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Subject: U.S. TRADEMARK APPLICATION NO. 78811559 - SEACRET - SEAC-11043 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 78811559

MARK: SEACRET

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GENERAL TRADEMARK INFORMATION:

http://www.uspto.gov/trademarks/index.jsp

TTAB INFORMATION:

http://www.uspto.gov/trademarks/process/appeal/index.jsp

APPLICANT: SEACRET SPA INTERNATIONAL LTD

CORRESPONDENT'S REFERENCE/DOCKET NO:

SEAC-11043

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the examining attorney's[1] final refusal to register the trademark SEACRET in International Class 3 for goods ultimately identified as "products containing ingredients from

[1] The application was originally assigned to examining attorney Tanya Amos. On October 1, 2008, the application was reassigned to examining attorney April A. Hesik. On April 8, 2013, the application was reassigned to the undersigned examining attorney, Timothy O. Schimpf.

the Dead Sea, namely, non-medicated skin care preparations, namely, moisturizers, facial cleansers, facial peels, masks, lotions, creams, scrubs, soaps, nail care preparations, hand creams, cuticle oils; after shave" on the ground that the applied-for mark is likely to be confused with the marks in U.S. Registration Nos. 3094293, 2855103, 2855101, and 0645874 pursuant to Trademark Act Section 2(d), 15 U.S.C. Section 1052(d).

FACTS

On February 9, 2006, applicant SEACRET SPA INTERNATIONAL LTD filed U.S. Application Serial No. 78811559 to register the mark SEACRET in stylized lettering for "skin care products; after shave; and nail care products" in International Class 3. In an Office action dated August 7, 2006, the examining attorney refused registration on the ground that the applied-for mark was likely to be confused with the marks in U.S. Registration Nos. 2898086, 3094293, 2855103, 2855101, 1351236, and 0645874 pursuant to Trademark Act Section 2(d). The examining attorney also noted a potential likelihood of confusion with the mark in U.S. Application No. 78598113. The examining attorney also issued requirements to amend the description of the mark and to amend the identification of goods.

In response to the initial Office action, applicant amended the description of the mark, added International Class 8, and amended the identification to "products containing ingredients from the Dead Sea; namely, non-medicated skin care preparations; nail care preparations; after shave" in International Class 3 and "Nail files and nail buffers" in International Class 8. Applicant also objected to the 2(d) refusal. On April 20, 2007, the examining attorney maintained the Section 2(d) refusal and the requirement to amend the identification of goods and then suspended the application pending the outcome of U.S. Application No. 78598113.

On June 8, 2012, applicant filed a response to the letter of suspension requesting the removal from suspension because U.S. Application Serial No. 78598113 had matured into U.S. Registration No.

4147145 and applicant is the owner of that registration. Applicant also amended the identification of goods in International Class 3 to "Products containing ingredients from the Dead Sea, namely, non-medicated skin care preparations; nail care preparations; after shave" in International Class 3. On June 29, 2012, the examining attorney removed the application from suspension and issued a final Section 2(d) refusal because of a likelihood of confusion with the marks in U.S. Registration Nos. 3094293, 2855103, 2855101, and 0645874.

On December 31, 2012, applicant filed a request to divide the goods in International Class 8 into a separate application. Applicant also amended the goods in International Class 3 to the current identification of goods: "Products containing ingredients from the Dead Sea, namely, non-medicated skin care preparations, namely, moisturizers, facial cleansers, facial peels, masks, lotions, creams, scrubs, soaps, nail care preparations, hand creams, cuticle oils; after shave" in International Class 3. Applicant also requested reconsideration of the Section 2(d) refusal.

On January 13, 2013, the request to divide was granted and the goods in International Class 8 were moved to U.S. Application Serial No. 78981469. On January 25, 2013, the examining attorney reviewed applicant's request to reconsider, but maintained the refusal to register because of a likelihood of confusion with the marks shown in U.S. Registration Nos. 3094293, 2855103, 2855101, and 0645874. This appeal now follows.

The registered marks are all owned by the same entity, the Procter & Gamble Company. The registered marks are:

> U.S. Registration No. 3094293 is the standard character mark SECRET for "body spray" in International Class 3.

> U.S. Registration No. 2855103 is the stylized word SECRET with a small flower design for "personal deodorant/anti-perspirant" in International Class 3.

