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Hearing:  
08 NOV 2001

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Paper No. 38  
AD

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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Beaute Prestige International  
v.  
OroAmerica, Inc. and  
Aurafin-OroAmerica LLC<sup>1</sup>

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Opposition No. 109,130  
to application Serial No. 75/252,794  
filed on March 6, 1997  
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Donald L. Dennison for Dennison, Scheiner, Schultz &  
Wakeman for Beaute Prestige International.

Marc J. Kesten of Aurafin-OroAmerica, LLC for OroAmerica,  
Inc.

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Before Walters, Rogers, and Drost, Administrative  
Trademark Judges.

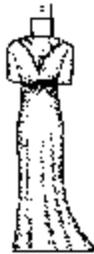
Opinion by Drost, Administrative Trademark Judge:

OroAmerica, Inc. (applicant) has applied to register  
the mark shown below for goods identified as "health and  
beauty products, namely, hair shampoos and conditioners,

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<sup>1</sup> Aurafin-OroAmerica LLC is now the owner of the involved  
application as a result of a merger. The change in ownership is  
recorded with the Office at Reel/Frame No. 2365/0761.

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personal deodorants, sun block, bar soaps, skin creams, skin lotions, and skin toners, lipsticks, nail polish, mascara, baby lotion, baby powder, baby shampoos, moisturizing lotion and lubricating lotion for the skin, facial masks, after shave lotions and perfumes, colognes, bath products, namely, bubble bath and bath crystals, foam, gels, powder, and non-medicated bath salts, suntanning lotion and creams, mouthwash, dentrifices and breath fresheners and non-medicated foot bath preparations" in International Class 3."<sup>2</sup>



Beaute Prestige International (opposer) has opposed registration on the ground that applicant's mark, when used on or in connection with the identified goods, so resembles opposer's previously used and registered marks shown below:

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Therefore, the new owner has been added as a party defendant, and the caption of this proceeding amended accordingly.

<sup>2</sup> Serial No. 75/252,794, filed March 6, 1997. The application is based on applicant's allegation of a bona fide intention to use the mark in commerce. The stippling is a feature of the mark and does not indicate color. The mark is described as a "woman in evening gown fragrance bottle design."



'555 reg.



'775 reg.

for "women's fragrance products, namely, perfume and eau de

toilette" in International Class 3.<sup>3</sup>

Applicant has denied the salient allegations of the notice of opposition.<sup>4</sup>

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<sup>3</sup> Registration Nos. 2,078,555, issued July 15, 1997 and 2,080,775 issued July 22, 1997. The stippling in the '555 registration "is for shading purposes and to represent a frosted appearance" and "the lining in the drawing [in the '775 registration] is for shading purposes only and is not intended to represent color." While opposer has not submitted a status and title copy for its registrations, opposer's witness has testified that the registrations are owned by opposer and that products with those designs are still sold by opposer. Laxenaire dep., pp. 19, 21, 23-25. 37 CFR 2.122(d)(2); TBMP § 703.02. Both marks are registered on the Principal Register without relying on the provisions of Section 2(f), 15 U.S.C. § 1052(f), of the Trademark Act. While opposer also argues (Br. at 9-11) that its mark is inherently distinctive, for the purposes of this opposition proceeding, the registrations are presumed valid. 15 U.S.C. § 1057(b). No additional argument or evidence is necessary.

<sup>4</sup> Opposer's Brief (p. 4) refers to Registration No. 2,141,962 (shown below). However, this registration was not identified in its Notice of Opposition. Opposer's counsel explained that "[t]he only reason we brought the male torso in is just to show that it does appear in advertising occasionally together with the female torso. But it's not being relied upon really as part of the opposition." Laxenaire dep., p. 62.

The Record

The record consists of the file of the involved application and the trial testimony deposition of opposer's French intellectual property counsel Sandrine Laxenaire, with accompanying exhibits.

Both parties have filed briefs. An oral hearing was requested by opposer who was the only party to appear for the hearing held on November 8, 2001.<sup>5</sup>

Preliminary Matters

Before we consider the likelihood of confusion question, we must address several issues applicant has raised in its brief. First, applicant has objected to opposer's introduction of Exhibits 26 and 27 because these documents are "irrelevant, not authenticated nor certified and because judgment is not only from a foreign tribunal, but it is also under appeal." Applicant's Br. at 1. We agree with applicant that "decisions of foreign courts in lawsuits involving a different evidentiary record and based upon different laws are irrelevant to

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the issue before us." Miles Laboratories, Inc. v. International Diagnostic Technology, Inc., 220 USPQ 438, 445 (TTAB 1983). See also Puma-Sportschuhfabriken Rudolf Dassler, K.G. v. Superga S.p.A., 204 USPQ 688, 690 n.3 (TTAB 1979) (Decisions of German courts "are of no probative value").<sup>6</sup> While we normally do not consider decisions of foreign tribunals, even if we were to consider this decision, inasmuch as the decision is on appeal and it involves different laws, it would not affect the outcome in this case. We must determine the question of likelihood of confusion based on U.S. trademark law.

