

**THIS OPINION IS NOT A
PRECEDENT OF THE T.T.A.B.**

Hearing:
October 23, 2007

Mailed:
January 29, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Pramil S.R.L.

v.

Michel Farah
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Cancellation No. 92032341
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Donald L. Dennison of Dennison, Schultz, Dougherty & Macdonald for Pramil S.R.L.

David M. Rogero of David M. Rogero, P.A. for Michel Farah.
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Before Drost, Bergsman and Wellington, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Pramil S.R.L. has petitioned to cancel Registration No. 2447970 for the mark OMIC PLUS, in typed drawing form, for "cosmetics, namely body cream, body oil, skin cream, skin and body lotions, skin moisturizer, skin lightener, skin soap, skin toners, soaps for hands, face and body, in both liquid and solid form." As ground for cancellation, petitioner has alleged priority of use and likelihood of confusion. Specifically, petitioner alleged that since prior to the filing date of respondent's application for the mark OMIC PLUS, it has continuously used the mark OMIC in commerce with the United States in connection with

"cosmetics similar or identical to those described in the registration sought to be canceled," and that respondent's use of the mark OMIC PLUS, in connection with cosmetics, so resembles OMIC, for cosmetics, as to be likely to cause confusion. Michel Farah, the respondent in this case, denied the salient allegations in the petition for cancellation and asserted the following affirmative defenses: (1) petitioner "cannot maintain that that it is entitled to lawfully use or sell its products in the United States"; and, (2) petitioner is guilty of unclean hands because petitioner is misrepresenting the nature, origin, and ingredients of the products identified by its mark.

The Record

By operation of Trademark Rule 2.122, 37 CFR §2.122, the record includes the pleadings and the registration file of the mark sought to be canceled. The record also includes the testimony deposition of Jacob Aini, the corporate secretary and buyer for I.C.E. Marketing, Inc., the exclusive distributor of petitioner's products in the United States, with attached exhibits.¹

¹ Respondent's testimony period was scheduled to close on February 28, 2005. (Board's March 28, 2005 Order). On March 29, 2005, respondent's counsel deposed respondent, and filed the transcript on April 27, 2005. Pursuant to an order dated July 19, 2005, the Board granted petitioner's motion to strike respondent's deposition because it was untimely taken and filed. The Board's July 19, 2005 was affirmed by the Director in an order dated February 28, 2006. In view of the foregoing, we have not given respondent's deposition any consideration.

Standing

A party has standing to cancel a registration under Section 14 of the Trademark Act of 1946 if that party can demonstrate that it has a real interest in the proceeding (*i.e.*, a direct and personal stake in the outcome of the proceeding). *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-1026 (Fed. Cir. 1999); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). In the case *sub judice*, Jacob Aini testified that petitioner manufactures cosmetics such as creams, gels, lotions, and soap identified by the OMIC trademark and exports them into the United States.² Petitioner's use of the OMIC mark in connection with cosmetics is sufficient to establish petitioner's direct commercial interest in its mark and its standing to petition to cancel respondent's mark for OMIC PLUS for cosmetics. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Marmark Ltd. v. Nutrexpa S.A.*, 12 USPQ2d 1843, 1844 (TTAB 1989) (opposer has standing if applicant's mark "is at least arguably confusingly similar to" opposer's mark).

Priority

Because respondent has failed to introduce any evidence regarding the first use of its OMIC PLUS mark, the earliest priority date on which respondent may rely is the filing

² Aini Dep., pp. 10, 12-15.

date of the application for its mark (*i.e.*, May 30, 2000). *Brewski Beer Co. v. Brewski Brothers Inc.*, 47 USPQ2d 1281, 1284 (TTAB 1998); *Home Juice Co. v. Runmlin Companies Inc.*, 231 USPQ 897, 898 n. 5 (TTAB 1986). See also Section 7(c) of the Trademark Act of 1946, 15 U.S.C. §1057(c) ("the filing of an application to register [a mark] shall . . . confer a right of priority, nationwide in effect, . . . against any other person except for a person . . . who, prior to such filing has used the mark").

