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*Decision Mailed:
October 11, 2007
GDH/gdh*

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Revlon Consumer Products Corporation

Serial No. 78587508

John N. O'Shea, Esq. for Revlon Consumer Products Corporation.

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(Thomas G. Howell, Managing Attorney).

Before Hohein, Bergsman and Wellington, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Revlon Consumer Products Corporation has filed an application to register on the Principal Register in standard character form the mark "SMART TONER" for "hair care and hair coloring preparations" in International Class 3.¹

Registration has been finally refused 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 goods, so resembles the mark "SMART" and design, as reproduced below,

¹ Ser. No. 78587508, filed on March 15, 2005, which is based on an allegation of a bona fide intention to use such mark in commerce. The word "TONER" is disclaimed.

SMART

which is registered on the Principal Register for "hair care products, namely, hair coloring" in International Class 16,² as to be likely to cause confusion, or to cause mistake, or to deceive.

Applicant has appealed and briefs have been filed.³ We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). See also In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity in the goods at issue and the similarity or dissimilarity of the respective marks in their

² Reg. No. 2,750,423, issued on August 12, 2003, which sets forth a date of first use anywhere and in commerce of January 1999.

³ Citing Trademark Rule 2.142(d), the Examining Attorney in her brief "objects to Applicant's inclusion of additional evidence with its appeal brief, namely, all of the Exhibits attached to the appeal brief (Exhibits A, B, and C)." Inasmuch as the Examining Attorney is correct that such evidence, which was not previously submitted, is untimely, the objection is sustained and the evidence will not be given further consideration. We nevertheless hasten to add that, even if such evidence were to be treated as part of the record herein, it would make no difference in the outcome of this appeal.

entireties.⁴ See also *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). Here, in relevant part, inasmuch as applicant's "hair coloring preparations" are legally identical to registrant's "hair coloring" products,⁵ and therefore would be marketed and sold to the same classes of ordinary consumers through the same channels of trade (e.g., drug stores, supermarkets, mass merchandisers and beauty salons),⁶ the

⁴ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." 192 USPQ at 29.

⁵ We note, as the Examining Attorney does in her brief, that applicant specifically states in its brief that: "Applicant does not contend that the goods are dissimilar."

⁶ Notwithstanding its previously noted statement that it "does not contend that the goods are dissimilar," applicant argues in its brief that "the channel of trade used by the Registrant is dramatically different from those of Applicant" because the registrant "sells its products through a small number of its salons, located only in Atlanta, Georgia" while applicant's goods "are not marketed in salons, nor other professional outlets, but instead are sold almost entirely through mass merchandisers ... and retail drug chain stores." The Examining Attorney in her brief, however, points out that "[w]ith respect to the goods being sold in different channels of trade, the record does not contain any timely evidence to support Applicant's assertion[s]." More importantly, observing that as identified in the application and cited registration, neither applicant's goods nor those of the cited registrant contain any limitation or restriction as to channels of trade or area of use, she also correctly notes that:

A determination of whether there is a likelihood of confusion is made solely on the basis of the goods identified in the application and [cited] registration, without limitations or restrictions that are not reflected therein. *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595 (TTAB 1999). If the cited registration describes the goods ... broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, then it is presumed that the registration encompasses all goods ... of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992); TMEP §1207.01(a)(iii).

Applicant also asserts that Registrant's products are sold exclusively in Atlanta, Georgia and that it is unlikely that the parties' products would ever be offered for sale in

primary focus of our inquiry is on the similarities and dissimilarities in the respective marks, when considered in their entirety, along with, as applicant also asserts, the additional *du Pont* factors of the number and nature of similar marks in use on similar goods and the conditions under which and buyers to whom sales are made (i.e., "impulse" versus careful, sophisticated purchasing).

