

This Opinion is Not a
Precedent of the TTAB

Hearing:
July 19, 2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Smith & Vandiver Corp.

Serial No. 77492026

Brent A. Capehart of Bowers Law Firm for Smith & Vandiver Corp.

Jessica A. Powers, Trademark Examining Attorney, Law Office 104 (Chris Doninger, Managing Attorney).

Before Bergsman, Wellington and Ritchie,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Applicant seeks to register the mark SKIN NUTRITION, in standard character form, on the Principal Register under the provisions of Section 2(f) with a disclaimer of the word "Skin" for the goods set forth below:

Non medicated toilet preparations, namely, hand and body soaps, skin cleansers, toners, hand creams and moisturizers, body lotions and creams, cosmetics, namely, facial moisturizers, toners, facial cleansers, skin treatments, namely, non-medicated skin care preparations, facial masks, eye

Serial No. 77492026

creams, facial serums, exfoliating
facial scrubs, in Class 3.

The trademark examining attorney has refused registration under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), in view of the two prior registrations, owned by different entities, listed below:¹

1. Registration No. 2921924 for the mark NATURE'S SKIN NUTRITION, in typed drawing form, for the goods listed below:

Non-medicated toilet preparations, namely, hand and body soaps, skin cleaners, toners, hand creams and moisturizers, body lotions and conditioners, skin creams, skin lotions and skin moisturizers; cosmetics, namely, facial moisturizers, toners, facial cleansers; skin treatments, namely, non-medicated skin care preparations; eye creams; soaps, hair treatments, namely non-medicated hair care preparations; hair styling preparations, shampoos and conditioners, in Class 3.²

Registrant disclaimed the exclusive right to use the term "Skin Nutrition."

¹ The examining attorney also initially refused registration on the ground that the mark SKIN NUTRITION is merely descriptive. During the prosecution of the application, applicant amended its application to seek registration under the provisions of Section 2(f) (acquired distinctiveness) with a disclaimer of the word "skin" to overcome the descriptiveness refusal. Whether applicant's mark has acquired distinctiveness, especially in light of the two cited registrations and evidence of third-party use of the term "Skin Nutrition," is not before us.

² Issued February 1, 2005; Sections 8 and 15 affidavits accepted and acknowledged.

Serial No. 77492026

2. Registration No. 3262298 for the mark NUTRIMAX SKIN NUTRITION, in standard character form, for "non-medicated skin care preparations," in Class 3.³ Registrant disclaimed the exclusive right to use the term "Skin Nutrition."

Our determination of the refusal under Section 2(d) must be 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, 567 (CCPA 1973). *See also, In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). "The likelihood of confusion analysis considers all *DuPont* factors for which there is evidence of record but 'may focus ... on dispositive factors.'" *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002) (citations omitted). In many cases, two dispositive considerations are the similarities of the marks and the similarities of the goods and services. *See, e.g., Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of

³ Issued July 10, 2007.

the goods and differences in the marks"). Accordingly, we review the evidence of record and the arguments concerning the import of such evidence in light of such considerations.

A. The similarity or dissimilarity and nature of the goods, channels of trade and classes of consumers.

Applicant's goods are in part identical to the goods listed in the cited registrations. The fact that applicant's description of goods includes additional products does not change this finding. It is sufficient for a finding of likelihood of confusion if the relatedness is established for any item encompassed by the identification of goods in the application. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

Because the goods are in part identical, we must presume that the channels of trade and classes of purchasers are the same. See *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"); *In re Smith and*

Serial No. 77492026

Mehaffey, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers").

B. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression and the strength of registrant's mark.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). In comparing the marks, we are mindful that where, as here, applicant's goods are in part identical to registrants' goods, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Real Estate One, Inc. v. Real Estate 100 Enterprises Corporation*, 212 USPQ 957, 959 (TTAB 1981); *ECI*

Serial No. 77492026

Division of E-Systems, Inc. v. Environmental Communications Incorporated, 207 USPQ 443, 449 (TTAB 1980).

Moreover, 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 overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1835, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992).

The marks are similar in terms of sight, sound, meaning and commercial impression to the extent that they all include the term "Skin Nutrition." However, the marks are different because the registered marks include a prefix term: NATURE'S SKIN NUTRITION and NUTRIMAX SKIN NUTRITION. Thus, the issue before us is whether the absence of a prefix term in applicant's mark is sufficient to distinguish it from the registered marks. For the reasons stated below, we find that the differences in the marks outweigh the similarities.

