

**THIS OPINION IS NOT A  
PRECEDENT OF  
THE T.T.A.B.**

Mailed: March 25, 2008

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Illuminare Cosmetics, LLC

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Serial No. 78774309

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Scott W. Pink of DLA Piper US LLP for Illuminare Cosmetics, LLC.

Mariam Aziz Mahmoudi, Trademark Examining Attorney, Law Office 112 (Angela Wilson, Managing Attorney).

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Before Hairston, Bucher and Cataldo,  
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

An application was filed by Illuminare Cosmetics, LLC to register on the Principal Register the mark shown below for the following goods: "cosmetics, namely, foundations, blushes, eye make-up and concealers" in International Class 3.<sup>1</sup>

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<sup>1</sup> Application Serial No. 78774309 was filed December 15, 2005, based on applicant's assertion of December 29, 2000 as the date of first use of the mark in commerce. In addition, applicant submits the following color statement: "color is not claimed as a feature of the mark."



The trademark examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, as used in connection with its goods, so resembles the mark ILLUMINAIRE ENZYMATIC REVITALIZING MASK, previously registered on the Principal Register in typed or standard character form for "skin care preparations, namely, beauty masks and peels" in International Class 3,<sup>2</sup> as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs on the issue under appeal. In addition, applicant filed a reply brief.

#### **Evidentiary Matters**

Before turning to the substantive ground for refusal, we note that applicant has submitted an exhibit with its main brief. This exhibit consists of a listing from applicant's Internet website of the locations at which applicant offers its goods for sale. Applicant argues that the listing is "illustrative" of evidence previously made

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<sup>2</sup> Registration No. 2638361 issued October 22, 2002 with a disclaimer of "ENZYMATIC REVITALIZING MASK" apart from the mark as shown.

of record with its December 21, 2006 response to the examining attorney's first Office action. We find, however, that the materials comprising this exhibit have not previously been made of record. Accordingly, we agree with the examining attorney that this exhibit is untimely, and it has not been considered. See Trademark Rule 2.142(d) (the record in the application should be complete prior to the filing of an appeal). See also TBMP §1207.01 (2d ed. rev. 2004) and the authorities cited therein. We note, however, that had we considered this exhibit in our determination of the issue on appeal, the result would be the same.

#### **Likelihood of Confusion**

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, 567 (CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (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, 27 (CCPA

1976). See also *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).

The Goods

Turning first to our consideration of the recited goods, we must determine whether consumers are likely to mistakenly believe that they emanate from a common source. It is not necessary that the goods at issue be similar or competitive, or even that they move in the same channels of trade, to support a holding of likelihood of confusion. It is sufficient instead that the respective goods are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. See *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

In this case, the examining attorney has made of record a number of use-based third-party registrations which show that various entities have adopted a single mark for goods that are identified in both applicant's application and the cited registration. See, for example:

Registration No. 3143407 for, *inter alia*,  
concealer, facial masks and scrubs, foundations,  
blushes;

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Registration No. 3152908 for, *inter alia*, facial masks, concealers, skin foundations;

Registration No. 3079264 for, *inter alia*, masks, peels, blushes;

Registration No. 2727177 for, *inter alia*, foundation makeup, eye makeup, facial peels, masks;

Registration No. 3028108 for, *inter alia*, light peels, foundation, concealers; and

Registration No. 2944900 for, *inter alia*, foundation, blush, beauty masks, concealers for skin and face, eye makeup.

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, 1786 (TTAB 1993). In this case, the evidence of record supports a finding that the same marks are used to identify both applicant's goods and those of registrant. This evidence demonstrates the related nature of the goods at issue, and this *du Pont* factor favors a finding of likelihood of confusion.

Channels of Trade

Furthermore, it is settled that in making our determination regarding the relatedness of the parties' goods, we must look to the goods as identified in the

involved application and cited registration. 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, there are no restrictions in either applicant's or registrant's recitation of goods as to the channels of trade in which the goods may be encountered, or type or class of customer to which the goods are marketed. Thus, both applicant's and registrant's goods are presumed to move in all normal channels of trade and be available to all classes of potential consumers, including consumers of each others' goods. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

The Marks

We turn to the first *du Pont* factor, i.e., whether applicant's mark and registrant's mark are similar or dissimilar when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The test, under the first *du Pont* factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result.

In this case, applicant's mark,



is highly similar to registrant's mark, ILLUMINAIRE ENZYMATIC REVITALIZING MASK, in that applicant's mark is nearly identical in appearance to the most distinctive and dominant feature, namely, "ILLUMINAIRE," of the mark in the cited registration. It is a well-established principle 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 the ultimate conclusion rests on a consideration of the marks in their entireties. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

The significance of "ILLUMINAIRE" in registrant's mark is reinforced by its location as the first word in the mark. *See Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897) TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed in the mind of a purchaser and remembered"). *See also Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers must first notice the identical lead word). Further, in registrant's mark, the wording "ENZYMATIC REVITALIZING MASK" is disclaimed, and that wording at best is highly descriptive of registrant's goods and, as such, is subordinate to "ILLUMINAIRE." Thus, "ILLUMINAIRE," being the first word of registrant's mark, as well as the only portion thereof that is not disclaimed, is the dominant portion thereof, and the portion that is most likely to be remembered by purchasers.

