

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

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Marketing Fundamental, Inc.

Serial No. 78856851

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for Marketing Fundamental, Inc.

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112 (Angela B. Wilson, Managing Attorney).

Before Seeherman, Holtzman and Kuhlke, Administrative
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Marketing Fundamental, Inc. seeks registration on the
Principal Register of the mark shown below for goods
identified as "beauty creams for body care; body and beauty
care cosmetics; cosmetic creams for skin care; cosmetics;
face creams for cosmetic use; lotions for face and body
care; lotions for skin care; make-up kits comprised of
cosmetics; non-medicated skin creams; skin cleansers; skin
creams; skin lightening creams; skin lotions; skin

moisturizer; skin whitening creams" in International Class 3.¹



Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used with its identified goods, so resembles the registered mark GENJI, in typed form, for "colognes," in International Class 3, as to be likely to cause confusion, mistake or deception.²

When the refusal was made final, applicant appealed and filed a request for reconsideration. On November 29, 2007, the examining attorney denied the request for reconsideration. Thereafter, the appeal was resumed and fully briefed. We affirm the refusal to register.

As a preliminary matter, in its brief, applicant requested that the application be remanded because "applicant was not afforded the opportunity to establish that the mark has acquired distinctiveness through continuous, exclusive and distinctive use" and "applicant

¹ Application Serial No. 78856851, filed April 7, 2006, alleging first use on July 1, 2001 and first use in commerce on July 7, 2001 under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a).

² Registration No. 1143838, issued December 23, 1980, renewed.

is a world leader in the sale of skin and beauty creams and can provide supporting evidence of this fact." Br. p. 12.

First, we point out that a request for remand should be filed as a separate paper, appropriately captioned, rather than being included in the body of a brief. Further, applicant has made its request in the alternative, should the Board not be persuaded of the mark's registrability, and has not attempted to submit the evidence for which remand is conditionally sought, stating only that if the Board would consider such evidence probative, it will submit it. Applicant is advised that, once a decision is rendered on appeal, the application cannot be reopened for the purpose of submitting additional evidence. See Trademark Rule 2.142(g). Moreover, remand may be granted upon a showing of good cause, and the later in the appeal proceeding that the request for remand is filed the stronger the reason needed for a finding of good cause. In re Zanova Inc., 59 USPQ2d 1300, 1302 (TTAB 2001); and In re Central Sprinkler Co., 49 USPQ2d 1194, 1194 n.2 (TTAB 1998) (applicant's request for remand made in its appeal brief in order to allow examining attorney to consider additional third-party registrations denied because such evidence could have been submitted earlier in the prosecution).

The question of acquired distinctiveness is not in issue in this appeal. Further, even if such evidence would be relevant to the refusal based on likelihood of confusion, applicant has not submitted a showing as to why such evidence could not have been submitted earlier in the proceeding. In view thereof, applicant has not demonstrated good cause for remand, and applicant's request is denied.

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, two key considerations are the similarities between the marks and the similarities between the goods and services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We turn first to a consideration of the goods identified in the application and the cited registration. It is well settled that goods need not be similar or competitive in nature to support a finding of likelihood of confusion. The question is not whether purchasers can

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differentiate the goods themselves, but rather whether purchasers are likely to confuse the source of the goods. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). Further, we must consider the cited registrant's goods as they are described in the registration and we cannot read limitations into those goods. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987). If the cited registration describes goods broadly, and there is no limitation as to the nature, type, channels of trade or class of purchasers, it is presumed that the registration encompasses all goods of the type described, that they move in all channels of trade normal for these goods, and that they are available to all classes of purchasers for the described goods. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992).

In support of his contention that the goods are related, the examining attorney submitted several third-party use-based registrations where the various cosmetic and skin care items identified in applicant's application, and the cologne identified in the registrant's registration, have been registered by the same entity under

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a common mark. See, e.g., Reg. No. 3326057 for the mark LOVE CHIC BABY for, inter alia, cosmetics, creams, lotions, skin moisturizers and cologne; Reg. No. 3313740 for the mark PHINOMENAL for, inter alia, cologne, cosmetics and makeup; Reg. No. 3245475 for the mark THE SCENT OF PEACE for, inter alia, cologne, body lotions and makeup; Reg. No. 3326386 for the mark ADENOGEN for, inter alia, body creams, body lotions, cologne, cosmetics and makeup; and Reg. No. 3309098 for the mark SKIN3 CUBED for, inter alia, beauty cream for body care, body and beauty care cosmetics, cologne, cosmetic rouges, lipstick and skin moisturizers. These registrations serve to suggest that cologne, and cosmetics and skin care preparations, would be sold by the same entity under a common mark. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). We find this evidence sufficient to establish the relatedness of the involved goods in this case.

