

**THIS OPINION IS NOT A
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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Cosmetic Essence, Inc.

Serial No. 78285127

Sharon A. Blinkoff of Buchanan Ingersoll, P.C. for Cosmetic
Essence, Inc.

Marlene D. Bell, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Hohein, Bucher and Drost, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Cosmetic Essence, Inc. seeks registration on the
Principal Register of the mark **SIMPLYME SPA** (*in standard
character format*) for goods identified in the application, as
amended, as follows:

“personal care products, namely, body wash,
bath and shower gels, hand and body soaps,
bath oils, body lotions and creams, body
scrubs, skin salt scrub and bath crystals,
non medicated tablets and non medicated
salts, fragrant body splash, body sprays and
body mists and room fragrancing gels and room
fragrances, and hair care preparations,
namely shampoos and conditioners” in
International Class 3.¹

¹ Application Serial No. 78285127 was filed on August 8, 2003,
based upon applicant’s allegation of a *bona fide* intention to use
the mark in commerce.

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register applicant's mark based upon Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). The Trademark Examining Attorney asserts that applicant's mark, when used in connection with the identified goods, so resembles the trademark **SIMPLY SPA** (*in standard character format*) in two registrations owned by the same party, registered in connection with:

"personal care products for the face, hands, body, feet, nails, and hair, namely, lip gloss, lip balm, lip gel, body and bath oils, skin lotions, body lotions, hand lotions, hand creams, shea butter, shower gels, milk bath, bubble bath, soaps, body wash, non-medicated bath salts, bath powder, bath fizzies, potpourri, hair shampoos, nail care preparations and polish, body scrubs, seaweed scrub, hair conditioner, body powder, clay mask, facial masks, cosmetic glitter gel, cosmetic glitter spray, and room fragrances in spray form" in International Class 3;²

and

"candles" in International Class 4,³

as to be likely to cause confusion, to cause mistake or to deceive.

² Registration No. 2804445 issued on January 13, 2004, claiming first use anywhere and first use in commerce at least as early as June 1, 2001.

³ Registration No. 2804446 issued on January 13, 2004, claiming first use anywhere and first use in commerce at least as early as June 1, 2001.

Applicant and the Trademark Examining Attorney have fully briefed the case. Applicant requested an oral hearing that was scheduled for December 5, 2006, but then applicant asked that the hearing be cancelled.

We affirm the refusal to register.

In arguing for registrability, applicant contends that there are on the federal trademark register numerous registrations for personal care products similar to the involved goods where the marks include the words "Spa" and/or "Simply." Applicant argues that inasmuch as the cited mark is weak, the word "Me" is sufficient to distinguish applicant's mark from registrant's mark. Applicant continues by arguing that consumers will exercise great care in selecting personal care and beauty items. Finally, applicant contends that the Trademark Examining Attorney has failed to provide sufficient evidence that "an appreciable number of ordinary prudent purchasers" are likely to be confused with the cited mark through its use of **SIMPLYME SPA** in connection with personal care products.

By contrast, the Trademark Examining Attorney contends that the marks of applicant and of registrant are confusingly similar, and that the goods are identical or closely related, such that there exists a likelihood of confusion. In fact, the Trademark Examining Attorney argues

that the only three marks registered for personal care products, room fragrances and candles that share *both* the words "Simply" and "Spa" are those involved in this appeal. She argues that these identically and otherwise closely related goods will travel in the same channels of trade and will be encountered by the same general consumers who are likely to mistakenly believe that the goods emanate from the same producer. As to the degree of care exercised by the buyers, she contends that these are inexpensive consumer products that are all routinely subject to impulse purchasing decisions.

Likelihood of Confusion

We turn, then, to the issue of likelihood of confusion. Our determination of likelihood of confusion is based upon our analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. See In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also In re Majestic Distilling Co., Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key, although not exclusive, 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).

The goods and services

We turn first to the du Pont factor focused on the relationship of the goods as identified in the application and registrations.

