

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: May 21, 2007

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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L.C. Licensing, Inc.  
v.  
JR Cosmetics, LLC

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Opposition No. 91163266  
to application Serial No. 76527565  
filed on July 3, 2003

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Erica D. Klein of Kramer Levin Naftalis & Frankel LLP for  
L.C. Licensing, Inc.

Peggy S. Vincent of Howard, Stallings, From & Hutson, PA for  
JR Cosmetics, LLC.

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Before Hohein, Bucher and Kuhlke, Administrative Trademark  
Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, JR Cosmetics, LLC, seeks registration of the  
mark JUICY GOO for goods ultimately identified in the  
application as "cosmetics, namely, lipstick, lip pencil,  
rouge, nail enamel, non-medicated nail treatment  
preparations, sun block, facial, body and skin cleansers,  
facial, body and skin moisturizers, astringents, face  
tonics, facial masks, face powder, foundation, blushers,

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mascara, eye shadow, eye liner, eyebrow pencil, eye makeup remover, shampoo, cream hair rinse, hair spray, personal deodorant and antiperspirant, perfume and cologne, skin lotions, body creams, night creams, eye gel, cellulite reducing creams, face soap, face scrubs, shaving cream, after shave lotion, bronzers, blemish concealer, body lotion, body oil, perfumed body mist, body emulsions, bath oils, bath and shower gel, suntanning preparations, sun screen, suntan oil and lotion, after-sun skin lotion and balm, self-tanning and tanning accelerators" in International Class 3.<sup>1</sup>

Opposer, L.C. Licensing, Inc., has opposed registration of applicant's mark on the ground that, as applied to applicant's goods, the mark so resembles opposer's previously used, registered and applied-for marks JUICY, JUICY COUTURE, JUICY JEANS, JUICY GIRL, JUICY BABY and CHOOSE JUICY for a variety of "fashion-related goods," including clothing, perfumery and cosmetics goods, as to "be likely to cause confusion, deception or mistake among consumers and dilute the distinctiveness of opposer's marks." To the extent, however, that opposer has also attempted to plead dilution, the pleading is insufficient inasmuch as opposer did not plead that its mark became

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<sup>1</sup> Serial No. 76527565, filed July 3, 2003, alleging a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act. 15 U.S.C. §1051(b).

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famous prior to the filing date of the opposed application. *Polaris Industries v. DC Comics*, 59 USPQ2d 1789 (TTAB 2001). In any event, opposer has not argued dilution in its brief. We therefore have only considered the claim of priority of use and likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Applicant has filed an answer by which it has admitted the following allegations as set forth in paragraph 4 of the Notice of Opposition:

Opposer is the owner of allowed Application Serial No. 76/376,638 for the mark JUICY COUTURE filed February 28, 2002 for a variety of fashion-related goods and services including lip gloss, lipstick, other cosmetics, perfumery, candles, eyewear, jewelry, handbags, housewares, bedding, clothing, and retail sales of the same in International Classes 3, 4, 6, 9, 14, 16, 18, 21, 24, 25 and 35. A true copy of the Notice of Allowance for this application is attached as Exhibit D.

The evidence of record consists of the pleadings herein, the file of the opposed application, and certified copies of opposer's pleaded registrations, which were submitted with the notice of opposition and show that the registrations are subsisting and owned by opposer.<sup>2</sup> Opposer and applicant did not take any testimony or submit any other

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<sup>2</sup> In addition to its registrations opposer pleaded five applications. However, other than the notices of allowance discussed infra and applicant's admission in its answer that opposer is the record owner of the applications, the contents of the application files were not made of record.

evidence during their respective trial periods. Applicant, however, attached a stipulation to its brief whereby the parties agreed that certain of their respective applications be made a part of the record, but other than copies of the notices of allowance, copies of the application files were not made of record and we cannot take judicial notice thereof. Cf. *Cities Service Co. v. WMF of America, Inc.*, 199 USPQ 493 (TTAB 1978) (judicial notice of third-party registrations may not be taken where no copies thereof are submitted). Therefore, we have only considered the notices of allowance.

