy of an exhibit to its brief if it wishes to focus the attention of the Board on that exhibit, no purpose is served by the submission of a voluminous number of exhibits, since obviously no single exhibit will then be particularly noted. There is certainly no reason for an applicant to submit copies of all exhibits that are already in the application file.³ As a result, there was no need to resubmit the exhibits with the appeal brief and, in fact,

³ In his brief, the Examining Attorney states that some of the evidence submitted with the applicant's appeal brief is untimely, but he does not indicate the specific exhibits which he contends should not be considered. As far as we can tell from a cursory review, all of the exhibits submitted by applicant with his brief were previously made of record. However, given the volume of evidence submitted with the appeal brief, the Board will not conduct a laborious comparison of the documents submitted with the brief and the hundreds of pages of documents submitted by applicant during the prosecution of the application. Instead, we have reviewed and considered those exhibits which were timely made of record during the course of prosecution, i.e., the exhibits submitted with applicant's responses and his request for reconsideration.

the processing and storage of this voluminous number of papers has been burdensome to the Office. Applicant should not do so in future.

Both during the course of prosecution and with his brief, applicant has submitted a copy of a non-precedential decision by the Board, noting that it involved another client of applicant's attorney. It is well settled that non-precedential decisions of the Board are not citable (a point which is clearly marked on the decision submitted by applicant), and therefore we will not discuss this decision to show why it is distinguishable from the present circumstances.

Turning then to the issue of likelihood of confusion, our determination is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See

also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

With respect to the goods, applicant's goods are various skin care products used in connection with exposure to the sun and wind, including sun screens, skin tanning lotions, sun blocks, wind screens and sunburn relief lotions. The registration includes face cream and eye cream. Although these products are not identical, they are clearly related. Both types are used to protect the skin, and both can be used in a complementary fashion, in that one might apply face cream or eye cream after exposure to the sun or wind. Face creams may also include sun block. Further, sunburn relief lotions and face creams have a somewhat similar function, to the extent that the lotions can be used for their moisturizing effect, which is the same effect that face creams have.

The relatedness of the products is also shown by applicant's own business activities, in that applicant has used his mark for both the identified goods listed above, and also for "hand and body moisturizers." In the original application applicant included "skin lotions" in the identification of goods. This application was based on use in commerce, and asserted use of the mark on the goods as of July 29, 1999, and use in interstate commerce on

September 1, 1999. On May 18, 2001, applicant amended his identification of goods, but still included "hand and body moisturizers." On July 2, 2001, although there is no indication that applicant had, in the meantime, changed the basis of his application to intent to use, applicant filed an amendment to allege use, and in that amendment he stated that he "is using the mark in commerce on or in connection with those goods/services identified in the application."⁴ At the time, those goods included "hand and body moisturizers." Thus, even though applicant subsequently deleted these items from his identification in order to try to avoid the present likelihood of confusion refusal, it is clear from his own statements that he has used the same mark for both hand and body moisturizers and his various sun tanning and skin protection products and, thus, that the same products may emanate from a single source under a single mark.

This brings us to a consideration of the marks. Applicant's mark is AMAZON; the cited mark is AMAZONN FLORA and design. For ease of reference, we show the registered mark below:

⁴ Because an amendment to allege use is not required for a use-based application, the fee applicant submitted for such document was refunded by the Office.



It is clear that in the cited mark the word AMAZONN appears at the top of the mark, separated from the word FLORA by a relatively large design of a palm tree. The word FLORA is also shown in a different type style from AMAZONN, with AMAZONN depicted in all capital letters, and FLORA in all lower case. The general impression is that AMAZONN is the more important, source-indicating part of the mark, and that FLORA indicates a type or line of AMAZONN products, or that it suggests the ingredients of the products. In this connection, we note that "flora" is, as applicant states, the Latin word for "flower," and that the word is defined as "plants collectively; especially, the plants of a particular region or time."⁵

⁵ The American Heritage Dictionary of the English Language © 1970. The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet*

