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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Two Square Meters LLC

Serial No. 78490360

Adam R. Agensky, Esq. for Two Square Meters LLC.

Shaunia P. Wallace Carlyle, Trademark Examining Attorney,
Law Office 110 (Chris A.F. Pedersen, Managing Attorney).

Before Hohein, Grendel and Walsh, Administrative Trademark
Judges.

Opinion by Walsh, Administrative Trademark Judge:

On September 27, 2004, Two Square Meters LLC
(applicant) filed an intent-to-use application to register
the mark RENOVATE YOUR SKIN in standard-character form on
the Principal Register for goods now identified as
"toiletries and skin care preparations, namely, lotion,
moisturizer, body wash, soap, skin cleanser, skin cream,
eye cream, shave cream and after-shave lotion" in
International Class 3. Applicant has disclaimed "skin."

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The Examining Attorney has refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a likelihood of confusion with the mark in Reg. No. 2806195, SKIN RENOVATION, in standard-character form on the Principal Register, for "compact cases containing cosmetics and cosmetics, namely, perfumes, facial and body soaps, hair shampoo, hair lotions, skin cream, skin lotion, eye cream, eye lotion, moisture cream, moisture lotion, foundation, anti-wrinkle cream and anti-wrinkle lotion" in International Class 3. The cited mark was registered on January 20, 2004. The registration includes a disclaimer of "skin."

Applicant argued against the refusal; the Examining Attorney made the refusal final; and applicant appealed. Applicant and the Examining Attorney have filed briefs. We affirm.

Before addressing the likelihood-of-confusion refusal on the merits, we must attend to a procedural matter. Applicant states that the Examining Attorney issued a first action which did not include the likelihood-of-confusion refusal, and one day later, issued another action which did include the refusal. Applicant argues that it suffered prejudice as a result of this action and asks that we

reverse the refusal due to this procedural glitch. We decline to do so.

Under the circumstances of this case, the Board will not consider the procedural correctness of the Examining Attorney's action; the Board will restrict its consideration to the underlying substantive refusal. See In Re Sambado & Son, Inc., 45 USPQ2d 1312, 1314 (TTAB 1997). Furthermore, as the Examining Attorney correctly notes, the Trademark Manual of Examining Procedure (TMEP) (4th ed. 2005) not only authorizes the Examining Attorney to issue an action to correct a failure to issue an appropriate refusal, but requires the Examining Attorney to do so when necessary. TMEP § 706. Accordingly, we will not second guess the procedural correctness of the Examining Attorney's decision to issue the refusal under Trademark Act Section 2(d) in the second action in this case, but we will consider the refusal on the merits. In Re Sambado & Son, Inc., 45 USPQ2d at 1314.

Section 2(d) of the Trademark Act precludes registration of an applicant's mark "which so resembles a mark registered in the Patent and Trademark Office... as to be likely, when used on or in connection with the goods of the applicant, to cause confusion..." The opinion in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ

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563, 567 (CCPA 1977), sets forth the factors we may consider in determining likelihood of confusion. Here, as is often the case, the crucial factors are the similarity of the marks and the similarity of the goods of the applicant and registrant. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The 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").

The goods of applicant and the registrant need not be identical to find likelihood of confusion under Section 2(d) of the Trademark Act. They need only be related in such a way that the circumstances surrounding their marketing would result in relevant consumers mistakenly believing that the goods originate from the same source. In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978). See also On-Line Careline Inc. v. America Online Inc., 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000).

Furthermore, in comparing the goods we must consider the goods as identified in the application and registrations. 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.").

In this case applicant has identified its goods as "toiletries and skin care preparations, namely, lotion, moisturizer, body wash, soap, skin cleanser, skin cream, eye cream, shave cream and after-shave lotion." The goods identified in the cited registration are "compact cases containing cosmetics and cosmetics, namely, perfumes, facial and body soaps, hair shampoo, hair lotions, skin cream, skin lotion, eye cream, eye lotion, moisture cream, moisture lotion, foundation, anti-wrinkle cream and anti-wrinkle lotion."

Both the application and registration include skin lotions, soaps, moisturizers and eye cream. Therefore, the goods in the application and registration are, at least in

part, identical. Furthermore, the balance of the goods in the application and registration are closely related personal care items.

