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- EXAMINER BRIEF

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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)**

**APPLICATION SERIAL NO.** 77830997

**MARK:** REEF SAFE



**CORRESPONDENT ADDRESS:**

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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**TTAB INFORMATION:**

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

**APPLICANT:** TROPICAL SEAS, INC.

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

0115223

**CORRESPONDENT E-MAIL ADDRESS:**

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**EXAMINING ATTORNEY'S APPEAL BRIEF**

The applicant, Tropical Seas, Inc, has appealed the trademark examining attorney's final refusal to register the proposed mark REEF SAFE for use in conjunction with sun care lotions. Registration was refused under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), on the grounds that consumers who utilize the applicant's and registrant's goods are likely to confuse the applicant's proposed mark with U.S. Registration Nos. 2,579,774 and 1,166,023 for REEF, used on "sun block preparations," and "REEF OIL (stylized), used on "suntan lotion."

The examining attorney respectfully requests that the Trademark Trial and Appeal Board (hereinafter, "The Board") affirm the refusal to register.

## **STATEMENT OF FACTS**

On September 21, 2009, applicant filed Application Serial No. 77/830,997 to register the mark REEF SAFE on the Principal Register for goods identified as “sun care lotions” in Class 3, based on applicant's use of the mark. In an Office Action dated December 17, 2009, the examining attorney refused registration of the mark under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), on the grounds that applicant's mark, when used on or in connection with the identified goods, so resembles the mark in U.S. Registration Nos. 2,579,774 and 1,166,023 and 2,895,321 as to be likely to cause confusion, to cause mistake, or to deceive.

In its response dated February 19, 2010, applicant set forth reasons why the Section 2(d) refusal should be withdrawn. In a final Office Action dated April 15, 2010, the examining attorney maintained and made final the refusal to register the mark under Section 2(d) of the Trademark Act. Applicant filed a request for reconsideration of the final. On November 15, 2010, the examining attorney denied the request for reconsideration as to Reg. Nos. 2,579,774 and 1,166,023, and withdrew the refusal to register as to Reg. no. 2895321.

Applicant filed its Appeal Brief on January 17, 2011.

## **ISSUE ON APPEAL**

**The only issue to be decided by the Board is whether applicant's mark is likely to cause confusion with U.S. Registration Nos. 2,579,774 and 1,166,023.**

### **LIKELIHOOD OF CONFUSION ARGUMENT**

#### **I. General Rules of Analysis for Section 2(d) Cases**

Trademark Action Section 2(d) bars registration where an applied-for mark so resembles a registered mark that it is likely, when applied to the goods and/or services, to cause confusion, mistake or to deceive the potential consumer as to the source of the goods and/or services. TMEP § 1207.01. *The Court in In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), listed the principal factors to consider in determining whether there is a likelihood of confusion. Among these factors are the similarity of the marks as to appearance, sound, meaning, and commercial impression, and the relatedness of the goods and/or services. The overriding concern is to prevent buyer confusion as to the source of the goods and/or services. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (C.C.P.A. 1974).

#### **II. Comparison of the Marks**

**A. General Rules for Comparison of Marks**

The marks are compared for similarities in sound, appearance, meaning or connotation. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1536 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *In re Mack*, 197 USPQ 755 (TTAB 1977); TMEP §1207.01(b). The marks are compared in their entireties under a Section 2(d) analysis. Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976). *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); TMEP §1207.01(b)(viii).

**B. The Marks Are Highly Similar in Sound, Appearance, & Overall Commercial Impression**

Applicant's mark, REEF SAFE, is similar to registrant's mark, REEF and REEF OIL. Both marks consist of the dominant term REEF. The only differences between the two marks is the additional wording, SAFE, in Applicant's mark and the disclaimed wording, OIL,

in the registrant's mark. This slight difference does not alter the overall commercial impression of the marks because the dominant feature of the marks, namely REEF, which holds the strongest trademark significance, is identical. It should also be noted that the Registrant no. 2579774 contains no additional wording or design elements. Although Registration no: 1166023 contains a design element and the wording "OIL," the additional wording is descriptive and both registered marks are owned by the same Registrant.

