

Mailed:
September 10, 2003

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Paper No. 13
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Kiss My Face Corporation

Serial No. 76/007,654

Michael A. Cornman of Schweitzer Cornman Gross & Bondell
for Kiss My Face Corporation.

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111 (Craig Taylor, Managing Attorney).

Before Simms, Hanak and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Kiss My Face Corporation [applicant] seeks to register, on the Principal Register, the mark SILKY SOFT for goods identified as "facial lotions, facial soaps, hair conditioning rinses, shampoos, liquid hand soaps, and shaving creams," in International Class 3. Applicant has asserted, as the basis for its application, that it has a bona fide intention to use the mark in commerce for the identified goods.

The examining attorney has refused registration on the ground that there would be a likelihood of confusion among consumers if applicant's mark were used for the identified goods, in view of the prior registration of SOF'N SILKY and SOFT'N SILKY, both registered to the same entity for goods identified as "non-medicated baby powder," in International Class 3.¹ When the refusal of registration was made final, applicant appealed.

Applicant and the examining attorney have filed briefs. Applicant did not request an oral hearing.

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 likelihood of confusion issue. See In re E.I. du Pont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In the analysis of likelihood of confusion presented by this case, two key considerations are the similarities of the marks and the similarities of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

¹ Registration no. 1,254,221 (SOF'N SILKY), registered October 18, 1983, and listing February 1973 as the date of first use and first use in commerce; registration no. 1,257,289 (SOFT'N SILKY), registered November 15, 1983, and listing February 1978 as the date of first use and first use in commerce. For each registration, a Section 8 affidavit has been accepted and a Section 15 affidavit has been acknowledged.

Turning first to the goods, we note that even if goods identified in an application and registration are not competitive, there may still be a likelihood of confusion, when similar marks are used in conjunction therewith, if such goods are related in some manner and/or if the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under conditions that would give rise to the mistaken belief that the goods emanate from or are in some way associated with the same source or sponsor. See In re Kangaroos U.S.A., 223 USPQ 1025, 1026-1027 (TTAB 1984), and cases cited therein.

In the case at hand, we find the goods related for purposes of the likelihood of confusion analysis. While applicant earlier argued that its products "are strictly cosmetics, products clearly not intended to be used on or in connection with babies" (response to first office action), we note that its goods in the subsequently amended identification include "facial soaps" and "shampoos" without restriction as to suitability for adults or infants. Thus, we must consider the listing of these items to encompass soaps and shampoos for use on infants as well as adults. See In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) ("Indeed, the second

DuPont factor expressly mandates consideration of the similarity or dissimilarity of the services as described in an application or registration"). Moreover, applicant does not argue, and we do not believe that it reasonably can, that baby powder is only for use on babies.

Turning to the marks, we note that applicant relies heavily on two cases wherein marks with essentially transposed terms were permitted to coexist on the register, despite goods and/or services that were held to be commercially related for likelihood of confusion purposes. We consider each of these cases and their lessons, to frame our consideration of the marks involved in this case.

In In re Akzona Inc., 219 USPQ 94 (TTAB 1983), the marks were SILKY TOUCH, which the applicant sought to register for "synthetic yarns," and TOUCH 'O SILK, which was already registered for "men's dress shirts, sport shirts and pajamas." In that case, the Board found the goods to be commercially related in that the clothing items could be made of the yarns and might then even be advertised as having been made from the yarns.² On the other hand, the Board found that the marks were different

² The Board noted that, in an earlier inter partes case, an applicant seeking to register NORLYN for panty hose and hosiery was opposed by a party using ORLON for synthetic fibers and which had advertised to ultimate consumers of hosiery the benefits of

in sound and appearance and, even more significantly, created different commercial impressions, because SILKY TOUCH meant "silky to the touch" while TOUCH O' SILK suggested registrant's clothing products "contain a small amount of silk." (It would appear that the Board considered TOUCH to have a different connotation in each mark, i.e., one meaning the physical act of touching something, and the other meaning a "bit of" something). Finally, in finding no likelihood of confusion, the Board relied on not just the different commercial impressions of the marks, but also on the fact that, although it had found the goods "commercially related" they were specifically different.

