

**THIS OPINION
IS NOT A PRECEDENT OF
THE TTAB**

Mailed: September 5, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Alagio Corp.

Serial No. 76635742

Myron Amer of Myron Amer, P.C. for Alagio Corp.

James A. Rauhen, Trademark Examining Attorney, Law Office 109
(Dan Vavonese, Managing Attorney).

Before Rogers, Zervas and Walsh, Administrative Trademark
Judges.

Opinion by Rogers, Administrative Trademark Judge:

Alagio Corp. (applicant) has filed an application to register the mark COLOR THERAPY on the Principal Register for "shampoo for natural blond, brunette and red hair," in International Class 3.¹

The examining attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), in view of the prior registration of the mark

¹Serial No. 76635742, filed April 11, 2005, based on use of the mark in commerce, alleging first use and use in commerce as of December 1, 2004.

ESSENTIAL COLOR THERAPY for both "hair treatment preparations, namely, shampoo for color-treated hair" and "hair conditioners" and the mark COLORCARETHERAPIE for "hair care preparations, namely, shampoo and conditioner, protective shine spray, hair treatment preparations," all in International Class 3.² It is the examining attorney's contention that applicant's mark so resembles these previously registered marks that its use on or in connection with applicant's identified goods is likely to cause confusion or mistake or to deceive.

Applicant has appealed. Both applicant and the examining attorney have filed briefs and applicant has filed a reply brief. We affirm the refusal to register.

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). See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); In re Majestic Distilling Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

² Registration Nos. 1965226 (issued April 2, 1996 and renewed), 2671345 (issued January 7, 2003), and 3071959 (issued March 21, 2006), all owned by L'Oreal USA Creative, Inc.

In considering the evidence of record on these factors, we keep in mind that "[t]he 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." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). See also In re Azteca Restaurant Enterprises, Inc., 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

We turn, first, to a determination of whether applicant's mark, COLOR THERAPY, and the mark in the first two cited registrations, ESSENTIAL COLOR THERAPY, when considered in their entirety, are similar in terms of appearance, sound, connotation and commercial impression. We will discuss the mark in the third cited registration separately.

The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered

in their entirety, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Both applicant's mark and the mark in the first two cited registrations include the term COLOR THERAPY. Applicant argues that confusion is unlikely because the term ESSENTIAL is the most dominant portion of the registered mark and thus distinguishes it from applicant's mark. The term ESSENTIAL is present in and a significant part of the cited mark since it is the first word, however, it is only one of three words and is somewhat laudatory in suggesting that the hair care products are "must have" items. Thus, we do not agree with applicant's contention that it is dominant.

Applicant also argues that the marks are not confusingly similar because the term ESSENTIAL in the registered marks has a "synergistic relation" with the term THERAPY while applicant's mark lacks this connotation. This argument fails to account for the presence of COLOR between the two words assertedly sharing the synergistic relation and is unpersuasive. Applicant's entire mark is subsumed within the registered marks because applicant has merely

removed the term ESSENTIAL from the registered marks and adopted the remainder. Thus, consumers seeing the marks could readily think that ESSENTIAL COLOR THERAPY shampoo and conditioner were particular formulations within the COLOR THERAPY line. We conclude that, although the presence of ESSENTIAL necessarily creates differences in appearance and pronunciation when spoken, the connotations of the marks are fundamentally the same and the overall commercial impressions are very similar.

We agree with the examining attorney that comparison of marks should be made from the point of view of the average consumer who normally will retain only a general rather than a specific impression of trademarks. When used on hair care products, we find all three marks convey the same impression that the consumer's hair color will benefit from the therapeutic qualities of the shampoos and conditioners. In this case, the shared connotation and commercial impression of the marks is more important than the differences in appearance or sound resulting from applicant's deletion of the word ESSENTIAL. In re Sarkli, Ltd., 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983) ("the PTO may reject an application ex parte solely because of similarity in meaning of the mark sought to be registered with a previously registered mark").

Turning next to consider the goods or services of the involved application and first two of the cited registrations, we note that the question of likelihood of confusion must be determined based on an analysis of the goods recited in applicant's application vis-à-vis the goods or services recited in the registrations, rather than based on what the evidence may show about the actual nature of the goods. Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). See also Octocom Systems, Inc. v. Houston Computer Services, Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and The Chicago Corp. v. North American Chicago Corp., 20 USPQ2d 1715 (TTAB 1991). Further, it is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services. See Time Warner Entertainment Co. v. Jones, 65 USPQ2d 1650, 1661 (TTAB 2002). See also,

In re Melville Corp., 18 USPQ2d 1386 (TTAB 1991), and cases cited therein.

The goods in applicant's application and the first two cited registrations are all hair care preparations in International Class 3. Applicant's goods are "shampoo for natural blonde, brunette and red hair" while the registrant's goods are "hair treatment preparations, namely, shampoo for color-treated hair" and "hair conditioners."

Regarding the nature of the shampoos and the supporting declaration from applicant's president, we note applicant's argument that confusion is unlikely because its goods are intended to be used on natural color hair while the registrant's goods are intended to be used on color-treated hair. There are a number of problems with this argument.