U.S. Registration No. 2855101 is the stylized word SECRET for "personal deodorant/anti-perspirant" in International Class 3.

U.S. Registration No. 0645874 is the stylized word SECRET for "personal deodorant" in International Class 3.

PRELIMINARY MATTER

Applicant is the owner of U.S. Registration No. 4147145, which is the standard character mark SEACRET for "Skin care products containing ingredients from the Dead Sea, namely, facial cream, facial peeling milk, facial mud mask, Non-medicated facial serum, eye gel, anti-wrinkle cream, mud soap, mineral soap, after shave, hand cream, salt facial scrub, body cream with salt, Non-medicated foot cream and body lotion." During the application process for that mark, registrant Procter & Gamble filed opposition proceeding 91174407 with the Trademark Trial and Appeal Board opposing the registration based on a likelihood of confusion with registrant's marks. Before registrant filed the brief in opposition, the opposition proceeding was suspended multiple times pending settlement negotiations. After several years of suspension, when the suspension period expired registrant failed to file the brief in opposition and the proceeding was dismissed with prejudice due to registrant failing to file a brief in opposition.

In previous responses, applicant argued that because applicant overcame the opposition filed by registrant in U.S. Registration No. 4147145, the applied-for mark in this case should also register. While a prior adjudication pertaining to an applicant, including decisions of the Trademark Trial and Appeal Board, may be dispositive of a later application for registration of the same mark on the basis of the same facts and issues, under the doctrine of res judicata, collateral estoppel, or stare decisis, those doctrines do not apply here. *See* TMEP §1217.

Res judicata, or claim preclusion, protects against relitigation of a previously adjudicated claim between the same parties or their privies based on the same cause of action. *In re Bose Corp.*, 476 F.3d 1331, 81 USPQ2d 1748 (Fed. Cir. 2007) (stating that application for registration of speaker design is barred by Federal Circuit's 1985 decision affirming refusal of registration of the same mark for the same goods on the ground that the proposed mark was functional). A plaintiff is barred by res judicata from bringing a second action if: (1) there is identity of parties (or their privies); (2) there has been an earlier final judgment on the merits of a claim; and (3) the second claim is based on the same set of transactional facts as the first. *Sharp Kabushiki Kaisha v. ThinkSharp, Inc.*, 448 F.3d 1368, 1370, 79 USPQ2d 1376, 1378 (Fed. Cir. 2006); *Mayer/Berkshire Corp. v. Berkshire Fashions, Inc.*, 424 F.3d 1229, 1232, 76 USPQ2d 1310, 1312 (Fed. Cir. 2005); *Jet, Inc. v. Sewage Aeration Sys.*, 223 F.3d 1360, 1362, 55 USPQ2d 1854, 1856 (Fed. Cir. 2000); *Zachry Infrastructure, LLC v. Am. Infrastructure, Inc.*, 101 USPQ2d 1249 (TTAB 2011). A defendant in an earlier proceeding is precluded from bringing a later action if: "(1) the claim or defense asserted in the second action was a compulsory counterclaim that the defendant failed to assert in the first action, or (2) the claim or defense represents what is essentially a collateral attack on the first judgment." *Nasalok Coating Corp. v. Nylok Corp.*, 522 F.3d 1320, 1324, 86 USPQ2d 1369, 1372 (Fed. Cir. 2008) (finding that cancellation petitioner is barred from challenging the validity of the subject registration where the petitioner could have asserted, but did not assert, a claim of invalidity in an earlier infringement action, and noting that the cancellation petition amounted to a collateral attack on the district court's judgment).

The doctrine of res judicata does not apply in this instance because there is neither identity of the parties nor the same set of transactional facts. Specifically, the parties in the inter partes proceeding were applicant and registrant, whereas this is an ex parte proceeding involving the applicant and the Office. Thus, because the owner of the cited registrations is not a party herein, there is no identity of the parties. Moreover, the transactional facts are different here because the test applied to

determine the registrability of the mark – a likelihood of purchaser confusion – is not the same test in an opposition, where the opposer asserts "damage". *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

The requirements for application of collateral estoppel are (i) the issue is identical to one in a prior proceeding; (ii) the identical issue was actually litigated; (iii) determination of the issue was necessary to the judgement in the prior proceeding; and (iv) the party defending against preclusion had a full and fair opportunity to litigate the issue in the prior proceeding. *Mayer/Berkshire Corp. v. Berkshire Fashions, Inc.*, 424 F.3d 1229, 1232, 76 USPQ2d 1310, 1313 (Fed. Cir. 2005) (citing *Montana v. U.S.*, 440 U.S. 147, 153-155, 99 S. Ct. 970, 59 L. Ed. 2d 210 (1979)). The doctrine of collateral estoppel does not apply in the present case because the issues that were the subject of the opposition proceeding were not actually litigated because the Office records show that judgment was entered against registrant for failure to file a brief in opposition. Neither applicant nor registrant filed a brief discussing any substantive issue in that proceeding. As no issues were raised or litigated, collateral estoppel does not apply.

