

This Opinion is Not a
Precedent of the TTAB

Oral Hearing: September 3, 2014

Mailed: December 3, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Seacret Spa International LTD¹

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Serial No. 78811559
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Albert L. Schmeiser and Sean K. Enos of Schmeiser Olsen & Watts LLP,
for Seacret Spa International LTD.

Matthew Galan,² Trademark Examining Attorney, Law Office 113,
Odette Bonnet, Managing Attorney.

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Before Bucher, Taylor and Masiello,
Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Secret Spa International (“Applicant”) seeks registration on the Principal

Register of the stylized mark **SEACRET** for goods ultimately identified as

Products containing ingredients from the Dead Sea,
namely, non-medicated skin care preparations, namely,
moisturizers, facial cleansers, facial peels, masks, lotions,

¹ We note Applicant’s communication, filed October 24, 2014, correcting the name to accurately reflect the mark owner’s name; “SPA” unintentionally was omitted at the filing of the Appeal Brief. The proceeding records accordingly have been amended to reflect Applicant’s name as Seacret Spa International LTD.

² Mr. Galan represented the Office at oral hearing, and three other examining attorneys were responsible for the application during prosecution.

creams, scrubs, soaps, nail care preparations, hand creams, cuticle oils; after shave in International Class 3.³

The mark is described as follows: “The mark consists of a wave as the center of the ‘E’ and crossing the ‘A.’”

The Trademark Examining Attorney has refused registration on the grounds that there is a likelihood that Applicant’s mark would cause confusion with the marks in the following registrations, both owned by the same entity.⁴

Registration No. 3094293⁵ for the mark SECRET (in standard character format) for “Body spray” in International Class 3; and

Registration No. 0645874⁶ for the mark **SECRET** for “Personal Deodorant” in International Class 3.

When the refusal was made final, Applicant appealed and requested reconsideration. The Examining Attorney denied the request for reconsideration on December 25, 2013, and the appeal subsequently was resumed. Applicant and the Trademark Examining Attorney fully briefed the issues on appeal, and at Applicant’s request, an oral hearing was held before this panel of the Board on September 3, 2014. We affirm the refusal to register.

³ Application Serial No. 78811559 was filed on February 9, 2006, based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as August 11, 2005.

⁴ The Examining Attorney also cited as a bar to registration, Registration Nos. 2855103 for the mark *Secret* and Registration No. 2855101 for the stylized mark *Secret*, both owned by the same Registrant that owns the cited marks listed above. Although the registrations are in the “grace period” for filing a renewal, Registrant has not yet done so. Accordingly, we have not based our decision on those registrations.

⁵ Registered March 30, 2006; Section 8 Affidavit accepted; Section 15 Affidavit acknowledged.

⁶ Registered, May 21, 1957; Second Renewal (10 years).

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). 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).

The marks

We first consider the *du Pont* factor concerning the similarity or dissimilarity of the marks. In doing so, we must compare the marks in their entirety as to appearance, sound, connotation and commercial impression to determine the similarity or dissimilarity between them. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005), quoting *In re E. I. du Pont de Nemours & Co.*, 177 USPQ at 567. However, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of the mark, provided the ultimate conclusion rests on a consideration of the marks in their entirety. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101

USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

With these principles in mind, we compare Applicant's mark ~~SE~~ACRET to the cited marks SECRET (standard characters) and **SECRET**.

