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Mailed:
August 4, 2004
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Nikos GmbH

Serial No. 76382877

Susan Upton Douglass of Fross Zelnick Lehrman & Zissu, P.C.
for Nikos GmbH.

Ira Goodsaid, Trademark Examining Attorney, Law Office 115
(Tomas Vlcek, Managing Attorney).

Before Seeherman, Bucher and Drost, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Nikos GmbH seeks registration on the Principal
Register of the mark shown below:



for goods identified in the application, as amended, as follows:

perfume, cologne, *eau de toilette*, *eau de parfum*, after-shave gel, after-shave lotions, personal deodorants and anti-perspirants, scented body lotion, bath and shower gel, bath oil, bath beads, body cream, body emulsions, non-medicated skin care preparations, cosmetics, in International Class 3.¹

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this mark based upon Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d). The Trademark Examining Attorney has held that applicant's mark, when used in connection with the identified goods, so resembles the mark shown below:



¹ Application Serial No. 76382877 was filed on March 15, 2002 claiming a right of priority pursuant to Section 44(d) based upon a German registration for which application was made on February 19, 2002. The instant application is based both upon applicant's allegation of a *bona fide* intention to use the mark in commerce (Section 1(b) of the Act) and on the foreign registration (Section 44(e) of the Act). Three other classes of goods in International Classes 14, 18 and 25, originally filed with this application, were divided out and have now issued as Reg. No. 2827573.

registered for goods identified as "cosmetics, namely foundation, concealer, powder, lipstick, lip gloss, lip pencil, eye shadow, eye liner, mascara, gels, serums, perfume, cosmetic brushes, cleansers, toners, moisturizers, make-up remover, night cream, eye cream, body cream, glitter pencil, shampoo, conditioner, styling gel, blush, hair spray, hair buffer and cologne," also in International Class 3,² as to be likely to cause confusion, to cause mistake or to deceive.

The Trademark Examining Attorney and applicant have fully briefed the case. Applicant did not request an oral hearing before the Board.

We affirm the refusal to register.

In arguing for registrability, applicant contends that an earlier registration owned by applicant³ co-existed with the cited registration; that the marks create totally different commercial impressions; that the Trademark Examining Attorney has improperly dissected the marks; and

² Registration No. 2549317 issued on March 19, 2002.

³ Registration No. 2036305 issued on February 11, 1997, but was then cancelled under Section 8, on November 15, 2003. However, this registration included no cosmetics in International Class 3 - containing goods in International Classes 18 and 25 only.



that the image of the winged lion contained within applicant's elaborate design is the signature element of applicant's mark. Applicant agrees that the goods are identical or otherwise closely related and that the respective goods would be presumed to travel through the same channels of trade to the same classes of consumers. On the other hand, applicant does argue that consumers "in the world of designer and licensed marks" would readily distinguish between these two marks.

By contrast, the Trademark Examining Attorney argues that while the involved marks have been considered in their entirety, the literal portions of the marks dominate each mark, creating similar overall commercial impressions. The Trademark Examining Attorney points out that applicant has shown neither the fame of its marks nor the sophistication of its consumers, and that a claim of ownership of a cancelled registration that included goods in International Classes 18 and 25 is totally irrelevant to the outcome in this proceeding.

Our determination under Section 2(d) is based upon an analysis of all of the facts in evidence that are relevant to the factors bearing upon the issue of likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d

1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relationship of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We turn first to the relatedness of the goods as listed in the cited registration and in the instant application. As noted, applicant has correctly conceded that its goods are identical or closely related to those of registrant, and would be presumed to travel through the same channels of trade to the same classes of consumers.

We turn next to the du Pont factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound and connotation. As our principal reviewing court, the Court of Appeals for the Federal Circuit, has pointed out, "[w]hen marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). While we compare the marks in their entirety, the Court of Appeals for the Federal Circuit has also held that in articulating reasons for reaching a

conclusion on the question of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature or portion of a mark. That is, one feature of a mark may have more significance than another. See Sweats Fashions Inc. v. Pannill Knitting Co., 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987), and In re National Data Corporation, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985).

