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Mailed: September 10, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re *Skin Within Services, Ltd.*

Serial No. 78122490

Diana Palchik of Clouse Dunn Hirsch LLP for Skin Within Services, Ltd.

Amy E. Hella, Trademark Examining Attorney, Law Office 110 (Chris A.F. Pedersen, Managing Attorney).

Before Seeherman, Walters and Rogers, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Skin Within Services, Ltd. has appealed from the final refusal of the Trademark Examining Attorney to register SKIN WITHIN as a trademark for "cosmetics, namely, skin care lotions and creams and non-medicated skin care preparations."¹ Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on

¹ Application Serial No. 78122490, filed April 18, 2002, and asserting a bona fide intention to use the mark in commerce.

the ground that applicant's mark so resembles the mark WITHIN, previously registered for "cosmetics, namely, perfume, eau de perfume, cologne, skin, hand and body lotions and cremes, face powder and dusting powder, and toilet preparations, namely, toilet water, bath oils, non-medicated bath salts, bath crystals, talcum powder, shampoos, perfumed soaps, and bath and shower gels"² that, if used on applicant's identified goods, it is likely to cause confusion or mistake or to deceive.

The appeal has been fully briefed. Applicant did not request an oral hearing.

Before turning to the substantive issue in this appeal, we must address a procedural matter. With its reply brief applicant filed a request for remand in order to amend its identification of goods. The request for remand was actually put into applicant's reply brief, at p. 4, although the amendment was submitted in a separate paper which was faxed to the USPTO on the same date the reply brief was received. Applicant is advised that a request for remand should always appear in a separate paper, since briefs are generally not thoroughly reviewed until final hearing, and a request for remand that is "buried" in a brief is not likely to be noted.

² Registration No. 2476328, issued August 7, 2001.

With respect to the merits of the request for remand, such a request must be supported by a showing of good cause. See TBMP §1209.94 (2d ed. rev. 2004). "In determining whether good cause has been shown, the Board will consider both the reason given and the point in the appeal at which the request for remand is made." Id. Applicant asserts, as good cause for the remand request, that the Examining Attorney stated in her brief that "applicant is not limited by the Office to using the goods listed in the Identification of Goods and Services Manual." As a result, applicant seeks remand in order to amend its identification to "cosmeceuticals, namely skin care lotions and creams for anti-aging purposes," even though "cosmeceuticals" is not listed in the Manual.

The Examining Attorney made the statement in her brief in response to an argument made by applicant in both its request for reconsideration and its appeal brief regarding the differences between its goods and those in the cited registration, and specifically that applicant's goods are "cosmeceuticals," but that because such goods "are a relatively recent invention and not yet a category in the Trademark Office's Acceptable Identification of Goods and Services Manual, Applicant was required to choose a category description that the Trademark Office has deemed

acceptable." Brief, p. 6. Applicant has not provided any explanation as to why it waited to amend its actual goods from "skin care lotions and creams and non-medicated skin care preparations" to "skin care lotions and creams for anti-aging purposes"; we note that "anti-aging cream" is listed as an acceptable identification in the USPTO manual.

As noted above, the point in the appeal at which the request for remand is filed plays a significant role in determining whether good cause has been shown. Here, applicant has filed its request for remand at an extremely late stage of the appeal, with its reply brief. Thus, if the request were to be granted, the appeal would essentially return to its beginning stages in order that applicant and the Examining Attorney could file supplemental appeal briefs, and applicant could file a supplemental reply brief. The only reason applicant has given for its delay is that it was unaware of USPTO policy that the applicant is not limited to using the identifications of goods listed in the Identification of Goods and Services Manual, even though this policy is set out in the Trademark Manual of Examining Procedure.

We find that applicant has not demonstrated the requisite good cause, and its request for remand is therefore denied.³

This brings us to the refusal based on likelihood of confusion. Our determination of this issue 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 (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 Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Applicant's goods are, in part, identical to those in the cited registration, as applicant's goods are identified, in part, as "skin care lotions and creams" and

³ It should also be noted that cosmeceuticals would still be considered cosmetics products falling in Class 3. Pharmaceutical products, which are classified in Class 5, are subject to a review and approval process by the U.S. Food and Drug Administration which is not required for cosmetics products. Further, applicant would not be allowed to amend its identification to that of a pharmaceutical in Class 5, as this would broaden the original identification. See Trademark Rule 2.71(a).

the cited registration includes "skin, hand and body lotions and cremes." Because the goods are legally identical, they must be deemed to travel in the same channels of trade and be sold to the same classes of consumers. They must also be deemed to be sold at the same price points, and we must disregard applicant's arguments regarding actual differences in the channels of trade and prices for the goods.

Contrary to applicant's arguments that "evidence that the respective goods move in different trade channels and are sold to different customers is also key," brief, p. 5, it is well-established that "the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-a-vis the goods and/or services recited in an opposer's registration [or, in the case of an ex parte appeal, the cited registration], rather than what the evidence shows the goods and/or services to be."

Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A., 811 F.2d 1490, 1 USPQ2d 1318, 1814 (Fed. Cir. 1987; In re William Hodges & Co., Inc. 190 USPQ 47 (TTAB 1976). This is because "although a registrant's current business practices [in connection with which the mark is used] may be quite narrow, they may change at any time." Canadian

Imperial Bank of Commerce, quoting *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983).

Thus, the goods must be presumed to be sold through all channels of trade which are usual for goods of this type. In *re Davis-Cleaver Produce Company*, 197 USPQ 248 (TTAB 1977). Applicant's assertions that its goods are sold only to physicians and aestheticians is of no moment; goods of this type may also be sold in pharmacies, department stores and on-line. The registrant's goods, as identified, may also be sold through aestheticians, pharmacies, etc.

Accordingly, if confusion is not to be found, it must be on the basis of the differences in the marks.⁴ Obviously applicant's mark consists of the cited mark, WITHIN, to which the word SKIN has been added. Equally obvious, SKIN is a descriptive term for skin care lotions and creams and skin care preparations. As the Examining Attorney has pointed out, generally the addition of a descriptive term to another's mark will not avoid the likelihood of confusion. Moreover, when a mark consists of a descriptive term and a distinctive term, the distinctive term will be

⁴ We have no evidence on many of the other duPont factors, e.g., fame of the registrant's mark, and actual confusion or the lack thereof.

considered the dominant part of the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Despite these general propositions, however, in this case we think that the marks SKIN WITHIN and WITHIN convey different commercial impressions, such that confusion is not likely. SKIN WITHIN, as applicant contends, has a certain incongruity, since "skin" is normally considered to be on the "outside." Moreover, SKIN WITHIN, used in connection with skin care products, suggests that the product reaches the interior layers of skin. This is a connotation that WITHIN per se does not have.

We also point out that in applicant's mark the word SKIN precedes WITHIN. The usual expectation is that the descriptive term SKIN for skin cream products would follow the source-indicating and dominant word, e.g. "WITHIN Skin" or "WITHIN SKIN." The placement of SKIN before the word WITHIN in the instant mark gives the impression that SKIN WITHIN is a unitary term, referring to the interior layers of skin rather than conveying that SKIN merely describes the product as a skin cream.

Finally, the fact that SKIN WITHIN rhymes internally also adds a certain phonetic distinction that WITHIN does not have. This rhyming effect also emphasizes the presence

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of the word SKIN, and adds to the unitary impression of the mark.

Because of the differences in the marks, and specifically their different connotations and commercial impressions, we find that, even as used on legally identical goods, confusion is not likely to result.

Decision: The refusal of registration is reversed.