Turning first, therefore, to the respective marks, applicant argues in its brief that, when its mark "is considered as a whole, it is substantially different in appearance, sound, and meaning from the ... mark cited by the Examining Attorney." In particular, applicant contends that "the marks are visually distinguishable"; that "the marks sound distinctly different from one another"; and that "the addition of the term TONER to Applicant's mark gives the mark a completely different connotation as ... the term SMART is used to modify the term 'TONER' ... [so] that it suggests that the product will 'intelligently tone the color of one's hair' or, alternatively, suggest[s] that the consumer is intelligent for making such a shrewd product purchase."

the same retail outlet. However, this argument is not persuasive because Applicant seeks a geographically unrestricted registration, and the registration at issue enjoys a presumption of registrant's exclusive right to nationwide use of the registered mark under Section 7(b) of the Trademark Act regardless of its actual extent of use. See e.g. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1568, 218 USPQ 390, 393 (Fed. Cir. 1983). Therefore, the geographical extent of Applicant's and Registrant's activities is not a proper factor for consideration here. *In re Shell Oil Co.*, 26 USPQ2d 1687, 1689-90 (Fed. Cir. 1993).

Applicant also asserts that marks which consist of or include the term "SMART" are considered weak, when used in connection with different goods, due to their "laudatory connotations." Among other things, applicant cites in support thereof a list of various third-party registrations for such marks as "SMART PERM," "SMART SCIENCE," "SMART SHIELD," "SMART SOLUTIONS," "SMART WAX," "SMARTFOIL," "SMARTSTART," "COLOR SMART" and "SMART SET" which it maintains constitutes proof of "extensive third-party use and registration of this term with respect to hair care products." According to applicant, "consumers are aware of widespread use of the laudatory term SMART that simply has the effect of praising the product as a 'smart buy' or that the product itself has some 'smart effect'." Applicant urges, in view thereof, that "[t]his prevalent third-party use of the laudatory term inevitably means that the consumers can easily recognize that many businesses use the term and are able to easily distinguish between the marks based on small distinctions." Applicant consequently insists that, "[a]s discussed above, the differences between the Applicant's and Registrant's marks in appearance, sound, and meaning, as well as the co-existence on the Register of so many other third-party beauty, cosmetic, and personal care product trademarks containing the common term SMART, militate strongly against a likelihood of confusion."

In addition, applicant emphasizes that confusion is not likely because of the care and deliberation involved in the

selection of beauty products, including hair coloring preparations, arguing that:

Finally, it must be recognized that beauty products are purchased overwhelmingly by women for application to their hair, eyes, ... lips, ... face, and ... other sensitive and visible parts of their body. These products are also relatively expensive. Consequently, because of the nature and purpose of such products, purchasers exercise a high degree of care in making their purchasing decision--they are sophisticated and focused buyers who are not likely to confuse two products merely because the sub-brand of a product bearing a famous house mark such as REVLON shares the suggestive term "SMART" with other products, including that bearing the cited mark. Accordingly, the fourth DuPont factor--"the conditions under which and buyers to whom sales are made, i.e., impulse vs. careful, sophisticated purchasing"--tilts strongly against the likelihood of confusion in this case.

We agree with the Examining Attorney, however, that confusion is likely. In particular, as our principal reviewing court has noted, while the marks at issue are to be considered in their entirety, including any descriptive or generic terms, it is also the case that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entirety." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For instance, according to the court, "that a particular feature is descriptive or generic with respect to the involved goods ... is one commonly

accepted rationale for giving less weight to a portion of a mark
...." Id.

Here, as the Examining Attorney points out, "the word SMART is the dominant feature of Applicant's mark for two primary reasons:"

First, as a general rule, consumers are more inclined to focus on the first word, prefix or syllable in any trademark See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Because the first part of a mark is often the portion most likely to be impressed upon the mind of a purchaser and remembered when making purchasing decisions, the word SMART is the dominant feature in Applicant's mark.

Second, Applicant disclaimed the wording TONER which necessarily makes the word SMART the dominant feature. Disclaimed matter is typically less significant ... when comparing marks. Although a disclaimed portion of a mark certainly cannot be ignored, and the marks must be compared in their entireties, one feature of a mark may be more significant in creating a commercial impression. *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

She maintains, in view thereof, that:

The dominant feature of the marks, SMART, is identical. The only difference between the marks is the TONER component. Applicant has simply taken the entire registered mark and added the extremely descriptive, if not generic, word TONER to Registrant's mark. The courts have found that the mere addition of [such] a term to a registered mark does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Section 2(d). *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) ... ; TMEP §1207.01(b)(iii).

