

THIS DISPOSITION IS
NOT CITABLE AS PRECEDENT
OF THE TTAB

Mailed: June 17, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Origins Natural Resources Inc.

v.

Robin E. Lendrum

Opposition No. 91115859
to application Serial No. 75548543
filed on September 8, 1998

Patrick T. Perkins of Fross Zelnick Lehrman & Zissu, P.C.
for Origins Natural Resources Inc.

James B. Brady of Young & Basile, P.C. for Robin E. Lendrum.

Before Quinn, Chapman and Bucher, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

Origins Natural Resources Inc. (a Delaware corporation)
has opposed the application of Robin E. Lendrum (an
individual, United States citizen) to register on the
Principal Register the mark ORIGINAL SIN for goods amended
to read "ladies perfume and cosmetics, namely, makeup,
rouge, lipstick, mascara, facial cleansers, facial and skin

Opposition No. 91115859

moisturizers, skin exfoliants, nail polish, eyeliner, blush, and eyeshadow" in International Class 3.¹

Opposer asserts as grounds for opposition that since 1976 opposer and its predecessor have manufactured, distributed and sold a wide variety of goods, including "cosmetics, skin care products, cleansers, exfoliants, lotions and other beauty products" under the mark ORIGINS and other marks derived from the word "ORIGIN"; that opposer's goods are sold through opposer's own stores which are located across the United States, department stores, mail order catalogs and over the Internet; that continuously since 1993 opposer has manufactured, distributed and sold foundations, pressed and loose powders and concealers under the mark ORIGINAL SKIN; that opposer owns Registration No. 1860236 for the mark ORIGINAL SKIN for "makeup foundation";² and that applicant's mark, when used on his goods, so resembles opposer's previously used and registered mark, as to be likely to cause confusion, mistake, or deception.

In his answer applicant denies the salient allegations of the notice of opposition.³

¹ Application Serial No. 75548543, filed September 8, 1998, based on applicant's assertion of a bona fide intention to use the mark in commerce on the identified goods.

² Registration No. 1860236, issued October 28, 1994, Section 8 affidavit accepted, Section 15 affidavit acknowledged.

³ Applicant's "affirmative defenses" are not affirmative defenses (see Fed. R. Civ. P. 8(c)), but are more in the nature of further information relating to his denials of opposer's likelihood of confusion claim.

Opposition No. 91115859

The record consists of the pleadings; the file of applicant's involved application; the testimony, with exhibits of Daria Myers, a former senior vice president for global marketing for opposer; opposer's notice of reliance on (i) a status and title copy of its pleaded registration, (ii) applicant's answers to opposer's first set of interrogatories and document requests, and (iii) a dictionary definition of the term "original sin"; the testimony, with exhibits, of applicant, Robin E. Lendrum; and applicant's notice of reliance on (i) opposer's answers to applicant's first set of interrogatories and a few documents produced by opposer to applicant in response to applicant's documents requests,⁴ and (ii) printouts of twenty-three registrations from the USPTO's Trademark Electronic Search System (TESS).

Both parties filed briefs on the case.⁵ Neither party requested an oral hearing.

Opposer, Origins Natural Resources Inc., a division of Estee Lauder, sells, inter alia, skin care, hair care,

⁴ Each party submitted a notice of reliance on at least some of the adverse party's answers to document requests. While a notice of reliance is not normally a proper way to enter such documents into the record, in this case the Board considers that the parties have stipulated such documents into the record. See Trademark Rule 2.120(j)(3)(ii).

⁵ The briefs were filed in this case in 2001. The inordinate delay in deciding this case and any resulting inconvenience to the parties is regretted. (There is no indication in the record of any inquiry from either party as to the status of the case during the last few years.)

Opposition No. 91115859

makeup, and body care products. Opposer first used the mark ORIGINAL SKIN on makeup foundation, loose powder, and concealer in 1993, and such use has been continuous. Thereafter, in 1998 opposer added use of the mark ORIGINAL SKIN for a compact makeup foundation, and this use has been continuous. The mark was selected to fit in with the "Origins philosophy" by suggesting something about the product, while at the same time conveying a sense of lightheartedness and a fun point of view. Specifically, opposer intended "to make reference to the biblical term of 'Original Sin,' to have that play on words"; and "because the coverage from this makeup is natural ... we have this kind of play on words, where we say that our makeup is the most natural coverage since the fig leaf." (Myers dep., pp. 13 and 14, Exhibits 4 and 5, nationwide press release from the launch of the products and an advertisement from the first promotional campaign.)⁶ An advertisement announcing the 1998 launch of the pressed makeup begins with the phrase "Do you believe in Original Skin®?" (Opposer's Exhibit 6.)