Stare decisis provides that when a court has once laid down a principle of law as applicable to a certain set of facts, it will adhere to that principle, and apply it to all future cases, where the facts are substantially the same, regardless of whether the parties and properties are the same. *In re Johanna Farms Inc.*, 8 USPQ2d 1408, 1410 (TTAB 1988). The doctrine of stare decisis does not apply here because in dismissing the opposition for failure to file a brief in opposition, the Trademark Trial and Appeal Board has not laid down a principle of law as applicable to the facts in this ex parte proceeding. As a result, the course of proceedings during the registration of U.S. Registration No. 4147145 are not controlling or applicable to the current application.

ISSUE ON APPEAL

Whether the applied-for mark with the literal element SEACRET is similar to the registered marks with the literal element SECRET and the registrant's various skin products are closely related to applicant's skin care such there is a likelihood of confusion by purchasers.

ARGUMENT

THE MARKS ARE CONFUSINGLY SIMILAR AS THE LITERAL ELEMENTS OF THE MARKS ARE NEARLY IDENTICAL AND THE GOODS ARE CLOSELY RELATED SUCH THAT CONSUMERS ARE LIKELY TO BE CONFUSED OR MISTAKEN OR DECEIVED AS TO THE SOURCES OF THE GOODS UNDER SECTION 2(d) OF THE TRADEMARK ACT

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused, mistaken, or deceived as to the source of the goods of the applicant and registrant. *See* 15 U.S.C. §1052(d). In the seminal decision *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), the court listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all the factors are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1355, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011); *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

The overriding concern is not only to prevent buyer confusion as to the source of the goods, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP

§1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

Taking into account the relevant du Pont factors, a likelihood of confusion determination in this case involves a two-part analysis. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567 (C.C.P.A. 1973). The marks are compared for similarities in their appearance, sound, connotation and commercial impression. TMEP §§1207.01, 1207.01(b). The goods are compared to determine whether they are similar or commercially related or travel in the same trade channels. *See Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); TMEP §§1207.01, 1207.01(a)(vi).

I. THE MARKS ARE CONFUSINGLY SIMILAR

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361, 177 USPQ at 567); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *see In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

In this instance, the applied-for mark is SEACRET in stylized lettering, and the registered marks are SECRET in standard characters (U.S. Registration No. 3094293), SECRET and a small flower design (U.S. Registration 2855103), and SECRET in stylized lettering (U.S. Registration Nos. 2855101 and 0645874). The applied-for mark is similar to the registered marks because the literal portions of the marks, that is, SEACRET and SECRET, sound similar. In both words, the first syllable will be pronounced "see" and the second syllable will be pronounced "cret". The marks are essentially phonetic equivalents

and thus sound similar. Similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d at 1535; *see In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d at 1586; TMEP §1207.01(b)(iv). For purposes of the Section 2(d) analysis, there is no "correct" pronunciation of a mark because it is impossible to predict how the public will pronounce a particular mark; therefore, "correct" pronunciation cannot be relied on to avoid a likelihood of confusion. *See, e.g., In re Viterra Inc.*, 671 F.3d at 1367, 101 USPQ2d at 1912 (upholding the Board's affirmance of a Section 2(d) refusal to register XCEED for agricultural seed based on a likelihood of confusion with the registered mark X-SEED and design, SEED disclaimed, for identical goods); *Centraz Indus. Inc. v. Spartan Chem. Co. Inc.*, 77 USPQ2d 1698, 1701 (TTAB 2006) (acknowledging that "there is no correct pronunciation of a trademark" and finding ISHINE (stylized) and ICE SHINE, both for floor finishing preparations, confusingly similar); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 n.3 (TTAB 1987) ("[C]orrect pronunciation as desired by the applicant cannot be relied upon to avoid a likelihood of confusion."); *Kabushiki Kaisha Hattori Tokeiten v. Scuotto*, 228 USPQ 461 (TTAB 1985) (holding SEYCOS and design for watches, and SEIKO for watches and clocks, likely to cause confusion); *In re Great Lakes Canning, Inc.*, 227 USPQ 483 (TTAB 1985) (holding CAYNA (stylized) for soft drinks, and CANA for, inter alia, canned and frozen fruit and vegetable juices, likely to cause confusion); *In re Energy Telecomms. & Elec. Ass'n*, 222 USPQ 350 (TTAB 1983) (holding ENTELEC and design for association services relating to telecommunications and other electrical control systems for use in the energy related industries, and INTELECT for promoting, planning, and conducting expositions and exhibitions for the electrical industry, likely to cause confusion); *In re Cresco Mfg. Co.*, 138 USPQ 401 (TTAB 1963) (holding CRESCO and design for leather jackets, and KRESSCO for hosiery, likely to cause confusion). The marks are similar because they sound similar.

