

THIS DISPOSITION IS  
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Mailed: September 30, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Calmia Limited

v.

ZAIJA Ltd. Zaklad Produkcji Lekow Spolka z o.o.

Opposition No. 91154813  
to application Serial No. 76374461  
filed on February 21, 2002

Donna J. Bunton of Nixon & Vanderhye P.C. for Calmia Limited.

Robert J. Ferb, Esq. for ZAIJA Ltd. Zaklad Produkcji Lekow Spolka  
z o.o.

Before Chapman, Holtzman and Rogers, Administrative Trademark  
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

On February 21, 2002, applicant, ZAIJA Ltd. Zaklad Produkcji  
Lekow Spolka z o.o., filed an application to register the mark  
CALMA on the Principal Register based upon an allegation of a  
bona fide intention to use the mark in commerce for the following  
goods in International Class 3:

non-medicated skin care preparations, namely, skin soap,  
antibacterial skin soaps, concealers, cosmetic preparations  
for skin renewal, skin lotion, after-sun skin lotions,  
medical cleansers for skin and wounds, skin mousse, non  
medicated stimulating lotions for the skin, patches  
containing sun screen and sun block for use on the skin,  
skin abrasive preparations, skin clarifiers, skin cream,

**Opposition No. 91154813**

skin cream for the care of infants; sun creams, cuticle cream, creams for cellulite reduction, hair removal cream, skin cleansing cream, skin cleansing lotion, skin conditioners, skin emollients, skin gels for accelerating, enhancing or extending tans, skin lighteners, skin lightening creams, skin masks, peelable skin masks, skin moisturizer masks, skin moisturizer, skin toner, skin whitening creams, topical skin sprays for cosmetic purposes; wrinkle removing skin care preparations, namely, face creams, age spot reducing cream, anti-aging cream, anti-wrinkle cream; shaving preparations, namely, shaving foam, shaving gel, after-shave gel, shaving soap, shaving cream, shaving balm, shaving lotion, after-shave lotions, face powder, liquid soaps for face, facial concealers, facial cleansers, facial emulsions, facial make up, facial masks, beauty masks, facial scrubs, facial lotions, facial mousse, eye cream, eye gel, eye make up remover; non-medicated lip care preparations, namely, non-medicated lip balm, lip cream, non-medicated lip protector, lip pomades, body emulsions, body cream, baby cream, body masks, body mask cream, body mask lotion, body mask powder, body soaps, liquid soaps for body, body oils, perfume oils, baby oil, bath oil, body powder, bath powder, body scrub, body concealers, hand cream, hand balm, hand lotions, hand soaps, liquid soaps for hands, non-medicated foot cream; cleaning preparations, namely toilet soap, deodorant soap, medicated soaps, disinfectant soaps; shower gel, bath gels, bath foam, bath milks, bath lotions.

Registration has been opposed by Calmia Limited. As grounds for opposition, opposer asserts that on June 21, 2001, prior to the filing date of the involved intent-to-use application, opposer filed an intent-to-use application (Serial No. 76274653) seeking registration of the mark CALMIA on the Principal Register for, inter alia, the following goods in International Class 3:

all purpose cleaning preparation, scouring preparation and polishing preparation for the home; beauty preparations, namely, creams and lotions for the skin, face and body; cosmetics; dentifrices; perfumes and colognes; deodorants for personal use; antiperspirants; sun-tan and sun screening preparations; depilatory preparations; essential oils for food flavoring; massage oils; essential oils for personal use; skin soaps and hair shampoos; non-medicated

**Opposition No. 91154813**

preparations for the care and appearance of the skin, body, face, eyes, hair, teeth and nails; bath oils and bath salts; talcum powder; face and body moisturizers; non-medicated baby oils and baby creams; non-medicated baby wipes.

Opposer alleges that applicant's mark CALMA when used on applicant's goods so resembles opposer's mark for the goods identified in its earlier-filed application as to cause confusion.

Applicant, in its answer, has essentially denied the salient allegations of the opposition.<sup>1</sup>

The record includes the pleadings; the file of the involved application; and opposer's notice of reliance on the file history of opposer's pleaded intent-to-use application. Applicant did not submit any testimony or other evidence in its own behalf.

Only opposer filed a brief. Neither party requested an oral hearing.

Opposer has introduced the file history of its pleaded application, showing, on its face, that opposer is the owner of the application and a reasonable basis for opposer's belief that it will be damaged by the registration of applicant's mark.