Opposer has substantial annual sales (1994-2000) and has spent considerable sums on advertising.⁷ The ORIGINAL SKIN products are sold through department stores such as

⁶ Another item mentioned in opposer's Exhibit 4 is "Origins Forbidden Fruits for Lips."

⁷ Opposer submitted this information as confidential under seal, and thus, the actual numbers cannot be set forth herein.

Opposition No. 91115859

Nordstrom's, Macy's, Hecht's, Dayton's, and Dillard's; opposer's own freestanding ORIGINS retail stores; and on the Internet through opposer's website. These products are advertised on radio, in national magazines and newspapers (e.g., "Mademoiselle" and "Glamour") and through significant direct mailings.

Opposer's ORIGINAL SKIN products have been written about in several well-known beauty magazines such as "Harper's Bazaar," "Modern Bride" and "Seventeen."

Having pondered the concept since 1992, applicant filed an application to register the mark ORIGINAL SIN for ladies perfume and certain cosmetics in September 1998. As stated by applicant's attorney in his brief (p. 3): "Lendrum has testified that he intends to use the mark only for perfume. (Lendrum Dep. pp. 11-12). To date, he has not used the mark at all. (Dep. p. 6)." Applicant applied for the mark covering cosmetics as well as perfume because he plans on using the mark on fragrances and hopes to expand to other products that tie into fragrances. (Dep., pp. 6-7 and 10-11.) He has contacted companies, but has not reached the stage of negotiations to license or sell the mark. (Dep., p 10.)

In view of opposer's status and title copy of its pleaded registration for its ORIGINAL SKIN mark, the issue

Opposition No. 91115859

of priority does not arise in this opposition proceeding.⁸ See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974); *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272, at footnote 6 (CCPA 1972); and *Carl Karcher Enterprises, Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125 (TTAB 1995). Moreover, the record establishes opposer's use of its mark ORIGINAL SKIN for makeup foundation, loose powder, and concealer in 1993, well prior to the September 8, 1998 filing date of applicant's application. (Applicant testified that he has not yet used his mark.)

We turn now to consideration of the issue of likelihood of confusion. Our determination of likelihood of confusion is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of

⁸ Opposer submitted a proper status and title copy of its pleaded registration with its notice of reliance (timely filed in October 2000). In this regard, when a registration owned by a party has been properly made of record in an inter partes case, and there are changes in the status of the registration between the time it was made of record and the time the case is decided, the Board will take judicial notice of, and rely upon, the current status of the registration as shown by the records of the United States Patent and Trademark Office. See TBMP §704.03(b)(1)(A) (2d ed. June 2003), and the cases cited therein. The Board notes that a Section 9 renewal was due on this registration on or before April 25, 2005. The records do not reflect that a renewal was filed, but there is also no indication that the registration has been deemed expired under Section 9 of the Trademark Act. Moreover, in view of the unusual delay in deciding this case, the Board will treat Registration No. 1860236 as a valid registration. In any event, as explained above, opposer pleaded and proved prior common law rights in the mark ORIGINAL SKIN for certain cosmetic products.

Opposition No. 91115859

likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, In re Majestic Distilling Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities of the marks and the similarities of the goods and/or services. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("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."). See also, In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). Based on the record before us, we find that confusion is likely.

Turning first to a consideration of the parties' respective goods, in Board proceedings, the issue of likelihood of confusion must be determined in light of the goods as identified in the involved application and registration and, in the absence of any specific limitations therein, on the presumption that all normal and usual channels of trade and methods of distribution are or may be utilized for such goods. See Octocom Systems Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); Canadian Imperial Bank of Commerce, N. A. v. Wells Fargo Bank, 811 F.2d 490, 1 USPQ2d

Opposition No. 91115859

1813, 1815 (Fed. Cir. 1987); and CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983).

Opposer's goods are those identified in its registration, "makeup foundation," as well as those for which opposer has proven use of its mark and thus common law rights for "loose powder, and concealer"; and applicant's goods are identified as "ladies perfume and cosmetics, namely, makeup, rouge, lipstick, mascara, facial cleansers, facial and skin moisturizers, skin exfoliants, nail polish, eyeliner, blush, and eyeshadow."⁹ As identified, we find that these goods are closely related. While opposer's cosmetic items (e.g., "makeup foundation," "loose powder," "pressed powder") and applicant's cosmetic items (e.g.,

⁹ Applicant suggested on page 15 of his brief that:

This Board has the authority to decide this case on marketplace realities. If this Board feels that the evidence warrants modification of the description of goods or services to avoid likelihood of confusion, such as by limiting the trade channels of product distribution or by narrowing the descriptions of the products themselves, it has the authority to do so. 37 C.F.R. §2.133(b).

