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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ultrasun AG

Serial No. 79089118

John L. Ambrogi of McCracken & Frank LLC for Ultrasun AG.

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(Michael W. Baird, Managing Attorney).

Before Seeherman, Cataldo and Gorowitz, Administrative Trademark Judges.

Opinion by Gorowitz, Administrative Trademark Judge:

Ultrasun AG seeks registration on the Principal Register for the mark ULTRASUN for “sun-screen preparations; cosmetics, perfumery, essential oils, and hair lotions.”¹ 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 so resembles the registered mark ULTRA SUN for “sun protective clothing for men, women and children”² that, as used in connection with applicant's identified

¹ Serial No. 79089118, filed September 21, 2010, pursuant to Section 66(a) of the Trademark Act, seeking an extension of protection of International Reg. No. 0930420, issued on June 29, 2007.

² Reg. No. 2864800, issued on July 20, 2004, §§ 8 & 15 accepted and acknowledged.

goods, it is likely to cause confusion or mistake or to deceive. The examining attorney issued a final refusal of registration, which applicant has appealed.

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). 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). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The first DuPont factor requires us to examine “the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.” *DuPont*, 177 USPQ at 567. The only difference between the marks is that applicant’s mark is one word (ULTRASUN) and registrant’s mark is two words (ULTRA SUN). However, this is not sufficient to distinguish the marks. The presence or absence of a space between virtually the same words is not a significant difference. *Stockpot, Inc. v. Stock Pot Restaurant, Inc.*, 220 USPQ 52, 54 (TTAB 1983), *aff’d*, 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984) (“There is no question that the marks of the parties [STOCKPOT and STOCK POT] are confusingly similar. The word marks are phonetically identical and visually almost identical”); *In re Best Western Family Steak House, Inc.*, 222 USPQ 827, 827 (TTAB 1984) (“There can

be little doubt that the marks [BEEFMASTER and BEEF MASTER] are practically identical”).

We find the marks virtually identical in appearance, and identical in sound, connotation and commercial impression.

The next DuPont factor that we consider is the similarity of the goods. The identification of goods in the application is “sun-screen preparations; cosmetics, perfumery, essential oils, and hair lotions.” Both the examining attorney and the applicant have concentrated their arguments on applicant’s “sun-screen preparations” and have not discussed the other goods in the identification, which is appropriate since likelihood of confusion must be found as to the entire class if there is likely to be confusion with respect to any item in the identification of goods for that class. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981). Therefore, we, too, will concentrate our analysis on whether these goods are similar.

In determining whether applicant’s sun-screen preparations and registrant’s sun protective clothing are similar, “it is not necessary that the respective goods be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods are related in some manner, or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective

goods.” *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1284-1285 (TTAB 2009) citing *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

Both sunscreen and sun protective clothing are used for the same purpose, and the products are clearly complementary in nature. See, for example, the statement on The Portable Baby website, www.theportablebaby.com: “I really like this shirt [Child’s UPF 50 UV Protective Long-Sleeved Swim/Sun Shirt] because I can put it on my sons (along with their sunhats, of course) and then I just have to apply a good sunscreen to their hands, legs and tops of feet.” January 11, 2011 Office Action, p 7. If goods are complementary in nature, or used together, this relatedness can support a finding of likelihood of confusion. See, e.g., *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

The examining attorney has made of record webpages showing that a number of websites offer both sun protective clothing and sunscreen, for example:

- Solartex Sun Gear (solartex.com) states that it “offers various UV sun protective products including sunscreen, spf clothing, sun protective clothing...” (January 11, 2011 Office Action, p. 5);
- SPFstore.com (spfstore.com) offers both a variety of clothing items (i.e. shorts, hats and swimwear) having UV protection and sunscreen;
- Coolibar (coolibar.com) offers swimwear with UV protection and sunscreen;

- SunProof.com (sunproof.com) offers a variety of sun protective clothing items (i.e. sun hats, swimwear, and gloves) and sunscreen;
- REI (rei.com) offers clothing items (i.e. gloves and neck gaiters and sunscreen;
- SunSport Company (sunsportco.com) offers sun protective clothing (i.e. shirts and hooded jackets) and sunscreen; and
- Sun Precautions (sunprecautions.com) offers sun protective clothing (i.e. shirts, jackets and pants) and sunscreen.