In order for petitioner to prevail on its claim of priority of use and likelihood of confusion, it must prove that it had a proprietary interest in its OMIC mark prior to May 30, 2000, the filing date of respondent's application to register OMIC PLUS, the registration sought to be canceled. *Brewski Beer Co. v. Brewski Brothers Inc.*, *supra*; *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711, 1714 (TTAB 1993). Mr. Aini testified that petitioner began exporting OMIC cosmetics into the United States in 1994,³ and he supported his testimony with a copy of an invoice, handwritten by him, dated May 13, 1994, from Zuri International, in Brooklyn, New York, to Tex International, in Miami, Florida.⁴ The invoice included 6000 units of OMIC

³ Aini Dep., p. 14. See also Aini Dep. p. 58.

⁴ Aini Dep., Exhibit 1. Mr. Aini owned Zuri International. (Aini Dep., p. 17). Tex International was a distributor in Florida for Zuri International. (Aini Dep., p. 17). See also Aini Dep. p. 58.

Gel Plus. This evidence establishes petitioner's prior use of its OMIC trademark.

Respondent argued that petitioner failed to prove prior use of the OMIC mark for the following reasons:

1. There is no testimony that the OMIC cosmetics were offered to the public;
2. There was no testimony that petitioner put the OMIC mark on the cosmetics;
3. There was no testimony regarding any relationship between Zuri International and petitioner; and,
4. Mr. Aini testified that 9 of the 12 cartons of OMIC cosmetics were shipped to Italy.⁵

We are not persuaded by respondent's arguments that petitioner failed to prove prior use. First, we find that Mr. Aini's testimony is credible. It is based on personal knowledge, it is clear and convincing, and it has not been contradicted. See *National Bank Book Co. v. Leather Crafted Products, Inc.*, 218 USPQ 826, 828 (TTAB 1983); *Liqwacon Corp. v. Browning-Ferris Industries, Inc.*, 203 USPQ 305, 316 (TTAB 1979) (oral testimony may be sufficient to establish both prior use and continuous use when the testimony is proffered by a witness with knowledge of the facts and the testimony is clear, convincing, consistent, and sufficiently circumstantial to convince the Board of its probative

⁵ Respondent's Brief, p. 8

value); *GAF Corp. v. Anatox Analytical Services, Inc.*, 192 USPQ 576, 577 (TTAB 1976) (oral testimony may establish prior use when the testimony is clear, consistent, convincing, and uncontradicted).

We are not persuaded by respondent's specific criticisms of petitioner's testimony for the following reasons:

1. Petitioner used its OMIC mark in commerce. "Use in commerce" for trademarks means a sale or transportation of the goods in the United States interstate commerce or in commerce with foreign nations. Section 45 of the Trademark Act of 1946, 15 U.S.C. §1127. "Commerce" means "all commerce which may lawfully be regulated by Congress." Commerce between the United States and a foreign country is a type of commerce that is regulated by Congress. *Person's Co., Ltd. v. Christman*, 900 F.2d 1564, 14 USPQ2d 1477, 1479 (Fed. Cir. 1990); *Shelby v. Ford Motor Co.*, 43 USPQ2d 1692, 1694 (C.D. Calif. 1997) ("Section 45 makes clear that 'use . . . in the ordinary course of trade' is synonymous with 'use in commerce,' defined as 'all commerce which may be lawfully regulated by commerce'"). The importation of OMIC products by petitioner in Italy, through Zuri International, to Tex International, in Miami, Florida, constitutes use in commerce, and under the circumstances a *bona fide* use of the mark in commerce. See *Cerverceria Centroamericana v.*

Cerverceria India, 892 F.2d 1021, 13 USPQ2d 1307, 1310 ("In cases involving products made from abroad, proof of nonuse of the trademark may require both proof of no importations into the United States and no domestic sales"); *7-11 Sales, Inc. v. Perma, S.A.*, 225 USPQ 170, 171 (TTAB 1984) (petitioner failed to show that respondent's marks were not used in commerce between the United States and a foreign country, and therefore failed to show nonuse). Accordingly, whether Tex International offered the products to the public does not detract from the fact that petitioner's shipment of OMIC products to Tex International constituted a *bona fide* use in commerce.

