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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Avon Products, Inc.

Serial No. 78/056,703

Michelle M. Graham of Kelley Drye & Warren LLP for Avon Products, Inc.

Rebecca A. Smith, Trademark Examining Attorney, Law Office 110 (Chris A.F. Pedersen, Managing Attorney).

Before Hanak, Chapman, and Bucher, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Avon Products, Inc. (a New York corporation) filed on April 4, 2001 an application to register on the Principal Register the mark POWER POWDER for "talcum powder" in International Class 3, based on applicant's assertion of a bona fide intention to use the mark in commerce. Upon requirement of the Examining Attorney, applicant disclaimed the word "powder."

The Examining Attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its identified goods, so resembles the registered mark POWER for "men's cologne and aftershave, soaps and toiletries, namely, deodorant and talcum powder, all for personal use" in International Class 3,¹ as to be likely to cause confusion, mistake or deception.

When the refusal was made final, applicant appealed. Briefs have been filed. Applicant did not request an oral hearing.

We affirm the refusal to register. In reaching this conclusion, we have followed the guidance of the Court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (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 (CCPA 1976). See also, *In re Dixie*

¹ Registration No. 1,442,631, issued on the Principal Register June 16, 1987, Section 8 affidavit accepted, Section 15 affidavit acknowledged.

Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Turning to a consideration of the respective goods, it has repeatedly been held that, when evaluating the issue of likelihood of confusion in Board proceedings regarding the registrability of marks, the Board is constrained to compare the goods as identified in the application with the goods as identified in the registration. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

In this case, applicant's goods are identified as "talcum powder," and registrant's goods are identified as "men's cologne and aftershave, soaps and toiletries - namely, deodorant and talcum powder, all for personal use." We will focus on the single item "talcum powder" in registrant's identification. While registrant's goods are limited to "men's" toiletry products, applicant's goods are not so limited. Thus, applicant's goods broadly encompass all "talcum powder," including that specifically for men. These goods, as identified, are legally identical.

Applicant argues that its goods were "expressly formulated to be used by women prior to exercising," and

"may only be purchased through an AVON-branded 'store within a store' located in selected J.C. Penney stores." (Brief, pp. 5 and 6.) These arguments are irrelevant because applicant included no restriction to trade channels or purchasers in its identification of goods. Thus, the Board must consider that the parties' respective goods could be offered and sold to the same classes of purchasers through all normal channels of trade. See Canadian Imperial Bank v. Wells Fargo Bank, supra; In re Smith and Mehaffey, 31 USPQ2d 1531 (TTAB 1994); and In re Elbaum, 211 USPQ 639 (TTAB 1981). Moreover, we note that these are inexpensive products, which may be purchased on impulse.

Turning next to a consideration of the respective marks, the cited registrant's mark consists of the word POWER, and applicant's mark is POWER POWDER, both in typed form. It is generally accepted that when a mark incorporates the arbitrary mark of another for closely related goods or services, the addition of suggestive or descriptive words or other matter is insufficient to avoid a likelihood of confusion as to source. See The Wella Corp. v. California Concept Corp., 558 F.2d 1019, 194 USPQ 419 (CCPA 1977); and Coca-Cola Bottling Company of Memphis, Tennessee, Inc. v. Joseph E. Seagram & Sons, Inc., 526 F.2d 556, 188 USPQ 105 (CCPA 1975). Applicant's addition of the

generic term "powder" does not serve to distinguish applicant's mark from that of the cited registrant.

Applicant argues that "even when marks are identical in sound and/or appearance, they may nonetheless create different commercial impressions when applied to the respective parties' goods" (brief, p. 3). While we agree with that broad, general statement, we do not agree that POWER and POWER POWDER create different commercial impressions, when used on the identified goods, "talcum powder" and "men's ... talcum powder." The cases cited by applicant in support of this argument are readily distinguishable from the facts now before the Board. The cited cases involve different respective goods and discussion of the connotation of the marks in relation thereto (e.g., CROSS-OVER for "bras" and CROSSOVER for "ladies sportswear, namely tops, shorts and pants" in *In re Sears, Roebuck and Co.*, 2 USPQ2d 1312 (TTAB 1987); PLAYERS (in stylized lettering) for "men's underwear" and PLAYERS for "shoes" in *In re British Bulldog, Ltd.*, 224 USPQ 855 (TTAB 1984); COPPER CLAD and design (COPPER CLAD disclaimed) for "composite metal wire material having an aluminum core clad with copper for use in electrical conductors" and COPPERCLAD (on the Supplemental Register) for "copper coated carbon electrodes for use in electric