The lettering of the applied-for mark is stylized while the mark in U.S. Registration No. 3094293 is in standard characters. A mark in standard characters may be displayed in any lettering style; the

rights reside in the wording or other literal element and not in any particular display or rendition. *See In re Viterra Inc.*, 671 F.3d 1363, 101 USPQ2d at 1909; *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii). Thus, a mark presented in stylized characters generally will not avoid likelihood of confusion with a mark in standard characters because the marks could be presented in the same manner of display. *See, e.g.*, *In re Viterra Inc.*, 671 F.3d at 1363, 101 USPQ2d at 1909; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (stating that "the argument concerning a difference in type style is not viable where one party asserts rights in no particular display"). The stylization in the applied-for mark does not obviate a likelihood of confusion because the U.S. Registration No. 3094293 could be presented with any stylization, including the stylization in the applied-for mark.

U.S. Registration No. 2855101 and 0645874 display the word SECRET in stylized lettering that differs from the stylization of the lettering in the applied-for mark. However, the stylization of each mark is minor and the literal element of each mark, the similar wording SEACRET and SECRET, is prominently visible. Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. *See In re Viterra Inc.*, 671 F.3d 1362, 101 USPQ2d at 1908; *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Greater weight is often given to this dominant feature when determining whether marks are confusingly similar. *See In re Nat'l Data Corp.*, 753 F.2d at 1058, 224 USPQ at 751. Despite the stylization, the wording is the most dominant feature of the marks because when consumers request the goods, they will use the dominant and phonetically equivalent wording SEACRET and SECRET. Here, the word portions of the marks are nearly identical in appearance, sound, connotation, and commercial impression. Both marks convey the commercial impression of a secret or secret ingredients because the only word of the registered marks is "secret" and applied-for mark is play

on the word "secret." Therefore, the addition of stylized lettering does not obviate the similarity of the marks in this case. *See In re Shell Oil Co.*, 992 F.2d at 1206, 26 USPQ2d at 1688; TMEP §1207.01(c)(ii).

U.S. Registration No. 2855103 includes stylization and a small design of flower. The small flower design appears small next to the large lettering of the mark. The size of the wording makes the wording SECRET the dominant part of the registered mark. Although marks must be compared in their entireties, the word portion generally may be the dominant and most significant feature of a mark because consumers will request the goods using the wording. *See In re Viterra Inc.*, 671 F.3d at 1362, 101 USPQ2d at 1908; *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1247 (TTAB 2010). For this reason, greater weight is often given to the word portion of marks when determining whether marks are confusingly similar. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); TMEP §1207.01(c)(ii). The small design of a flower does not obviate a likelihood of confusion because consumers will focus on the larger wording of U.S. Registration No. 2855103 that is similar to the wording of the applied-for mark.

Applicant argues that the word SEA in the first three letters of SEACRET is the dominant element of the mark that consumers will separate out of the applied-for mark. Marks must be compared in their entireties and should not be dissected. *In re Chatam Int'l Inc.*, 380 F.3d 1340, 1342, 71 USPQ2d 1944, 1946-47 (Fed. Cir. 2004). Contrary to applicant's argument, the mark is not two words with one word dominating over the other word. Instead, the mark is one word – SEACRET - that must be compared in its entirety to the registered marks. Purchasers will not perceive the applied-for mark as two words, but as a novel misspelling of the word SECRET that creates the same commercial impression as the word SECRET in the registered marks. As discussed above, the word SEACRET is phonetically equivalent to the word SECRET in the registered marks and similarity in sound alone is sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d at 1535; *see In re 1st USA Realty*

Prof'ls, Inc., 84 USPQ2d at 1586; TMEP §1207.01(b)(iv). Comparing the marks in their entireties, the similarity in sound between the marks is sufficient to find a likelihood of confusion between the marks.

