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Decision Mailed:
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re On-Beauty Limited

Serial No. 78779336

Thomas F. Dunn of Morse, Barnes, Brown & Pendleton, P.C. for On-Beauty Limited.

James W. Ringle, Trademark Examining Attorney, Law Office 111 (Craig D. Taylor, Managing Attorney).

Before Seeherman, Hohein and Walters, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

On-Beauty Limited has filed an application to register on the Principal Register in standard character form the mark "PROTO-COL" for "cosmetics; cosmetic soaps; soaps for body care; perfumes, essential oils; hair lotions; toothpaste; skin moisturizer; facial beauty masks; body scrubs; non-medicated skin care preparations; non-medicated lip balms; beauty creams; body creams; cosmetic creams; facial creams; non-medicated skin creams; bath powder; body powder; bath gels; beauty gels; hair gels; shaving gels; non-medicated stimulating lotions for the skin; bathing lotions; beauty lotions; body lotions; non-medicated skin serums; massage oils; collagen based cosmetics;

dentifrices; mouthwashes; tooth whitening preparations; tooth cleaning preparations; denture cleaners; hair conditioners, hair care creams, hair care lotions, hair care preparations, nail care preparations, nail cream, nail enamels, nail polish, nail polish remover, nail strengtheners, hair emollients, [and] skin emollients" 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 "PATIENT PROTOCOL," which is registered on the Principal Register in standard character form for "skin and body care products, namely, cleansers, cleansing cremes, toners, exfoliation cremes, gels, skin lotions, liposomes extracts and creams for application to the skin, eye cremes, hand and body cremes and lotions, leg cremes and lotions and sun screens, creams for cellulite reduction and firming cremes" in International Class 3,[2] as to be likely to cause confusion, or to cause mistake, or to deceive.

Applicant has appealed and briefs have been filed. 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

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[1] Ser. No. 78779336, filed on December 22, 2005, which is based on an allegation of a bona fide intention to use the mark in commerce.

[2] Reg. No. 2,921,884, issued on February 1, 2005, which sets forth a date of first use anywhere and in commerce of October 1998. The word "PATIENT" is disclaimed.

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 of the goods at issue and the similarity or dissimilarity of the respective marks in their entireties.[3] See also In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). Here, inasmuch as the respective goods are identical in part (e.g., "body creams" (or "body cremes") and "body lotions") or otherwise overlap or are related (e.g., "non-medicated skin care preparations" encompass "skin and body care products, namely, cleansers, cleansing cremes, toners, ... gels, skin lotions, ... and creams for application to the skin"),[4] the primary focus of our inquiry

[3] 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.

[4] Applicant, in its brief, takes exception to the Examining Attorney's "determination that confusion is likely because 'both [applicant's goods and registrant's goods] would likely be sold at pharmacies or cosmetics counters at department stores.'" Specifically, applicant asserts that "[i]t is well-settled that the mere fact that two products sold with the same or a similar mark are sold in the same type of store, or even the same store, is an insufficient basis for finding confusion likely," citing various inapposite cases involving dissimilar goods. In a case such as this, however, likelihood of confusion is determined on the basis of the goods as they are identified in the application and the cited registration. See, e.g., Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987) and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Moreover, where, as here, the goods of an applicant and a registrant are broadly described as to their nature and type, it is presumed in each instance that in scope the application and cited

is accordingly on the similarities and dissimilarities in the marks at issue when considered in their entireties.

Turning thereto, we note as a preliminary matter that, "[w]hen marks would appear on virtually identical goods ..., the degree of similarity [of the marks] 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), *cert. denied*, 506 U.S. 1034 (1994). See also ECI Division of E-Systems, Inc. v. Environmental Communications Inc., 207 USPQ 443, 449 (TTAB 1980). Applicant, in this case, nonetheless contends in its brief that "the mere fact that PATIENT PROTOCOL and PROTOCOL [sic] share an element does not compel a conclusion of likely confusion" because, when considered in their entireties, "the marks are strikingly different visually, aurally, and connotatively." Asserting, in particular, that "registrant's mark contains the dominant leading PATIENT component," applicant argues that:

> Aurally, PATIENT PROTOCOL and PROTO-COL are sufficiently dissimilar to preclude confusion. The term PATIENT is wholly missing from the applicant's mark. Likewise, the alliterative "P" sounds in PATIENT PROTOCOL provide for a distinctive aural experience.

