

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

Mailed:  
April 18, 2012  
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Ledes Group Inc.

Serial No. 85002861

Michael E. Hall and Sharon Blinkoff of Venable LLP for The  
Ledes Group Inc.

Myriah A. Habeeb, Acting Supervisory Senior Attorney, Law  
Office 109 (Gwen Stokols, Acting Managing Attorney).

Before Bucher, Kuhlke and Ritchie, Administrative Trademark  
Judges.

Opinion by Bucher, Administrative Trademark Judge:

The Ledes Group Inc. seeks registration on the  
Principal Register of the mark **COSMETIC WORLD** (*in  
standard character format*) for goods identified in the  
application, as amended, as "newsletter about the cosmetic  
and beauty industries, and directed solely to those who work  
or operate in those industries" in International Class 16.<sup>1</sup>

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<sup>1</sup> Application Serial No. 85002861 was filed on March 31, 2010,  
based upon applicant's claim of use anywhere and use in commerce  
since at least as early as January 5, 1966. No claim is made to  
the exclusive right to use the word "Cosmetic" apart from the  
mark as shown.

The Trademark Examining Attorney issued a final refusal to register this designation based upon Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). The Senior Attorney has taken the position that applicant's mark, when used in connection with the identified goods, so resembles the identical mark **COSMETIC WORLD** for "retail store services in the field of perfumery, cosmetic products, beauty products and hair products" in Class 35,<sup>2</sup> as to be likely to cause confusion, to cause mistake or to deceive.

After the Senior Attorney made the refusal final, applicant appealed to this Board.

We reverse the refusal to register.

**Arguments of applicant and the Trademark Examining Attorney**

In support of her refusal, the Senior Attorney argues that the marks are identical, the goods and services are closely related, and there are no limitations as to nature, type, channels of trade or classes of purchasers in the cited registration.

By contrast, in urging registrability, applicant contends that: the cited services do not feature

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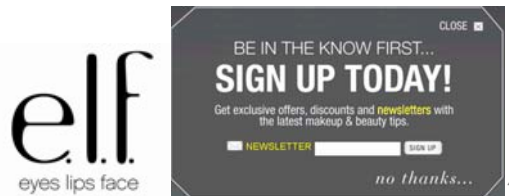
<sup>2</sup> Registration No. 3328533 issued on November 6, 2007. The mark consists of the word SONU in a stylized format. No claim is made to the exclusive right to use the word "Cosmetic" apart from the mark as shown.

applicant's goods; that merely because applicant and registrant may operate in the same broad industry does not establish that their respective goods and services are related; and the fact that the Trademark Examining Attorney was unable to locate any third-party registrations containing both registrant's services and applicant's goods supports applicant's position that these goods and services are not commercially related.

### **PRELIMINARY MATTER**

As a preliminary matter, the Senior Attorney objects to applicant's submission of supplemental evidence at the time of filing its appeal brief (June 21, 2011).<sup>3</sup>

As background, in her final Office Action of January 25, 2011, the Senior Attorney submitted printouts from third-party websites, like the following half-dozen examples:



<sup>3</sup> See "Exhibit 1" attached to applicant's appeal brief.

<sup>4</sup> <http://www.eyeslipsface.com/>

<sup>5</sup> <http://cosmeticmall.com/>



Based upon those printouts showing merely that these third-party websites use the term "newsletter(s)," the Senior Attorney asserts that "purchasers are accustomed to receiving newsletters in the field of cosmetics and beauty from retailers of cosmetic and beauty products." The Senior Attorney did not submit any of the actual newsletters.

With its appeal brief of June 21, 2011, applicant included copies of these newsletters, showing them to be broadly-distributed automated email promotional pieces for consumers who signed up to receive the same. Applicant included full copies of the "newsletters" in the form of emails and other electronic promotional materials as Exhibit

<sup>6</sup> <http://www.smashbox.com>  
<sup>7</sup> <http://www.marykay.com/>  
<sup>8</sup> <http://www.urbandecay.com/>  
<sup>9</sup> <http://www.lorealparisusa.com/>

#1 to its brief and referred to them repeatedly within the brief with smaller images drawn out of Exhibit 1 materials.

The Senior Attorney argues that this evidence is clearly untimely and requests that we refuse to consider this evidence in making our decision. However, applicant argues that these screen prints simply provide further "context" about the truncated evidence of the Senior Attorney. Analogizing to the facts of *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986) [where only excerpts of Nexis articles were introduced as evidence by the Trademark Examining Attorney, applicant was permitted to submit the full text of the articles for purposes of context, even at the appeal brief stage], applicant argues that it is actually showing the true nature of the "newsletters" reportedly originating from the websites on which the Senior Attorney relied.

By contrast, the Senior Attorney points out that these newsletters, which applicant argues "complete the record," involve materials not presently in the record in any form. Hence, the Senior Attorney argues that the case at bar is much more like the fact of *In re Psygnosis Ltd.*, 51 USPQ2d 1594 (TTAB 1999). In *Psygnosis*, the Board held that full NEXIS printouts of articles referenced in a Trademark Examining Attorney's search, but were then not introduced

among the Office's evidence of "representative" articles, would not be considered if their inclusion was untimely. The Senior Attorney argues that inasmuch as applicant herein failed to submit this evidence with its request for reconsideration, this failure to place them into the record earlier in the prosecution supports her position that the evidence is untimely and should not be considered.