Applicant argues that its goods differ from the goods identified in the registration because the registrant's goods "...fall under the premium or super-premium, segment of the skin care market, and are sold through high-end retailers and department stores..." Applicant also argues that its products are marketed to men in contrast to the goods in the cited registration, which are marketed to women.

In asserting these arguments applicant disregards the requirement that we look to, and not beyond, the identifications of goods in the application and registration in comparing the goods. See Octocom Systems, Inc. v. Houston Computers Services Inc., 16 USPQ2d at 1787. Consequently, we cannot consider extrinsic evidence regarding the registrant's goods or the channels of trade for those goods. In re Bercut-Vandervoort & Co., 229 USPQ 763, 764 (TTAB 1986) (extrinsic evidence and argument suggesting trade-channel restrictions not specified in application rejected). For these reasons alone we reject applicant's arguments.

For completeness we also note that the only "evidence" applicant offered to support its arguments regarding the nature of the registrant's goods is a reference to a web address, allegedly associated with the registrant, in its brief. We will not consider evidence offered in this form for any purpose. In re Planalytics Inc., 70 USPQ2d 1453, 1457 (TTAB 2004) (a mere reference to a web address does not make the information at the web address of record). In addition, Applicant's submission of this "evidence" with its brief is untimely. Trademark Rule 2.142(d) requires that the record be complete prior to the filing of an appeal, subject to certain exceptions not relevant here.

Accordingly we conclude that the goods of applicant and registrant are, at least in part, identical. Furthermore, we note that, "the degree of similarity [between the marks] necessary to support the conclusion of likely confusion declines" when the goods or services are identical. Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), cert. denied, 506 U.S. 1034 (1992).

Before turning to consideration of the marks, we will address applicant's other argument related to the goods, that is, that there would not be a likelihood of confusion because the purchasers of the goods in the registration are

sophisticated. This argument rests entirely on the assertion that the registrant's goods are expensive, "high-end" products, priced in the \$100 range and higher. For all of the same reasons we stated in our discussion of the registrant's goods we reject applicant's arguments regarding the sophisticated nature of the purchasers. For purposes of this argument also, we must consider the goods as identified in the application and registration. Goods identified simply as "soaps" or "lotions" could vary greatly in price and could include inexpensive products purchased by the general public without significant deliberation. Also, as the Examining Attorney notes, even sophisticated consumers are not immune from trademark confusion. In re Decombe, 9 USPQ2d 1812 (TTAB 1988) and In re Pellerin Milnor Corp., 221 USPQ 558 (TTAB 1983).

Accordingly, we conclude that there is no basis in this record to conclude that there would be a diminished likelihood of confusion due to the sophistication of potential purchasers. Therefore, we have given no consideration to this factor in our decision.

Turning to the marks, in comparing the marks we must consider the appearance, sound, connotation and commercial impression of the marks at issue. Palm Bay Imports Inc. v.

Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Applicant argues that the marks differ in all respects stating, "The similarities between Applicant's RENOVATE YOUR SKIN mark and Kose's SKIN RENOVATION [mark] are confined to the use of the term 'SKIN', which is disclaimed in both the instant application and the registration, and the inclusion of a 'RENOVATE'-formative element. These *de minimus* similarities are far outweighed by the mark's differences in sight, sound, and meaning/connotation, which cumulatively act to create a distinct commercial impression." Applicant argues, further, that "...it is well established that even when marks are identical in sound and/or appearance (which is clearly not the case here), they may nonetheless create different commercial impressions when applied to the respective parties' goods." In this connection applicant cites numerous cases including, for example, In re British Bulldog, Ltd., 224 USPQ 854 (TTAB 1984) (PLAYERS for men's underwear held not likely to be confused with PLAYERS for shoes). Applicant also argues that the marks at issue here are distinguishable from the cases where marks were found to be similar on the basis that elements were merely transposed, for example, RUST BUSTER versus BUST RUST in In re

Nationwide Industries Inc., 6 USPQ2d 1882 (TTAB 1988).

Applicant also argues that the marks differ in sound and that the marks differ in connotation, stating, "Applicant's mark is instructive, containing a 'call to action,'" whereas registrant's mark, "...is comprised of the nouns 'skin' and 'renovation.' There is no action involved. It is a descriptive, or reflective message."