In terms of appearance, Applicant essentially asserts that the marks are visually different because its applied-for mark and the cited marks are spelled differently and the stylization of its mark creates the appearance of a wave which consumers would relate to the "SEA" portion of its mark. We do not, as Applicant suggests, find the visual differences between the marks sufficient to differentiate them. The literal element of all of the marks is comprised of a single word beginning with the letters "S-E" and ending with the letters "C-R-E-T." Although Applicant's mark includes the letter "A" between the letters "E" and "C," because of its embedded placement in the middle of the mark, it may not be noticed. Similarly, and contrary to Applicant's contention, neither its mark, nor the cited stylized mark for that matter, is so stylized that the stylization creates a unique commercial impression apart from the literal element and, thus, the different stylizations do not obviate the similarities between Applicant's mark and the cited marks. Moreover, with particular regard to Registrant's cited standard character mark, its display is not limited to any particular font, style, size, or color, and we therefore must consider that it might be

used in any stylized display, including the same or similar stylization to the lettering used by Applicant. *See e.g., Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1258-59 (Fed. Cir. 2011) (“If the registrant ... obtains a standard character mark without claim to any particular font style, size or color, the registrant is entitled to depictions of the standard character mark regardless of font style, size, or color” (internal quotation marks omitted)); *Weider Pub’s, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1355 (TTAB 2014).

In terms of sound, Applicant asserts that English-speaking consumers will naturally place additional stress and emphasis on the first part of its mark because of the way it is written and this will change the way it is pronounced. Given that all of the letters of Applicant’s mark are presented in the same size and font, if the minimal stylization of the letter “A” is noted, it will not change the aural character of the spoken word. More importantly, as regards the pronunciation, it is settled that there is no correct way to pronounce a trademark. *See In re Belgrade Shoe*, 411 F.2d 1352, 162 USPQ 227 (CCPA 1969); *Interlago AG v. Abrams/Gentile Entertainment Inc.*, 63 USPQ2d 1862 (TTAB 2002). *See also In re Microsoft Corp.*, 68 USPQ 1195 (TTAB 2003) (it is not possible to control how consumers will vocalize marks). Moreover, the common word “secret” is pronounced with emphasis on the first syllable; so that emphasis on the first syllable of Applicant’s mark would not distinguish it from the most likely pronunciation of Registrant’s marks. Notwithstanding Applicant’s assertions to the contrary, we find the marks to be phonetic equivalents, which will be pronounced identically. *See RE/MAX of*

America, Inc. v. Realty Mart, Inc., 207 USPQ 960, 964 (TTAB 1980) (similarity in sound alone may be sufficient to support a finding of likelihood of confusion). *See also, e.g., Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469 (TTAB 1975); *In re Cresco Mfg. Co.*, 138 USPQ 401 (TTAB 1963).

As regards meaning and commercial impression, the marks are also similar. Applicant's assertions otherwise are unavailing. Applicant suggests that some consumers may ascribe the meaning of "sea" or "ocean" to the "SEA" portion of Applicant's mark. However, customers will also readily recognize in Applicant's mark a reference to the common word "secret." Accordingly, when both Applicant's mark and the cited marks are viewed in their entireties – keeping in mind that the average purchaser only retains a general impression of trademarks – they all will convey the ordinary meaning of "secret," e.g., that the respective products contain "secret" ingredients. Indeed, although Applicant may have intended its applied-for mark to "principally conjure up images of the sea," even Applicant acknowledges that the mark "secondarily conjure[s] a perception of "secret ingredients." Br. p. 7. Applicant's contention that its mark must be spoken before the "secondary" meaning is understood is unsupported and unavailing.

For the reasons discussed, despite the minor differences in spelling and the different stylizations, when compared in their entireties, Applicant's mark and the cited marks are substantially similar in appearance and connotation, identical in sound, and convey a highly similar commercial impression. We are not persuaded

that the “SEA” portion of Applicant’s mark dominates the applied-for mark such that it distinguishes Applicant’s mark from either of the cited marks.

Relationship of the goods

We turn then to the goods. It is well settled that the goods of Registrant and Applicant need not be identical or competitive, or even be offered through the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods of Registrant and Applicant are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. *See Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993).⁷ The issue here, of course, is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of these goods. *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2012); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

In making our determination regarding the relatedness of the goods, we must look to the goods as identified in the application and the cited registrations. *See Octocom Sys., Inc. v. Houston Computer Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011). Applicant’s goods are identified as “[p]roducts containing ingredients from

⁷ Applicant’s reliance on other “criteria” for determining the relatedness of the goods is misplaced.