The pleaded registrations, which are in full force and effect and are owned by opposer, are summarized as follows:<sup>3</sup>

Registration No. 2285232 for the mark JUICY (in typed form) for "clothing, namely, shirts, dresses, pants, skirts and jackets" in International Class 25, issued on October 19, 1999, Section 8 accepted and Section 15 acknowledged;

Registration No. 2348674 for the mark JUICY COUTURE (in typed form) for "women's clothing, namely, jackets, dresses, skirts, shorts, pants, shirts and t-shirts" in International Class 25, issued on May 9, 2000, Section 8 accepted and Section 15 acknowledged; and

Registration No. 2387924 for the mark JUICY JEANS (in typed form) for "girls' and womens' clothing, namely, jeans, pants, shorts, skirts, t-shirts,

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<sup>3</sup> Although opposer also pleaded ownership of Registration No. 2882280, it did not submit a certified copy showing the status and title thereof. The plain copy of the registration attached to opposer's pleading is not sufficient to make the additional pleaded registration of record. Trademark Rule 2.122(d); TBMP §704.03(b)(1)(A) (2d ed. rev. 2004).

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shirts, tops, jackets, vests, bandannas" in International Class 25, issued on September 19, 2000, Section 8 accepted.

Because opposer has made the pleaded registrations summarized above properly of record, opposer has established its standing to oppose registration of applicant's mark and its priority is not in issue. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We first note that opposer did not present any evidence regarding its alleged common law rights in its various JUICY marks. Our determination here is thus made only as to the marks and goods listed in the pleaded registrations and application Serial No. 76376638.

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Opposer argues that it has a family of marks with the common element JUICY. However, although opposer alleged that JUICY is the common element of several of opposer's other marks and is a common name by which opposer and its brand are known, opposer did not specifically plead a family of marks, nor has opposer proven that it has a family of marks. "Simply using a series of similar marks does not of itself establish the existence of a family. There must be a recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods." *The Black & Decker Corp. v. Emerson Electric Co.*, \_\_\_ USPQ2d \_\_\_, Opp. No. 91158891 (TTAB March 23, 2007). Thus, it is necessary, at a minimum, to consider the manner of use and advertising of the various marks and whether the consumers view a part of these marks as the common element tying them together. *J& J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991). As noted above, opposer has not submitted any testimony or other evidence of advertising or use of its marks.

We next consider the similarities between opposer's and applicant's goods and the similarities between opposer's and applicant's trade channels and classes of purchasers of these goods. We must make our determinations under these factors based on the goods as they are recited in the

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applications and registrations, respectively. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

The goods at issue need not be identical or directly competitive in order for there to be a likelihood of confusion. Rather, the respective goods need only be related in some manner or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. In *re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984). However, if the goods are not related or are not marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely. *Shen Mfg Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004).

With regard to applicant's cosmetic products and the goods identified in opposer's Reg. Nos. 2285232, 2348674 and 2387924, which consist of various clothing items, the parties' goods are obviously different and noncompetitive and there is no evidence to support even a finding that they would be complementary. Opposer has presented no evidence to show that these clothing items are related to applicant's various cosmetic items in such a manner as to be likely to

cause confusion when used in connection with similar marks. Opposer merely recites various cases where such a finding was made.<sup>4</sup> On their face the respective goods are so different that we cannot make a determination that they are nonetheless related in some meaningful commercial sense without any evidence thereof. As noted by applicant, there is no per se rule that these goods are related. In re Jacques Bernier Inc., 1 USPQ2d 1924, 1925 (TTAB 1987). Moreover, as noted in Jacques Bernier, the cases where such a relationship has been found involved marks that were found to be well-known, and in this case opposer has not presented any testimony or evidence to establish that its mark is well known.

In view thereof, and notwithstanding any possible similarity of the marks, the differences in these goods, as identified in the application and registrations, are too great to find a likelihood of confusion without evidence to support such a conclusion.

Thus, in view of our finding that opposer has not shown that the goods are related or that the channels of trade overlap, we conclude that the evidence of record as it pertains to the relevant du Pont factors does not support a finding of a likelihood of confusion as to the marks in

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<sup>4</sup> We note that there are cases that find the opposite. See, e.g., Edison Bros. Stores, Inc. v. Cosmair, Inc., 651 F. Supp.

