

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

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sanyet Ferdinand

Serial No. 77965837

Morris I. Pollack for Sanyet Ferdinand

Kathryn E. Coward, Trademark Examining Attorney, Law Office
115 (John Lincoski, Managing Attorney)

Before Seeherman, Zervas and Shaw, Administrative Trademark
Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Sanyet Ferdinand has appealed from the final refusal
of the trademark examining attorney to register mark shown
below for "retail store services featuring perfumes."¹

Applicant has disclaimed the exclusive right to use PERFUME
and PARIS apart from the mark as shown.

¹ Application Serial No. 77965837, filed March 23, 2010, based
on Section 1(a) of the Trademark Act, and asserting first use and
first use in commerce as early as November 20, 2009.



Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's mark, as used for his identified services, so resembles the mark PARIS PERFUMES and design, as shown below, registered for "distributorship services in the field of perfumes," that it is likely to cause confusion or mistake or to deceive.² The registration includes a disclaimer of the word PERFUMES, and the stylized words PARIS PERFUMES in the mark have been registered pursuant to Section 2(f).³



PARISPERFUMES

² The examining attorney initially refused registration on the additional grounds that the mark is geographically deceptive and primarily geographically deceptively misdescriptive, Sections 2(a) and 2(e)(3) of the Trademark Act. When applicant submitted, in response to a requirement for information about the goods that applicant sells, that "at least some of Applicant's perfumes come from Paris, France," the examining attorney accepted the disclaimers of PERFUME and PARIS and withdrew the refusals under these sections. Accordingly, those issues are not before us in this appeal.

³ Registration No. 3798130 issued June 8, 2010.

We reverse the refusal of registration.

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).

Turning first to the services, applicant's services are retail store services featuring perfumes, and the registrant's services are identified as distributorship services in the field of perfumes. To show that these services are related, the examining attorney has submitted a large number of third-party registrations that show a single mark has been registered for both retail store services and distributorship services. However, the subjects of most of the store and distributorship services are very different from perfume. For example, Registration No. 2919027 is retail and distributorship services featuring books and compact disks, and Registration No. 3027745 is for these services featuring elevators. There are only two registrations for goods arguably similar to perfume: Registration No. 3140379 is for, inter alia, retail store services and wholesale distributorship

services featuring personal care products, and Registration No. 3379332 is for wholesale distributorship services and retail store services featuring, inter alia, beauty products and beauty and personal care accessories. Thus, there is very limited evidence to show that, with respect to perfume, companies have adopted a single mark for both distributorship and retail store services or, indeed, that companies offer both types of services in the field of perfume.

With respect to the du Pont factor of the channels of trade, there is some question as to whether the public at large, who are customers of retail store services, would encounter distributorship services in the field of perfume. The examining attorney has made of record Internet evidence in an attempt to show that the general public is able to purchase perfume from distributors. A website called "ineed2know," www.ineed2know.org, and having the slogan "The Answers You're Looking For-Fast, Friendly and Free," states that "Many wholesale distributors sell discount perfume and can be found online." In a webpage from PerfumeDistributor.com, www.perfumedistributor.com, that company describes itself as "the largest wholesaler of discounted perfume and cologne." It appears from this

website that this company offers products to the public at large.⁴

On the other hand, the definitions for "distributor" made of record by the examining attorney are "a wholesaler who has exclusive rights to market, within a given territory, the goods of a manufacturer or company,"⁵ and "a wholesaler or middleman engaged in the distribution of a category of goods, esp. to retailers in a specific area."⁶ These definitions show that distributorship services are by wholesalers who are middlemen who sell products to retailers who in turn sell them to the general public.

Applicant argues that distributorships market to retailers rather than to the public at large. With respect to the website evidence reporting distributors marketing to ultimate consumers, or wholesale sales to the public, applicant states that these companies are merely using the "guise" of wholesalers in order to sell perfumes at discount prices. It appears to be applicant's position

⁴ A third webpage submitted by the examining attorney, called inet Health, <http://inethealthtips.com>, with the subtitle "Community Health Information, Tips, Resources and News," uses such poor English that we question how legitimate the information is. Thus, we give this evidence no probative value.

⁵ Dictionary.com, <http://dictionary.reference.com>, based on the Random House Dictionary, (2011).

⁶ Dicitonary.com, based on Collins English Dictionary, 10th ed. (2009).

that a company would or could not be considered a distributorship if it were selling to the ultimate consumer. The examining attorney essentially accepts that this is an accurate distinction:

The applicant further argues that retail stores and distributorships are different channels of trade because retailers provide goods to the consumer whereas distributorships are business entities that market to business entities who are themselves the retailers. This distinction is technically accurate according to the dictionary evidence found in the September 19, 2011 Office action.

Brief, unnumbered p. 6, referencing the dictionary definitions reported above.