While it is true that the Board has such authority pursuant to Section 18 of the Trademark Act, 15 U.S.C. §1068, it is not true that the Board can look to marketplace realities generally (see *Octocom v. Houston* case, *supra*). In any event, in order for such matters to be considered by the Board, the defendant must timely and properly raise the issue by way of an affirmative pleading in its answer to the complaint or by way of motion under Trademark Rule 2.133. See TBMP §311.02(b) (2d ed. rev. 2004). Applicant did not make clear what specific restriction of its application's identification goods would be appropriate. Raising this matter in his brief on the case is untimely and improper and will not be further considered.

Opposition No. 91115859

"makeup," "rouge," lipstick," "mascara," "nail polish," "facial and skin moisturizers") are specifically different products, nonetheless they are closely related personal grooming products. Moreover, we find that perfume and opposer's various cosmetic products are also related. See *In re American Safety Razor Co.*, 2 USPQ2d 1459 (TTAB 1987); *Royal Hawaiian Perfumes, Ltd. v. Diamond Head Products of Hawaii, Inc.*, 204 USPQ 144 (TTAB 1979); and *Frances Denney v. ViVe Parfums Ltd.*, 190 USPQ 302 (TTAB 1976). See also, *Hewlett-Packard Company v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) ("even if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services").

Inasmuch as neither applicant's application nor opposer's registration includes any type of restriction as to trade channels or purchasers, we must presume in this administrative proceeding that the involved goods are sold in all normal channels of trade to all the usual classes of purchasers for such goods. See *Octocom Systems Inc. v. Houston Computers Services Inc.*, supra; and *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, supra. Specifically, we find that the channels of trade and the classes of purchasers for the parties' goods, as identified,

Opposition No. 91115859

are identical, for purposes of determining whether there is a likelihood of confusion.

In addition, we find that the involved goods (perfume and various cosmetic items) may be expensive or inexpensive.¹⁰ We also find that these goods are not necessarily purchased by sophisticated purchasers.¹¹

Turning next to a consideration of the marks, it is well settled that marks must be considered in their entireties because the commercial impression of a mark on an ordinary consumer is created by the mark as a whole, not by its component parts. This principle is based on the common sense observation that the overall impression is created by the purchaser's cursory reaction to a mark in the marketplace, not from a meticulous comparison of it to others to assess possible legal differences or similarities. See 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §23:41 (4th ed. 2005). See also, Dassler KG v. Roller Derby Skate Corp., 206 USPQ 255 (TTAB 1980).

¹⁰ Opposer's request (brief, p. 14) that the Board take judicial notice "that makeup, facial care products and fragrances are generally not very expensive items" is denied. See TBMP §704.12 (2d ed. rev. 2004).

¹¹ Applicant commented (brief, p. 11) that "The 'special' sophistication of women consumers has been acknowledged by at least one court. 'The courts will take judicial notice of 'a certain degree of sophistication' of women purchasers.' Avon Shoe Co. v. David Crystal, Inc. 171 F.Supp. 293 (SDNY 1959), citing Warner Brothers company v. Jantzen, inc., 249 F.2d 353, 354 (2d Cir. 1957)." To the extent, if any, that applicant requests that the Board take judicial notice of "the sophistication of women purchasers," applicant's request is denied. See TBMP §704.12 (2d ed. rev. 2004).

Opposition No. 91115859

Moreover, the differences in the marks may not be recalled by purchasers seeing the marks at separate times. The emphasis in determining likelihood of confusion is not on a side-by-side comparison of the marks, but rather must be on the recollection of the average purchaser, who normally retains a general rather than a specific impression of the many trademarks encountered; that is, the purchaser's fallibility of memory over a period of time must be kept in mind. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd unpub'd* (Fed. Cir., June 5, 1992).

In this case, both applicant's and opposer's two-word marks begin with the word "ORIGINAL," and the second word differs by only one letter, the letter "K." These marks ORIGINAL SKIN and ORIGINAL SIN, are similar in sound and appearance. It is often the first term which is most likely to be impressed upon the mind of a purchaser and be remembered by the purchaser. See *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). Moreover, consumers have fallible memories when considering the marks they have seen, and the difference may not be heard by consumers when they hear the marks spoken. The fact that the second word is not identical does not obviate the likelihood of confusion.