Here, the only word in registrant's mark is the word NIKO, and we find NIKO to be the dominant feature of registrant's mark. Clearly, purchasers would generally call for registrant's goods by utilizing the word, NIKO, rather than trying to describe the oval design feature - described by applicant as reminiscent of "a sign or plaque." While applicant's mark does, of course, include the prominent image of a winged lion, the presence of this image does not change the reality that purchasers would generally call for applicant's goods by utilizing the word, NIKOS. The winged-lion design feature, being a non-literal element, is not something that potential or actual consumers can easily verbalize. While applicant analogizes NIKOS' winged-lion image to the NIKE swish or the RALPH LAUREN

polo player, there is no support in the record for the proposition that applicant's winged-lion image has attained such renown in the United States in connection with the sale of cosmetics products that the image alone would create strong source identification with applicant absent the word mark. Accordingly, despite applicant's arguments to the contrary, we find that the word NIKOS is the dominant portion of the composite mark involved herein.

As to appearance, as argued by applicant, both marks are displayed in different stylized formats:



Registrant's mark



Applicant's mark

Applicant emphasizes that its mark contains a "... Winged Lion design against a black background with a surrounding rim." When placed side-by-side, as shown above, there are obvious visual differences.

However, the test to be applied in determining likelihood of confusion is not whether the marks are distinguishable upon side-by-side comparison, but rather whether the marks, as they are used in connection with the

registrant's and applicant's goods, so resemble one another as to be likely to cause confusion. Under actual marketing conditions, consumers do not necessarily have the opportunity to make side-by-side comparisons between marks. Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corporation, 206 USPQ 255 (TTAB 1980). The proper emphasis is thus on the recollection of the average customer, and the correct legal test requires us to consider the fallibility of human memory. The average purchaser normally retains a general rather than a specific impression of trademarks. See Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); Spoons Restaurants Inc. v. Morrison Inc., 23 USPQ2d 1735 (TTAB 1991), affirmed in unpublished opinion, Appeal No. 92-1086 (Fed. Cir. June 5, 1992); Envirotech Corp. v. Solaron Corp., 211 USPQ 724 (TTAB 1981); and Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106 (TTAB 1975).

Here, the literal elements in both marks are formed in all upper case letters of a similar font style. Applicant's NIKOS is contained within a circle carrier while registrant's NIKO is contained within an oval carrier device. As noted, registrant's mark has no other

significant design features, while applicant's mark prominently includes at its center a winged lion.

Nonetheless, we find that the differences between these two marks are not sufficient to distinguish them. As argued by the Trademark Examining Attorney, given the composition of these two marks, applicant's mark is much closer in overall appearance to registrant's mark than applicant would have us conclude.

As to connotation, applicant offered in its application papers that "the mark NIKOS comprises a common first name." The cited registration does not provide any information about the origins of the very similar word NIKO, although it appears as if both NIKO and NIKOS might be seen as nicknames for Nicholas. In any case, consumers who are already acquainted with registrant's NIKO mark on cosmetics and notice the terminal letter "S" might well view NIKOS as a pluralized or even possessive (without the presence of an apostrophe) variation on the word NIKO.

As to pronunciation, when spoken, NIKO and NIKOS are almost indistinguishable. The Trademark Examining Attorney points out that given the frequency with which perfume is given as a gift, the putative buyer who asks the intended recipient to name her favorite perfume may hear either

"NIKO" or "NIKOS," and may well purchase the first of these products encountered.

Hence, after comparing these two marks in their entireties as to sound, meaning and appearance, we conclude that they create similar overall commercial impressions.

Applicant argues that the United States Patent and Trademark Office had earlier made a decision to permit the cited registration and its NIKOS APOSTOLOPOULOS and design mark to coexist on the Register:

The Applicant is the owner of U.S. Registration No. 2,036,305 for a design mark that is essentially identical to the mark at issue, except for the name APOSTOLOPOULOS, appearing in smaller print below the Winged Lion design, registered in Classes 18 and 25...

