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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Evonik Goldschmidt GmbH

Serial No. 85014843

William F. Lawrence and Marilyn Matthes Brogan of Frommer Lawrence & Haug LLP for Evonik Goldschmidt GmbH.

Maureen Dall Lott, Trademark Examining Attorney, Law Office 117 (J. Brett Golden, Managing Attorney).

Before Seeherman, Holtzman and Lykos, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Evonik Goldschmidt GmbH has appealed from the final refusal of the trademark examining attorney to register SK-INFLUX, in standard characters, as a trademark for "chemical products for use in industry, namely, additives and auxiliary agents for the production of cosmetic and pharmaceutical products."[1] Applicant has stated that "SK"

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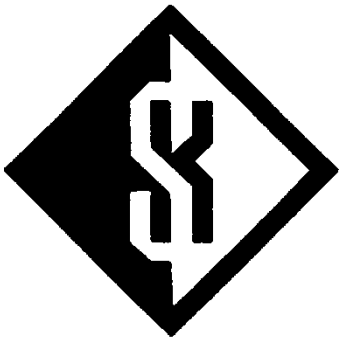
[1] Application Serial No. 85014843, filed April 15, 2010. The application is based on Section 1(a) (use in commerce) and

and "INFLUX" appearing in the mark has no significance in the relevant trade or industry or as applied to the goods/services listed in the application, or any geographical significance.

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, as used for its goods, is likely to cause confusion with the following marks, all owned by the same entity, SK Holdings Co., Ltd.:



> for, inter alia, chemical additives for use in the manufacture of pharmaceuticals, cosmetics and plastic molding compositions; chemical additives for use in the manufacture of adhesives, pharmaceuticals, textile, plastics and paints; synthetic resins for use in the manufacture of adhesive, paint, cosmetics and binder.[2]

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asserts first use and first use in commerce as early as March 31, 2000. Applicant also asserts a priority filing date of March 2, 2010, under Section 44(d) of the Trademark Act, based on a German application. Applicant subsequently submitted the German registration, thus perfecting the Section 44(e) basis for the application.

[2] Registration No. 2759298, issued September 2, 2003. The registration as originally issued was for goods in eight classes. The registration for six of the classes was cancelled as a result of the registrant's failure to file a Section 8 affidavit of continuing use for the goods in those classes. The goods that

for, inter alia, acetone and citric acid for industrial purposes;[3]

and for, inter alia, medicines for sensory organs, namely, central nervous system stimulants; oral contrceptive pillls, gummed medical taffeta plasters; mouthwashes for medical purposes; breath refreshers for medical purposes; vermifuges; Goulard water for use as an astringent or anti-inflammatory lotion; bronchodilating preparations; antiparasitic preparations; eye-wash; tobacco-free cigarettes for medical purposes; cod liver oil; agents affecting metabolism; liniments; chilblain preparations, digitalin; synthetic narcotics, anesthetics; agents affecting perpheral nervous system; agents for immunity adjustment; agents for treating physically caused lesions; and oriental medicines for women's diseases, namely, hormonal imbalances or fertility treatments;[4]

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remain, and for which a Section 8 affidavit has been accepted, are in Classes 1 and 4, and we have listed those goods in Class 1 that are most similar to the goods in applicant's application.

[3] Registration No. 3422863, issued May 6, 2008. This registration lists hundreds of items in Class 1. The examining attorney has discussed and submitted evidence to show the relatedness of applicant's goods to the citric acid and acetone listed in the identification, and we therefore will not burden this opinion with a multi-page listing of the entire identification.

[4] Registration No. 3411705, issued April 15, 2008. The registration is for a very large number of goods in Class 5, and we have listed a small number of the items that are in the nature of pharmaceutical products. The examining attorney has stated that the refusal with respect to this registration is limited to applicant's "chemical products for use in industry, namely, additives and auxiliary agents for the production of pharmaceutical products," i.e., not the additives and auxiliary agents for the production of cosmetics.

Registration No. 3422863 includes the description statement, "The mark consists of the color red appearing in the inside of the butterfly and in the letters SK. The color white appears separating the color red from the color orange which appears on the outside of the butterfly's wings." (The description of the mark in Registration No. 3411705 is essentially the same, but instead of the language "the inside of the butterfly," it says "the inside of the butterfly's wings.")

