

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

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Oral Hearing:
October 19, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Coty US LLC

Serial No. 77631330

Paul W. Garrity of Sheppard Mullin Richter and Mapton LLP,
for Coty US LLC.

Timothy J. Finnegan, Trademark Examining Attorney, Law
Office 104 (Chris Doninger, Managing Attorney).

Before Holtzman, Wellington, and Ritchie, Administrative
Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

Coty US LLC has filed an application to register on the
Principal Register the mark TEMPEST, in standard character
form, for services which were ultimately identified as
"perfumery, namely, perfume, perfumed soaps, eau de
toilette, perfumed body wash, and perfumed shower gel," in
International Class 3.¹

Registration has been finally refused under Section

¹ Application No. 77631330, filed December 11, 2008 under Section
1(b) of the Trademark Act, claiming a bona fide intent to use.

2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's mark, when applied to the identified goods, so resembles the mark TEMPEST, also registered in standard character form, for "indoor tanning preparations," in International Class 3,² as to be likely to cause confusion, mistake, or to deceive.

Applicant and the examining attorney filed briefs, and applicant filed a reply brief. At the request of applicant, an oral hearing was held. The hearing was presided over by this panel.

We reverse the refusal to register.

Our determination of the issue of likelihood of confusion is based on an analysis of all 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 Company, 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 and/or services. 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.

² Registration No. 3551671, issued December 23, 2008.

1997). Another key factor in this case concerns the conditions under which, and the buyers to whom sales of the goods are made.

We first consider the *du Pont* factor of similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 177 USPQ at 567. The marks are identical, both being the word TEMPEST, in standard character form. This appears to be an arbitrary term for the goods in cited registration, and there is no reason to believe that the word would have a different commercial impression or connotation when applied to the goods in the application. Accordingly, this *du Pont* factor favors finding a likelihood of consumer confusion.

We next turn to a consideration of the similarity or dissimilarity of the goods and services. It is well-settled that the question of likelihood of confusion must be determined based on an analysis of the goods identified in the application vis-à-vis the goods identified in the registration. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991). It is enough that the goods and 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 would 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 registrant's and applicant's goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and the cases cited therein.

Applicant argues that the goods offered under its mark are distinctly different than those offered under the registered mark which are "a very narrow set of goods" such that there is no overlap between the two. (appl's brief at 9). The examining attorney, on the other hand, contends that the respective goods are similar because they both "fall under the category of cosmetics" and involve potentially overlapping clients or markets. (examining atty's brief at unnumbered 4 of 11.) In support of this position, the examining attorney made of record third-party registrations that purportedly demonstrate that consumers may be familiar with the idea of one entity offering goods identified by both applicant and registrant under the same mark. Copies of use-based, third-party registrations may serve to suggest that the goods and/or services are of a

type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993). However, on close inspection, we find that the third-party registrations submitted into the record by the examining attorney cover goods that are distinctly different from (or not sufficiently clear that they are the same as) those at issue in this case. For example, none of the identifications in the third-party registrations contains the clear limitation present in applicant's identification of "indoor" tanning preparations or even "tanning preparations" generally. A number mention "sun tanning preparations," but the identification in the cited registration is clearly not intended to include "preparations" for "tanning" in the "sun." Moreover, there is no evidence in the record that otherwise establishes that "indoor tanning preparations" are a similar category of goods to those identified in the application or that they involve similar classes of consumers or channels of trade. Therefore, regardless of sheer number of registrations submitted, we of course have to look carefully at the content thereof. The examining attorney has simply not carried his burden of showing that indeed there is relatedness, and that these goods are of the type that consumers may expect to emanate from a single source and

travelling through the same or similar channels of trade. For this reason, the second and third *du Pont* factors weigh against finding a likelihood of confusion.

We turn next to the *du Pont* factor considering the conditions of sale and the sophistication of the purchasers. Although we look to the standard of care of the least sophisticated consumer, the examining attorney has conceded that the "indoor tanning preparations" identified in the cited registration are directed toward sophisticated professionals. (Examining attorney's brief, unnumbered 9.) That registrant's customers are sophisticated is not by itself a determinative factor. See *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983). However, circumstances suggesting care in purchasing may tend to minimize likelihood of confusion. As our principal reviewing Court has pointed out, "sophistication is important and often dispositive because sophisticated end-users may be expected to exercise greater care." *Electronic Design & Sales Inc. v. Electronic Date Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992). In this case, we find that this *du Pont* factor weighs against finding a likelihood of confusion.

As discussed above, we find that the evidence of record does not support a finding that there is a likelihood of

Ser No. 77631330

confusion. While the marks are legally identical, the examining attorney has not carried his burden of showing a viable relationship between applicant's identified goods and the goods in the cited registration, or that they would travel in the same or similar channels of trade. We further find that the consumers of registrant's goods are likely to be sophisticated professionals. We therefore conclude that confusion is not likely.

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