The Examining Attorney argues that "Applicant's mark and the registrant's mark are confusingly similar because they convey a very similar commercial impression." The Examining Attorney argues further that "...the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); *Visual Information Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179 (TTAB 1980)."

We agree with the Examining Attorney. We recognize that there are some differences in appearance and sound between the marks, but the overall similarity in connotation and commercial impression is more important here. The marks are fundamentally the same in concept. Both suggest that the skin can be renovated, restored or improved - in the same way that a property might be. The

difference in form which applicant emphasizes is not sufficient to distinguish the marks under the totality of circumstances here. We find it unlikely that potential purchasers for goods such as these, which could include the general public, will take note of and recall the distinction between the "instructive" versus the "descriptive or reflective" form, as applicant argues. As the Examining Attorney notes, "The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 19790; *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975)."

We find applicant's arguments regarding the marks unpersuasive, including applicant's arguments that even identical marks may project different commercial impressions as applied to different goods. As we stated above, the goods here are, at least in part, identical.

Accordingly, we conclude that applicant's RENOVATE YOUR SKIN mark is similar to the cited SKIN RENOVATION mark.

In a related argument, Applicant also points to a number of third-party registrations for marks unrelated to the marks at issue here in support of its general position

that there is not a likelihood of confusion in this case. Specifically, applicant provided a list of third-party registrations to support its argument that other marks, based on the same root word, coexist on the register for personal care items.¹ Those marks include, for example, ILLUMINE versus ILLUMINATE and ILLUMINATION. We find these arguments and this evidence unpersuasive. In the end, we must decide each case on its unique facts. In re Nett Designs, Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

Lastly, applicant also argues that the manner in which it intends to use its mark, in contrast to the manner in which the registrant uses its mark, will avoid confusion. Applicant states that "Applicant intends for its RENOVATE YOUR SKIN mark to be akin to a house mark, appearing on all products in the relevant collection. Kose's SKIN RENOVATION mark is used in a secondary fashion, appearing

¹ In her brief, the Examining Attorney argued that we should not consider this evidence because applicant provided only a listing and not acceptable copies of the relevant Office records. In its reply brief applicant correctly points out that applicant first provided the listings with its office action response and the Examining Attorney failed to advise applicant at that time that the records must be in proper form. See In Re Hayes, 62 USPQ2d 1443, 1445 n.3 (TTAB 2002). Consequently, we find that the Examining Attorney has waived the objection, and we have given full consideration to the listing applicant provided.

under its primary mark, AWAKE, which appears much more prominently in its packaging (see awakecosmetics.com)."

We have already noted problems both with the form of the "evidence" applicant offers here, as well as the general prohibition against the use of extrinsic evidence in this manner. In re Bercut-Vandervoort & Co., 229 USPQ at 764. Furthermore, we cannot base our evaluation of applicant's mark or registrant's mark on a specific display applicant used or intends to use, or a display registrant allegedly uses. Vornado, Inc. v. Breuer Electric Mfg. Co., 390 F.2d 724, 156 USPQ 340, 342 (CCPA 1968) ("...the display of a mark in a particular style is of no material significance since the display may be changed at any time as may be dictated by the fancy of the applicant or the owner of the mark"). We must confine our consideration to the specific mark in the application and registration.

Also, in the case of the mark in the cited registration, SKIN RENOVATION, Trademark Act Section 7(b), 15 U.S.C. § 1057(b), provides that the registration is prima facie evidence, among other things, "of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate." Likewise, if applicant received a registration as a result of this application, it

too would be entitled to claim such a right. In neither case is the right subject to the use of the mark in conjunction with any other mark or in any particular manner. Accordingly, we reject applicant's arguments based on the manner of use of the respective marks.

In conclusion, we have considered all relevant evidence in this case bearing on the du Pont factors and conclude that there is a likelihood of confusion between applicant's RENOVATE YOUR SKIN mark and the SKIN RENOVATION mark in the cited registration. We conclude so principally because the marks are similar and the goods identified in the application and cited registration are, at least in part, identical and otherwise related. We note also that applicant has discussed a number of prior cases; we have considered those arguments carefully and found them unpersuasive due to significant factual differences between those cases and the one before us.

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