2. Exhibits 13 and 14 of the Aini deposition are samples packages of OMIC products displaying the OMIC trademark.⁶ The packages are currently in use.⁷ Despite the fact that Mr. Aini did not specifically testify that these packages were used in 1994, there is no evidence or testimony that leads us to believe that petitioner did not use the same or similar packages for its products or that it did not somehow label the products when it first shipped them into the United States;

3. Mr. Aini's testimony establishes that Zuri International imported OMIC products from petitioner. Mr.

⁶ Aini Dep., pp. 38-42.

⁷ Aini Dep., p. 42.

Aini testified that he has been involved with petitioner and its OMIC products since 1994.⁸ Because Mr. Aini testified that Zuri International was his company and Exhibit 1 was a 1994 invoice from Zuri International for the sale of OMIC products, we conclude that Mr. Aini purchased OMIC products from petitioner to ship to Tex International through Zuri International; and,

4. The fact Tex International shipped 9 cartons of OMIC products back to Milan, Italy, a year after it received those products does not detract from the validity of the original shipment from petitioner to Tex International. Tex International shipped 9 cartons of OMIC cream, to Duwin Pharmaceutical and Chemical Co., Ltd. in Milan, Italy. Mr. Aini testified that Exhibit 16 was a bill of lading for a sale of 9 cartons of OMIC Gel Plus from Tex International to Duwin Pharmaceutical and Chemical Co., Ltd.

This document is a shipping line Bill of Lading that clearly states the date of the consignment leaving Florida, which is December 22, 1995, and it describes the nine cartons of Omic Cream being sold from Tex to Duwin International in Italy. This document claims that - - it's a shipping line document, proof that Tex shipped and sold nine cartons of Omic Cream to Duwin International, a customer in Italy.⁹

The shipment from Tex International to Duwin Pharmaceutical

⁸ Aini Dep., pp. 6-7.

⁹ Aini Dep., pp. 94-95.

and Chemical Co., Ltd. appears to be a sale, or at least a shipment, of products from one company to another.

In view of the foregoing, we find that petitioner has established prior use of its OMIC trademark.

Respondent also argued that petitioner failed to prove its continuous use of the OMIC mark, and that it abandoned the mark as demonstrated by three consecutive years of nonuse from 1997 to 2000. According to respondent, petitioner's evidence of its prior and continuous use comprised invoices for products sold by petitioner between 1994 and 1996 and between 2000 and 2004. Petitioner failed to prove use of the mark in 1997, 1998, and 1999, and therefore it has abandoned its mark.¹⁰

Respondent's abandonment argument is a defense to petitioner's evidence of prior use, and therefore respondent bears the burden of proof. *West Florida Seafood Inc. v. Jet Restaurants Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1666 (Fed. Cir. 1994).¹¹ We have two problems with respondent's abandonment defense. First, petitioner was not on notice that respondent was asserting abandonment as a defense to

¹⁰ Respondent's Brief, pp. 10-11.

¹¹ Respondent did not plead abandonment as an affirmative defense. If petitioner's alleged abandonment of its OMIC mark is construed as an affirmative defense, then respondent is precluded from asserting abandonment because abandonment was not set forth in respondent's answer, and it was not tried by implied consent. *Sperry Rand Corporation v. Gruen Industries, Inc.*, 189 USPQ 381, 383-384 (TTAB 1975).

its prior use of the OMIC trademark. Respondent raised abandonment for the first time in its brief. Accordingly, petitioner was not provided an adequate opportunity to rebut the abandonment defense. See *West Florida Seafood Inc. v. Jet Restaurants Inc.*, *supra*, quoting *P.A.B. Products v. Statinine Societa*, 570 F.2d 328, 196 USPQ 801, 804 (CCPA 1978).