We find that this factual situation is more like the facts of *Bed & Breakfast Registry* than it is like the facts of *Psygnosis*. The late-filed material was applicant's attempt to offer context for the "newsletters" on which the Senior Attorney had relied. They were hyperlinks from or email responses originating from the same websites to which the Senior Attorney had earlier provided screen prints as an attachment to the Office's Final action. Accordingly, we will accept these late offerings by applicant to the extent that they provide context for the Trademark Examining Attorney's submissions. However, the Senior Attorney makes a good point that the preferred method would have been for applicant to have included this evidence with its request for reconsideration rather than waiting until the time of briefing the case.

### ***Likelihood of Confusion***

We turn then to a consideration of the issue of likelihood of confusion. Our determination of likelihood of confusion is based upon our analysis of all of the probative facts in evidence that are relevant to the factors bearing on this issue. See *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); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In any likelihood of confusion analysis, however, two key, although not exclusive, considerations are the similarities between the marks and the relationship 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 Similarity of the Marks***

As to the first *du Pont* factor, the Senior Attorney points out that the two marks are visually and aurally identical, creating the exact same connotation and commercial impression. As a result, purchasers have no way of relying on the marks to distinguish between the sources of the respective goods and services. This *du Pont* factor supports a finding of a likelihood of confusion.

**Relationship of the Goods and Services**

We turn next to the *du Pont* factor focused on the relationship of the services and goods. By definition, applicant's newsletter is directed to the cosmetic and beauty industries, of which registrant is a retail component. In order to show the relatedness of applicant's newsletters to registrant's retail store services, the Senior Attorney submitted for the record copies of the following third-party registrations:

**THE SELF  
CENTER**

for "**catalogs, informational brochures and informational pamphlets** about health, well being, fitness, **beauty** and fashion" in Int. Cl. 16; retail store services and mail order services for products relating to well being, health, fitness, **beauty** and fashion" in International Class 35;<sup>10</sup>

**ARBONNE =  
RESULTADOS**

for "**printed instructional, educational, and teaching materials** in the field of fragrances, toiletries, skin, hair, **beauty, cosmetic** and health care products" in International Class 16; "retail shop-at-home party services in the field of fragrances, toiletries, skin, hair, **beauty, cosmetic** and health care products" in International Class 35;<sup>11</sup>

**ARMAND  
DUPREE**

for "**printed catalogs** in the field of cosmetics, clothing and house wares; **brochures** about **cosmetics**, clothing and house wares" in International Class 16; and "providing door-to-door shopping services, featuring **cosmetics**, clothing, and house wares" in International Class 35.<sup>12</sup>

<sup>10</sup> Registration No. 2960106

<sup>11</sup> Registration No. 3529281

<sup>12</sup> Registration No. 3562715



The Senior Attorney argues that these registrations have probative value to the extent that they serve to suggest that the relevant goods and services 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); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 at n.6 (TTAB 1988).

However, especially in the case where retail sales are taking place in the form of mail-order shopping, door-to-door selling and shop-at-home parties (as in the above recitations), it makes sense that catalogues, pamphlets and teaching materials are an integral part of the retail shopping experience in a way quite different from retail shopping in a more traditional brick-and-mortar store.<sup>13</sup> Furthermore, these types of global advertising promotions would seem to bear little resemblance to applicant's targeted "newsletter about the cosmetic and beauty industries, and directed solely to those who work or operate in those industries."

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<sup>13</sup> Moreover, we find no probative value in support of the position of the Senior Attorney in her listing of third-party registrations of retail operations selling stuffed animals or video games, or businesses operating in the field of telecommunications.

As listed in the amended identification of goods, applicant's newsletters are not intended for members of the consuming public. By contrast, the third-party "newsletters" for consumers (**e.l.f., Cosmetic Mall, Smashbox, THE SELF CENTER, ARBONNE = RESULTADOS** or **ARMAND DUPREE**) as introduced by the Senior Attorney are intended for members of the consuming public, and hence, provide no evidence for the relationship between retail store services and an industry trade paper. Accordingly, this critical *du Pont* factor favors a finding of no likelihood of confusion.

### **Channels of trade**

As seen above, applicant's newsletters are not intended for members of the consuming public, and would be targeted to retailers. Registrant's services, by contrast, are targeted to ordinary consumers. Hence, we find that there is substantially no overlap in trade channels, and this factor too favors a finding of no likelihood of confusion.

### **Sophistication of consumers**

Applicant argues that its customers are sophisticated enough not to be confused.<sup>14</sup> We agree with applicant that prospective customers of applicant's newsletters are much

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<sup>14</sup> See applicant's brief at 16-18.

more sophisticated about the cosmetic and beauty industries than would be the average retail customer of cosmetic and beauty items - whether that consumer is the recipient of an electronic email advertisement blasted from a national retail firm or is the target of written materials for less traditional forms of retail (like mail-order, door-to-door or shop-at-home parties). Under the circumstances of this case, the sophistication of applicant's purchasers is a critical factor in favor of finding no likelihood of confusion.

### ***Conclusion***

When balancing all the relevant *du Pont* factors, we agree with applicant that despite the identical commercial impressions of the marks herein, this factor does not outweigh the fact that applicant's newsletter is targeted to a select and sophisticated class of specialized customers, that the record reflects an absence of any showing of a close relationship between the involved goods and services, and that registrant's services and applicant's newsletters move in distinct channels of trade.

*Decision:* The refusal to register under Section 2(d) of the Lanham Act is hereby reversed, and this application will proceed to issuance in due course.