This issue is similar to the issue we face when a house mark is added to otherwise similar product marks.

There is no *per se* rule concerning whether the addition of a house mark (e.g., NATURE'S or NUTRIMAX) would or would not be sufficient to differentiate the marks from the common elements of the marks (e.g., SKIN NUTRITION). *New England Fish Co. v. Hervin Co.*, 511 F.2d 562, 184 USPQ 817, 819 (CCPA 1975). We note that this case is somewhat different because applicant seeks to register the common element (*i.e.*, absent the house mark of registrants). More frequently, applicant seeks to register a mark that comprises a previously-registered term with the addition of applicant's own house mark or other matter. In any event and in all such cases, we must consider the entire marks, including the presence of any house mark in light of the evidence of record.

The Board has previously described the different effects the addition (or subtraction) of a house mark can have in the likelihood of confusion analysis:

[S]uch addition may actually be an aggravation of the likelihood of confusion as opposed to an aid in distinguishing the marks so as to avoid source confusion. On the other hand, where there are some recognizable differences in the asserted conflicting product marks **or the product marks in question are highly suggestive or merely descriptive** or play upon commonly used or registered terms, the addition of housemark and/or other material to the assertedly conflicting

Serial No. 77492026

product mark has been determined sufficient to render the marks as a whole sufficiently distinguishable.

In re Christian Dior, S.A., 225 USPQ 533, 534 (TTAB 1985) (citations omitted) (applicant's LE CACHET DE DIOR confusingly similar to CACHET because applicant failed to prove that the word "cachet" was highly suggestive, descriptive or commonly used or registered) (Emphasis added). See also *Nike Inc. v. WNBA Enterprises LLC*, 85 USPQ2d 1187, 1201-1202 (TTAB 2007) (S and a star design for athletic bags and clothing is likely to cause confusion with S STARTER and star design for identical products). Compare with *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313 (TTAB 2005) (NORTON MCNAUGHTON ESSENTIALS for ladies' sportswear not likely to cause confusion with ESSENTIALS for women's clothing); and *In re S. D. Fabrics, Inc.*, 223 USPQ 54, 55 (TTAB 1984) ("designers/fabric" and design for retail store services in the field of fabrics, wall hangings, buttons and accessories is not likely to cause confusion with DAN RIVER DESIGNER FABRICS and design for textile fabrics).

In *Knight*, the Board found that the word "essentials" was highly suggestive when used in connection with clothing. As evidence of the highly suggestive nature of the word "essentials," the Board relied on a dictionary

Serial No. 77492026

definition of "essentials" as connoting that "the clothing items sold under the marks are basic and indispensable components of, or 'essentials' of, one's wardrobe," as well as 23 third-party registrations, owned by 21 different entities, that include the word "essentials" as part of the mark. Based on the evidence, the Board found that purchasers would be able to distinguish among the various "essential" marks by looking to other elements of the marks. *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d at 1316.

In this case, applicant amended its application to seek registration under the provisions of Section 2(f) of the Trademark Act (acquired distinctiveness) and to disclaim the exclusive right to use the word "Skin" to overcome a descriptiveness refusal pursuant to Section 2(e)(1) of the Trademark Act. For procedural purposes, a claim of distinctiveness under §2(f), whether made in the application as filed or in a subsequent amendment, may be construed as conceding that the matter to which it pertains is not inherently distinctive and, thus, not registrable on the Principal Register absent proof of acquired distinctiveness. *See, e.g., Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1577, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988); *In re Cabot Corp.*, 15 USPQ2d 1224, 1229 (TTAB

Serial No. 77492026

1990); *In re Prof'l Learning Ctrs., Inc.*, 230 USPQ 70, 71 (TTAB 1986); *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984).