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”; and Registrant’s goods are identified as “[b]ody sprays” and “[p]ersonal deodorant.” The Examining Attorney maintains that the goods are related, all being products used to care for the skin that would be sold to the same class of purchaser under circumstances that would lead one to mistakenly believe that they all originate from the same source. The Examining Attorney has supported the position that the goods are related with various use-based, third-party registrations covering both non-medicated skin care preparations and aftershave on the one hand and deodorant, antiperspirant and body spray on the other.⁸ These registrations made of record as attachments to the Office action dated June 29, 2012, the Notice of Suspension dated April 20, 2007, and the Denial of Request for Reconsideration dated January 25, 2013 include, for example:

Registration No. 3623325 for the mark STOODIO BY BATHMARK for, *inter alia*, “body lotion, bath soap and hand lotion” and “body spray”;

Registration No. 4120932 for the mark ENGLISH LEATHER for, *inter alia*, “after-shave, perfumed soaps, skin lotion and soaps for personal use” and “deodorant for personal use”;

Registration No. 3230510 for the mark erbaviva for, *inter alia*, “body lotions, non-medicated skin care preparations, face and body care lotions and creams” and “deodorant and deodorants for personal use”;

⁸ We did not, however, consider the various third-party registrations that did not include goods of the type identified in both Applicant’s application and the cited registration.

Registration No. 3169570 for the mark  for, *inter alia*, “non-medicated skin care preparations” and “deodorants”;

Registration No. 3184524 for the mark RAFRAICHISSANT IMMEDIAT for, *inter alia*, “non-medicated skin care preparations; body care products, namely, body soaps, body creams, body lotions” and “deodorants”;

Registration No. 4220407 for the mark BLACK PEARL for, *inter alia*, “non-medicated skin care cream, namely aromatherapy body peels, ... all being produced from or enriched with minerals from the Dead Sea” and “body deodorant, deodorant for personal use, [and] deodorants for body care, all being produced from or enriched with minerals from the Dead Sea”;



Registration No. 2831561 for the mark  for, *inter alia*, “soaps and creams for the hands, face, and body and after-shave lotions” and “personal deodorants”;

Registration No. 3772169 for the mark ONE PLANET for, *inter alia*, “body spray used as a personal deodorant and deodorant” and “skin moisturizer, after-shave balm and shaving preparations”;



Registration No. 3926048 for the mark  for, *inter alia*, “soaps for personal use, liquid soaps, facial peels, body lotions and hand creams” and “personal deodorants”;

Registration No. 3824507 for the mark NATURAL SERENADE for, *inter alia*, “body cream, body lotions, skin cleansing lotion, skin cleansing cream, and body soaps” and “deodorants”;

Registration No. 2923290 for the mark DIVIDENDS for, *inter alia*, “shaving cream and body lotion” and “deodorant and body spray”;

Registration No. 4013334 for the mark FAT BASTARD for, *inter alia*, “skin lotion, shaving cream and soap” and “body spray for men used as a personal deodorant and as a fragrance and anti-perspirant deodorant”;

Registration No. 4140102 for the mark PRIMAJOLIE for, *inter alia*, “cosmetics and body care products, namely ... skin cleaners and lotions” and “cosmetics and body care products, namely ... personal deodorants; and

Registration No. 2851449 for the mark PALEMO for, *inter alia*, “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 after-shave lotions” and “personal deodorants.”