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<sup>1</sup> In one of the paragraphs of the opposition, opposer alleged that, based on information and belief, applicant made no use of CALMA prior to the filing date of the opposed application. In answering that paragraph, applicant stated that it "leaves the Opposer to his proofs relating to no use of the mark CALMA by applicant prior to the filing of [the opposed application]." The burden of proving use prior to the filing of the opposed application, to the extent there was any such use, falls to applicant, not opposer. Absent any proof of earlier use by an applicant, the earliest date upon which the applicant is entitled to rely for purposes of priority is the filing date of its intent-to-use application, in this case February 21, 2002. See, for example, *Larami Corp. v. Talk To Me Programs, Inc.*, 36 USPQ2d 1840 (TTAB 1995).

**Opposition No. 91154813**

Thus, opposer's standing, that is, its real interest in this proceeding, has been established. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 942, 55 USPQ2d 1842 (Fed. Cir. 2000). See also, e.g., *The Hartwell Co. v. Shane*, 17 USPQ2d 1569 (TTAB 1990); and *American Vitamin Products Inc. v. DowBrands Inc.*, 22 USPQ2d 1313 (TTAB 1992).

Opposer has also established its constructive use priority by virtue of its ownership of an intent-to-use application with a filing date that is earlier than the filing date of the challenged intent-to-use application. See *Zirco Corp. v. American Telephone & Telegraph Co.*, 21 USPQ2d 1542 (TTAB 1991); and *Larami Corp. v. Talk to Me Programs Inc.*, supra.

We turn then to a consideration of the question of likelihood of confusion. Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue, including the similarity of the marks and the similarity of the goods. In *re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The factors deemed pertinent in this proceeding are discussed below.

The goods in this case are, in substantial part, identical or so closely related as to be legally identical. Both applications include, for example, cosmetics, skin soaps, skin lotions and skin creams, facial lotions and facial creams, depilatory preparations, suntan preparations and body oils.

**Opposition No. 91154813**

Because the goods are identical, and there are not restrictions as to their channels of trade or classes of purchasers, they must be deemed to be sold in the same channels of trade and directed to the same purchasers. *Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910 (TTAB 2000). It is clear that if these identical and closely related goods are offered under similar marks there would be a likelihood of confusion.

Thus, we turn our attention to the marks, keeping in mind that when marks would appear on identical goods, the degree of similarity between the marks necessary to support a finding of likely confusion declines. *Century 21 Real Estate v. Century Life*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

The marks CALMA and CALMIA are virtually identical in appearance, differing only by one letter. There are some differences in sound. In particular, CALMA has two syllables, and CALMIA has three syllables. More important, however, there are significant similarities; both are short, one word marks beginning with the identical word "CALM."

The differences in the marks become even less significant when we consider that the marks convey the same meanings and create the same overall commercial impressions. In this regard, we note that both applications contain statements concerning the significance of the respective marks. Applicant, in its application, has described CALMA as fanciful, and opposer states

**Opposition No. 91154813**

in its application that CALMIA has no meaning in the trade, no geographic significance and no meaning in a foreign language.

While the marks as a whole, according to the parties, have no recognized meaning in English or in any other language, the familiar word "CALM" is visually and aurally a significant part of both marks. To the extent these marks suggest anything in relation to cosmetics and personal care products, the meaning would be the same, namely the calming or soothing qualities of the products.

Thus, we find that the similarities in the two marks far outweigh their differences especially when we consider that average purchasers are not infallible in their recollection of trademarks and often retain only a general overall impression of marks that they may previously have seen in the marketplace. See *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988). The differences in these marks are not so significant that they are likely to be noted or remembered by purchasers when seeing the marks at different times on identical goods.

It must also be remembered that cosmetics and personal care items can be relatively inexpensive products and therefore are likely to be purchased casually and on impulse, thus increasing the risk of confusion. *Kimberly-Clark Corp. v. H. Douglas Enter., Ltd.*, 774 F.2d 1144, 1146, 227 USPQ 541, 542 (Fed. Cir. 1985).

**Opposition No. 91154813**

Accordingly, we find that consumers familiar with opposer's cosmetics and personal care products sold under its mark CALMIA would be likely to believe, upon encountering applicant's mark CALMA for the identical products, that the goods originated with or are associated with or sponsored by the same entity.

**Decision:** The opposition is sustained, and judgment is entered in favor of opposer contingent upon the issuance of a registration to opposer.<sup>2</sup>

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<sup>2</sup> See Section 7(c) of the Trademark Act, 15 U.S.C. 1057(c) and Trademark Rule 2.129(d). See also, *Larami Corp. v. Talk to Me Programs Inc.*, *supra*.