With regard to the channels of trade, inasmuch as there are no limitations in the cited registration or the application and the goods are closely related, we must presume that applicant's and registrant's goods will be sold in some of the same channels of trade and will be bought by some of the same classes of purchasers. See

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Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and In re Smith and Mehaffey, 31 USPQ2d 1531 (TTAB 1994). Thus, applicant's unsupported arguments regarding its actual channels of trade and attempts to limit registrant's channels of trade fail inasmuch as one may not restrict the scope of goods in an otherwise unlimited identification. See In re Bercut-Vandervoort & Co., 229 USPQ 763, 764 (TTAB 1986).

In view of the above, the du Pont factors of the relatedness of the goods and the channels of trade favor a finding of likelihood of confusion as to the mark in the cited registration.

We turn now to the first du Pont factor, i.e., whether applicant's mark GINGI and design and registrant's mark GENJI are similar or dissimilar when compared in their entireties in terms of appearance, sound, connotation and commercial impression. The analysis is not whether the marks can be distinguished when compared side-by-side. Rather, we must determine whether the marks are sufficiently similar that there is a likelihood of confusion as to source and, in making this determination, we must consider the recollection of the average purchaser who normally retains a general, rather than specific,

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impression of trademarks. Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106, 108 (TTAB 1975).

Applicant argues that "GINGI is pronounced as "GIN' and 'G,' whereas no evidence is advanced to show that the Cited Registration is pronounced similarly or as another name such as 'GIN' and 'JAY' or 'JI.'" Br. p. 5. However, it is well established that in making our determination we must recognize that there is no correct pronunciation of a trademark that is not an ordinary word; thus, a "correct" pronunciation cannot be relied on to avoid a likelihood of confusion. Centraz Industries Inc. v. Spartan Chemical Co. Inc., 77 USPQ2d 1698, 1701 (TTAB 2006). GINGI and GENJI certainly could be pronounced in a similar manner, with all the 'G's' pronounced like 'j' or with the first 'G' pronounced as a hard 'g.'

As to appearance, there are similarities in that the literal portion of both marks consists of five letters, begins with G, has N in the middle and ends with I. Moreover, because of the stylization in applicant's mark the second lower case g could appear as a lower case j. Trademarks may be confusingly similar in appearance despite the addition, deletion or substitution of letters. Weiss Associates Inc. v. HRL Associates, Inc., 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (TMM held confusingly similar

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to TMS, both for software); Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, supra (COMMCASH held confusingly similar to COMMUNICASH, both for banking services).

Applicant's argument that the black rectangular background with two dots dominates over the literal portion GINGI is not tenable. The design in the mark is minimal and does not present a sufficient difference to distinguish the marks. See *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987) (greater weight is often given to the word, because it is the word that purchasers would use to refer to or request the goods).

In its first response (March 27, 2007), applicant argued that "it appears that GENJI is a simple Japanese translation relating to an ancient tribe"; however, applicant did not present any evidence with regard to this meaning. In its brief, applicant elaborates on this idea and argues that "generic phrases can potentially have multiple meanings" and "owners of marks employing common names such as 'GENJI' are not afforded broad protection over the use of a similar mark because of the number of varying definitions that are potentially available." Br. p. 6. Applicant concludes that "GENJI has multiple meanings as found in ancient Japanese Samurai novels and

should not be viewed as confusingly similar to the Applicant's mark, which specifically is an arbitrary name and unique name." Br. p. 8.

First, to the extent applicant is arguing that GINGI and GENJI have different connotations, there is nothing in the record to support either the asserted meaning of GENJI or that general consumers would recognize this meaning and if so distinguish the transliteration GENJI from GINGI as another possible transliteration.

To the extent applicant is arguing that GENJI is a generic or common term, there is nothing in the record to indicate that it is generic for or commonly used in connection with cologne. In fact, the meaning proffered by applicant supports a finding that it is arbitrary for cologne.