In traversing the refusal, Applicant questions the probative value of third-party registrations to show the relatedness of the goods, arguing that each case is decided on its own facts and stands on its own merits. While these registrations are admittedly not evidence of use in commerce, they are sufficient to suggest that these goods are ones which might be provided by a single entity and offered to the public under the same mark. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

The Examining Attorney also made of record webpages from the website www.burstein-deadsea.com showing 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;⁹ and webpages from the website www.ahavaus.com showing that skin care preparations containing ingredients from the Dead Sea and after shave are sold

⁹ Attachments to the Office action dated June 29, 2012.

under the same trademark as body spray.¹⁰ In addition, the Examining Attorney made of record evidence from the websites www.deadseapremium.com, www.magicspa.net, www.aroma-deadsea.com, www.lalineusa.com and www.jesusboat.com showing that goods of the types identified in Applicant's application and the cited registrations, and which often contain ingredients from the Dead Sea, are offered for sale on the same Internet site.¹¹

We find this evidence sufficient to show that Applicant's non-medicated skin care preparations and after shave are closely related to Registrant's body spray and personal deodorant, such goods all being skin care products that are often sold by the same source under the same mark, and are complementary to the extent that they may be used together in a personal care regimen.

Applicant argues that there is no overlap in the goods whatsoever and, further, inasmuch as Registrant has used the mark SECRET for deodorant since 1956 without expanding its use of the mark to other goods (with the exception of one similar product, i.e., a fragrant body spray), there is no likelihood that Registrant would "bridge the gap" to produce non-medicated skin care preparations as defined in Applicant's identification of goods. An *ex parte* proceeding, in which Registrant does not participate, is not an appropriate forum in which to speculate about and make findings regarding Registrant's plans or ability to bridge the gap. Rather, in this *ex parte* context, we apply the traditional analysis of the relatedness of the

¹⁰ *Id.*

¹¹ Attachments to the Office action dated June 29, 2012 and the Denial of Request for Reconsideration dated January 25, 2013.

involved goods. Here, the evidence of record clearly demonstrates that the goods are related and complementary, all being personal care items used to care for the skin.

Applicant's argument that a search of Amazon.com using particular search terms did not reveal overlapping marks or goods is not persuasive because Internet search results reflect character-specific searches. That is, Applicant's search of the term "seacret" is unlikely to result in any information regarding the term "secret."

Channels of trade and buyers to whom sales are made

Explaining that its products are sold mainly to a more sophisticated customer through kiosks on a one-to-one basis and with more expensive pricing than those of Registrant, Applicant also asserts that its goods and those of Registrant travel in distinct channels of trade. The problem with this argument is that there are no such limitations as to channels of trade and classes of consumers in the respective identifications. Where, as in this case, the goods in the application and cited registrations are broadly described, such that there are no restrictions as to trade channels and classes purchasers, it is presumed that the identification of goods encompasses not only all goods of the nature and type described therein, but that the identified goods are provided in all channels of trade which would be usual therefor, and that they would be purchased by all potential customers thereof. *See, e.g., In re Elbaum*, 211 USPQ 639 (TTAB 1981). In this regard, the Examining Attorney has made of record excerpts from commercial websites, i.e., <http://shopnordstrom.com>, www.walgreens.com, www.drugstore.com, www.cvs.com and <http://www1.macys.com>, showing that goods of the type identified in both

Applicant's application and the cited registrations are commonly sold in drug stores, department stores, online retail stores, as well as specialty kiosks, and are promoted to all potential classes of consumers including ordinary consumers. We thus find that the channels of trade and classes of consumers overlap.

With regard to Applicant's suggestion that its customers are sophisticated purchasers, there is no evidence supporting this claim. However, even assuming *arguendo* that Applicant's customers will exercise some degree of care in their purchasing decisions, even careful purchasers can be confused as to source, where, as here, very similar marks are used in connection with related goods. *See In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) *citing Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) ("Human memories even of discriminating purchasers ... are not infallible.").