Even assuming that respondent's abandonment defense was tried by implied consent, respondent failed to prove that petitioner abandoned its OMIC trademark. In the case *sub judice*, the burden of proof is on respondent to prove that petitioner abandoned its mark by a preponderance of the evidence. *Rivard v. Linville*, 133 F.3d 1446, 45 USPQ2d 1374, 1376 (Fed. Cir. 1998); *Cerverceria Centroamericana v. Cerverceria India*, *supra* at 13 USPQ2d at 1309. Mr. Aini testified that petitioner's sales of OMIC products have been continuous since 1994, and such sales have been without any interruption or cessation.¹² Mr. Aini further testified that the invoices introduced into evidence were "[a] random sampling of a customer and the dates are that way to show the product has been around."¹³ To the extent that petitioner's failure to introduce documentary evidence of its sales in the United States in 1997, 1998, and 1999 could

¹² Aini Dep., p. 29.

¹³ Aini Dep., p. 33.

be construed as three consecutive years of nonuse, Mr. Aini's testimony that petitioner's use has been continuous and uninterrupted is sufficient rebuttal.

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 issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between goods. *See In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *Federated Foods, Inc. v. Fort Howard Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

A. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

The first *du Pont* factor focuses on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). The test 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 impression that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1848 (TTAB 2004).

In this case, we find that the marks are similar in appearance. While marks must be compared in their entirety, it is not improper to accord more or less weight to a particular feature of a mark. *In re National Data Corp.*, 753 F.2d 1056, 24 USPQ2d 749, 751 (Fed. Cir. 1983). The term "OMIC" is the dominant portion of respondent's mark because the word "Plus" is a descriptive or highly suggestive term meaning "added to; along with," "positive or on the positive side of the scale," "added or extra," or "a favorable condition or factor."¹⁴ When used as part of a trademark, "plus" is a laudatory word connoting

¹⁴ The American Heritage Dictionary of the English Language (4th ed. 2006). The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed Cir. 1983). Petitioner sells both OMIC Gel and OMIC Gel Plus. According to Mr. Aini, "Plus means extra or stronger. It doesn't have any significant thing, except telling the people that it's a little bit stronger than the regular. It's a marketing aspect of it." (Aini Dep., pp. 18-19).

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a higher quality product or indicating that the product adds an additional value or quality. This has been recognized in numerous likelihood of confusion cases. *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773 (TTAB 1979); *Plus Products v. Redken Laboratories*, 199 USPQ 111 (TTAB 1978); *Plus Products v. Sterling Food Company, Inc.*, 188 USPQ 586 (TTAB 1975); *Plus Products v. General Mills, Inc.*, 188 USPQ 520 (TTAB 1975).

The significance of the word "Omic" is further reinforced by its location as the first word in respondent's mark. Because it is the first word consumers will see when encountering respondent's mark (and cosmetics), it is more likely to have a greater impact on purchasers and be remembered by them. *Presto Products Inc. v. Nice-Pak Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed on the mind of a purchaser and remembered). See also *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin, supra* at 1692 ("Veuve" is the most prominent part of the mark VEUVE CLICQUOT because "veuve" is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers must first notice the identical lead word).

Finally, in comparing the petitioner's OMIC mark and respondent's OMIC PLUS mark, respondent's mark contains all of petitioner's mark. Likelihood of confusion is often found where the entirety of one mark is incorporated within another. *Johnson Publishing Co. v. International Development Ltd.*, 221 USPQ 155, 156 (TTAB 1982) (EBONY for cosmetics and EBONY DRUM for hairdressing and conditioner). The addition of the descriptive, or highly suggestive, term "plus" is not sufficient to distinguish respondent's mark from petitioner's mark. *In re Xerox Corp.*, 194 USPQ 449 (TTAB 1977) ("6500" and "6500 LINE" are basically the same because the addition of the descriptive word "line" does not distinguish the marks). *See also, The Wella Corp, v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (the inclusion of a suggestive or descriptive word to an otherwise arbitrary term will not preclude a finding of likelihood of confusion).

We also find that the marks are aurally similar because applicant's mark is dominated by the word "OMIC," which is the first word in the marks.

