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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Jafer Limited

Serial No. 78663877

Marnie Wright Barnhorst of The Trademark Group, APLC for
Jafer Limited.

Won T. Oh, Trademark Examining Attorney, Law Office 114 (K.
Margaret Le, Managing Attorney).

Before Seeherman, Hohein and Walters, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Jafer Limited has appealed from the final refusal of
the Trademark Examining Attorney to register MAQ-OFF, in
standard character format, for "eye makeup remover,
eyelashes makeup remover, eyebrow makeup remover, facial
makeup remover, lip makeup remover."¹ Registration has

¹ Application Serial No. 78663877, filed July 5, 2005, based on
Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b) (intent-to-
use).

been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the mark MAKE-OFFS, registered for "make-up remover pads,"² that if used on applicant's identified goods, it is likely to cause confusion or mistake or to deceive.

We affirm the refusal of registration.

Our determination of the issue of likelihood of confusion 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 Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, 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).

With respect to the goods, they are essentially identical. Applicant's goods are makeup remover, while the registrant's goods are identified as "make-up remover

² Registration No. 1774855, issued June 8, 1993; renewed.

pads.”³ It appears to us that applicant’s goods, as identified, could encompass “make-up remover pads,” since such pads are pre-moistened with makeup remover and therefore are simply a makeup remover sold in a particular format. See, for example, the listing of record for Andrea EyeQ eye makeup remover pad, stating that “Andrea EyeQ’s Oil Free Eye Makeup Remover Pads are saturated with an oil free cleanser to easily remove all types of makeup.”
www.folica.com.

However, because the Examining Attorney never took this position, we will treat applicant’s identified goods as not including a pre-moistened pad. Even so, the goods must be considered virtually identical. They are both essentially the same item, makeup remover, and differ only as to the form in which it is sold, e.g., one is sold as a liquid or gel in a bottle or tube, and the other is sold in the form of a pre-moistened pad.

Applicant has tried to characterize the goods as being different by stating that its goods are “a cream or gel solution sold in a tube while Registrant’s goods are 100% dry cotton fiber pads sold in clear plastic packaging.”

³ Registrant has hyphenated the word “makeup” in its identification, while applicant has not. Because the standard spelling appears to be without hyphenation, unless we are specifically quoting the registrant’s identification, we have spelled the word as “makeup” in our opinion.

Reply brief, p. 2. However, the determination of likelihood of confusion must be made on the basis of the identification of goods set forth in the subject application and cited registration. In re William Hodges & Co., Inc., 190 USPQ 47 (TTAB 1976); see also, Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A., 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). As the goods are identified, the registrant's goods are not limited to a "dry cotton fiber pad." Rather, the identification encompasses not only dry pads, but pads that are pre-moistened with makeup removing solution. Thus, even if we treat makeup remover and makeup remover pads as different items, the goods are the same in that they both are used for the same purpose, to remove makeup, and both consist of a makeup removing solution.

Further, even if we were to accept applicant's position that makeup remover can only be a liquid or gel that is sold in a tube, and that makeup remover pads are dry cotton, applicant's and the registrant's goods must be considered complementary items, with the pads used to apply the makeup remover to the eyes, eyelashes, etc. Thus, they would be purchased by the same consumers for the same purpose.

Applicant has argued that the goods are different because they are made by a different manufacturing process, asserting that cotton pads are manufactured in plants that process natural fibers into cotton pads and the like, and that such plants "are not configured to also manufacture cosmetic liquids and gels." Brief, p. 3. Applicant also asserts that "the manufacture of cosmetic solutions requires entirely different equipment and processes than those used for processing natural fibers." There are several problems with this argument. First, a company can be the source of goods even if it is not the actual manufacturer of them. Consumers are aware that many products are produced for a trademark owner by contract manufacturers. Second, because makeup remover pads can be pre-moistened with makeup remover, consumers are likely to assume that the company that manufactures makeup remover that is sold in a tube also manufactures makeup remover that is used in pre-moistened pads, if both products were sold under confusingly similar marks. Third, the evidence of record shows that at least one company (Colose) sells both makeup remover in a tube and eye makeup remover pads.

The factor of the similarity of the goods strongly favors a finding of likelihood of confusion.⁴

We turn next to a consideration of the marks, noting that when marks would appear on virtually identical goods or services, as they do here, 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, 1700 (Fed. Cir. 1992). The marks are similar in appearance to the extent that they both begin with the same two letters, and end with an element which, because it is preceded by a hyphen in both marks, creates a separate impression of OFF or OFFS. We acknowledge that the marks differ in that applicant's mark contains the letter "Q" while the