Applicant points out that many of these websites are merchant-type sites which offer goods under what appear to be third-party marks. Even if this is the case, they show that consumers can encounter both types of products in the course of seeking sun protection products. Further, applicant acknowledges that the evidence shows that there are instances in which both sun protective clothing and sunscreen are sold under a single mark, namely REI and BABY BLANKET.

The evidence, thus, shows that the types of goods sold by applicant and registrant are sold through the same websites. Therefore, the DuPont factors of the similarity of goods and the channels of trade favor a finding of likelihood of confusion.³

³ In reaching this conclusion, we have not given any weight to the third-party registrations submitted by the examining attorney. Although third-party registrations may serve to suggest that the listed goods and/or services are of a type which may emanate from a single source, in this case the registrations are not for sun protective clothing, but just for clothing in general. Because sun protective clothing is a particular category of clothing, the registrations for clothing in general are not

We note applicant's assertion that the actual stores and websites in which applicant's and registrant's goods are or will be available are different. However this argument is unavailing because there is no restriction of the channels of trade in either the cited registration or the application. "Where the goods in a cited registration are broadly described and there are no limitations in the identification of goods as to their nature, type, channels of trade or classes of purchasers, it is presumed that the scope of the registration encompasses all goods of the nature and type described, that the identified goods move in all channels of trade that would be normal for such goods, and that the goods would be purchased by all potential customers." *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

As with channels of trade, the fourth DuPont factor, "the condition under which and buyers to whom sales are made" is also determined by the goods as identified in the cited registration and the application. Therefore, although applicant asserts that the goods in the cited registration are "advertised as medical solutions and a medical device" (Appeal Brief, page 10), there is no such restriction of the goods in the cited registration and thus we do not consider the goods to be medical devices. With respect to the cost of the items, we note that applicant's sunscreen preparations will "range in price from \$26.90 to \$43.90 (Declaration of Marcel Roesti, applicant's Head of Suncare) and that registrant's website lists the price range for its protective clothing as

sufficient to show that sun protective clothing and sunscreen may emanate from a single source.

from \$49.94 to \$98.95. Again, we must consider the issue of likelihood of confusion based on the goods as they are identified in the application and the cited registration. Therefore, although applicant may currently intend to sell its sunscreen preparations for a minimum of \$26.90, there is no inherent reason why it could not use its mark on sunscreen sold at a far lower cost. Sunscreen may even be the subject of an impulse purchase. As a result, a purchaser who is aware of registrant's ULTRA SUN sun protective clothing, seeing ULTRASUN on sunscreen preparations, is likely to simply assume a connection as to the source of the goods, without giving the purchase a great deal of thought. As such, we find that the DuPont factor of the conditions of purchase favors a finding of likelihood of confusion.

Applicant also points out, presumably under the thirteenth factor of the DuPont case - any other established fact probative of the effect of use - that the cited registration issued despite the existence of prior Reg. No. 2269905 for the mark ULTRA SUN for sun care preparation.⁴ However, "it has long been held that while the PTO is encouraged to achieve a uniform standard for assessing registrability of marks, the Board and the Federal Circuit "must assess each mark on the record of public perception submitted with the application." *In re Nett Designs Inc.*, 57 USPQ2d 1564 (Fed. Cir. 2001). Thus, whatever the reasons that were relied on by the examining attorney who considered the cited

⁴ Reg. No. 2269905 was cancelled on March 4, 2010 pursuant to Section 8 of the Trademark Act.

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registration in light of Reg. No. 2269905, we must reach our decision in this case based on the record before us.

These are the only DuPont factors raised by either the applicant or the examining attorney. To the extent that there are other relevant DuPont factors, we treat them as neutral.

Having considered all the evidence and argument on the relevant DuPont factors, we find that applicant's mark is likely to cause confusion with the cited registration.

Decision: The refusal to register is affirmed.