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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Spa de Soleil, Inc.

Serial No. 76642151

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106 (Mary I. Sparrow, Managing Attorney).

Before Walsh, Cataldo and Wellington,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

An application was filed by Spa de Soleil, Inc. to register the mark shown below on the Principal Register for "non-medicated skin care products and facial and body treatments, namely, skin creams, facial creams, facial lotions, facial cleansers, facial masks, body creams, body lotions, body cleansers and body masks" in International Class 3; and "medicated skin care products and facial and body treatments, namely, skin creams, facial creams, facial lotions, facial cleansers, facial masks, body creams, body

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lotions, body cleansers, and body masks" in International Class 5.¹

PHARMASKINCARE
"The Future of SKIN"

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, as used on or in connection with its goods, so resembles the mark THE FUTURE OF SKIN CARE, previously registered on the Principal Register in typed or standard character form for "face and body wash; skin moisturizer; eye cream; glycolic acid, collagen, and vitamin c and other skin patches for cosmetic purposes and for use on blemishes" in International Class 3 and "preparations for the treatment of acne, namely, patches, cleansers, and gels; and vitamin c patch for treating wrinkles" in International Class 5,² as to be likely to cause confusion.

¹ Application Serial No. 76642151 was filed on July 1, 2005, based upon applicant's assertion of January 1, 1999 as the date of first use of the mark anywhere and in commerce for both classes of goods. In addition, applicant claimed ownership of Registration No. 2404716 for the mark PHARMASKINCARE for the same goods.

² Registration No. 2457739 issued on June 5, 2001.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs on the issue under appeal.

Likelihood of Confusion

Our determination of the issue of likelihood of confusion 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, 567 (CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (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, 27 (CCPA 1976). See also *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).

The Marks

In its briefing of the issue under appeal, applicant focuses its arguments exclusively on various aspects of the similarity or dissimilarity between its mark and the mark in the cited registration. We turn then to the first *du Pont* factor, i.e., whether applicant's mark and registrant's mark are similar or dissimilar when viewed in

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their entireties in terms of appearance, sound, connotation and overall commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). We note initially that the test under the first *du Pont* factor 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 impression 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). We further note that under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their imperfect recollections. See *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255, 259 (TTAB 1980).

In this case, applicant's mark, PHARMASKINCARE "THE FUTURE OF SKIN" in stylized form is similar to the registered mark THE FUTURE OF SKIN CARE in that both contain the identical wording THE FUTURE OF SKIN. Applicant's mark contains the additional wording

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PHARMASKINCARE while registrant's mark contains the additional word CARE. However, these elements are not entirely dissimilar. PHARMASKINCARE is comprised of the terms PHARMA, SKIN and CARE. As noted above, SKIN CARE is an element of registrant's mark. As a result, the term PHARMA in applicant's mark is the only term unique to either mark. That is to say, PHARMA is the only element of applicant's mark that is entirely dissimilar from the elements comprising registrant's mark, aside from the quotation marks which are insufficient to create a distinct commercial impression. The wording THE FUTURE OF SKIN in applicant's mark is identical in sound and nearly identical in appearance to that same phrase in registrant's mark. In addition, the wording SKINCARE as it forms part of PHARMASKINCARE is identical in sound and highly similar in appearance to those same terms in registrant's mark. As a result we find that, viewing the marks as a whole, the similarities between the marks in appearance and sound outweigh the dissimilarities. Further, both marks suggest that the goods identified thereby offer advancements with regard to the skin and its care. Thus, we find that the marks are highly similar in terms of overall connotation and convey highly similar commercial impressions.

Applicant contends that the examining attorney improperly dissected its mark in analyzing the similarities between it and the mark in the cited registration. However, and as noted above, we find that when the marks are viewed in their entirety the similarities in appearance, sound, connotation and commercial impression outweigh the differences. See *Palm Bay Imports, Inc. v. Veuve Clicquot, supra*. As such, applicant's arguments regarding the asserted dissection of its mark are unavailing.