⁴ The Examining Attorney also made of record a number of third-party applications and registrations in order to show relatedness of the goods, because third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). However, third-party applications are evidence only of the fact that they were filed. Further, only one of the third-party registrations submitted by the Examining Attorney lists both makeup remover and makeup remover pads. The Examining Attorney may have been unable to discover additional registrations because registrants treat an identification of "makeup remover" to encompass "makeup remover pads" as well as makeup remover lotions and gels. Whatever the reason for the lack of a significant number of third-party registrations listing makeup remover and makeup remover pads, we have not relied on this single third-party registration in reaching our conclusion that applicant's goods and the registrant's goods are related.

registered mark has "KE," such that the first element in applicant's mark appears as MAQ and is MAKE in the registered mark, and that the registrant's mark has an additional "S" at the end. While these letters create some difference in appearance, that difference is not sufficient to distinguish the marks. The test in assessing whether there is a likelihood of confusion is not whether the marks are distinguishable on the basis of a side-by-side comparison. *Sealed Air Corporation v. Scott Paper Company*, 190 USPQ 106 (TTAB 1975). Under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their imperfect recollections. *Dassler KG v. Roller Derby Skate Corporation*, 206 USPQ 255 (TTAB 1980). Therefore, we must consider the fallibility of memory over a period of time.

The marks must be deemed virtually identical in sound. There is no correct pronunciation of a trademark when the trademark is not a recognized word. In re *Teradata Corporation*, 223 USPQ 361, 362 (TTAB 1984) ("as we have said many times, there is no 'correct' pronunciation of a trademark"). The element "MAQ" in applicant's mark MAQ-OFF is not a word, and therefore, contrary to applicant's assertion that it must be "pronounced as 'MACK' or 'MOQ' as

the rules of the English, French or Spanish languages would require," reply brief, p. 1, it may be pronounced as "MAKE," the same as the first element in the cited mark. Applicant's unsupported assertion as to how "MAQ" would be pronounced in French or Spanish has no bearing on how consumers in the United States are likely to pronounce the mark. Nor has applicant provided any support as to how "MAQ" would be pronounced in English. Our own review of a dictionary⁵ for words beginning with "Maq" discovered only three entries, one being the name of the French underground during World War II; the second being a word for a dense growth of small trees and shrubs in the Mediterranean area (and from which the name of the underground organization was taken), and the third being an evergreen shrub or a Chilean wine made from the berries of the shrub. These three entries show that the particular words are pronounced with the first syllable "mock." However, one of the three is clearly a French word and the other two are rather arcane. Therefore, we cannot conclude, based on applicant's unsupported assertion and our review of dictionary listings, that consumers in the United States

⁵ The American Heritage Dictionary of the English Language, © 1970. The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

would pronounce MAQ-OFF as applicant asserts. With respect to connotation, we agree with applicant that if consumers see the MAQ portion of its mark as an arbitrary letter string the mark will not have the same meaning as MAKE-OFFS. However, because applicant's goods are makeup remover, consumers may view MAQ as a misspelling of "MAKE," and for them, the marks would have the same connotation. See, for example, In re State Chemical Manufacturing Co., 225 USPQ 687 (TTAB 1985) (FOM is the equivalent of FOAM).

Further, because the marks may be pronounced similarly and because they have the same connotation, they convey the same commercial impression.

Given that the goods are virtually identical, and therefore a lesser degree of similarity is necessary to support a conclusion of likely confusion, the du Pont factor of the similarities of the marks favors a finding of likelihood of confusion.

We also find the goods to be sold in the same channels of trade. The Examining Attorney has submitted Internet webpages that show a search for "Eye Makeup Remover" on Yahoo!Shopping retrieved a number of make-up remover and make-up remover pad products, including Almay Makeup Remover, Joey New York Eye Makeup Remover, and Andrea EyeQ Eye Makeup Remover Pads. <http://shopping.yahoo.com>. In

fact, the Andrea EyeQ makeup remover pads are shown on the same webpage as the Almay makeup remover. Another search on this same site, for "long lasting makeup removers" retrieved, on the same webpage, Erno Laszlo makeup remover, Interface makeup remover and Jason makeup remover pads, while a second page lists Yves Saint Laurent makeup remover lotion, Ponds makeup remover towelettes, Jason make-up remover pads, and Nivea make-up remover, and a third page of the same search shows Jason makeup remover pads, CM's makeup remover and Guerlain Issima makeup remover. A third search, for eye makeup remover, on the website for Make-Up USA, retrieved eye makeup remover and eye makeup remover pads, both offered under the same trademark, COLOSE. www.make-upusa.com Moreover, because makeup remover and makeup remover pads are merely different forms of the same item, which has the same purpose and would be used by the same customers, they will be sold in the same stores and are likely to be displayed in those proximity.⁶

⁶ In its request for reconsideration applicant made the argument that the channels of trade were different, contending that the registrant's goods are really cotton balls or pads and are therefore sold as a first aid or health care product. Applicant did not reiterate this argument in its brief, and therefore may have realized its incorrectness, but because applicant stated in its brief that it was reiterating its previous arguments, we address it briefly. Applicant cannot mischaracterize the registrant's identified goods to change the likelihood of confusion analysis to makeup remover versus first aid cotton. Registrant's goods are makeup remover pads, a cosmetic product,

This du Pont factor favors a finding of likelihood of confusion.

