

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

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July 10, 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Consac Industries, Inc. d/b/a Desert Essence
v.
Forest Essentials, Inc.

Opposition No. 124,502
to application Serial No. 78/034,841
filed on November 11, 2000.

Thomas M. Furth of Jordan and Hamburg, LLP for Consac
Industries, Inc.

Paul Cipriani, Applicant's President, pro se, for Consac
Industries, Inc.

Before Cissel, Chapman and Walters, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

As amended, the above-identified application seeks registration on the Principal Register of the mark DESERT ESSENTIALS for "bar soap, hair shampoos and conditioners, bath gels, body lotions and personal gift sets comprising of (sic) hair shampoos, conditioners, baths gels, body lotions, [and] bar soaps[,] in International Class 3." The basis for filing the application was applicant's assertion that it possessed a bona fide intention to use the mark in commerce

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in connection with these products. As amended, the application claims ownership of Registration No. 2,422,183 for the mark ISLAND ESSENTIALS for "skin soap in bar form and body care products, namely, hair shampoo, hair conditioner, and gel, body lotion, sunscreens and self tanning lotion, colognes and bath crystals," in Class 3, and Registration No. 2,005,951 for the mark



for "personal soaps, hair shampoos, hair conditioners, bath gels, body lotions, fragrances in the nature of perfumes and potpourri," in Class 3.

On October 29, 2001, a timely Notice of Opposition was filed by Consac Industries, Inc., d/b/a Desert Essence, a New York corporation. As grounds for the opposition, opposer alleged that it and its predecessors-in-interest adopted and have continuously used in interstate commerce the trademark DESERT ESSENCE since at least as early as November 11, 1980 in connection with goods similar to the goods on which applicant intends to use the mark it seeks to

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register; that opposer owns seven listed federal trademark registrations for marks which consist of or include DESERT ESSENCE for a variety of personal care products that are the same as or otherwise closely related to the goods listed in the opposed application; that opposer's DESERT ESSENCE mark is famous within the meaning of Section 43(c) of the Lanham Act; that the mark applicant seeks to register so resembles opposer's pleaded marks that if applicant were to use it in connection with the goods listed the application, confusion would be likely; and further, that such use by applicant would lessen the capacity of opposer's mark to identify and distinguish opposer's goods, thereby diluting the distinctive quality of opposer's mark under Section 43(a) of the Act.

In its answer, applicant denied the salient allegations asserted by opposer in the Notice of Opposition, and claimed that applicant has used the marks in the registrations of which it claimed ownership in the application, ISLAND ESSENTIALS and "Forest Essentials" and design, "with no problems."

A trial was conducted in accordance with the Trademark Rules of Practice. Opposer made of record the testimony and nineteen related exhibits from the deposition of opposer's president of marketing, Jodi Billet. In addition, during

its testimony period, opposer filed a notice of reliance on status and title copies of its pleaded registrations.

Applicant declined to attend the deposition of Ms. Billet, and neither took testimony nor filed any other evidence¹.

Opposer filed its brief, applicant's president filed a brief on behalf of applicant², and opposer filed a reply brief. The oral hearing referenced above was conducted before the Board on July 10, 2003.³

Based on careful consideration of the testimony and evidence properly of record in this opposition proceeding, as well as the arguments presented by applicant and counsel for opposer, we hold that opposer has met its burden of proof with regard to its likelihood of confusion claim under Section 2(d) of the Act.

¹Opposer's brief notes that opposer was served with the affidavit of applicant's president, but no copy thereof has been received at the Board, and in any event, as opposer points out, any such submission would not have complied with Rule 2.123(b) of the Trademark Rules of Practice, and the Board would not have considered any such affidavit.

² Applicant sought to make of record evidence attached to its brief, but opposer properly objected to the Board's consideration of any such attachments because they were not timely submitted within applicant's testimony period established in the earlier trial schedule promulgated by the Board. Moreover, and in any event, even if applicant had properly made of record the third-party registrations on which its brief appears to be centered, it is well settled that third-party registrations are not evidence of the use of the marks therein and are of little probative value in resolving the issue of likelihood of confusion. See Sams, Third-Party Registrations in TTAB Proceedings, 72 TMR 297 (1982).

³ Counsel for opposer appeared in person before the Board in Arlington, Virginia, and applicant's president appeared on behalf of applicant by means of a video teleconference.

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The predecessor to our primary reviewing court listed the principal factors to be considered in determining whether confusion is likely in the case of *E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Chief among these factors are the similarity of the marks as to appearance, pronunciation, meaning and commercial impression, and the similarity of the goods.

The goods listed in the application include bar soap, hair shampoos and conditioners, bath gels and body lotions. Opposer's registrations and the testimony (and exhibits thereto) establish opposer's prior use of DESERT ESSENCE in connection with the identical goods.

"When marks would appear on virtually identical goods or services, the degree of similarity between 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 USPQ 6098, 1700 (Fed. Cir. 1982). In the case before us, especially in view of the identity of the goods of applicant and opposer, the marks are plainly similar enough that confusion would be likely if applicant were to use the mark it seeks to register on the goods listed in the application.

This is so because the marks create very similar commercial impressions. The word "DESERT" is the first word in each mark. This non-descriptive word plays a significant

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role in determining the connotation, and hence the commercial impression, each mark has. The second word in applicant's mark is "ESSENTIALS," whereas the second word in opposer's mark is "ESSENCE." While these terms are not identical, they are similar in appearance, pronunciation and meaning. As opposer points out, "ESSENTIAL" is defined as "of, relating to or constituting essence." Merriam-Webster Online Dictionary, (www.m-w.com) (of which the Board may take judicial notice). When we compare "DESERT ESSENTIALS" with "DESERT ESSENCE," we find that the marks in their entireties create very similar commercial impressions. The record is devoid of evidence that anyone other than opposer uses another mark which is similar to opposer's mark in connection with goods which are commercially related to opposer's products. As noted above, even if applicant had properly made of record third-party registrations of such marks, the registrations themselves would not have been evidence that the marks therein are in use, or that prospective purchasers of these kinds of products are aware of the use of them such that small differences in the marks are sufficient for such purchasers to distinguish among them.

Applicant argues that in resolving the issue of whether confusion would be likely, the Board should be guided by the decision of the Examining Attorney to pass applicant's mark

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to publication notwithstanding opposer's valid registrations. This argument is not well taken. As opposer points out, every opposition based upon Section 2(d) the Lanham Act follows a finding by an Examining Attorney that registration is not precluded by prior registrations. If applicant's argument were consistent with actual practice, no opposition based on Section 2(d) could ever be sustained.

Additionally, although applicant asserts that its decision to adopt the mark it seeks to register was made in good faith, this fact does not vitiate the likelihood of confusion. As opposer notes, if potential purchasers would be likely to be confused by the use of similar marks on identical products, applicant's intentions would probably not change that; no amount of good faith on the part of applicant could make them less likely to be confused.

In summary, opposer has met its burden of proof in the case at hand by establishing its prior use and registration of a similar mark in connection with goods which are in part identical and otherwise closely related to the goods listed in the opposed application. Under these circumstances, confusion within the meaning of Section 2(d) of the Act is plainly likely. We need not resolve opposer's claim of dilution under Section 43(c)(1) of the Act.

DECISION: The opposition is sustained under Section 2(d) of the Act, and registration to applicant is refused.