Contemporaneous usage without evidence of actual confusion

Applicant also states that its use of the SEACRET mark has been nationwide with substantial sales, and further asserts that during the last seven years, there has been contemporaneous use of Applicant's and Registrant's marks without any indication of actual confusion. It is not necessary, however, to show actual confusion in order to establish likelihood of confusion. *See Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 223 USPQ 1025 (Fed. Cir. 1990). The lack of actual confusion carries little weight, *J.C Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 438 (CCPA 1965), especially in an *ex parte* context. In this *ex parte*

proceeding, we are not privy to what, if any, instances of confusion may have occurred in Registrant's experience with respect to its own and Applicant's marks. As the Board stated in *In re General Motors Corp.*, 23 USPQ2d 1465, 1470 (TTAB 1992):

We recognize, of course, that the above [evidence of an absence of actual confusion] is one-sided inasmuch as it provides only applicant's experience in the marketplace and not that of registrant. Normally, in the absence of a detailed consent agreement, the registrant has no opportunity to be heard in an *ex parte* proceeding of this type and the Board, therefore, is not in a position to meaningfully assess whether the claimed period of contemporaneous use had provided ample opportunity for confusion to have arisen. *See, e.g. In re Jeep Corp.*, [222 USPQ 333, 337 (TTAB 1984)]. The asserted absence of actual confusion, especially over a relatively short period of years, has thus often been asserted to be of "limited influence" or of "dubious probative value". *See, e.g., In re Barbizon International, Inc.*, 217 USPQ 735, 737 (TTAB 1983) and *In re Whittaker Corp.*, 200 USPQ 54 (TTAB 1978), respectively.

Thus, Applicant's assertion of the absence of actual confusion is of little probative value in our determination on the issue of likelihood of confusion.

Other alleged facts: No preclusive effect of earlier proceeding

Last, Applicant states that in Opposition No. 91174407 between it and Registrant (as Opposer) concerning application Serial No. 78598113 (now Registration No. 4147145) for the mark SEAcet,¹² "Registrant failed to file a [required] response and the opposition was dismissed with prejudice." Br. p. 7. As

¹² The goods identified in that registration are "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."

aptly explained by the Examining Attorney in his brief, and seemingly acknowledged by Applicant,¹³ that proceeding has no *res judicata*, collateral estoppel or *stare decisis* effect on this proceeding.¹⁴ Applicant nonetheless asserts that Registrant's failure to pursue that opposition "further leads to the conclusion that Registrant did not find the Applicant's marks confusingly similar." *Id.* We disagree. The fact that Registrant did not pursue an opposition for a mark for goods which Applicant considers very similar to the mark and goods at issue herein has no relevance to this proceeding. As stated, no preclusive effect attached to the prior proceeding as it concerns this *ex parte* matter, and our task in this case is to determine, on the record before us, whether Applicant's mark is registrable. Notably, the mark in the application that was the subject of that opposition, with its upper- and lower-case letters, created a different overall commercial impression.

We also point out with regard to Registration No. 4147145 that we are not bound by the prior decisions of examining attorneys in allowing marks for registration. As has been noted many times, each case must be decided on its own facts. *See In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Even if some prior registrations had some characteristics similar to [Applicant's] application, the PTO's allowance of such prior registrations does not bind the Board or this court."); *In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828 F.2d 1567, 4

¹³ Applicant specifically noted that "[t]he Examining Attorney may be correct with regard to *res judicata*, collateral estoppel or *stare decisis*." Br. p. 7.

¹⁴ As regards any *res judicata* effect, we point out that while Registrant was a party to Opposition No. 91174407, Registrant is not a party to this proceeding and, further, that there were no issues actually adjudicated in that opposition.

USPQ2d 1141, 1142 (Fed. Cir. 1987). In view of the foregoing, we are obligated to assess the registrability of Applicant's mark in this proceeding on its own merits and not simply based on the existence of another registration.

Conclusion

When we consider the record, the relevant likelihood of confusion factors, and all of the arguments and evidence relating thereto, including those arguments and evidence not specifically addressed in this decision, we conclude that in view of the substantial similarity in the commercial impressions of the marks and the overlap in the channels of trade and classes of consumers, the contemporaneous use of the respective marks on related and complementary goods is likely to cause confusion as to the source or sponsorship of such goods.

Decision: The refusal to register pursuant to Section 2(d) is affirmed.