It is a well-established principle of trademark law that marks must be considered in their entirety. It is equally well established that there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entirety. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

In this case, we find that the term AMAZONN is the dominant part of the cited mark. For the reasons set forth above, it, rather than the word FLORA, will be perceived by consumers as the source-indicating part of the mark. As for the palm tree design, although it is prominently displayed, it is still the term AMAZONN by which people will refer to and call for the products and, thus, it is the portion of the mark which consumers are more likely to note and remember. See In re Appetito Provisions Co., 3 USPQ21d 1553 (TTAB 1987). The design, in fact, along with the word FLORA, reinforces the meaning of AMAZONN as the river in South America, giving the impression that the registrant's products contain ingredients from this region.

Food Imports Co., Inc., 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

We recognize that the term in the cited mark has an additional "N." However, we do not think that this slight difference distinguishes the registered mark from applicant's mark. Because it is a final letter, and merely repeats the last letter in "amazon," consumers are not likely to even notice it, but will view the term as the familiar word "amazon." Even if they do notice that the registered mark has the additional "n," they are not likely to remember this difference when confronted by applicant's mark. Under actual marketing conditions consumers do not necessarily have the luxury to make side-by-side comparisons of marks, but must rely on their imperfect recollections. See *Dassler KG v. Roller Derby Skate Corporation*, 206 USPQ 255 (TTAB 1980).

Applicant argues that the cited mark is a weak mark, and consequently that the registration should be given a limited scope of protection. Applicant bases his position on his assertion that the term AMAZON has been used as a mark by third parties, and has also been the subject of third-party registrations. In support of this position, applicant has submitted apparently every AMAZON or AMAZON-variation registration that appears in the records of the

U.S. Patent and Trademark Office, as well as excerpts obtained from searches of the Internet.⁶

With respect to the third-party registrations, we must first point out that third-party registrations are not evidence that the marks shown therein are in use. *General Mills, Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1277 (TTAB 1992).⁷ Third-party registrations are probative to the extent that they may show the meaning of a mark or a portion of a mark in the same way that dictionaries are employed. *Mead Johnson & Company v. Peter Eckes*, 195 USPQ 187 (TTAB 1977). In this case, virtually all of the third-party registrations are for goods and services that are very different from those of the applicant and the owner of the cited registration. For example, AMAZON is registered for "computer software for use in connection with communications hardware and software" (Registration No. 1930917); for "flour made from wheat" (Registration No. 199499); "prepaid telephone calling cards not magnetically

⁶ Applicant also submitted a search report prepared by a private search service. Such a report is not probative that the marks shown therein are in use, or that the registrations are in existence. See *In re Hub Distributing, Inc.*, 218 USQ 284 (TTAB 1983).

⁷ Applicant states in his brief that third-party registrations (and applications) establish third-party use, and cites *General Mills* for that proposition. However, that is decidedly not the case, as the *General Mills* opinion explicitly states ("although the registrations are not evidence of use").

encoded" (Registration No. 2333851) and "restaurant services" (Registration No. 2056533); while variations of the AMAZON mark include AMAZON QUEEN for "machines for playing games of chance and parts thereof" (Registration No. 2624479); AMAZONAS for "hammocks and fabric hanging chairs" (Registration No. 2512362); and AMAZON COMMANDO for "sport blowguns" (Registration No. 2300044). These registrations do not show that AMAZON has a particular meaning or significance in the cosmetics industry, such that a more limited scope of protection must be accorded to the cited registrant's mark. Compare, General Mills, supra, where there were 171 third-party registrations in the food products and dietary food supplement industries (the goods at issue in that proceeding were breakfast cereal).

In fact, the only third-party registrations for goods similar to those of the applicant and the cited registrant are two registrations, owned by a single registrant, for AMAZONE and a package design for "perfumes, perfumed water, toilet water, toilet soaps and deodorants" (Registration No. 1636608) and for AMAZONE in the same slightly stylized type font for "perfumes, toilet soaps, essential oils, hair lotions, dentifrices, face powder, rouge, lipstick, and cosmetic skin creams and lotions" (Registration No.