Regarding the issue of likelihood of confusion, the question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558 (C.C.P.A. 1972). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 54 USPQ2d 1894, 1890 (Fed. Cir. 2000); *Visual Information Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP §1207.01(b). The mere addition of a term to a registered mark does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Section 2(d). *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) ("GASPAR'S ALE and "JOSE GASPAR

GOLD”); *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975) (“BENGAL” and “BENGAL LANCER”); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) (“THE LILLY” and “LILLI ANN”); *In re El Torito Rests. Inc.*, 9 USPQ2d 2002 (TTAB 1988) (“MACHO” and “MACHO COMBOS”); *In re United States Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (“CAREER IMAGE” and “CREST CAREER IMAGES”); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (“CONFIRM” and “CONFIRMCELLS”); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (“ACCUTUNE” and “RICHARD PETTY’S ACCU TUNE”); *In re Cosvetic Laboratories, Inc.*, 202 USPQ 842 (TTAB 1979) (“HEAD START” and “HEAD START COSVETIC”); TMEP §1207.01(b)(iii).

**C. Applicant’s Argument**

Applicant argues that the wording REEF is commonly used by third parties which supports the fact that consumers are accustomed to differentiating marks containing the term REEF for water related products. First, there has been no evidence presented to indicate REEF is weak with regard to suntan products. While it is true that REEF is suggestive of aquatic life, and people who use suncare lotions may be concerned about the products’ harmful affects on the environment, then consumers are likely to assume that REEF is a house mark for various types of sun care products and is part of a family of marks in the “REEF” product line. Consumers would believe that REEF SAFE is the sun care lotion produced by the makers of REEF suntan lotion, just as it is the maker of

REEF OIL suntan lotions. When seeing two sun care products with the first portion of the mark REEF, this portion is likely to be seen as the house mark. The additional matter, SAFE, is likely to be seen as simply clarifying which particular product out of a full line of goods.

### III. **Relatedness of Goods and Services**

#### A. **General Rules for Relatedness of Goods and Services**

The second step in a likelihood of confusion analysis is to compare the goods or services of the parties to determine whether they are similar or related or whether the activities surrounding their marketing are such that confusion as to origin is likely. *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984); *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re Int'l Tel. and Tel. Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Prods. Co. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); TMEP §1207.01(a)(i).

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. Instead, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080,

56 USPQ2d 1471 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Prods. Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re Int'l Tel. & Tel. Corp.*, 197 USPQ 910 (TTAB 1978); TMEP §1207.01(a)(i).

A determination of whether there is a likelihood of confusion is made solely on the basis of the goods and/or services identified in the application and registration, without limitations or restrictions that are not reflected therein. *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595 (TTAB 1999). If the cited registration describes the goods and/or services broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, then it is presumed that the registration encompasses all goods and/or services of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992); *In re Elbaum*, 211 USPQ 639 (TTAB 1981); TMEP §1207.01(a)(iii). Moreover, any goods or services in the registrant's normal fields of expansion must also be considered in order to determine whether the registrant's goods or services are related to the applicant's identified goods or services for purposes of analysis under Section 2(d). *In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977). The test is whether purchasers would believe the product or service is within the registrant's logical zone of expansion. *CPG Prods. Corp. v. Perceptual Play, Inc.*, 221 USPQ 88 (TTAB 1983); TMEP §1207.01(a)(v).

**B. The Registrant's Goods are Highly Related to the Applicant's Goods**

Applicant is seeking registration of the mark for “sun care lotions” in Class 3. The registered marks are for “sun block preparations” and “suntan lotion” in Class 3. These goods are closely related, if not identical, because they are all sun care products which would pass through the same channels of trade. The examining attorney requests that this Board take judicial notice of the dictionary definition of the term “sun block” attached to this brief from Merriam-Webster Online Dictionary 2011, that defines “sun block” as “a preparation applied to the skin to prevent sunburn.”

Furthermore, the label on the applicant's specimen of record describes the goods as “sun block lotion.” The registrant also describes its goods as “sun block preparations.”

**C. Applicant's Argument**

Applicant does not dispute that the goods are related or highly similar. Rather the Applicant argues that the “fact that the respective marks are dissimilar is dispositive on the issue of likelihood of confusion.” To the contrary, although the marks themselves are not identical, the dominant portion is identical. Likewise, if the goods or services of the respective parties are closely related, the degree of similarity between marks required to support a finding of likelihood of confusion is not as great as would apply with diverse goods or services. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), cert. denied 506 U.S. 1034 (1992); *In*

*re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); *ECI Division of E-Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443 (TTAB 1980); TMEP §1207.01(b).

As such, because the goods are nearly identical, there is likelihood of confusion.

## **CONCLUSION**

The Applicant's mark is highly similar to the registrant's mark. The Applicant's goods are highly related to the registrant's goods. As a result of these similarities, a likelihood of confusion exists. Therefore, the Board is respectfully requested to affirm the refusal to register that issued under Section 2(d) of the Trademark Act.

Respectfully submitted,

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sunburn (as by physically blocking out ultraviolet radiation);  
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SUNSCREEN  
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