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registration respectively include not only all goods of the nature and type described therein, but that the identified goods are available through all channels of trade which would be normal for those goods and that they would be purchased by all potential buyers thereof. See, e.g., In re Elbaum, 211 USPQ 639, 640 (TTAB 1981). Thus, in light of the identity in part and overlap of the respective goods and the absence of any restrictions or limitations as to their channels of trade and classes of purchasers, such goods must be presumed to travel in the same channels of trade to the same customers. These factors therefore favor a finding of a likelihood of confusion.

> Visually, the leading dominant PATIENT component, coupled with the different appearance of the PROTOCOL and PROTO-COL components, render the applicant's mark readily distinguishable from the registrant's.
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> Finally, and perhaps most importantly, the applicant's unique spelling of PROTO-COL lends its mark a highly distinctive meaning. The COL component is an abbreviation for COLLAGEN, the main support material of skin, in connection with which the applicant's products are used. This wordplay renders the applicant's mark highly distinctive."

Contending further that "the PATIENT PROTOCOL mark for use with a 'protocol' of aftercare products on a 'patient' is so weak as to merit only the narrowest, and arguably no, scope of protection," applicant concludes that, "[t]aken together, the visual, aural and connotative differences between the two marks ... render the applicant's mark readily distinguishable from the registrant's such that the applicant's use of its mark is not likely to cause confusion in the market."[5]

While we agree with applicant that differences in the respective marks are apparent upon a side-by-side comparison of the marks, we concur with the Examining Attorney that confusion is likely. Among other things, the Examining Attorney properly observes in his brief that:

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[5] Although applicant also refers to "the highly descriptive nature of the registrant's mark when contrasted with the highly distinctive wordplay in the applicant's mark," such a contention, as the Examining Attorney correctly points out in his brief, constitutes an improper collateral attack on the validity of the cited registration which will not be further considered. See, e.g., In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997), *citing* Cosmetically Yours, Inc. v. Clairol Inc., 424 F.2d 1385, 165 USPQ 515, 517 (CCPA 1970) and In re Calgon Corp. 435 F.2d 596, 168 USPQ 278, 280 (CCPA 1971).

> [T]he test of likelihood of confusion is not whether the marks [at issue] can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall commercial impression. *Recot*[] *Inc. v. M.C. Becton*, 214 F.[3]d 1322, 54 USPQ2d 1894, 189[9] (Fed. Cir. 2000); *Visual Information Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179 (TTAB 1980). 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 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP §1207.01(b).

Moreover, the Examining Attorney also correctly notes that, while the marks at issue must be considered in their entireties, including consideration of any descriptive and/or generic matter therein, our principal reviewing court has indicated 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 entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For instance, according to the court, "[t]hat 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" and that, "[i]ndeed, this type of analysis appears to be unavoidable." 224 USPQ at 751. See also In re Dixie Restaurants Inc., supra.

Here, we concur with the Examining Attorney that, in view of the descriptiveness of the term "PATIENT" as evidenced by

the disclaimer thereof in the cited registration for registrant's "PATIENT PROTOCOL" mark, it is the word "PROTOCOL" which constitutes the principal source distinguishing element of registrant's mark. Such word is essentially identical to applicant's "PROTO-COL" mark and, when used in connection with the descriptive term "PATIENT" to form the mark "PATIENT PROTOCOL," such mark is substantially similar overall in sound, appearance and connotation to applicant's mark "PROTO-COL." Although, perhaps, some customers for applicant's goods would regard the element "COL" in applicant's mark as suggestive of the term "collagen," especially as to those of its goods which are for use on or in connection with the skin,[6] we agree with the Examining Attorney that other "consumers are unlikely to perceive such reference." In consequence thereof, applicant's mark, as contended by the Examining Attorney, would appear to such consumers "to be nothing more than a slightly novel spelling of the otherwise familiar term 'PROTOCOL.'"