Applicant also argues that the marks are visually different because they are spelled differently and the stylization of the applied-for mark creates the appearance of a wave which consumers would relate to the lettering SEA. The slight differences highlighted by applicant are not sufficient to obviate the similarities between the marks. With regard to the literal element of the marks, the only difference between the applied-for and registered marks is the inclusion of an "A" in the applied-for mark. The addition of the stylization of the wording does not obviate a likelihood of confusion because it is well established that when the literal elements of marks are virtually identical, neither stylization of wording nor minor design elements will overcome a likelihood of confusion. *See, e.g., In re Dakin's Miniatures, Inc.*, 59 USPQ2d at 1596; TMEP §1207.01(c)(ii); *In re Viterra Inc.*, 671 F.3d at 1362, 101 USPQ2d at 1908 (citing *CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir 1983)). Given the identical pronunciation of the marks and the similarity of the majority of the lettering of the marks, the slight visual stylization differences cannot overcome the confusing similarity between the marks.

Applicant argues that the spelling of the applied-for mark and the wave stylization creates a commercial impression of the sea, which is a different commercial impression from the registered marks. However, applicant states that in addition to the sea connotation, the applied-for mark will also convey an impression of "secret ingredients" because the applied-for mark is a play on the word "secret." The registered marks also use the word "secret" and have a similar commercial impression of secret ingredients. Despite any additional sea connotation, as applicant admits, the applied-for mark will convey the commercial impression of the word "secret" which is the same commercial impression as the word "secret" in the registered marks. As a result, the applied-for mark has a similar commercial impression of the registered marks.

Thus, when looking at the various goods identified in the marks, a consumer would be confused as to the source of the goods because of the use of the phonetically equivalent wording SEACRET and SECRET. Therefore, the marks are confusingly similar.

II. THE GOODS ARE CLOSELY RELATED

The applied-for mark is used on products containing ingredients from the Dead Sea, namely, non-medicated skin care preparations, namely, moisturizers, facial cleansers, facial peels, masks, lotions, creams, scrubs, soaps, nail care preparations, hand creams, cuticle oils, and after shave. The registered marks are used in connection with body spray (U.S. Registration No. 3094293), personal deodorant/antiperspirant (U.S. Registration Nos. 2855103 and 2855101), and personal deodorant (U.S. Registration No. 0645874).

The goods of the parties need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); TMEP §1207.01(a)(i). The respective goods need only be related in some manner or the conditions surrounding their marketing be such that they will be encountered by the same consumers under circumstances that would lead to the mistaken belief that the goods originate from the same source. *Gen. Mills Inc. v. Fage Dairy Processing Indus.*, 100 USPQ2d 1584, 1597 (TTAB 2012); TMEP §1207.01(a)(i).

As a preliminary matter, it must be presumed that registrant's goods encompass all types of deodorants, anti-perspirants, and body sprays, including those containing, like applicant's goods, ingredients from the Dead Sea. It is well settled that when analyzing an applicant's and registrant's goods for similarity and relatedness, that determination is based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. *See Octocom Sys. Inc.*

v. Hous. Computers Servs. Inc., 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *see also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002).