In its brief, applicant requests that the Board strike the testimony of opposer's witness Sandrine Laxenaire as an expert because opposer failed to show that she was qualified to testify as an expert. Applicant's request to strike the testimony contained in its appeal brief is untimely. 37 CFR 2.123(e)(3) (Motion to strike must be filed "[p]romptly after the testimony

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<sup>5</sup> In an order faxed on November 7, 2001, the Board denied applicant's request to conduct a hearing by telephone.

<sup>6</sup> However, applicant's failure to object to the lack of authentication and certification of the decision is waived because applicant failed to object to the documents when they were introduced when opposer could have obviated or removed the objection at that time. 37 CFR 2.123(k); Fed. R. Civ. P. 32(d)(3)(A). Even if the objection was not waived, opposer's

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is completed"). In addition, "[o]bjections to testimony depositions on grounds other than the ground of untimeliness, or the ground of improper or inadequate notice, generally should not be raised by motion to strike." TBMP § 534.03. To the extent applicant's request to strike is considered an objection to the testimony, the objection should have been raised at the time of the testimony because it could have been cured at that time. TBMP § 718.04. Finally, even if we consider applicant's request to strike as an objection to opposer's witness testimony, it appears that Laxenaire testified primarily as a fact witness and not as an expert witness. Opposer maintains that the witness "was never presented as an expert witness." Reply Br. at 2. We generally agree with opposer that the witness testified as a fact witness and applicant's objection is not well taken.<sup>7</sup>

Applicant also argues that because of a prior U.S. design patent (D102,172), which it requests we take

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witness did authenticate the exhibits during her testimony. Laxenaire dep. at 69-74, 97. Fed. R. Evid. 901(a) and (b)(1).<sup>7</sup> Opposer did ask the witness: "In your opinion as an expert attorney in the intellectual property field in France, what is the effect on the trade of the OroAmerica bottle in the United States." Laxenaire dep. at 73. Inasmuch as opposer does not assert that its witness is an expert, we will not consider the witness's answer to this question that was clearly posed to the witness as an expert.

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judicial notice of (Applicant's Br. at 2), opposer's two registrations should be cancelled since opposer's design is in the public domain. Applicant's Br. at 6. The Board "does not take judicial notice of the records of this Office" and we will not take judicial notice of the design patent to which applicant refers. In re The Clausen Co., 222 USPQ 455, 456 n.2 (TTAB 1984); International Association of Lions Clubs v. Mars, Inc., 221 USPQ 187, 189 n.8 (TTAB 1984) (same). More importantly, an applicant cannot attack the validity of an opposer's registration in an opposition proceeding. It must petition to cancel the opposer's registrations. In this case, applicant did petition to cancel these registrations and on May 7, 2001, the Board granted opposer's uncontested motion to dismiss these cancellations with prejudice. (Paper No. 28). Therefore, applicant cannot collaterally attack opposer's registrations in this opposition proceeding. Contour Chair-Lounge Co. v. The Englander Co., 324 F.2d 186, 139 USPQ 285, 287 (CCPA 1963) ("[T]his is an opposition only and in an opposition, this court has always held that the validity of the opposer's registrations are not open to attack"); Cosmetically Yours, Inc. v. Clairol, Inc., 424 F.2d 1385, 165 USPQ 515, 517 (CCPA 1970) ("As long as the

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registration relied upon by an opposer in an opposition proceeding remains uncanceled, it is treated as valid and entitled to the statutory presumptions"). Therefore, we will not consider applicant's argument that we should cancel opposer's registrations because the designs are in the public domain.

Priority

Priority is not an issue here in view of opposer's ownership of Registration Nos. 2,078,555 and 2,080,775. See King Candy Co. v. Eunice King's Kitchen, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Likelihood of Confusion

Now, we turn to the central issue in this case which is whether eventual use of applicant's mark would be likely to create confusion, given the existence of the marks in opposer's two registrations. To determine whether there is a likelihood of confusion, the Court of Customs and Patent Appeals, one of the predecessor courts of the Court of Appeals for the Federal Circuit, articulated thirteen factors to consider in the case of In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes

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to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Opposer's arguments on the likelihood of confusion issue are set out below:

Opposer's Registrations are the only evidence of record showing the use as a trademark of a spray bottle for cosmetics and particularly fragrances in the shape of a headless and armless torso of a woman. Opposer's registrations show several forms of this design, each of which are [sic, is] visually recognized as representing Opposer's goods. Registration 2,078,555 shows that the corset in the design has a frosted appearance. This same frosted appearance is apparent in Applicant's headless and armless torso body also having a deep V bustline in common with that of the Opposer. Clearly, the marks look alike to the consumer; especially considering the specific goods involved herein which are usually displayed on shelves and counters of stores selling cosmetics and fragrances. It is obvious that the marks are similar as to appearance, connotation and commercial visual impression. Further, there is no evidence of similar marks in use or on the register for similar goods. See the benchmark standards set by the Court of Customs and Patent Appeals in the landmark case of In re du Pont de Nemours & Co. (CCPA 1973) 177 USPQ 563.

Opposer's Br. at 8-9.

