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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Prestige Cosmetics

Serial No. 76622251

Myron Amer of Myron Amer, P.C. for Prestige Cosmetics.

Dominic J. Ferraiuolo, Trademark Examining Attorney, Law Office 102 (Thomas V. Shaw, Managing Attorney).

Before Hairston, Zervas and Walsh, Administrative Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

Prestige Cosmetics (applicant) filed an intent-to-use application on November 26, 2004 to register SUNFLOWER BRONZER in standard-character form on the Principal Register for goods now identified as "facial skin bronze-coloring fluid" in International Class 3.

The Examining Attorney has refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a likelihood of confusion with the marks in the following registrations, all owned by FD Management, Inc.:

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Reg. No. 757881 for the mark SUNFLOWER in standard-character form for "nail polish and face powder" in International Class 3, issued October 1, 1963, twice renewed and active;

Reg. No. 1830983 for the mark SUNFLOWERS in standard-character form for "fragrances; namely, perfume and eau de toilette" in International Class 3, issued April 19, 1994, renewed and active;

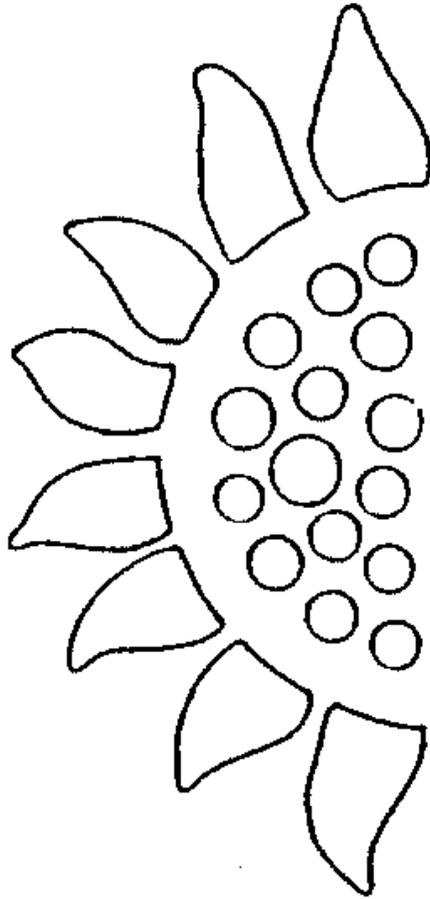
Reg. No. 1917541 for the mark SUNFLOWERS in standard-character form for "talcum powder, bath and shower gel, body lotion, body oil spray, toilet soap, hair shampoo and conditioner in one, and body splash" in International Class 3, issued September 12, 1995, renewed and active;

Reg. No. 12522949 for the mark SUNFLOWERS in standard-character form for "hair shampoo, hair conditioner, anti-perspirants and deodorants" in International Class 3, issued September 12, 1995, active;

Reg. No. 2646022 for the mark SUNFLOWERS in standard-character form for "lipstick and nail polish" in International Class 3, issued November 5, 2002, active; and

Reg. No. 1820936 for the mark shown below for "eau de toilette" in International Class 3, issued February 15, 1994, renewed and active.

Sunflowers



The Examining Attorney also required a disclaimer of "BRONZER" under Trademark Act Section 6, 15 U.S.C. § 1056, on the ground that "BRONZER" merely describes applicant's goods under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1).

Applicant argued against both the likelihood-of-confusion refusal and the disclaimer requirement and the Examining Attorney made both final. Applicant has appealed. Applicant and the Examining Attorney have filed briefs. We affirm as to both the likelihood-of-confusion refusal and the disclaimer requirement.

LIKELIHOOD OF CONFUSION

Section 2(d) of the Trademark Act precludes registration of an applicant's mark "which so resembles a mark registered in the Patent and Trademark Office... as to be likely, when used on or in connection with the goods of the applicant, to cause confusion..." Id. The opinion in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1977) sets forth the factors we may consider in determining likelihood of confusion. Here, as is often the case, the crucial factors are the similarity of the marks and the similarity of the goods of the applicant and registrant. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The

fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."). Below we will discuss all factors as to which Applicant or the Examining Attorney argued or presented evidence.