Applicant's goods are related to the registrant's goods because they are all products to care for the skin. Applicant identifies moisturizers, creams, oils, soaps, and other products while applicant identifies body spray, deodorant, and anti-perspirants. All the goods are applied to the skin to care for the skin by moisturizing, cleaning, perfuming, or other methods. As the goods are similar skin care products, the goods would be sold to the same class of purchasers and encountered under circumstances leading one to mistakenly believe the goods originate from the same source. In particular, the evidence from www.burstein-deadsea.com demonstrates that deodorant and antiperspirant, skin care preparations, aftershave and nail care cream, all containing minerals from the Dead Sea, are marketed under the same mark and offered to consumers at the same website. *See attachments to Office action dated June 29, 2012 at 146-49.* The evidence from www.deadseapremium.com demonstrates that nail care preparations and skin care preparations containing ingredients from the Dead Sea are sold together with deodorant at the same online retail store. *See attachments to Office action dated June 29, 2012 at 89-100.* Similarly, at www.magicspa.net, deodorant, skin care preparations, and nail care preparations all containing ingredients from the Dead Sea, as well as nail care kits containing nail files and nail buffers, are marketed through an online retail store. *See attachments to Office action dated June 29, 2012 at 101-05.* Furthermore, at www.ahavaus.com, skin care preparations containing ingredients from the Dead Sea and after shave are sold under the same trademark as body spray. *See attachments to Office action dated June 29, 2012 at 106-12.* Additionally, see also evidence from www.lalineusa.com (online retail store offering skin care preparations with ingredients from the Dead Sea, nail care preparations, deodorants, and body sprays) *attached to Office action dated June 29, 2012 at 113-20*; www.thefragranceshoppeonline.com (offering Dead Sea skin care products, body spray, deodorant, nail care preparations, nail files and nail buffers)

attached to Office action dated June 29, 2012 at 121-35; www.jesusboat.com (offering antiperspirant with Dead Sea minerals and Dead Sea skin care preparations and after shave) *attached to Office action dated June 29, 2012 at 136-44*; www.aroma-deadsea.com (offering deodorant with Dead Sea minerals and Dead Sea skin care preparations) *attached to Office action dated January 25, 2013 at 89-100.*

The above referenced evidence establishes that the same entity commonly manufactures the relevant goods and markets the goods under the same mark and that the relevant goods are sold through the same trade channels and used by the same classes of consumers in the same fields of use such that purchasers are likely to believe the relevant goods emanate from the same source. Therefore, applicant's and registrant's goods are considered related for likelihood of confusion purposes. *See, e.g.*, *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Evidence obtained from the Internet may be used to support a determination under Trademark Act Section 2(d) that goods are related. *See, e.g.*, *In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009); *In re Paper Doll Promotions, Inc.*, 84 USPQ2d 1660, 1668 (TTAB 2007).

The evidence of record also includes evidence from the USPTO's X-Search database consisting of a number of third-party marks registered for use in connection with similar goods as those of both applicant and registrant in this case. This evidence shows that the goods listed therein, namely, non-medicated skin care preparations and aftershave on the one hand, and deodorant, antiperspirant, and body spray, on the other, are of a kind that may emanate from a single source under a single mark. *See In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii). As the representative sample below demonstrates, purchasers are accustomed to encountering these goods offered under a single trademark. Specifically:

Reg. No.	Mark	Relevant Goods	Location
3230510	ERBAVIVA	Baby oils, baby soaps, body lotions, essential oils for personal use, shampoos, aromatherapy oils, sunscreen, washing sachets containing natural and herbal cleansers, bath soaps, bath oils, bath salts, aromatic room and body sprays, aromatherapy bath oils, and gift sets in bag or box form containing combinations of the previously listed goods; Stretch-mark cream, foot balm for pregnant women, cheek balm for babies, lip balm, **deodorant**, and body wash; essential oils for personal use; aromatherapy room and body sprays and oils; **deodorants for personal use**; sun-screening creams; massage oils; creams and lotions for skin care; soaps and shampoos; non-medicated skin care preparations, face and body care lotions and creams, hair care preparations, non-medicated bath and shower preparations; bath oils and bath salts; skin moisturizers; room fragrances and spray-bottles for perfuming rooms; non-medicated baby oils and baby creams	4/20/2007 Office Action at 21-23.
3169570	THE BATH LOUNGE	hair care products, namely, shampoo, conditioners; skin care products, namely, non-medicated skin care preparations; personal care products, namely, **deodorants**, soaps for personal use, and body wash	4/20/2007 Office Action at 30-32.
3184524	RAFRAICHISSANT IMMEDIAT	Non-medicated skin care preparations; hair care preparations; body care products, namely, body soaps, body creams, body lotions, body powders, non-medicated **deodorants and anti-perspirants**; suncare products, namely, sunscreen, sun block and sun tanning	4/20/2007 Office Action at 33-35.

