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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Prestige Cosmetics

Serial No. 76684117

Myron Amer, Esq. for Prestige Cosmetics.

Melissa C. Vallillo, Trademark Examining Attorney, Law Office 114 (Odette Bonnet, Managing Attorney).

Before Walters, Grendel and Bergsman, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Prestige Cosmetics has filed an application to register the standard character mark SKIN LOVING MINERALS on the Principal Register for "color cosmetics for the eyes, not including gels and powders," in International Class 3.[1] The application includes a disclaimer of MINERALS apart from the mark as a whole.

[1] Serial No. 76684117, filed November 16, 2007, based on use of the mark in commerce, alleging first use and use in commerce as of September 1, 2007.

The examining attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the standard character mark SKIN LOVING COLORS[2] previously registered in connection with the goods identified below that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.

> **Registration No. 2743695** [Registered July 29, 2003]
> **Disclaimer:** SKIN and COLORS
> **Goods:** "Perfume, toilet water; gels for the bath and the shower not for medical purposes, salts for the bath and the shower not for medical purposes; toilet soaps, body deodorants; cosmetics, namely creams, milks, lotions, gels and powders for the face, the body and the hands; self-tanning milk, pre-sunning milk, after sun moisturizer, anti-wrinkle creams, total sunscreen, high protection sun tanning preparations, and moisturizing tanning milk; make-up preparations; essential oils for personal use," in International Class 3.

> **Registration No. 2839808** [Registered May 11, 2004]
> **Disclaimer:** COLORS
> **Goods:** "cosmetics, namely, pressed powders, liquid foundation, lipsticks, lip gloss, eye shadow, and blush," in International Class 3.

Applicant has appealed. Both applicant and the examining attorney have filed briefs. 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

[2] Both registrations are owned by Biotherm.

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).

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); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

Considering, first, the goods involved in this case, we note that the question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than what the evidence shows the goods or services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (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. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein; and *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002).

The examining attorney contends that applicant's identified goods are encompassed within the broadly worded identification of goods in Registration No. 2743695, arguing that "make-up preparations" includes color cosmetics for the eyes. In support of this contention, the examining attorney submitted a definition from *The American Heritage Dictionary of the English Language* of "makeup" as "cosmetics applied especially to the face." Additionally, the examining attorney submitted excerpts from Internet websites of Clinique, Sephora, Estee Lauder and Prescriptives to

demonstrate that "makeup" retailers and manufacturers include eye cosmetics among their "makeup" products. The examining attorney contends, further, that the cited Registration No. 2839780 includes "eye shadow," which is a type of "eye cosmetic" and, thus, these goods are overlapping. The examining attorney contends that applicant's identified goods are similar to the remaining goods in the cited registrations because they are all types of makeup or cosmetic products, stating that the evidence noted above shows the same entities selling various cosmetic products under the same mark.

Applicant argues, without further explanation, that its goods and the goods in the cited registrations "are distinctly different and travel through different channels of trade to the ultimate consumer" (brief, p. 2). Applicant states that registrant was required to apply for the cited '780 registration because the '695 registration did not cover the same goods, implying, perhaps, that these differences are relevant to determining what if any relationship exists between applicant's identified goods and those identified in the registrations. In its reply brief, applicant appears to argue that the respective goods are different because applicant has excluded color eye cosmetics made of gels or powders.

The evidence establishes that "makeup" is synonymous with, or a subset of, "cosmetics"; and that several cosmetics companies offer for sale and market all types of cosmetics under the same marks. As the examining attorney correctly notes (unnumbered p. 8) and as the evidence shows:

> [U]nder "Makeup," Sephora includes a number of eye cosmetics such as mascara, eye shadow and eye liner. Similarly, Clinique features makeup such as cream eye shadow, base for the eyes and eye shimmer tint. As yet another example, Estee Lauder lists eye cosmetics such as eye liners and eye shadow among its makeup products. Lastly, Prescriptives lists mascara, eye color and eye liner among its makeup products.

Cited Registration No. 2743695 includes "makeup preparations," which clearly encompasses applicant's "color cosmetics for the eyes"; and Registration No. 2839808 includes "cosmetics, namely, … eye shadow …," which is clearly identical to "color cosmetics for the eyes." To this extent, applicant's goods are identical to those of the cited registrations. In view of the evidence of record, applicant's goods are also closely related to the other cosmetics and items identified in the cited registrations. As the examining attorney correctly notes in her brief (unnumbered p. 9) and the evidence shows:

> Sephora provides lip gloss, foundation, eye shadow and mascara. Clinique also provides lip gloss, foundation and blushers. Estee Lauder provides blush, lipsticks, lip gloss and foundation. Lastly, Prescriptives provides foundation, lipsticks and lip gloss.

While some of the goods identified in the registrations are "pressed powders" and "gels and powders for the face," applicant's exclusion of gel and powder eye cosmetics from its identification of goods is not sufficient to distinguish the goods. The evidence establishes that these goods, whether gels, powders or liquids, are sold under the same marks and, thus, are closely related, if not identical in part.

Further, inasmuch as the identifications of goods in both the involved application and the cited registrations are not limited to any specific channels of trade, we presume an overlap and that the goods would be offered in all ordinary trade channels for these goods and to all normal classes of purchasers. *See In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992). In other words, the trade channels and purchasers are likely to be the same. Additionally, both applicant's and registrant's goods may be purchased by members of the general public.

Considering, next, the marks, we note that in determining likelihood of confusion, a lesser degree of similarity between two marks is required when the marks are applied to identical goods or services. *HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd* 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990). See also *In re J.M. Originals*, 6 USPQ 1393 (1987). The question

is whether applicant's mark and the registered mark, when viewed in their entireties, are similar in terms of appearance, sound, connotation and commercial impression. 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 entireties, 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).

The examining attorney contends that because both applicant's and registrant's marks contain the dominant phrase "Skin Loving" followed by merely descriptive and disclaimed wording, the marks convey similar commercial impressions. Applicant contends only that the words "Minerals" and "Colors" adequately distinguish the marks,

noting that the disclaimer of each of these terms in the respective marks does not change the appearance of each mark.

Applicant is correct that the disclaimers do not change the appearances of the respective marks and, obviously, the marks do differ visually and aurally to the extent that applicant's mark ends with the word "Minerals" and the registered mark ends with the word "Colors." However, while we must consider the marks in their entireties, we agree with the examining attorney that the first and identical phrase in each mark, "Skin Loving," is the dominant portion of each mark. Both "Minerals" and "Colors" are merely descriptive in connection with the identified goods in the application and registrations and they are the last words in the respective marks. As such, they are of less significance in determining the overall commercial impressions of the marks. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1845-45 (Fed. Cir. 2000). Because the first and dominant part of applicant's mark, SKIN LOVING MINERALS, is identical to the first and dominant part of the mark in the cited registrations, SKIN LOVING COLORS, consumers may believe that applicant's products are simply a variation of the registrant's product line. Accordingly, when we consider each mark as a whole, we consider them to be more similar than dissimilar.

When we consider the record and the relevant likelihood of confusion factors, and all of applicant's arguments relating thereto, including those arguments not specifically addressed herein, we conclude that in view of the similarity in the commercial impressions of applicant’s mark, SKIN LOVING MINERALS, and registrant’s mark, SKIN LOVING COLORS, their contemporaneous use on the overlapping and closely related goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

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