The word "Omic" is an arbitrary or fanciful term when used in connection with cosmetics.¹⁵ As such, it is entitled to a broad scope of protection or exclusivity of

¹⁵ Mr. Aini testified that "Omic" had no particular meaning, and he was unaware of whether "Omic" was an acronym. (Aini Dep., 90-91).

use. Accordingly, consumers familiar with petitioner's OMIC cosmetics may believe, upon encountering respondent's OMIC PLUS cosmetics, that because of the similarity of the marks, respondent's cosmetics are an extra-strength version of petitioner's OMIC cosmetics.

Finally, the overall similarity of the commercial impression engendered by the marks is emphasized by the similarity of the trade dress. Ordinarily, we do not consider trade dress when word marks are at issue because the trade dress can be changed at any time. However, trade dress may provide evidence of whether the word marks project similar commercial impressions. *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1458 (Fed. Cir. 1992). A copy of respondent's packaging¹⁶ and a copy of petitioner's packaging are forth below.¹⁷ Petitioner's packaging is also yellow and white, and the word "plus" is displayed in an identical angle in a

¹⁶ The copy of respondent's packaging is the specimen displaying use of respondent's mark filed as part of respondent's Section 8 Declaration of Use on June 5, 2006. As indicated above, the registration file is part of the record in this proceeding. Although the specimen in the registration file is not evidence on behalf of the respondent, it may be used as evidence against the respondent as an admission against interest. TBMP §704.04 (2nd ed. rev. 2004). See also *Eikonix Corp. v. CGR Medical Corp.*, 209 USPQ 607, 613 n.7 (TTAB 1981) (specimens submitted with application cannot be considered as evidence on behalf of the respondent, but they may be used as an admission against interest).

¹⁷ Petitioner's Exhibit 13 is black and white in the record.

rectangular background to the right of the word "OMIC."¹⁸

Both packages also display the letter "E" in a hexagon. The relevant differences in the packaging are the following:

- (1) petitioner's packaging displays OMIC Cream Plus; and,
- (2) under OMIC Cream Plus, petitioner identifies the product as "Lightening Cream."

Respondent's Packaging



Petitioner's Packaging



Based on our review of the marks, we find that petitioner's OMIC mark and respondent's OMIC PLUS mark are similar when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression.

¹⁸ Aini Dep., pp. 38-39; Exhibit 13.

B. The similarity or dissimilarity and nature of the goods.

Respondent's mark OMIC PLUS has been registered for "cosmetics, namely body cream, body oil, skin cream, skin and body lotions, skin moisturizer, skin lightener, skin soap, skin toners, soaps for hands, face and body, in both liquid and solid form." Petitioner uses its OMIC mark in connection with cosmetics in the nature of lotions, creams, gels, and soaps. They are primarily a facial moisturizer.¹⁹ They also help to provide lighter, clearer, and smoother skin.²⁰ The products are essentially identical because they are cosmetics for moisturizing and lightening skin.

C. The similarity or dissimilarity of likely-to-continue trade channels and the buyers to whom sales are made.

Petitioner's OMIC products are sold primarily to people of color. OMIC is a well-known brand in Africa and the Caribbean.²¹ As indicated above, respondent's OMIC PLUS mark is registered for cosmetics. There is no restriction or limitation on the channels of trade or classes of consumers. Accordingly, we must presume that respondent's cosmetics may be sold in the same channels of trade as petitioner's products and to the same consumers who buy petitioner's products. *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); *Venture Out Properties*

¹⁹ Aini Dep., pp. 10, 13, 14

²⁰ Aini Dep., p. 40; Exhibit 13.

²¹ Aini Dep., p. 13.

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LLC v. Wynn Resorts holding LLC, 81 USPQ2d 1887, 1893-1894 (TTAB 2007); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

D. Balancing the factors.

The *du Pont* case requires us to consider the thirteen factors made of record in likelihood of confusion cases. The CCPA has also observed that "[t]he 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." *Federated Foods, Inc. v. Fort Howard Paper Co.*, *supra* 192 USPQ at 29. When we compare the marks OMIC and OMIC PLUS, the similarity of the goods identified by each mark, and the identity of trade channels, we conclude that there is a likelihood of confusion.

Decision: The petitioner to cancel Registration No. 2447970 is granted and the registration will be cancelled in due course.