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opposer's Registration Nos. 2285232, 2348674 and 2387924. See *Shen Mfg Co. v. Ritz Hotel Ltd.*, *supra*; *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991) (any single factor may play a dominant role in a likelihood of confusion analysis).

As regards opposer's application Serial No. 76376638, applicant has admitted the allegations pertaining to this application, namely, its filing date, February 28, 2002, the mark, JUICY COUTURE, and the various cosmetic/perfumery goods identified in the application. Thus, opposer has established its priority inasmuch as the filing date of opposer's application Serial No. 76376638, February 28, 2002, is earlier than applicant's filing date, July 3, 2003. See *Larami Corp. v. Talk To Me Programs, Inc.*, 36 USPQ2d 1840 n. 7 (TTAB 1995); and *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542 (TTAB 1991). In addition, at least several of the goods in opposer's application are identical to the goods in applicant's application (e.g., perfume, body lotions, shower gel and bath oil) or are closely related thereto (e.g., lip gloss and lipstick.) Moreover, given that the goods are identical or closely related and there is no limitation in the identifications thereof in opposer's and applicant's applications, we must presume that the identical goods will be sold in the same

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1547, 2 USPQ2d 1013 (SDNY 1987) (use of NOTORIOUS for women's

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channels of trade and will be bought by the same classes of purchasers, while the related goods will be sold in some of the same channels of trade, and will be bought by some of the same purchasers. See *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994).

We now turn to consider the similarity or dissimilarity of the marks when compared in their entireties in terms of appearance, sound, connotation and commercial impression. We make this determination in accordance with the following principles. The test, under this du Pont factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods offered under the respective marks is likely to result. Moreover, where the goods are identical "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, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), cert. denied, 506 U.S. 1034 (1992).

In comparing the marks JUICY COUTURE and JUICY GOO, we first observe that the term JUICY is the dominant element in  

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clothing and shoes and perfume and cosmetics).

opposer's mark. COUTURE is defined as "high-fashion clothing created by designers." The American Heritage Dictionary of the English Language (4<sup>th</sup> ed. 2006).<sup>5</sup> Thus, in relation to the cosmetic goods set forth in opposer's application it is at least suggestive of product's emanating from a designer. With regard to the term GOO in applicant's mark, we take judicial notice that it is defined as "a sticky wet viscous substance" and, as such, is somewhat suggestive of the various cosmetic goods. The American Heritage Dictionary of the English Language (4<sup>th</sup> ed. 2006). In any event, the JUICY part of both marks appears to be an arbitrary term and, coming as the first word in these word marks, makes a stronger impression than the suggestive elements in the marks. Thus, the marks are similar in appearance and overall commercial impression.

As to connotation, given the identity of the goods, whatever meaning the word JUICY would have in relationship to these goods would be the same. We take judicial notice of the following definition of the word JUICY:

Juicy: 1. Full of juice; succulent. 2. a. Richly interesting: a juicy mystery novel. B. Racy; titillating: a juicy bit of gossip. 3. Yielding profit; rewarding or gratifying: a juicy raise; a juicy part in a play.

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<sup>5</sup> University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983) (Board may take judicial notice of dictionary definitions).

The American Heritage Dictionary of the English Language (4<sup>th</sup> ed. 2000).

Moreover, despite the different second word in each mark, COUTURE and GOO, given the identical goods, trade channels and class of purchasers, we find that the overall commercial impression engendered by each of these marks is such that the similarities outweigh the differences. We therefore conclude that the parties' marks are substantially similar.

Thus, considering the marks in their entireties, we conclude that the evidence of record as it pertains to the relevant du Pont factors supports a finding of a likelihood of confusion as between applicant's JUICY GOO mark and opposer's applied-for JUICY COUTURE mark, such that registration of applicant's mark is barred under Trademark Act Section 2(d).

**Decision:** The opposition is sustained contingent upon opposer's registration of the mark in application Serial No. 76376638. The time for filing an appeal or for commencing a civil action will run from the date of the present decision. See Trademark Rules 2.129(d) and 2.145. When opposer's mark has been registered or its application therefor becomes abandoned, opposer should promptly inform the Board, so that appropriate action may be taken to terminate this proceeding.