First, even if we were to agree that the two types of shampoo are different for likelihood of confusion purposes, applicant's specimens show potential use of its shampoo on color-treated hair and, as pointed out by the examining attorney, strongly suggest that any shampoo producer can produce either type of shampoo. We are skeptical of applicant's unsupported argument that different types of shampoos would be sold in different sections of a store or on different shelves. However, even if true, this may actually heighten likelihood of confusion because there will be no opportunity for consumers to readily compare the

shampoos. Finally, we note that dyed hair can be changed back or left un-dyed. That is, a consumer with dyed hair can just as easily choose to return to his or her natural color and so, notwithstanding the asserted differences between types of shampoo, chemical composition and store placement, different shampoos may still be used by or purchased at different times by the same consumers.

Regarding applicant's shampoo and the second cited registration for "hair conditioners," we note the term conditioner is unrestricted as to use or channels of trade and even applicant has not contested the examining attorney's contention that registrant's conditioners and applicant's shampoo must be considered complementary products.

Finally, when products are inexpensive and subject to impulse purchase, as they are here, purchasers exercise a lesser standard of purchasing care and thus are more likely to be confused as to the source of the goods. See Recot Inc. v. M.C. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000). See also, Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984).

We conclude that in view of the substantial similarity in the commercial impressions of applicant's mark, COLOR THERAPY, and the mark in the first two cited registrations,

ESSENTIAL COLOR THERAPY, their contemporaneous use on these closely related goods is likely to cause confusion as to the source or sponsorship of such goods.

Finally, we also agree with the examining attorney that a latecomer cannot typically adopt a mark that consists of a registered mark less one of its words, and hope to avoid a finding of likelihood of confusion. See In re Optical Int'l, 196 USPQ 775, 778 (TTAB 1977) (Applicant's mark "Optique" and registered mark "Optique Boutique" when used in connection with competing optical wear likely to cause confusion). See also Carl Karcher Enterprises Inc. v. Stars Restaurants Corp., 35 USPQ2d 1125, 1133 (TTAB 1995) ("a newcomer has both the opportunity and the obligation to avoid confusion").

We now turn to a comparison of applicant's mark, COLOR THERAPY, and the mark in the third cited registration, COLORCARETHERAPIE. We begin by noting that the registrant's hair shampoo and conditioner are unrestricted as to type and channels of trade and we must presume that the registration encompasses all types of hair shampoo and conditioner, that they move in all channels of trade normal for these goods, and that they are available to all classes of purchasers for the described goods. See In re Linkvest S.A., 24 USPQ2d 1716 (TTAB 1992). In short, we must consider registrant's shampoo to be identical to applicant's shampoo.

When goods are closely related or legally identical, the degree of similarity between the marks need not be as great to support a conclusion of likelihood of confusion. Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1992); and In re J.M. Originals Inc., 6 USPQ2d 1393, 1394 (TTAB 1987).

Nonetheless, when viewed in their entireties, applicant's mark and the third cited mark are similar in terms of appearance, sound, connotation and commercial impression.

Both marks begin with the term COLOR and end with the term THERAPY (or THERAPIE), and the examining attorney argues that there is little distinction between the terms THERAPIE and THERAPY. Applicant has not contended to the contrary. Although neither applicant nor the examining attorney addressed the issue, we take judicial notice of the fact that "therapie" is the French word for "therapy."³ It is well settled that an applicant may not register the foreign equivalent of a term if consumers would be likely to translate the foreign term into its English equivalent.

Palm Bay, *supra*, 73 USPQ2d 1696; In re Pan Tex Hotel Corp.,

³ Larousse English-French Dictionary (1998). The Board may take judicial notice of dictionary definitions. See 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).

190 USPQ 109, 110 (TTAB 1976). We agree with the examining attorney that consumers would view the terms THERAPY and THERAPIE as equivalents. In contrast to the Palm Bay case, wherein there was not sufficient evidence to support a conclusion that consumers would translate the French VEUVE to "widow," in the case at hand the two words THERAPY and THERAPIE are virtually the same in French and English and the translation would therefore be easily and readily made by most consumers.

In considering the connotation and commercial impression of the two marks, we note that in the registrant's mark, CARE and THERAPIE reinforce each other and the presence of CARE does not significantly alter the connotation of the mark, vis-à-vis applicant's mark. As with the first two cited marks, the applicant's mark and the third cited mark convey the same impression, namely, the therapeutic qualities of the involved shampoos and conditioners.

We conclude that in view of the presumptively identical nature of the goods and the substantial similarity in the commercial impressions of applicant's mark, COLOR THERAPY, and the third cited mark, COLORCARETHERAPIE, their contemporaneous use on the identified goods is likely to cause confusion as to the source or sponsorship of such goods.

Finally, we note applicant's claim of common law priority in regard to the third cited registration.⁴ This argument is not relevant to an ex parte proceeding. Dixie, *supra*, 41 USPQ2d at 1534. During ex parte prosecution, the trademark examining attorney has no authority to review or decide on matters that constitute a collateral attack on the cited registration.

Decision: The refusal under Section 2(d) of the Act is affirmed as to each of the cited registrations.

⁴ Applicant's claimed date of first use is well after that listed in the first two cited registrations but a few months prior to that asserted in the third registration.