After reviewing the evidence, we conclude that "distributorship services," as identified in the cited registration, are not rendered to the public at large. The mentions of "wholesale distributors" on the "ineed2know" website, and "wholesaler" on the PerfumeDistributor.com website can be viewed, as applicant suggests, as mere puffery in advertising that the perfume is sold at discount prices. The website evidence does not outweigh the clear meaning of "distributorship services" shown by the dictionary definitions, or serve to broaden the ordinary meaning of "distributorship services" identified in the registration.

Accordingly, we view the registrant's distributorship services as being rendered to retail businesses and others in the trade, rather than to the public at large. Thus, retailers or others in the trade are the only entities that would be aware of or who could encounter both the applicant's retail store services rendered under his mark and the registrant's distributorship services rendered under its mark. We must therefore assess the likelihood of confusion from the standpoint of these entities.⁷

Those in the perfume trade, whether distributors or retail store operators, must be treated as sophisticated and careful purchasers, and thus would be aware of trademarks and likely to notice differences between them.

With this in mind, we turn to a consideration of the marks. It is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has

⁷ Although customers of distributorship services in the field of perfume would be retail stores, and therefore are presumably not customers of retail stores featuring perfume, they would know of other retail stores that sell perfume, and could believe that there was an association between the distributorship services and the retail store services if they were rendered under the same or a similar mark. Such confusion could have a deleterious effect on the registrant, since a retail store might decide not to purchase goods from the distributor if it thought that the distributor also had a competing retail store.

been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). In the present case, applicant's mark consists of the words PERFUMES and PARIS, and the design of the Eiffel Tower. The word PERFUME, which has been disclaimed, is generic for the goods that are the focal point of applicant's retail store services, and PARIS, which has also been disclaimed, describes the geographic origin of some of the perfume. Although these words form part of the mark, and cannot be ignored in our comparison, because they are descriptive/generic they are entitled to less weight in our analysis. In other words, consumers will look to other source-identifying features of the mark, i.e., the Eiffel Tower design. Thus, although normally if a mark comprises both a word and a design, the word is normally accorded greater weight because it would be used by purchasers to request the goods or services, see In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987), that principle does not apply to this mark.

We reach a similar conclusion for the cited mark, such that we give greater weight to the design element for this mark as well. The word portion of the mark consists of a

term, PARIS, that describes the geographic origin of the goods that are the subject of the services, and a term, PERFUMES, which is disclaimed, that is generic for those goods. We recognize that the registrant's Section 2(f) claim as to the words PARIS PERFUMES was accepted by the examining attorney during the prosecution of the underlying application, so we do not treat these words as merely descriptive/geographically descriptive, but the acquired distinctiveness must be recognized to derive from the registrant's use of the mark as a whole, and the conclusion of acquired distinctiveness is to the stylized manner in which the words are depicted, and not to the words per se. That is, the Section 2(f) claim in the registration does not give the registrant exclusive rights to the word PARIS or PARIS PERFUMES (as noted, the registration in fact includes a disclaimer to exclusive rights to the word PERFUMES).

Thus, when the marks are compared in their entireties, and giving appropriate weight to the dominant elements in each, it is clear that the design portions of the respective marks are quite different in appearance and significance. Further, although both marks consist of the words PARIS and PERFUME(S), they appear in a different

order, with the cited mark depicting PARIS PERFUMES,⁸ with the "normal" English-language construction of the adjective before the noun, and with PARISPERFUMES shown in a stylized format that emphasizes the word PARIS. In applicant's mark the word PERFUME appears in larger type font and physically separated from the word PARIS, which appears under the depiction of the Eiffel Tower, such that it is unclear whether the mark would be pronounced PERFUME PARIS; even if it were, the odd syntax of PERFUME PARIS creates a somewhat different impression from PARIS PERFUMES.

Accordingly, the only similarity between the marks is that they both include the words PARIS and PERFUME(S). However, these common elements are not a sufficient basis for us to conclude that the marks are confusingly similar. In particular, the sophisticated purchasers who would be the only overlapping customers for the parties' services would not assume that, merely because marks includes the words PERFUME(S) and PARIS, that the marks indicate that the services emanate from the same source. Given the limited scope of protection to which the registrant's mark is entitled, e.g., the registrant does not have exclusive

⁸ We acknowledge that the cited mark does not have a space between PARIS and PERFUMES; however, because PARIS is shown in darker lettering than PERFUMES, the term will be read and understood as two separate words.

rights to use the word PERFUMES, and the acquired distinctiveness of PARIS PERFUMES is limited to the way the phrase is used in the mark, we find that the overall differences in appearance, connotation and commercial impression are sufficient to distinguish the marks.

Accordingly, in the particular circumstances of this case, we find that the Office has not proved that applicant's mark for his services is likely to cause confusion with the registered mark.

Decision: The refusal of registration is reversed.