As pointed out by the Trademark Examining Attorney, "the application and the first cited registration reference identical goods in International Class 003, such as body wash, body lotion and shampoo" (Trademark Examining Attorney's appeal brief, unnumbered p. 6), a listing to which we might well add "soaps," "bath oils," "shower gels," "hair conditioners" and "room fragrances." The balance of personal care products listed in applicant's and registrant's respective identifications of goods in International Class 3 are, on their face, all closely related.

As to the cited registration for candles, the Trademark Examining Attorney placed into the record the following third-party registrations having marks registered for candles as well as a range of personal care products of the kind identified by applicant.

Aura Cacia



pure botanical essence

for "personal care products, namely, body oils, body lotion, body wash, skin cleansing body bars, body balms, hand lotion, hand wash, massage balm, massage oils, bath and shower gels, bath salts, mineral bath powders, foot balms, foot soaks, cocoa butter for cosmetic use, vegetable oils for cosmetic use, essential oils for personal use, non-medicated lip care preparations, hair shampoo, hair conditioner, hair relaxers, hair detanglers, hair styling foams, hair styling gels, hair spray, and sachet-like eye pillows containing fragrances" in International Class 3; "aromatherapy candles" in International Class 4;⁴

JUNIPER BREEZE

for "personal care products, namely, body lotion, shower gel, body cream, body wash, hand soap, body soap, moisturizing hand cream, body scrub, and room fragrancing gels; scented room sprays," in International Class 3; "candles" in International Class 4;⁵

CANDY CARE

for "personal care products, namely, bubble bath, shower gel, bath gel, body scrubs, soaps, skin creams, skin lotions, lip gloss" in International Class 3; "candles" in International Class 4;⁶

⁴ Registration No. 2815074 issued on February 17, 2004 based upon claims of first use anywhere and first use in commerce in both classes at least as early as September 1, 2001.

⁵ Registration No. 2621534 issued to Bath & Body Works, Inc. on September 17, 2002 based upon claims of first use anywhere and first use in commerce in International Class 3 at least as early as May 31, 1996 and claims of first use anywhere and first use in commerce in International Class 4 at least as early as October 31, 1997.

⁶ Registration No. 2814716 issued on February 17, 2004 based upon claims of first use anywhere and first use in commerce in International Class 3 at least as early as March 2002 and claims of first use anywhere and first use in commerce in International Class 4 at least as early as June 2002. No claim is made to the exclusive right to use the word "Care" apart from the mark as shown.

GODDESS GIRL

for "personal care products for women, namely, bath gels, shower gels, bath soaps, body soaps, hand soaps, bath salts, body scrub, bubble bath, milk bath, hand lotions, body lotions, skin moisturizing creams, skin moisturizing lotions, bath oils, body powders, massage oil; and combinations of the foregoing goods sold as a unit" in International Class 3;
"candles" in International Class 4;⁷

FOR EVERY BODY

for "personal care products, namely, body oils, body lotions, perfumes, essential oils for personal use, and colognes" in International Class 3;
"Candles" in International Class 4;⁸

PAPERWHITES ISABELL

for "personal care products, namely, body lotion, body scrub, perfume, cologne, Eau de toilette and shower gel" in International Class 3;
"candles" in International Class 4;⁹

IDENTITY

for "bath, beauty and personal care products, namely, non-medicated skin care preparations, namely, lotions for moisturizing the body; body shimmer, bath products, namely, bath gel, body mist, body lotions; hair care preparations, namely shampoos, conditioners, sprays and gels" in International Class 3;
"scented candles" in International Class 4;¹⁰

⁷ Registration No. 2736349 issued on July 15, 2003 based upon claims of first use anywhere and first use in commerce in both classes at least as early as July 2002. No claim is made to the exclusive right to use the word "Girl" apart from the mark as shown.

⁸ Registration No. 2662837 issued on December 17, 2002 based upon claims of first use anywhere and first use in commerce in both classes at least as early as November 6, 1995.