The Marks

In comparing the marks we must consider the appearance, sound, connotation and commercial impression of both marks. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

As to the marks, applicant argues "... as between the one-word mark vis-à-vis applicant's two-word mark there are sufficient differences in sound, meaning and appearance to obviate any likelihood of confusion. Applicant uses the source-identifying word BRONZER and the registrant does not." The Examining Attorney argues that applicant's SUNFLOWER mark and registrant's SUNFLOWER and SUNFLOWERS marks are similar and that BRONZER is not sufficient to distinguish the marks because it is merely descriptive.

We conclude that applicant's mark is highly similar to each of the marks in the cited registrations. The one-word versus two-word distinction applicant mentions is not

determinative of similarity. The inclusion of "BRONZER" in applicant's mark is not sufficient to distinguish the marks. While we must consider the marks in their entireties, and we have, it is entirely appropriate to accord greater importance to the more distinctive elements in the marks, here SUNFLOWER and SUNFLOWERS, than to the less distinctive elements in determining whether the marks are similar. As the Court of Appeals for the Federal Circuit observed, ". . . in articulating reasons for reaching a conclusion on the issue of confusion, 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 consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

As we discuss more fully below in addressing the disclaimer requirement, we conclude that "BRONZER" is descriptive, if not generic. As such, "BRONZER" is insufficient to distinguish applicant's mark from any of the registered marks. Even if we had found "BRONZER" to be distinctive, it would nonetheless be highly suggestive as

applied to applicant's "facial skin bronze-coloring fluid" and still insufficient to distinguish the marks.

Accordingly, we conclude that applicant's mark is highly similar to each of the cited registered marks in appearance, sound, connotation and commercial impression.

The Goods

Applicant's goods are identified as "facial skin bronze-coloring fluid." The cited registrations include the following goods: lipsticks, nail polish, face powder, perfume, eau de toilette, talcum powder, bath and shower gel, body lotion, body oil spray, toilet soap, hair shampoo and conditioner in one, body splash, hair shampoo, hair conditioner, anti-perspirants and deodorants.

Applicant argues that, "... it has not been established that the respective goods have been marketed in a way that they would be encountered in a situation that would create the incorrect assumption that they originate from the same source..." (Emphasis in the original.) Applicant states further, "Applicant's product prolongs the appearance of a sun tan obtained by sunning on a beach or sunning permitted during another outdoor activity, and is distinctly different from any product of the cited registrations."

The Examining Attorney argues that the goods of applicant and the goods in the cited registrations are

related. The Examining Attorney states, "Registrant's goods are all personal care products, including cosmetic products that purchasers and consumers are highly likely to purchase from a common source. The same is true for the Applicant's cosmetic product for giving the skin a 'bronzed' appearance." The Examining Attorney discusses his evidence and states further, "It appears highly likely that purchasers and consumers and intended purchasers and consumers of the goods in issue will encounter these goods at the same retail point-of-purchase from the same sources and that these goods are marketed, advertised and sold side-by-side by contemporary retail stores and online retail store services."

The goods need not be identical to find that the goods are related under Section 2(d) of the Trademark Act. The goods need only be related in such a way that the circumstances surrounding their marketing would result in relevant consumers mistakenly believing that the goods originate from the same source. On-Line Careline Inc. v. America Online Inc., 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000).

Furthermore, in comparing the goods and the channels of trade for the goods, we must consider the goods as identified in the application and registrations. CBS Inc.

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v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991).

Also, the proper inquiry is not whether the goods could be confused, but rather whether the source of the goods could be confused. Safety-Kleen Corp. v. Dresser Indus., Inc., 518 F.2d 1399, 186 USPQ 476, 480 (CCPA 1975); In re Rexel, Inc., 223 USPQ 830, 831 (TTAB 1984).

The Examining Attorney has provided evidence consisting of Internet web pages to show both that the goods are related, and that "bronzer" is merely descriptive for applicant's goods.

Web pages from the drugstore.com site show and discuss a product from Neutrogena® stating, "Instant Bronzer, sunless tanner and bronzer in one." The text also states, "The sheer bronzer provides a hint of temporary natural looking color..."The page displays moisturizing bath and shower gels along with the "tanning" products. The page also provides links to related products identified by category as: "personal care, hair care, beauty, skin care" and others.