		preparations; preparations to protect the skin from the sun; namely, sun creams and after-sun lotions; bath products, namely, bath beads, bath foam, bath gels, bath lotion, bath oil, bath powder, and non-medicated bath salts; perfume, cologne, cosmetics and makeup	
2831561	RIVAGE RR	Non-medicated dead sea salts for the bath; dead sea body mud and dead sea facial mud mask; hair shampoo; soaps and creams for the hands, face, and body; personal **deodorants**; hair spray, massage oil, aroma therapy salts, after-shave lotions, eye gels, shower gels, foam bath lotions	1/25/2013 Office Action at 46-48.
3772169	ONE PLANET	Body spray used as a personal deodorant; **Anti-perspirant**; Skin moisturizer; After-shave balm; Shower and bath gel; Shaving balm; Shaving preparations; Personal **deodorant**	1/25/13 Office Action at 21-22.
3926048	AA	Soaps for personal use, liquid soaps; cosmetics products for the care of the skin, namely, facial creams, facial serums, makeup removers, masks, moisturizer masks, facial gels, facial peels, tonic lotions, balms, body lotions, body olive oils, cocoa butter, body milks, body gels, body peels, lipsticks, eyebrow pencils, mascara, hand creams, personal **deodorants**, foot care creams	1/25/13 Office Action at 23-25.
3824507	NATURAL SERENADE	Baby oil; baby powder; bath gel; bath oil; bath powder; beauty masks; non-medicated bath salts; body cream; body oil; body powder; body sprays; body lotions; body moisturizers; body mists; bubble bath; skin cleansing lotion; cold cream; cosmetic pencils; eye creams; eye gels;	1/25/13 Office Action at 26-28.

		hand cream; night cream; shaving cream; skin cleansing cream; skin cream; personal deodorants; **deodorants and anti-perspirants**; essential oils for personal use; eye makeup; eye pencils; eye shadow; eyebrow pencils; eyeliners; face powder; facial scrubs; foundation makeup; hair gel; shaving gel; shower gel; lip gloss; lipstick; makeup; mascara; blush; make-up bases; skin moisturizer; nail lacquer and glitter; nail polish; nail polish top coat; talcum powder; rouge; skin clarifiers; skin cleansing lotions; skin lotion; body soaps; skin soap; glycerin soap; skin toners; deodorant soap; liquid soaps for hands, face and body; lip pencils; lip balm; blushers; foot care products, namely, foot lotions, non-medicated foot powder, foot scrubs; aroma therapy products, namely, essential oils, fragrance beads and potpourri; hair care products, namely, shampoo, hair conditioner, hair cleaning preparations, hair rinses, hair lighteners; lotion bars; linen sprays; solid perfume; liquid perfume; fragrance oils; soap and facial soaps	
2923290	DIVIDENDS	Shaving cream, Shaving gel, **Deodorant**, **Anti-perspirant**, Fragrances for personal use, Body Spray, Body Lotion	1/25/13 Office Action at 35-36.
4013334	FAT BASTARD	Skin lotion, sun screen, shampoo, conditioner, hair coloring, shaving cream, after shave lotion, perfume for men, body spray for men used as a personal deodorant and as a fragrance, **anti-perspirant deodorant**, soap	1/25/13 Office Action at 39-40.
4140102	PRIMAJOLIE	Cosmetics and body care products, namely, **deodorants** for personal use, body oils, cuticle oils and hair oils, skin moisturizers, body powders, essential oils for personal use, skin	1/25/13 Office Action at 41-42.

		cleansers, lotions for skin and bath oils; fragrance, namely, scented oils for personal use	
2851449	PALEMO	Skin care and hair care products, namely, blusher, eye shadow, liquid foundation, loose and pressed facial powder, liquid eye liner, mascara, eye liner pencils, lip liner pencils, lipstick, nail polish, and nail polish remover; non-medicated dead sea salts for the bath; dead sea body mud and dead sea facial mud mask; soaps and creams for the hands, face, and body; personal **deodorants**; massage oil, aroma therapy salts, after-shave lotions, eye gels, shower gels, foam bath lotions, hair shampoos and conditioners; hair spray	1/25/13 Office Action at 43-45.

Ultimately, all of these registrations have probative value to the extent that they serve to suggest that the goods listed therein are of a kind that may emanate from a single source. *See In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-1218 (TTAB 2001).