Opposition No. 91115859

As to connotation and commercial impression, clearly the words "SKIN" and "SIN" are different words with different specific meanings. However, our primary reviewing Court has explained that on registrability questions, we do not ordinarily look to the trade dress, "but the trade dress may nevertheless provide evidence of whether the word marks projects a confusingly similar commercial impression." *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984). Here it is clear that since opposer's initial use of its mark in 1993, opposer has played on the association between its ORIGINAL SKIN mark and the Biblical story of "original sin."¹² The first advertisements, press releases, and the like, include allusions to the Garden of Eden, the fig leaf, forbidden fruit, and the like. In 1998, opposer used the phrase "Do you believe in Original Skin®?" in launching its new pressed makeup product. Thus, the connotation and overall commercial impression of both marks are similar. We find the respective marks ORIGINAL SKIN and ORIGINAL SIN are similar in sound, appearance, connotation and commercial impression. See *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209 (TTAB 1999).

¹² The Columbia Encyclopedia (Fifth Edition 1993) defines "original sin" as "in Christian theology, the SIN OF ADAM, by which all humankind fell from divine GRACE. ..." Opposer's notice of reliance, Exhibit C.

Opposition No. 91115859

Turning to the du Pont factor of the fame of opposer's mark, opposer has established that its mark ORIGINAL SKIN is strong and well known in the field of cosmetics. Opposer's sales of its ORIGINAL SKIN products are substantial, with tens of millions of dollars in sales since 1993. Opposer's advertising expenditures are also substantial. Opposer advertises nationwide through direct mailings and on radio and in newspapers and magazines.

We find that opposer's mark ORIGINAL SKIN is clearly well known and a strong mark entitled to a broad scope of protection.

The strength of opposer's mark increases the likelihood that consumers will believe that applicant's goods emanate from or are sponsored by opposer. As the Court stated in *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992):

A strong mark, on the other hand, casts a long shadow which competitors must avoid. See e.g., *Nina Ricci*, 889 F.2d at 1074. Thus, the Lanham Act's tolerance for similarity between competing marks varies inversely with the fame of the prior mark. As a mark's fame increases, the Act's tolerance for similarities in competing marks falls.

Applicant's argument that it adopted its mark in good faith is unavailing. Although an intent to trade on the mark of another is strong evidence of likelihood of confusion because it is presumed that such an intention is

Opposition No. 91115859

successful, the converse is not true. That is, good faith adoption does not necessarily mean that confusion is not likely. Stated another way, that applicant did not intend to cause confusion by adopting a similar mark in connection with closely related goods does not justify registration if confusion is likely to occur. See *Hydra Mac, Inc. v. Mack Trucks, Inc.*, 507 F.2d 1399, 184 USPQ 351 (CCPA 1975); and *Greyhound Corp. v. Both Worlds Inc.*, 6 USPQ2d 1635 (TTAB 1988). See also, *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991) ("Whether there is evidence of intent to trade on the goodwill of another is a factor to be considered, but the absence of such evidence does not avoid a ruling of likelihood of confusion. (citation omitted).")

Applicant also argues that "the expertise of examiners is entitled to respectful consideration" and "The Examiner here is presumed to have performed her job competently. The mark was passed to publication and [the] decision of the Examiner is entitled to consideration." (Brief, p. 15.) However, the Board is not bound by the Examining Attorney's decision to allow the mark for publication. Rather, the Board must determine an inter partes case on the evidence supported by the record. See *McDonald's Corp. v. McLain*, 37 USPQ2d 1274, 1276 (TTAB 1995).

Opposition No. 91115859

On balance, and considering all of the evidence on the relevant du Pont factors, and giving each such factor its appropriate weight in the circumstances of this case, we find that confusion is likely between applicant's mark ORIGINAL SIN and opposer's mark ORIGINAL SKIN when used on these closely related goods. See generally, Kangol Ltd. v. Kangaroo U.S.A. Inc., 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992); Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc., 1 USPQ2d 1445 (TTAB 1986, amended 1987); and Chemical New York Corp. v. Conmar Form Systems, Inc., 1 USPQ2d 1139 (TTAB 1986).

While we have no doubt in this case, if there were any doubt on the question of likelihood of confusion, it must be resolved against the newcomer as the newcomer has the opportunity of avoiding confusion, and is obligated to do so. See TBC Corp. v. Holsa Inc., 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997); and In re Hyper Shoppes (Ohio) Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

Decision: The opposition is sustained and registration to applicant is refused.