The factor of the conditions of purchase also favors a finding of likelihood of confusion. Makeup remover as identified in applicant's application and the makeup remover pads identified in the cited registration are consumer items that are likely to be purchased by the general public, including adolescent girls and women of all ages. Further, the Internet evidence shows that these products are relatively inexpensive. The Andrea EyeQ makeup remover pads are priced at \$3.99; the Colose brand eye makeup remover sells for \$10.00, while the eye makeup remover pads sell for \$7.00. Consumers are not likely to exercise a great deal of care in making these purchases.

Applicant has argued that "there is a crowded field of 'off' marks in the cosmetic industry and consumers are used to taking extra time to distinguish them." Brief, p. 4. The only evidence applicant has submitted in support of this argument is a printout from the USPTO's TARR database. Applicant states that there are 23 "'live' marks on the PTO register that are comprised of the word 'off',' or a phonetic equivalent, that also list the word 'remover' in

not a first aid product, and they would be sold in the same section of a store as makeup removers.

connection with makeup or cosmetics in the description of goods." Brief, p. 4. First, we point out that submitting a listing from the TARR database is not an acceptable way to make the registrations of record. However, the Examining Attorney has treated the registrations as though they were properly of record, and therefore we will consider them for whatever probative value they have. That value is very limited. Third-party registrations are not evidence that the marks are in use. See, *In re Albert Trostel & Sons Co.*, supra. Therefore, they do not prove applicant's argument that consumers are used to seeing "OFF" marks, or that they distinguish them based on other elements in the marks. Since there is no evidence of third-party use, that du Pont factor is neutral.

Third-party registrations can be used to show that a particular term has been adopted by many companies, and therefore that it has a meaning or significance in an industry, such that less weight should be given to that element. See *Tektronix, Inc. v. Daktronics, Inc.*, 187 USPQ 588 (TTAB 1975). However, based on these registrations, we cannot conclude that the word "OFF" in general has a descriptive or suggestive meaning for all cosmetic products. Many of the marks in the list submitted by applicant do not even use "OFF" in a way that it would be

recognized as a separate term, e.g., ZAHAROFF; ALEXANDRA DE MARKOFF; DFP DENISE FORTE-PATHROFF, M.D.; COFFEE BREAKER.

Nor can we determine, from the list that applicant has presented, for what goods these marks are registered.

Although applicant has stated that the registrations are for marks that list the word "remover" in connection with makeup or cosmetics in the identification of goods, the identification of goods of the various registrations is not listed. We note that from the wording of the marks themselves, some of them appear to be for non-cosmetic items, e.g., MOTSENBOCKER'S LIFT OFF RUSTOFF; DUST-OFF.

Also, the registrations which do use OFF as a separate word or element seem to have different meanings for that term, e.g., POLISH OFF; GOOF OFF; KISS-OFF; COOL OFF; TAKE THE DAY OFF; TIP OFF; OFF-BROADWAY; OFF YOU GO!.

We acknowledge that, as used in connection with a makeup removing product, OFF has the suggestion of removing or taking off makeup, but this meaning is the same for both applicant's and the registrant's mark. Most importantly, even giving OFF this suggestive significance, the similarity between applicant's and the registrant's mark is not confined to the element OFF. As we discussed previously, there are also similarities between the first

elements of the marks, MAQ and MAKE, such that the marks as a whole, MAQ-OFF and MAKE-OFFS, are similar.

Applicant has also asserted that the extent of potential confusion is de minimis. Applicant appears to base this position on its contention that "the Examining Attorney's strongest argument for possible confusion is that Applicant's mark might be mispronounced and, therefore, sound like Registrant's mark," and "that Applicant's mark might be mispronounced is merely theoretical." Reply brief, p. 3. As we have previously discussed, we do not think it merely theoretical that MAQ-OFF could be pronounced as MAKE-OFF, and we have also found many additional reasons that favor a finding of likelihood of confusion. Further, because applicant's and the registrant's products are relatively inexpensive general consumer items that could be purchased without a significant amount of care by everyone that wears makeup, the number of people who could be confused is very great. Therefore, this du Pont factor, too, favors a finding of likelihood of confusion.

Neither applicant nor the Examining Attorney have discussed any other du Pont factors. Because of this, and because no evidence has been submitted on other factors, we, too, have limited our discussion to these factors. To

Ser No. 78663877

the extent that any other factors are applicable, we must treat them as neutral.

In conclusion, after considering all relevant du Pont factors, we find that applicant's mark for its identified goods is likely to cause confusion with MAKE-OFFS for makeup remover pads.

Decision: The refusal of registration is affirmed.