arc cutting and gouging" in *In re Texas Instruments Incorporated*, 193 USPQ 678 (TTAB 1976).) Moreover, the overall facts of the cited cases are different from the situation presented in this application (e.g., a written consent agreement between applicant and the cited registrant, and one affidavit each from applicant and the cited registrant - *Sears, Roebuck case*, supra; a finding of distinctly different goods and a discussion of how the mark in the cited Supplemental Register registration may be capable of identifying registrant's goods but incapable of identifying applicant's goods - *Texas Instruments case*, supra).

Applicant contends that the packaging for the involved goods bears applicant's house mark "AVON." This is irrelevant because the mark applied for does not include the word AVON, and the USPTO must consider the issue of the registrability of the mark as applied for. Moreover, applicant could alter what is depicted on its packaging at any time. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, footnote 4 (Fed. Cir. 1993); and *Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910, 1914 (TTAB 2000).

We find the marks POWER and POWER POWDER are similar in sound, appearance, connotation and commercial impression.

Applicant strongly urges reversal on the basis the registered mark POWER is a weak mark entitled to a narrow scope of protection because there are numerous third-party registrations in the relevant class of goods. Specifically, applicant argues that "the term 'POWER' is highly dilute [sic] when used as part of a trademark in International Class 3," and "the term POWER by itself, in this crowded field, simply is not sufficiently strong to be infringed or confused with marks that include POWER and any other word." (Emphasis in original) (Brief, pp. 2 and 3.)

In applicant's e-mail response to the first Office action and again in its brief applicant provided a typed list of eight registrations² including the registration number, the mark (some with disclaimers), and the goods;

² The Examining Attorney did not object to the improper format of these registrations (i.e., typed listing rather than photocopies of the registrations) [see *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); *Cities Service Company v. WMF of America, Inc.*, 199 USPQ 493 (TTAB 1978); and *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974)]. Moreover, the Examining Attorney responded to this argument on the merits. Therefore, the Board considers applicant's entire third-party registration list stipulated into the record. (We note the Examining Attorney stated in her brief (p. 4) that applicant "provided copies of [third-party] registrations." However, there are no such copies in the application file before us.)

and an additional nine listings of marks only and a statement that they are all "in the same product field."

With regard to the weight given to third-party registrations, these registrations are not evidence of use in the marketplace or that the public is familiar with them. Thus, we cannot assume that the public will come to distinguish between them. As the Court of Appeals for the Federal Circuit stated in the case of *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992):

Under *Du Pont*, "[t]he number and nature of similar marks in use on similar goods" is a factor that must be considered in determining likelihood of confusion. 476 F.2d at 1361, 177 USPQ at 567 (factor 6). Much of the undisputed record evidence relates to third party registrations, which admittedly are given little weight but which nevertheless are relevant when evaluating likelihood of confusion. As to strength of a mark, however, registration evidence may not be given any weight. *AMF Inc. v. American Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (CCPA 1973)("The existence of [third party] registrations is not evidence of what happens in the market place or that customers are familiar with them. ...") (Italics emphasis in original.)

None of the third-party registrations is of the word POWER alone, but rather the marks include POWER in

combination with other words (e.g., POWER LIFT, POWER PLAY, GLO POWER, POWER TRIP, FLOWER POWER, STAYING POWER) all of which create separate and distinct commercial impressions. Moreover, the nine third-party registrations listed only by mark obviously do not include any information regarding the specific goods or services involved.

The existence of a few registrations which include the word POWER for various cosmetic products, and no evidence of third-party use, does not establish that the cited registrant's mark is weak and entitled to a narrow scope of protection. Even if applicant had established that fact, weak marks are still entitled to protection against registration by a subsequent user of the same or similar mark for the same or related goods. See *Hollister Incorporated v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976).

Neither the Board nor any Court is bound by prior decisions of Trademark Examining Attorneys, and each case must be decided on its own merits, on the basis of the record therein. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). See also, *In re Kent-Gamebore Corp.*, 59 USPQ2d 1373 (TTAB 2001); and *In re Wilson*, 57 USPQ2d 1863 (TTAB 2001).