Applicant argues that the goods are dissimilar because applicant identifies different goods than registrant. This argument is not convincing because, while the goods of the parties are not identical, they are closely related. As discussed previously, the goods of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient to show that because of the conditions surrounding their marketing, or because they are otherwise related in some manner, the goods would be encountered by the same consumers under circumstances such that offering the goods under confusingly similar marks would lead to the mistaken belief that they come from, or are in some way associated with, the same source. *In re Iolo Techs.*, LLC, 95 USPQ2d 1498, 1499 (TTAB 2010); *see In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223

USPQ 1289, 1290 (Fed. Cir. 1984); TMEP §1207.01(a)(i). In this case, the evidence of record amply demonstrates that the goods of parties are related because they commonly emanate from the same manufacturer, are marketed under the same marks, and are offered to the same groups of consumers in the same trading channels.

Applicant also argues that the trade channels of the goods are dissimilar, with its goods being relatively expensive products sold though kiosks on a one-to-one basis while registrant's goods are inexpensive and mass marketed. Applicant impermissibly reads limitations and restrictions into the scope of the registration and application that are not present therein. Where, as here, neither the application nor the registration contain any restrictions as to the channels of trade, the identified goods must be presumed to travel in all normal trade channels and be available to all potential classes of consumers. *See Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d at 1268, 62 USPQ2d at 1005. Thus, despite applicant's contention, it must be presumed that the goods of both parties are sold wherever normal for similar skin care products, such as drug stores, department stores, and online retail websites, as well as specialty kiosks. The evidence of record includes excerpts from commercial retail websites Jerusalem Gift Shop, Dead Sea Deal & Products, drugstore.com, Walgreens, Macy's, Nordstrom, and Anchor Drugs Pharmacy showing the similar goods sold in the same trade channels. *See attachments to Office action dated January 25, 2013 at 66-88 and 101-18 and 124-75.* The evidence of record also includes an article discussing applicant where it indicates that applicant's goods may also be purchased online, indicating that applicant's goods are not only sold at kiosks. *See attachments to Office action dated January 25, 2013 at 119-23.* Contrary to applicant's assertion, the trade channels of the goods are similar for the purposes determining the likelihood of confusion between the marks.

Finally, applicant alleges that there has been no evidence of actual confusion between the marks during seven years of concurrent use. This argument is also unavailing. The test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is unnecessary to show actual confusion in establishing likelihood of confusion. TMEP §1207.01(d)(ii); *e.g., Weiss Assocs. Inc. v. HRL Assocs. Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990). The Trademark Trial and Appeal Board stated as follows:

> [A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case).

In re Kangaroos U.S.A., 223 USPQ 1025, 1026-27 (TTAB 1984). Actual confusion between the applied-for mark and the registered marks is unnecessary for a likelihood of confusion to exist.

In previous responses, applicant argued that its ownership of U.S. Registration No. 4147145 demonstrates that no likelihood of confusion exists between the applied-for mark and the registered marks. U.S. Registration No. 4147145 is the standard character mark SEACRET for "skin care products containing ingredients from the Dead Sea, namely, facial cream, facial peeling milk, facial mud mask, Non-medicated facial serum, eye gel, anti-wrinkle cream, mud soap, mineral soap, after shave, hand cream, salt facial scrub, body cream with salt, Non-medicated foot cream and body lotion" in International Class 3. However, prior decisions and actions of other trademark examining attorneys in registering different marks have little evidentiary value and are not binding upon the Office. TMEP §1207.01(d)(vi). Each case is decided on its own facts, and each mark stands on its own merits. *See*

AMF Inc. v. Am. Leisure Prods., Inc., 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Int'l Taste, Inc.*, 53 USPQ2d 1604, 1606 (TTAB 2000); *In re Sunmarks, Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994). "Moreover, the existence on the register of other seemingly similar marks does not provide a basis for registrability for the applied-for mark. *AMF*, 474 F.2d at 1406, 177 USPQ at 269; *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1477 (TTAB 1999). As the evidence in this case establishes a likelihood of confusion, applicant's prior registration has little evidentiary value.

Thus, when confronted by applicant's and registrant's goods, consumers would likely be confused as to the source of the goods because they are similar skin care products manufactured by the same companies and available in the same channels of trade. Therefore, the goods are closely related.

CONCLUSION

Therefore, because the dominant elements of the marks are nearly identical and the goods of applicant and registrant are closely related, purchasers are likely to be confused or mistaken or deceived as to the sources of the goods. For the foregoing reasons, the refusal to register on the basis of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) should be affirmed.

Respectfully submitted,

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