Overall we find that the marks GINGI and design and GENJI are similar in appearance, sound and, as far as this record shows, connotation, and they convey a very similar commercial impression. Therefore, the factor of the similarity of the marks weighs in favor of likelihood of confusion.

Applicant's arguments regarding the fourth du Pont factor, i.e., the conditions under which and buyers to whom sales are made, i.e., impulse versus careful, sophisticated

purchasing, do not lead us to a different conclusion.

Applicant argues that cosmetics are not inexpensive and "the person purchasing colognes and skin creams these days are [sic] so sophisticated as to not be confused." Br. p. 10. Further, applicant argues that although "cologne is an inexpensive product and available for purchase by unsophisticated buyers," the "remaining cosmetics industry is not" and applicant's products "are found in the presenter bags at the Oscars and Grammy's." Reply Br. p.

1. While applicant's actual goods may be expensive and less susceptible to impulse purchasing, as noted above, there are no limitations in the identification in the application, and thus, as identified, applicant's goods could include inexpensive skin creams and cosmetics.

Moreover, to the extent more care is exercised in the purchase of cosmetics and skin cream, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. See *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). We find that this factor does not weigh in favor of applicant.

Applicant argues that its "Registered Mark and the Cited Registrations have coexisted as Registered Trademarks

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for over five years without any actual confusion between the respective marks and/or the associated goods or services" and "the lack of any actual confusion adds to the argument that the Applicant's mark and the Cited Registration are not confusingly similar enough to warrant a refusal." Br. p. 11.

First, there is nothing in the record to show that there has been a meaningful opportunity for such confusion to have occurred. More importantly, in the context of an ex parte proceeding, "the lack of evidence of actual confusion carries little weight." *Majestic Distilling*, supra, 65 USPQ2d at 1205.

Finally, applicant argues that "there is no question that the trademark professionals at the Trademark office have found the GINGI mark to be allowable over (and thus not likely to be confused with) GENJI." Br. p. 10. Applicant is referencing its claimed prior registration for the mark GINGI (in typed form) for "cosmetics and non-medicated skin care preparations." Reg. No. 2555977. We first note that the mark and goods in the application are not identical to those in the prior registration. While the registration is over five years old and is incontestable pursuant to Section 15 of the Trademark Act, 15 U.S.C §1065, this has no effect on the question of

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registrability (as distinguished from use) of a mark. See *In re Save Venice New York Inc.*, 259 F.3d 1346, 59 USPQ2d 1778, 1782 (Fed. Cir. 2001) ("A registered mark is incontestable only in the form registered and for the goods or services claimed"); and *In re Best Software Inc.*, 63 USPQ2d 1109, 1112 (TTAB 2002). As stated by the Board in *In re BankAmerica Corp.*, 231 USPQ 873, 876 (TTAB 1986):

The cases are legion holding that each application for registration of a mark for particular goods or services must be separately evaluated. See, for example, *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865, 869 (Fed. Cir. 1985) [other citations omitted]. Section 20 of the Trademark Act, 15 USC Section 1070, gives the Board the authority and duty to decide an appeal from an adverse final decision of the Examining Attorney. This duty may not be delegated by adoption of conclusions reached by Examining Attorneys on different records.

Thus, the question of likelihood of confusion of the mark for the goods identified in applicant's registration vis-à-vis the mark for the goods in the cited registration is a different issue from the likelihood of confusion of the mark for the goods identified in applicant's application vis-à-vis the mark for the goods in the cited registration. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). The mark in the application is different from the mark in the prior registration. The fact that applicant has registered the

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mark GINGI in typed form simply means that applicant is not claiming rights in any particular style of lettering for that mark. While the protection accorded to the registration is not limited to a particular type of script, it does not provide applicant with the right to register any form of the mark GINGI regardless of the registrability questions that may be raised thereby. "Suffice it to say that each case must be decided on its own merits based on the evidence of record. We obviously are not privy to the record in the files of the registered marks and, in any event, the issuance of a registration(s) by an Examining Attorney cannot control the result of another case." In re Sunmarks Inc., 32 USPQ2d 1470, 1472 (TTAB 1994).

In conclusion, we find that because the marks are similar, the goods are related, and the channels of trade and purchasers overlap, confusion is likely between applicant's mark and the mark in the cited registration.

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed.