

**THIS OPINION
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THE TTAB**

Mailed: April 29, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Daniel T. Phuoc

Serial No. 77356068

Daniel M. Cislo of Cislo & Thomas for Daniel T. Phuoc.

Sani Philippe Khouri, Trademark Examining Attorney, Law
Office 110 (Chris A.F. Pedersen, Managing Attorney).

Before Quinn, Walters and Wellington, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Daniel T. Phuoc has filed an application to register
the standard character mark REVIVE WITH 'THI' on the
Principal Register for "medicated lotions for hand, body and
foot," in International Class 5.¹

The examining attorney has issued a final refusal to
register under Section 2(d) of the Trademark Act, 15 U.S.C.

¹ Serial No. 77356068, filed December 19, 2007, based on an allegation
of a bona fide intention to use the mark in commerce. On May 7, 2008,
applicant filed an amendment to allege use and a specimen of use, which
were accepted by the examining attorney. Applicant alleges first use
and use in commerce as of April 5, 2008.

1052(d), on the ground that applicant's mark so resembles the standard character mark THI² and the design mark shown below,³ previously registered for "adhesives for affixing false eyelashes; cosmetics; false eyelashes," in International Class 3," that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.

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Applicant has appealed. Both applicant and the examining attorney have filed briefs. We reverse the refusal to register.

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. See *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In*

² Registration No. 3284656, issued August 28, 2007. The registration is owned by Taylor Pham.

³ Registration No. 3284659, issued August 28, 2007. The registration is owned by Taylor Pham and includes the following description of the mark: "The mark consist of the word "THI" in lowercase letters, with the lowercase "I" dotted by the design of a leaf."

re Majestic Distilling Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 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.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

We turn, first, to a determination of whether applicant's mark and the registered marks, when viewed in their entirety, are similar in terms of appearance, sound, connotation and commercial impression. 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 impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715 (TTAB 2008). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Furthermore, although the marks at issue must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Both of the cited registered marks consist of the word THI, one in standard character form and the other in stylized lettering. The stylization of the registered design mark is minimal and we find that it is not a distinguishing factor. Moreover, applicant seeks to register his mark in standard character format and, thus, applicant could conceivably display his mark in any lettering style, including that of the word THI in registrant's design mark. *See e.g.*, 37 C.F.R. § 2.52(a); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988) (when registering mark in block letters, registrant remains free to change the display of its mark at any time); and *Sunnen Products Co. v. Sunex Int'l Inc.*, 1 USPQ2d 1744 (TTAB 1987) (styling of letters is irrelevant to the issue of confusion where applicant seeks to register mark without any special form of lettering or design).

Applicant contends that the beginning phrase in his mark "revive with ..." sufficiently distinguishes his mark

from the registered marks. Applicant argues that "revive" is emphasized in the commercial impression of the mark because it is the first word and because it "suggests the product heals and restores something that is damaged, unlike the impression of the registered mark." Applicant makes the following additional argument in his brief:

[T]he phrase REVIVE WITH THI has a rhyming quality and the term as a whole gives a separate impression apart from the two individual words revive and thi included in the phrase. The fact that REVIVE WITH THI has a somewhat internal rhyming quality adds a certain phonetic distinction that THI alone does not.

The cited registered marks consist of the single word THI, which applicant has incorporated into his mark. There is no indication in the record that THI is other than an arbitrary word in English or in the context of either applicant's or registrant's goods. Applicant submitted a list of twenty-one marks that include the term THI from the USPTO database; however, the list includes both applications and registrations, the majority of these are abandoned or cancelled/expired, the goods are not listed, and the marks contain substantial additional matter. The list is not the appropriate manner for making registrations or applications of record in an appeal and it is not sufficient to make the full records of the listed registrations or applications of record. *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1366 (TTAB 2007); and *In re Duofold, Inc.*, 184 USPQ 638, 640 (TTAB

1974). The listed applications establish nothing other than that they were filed with the USPTO. Normally, a list of registrations is not admissible, but in this case, the examining attorney did not object to its submission, so we consider the list to be of record; however, given its deficiencies, it is of no probative value. Thus, this evidence does not establish that the cited registered marks are weak.

The phrase "revive with ..." in applicant's mark pertains directly to the word THI in the mark and it suggests that THI will "restore" the skin or emotional state of the user of applicant's product. As such, THI is the focus of applicant's mark, REVIVE WITH 'THI.' We do not agree with applicant that there is any rhyme or internal rhythm to the mark as a whole that is likely to be perceived by prospective purchasers. Applicant's mark is likely to be perceived as a derivative of, or somehow related to, the registered mark THI, if used in connection with related or similar goods or services. While the marks are different in sound and appearance due to the addition of the phrase "revive with ..." in applicant's mark, we find that the connotations and commercial impressions of the respective marks are substantially similar and, thus, the marks in their entireties are substantially similar.

The *du Pont* factor of the similarities of the marks favors a finding of likelihood of confusion.

Turning to consider the goods involved in this case, we note that the question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than what the evidence shows the goods or services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also, *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991).

Further, it is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited

therein; and *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002).

Applicant's goods are identified as "medicated lotions for hand, body and foot" and the goods in the two cited registrations are identified as "adhesives for affixing false eyelashes; cosmetics; false eyelashes." The examining attorney submitted a definition from the website www.dictionary.cambridge.org of "cosmetics" as "substances put on the face or body that are intended to improve its appearance or quality," and argues, essentially, that applicant's and registrant's goods are related because they both fall within this definition of "cosmetics." In support of this position, the examining attorney submitted ten use-based third-party registrations that are allegedly for "cosmetic-type goods and medicated lotions." The third-party registrations consist of: five registrations that include lotion and medicated lotion; one registration that includes skin care products and medicated lotion; two registrations for distributorship services for various goods including cosmetics and medicated lotion; one registration for lotion and medicated lotion and the manufacture for others of cosmetics and skin care products; and one registration for medicated lotion and polymers for the manufacture of cosmetics and skin care products.

We agree with applicant's contention that the examining attorney's definition of "cosmetics" is extremely broad and, we take additional judicial notice of the definition in *Merriam-Webster's Collegiate Dictionary* (11th ed, 2003) of "cosmetic" as, in relevant part, "of, relating to, or making for beauty esp. of the complexion: beautifying." In other words, "cosmetics" are, in everyday parlance, "make-up," and are usually applied to the face. Clearly, the "false eyelashes" identified in the cited registrations are "cosmetics." However, we do not agree that applicant's medicated lotion is likely to be considered a "cosmetic." This is supported by the fact that the PTO identifications of goods in the third-party registrations separately identify "medicated lotions/skin care products" and "cosmetics." Moreover, even if applicant's medicated lotion were to be considered a "cosmetic," the mere fact that applicant's and registrant's goods might belong to the broad category of cosmetics does not require the conclusion that they are related products. Such a relationship must be established in each case to avoid a *per se* rule for all cosmetics.

We find that the third-party registrations are not probative of a relationship between applicant's and registrant's goods because these registrations do not include both medicated lotions and either cosmetics, false

eyelashes or adhesives for such. Six of the registrations are limited to medicated and non-medicated lotions/skin care products and do not include cosmetics. The registration for medicated lotions and polymers for manufacturing cosmetics and skin care products establishes only that such products may contain polymers manufactured at the same facility. The registration that includes the service of manufacturing cosmetics and skin care products for others and the two registrations for distributorship services do not specify whether the finished or distributed products are identified by the same marks, and we cannot reach this conclusion from the identification of services.

In this case, the examining attorney has not met the required burden of proof because the record is entirely devoid of evidence that the involved goods are related and we cannot draw any such conclusion based only on the language of the respective identifications of goods.

Therefore, despite the similarities in the marks, we find the lack of any evidence that consumers would perceive a relationship between applicant's and registrant's identified goods to be dispositive. We conclude that that examining attorney has failed to establish a likelihood of confusion.

Decision: The refusal under Section 2(d) of the Act is reversed.