During the prosecution of the cited registrations, both registrants agreed to disclaim the term "Skin Nutrition" when the examining attorneys required a disclaimer of that term on the ground that "Skin Nutrition" is merely descriptive when used in connection with skin care products.⁴ Under these circumstances, the disclaimers of the term "Skin Nutrition" by the registrants constitute further evidence regarding the merely descriptive nature of that term, as applied to the goods in connection with which they are registered, and an acknowledgement of the lack of an exclusive right therein at the time of the disclaimer. *In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1442 (TTAB 2005) ("it has long been held that the disclaimer of a term constitutes an admission of the merely descriptive nature of that term ... at the time of the disclaimer"). *See also*

⁴ Applicant's Brief, Exhibits A and B. Exhibits A and B are copies of the relevant Office actions requiring the registrants to disclaim the exclusive right to use "Skin Nutrition" on the ground that the term is merely descriptive. Although the exhibits were not timely filed, the examining attorney did not object to the exhibits and referenced applicant's argument in her brief ("the applicant presents arguments that the wording 'SKIN NUTRITION' is 'weak' based on disclaimers of the wording in each registration"). (Examining Attorney Brief, p. 4). Accordingly, we will treat the exhibits as being of record.

Serial No. 77492026

Quaker State Oil Refining Corp. v. Quaker Oil Corp., 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972) (disclaimer is an admission of descriptiveness at the time the disclaimer was made); *In re Interco Inc.*, 29 USPQ2d 2037, 2038 n.3 (TTAB 1993) ("It has been held that the disclaimer of a term constitutes both an admission of the merely descriptive nature of such term, as applied to the goods or services in connection with which it used, and an acknowledgement of the lack of an exclusive right therein at the time of the disclaimer."). Thus, the dominant portion of the marks in the cited registrations are the words "Nature's" in the mark NATURE'S SKIN NUTRITION and "Nutrimax" in the mark NUTRIMAX SKIN NUTRITION.

In addition, in the April 20, 2009 Office action, the examining attorney submitted third party use of the term "Skin Nutrition" in connection with skin care products.

1. ASHLEY SKIN NUTRITION website (ashleyskinnutrition.com) advertising the sale of "Skin Nutrition Systems."
2. Bliss website (blissworld.com) advertising the SKIN NUTRITION ++ brand of cosmetics designed "around a synergistic face, body and nutrition wellness concept."
3. EVITAMINS website (evitamins.com) selling "Hair & Skin Nutrition by Enzymatic Therapy."

Hair & Skin Nutrition® provides a balanced combination of vitamins, minerals, and other natural factors to nutritionally support the body systems involved in maintaining healthy skin and hair.

4. An article posted in the *SmartSkinCare.com* website.

Does nutrition make a difference in skin rejuvenation

... While a skin cream may provide a number of important substances, it is never enough to ensure a proper, all-around skin nutrition.

* * *

We discuss these issues in other articles of this section and, in further detail, in the Skin & Nutrition Infopack.

5. An article posted in the *American Chronicle* website (americanchronicle.com) on November 7, 2007) entitled "Skin Nutrition - Minerals For Your Skin."

Based on this evidence, we find that purchasers will be able to distinguish the marks because the common elements are descriptive and consumers will perceive the term "Skin Nutrition" in the marks NATURE'S SKIN NUTRITION and NUTRIMAX SKIN NUTRITION as ordinary descriptive speech, not as trademarks. Hence applicant's amendment to seek registration pursuant to the provisions of Section 2(f) coupled with registrants' disclaimers of the exclusive

right to use "Skin Nutrition" are significant in this case. That a descriptive or generic term is given little weight in the likelihood of confusion analysis reflects marketplace reality because consumers give little source indicating significance to descriptive terms. There is no reason to believe, and there is no evidence on the point, that consumers are likely to perceive the term "Skin Nutrition" in the registered marks as anything other than a type, not a brand, of skin care preparation. To hold otherwise gives registrants the exclusive right to use the term, "Skin Nutrition" when it is a privilege that they hold in common with all others, including applicant.

In view of the foregoing, we find that the marks are not similar in terms of their appearance, sound, meaning and commercial impression.

C. Balancing the factors.

Having considered the evidence of record as it pertains to the relevant likelihood of confusion factors, we find that confusion is unlikely to result from the contemporaneous use of NATURE'S SKIN NUTRITION and NUTRIMAX SKIN NUTRITION and applicant's SKIN NUTRITION mark, even though the marks are used on identical products that move in the same channels of trade and are sold to the same classes of consumers. We find that dissimilarity of the

Serial No. 77492026

marks, simply outweighs the evidence as to the other factors. See *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1889), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

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