Applicant responds by arguing that applicant's bottle design "is not that of a female torso, it is an entire figure of a woman (without a head). The female figure in Applicant's bottle design is not wearing a corset nor is it buxom. Applicant's bottle design is a

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relatively flat-chested woman wearing an evening dress; a classier depiction of the female form than Opposer's female torso." Applicant's Br. at 4. Applicant further argues that opposer is seeking to "exclude all other[s] from designing and making perfume bottles that resemble the female form (whether it be a torso, full-bodied, etc.)." Applicant's Br. at 6.

In this case, both parties' identifications of goods include the identical goods "perfume." Therefore, we must assume that these goods move through the same channels of trade to the same purchasers. Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987). Because the marks are used on identical goods, there is a greater likelihood that when similar marks are used in this situation, confusion would be likely. Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992) ("When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines"). These factors favor opposer.<sup>8</sup>

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<sup>8</sup> Also, opposer has had some modest success with marketing its goods under its registered trademarks. The record shows, for example, that opposer's sales in the United States in 1995 were

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The next factor concerns the similarity or dissimilarity of the marks as to appearance, sound, connotation, and commercial impression. Since the marks in this case are design marks, they would not be pronounced. We must determine if they are similar based on a visual comparison. In re Brundy Corp., 300 F.2d 938, 133 USPQ 196, 197 (CCPA 1962) (“[T]he case must be decided primarily on the basis of the visual similarity of the marks. The marks are not word marks and are not capable of being spoken”); Daimler-Benz Aktiengesellschaft v. Chrysler Corp., 169 USPQ 686, 688 (TTAB 1971) (“The trademarks involved herein are design or symbol marks and thus this case must be decided primarily on the basis of their visual impressions”). We do not engage in a side-by-side comparison of the trademarks to identify differences, but rather we look to “the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks.” Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106, 108 (TTAB 1975).

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approximately \$1.9 million and that several celebrities attended the introduction of its products in New York. Laxenaire Dep. at 53-56, 59; Ex. 21 and 22. Applicant questions the significance of opposer’s sales and the sporadic nature of opposer’s advertising. Applicant’s Br. at 5. We agree that opposer’s evidence of limited sales and promotional activities does not significantly favor a determination that confusion is likely.

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When we compare the designs, it is apparent that there are few similarities between the designs besides the most general ones. All of the designs are headless representations of the female form. Besides that general similarity, the figures are dressed differently and they look different.



Applicant



Opposer '555



Opposer '775

Applicant's design consists of a woman wearing an evening dress, without forearms or a head. Opposer's design is a female figure in a corset, without arms, legs, or a head. Both parties have chosen to use a female figure as the basis for their respective designs. Inasmuch as the goods of both parties would include perfume for females, the female shape is hardly an arbitrary design when applied to women's perfume. Red Carpet Corp. v. Johnstown American Enterprises Inc., 7 USPQ2d 1404, 1406 (TTAB 1988) (Stylized designs of houses not similar; "[t]his element is suggestive of a key

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element involved in the real estate services of both applicant and opposer").

As opposer notes, one of its registration's ('555) utilizes a frosted appearance and the stippling in applicant's mark may represent a similar frosted appearance. Opposer argues that applicant's and opposer's figures have a "V" neckline. While it is true that both designs can be said to have a "V" neckline, the necklines themselves and the clothing featuring these necklines are dissimilar. The figure in applicant's design is wearing a full-length evening gown that covers the shoulders to form a classic "V." Opposer's figure is wearing a corset with a less dramatic "V" and the corset does not cover the figure's shoulders.

Merely because the marks have the same common feature, a woman without a head, it does not mean confusion is likely when the other features of the marks are so different. See Brundy, 133 USPQ at 197, marks shown at, 125 USPQ 497 (TTAB 1960) (Even though both marks consist of a stylized letter "B," CCPA held that there was no likelihood of confusion). On the other hand, when the designs' features result in the same visual appearances, there would be a likelihood of confusion. See In re Calgon Corp., 435 F.2d 596, 168

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USPQ 278 (CCPA 1971) (Confusion found when both designs consisted of a woman in a bathtub). Here, we conclude that the marks are significantly different.

After we consider all the du Pont factors and the evidence of record, we determine that there is no likelihood of confusion. Likelihood of confusion is decided upon the facts of each case. In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997); In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993). The various factors may play more or less weighty roles in any particular determination of likelihood of confusion. 992 F.2d at 1206, 26 USPQ2d 1688; du Pont, 476 F.2d at 1361, 177 USPQ at 567.

While the goods of the parties are legally identical<sup>9</sup>, the goods would be sold in the same stores, and the goods would be sold to the same customers, the marks of the parties are distinctly different. The differences are so pronounced and the similarities so tenuous that confusion is unlikely, and opposer cannot prevail.

Decision: The opposition is dismissed.

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<sup>9</sup> Applicant's professed intent to use this "bottle design" as a mark for goods such as bar soaps, lipstick, mouthwash, and

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dentifrices does not alter the fact that both parties use or, in applicant's case, intend to use, their marks for perfume.