Furthermore, nothing in this record demonstrates that marks which consist of or include the term "PROTOCOL" or variants thereof are so weak as to merit only the narrowest scope of protection. There is no evidence, in particular, to support applicant's assertion that registrant's "PATIENT PROTOCOL mark for use with a 'protocol' of aftercare products on a 'patient' is so weak as to merit only the narrowest, and arguably no, scope of

[6] We note in this regard that the record contains no proof that the term "col," as asserted by applicant, is commonly understood as an abbreviation for the word "collagen."

protection,"[7] either in the sense of being highly suggestive of the goods in connection with which the mark is used[8] or there being extensive use in the marketplace by third parties of other marks containing the term "PROTOCOL" in connection with the same or similar goods. While, at best, use of the word "PROTOCOL" in applicant's and registrant's marks is arguably suggestive of, for example, skin care preparations and products which are devised to be used in a particular skin-care regimen, both marks convey

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[7] While applicant, with its request for reconsideration, submitted a copy of excerpts from registrant's website along with a copy of the specimen of use from registrant's registration to show, as recounted in the Examining Attorney's brief, that "applicant's research ... [reveals that] the use of the mark by registrant is limited to 'after care' products that differ from those identified in the registration, and that[,] as a result, the goods ... [at issue] are readily distinguishable," the Examining Attorney accurately points out that:

> Registrant has not limited its identification of goods to a particular type of "after care" product distinguishable from applicant's goods. The presumption under Trademark Act Section 7(b), 15 U.S.C. §1057(b), is that registrant is the owner of the mark and that use of the mark extends to all goods ... identified in the registration. Further, registrant has not limited its identification of goods as to their location of sale. The presumption also implies that registrant operates in all normal channels of trade and reaches all classes of purchasers of the identified goods .... *RE/MAX of America, Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964-[6]5 (TTAB 1980). Thus, there is no limitation to registrant's trade channels and applicant's goods could reach the same purchasers in the same trade channels.

[8] For instance, we judicially notice in this regard that The American Heritage Dictionary of the English Language (4th ed. 2000) defines "protocol" as a noun meaning: "**1.a.** The forms of ceremony and etiquette observed by diplomats and heads of state. **b.** A code of correct conduct: *safety protocols; academic protocol.* **2.** The first copy of a treaty or other such document before its ratification. **3.** A preliminary draft or record of a transaction. **4.** The plan for a course of medical treatment or for a scientific experiment. **5.** *Computer Science* A standard procedure for regulating data transmission between computers." It is well settled that the Board may properly take judicial notice of dictionary definitions. See, e.g., Hancock v. American Steel & Wire Co. of New Jersey, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and Marcal Paper Mills, Inc. v. American Can Co., 212 USPQ 852, 860 n.7 (TTAB 1981).

substantially the same overall commercial impression when used in connection with the goods at issue. Neither the descriptive word "PATIENT" in registrant's "PATIENT PROTOCOL" mark nor the hyphenated spelling of applicant's "PROTO-COL" mark are considered sufficient to distinguish such marks so as to preclude a likelihood of confusion, particularly when used in connection with identical and otherwise related goods.

Accordingly, we conclude that purchasers who are familiar or otherwise acquainted with registrant's "PATIENT PROTOCOL" mark for, among other items, "body cremes," "body lotions" and "skin and body care products, namely, cleansers, cleansing cremes, toners, ... gels, skin lotions, ... and creams for application to the skin," would be likely to believe, upon encountering applicant's substantially similar "PROTO-COL" mark for, *inter alia*, "body creams," "body lotions" and "non-medicated skin care preparations," that such identical in part and otherwise commercially related goods emanate from, or are sponsored by or affiliated with, the same source. Consumers could reasonably believe, for instance, that applicant's "PROTO-COL" products constitute a new or additional line of body creams, body lotions and other non-medicated skin care preparations from the same source as registrant's "PATIENT PROTOCOL" body cremes, body lotions and other skin and body care products and vice versa. To the extent, however, that there may be any doubt as to our conclusion in this regard, we resolve such doubt, as we must, in favor of the registrant. See, e.g., In re Chatam

International Inc., 380 F.3d 1340, 71 USPQ2d 1944, 1948 (Fed. Cir. 2004); In re Hyper Shoppes (Ohio), Inc., 837 F.2d 840, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988); In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 156, 223 USPQ 1289, 1290 (Fed. Cir. 1984; and In re Pneumatiques Caoutchouc Manufacture et Plastiques Kleber-Columbes, 487 F.2d 918, 179 USPQ 729, 729 (CCPA 1973).

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