1019789).⁸ We do not know the circumstances under which the cited mark was registered despite the existence of these registrations, since the file of this registration is not of record. There may, for example, have been a consent by the owner of the AMAZONE registrations. Or the Examining Attorney reviewing the application which issued into the cited registration may have viewed the commercial impression of the element AMAZONN as different from AMAZONE because of the recognizable suffix "zone" in the latter mark. Whatever the reason, we do not find these two registrations owned by a single entity for the same AMAZONE mark to be sufficient to demonstrate that the cited mark is so weak that its protection would not extend to the registration of AMAZON for similar goods.

As for third-party use, applicant has submitted nine exhibits taken from various websites. This evidence, upon closer examination, does not support applicant's claim that the mark AMAZON is weak. As the Court of Appeals for the Federal Circuit said in a slightly different context, *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824

⁸ Applicant also points to another registration in Class 3, for AMAZON'S for "cleaning preparations for marine use, namely boatsoap, mildew cleaner and teak cleaner" (Registration No. 1421664). Although this registration is in the same class as the application and the cited registration, clearly the goods are as different as those in the other third-party registrations which we have already discussed.

F.2d 957, 3 USPQ2d 1450, 1451 (Fed. Cir. 1987), "It is indeed remarkable to see the thoroughness with which NEXIS can regurgitate a placename casually mentioned in the news." The same can be said of Internet searches, as evidenced by the exhibits submitted by applicant. For example, applicant has submitted various excerpts from the E-Bay website which show that single items are being offered at auction. They include a single vial of "EROTIC OIL-AMAZON PASSION," being auctioned by an entity in Canada; a single vintage bottle (sold empty) which had once apparently held AMAZONE eau de toilette; and a listing for the "Amazing New 'Amazon Diet' Weight Loss System." Obviously, the latter is for goods very different from those of applicant and the registrant, and it is also noted that only one such item is being offered, and the offeror is located in Canada.

Other websites appear to offer items different from those at issue herein. For example, the website for iHerb.Com provides "Herbs, Vitamins, Amino Acids at the best Value." <http://amazondrugs.com>. And the website for Amazon-Life, <http://amazon-life.com>, indicates that this is an herb company which offers "wild food" products.

This is not to say that none of the nine Internet exhibits indicates use of the term AMAZON for cosmetic

products. For example, E-BANNER.com lists, among other brands, "Class Cosmetics—Offers handmade skincare range from Amazon Cosmetics and discounts on name brand cosmetics from lipstick to eye creams."⁹ However, the limited evidence provided by applicant is not in any way sufficient for us to conclude that there has been significant third-party use of AMAZON marks for cosmetic and skin care products, such that consumers will look to other elements in the marks to distinguish one AMAZON mark from the others.

Although not addressed by applicant, we note that there are additional duPont factors which favor a finding of likelihood of confusion. The goods identified in the cited registration and applicant's application would travel in the same channels of trade and could be sold, for example, in drugstores. The goods are also consumer items that would be purchased by the public at large; thus, the purchasers cannot be considered particularly sophisticated. Further, although there is no evidence as to the cost of applicant's and registrant's goods, the identifications could include items that are relatively low cost. As a

⁹ Because this page prominently features Amazon.com, and a link to "shop now," it is not entirely clear to us whether the reference to Amazon Cosmetics is merely to third-party brands which are sold by the internet company Amazon.com.

result, there is no reason to expect that the consumers of the products would exercise a great deal of care in making their purchases.

Accordingly, we find that applicant's mark, AMAZON, as used on his identified goods, is likely to cause confusion with AMAZONN FLORA and design for cosmetic products for the face and body, namely, eye cream, face cream, face gel, face and body soap. To the extent that there is any doubt on this issue, it is well settled that such doubt must be resolved in favor of the registrant and prior user. In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes, 487 F.2d 918, 179 USPQ 729 (CCPA 1973).

Decision: The refusal of registration is affirmed.