⁹ Registration No. 2392139 issued to Perfumes Isabell, Inc. on October 3, 2000, based upon claims of first use anywhere and first use in commerce in both classes at least as early as September 1998.

¹⁰ Registration No. 2729799 issued to Albertson's, Inc. on June 24, 2003, based upon claims of first use anywhere and first use in commerce in both classes at least as early as December 2000.

BIZZY BODY BUBBLES

for "personal care products, namely soap" in International Class 3; "candles" in International Class 4;¹¹

These third-party registrations, all of which are based on use in commerce, provide support for the Trademark Examining Attorney's position that candles are related to personal care products inasmuch as they have been registered by the same source under the same mark. See In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988)

[Although third-party registrations "are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may have some probative value to the extent that they may serve to suggest that such goods or services are the type which may emanate from a single source"]. See also In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993).

Additionally, the Trademark Examining Attorney has included in the record screen prints of web pages from an Internet search showing candles combined with personal care products in promotional websites placed by, *inter alia*, Attitudes, Ltd,¹² Candles Forever,¹³ Fredericksburg Herb Farm¹⁴

¹¹ Registration No. 2352768 issued to Dial Brand, Inc. on May 23, 2000, based upon claims of first use anywhere and first use in commerce in both classes at least as early as March 1999.

¹² www.shopattitudes.com/, 07/21/2005.

¹³ www.candlesforever.com/burts.html, 07/21/2005.

¹⁴ www.fredericksburgherbfarm.com/, 07/21/2005.

and Sensia.¹⁵

Accordingly, this du Pont factor favors a finding of likelihood of confusion based on both cited registrations.

Channels of trade and classes of purchasers

As seen in the third-party registrations and websites placed into the record by the Trademark Examining Attorney, candles - and especially scented or aromatic candles - clearly move in the same channels of trade as do personal care products. The record demonstrates that this includes, *inter alia*, retail stores and online shopping by way of the Internet.

As to the care with which consumers approach the purchase of personal care products, applicant argues without support that given the nature of these respective goods (i.e., "products used for personal care and beauty"), "it is expected that consumers will take greater care in reading the product labels and making their product selections." (Applicant's brief, p. 9). The record convinces us that the Trademark Examining Attorney is correct in arguing that the goods of applicant and registrant "are inexpensive consumer products consisting primarily of personal care products, room fragrances and candles that are routinely subject to

¹⁵ www.sensia.com/archipelago2.htm, Morning Mint Candle, 07/21/2005.

impulse purchasing." (Trademark Examining Attorney's appeal brief, unnumbered p. 7).

Hence, on these two related du Pont factors -- the similarity of established, likely-to-continue trade channels and the conditions under which and buyers to whom sales will be made - we find that the same classes of ordinary consumers would find these goods offered through the same channels of trade, and hence, these two factors also favor the position of the Trademark Examining Attorney.

The number and nature of similar marks on related goods

Throughout its brief, despite having introduced no supporting evidence, applicant emphasizes the "large number of similar marks in the class":

"... There are as noted over 700 references that include SPA in the class and some 150 that include SIMPLY, which are all again for Class 3 goods. Again, fiven [sic] the common use of the common portions of the marks for the same or similar goods demonstrates in fact that there is no confusion caused by the common adoption and use of these words."

(Applicant's brief, p. 9). We note that applicant admits that it has gone beyond the exact form of the words, to include "marks which were based upon or contained the words" (applicant's appeal brief, p. 2). Hence, the alleged 150 occurrences of marks based upon or containing some form of the word "simply" would actually include all those composite marks having somewhere within the mark, for example, the

word "simple." Moreover, this number of allegedly similar marks would include marks having totally different commercial impressions as registered for International Class 3 goods not at all related to personal care products or candles.¹⁶

In response, the Trademark Examining Attorney points out that applicant's arguments above are misleading:

"...[A]pplicant contends that *each* term appears numerous times in the Office's Registers. However, the applicant failed to provide evidence [soft copies of registrations] to support its argument...

