From: Hesik, April

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Subject: U.S. TRADEMARK APPLICATION NO. 78811559 - SEACRET - SEAC-11043 - Request for Reconsideration Denied - Return to TTAB - Message 1 of 21

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 78811559

MARK: SEACRET

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GENERAL TRADEMARK INFORMATION:
http://www.uspto.gov/trademarks/index.jsp

APPLICANT: SEACRET SPA INTERNATIONAL LTD

CORRESPONDENT'S REFERENCE/DOCKET NO:
SEAC-11043
CORRESPONDENT E-MAIL ADDRESS:
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REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 1/25/2013

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.64(b); TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a). The refusal made final in the Office action dated June 29, 2012, are maintained and continue to be final. *See* TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a).

The voluntary amendment to the identification of goods is acceptable and entered into the record.

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. *See* 37 C.F.R. §2.64(b); TMEP §715.03, (a)(2)(B), (a)(2)(E), (c).

If time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to comply with and/or overcome any outstanding final requirement(s) and/or refusal(s) and/or to file an appeal with the Board. TMEP §715.03(a)(2)(B), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal when the time for responding to the final Office action has expired. *See* TMEP §715.04(a).

Response to Applicant's Arguments

The applied-for mark is SEACRET and design for the following goods, as amended: "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. It is noted that the goods in International Class 8 have been divided from the present application.

The examining attorney previously issued a Final Refusal under Trademark Act Section 2(d) because of a likelihood of confusion with the marks shown in U.S. Registration Nos. 3094293, 2855103, 2855101, and 0645874. The registered marks, which are all owned by the same entity, are SECRET for body spray (Reg. No. 3094293), SECRET and a design for personal deodorant/antiperspirant (Reg. No. 2855103), SECRET in stylized lettering for personal deodorant/antiperspirant (Reg. No. 2855101), and SECRET in stylized lettering for personal deodorant (Reg. No. 0645874). The examining attorney previously argued that the marks are similar and the goods are related and travel in the same trade channels. Attached to the previous Office action are examples of third-party registrations and commercial websites showing the goods of the parties may emanate from the same source, may be offered under the same mark, and may be offered to consumers in the same trade channels.

Applicant argues in it request for reconsideration that the marks are dissimilar, the goods are dissimilar, the trade channels are dissimilar, and the parties have used the marks concurrently without actual confusion. Each of these arguments have been previously made and responded to in the previous actions. However, the examining attorney will briefly address each in turn.

First, applicant argues that the marks are dissimilar is appearance because its mark is spelled with an "A," appears in stylized text, and includes a wave design. Applicant also argues that its mark is dissimilar in meaning and commercial impression because it connotes the word "SEA" and thus suggests the ingredients from the Dead Sea that are included in applicant's products. These slight differences, however, are not sufficient to obviate the similarity between the marks. The fact remains that the marks are phonetic equivalents—that is, they would be pronounced in the same way. Similarity in sound alone is sufficient to support a finding that the marks are 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)(iv).

Furthermore, the visual differences between the marks are small. With regard to the literal element of the marks, the only difference in the inclusion of an "A" in the applied-for mark, the stylization of the wording, and the small design element of a wave that forms parts of the letter "E" and "A." 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 1593, 1596 (TTAB 1999); TMEP §1207.01(c)(ii); *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (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 their similarity in appearance, the arguable difference in connotation cannot overcome the confusing similarity between the marks.

Applicant's second argument is that the goods are dissimilar because registrant's goods are body spray, personal deodorant/anti-perspirant, and personal deodorant, whereas applicant's goods are 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. This argument is not convincing because, while the goods of the parties are not identical, they are closely related. As discussed in the previous actions, 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. 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). Additionally, unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described. *See In re Jump Designs*, 80 USPQ2d 1370, 1374 (TTAB 2006); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

Attached to the previous actions were examples of third-party registrations showing goods similar to applicant's and registrant's offered under common marks, as well as examples of commercial websites showing the goods offered under the same marks and to the same groups of consumers. In light of applicant's further amendments to the identification, attached to underscore this point are additional examples of third-party registrations and commercial websites for similar goods. The examining attorney may introduce additional evidence directed to the issue for which reconsideration is sought. TBMP §1207.04*; see In re Davey Prods.* Pty Ltd., 92 USPQ2d 1198, 1200-01 (TTAB 2009); *In re Giger*, 78 USPQ2d 1405, 1406-07 (TTAB 2006).

Third, applicant 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. However, 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 body care products, such as drug stores, department stores, and online retail websites, as well as specialty kiosks. Attached are excerpts from commercial websites showing where such goods are typically sold. In fact, an attached article discussing applicant indicates that its goods may also be purchased online.

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).

In summary, applicant's arguments do not convince the examining attorney that consumer confusion is not likely in this instance. Therefore, the final refusal under Section 2(d) is maintained, and the request for reconsideration of the refusal is denied.

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Third-Party Registrations