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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Lykos

Mailed: September 22, 2006

Opposition No. 91122000

AMAZON.COM, INC.

v.

VON ERIC LERNER KALAYDJIAN

Before Seeherman, Bucher and Cataldo, Administrative Trademark Judges.

By the Board:

This case now comes up on opposer's second motion for summary judgment.

As background, applicant applied to register the mark COSMETICSAMAZON for "retail store and on-line ordering services featuring skin tanning preparations, namely, lotions, creams, gels and oils, sun block lotion to be applied to the skin and lips, cosmetics and skin cleaning preparations, namely, facial soap, body soap, bath oil, hair shampoos and conditioners, skin lotions, face and body cleansers, colognes, eau de toilette, and perfume" in International Class 35, alleging a bona fide intent to use the mark in commerce.[1] On February 3, 2001, opposer filed a

[1] Application No. 75938728, filed March 8, 2000.

notice of opposition against applicant's application on the grounds that applicant's applied-for mark (1) so resembles opposer's previously used and registered marks that they are likely to cause confusion, mistake, or deceive prospective consumers(Section 2(d) of the Lanham Act); and (2) dilutes the distinctive quality of opposer's marks (Section 43(c) of the Lanham Act). Thereafter, opposer moved for summary judgment on both claims.

On December 22, 2005, the Board denied opposer's motion for summary judgment on its Section 2(d) claim because opposer had relied in its motion on the following registrations that were not pleaded in the notice of opposition:

> Registration No. 2837138 for AMAZON.COM for automated and computerized trading of goods and online mail ordering services featuring, among other things, "soaps, perfumery, cosmetics" and "cosmetic utensils;" registered April 27, 2004;
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> Registration No. 2832943 for AMAZON for electronic retailing services via computer and an online searchable database featuring, among other things, "soaps, perfumery, cosmetics" and "cosmetic utensils;" registered April 13, 2004; and
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> Registration No. 2649373 for AMAZON.COM OUTLET for electronic retailing services via computer and an online searchable database featuring, among other things, "soaps, perfumery, cosmetics" and "cosmetic utensils;" registered November 12, 2002.

The Board also denied opposer's motion for summary judgment on the dilution claim because opposer had failed to

demonstrate the absence of a genuine issue as to the fame of its mark.

In wake of the Board’s decision, on February 14, 2006, opposer moved to amend the notice of opposition to plead ownership of the above registrations as well as additional registrations for various AMAZON marks in the online computer services field, and to withdraw its dilution claim. With the amended notice of opposition, opposer provided certified status and title copies of each pleaded registration. Concurrently therewith, opposer filed a renewed motion for summary judgment based on the amended pleading. The Board granted opposer's motion to amend the notice of opposition on June 2, 2006, and allowed applicant time to respond to opposer's second summary judgment motion. Applicant has submitted a response in opposition thereto.

In support of its motion for summary judgment, opposer has submitted the affidavit of its attorney, Ms. Sarah Silbert, describing and attesting to the accuracy of various searches conducted over the Internet and USPTO database, with various exhibits attached thereto, including certified status and title copies of several of opposer’s registrations for trademarks containing the term AMAZON; three third-party registrations containing the term AMAZAON; a print-out from the Internet demonstrating that applicant is the owner of the domain name velk.com; a print-out of the

home page of applicant’s web site at the Internet address www.velk.com, which site contains the hyperlink to “Cosmetics Amazon Store”; and a print out of a product and price directory page from applicant’s website. Opposer has also submitted the affidavit of Ms. Katherine Savitt, opposer’s Vice President of Strategic Communications, with exhibits attached thereto, including news articles and press releases chronicling the company’s history; pages from opposer’s web site showing various information such as product categories and online catalogs; copies of several of opposer’s federal trademark registrations; letters to opposer’s shareholders as evidence of opposer’s annual revenues; copies of opposer’s return and customer privacy policies; a copy of the Media Metrix Survey which monitors Internet traffic on consumer web sites; package, shipping, and promotional materials bearing the AMAZON.COM trademark; sample print ads; and copies of agreements with other Internet entities which permit the display of the AMAZON.COM logo.

The Board will now review the parties' respective arguments.

In its renewed motion for summary judgment, opposer argues that applicant's mark is confusingly similar in sound and appearance to opposer's mark because the only distinction between the marks is the addition of the

descriptive term COSMETICS; that opposer and applicant sell directly competitive goods and services; that applicant and opposer market their goods in the same trade channel, that is, the Internet; and that opposer’s and applicant's prospective consumers are identical. Opposer also maintains that confusion is more likely in light of the fame of opposer’s mark, and the relatively inexpensive nature of the goods at issue.

Applicant submitted no evidence in response to the motion. However, applicant argues “that the mark cosmeticsamazon as a whole mark would be impossible to be confusing with the Amazon.Com trademark"; that the Trademark Office has permitted the coexistence of other similar marks for identical services; and that opposer’s mark was not famous at the time applicant filed its application in 2000.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(c). A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. *See Celotex Corp. v. Catrett,* 477 U.S. 317, 106 S.Ct. 2548 (1986). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of

material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. *See Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). When the moving party's motion is supported by evidence sufficient to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely-disputed facts that must be resolved at trial. The nonmoving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine issue of material fact for trial.

Based on the submissions of the parties, we find that opposer has met its burden of demonstrating that there are no genuine issues of material fact, and that opposer is entitled to judgment as a matter of law.

A plaintiff moving for summary judgment in its favor on a Section 2(d) claim must establish that there is no genuine dispute that (1) it has standing to maintain the proceeding; (2) it is the prior user of its pleaded mark or marks; and (3) contemporaneous use of the parties' respective marks on

their respective goods or services would be likely to cause confusion, mistake or to deceive consumers. *See Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.,* 60 USPQ2d 1733 (TTAB 2001).