Here, the addition of the disclaimed word TONER only minimally distinguishes the

two marks, especially as applied to ... goods which Applicant describes as "a shampoo-in toner." See Applicant's website attached as p. 10 to ... Office Action dated October 7, 2005. Because SMART is the first word in Applicant's mark and the only word in Registrant's mark, the additional wording in Applicant's mark is unlikely to be a feature that consumers would use to distinguish the respective marks. The result is that the principal, eye-catching word with the greatest commercial impression in both marks is the word SMART.

We concur that in light of the highly descriptive, if not generic, term "TONER," it is the word "SMART" which constitutes the dominant and distinguishing element of applicant's "SMART TONER" mark. Such word, moreover, is indeed the first and most source significant element of applicant's mark and is identical in all respects to the word "SMART" in registrant's "SMART" and design mark. Consequently, when considered in their entirety, it is readily apparent that applicant's "SMART TONER" mark is substantially identical to registrant's "SMART" and design mark in appearance, sound, connotation and overall commercial impression.

In particular, rather than being "visually distinguishable" as contended by applicant, it must be kept in mind that, inasmuch as applicant seeks registration for its mark in standard character form, such mark could be displayed in any reasonable manner, including the same stylized lettering (cursive lower case letters "s" and "m" followed by the capitalized letters "A," "R" and "T") utilized by registrant for its "SMART" and design mark. See, e.g., Phillips Petroleum Co. v. C. J. Webb, Inc. 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971) [a mark ...

in typed or standard character form is not limited to the depiction thereof in any special form]; and *INB National Bank v. Metrohost Inc.*, 22 USPQ2d 1585, 1588 (TTAB 1992) ["[a]s the *Phillips Petroleum* case makes clear, when [an] applicant seeks a typed or block letter registration of its word mark, then the Board must consider all reasonable manners in which ... [the word mark] could be depicted"]. It consequently is not a valid argument to contend that there is a distinguishable difference in appearance between applicant's mark and the registrant's "SMART" and design mark. See, e.g., *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) (italics in original):

[T]he argument concerning a difference in type style is not viable where one party asserts rights in no particular display. By presenting its mark merely in a typed drawing, a *difference* cannot legally be asserted by that party. Thus, ... the displays must be considered the same.

Furthermore, as to applicant's assertions that "the marks sound distinctly different from one another" and that "the addition of the term TONER to Applicant's mark gives the mark a completely different connotation" from registrant's "SMART" and design mark, suffice it to say, as previously noted, that when used in connection with hair coloring preparations such as toner products, the highly descriptive, if not generic, term "TONER" in applicant's mark "SMART TONER" is essentially of no source-indicative significance and adds basically nothing to the connotation of such mark. Instead, when used in connection with hair color toners, applicant's mark sounds substantially the same as, and conveys virtually the identical connotation, as

registrant's "SMART" and design mark. On the whole, both marks also project substantially the same commercial impression, such that their contemporaneous use in connection with legally identical hair coloring products would be likely to cause confusion as to the origin or affiliation thereof.

With respect to applicant's arguments concerning the asserted weakness of marks which consist of or include the word "SMART," the Examining Attorney, citing *In re Delbar Products, Inc.*, 217 USPQ 859, 861 (TTAB 1981), is correct that as pointed out in her final refusal and again in her brief, applicant's mere "submission of a list of registrations does not make these registrations part of the record."⁷ Nonetheless, considering in any event even the limited information contained in applicant's list of third-party registrations, the Examining Attorney, citing *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991), goes on in her brief properly to observe that such registrations, "by themselves, are entitled to little weight on the question of likelihood of confusion." This, as is well established, is because third-party registrations do not demonstrate use of the marks which are the subjects thereof in the marketplace or that the consuming public is familiar with the use of those marks and has learned to distinguish between them. See, e.g., *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463

⁷ While the third-party registrations noted earlier could have been properly made of record if applicant had filed a timely request for reconsideration of the final refusal which was accompanied by printouts of such registrations from the electronic search records of the U.S. Patent and Trademark Office instead of just submitting such copies for the first time with its brief, applicant did not do so.