As noted above, the dominant portion of the mark in the cited registration is nearly identical in appearance to applicant's mark. As to sound, it is settled that there is no correct way to pronounce a trademark. See *In re Belgrade Shoe*, 411 F.2d 1352, 162 USPQ 227 (CCPA 1969) and *Interlego AG v. Abrams/Gentile Entertainment Inc.*, 63 USPQ2d 1862 (TTAB 2002). See also *In re Microsoft Corp.*, 68 USPQ2d 1195 (TTAB 2003) (it is not possible to control how consumers will vocalize marks). Nonetheless, we find that because applicant's mark and the "ILLUMINAIRE" portion of registrant's mark are nearly identical in appearance and spelling, there is no reason why the marks would not be highly similar, if not identical, in pronunciation. See *In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214, 1217 (TTAB 2001). Thus, when taken as a whole, the marks are highly similar in sound. Furthermore, while the examining attorney and applicant have argued and introduced conflicting evidence regarding possible meanings of the marks, it is clear that both marks convey a sense of illumination resulting from the use of the products identified thereby. Thus, the marks are highly similar in connotations and convey highly similar overall commercial impressions.

Applicant contends that the mark in the cited registration is weak and thus entitled to a narrow scope of protection. In support of its argument, applicant has made of record copies of third-party registrations taken from the United States Patent and Trademark Office's Trademark Applications and Registrations Retrieval (TARR) database of several "ILLUMIN" formative marks for various cosmetics. We note, however, that the marks in these registrations are not as similar to either applicant's or registrant's marks as those marks are to each other. In addition, these third-party registrations do not prove that the marks are in use or that the public is familiar with them. See *The Conde Naste Publications, Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 184 USPQ 422, 424-25 (CCPA 1975). Thus, they are of limited probative value as to the asserted weakness of registrant's mark.

On balance, we find that consumers who are familiar with the mark, ILLUMINAIRE ENZYMATIC REVITALIZING MASK, used in connection with registrant's "skin care preparations, namely, beauty masks and peels," who then see applicant's mark used in connection with "cosmetics, namely, foundations, blushes, eye make-up and concealers," are likely to assume that the owner of registrant's mark has adopted that of applicant when using the mark in

connection with cosmetics. In other words, consumers are likely to view both marks as variations of each other, and therefore as indicators of a single source. Thus, despite the difference in appearance and the presence in registrant's mark of the wording "ENZYMATIC REVITALIZING MASK," the marks, when viewed as a whole, are highly similar in appearance, pronunciation, connotation and commercial impression. Accordingly, this *du Pont* factor also favors a finding of likelihood of confusion.

Conditions of Sale

Another *du Pont* factor discussed by applicant and the examining attorney is that of the conditions of sale. Applicant asserts that its goods are purchased by careful and sophisticated consumers. However, there is no evidence that either applicant's or registrant's goods are limited to purchase or use only by highly sophisticated persons. In the absence of any restrictions in the respective identifications of goods as to the classes of purchasers, we must presume that the goods of applicant and registrant may be purchased by all the usual classes of purchasers, including ordinary consumers. In addition, even sophisticated purchasers are not necessarily knowledgeable in the field of trademarks or immune from source confusion. *See In re Decombe*, 9 USPQ2d 1812, 1814-1815 (TTAB 1988).

Actual Confusion

Applicant also argues that there is no evidence of any actual confusion and that there has been concurrent use for seven years. We do not accord significant weight to applicant's contention, unsupported by any evidence, that there have been no instances of actual confusion despite contemporaneous use of the respective marks. The Federal Circuit has addressed the question of the weight to be given to an assertion of no actual confusion by an applicant in an ex parte proceeding:

With regard to the seventh DuPont factor, we agree with the Board that Majestic's uncorroborated statements of no known instances of actual confusion are of little evidentiary value. See *In re Bissett-Berman Corp.*, 476 F.2d 640, 642, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving testimony of appellant's corporate president's unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion). A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight, [citation omitted], especially in an ex parte context.

*Majestic Distilling*, 65 USPQ2d at 1205.

Accordingly, while examples of actual confusion may point toward a finding of a likelihood of confusion, an absence of such evidence is not as compelling in support of a finding of no likelihood of confusion. Thus, we cannot

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conclude from the lack of instances of actual confusion that confusion is not likely to occur.

Finally, to the extent that we have doubt, we have resolved our doubt, as we must, in favor of the prior registrant and against applicant. See *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992); *Ava Enterprises Inc. v. Audio Boss USA Inc.*, 77 USPQ2d 1783 (TTAB 2006); and *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844 (TTAB 2004). It is well established that one who adopts a mark similar to the mark of another for the same or closely related goods or services does so at his own peril. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed Cir. 1988); and *W.R. Grace & Co. v. Herbert J. Meyer Industries, Inc.*, 190 USPQ 308 (TTAB 1976).

Decision: The refusal of registration is affirmed.