Notwithstanding the fact that the Applicant's mark containing the term NIKO[S] was already registered when the cited registrant's mark was being examined, the PTO determined that the marks could coexist. Undoubtedly, the PTO considered that the previously registered mark contained a number of elements, only one of which was the word NIKOS; as such, the mark NIKO would be able to coexist. Since the NIKO mark is already coexisting with the Applicant's registered mark NIKOS APOSTOLOPOULOS with the identical design for related goods, it is apparent that the PTO and the public, not to mention the owner of the cited registration, do not consider the marks to be confusingly similar. Because the marks are already coexisting, there is little prejudice to the cited registrant to allow

this similar mark for related goods to be registered as well.

Applicant's appeal brief of January 7, 2004, pp. 10, 11. However, as noted by the Trademark Examining Attorney, "that registration was cancelled on November 15, 2003 for failure to file an affidavit of continuing use under Section 8 of the Trademark Act." A cancelled trademark registration represents no continuing ownership rights for applicant.

In any case, the literal element of applicant's earlier mark was NIKOS APOSTOLOPOULOS. Moreover, it is noteworthy that this now cancelled registration was for goods in International Classes 18 and 25 only. In fact, as applicant is aware, the USPTO has actually acted in a manner consistent with that earlier determination during the prosecution of the instant application. As noted above, the involved application originally included, *inter alia*, goods in International Classes 18 and 25. The Office agreed with applicant to divide those goods out into a "child" application (Application Serial No. 76975972), and the involved mark with three classes of goods has now issued as Reg. No. 2827573.

Applicant and the Trademark Examining Attorney have debated the applicability of *In re Produits de Beaute*, 225

USPQ 283 (TTAB 1984) - an earlier Board decision having some parallels to the instant case. In that case, the cited registration was for the mark JUVENANCE for "cosmetic skin creams, lotion and cleansers." The application was for the following design mark, for "night cream":



In reversing the refusal to register, the Board found that the Trademark Examining Attorney had dissected the mark in that she concluded there was a likelihood of confusion based upon the similarity between the words "Jouvence" and "Juvenance." The Board noted that when considering the marks in their entireties, the comparison needed to be made between the single word JUVENANCE and a "visually complicated" mark having "a stylized bird design, color, the signature of 'JEAN d' AVEZE,' the word 'PARIS,' and the black background for all of the wording." 225 USPQ at 284. However, as noted in our detailed comparisons of the marks, *supra*, we do not find as sharp a contrast between the marks involved herein as was present in

Produits de Beaute. Additionally, in that decision, the Board seemed to accept applicant's argument that as applied to beauty products, the JOUVENENCE / JUVENANCE elements may "have a similar suggestiveness - that of youthfulness or rejuvenation," *Id.*, which would have limited the scope of protection to be accorded the cited registration. Such is not the case here with totally arbitrary terms like NIKO / NIKOS. Moreover, when weighing all the du Pont factors in the Produits de Beaute case, the Board accorded strong significance to the du Pont factor focusing on the interface between applicant and the owner of a prior mark. Specifically, the owner of the cited registration and applicant had entered into a stipulation to dismiss an earlier *inter partes* case.⁴ The Board concluded that this agreement reflected the belief of registrant that there was no likelihood of confusion between their respective marks. 225 USPQ at 284-85. Our reviewing court has repeatedly encouraged the Board to accord significant weight to an agreement between actual merchants in the marketplace as they are in the best position to know the real life situation. See Bongrain International (American)

⁴ This was an opposition proceeding involving registrant's JUVENANCE mark and applicant's  mark.

Corporation v. Delice de France Inc., 811 F.2d 1479, 1 USPQ2d 1775, 1778 (Fed. Cir. 1987). This too represents a critical du Pont factor in favor of registration that is clearly missing in the instant case. Finally, we should note that the Board in Produits de Beaute expressly disagreed with the position taken by applicant herein that purchasers of cosmetics are "sophisticated and careful." Accordingly, the Produits de Beaute case can be distinguished from the instant case, and we conclude that it does not support a reversal of the Trademark Examining Attorney herein.

In conclusion, given that the goods are identical and otherwise closely related, that the respective goods must be presumed to travel through the same channels of trade to the same classes of consumers, and that the marks create a similar overall commercial impression, we find a likelihood of confusion herein.

Decision: The refusal to register based upon Section 2(d) of the Trademark Act is hereby affirmed.