(Trademark Examining Attorney's denial of applicant's request for reconsideration, July 2005, p. 4). In fact, we would point out that not only does the Board not take judicial notice of third-party registrations, *see, e.g., In re Duofold Inc.*, 184 USPQ 638, 640 (TTAB 1974), but there is not even a summary listing in the record of the "references" to which applicant cites.

By contrast, the Trademark Examining Attorney argues that applicant's mark and Registrant's two marks "are the only three listed marks that share *both* the words 'Simply' and 'Spa' to identify personal care products, room fragrances and candles." (Trademark Examining Attorney's

¹⁶ Hypothetically, this could include a registration for the mark HORSE SENSE PURE AND SIMPLE for "leather conditioner" in International Class 3.

brief, unnumbered p. 5). Accordingly, on this record, we conclude that, indeed, the marks involved herein are the only three registered marks having both words "Simply" and "Spa" identifying personal care products, room fragrances or candles.

In a similar vein, applicant argued in its response of September 3, 2004, that it was "manifestly unjust" to deny registration herein inasmuch as the Trademark Office had allowed the cited marks to register over applicant's two prior-filed, now-abandoned applications identifying the same personal care products in International Class 3. However, inasmuch as those earlier application were for different marks (e.g., **SIMPLY**¹⁷ and **SIMPLYME**¹⁸), the Office's now refusing **SIMPLYME SPA** on the basis of the intervening **SIMPLY SPA** can hardly be viewed as improper.

The marks

The critical du Pont factor that the Trademark Examining Attorney and applicant discuss in their briefs involves the similarities or dissimilarities in the

¹⁷ Serial No. 78115545 was filed on March 18, 2002; abandoned on February 23, 2006, upon applicant's failure to file a statement of use.

¹⁸ Serial No. 78115539 was filed on March 18, 2002; abandoned on September 1, 2006, upon applicant's failure to file a statement of use.

appearance, sound, connotation and commercial impression of the respective marks. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

We note, in discussing this factor, that the Court of Appeals for the Federal Circuit has held that when marks appear on "virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992).

Under actual market conditions, consumers generally do not have the luxury of making side-by-side comparisons. The proper test in determining likelihood of confusion is not a side-by-side comparison of the marks, but rather, the decision must be based on the similarity of the general overall commercial impressions engendered by the involved marks. See Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corporation, 206 USPQ 255 (TTAB 1980).

Applicant's mark is **SIMPLYME SPA** and opposer's mark is **SIMPLY SPA**. There are obvious similarities in the appearance and pronunciation of the two marks in that both begin with the word "Simply" and end with the stand-alone

word, "Spa." In fact, these two marks are similar enough overall that the differences may not even be noticed.

If this small difference in the middle of the marks is noticed - with applicant's mark containing the added letters "me" as a suffix to the word "Simply" -- we find that this difference is not sufficient to distinguish the marks as to sound or appearance. Moreover, the connotations are similar in that prospective customers would likely see applicant's mark as meaning "Simply Spa for Me."

Thus, although there are some differences in the marks, we find that the marks are similar in their entireties as to appearance, sound, connotation and commercial impression.

Conclusion

We find that: applicant's goods are identical or otherwise closely related to registrant's goods in both cited classes; the marks of applicant and of registrant are confusingly similar inasmuch as the suffix "me" buried in the middle of the composite mark is not sufficient to distinguish applicant's mark from registrant's mark; the cited mark is not shown on this record to be a weak mark - to the contrary, we find that the only three marks registered for personal care products, room fragrances and candles that share *both* the words "Simply" and "Spa" are

involved in this appeal; these identically and otherwise closely related goods will travel in the same channels of trade and will be encountered by the same general consumers; there is no proof that consumers will exercise great care in selecting these inexpensive consumer products that are all routinely subject to impulse purchasing decisions; and an appreciable number of ordinary prudent purchasers are likely to be confused with the cited mark through applicant's use of **SIMPLYME SPA** in connection with personal care products.

Decision: The refusal to register based upon Section 2(d) of the Lanham Act is hereby affirmed as to both cited registrations.