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PRECEDENT OF THE T.T.A.B.

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Kose Corporation

Serial No. 77519214

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Before Seeherman, Grendel and Kuhlke, Administrative
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Kose Corporation seeks registration on the Principal
Register of the standard character mark AQ for goods
identified as "cosmetics, perfumes, cosmetic soaps, cotton
for cosmetic use and hair care preparations" in
International Class 3 and "eyebrow brushes, cheek brushes,
eye shadow brushes, mascara combs, compacts sold empty, lip
brushes, powder puffs and foundation sponges for applying

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make-up" in International Class 21.¹ Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used on its identified goods, so resembles the registered standard character mark PARADISE MAKEUP AQ for "makeup," in International Class 3 (Reg. No. 3236733), as to be likely to cause confusion, mistake or deception.

Our determination of the issue of likelihood of confusion 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 & 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, 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).

"Makeup" is defined as "cosmetics: cosmetic products, specifically for the face, e.g., lipstick and mascara." Encarta World English Dictionary (North American Edition

¹ Application Serial No. 77519214, filed July 10, 2008, alleging a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. §1052(b).

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2007) attached to September 12, 2008 Office Action. Thus, applicant's "cosmetics" in International Class 3 encompass and are legally identical to registrant's "makeup." Applicant's various items in International Class 21 ("eyebrow brushes" etc.) are closely related to registrant's makeup. The goods 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). Registrant's make-up and applicant's make-up applicators would be used together and, as such, are complementary. Id. The use-based third-party registrations submitted by the examining attorney support this finding. In re Albert Trostel & Sons CO., 29 USPQ2d 1783 (1993) (third-party registrations may serve to suggest that such goods emanate from the same source.) See, e.g., Reg. No. 3328757 for the mark LARENIM for, inter alia, cosmetics, namely make-up for the eyes, face and body, and make-up brushes and facial sponges for applying make-up.

Further, because the application and cited registration do not contain limitations and the goods are legally identical and otherwise closely related, we must presume that they travel in the same channels of trade and are available to the same classes of customers. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987).

We turn then to an analysis of the similarity or dissimilarity of the marks when compared in their entirety in terms of appearance, sound, connotation and commercial impression.

The examining attorney argues that the marks are similar because the marks "contain the same wording" AQ which comprises the entirety of applicant's mark. Br. p. 4. In addition, the examining attorney argues that the "letters 'AQ' have been given greater weight in the likelihood of confusion analysis because it is the common wording that both marks share [and t]he arbitrary letters 'AQ' are not descriptive or even suggestive of either the applicant's or the registrant's goods [and] there is no evidence that the letter combination 'AQ' is weak or diluted when used in conjunction with the applicant's or

the registrant's products." Br. pp. 5-6. Finally, she argues that the "common lettering 'AQ' creates a similar overall commercial impression because consumers are likely to view 'AQ' as a house mark for cosmetics, makeup, and other personal care and beauty products [and] seeing the registrant's 'PARADISE MAKEUP AQ' products, consumers are likely to believe that the goods are a specific product line within the applicant's 'AQ' general line of cosmetics." Br. p. 7.

In response, applicant argues that the word PARADISE is the dominant word in registrant's mark inasmuch as it is arbitrary and is the first term in the mark. In addition, applicant argues that the letters AQ have a different connotation in registrant's mark. Applicant bases this assertion on a response the registrant made to the Office during prosecution of the application which matured into the cited registration wherein the registrant stated that "AQ in PARADISE MAKEUP AQ is short for aqueous." Request for Reconsideration (June 26, 2009). Finally applicant argues that:

Applicant's prior application to register the mark AQ COSME DECORTE ABSOLUTE QUALITY ... for similar goods in International Classes 3 and 21, and which prominently bears the term AQ, has been allowed to register over the cited mark PARADISE MAKEUP AQ. Similarly, the cited mark was allowed to register over Applicant's previously approved

application for the mark AQ for similar goods in International Classes 3 and 21.... Moreover, the cited mark PARADISE MAKEUP AQ was allowed to register over a registration for the mark AQ DAY for facial cream. Although the AQ DAY mark has since cancelled, it is notable that the owner of the cited mark, in traversing a refusal based on the AQ DAY mark, submitted arguments that even though both of the marks contain the term AQ, they are different in sound, appearance, meaning or connotation, and stated that the dominant term in its mark was PARADISE, not AQ. Given the owner of the cited mark's own arguments and statements, the mark PARADISE MAKEUP AQ should not be afforded a wide ambit of protection.

Br. p. 12.

We find that PARADISE is the dominant element in registrant's mark. It is an arbitrary term, and appears at the beginning of the mark. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, (Fed. Cir. 2005); *Presto Prods. Inc. v. Nice-Pak Prods. Inc.*, 9 USPQ2d 1895 (TTAB 1988). Moreover, PARADISE is followed by the word MAKEUP, a generic term, that has the effect of further emphasizing the first word. The lettering AQ comes at the end after the generic term and appears almost as an afterthought. Thus, the word PARADISE is the element with the strongest source-identifying capability in registrant's mark.² In re

² In this regard, we do not agree with the examining attorney's analysis giving greater weight to the term AQ in registrant's mark because it is the common term and is not descriptive. It must first be determined what, if anything, is the dominant element in a mark, regardless if it is the common element.

National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). We further note that the registrant itself characterized PARADISE as the dominant element of its mark when prosecuting the application that resulted in the registration. Cf. Interstate Brands Corp. v. Celestial Seasonings, Inc., 576 F.2d 926, 198 USPQ 151, 154 (CCPA 1978) (although not determinative, prior statements in a similar proceeding may be "illuminative of shade and tone in the total picture confronting the decision maker"). In view thereof, considering the marks in their entirety, despite the common lettering AQ, we find that they are dissimilar in appearance, sound, connotation and commercial impression.

In making this finding, we do not give any credence to applicant's argument regarding the connotation of the element AQ in the respective marks. The record here does not support applicant's argument that AQ would have a different connotation in registrant's mark. While the registrant noted the meaning "aqueous" for AQ during the prosecution of its underlying application, there is nothing in the record to indicate that consumers would associate the meaning "aqueous" in connection with registrant's types of goods or if consumers did associate the meaning "aqueous" with the letters AQ when used in connection with

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makeup or cosmetics, that they would not make that same association when used in applicant's mark. In addition, there is nothing about the words PARADISE or MAKEUP that give the letters AQ a specific or different meaning from the letters used alone, as in applicant's mark.

In conclusion, in this case the dissimilarity of the marks is dispositive. See *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) ("We know of no reason why, in a particular case, a single duPont factor may not be dispositive"). Applicant's mark used on its identified goods is not likely to cause confusion with the cited registration.

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