Applicant further argues that "THE FUTURE OF SKIN" in its mark "is a fairly descriptive generic term" (brief, p. 3) and that, as a result, PHARMASKINCARE is the dominant portion of its mark. However, applicant presented no evidence that "THE FUTURE OF SKIN" is a descriptive or generic term as applied to its goods. Further, applicant did not offer to disclaim such wording as descriptive, nor did the examining attorney request such a disclaimer. Neither are we persuaded by applicant's assertion that because its prior Registration No. 2404716 for PHARMASKINCARE has attained incontestable status under Section 15 of the Trademark Act, PHARMASKINCARE is the dominant portion of its mark. The fact that applicant owns an incontestable registration for PHARMASKINCARE does not

render the wording "THE FUTURE OF SKIN" any less distinctive or otherwise diminish its significance in the mark under consideration herein. Moreover, there is no evidence of record that registrant's mark THE FUTURE OF SKIN CARE is a weak mark or otherwise is not entitled to a broad scope of protection.

Finally, applicant, with its response to the first Office action, submitted a list of third-party registrations for marks unrelated to its involved mark or the mark in the cited registration. Applicant argues that these registrations illustrate the absence of likelihood of confusion "when the prior marks incorporated were found to be suggestive, or alternatively, conveyed a different meaning as used alone" (brief, p. 7). To make third-party registrations of record, applicant must submit a copy of the registration or a printout from the USPTO's electronic database prior to the briefing stage of the case. *In re Duofold, Inc.*, 184 USPQ 638, 640 (TTAB 1974) ("[T]he submission of a list of registrations is insufficient to make them of record."). However, the examining attorney has not objected to this listing of registrations (including the marks) or advised applicant that the listing is insufficient to make the registrations of record at a point when applicant could have corrected the error. See

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TBMP §1208.02 (2d ed, 2004 and authorities cited therein). We therefore have considered the registrations, but only to the extent of the information provided.

In this case, applicant's listing of registrations has very limited probative value because none of the subject marks contain any elements in common with applicant's or registrant's mark, which thus creates a completely different commercial impression; and because there is no information regarding the goods and/or services identified thereby.

In this case, we find that consumers who are familiar with the mark, THE FUTURE OF SKIN CARE, used in connection with registrant's goods, and then see the mark PHARMASKINCARE "THE FUTURE OF SKIN" in stylized form used in connection with applicant's goods, are likely to assume that the owner of the mark THE FUTURE OF SKIN CARE has simply added PHARMASKINCARE when using the mark in connection with applicant's goods. In other words, consumers are likely to view the marks as variations of each other, but indicating a single source. Thus, despite the fact that applicant's mark includes the word PHARMASKINCARE, the marks, taken as a whole, are highly similar in appearance, sound, connotation and commercial

impression. Accordingly, this *du Pont* factor favors a finding of likelihood of confusion.

The Goods

Turning now to our consideration of the identified goods, we note that it is not necessary that the goods at issue be the same as, or even similar or competitive, or even that they move in the same channels of trade, to support a holding of likelihood of confusion. It is sufficient instead that the respective goods are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. *See In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

In this case, applicant's various medicated and non-medicated "skin care products and facial and body treatments" - including creams, lotions, cleansers and masks - are related on their face at least to registrant's "face and body wash," "skin moisturizer" and "eye cream" in that these goods are used for the cleaning, treatment and protection of the skin. In short, all of these products, as identified, are used for general skin care. We note

that there is no limiting language in either applicant's or registrant's identification of goods to indicate that the goods recited therein are restricted for use by a particular gender, age group, or type of skin. As such, both applicant's goods as well as those of registrant are presumed to be appropriate for general use by any potential consumer.

Finally, we note that applicant does not argue in its brief that the goods are dissimilar. Accordingly, this *Pont* factor also favors a finding of likelihood of confusion.

Channels of Trade

Neither applicant's goods nor those of registrant contain any restrictions as to the channels of trade in which they are distributed or the class of purchasers to whom they are marketed. It is settled that in making our determination regarding the relatedness of the parties' goods, we must look to the goods as identified in the involved application and cited registration. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application

regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.") See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.") Thus, registrant's goods are presumed to move in all normal channels of trade and be available to all classes of potential consumers, including consumers of applicant's goods. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). Accordingly, this *du Pont* factor further favors a finding of likelihood of confusion.

Summary

In light of the foregoing, we conclude that consumers familiar with registrant's goods sold under its above-referenced mark would be likely to believe, upon encountering applicant's goods rendered under its mark that the goods originated with or are associated with or sponsored by the same entity.

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior

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registrant. See *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 165, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal of registration is affirmed.