(CCPA 1973); and *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973). Furthermore, as our principal reviewing court noted in *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001), "[e]ven if some prior registrations had some characteristics similar to [applicant's] application, the ... allowance of such prior registrations does not bind the Board or this court." See also, *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1514 (TTAB 2001); and *In re Pennzoil Products Co.*, 20 USPQ2d 1753, 1758 (TTAB 1991). Thus, as the Examining Attorney, citing *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1477 (TTAB 1999), also persuasively notes, the "existence on the register of other confusingly similar marks would not assist applicant in registering yet another mark which so resembles the cited registered mark that confusion is likely."

To the extent, however, that by referencing various third-party registrations, applicant is attempting to show that marks which consist of or include the word "SMART" are weak in the sense that they have been adopted by others in the beauty products industry for the laudatory meaning conveyed by such word, the Examining Attorney, citing *Hollister Inc. v. Ident A Pet, Inc.*, 193 USPQ 439, 442 (TTAB 1976) and cases cited therein, properly observes in her brief that even if the cited mark is considered to be weak, such mark is "still entitled to protection against registration by a subsequent user of the same or similar mark for the same or closely related goods." Plainly, when used in connection with legally identically hair coloring preparations

and products, whatever laudatory connotation is conveyed by the cited registrant's "SMART" and design mark is likewise engendered by applicant's "SMART TONER" mark, given the high degree of descriptiveness, if not genericness, inherent in the term "TONER."

In addition, with respect to applicant's contention that confusion is not likely because it intends to use its "SMART TONER" mark as "the sub-brand of a product bearing a famous house mark such as REVLON," it is settled that the issue of likelihood of confusion must be determined solely on the basis of the marks as they are respectively set forth in the application and cited registration. This is because Section 2(d) of the Trademark Act precludes registration of "a mark which so resembles a mark registered in the Patent and Trademark Office ... as to be likely ... to cause confusion" Thus, that applicant assertedly intends to use its "SMART TONER" mark in conjunction with "a famous house mark such as REVLON" is irrelevant and immaterial to the issue of likelihood of confusion. See, e.g., *Sealy, Inc. v. Simmons Co.*, 265 F.2d 934, 121 USPQ 456, 459 (CCPA 1959); *Burton-Dixie Corp. v. Restonic Corp.*, 234 F.2d 668, 110 USPQ 272, 273-74 (CCPA 1956); *Hat Corp. of America v. John B. Stetson Co.*, 223 F.2d 485, 106 USPQ 200, 203 (CCPA 1955); and *ITT Canteen Corp. v. Haven Homes Inc.*, 174 USPQ 539, 540 (TTAB 1972). The mark "REVLON," not being part of the "SMART TONER" mark sought to be registered, therefore cannot lend registrability thereto.

Finally, as to applicant's contentions that confusion is unlikely to occur because the respective goods are expensive

and customers for hair coloring preparations and products are sophisticated purchasers, we share the Examining Attorney's skepticism, as expressed in her brief, that "it is doubtful that hair-coloring preparations are very expensive" and hence would be purchased with greater care and deliberation. We note, in this regard that applicant has offered no evidence in support of its contentions. Nonetheless, even assuming that ordinary purchasers of hair coloring preparations and products would be sophisticated in that, at the very least, they would be knowledgeable as to their specific needs and would carefully select such goods based upon shades of color, ease of application, and other factors, including product cost, it is well settled that the fact that consumers may exercise care and deliberation in their choice of goods "does not necessarily preclude their mistaking one trademark for another" or that they otherwise are entirely immune from confusion as to source or sponsorship. *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962). See also *In re Research & Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986); *In re Decombe*, 9 USPQ2d 1812, 1814-15 (TTAB 1988); and *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983). This is especially so in a case like this in which the goods at issue are legally the same and the respective marks are substantially identical.

Accordingly, we conclude that purchasers who are familiar or otherwise acquainted with registrant's "SMART" and design mark for "hair care products, namely, hair coloring" would be likely to believe, upon encountering applicant's substantially

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identical "SMART TONER" mark for, in particular, "hair coloring preparations," that such legally identical products emanate from, or are sponsored by or affiliated with, the same source.

Consumers, for example, could readily regard the toner preparations for hair coloring sold by applicant under its "SMART TONER" mark as a new, expanded or up-graded line from the same source as hair coloring products marketed by respondent under its "SMART" and design mark.

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