A. **Standing**

With regard to whether opposer has standing to maintain this proceeding, we note that applicant has not challenged opposer's standing to oppose the involved application. In view of opposer's pleaded registrations which are of record, we find that there is no genuine issue that opposer has a direct commercial interest in this proceeding, and that opposer has demonstrated its standing. *See Cunningham v. Laser Golf Corp.,* 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir.(2000); *see also Lipton Industries, Inc. v. Ralston Purina Co.,* 670 F.2d 1024, 213 USPQ 185 (CCPA).

B. **Priority**

As noted above, opposer has made of record status and title copies of its pleaded registrations. Thus, there is no genuine issue that opposer owns these registrations. Accordingly, opposer's priority is not in issue. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.,* 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

C. **Likelihood of Confusion**

Turning to the issue of likelihood of confusion, we are guided by the factors set forth in the case of *In re E.I. du Pont de Nemours & Co.,* 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). 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 likelihood of confusion.[2] In conducting our analysis, we have concentrated our discussion on opposer's pleaded registration for AMAZON, identified above, since it is the closest in terms of the mark and the services to applicant's mark and services.

Turning first to the marks, there is no issue that opposer's mark is AMAZON and applicant's mark is COSMETICSAMAZON. Thus, both applicant's mark and opposer's mark share the term AMAZON. The only literal difference between the marks is the addition of the generic word COSMETICS as a prefix to applicant's mark. The addition of the generic term COSMETICS does not serve to distinguish applicant's mark from opposer's AMAZON marks. Consumers would simply regard the word COSMETICS in the mark COSMETICSAMAZON as indicating the products that are being

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[2] Our primary reviewing Court has held that only those *du Pont* factors shown to be material or relevant in the particular case and which have evidence submitted thereon are to be considered. *See Olde Tyme Foods, Inc. v. Roundy's, Inc.,* 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

sold through the retail electronic sales, and will view the AMAZON portion of the mark as the source-identifying element. Thus, they will view the mark COSMETICSAMAZON as merely a variation of opposer's AMAZON mark. *See In re Charam International Inc.,* 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *In re El Torito Restaurants Inc.,* 9 USPQ2d 2002 (TTAB 1988); *In re Corning Glass Works,* 229 USPQ 65 (TTAB 1985); *Weiss Associates, Inc. v. HRL Associates,* 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990). Accordingly, when the marks are compared in their entireties, they are similar in appearance, pronunciation, connotation and commercial impression. This *du Pont* factor favors a finding of likelihood of confusion.

We note applicant's argument that the USPTO has permitted the coexistence of other purportedly similar marks for identical services. Applicant bases this argument on registrations for the marks BUY.COM and BESTBUY.COM, both for Internet retailing services in the field of electronics. Applicant has not submitted copies of these registrations, and therefore his mere assertion that these registrations exist does not raise a genuine issue. In any event, the marks cited by applicant are completely different from the marks at issue in this case, and therefore have no bearing here. Accordingly, even if applicant had made these registrations of record, they would not raise a genuine

issue as to the similarity of the marks AMAZON and COSMETICSAMAZON.

We next turn to a consideration of the services. There is no genuine issue that, as identified, opposer's services include the electronic retailing via computer of soaps, perfumery and cosmetics, and that applicant's services include retail store and on-line ordering services featuring cosmetics, facial soap, body soap, colognes, eau de toilette, and perfume. It is well settled that the question of likelihood of confusion must be determined based on an analysis of the services recited in applicant's application vis-à-vis the services identified in the cited registration. *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank,* 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *In re Shell Oil Co.,* 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993). Thus, there is no genuine issue that the parties' respective services are legally identical. Indeed, we note that applicant does not dispute in its responsive brief that the parties' respective services are identical. This *du Pont* factor favors a finding of likelihood of confusion.

Regarding the channels of trade, both the involved application and opposer's pleaded registrations specifically identify the services as being offered or intended to be offered via the Internet. Therefore, there is no genuine issue that the trade channel for the parties' services is

identical. We must therefore assume that the same potential class of consumers (that is, purchasers of cosmetics, soaps, and perfumes via the Internet) would encounter both applicant's and opposer's services. *See In re Elbaum,* 211 USPQ 639 (TTAB 1981). This *du Pont* factor also favors a finding of likelihood of confusion.

In addition, we note that according to the identification of goods in applicant's application, applicant's Internet retail services include the sale of relatively inexpensive products such as soaps. The case law recognizes that consumers devote limited attention to the purchase of low-cost, consumable goods, and that such goods are subject to impulse buying. *See e.g., Federated Foods, Inc., supra.* Thus, the *du Pont* factor of the conditions of purchase favors a finding of likelihood of confusion.

We note that opposer has asserted that the fame of its mark also favors a finding of likelihood of confusion. However, because opposer has submitted evidence pertaining to the fame of its mark AMAZON.COM, and not AMAZON, we cannot treat AMAZON per se as a famous mark. Therefore, in terms of our analysis of the issue of likelihood of confusion between AMAZON and COSMETICSAMAZON, this factor is neutral.

We have concentrated our discussion on the *du Pont* factors which the parties have discussed and/or on which we

have evidence. To the extent that any other factors are applicable, we must treat them as neutral.

Inasmuch as opposer has demonstrated that there is no genuine issue of material fact, and that it is entitled to judgment as a matter of law, opposer’s motion for summary judgment is granted; the opposition is sustained, and registration of applicant's mark is refused.