Web pages from sephora.com also show and discuss a product under the CARGO mark identified as a "bronzer powder" which purports to "extend the life of your tan."

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This page also provides links to related products identified by category as: "makeup, skin care, fragrance, bath and body, hair" and others.

Web pages from sunless.com discuss the "Jan Tana Face and Body Bronzer." The text states further, "If you are looking for an everyday bronzer to use over large areas of the body..."

Web pages from lifetips.com discuss the "Deep Tanning Bronzer" stating, "Some bronzers instantly provide a deep, rich, robust tan..." The pages also discuss "Bronzer Tanning Lotions," "Pressed Powder Bronzer," "Sunless Tanner and Bronzer" and "Aerosol Bronzer" with frequent uses of "bronzer" in the text in a descriptive or generic sense.

This page also provides links to related products identified by category as: "Bath and Body, Beauty Products, Cosmetics, Lipstick, Skin Care" and others.

This evidence establishes that applicant's product is categorized among other personal care, beauty and cosmetic items, such as those identified in the cited registrations and further that applicant's goods are sold along with all of the types of products identified in the cited registrations. It is also obvious that applicant's product which is used on the skin, and which serves a cosmetic purpose, is functionally related to the goods in the cited

registration, such as, body lotions, lipsticks and nail polish, and others.

We also reject applicant's implication that visitors to web pages are not "shoppers." In fact, the pages in the record demonstrate that they are directed specifically to potential purchasers for the goods displayed and, in most instances, the goods are available for purchase through the web site.

Accordingly, we conclude that applicant's products and the products identified in the cited registrations are related and that they would be sold through the same or overlapping channels of trade to the same purchasers.

THE DISCLAIMER

Applicant has also declined to provide the disclaimer of "BRONZER" the Examining Attorney required resulting in an additional ground for refusal. The Examining Attorney argues that "BRONZER" is merely descriptive of "facial skin bronze-coloring fluid" under Trademark Act Section 2(e)(1). Applicant argues that "BRONZER" is "a coined version of the word BRONZE" and that the evidence is not sufficient to show that it is merely descriptive.¹

¹ Applicant argues that the Examining Attorney has not met the burden of showing that "BRONZER" is generic. Although BRONZER may be generic, we need not reach that question. A finding that BRONZER is merely descriptive is sufficient to support the disclaimer requirement.

A term is merely descriptive of goods or services within the meaning of Section 2(e)(1) if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute or function of the goods. See In re H.U.D.D.L.E., 216 USPQ 358, 359 (TTAB 1982); and In re MBAssociates, 180 USPQ 338, 339 (TTAB 1973).

Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services identified in the application, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of use or intended use. In re Polo International Inc., 51 USPQ2d 1061, 1062 (TTAB 1999); and In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979).

The evidence from various web pages discussed above is more than sufficient to demonstrate that BRONZER is merely

descriptive, if not generic for applicant's goods. It shows that potential purchasers of "facial skin bronze-coloring fluid" and similar products use and understand BRONZER descriptively, if not generically. In addition, the Examining Attorney had introduced a dictionary definition to show that BRONZER is merely descriptive. Applicant has challenged the definition apparently on the ground that the online version of the dictionary in question does not agree with the print version and on the ground that the definition relates to "bronze" and not "bronzer." Although the dictionary definition is by no means necessary for purposes of our decision here, we have consulted a print dictionary to settle the point. The print version of the Random House Webster's Unabridged Dictionary (second edition 2001) indeed includes a separate definition for the noun "bronzer" as follows: "a cosmetic ointment used to give the skin a tanned looked."²

In view of the totality of the evidence we find applicant's claim that BRONZER is a "coined" and "source-identifying" term anomalous. We conclude that "BRONZER" is

² We take judicial notice of this dictionary definition under University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

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merely descriptive of applicant's goods and further that the disclaimer requirement is proper.

Decision: The refusal under Trademark Act Section 2(d) is affirmed as to all six cited registrations; the refusal based on the requirement for a disclaimer under Trademark Act Section 6 is also affirmed.