Additionally, applicant argues that the Examining Attorney ignored the fact that applicant owned Registration No. 967,792, issued September 4, 1973 for the mark AVON POWDER POWER (POWDER disclaimed) for "dusting powder" and "powdered hand cleanser," expired Section 9 in 1994; Registration No. 985,625, issued June 4, 1974 for the mark AVON MOISTURE POWER (MOISTURE disclaimed) for "moisturized skin cream and moisturized hand cream" and "toilet soap," expired Section 9 in 1995; and Registration No. 1,021,861, issued October 7, 1975 for the mark SPRAY POWER (SPRAY disclaimed) for "aerosol personal deodorant," cancelled Section 8 in 1982;³ and that the cited registration issued while the first two of these prior registrations owned by applicant were in existence. In essence, applicant is asserting that its registrations add to the number of "third-party" registrations which make the mark in the cited registration weak. That concept is not persuasive for the reasons explained above regarding third-party registrations.

Applicant also asserts, in essence, that the USPTO already determined that there was no likelihood of

³ Applicant did not make copies of its three expired and/or cancelled registrations of record, but the Examining Attorney treated the argument on the merits. Thus, these three registrations have also been stipulated into the record.

confusion by registering the cited mark in 1987 over applicant's then-valid 1973 and 1974 registrations (Nos. 967,792 and 985,625) for the marks AVON POWDER POWER and AVON MOISTURE POWER for the respective involved goods. However, the issue now before us is whether applicant's mark POWER POWDER for "talcum powder" is likely to cause confusion with the cited mark POWER for certain men's toiletries, including "talcum powder," not whether the Examining Attorney who examined the application which issued as the cited registration acted appropriately, or whether the Examining Attorney did or did not have any doubt on the issue of likelihood of confusion.

In any event, as explained previously, each case must be decided on its own merits, on the basis of the record therein. See *In re Wilson*, supra. See also, *In re Nett Designs Inc.*, supra. We can only speculate as to why the cited registration issued over applicant's two now-expired registrations. (Some of that speculation would include facts such as the inclusion of the house mark AVON in two of applicant's previously registered marks.)

Applicant contends that there have been no instances of actual confusion involving (i) applicant's previously registered marks and registrant's mark, and/or (ii) applicant's applied-for mark and registrant's mark. It

states that "applicant's current product under the subject mark has been in use for some time, and it is no surprise that no incidents of confusion with the reference mark have arisen." (Brief, p. 3.) However, there is no evidence of the parties' respective sales of the involved goods sold under the marks POWER and POWER POWDER, and there is no information from registrant on the issue of actual confusion. In any event, the test is likelihood of confusion, not actual confusion. See *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990); and *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209 (TTAB 1999).

Finally, applicant asserts that the registrant (a Florida corporation) was "administratively dissolved by the Florida Secretary of State" in 2000⁴; that "upon information and belief, no active use in commerce of the mark POWER has been made by any entity in the last two-three years"; and that "Registrant has presumptively abandoned its registration for the mark POWER." (Brief, p. 1.) This argument that registrant has abandoned use of its involved registered mark is inappropriate or irrelevant in an ex

⁴ Applicant's evidence thereof was submitted for the first time with applicant's brief. Therefore, aside from being irrelevant in an ex parte context, it is untimely under Trademark Rule 2.142(d). The Board did not consider this evidence.

parte proceeding. That is, an applicant cannot attack the validity of a registration cited against it. See *In re Dixie Restaurants*, supra. If an applicant believes a cited registered mark has been abandoned, its remedy is to file a petition to cancel the cited registration pursuant to Section 14 of the Trademark Act.

Based on the virtually identical marks, the virtually identical goods, which are inexpensive consumer goods, and the identical trade channels and purchasers, we find that there is a likelihood that the purchasing public would be confused as to the source of the goods when applicant uses POWER POWDER as a mark for talcum powder.

Although we have no doubt in this case, any doubt on the question of likelihood of confusion must be resolved against the newcomer as the newcomer has the opportunity of avoiding confusion, and is obligated to do so. See *TBC Corp. v. Holsa Inc.*, 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997); and *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

Decision: The refusal to register under Section 2(d) is affirmed.