In In re Best Products Co., Inc., 231 USPQ 988 (TTAB 1986), the marks were BEST JEWELRY (the words being set forth in distinctly different styles of lettering), which the applicant sought to register for "retail jewelry store services," and JEWELERS' BEST, which had previously been registered for "men's and ladies' bracelets and watch bracelets, sold separately from the watches." The Board noted that the registrant's goods and the applicant's services clearly were related for purposes of the

stockings made of such fibers. See E. I. Du Pont de Nemours and Co. v. Norlyn Oy, 174 USPQ 405 (TTAB 1972).

likelihood of confusion analysis. Nonetheless, noting that the "primary concern" in cases involving transposed marks is that consumers with fallible recall of the marks might make mistaken purchases, the Board noted that such was not a concern in a case involving services and goods, for one would not purchase a product when looking for a service or a service when looking for a product.

The Board concluded that the only potential type of confusion would be as to source or sponsorship (i.e., prospective purchases would not be likely to make mistaken purchases). The Board found that this type of confusion was not likely to occur because of the different commercial impressions created by the involved marks. Specifically, it noted that BEST was a house mark and already registered for retail store services that encompassed the sale of jewelry; that BEST JEWELRY was not unitary (as it would be if it were perceived as a laudatory mark), because it would be perceived as the coupling of house mark and generic name of goods (each term being set forth in markedly different type). Thus, the Board found that applicant's mark would be perceived as expressing two distinct facts: first, it was a BEST store, and second, it was a jewelry store. On the other hand, the Board found that JEWELERS' BEST would

be perceived as creating the impression of jewelers' personally selected pieces of high quality.

While the Board found no likelihood of confusion in the *Best Products* case, it noted that it was a close case; and it was careful to note that transposed marks can result in likelihood of confusion even when the goods are not the same but, rather, are only closely related, when the marks create the same commercial impression. To underscore the point, the Board noted an earlier decision in which it found contemporaneous use of JEWELMASTERS PALM BEACH for "retail jewelry store services" and MASTER JEWELER'S COLLECTION for "jewelry—namely, rings" to create a likelihood of confusion, specifically because the marks, although involving a transposition, both evoked the "master jeweler" impression. See In re Jewelmasters, Inc., 221 USPQ 90 (TTAB 1983).

We find the case at hand distinguishable from the two cases on which applicant relies. First, while the goods are not competitive, they are complementary and likely may be found if not on the same shelves, in the same sections of retail stores such as groceries and pharmacies. In addition, they are the types of goods that consumers might expect to be marketed by a single producer. In this regard, we note that the examining attorney has made of

record six registrations based on use of the marks in commerce that list in their identifications products such as applicant's and baby powder.³ Second, in the case at hand, we do not find the transposition of terms to result in two marks with different commercial impressions. Rather, applicant's mark and the two registered marks create the same commercial impression, i.e., that of products that leave the user with skin or hair feeling soft as silk. We find this situation more akin to the *Jewelmaster* case than those cases on which applicant has relied.

Even if applicant is correct in arguing that the marks will be visually and aurally different, they will have the same commercial impression. We need not find similarity in each of the elements of the "sound, appearance or meaning" trilogy to find that marks are similar for purposes of the likelihood of confusion analysis. See In re Lamson Oil Co., 6 USPQ2d 1041, 1042 (TTAB 1988).

We are not persuaded that we should find no likelihood of confusion because of applicant's argument that there are hundreds of marks in International Class 3 that use either

³ Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993).

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silk or soft, or variations thereof. Significantly, applicant has not argued that there is even one other mark in the class that combines both silk or silky and soft.

Finally, we note that the registered marks have been on the register for decades and applicant is a newcomer who had the opportunity to select a mark that was unlike registrant's marks. Indeed, it had a duty to do so for, as the examining attorney has noted, even highly suggestive or "weak" marks are entitled to be protected against the registration by a subsequent user of a similar mark for closely related goods. See King-Kup Candies, Inc. v. King Candy Co., 288 F.2d 944, 129 USPQ 272 (CCPA 1961); and The Superior Electric Co. v. Frequency Technology, Inc., 197 USPQ 180 (TTAB 1977). Moreover, it is well settled that, if there is any doubt in a case involving a refusal under Section 2(d), it is to be resolved in favor of the registrant and against the applicant who had an opportunity to select a mark that would avoid creating confusion.

Decision: The refusal of registration under Section 2(d) of the Lanham Act is affirmed.