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).

We consider the issue of likelihood of confusion with respect to each registration in turn.

<u>Registration No. 2759298</u>

Applicant's identified additives for the production of cosmetic and pharmaceutical products must be considered legally identical to the chemical additives for the manufacture of pharmaceuticals and cosmetics identified in

this registration and, because the goods are legally identical, they must be presumed to travel in the same channels of trade and be sold to the same classes of customers. See In re Viterra Inc., 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (absent restrictions in the application and registration, goods and services are presumed to travel in the same channels of trade to the same class of purchasers). These two du Pont factors obviously favor a finding of likelihood of confusion. However, there are two other relevant du Pont factors that do not, and in this case they outweigh the other factors.

The mark in Registration No. 2759298 consists of letters in a design format in which the letters partially appear on the reverse tonality background, and part of each letter appears or is created by part of the other letter. As a result, it is not clear that the letters are, in fact, "SK"; for example, the mark may be perceived as the letter "S" next to an abstract line design. Even if we accept that consumers would view the letters in the mark as "SK," because the letters are depicted in a noticeable design format, we cannot treat the mark as though it were merely the letters SK, or that it would be pronounced as SK. "The nature of stylized letter marks is that they partake of both visual and oral indicia, and both must be weighed in

the context in which they occur." In re Electrolyte Laboratories, Inc., 929 F.2d 645, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990). As the predecessor to our primary reviewing court stated in Georgia-Pacific Corp. v. Great Plains Bag Co., 614 F.2d 757, 204 USPQ 697, 699 (CCPA 1980), a mark that consists of highly stylized letters is "in the gray region between pure design marks which cannot be vocalized and word marks which are clearly intended to be."

Accordingly, we do not regard the letters "SK" in applicant's mark SK-INFLUX to convey the same impression as "SK" in the cited mark, and cannot base a finding of similarity on the mere fact that both marks can be said to contain these letters. Because of the significant visual differences between the marks, and the fact that a design mark is viewed, not spoken, and therefore the cited stylized letter mark cannot be treated simply as a word mark, we find that the marks are different in appearance, pronunciation, connotation and commercial impression. See In re Electrolyte Laboratories, 16 USPQ2d at 1240.

Further, based on the identification of the goods, which are chemical additives for the manufacture of pharmaceuticals and cosmetics, the purchasers must be deemed to be manufacturers of pharmaceuticals and

cosmetics. As such, they are considered to be sophisticated purchasers, who would purchase these products with care. Such purchasers are not likely to believe that these goods emanate from a single source merely because the letters in a design mark may be construed as "SK," and "SK" is the first element of applicant's mark.

In view of the foregoing, the examining attorney's refusal of registration based on Registration No. 2759298 is reversed.

Registration No. 3422863

The mark in this registration, as well as in Registration No. 3411705, is

and, unlike the mark in Registration No. 2759298, the mark is not merely a design mark, but a mark in which it is clear that the letters are "SK." Further, these letters comprise the only literal element of the mark, and are larger and clearly separate from the design element which, although it is described as a butterfly, is an abstract design rather than a true image of a butterfly, such that it does not clearly convey that it is a depiction of any particular object. As a result, consumers are likely to

refer to or call for the registrant's goods by the only literal element in the mark, "SK." See In re Appetito Provisions Co., 3 USPQ2d 1553, 1554 (TTAB 1987) (if a mark comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services). Accordingly, we treat "SK" as the dominant part of the registered mark.

As for applicant's mark, because a hyphen separates the "SK" portion from the "INFLUX" portion, "SK" will be seen as a separate element. Further, although applicant has stated that "influx" has no significance in the industry, we take judicial notice that the word "influx" means "the act of flowing in; inflow,"[5] and therefore, as applied to additives, has a slight suggestive connotation. Moreover, based on the record herein, "SK" must be considered arbitrary. Although applicant has submitted four third-party registrations which include the letters "SK," third-party registrations are not evidence of use of the marks. In re Mighty Leaf Tea, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010). Third-party registrations may

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[5] Collins English Dictionary, unabridged, 10th ed. (2009). The Board may take judicial notice of dictionary definitions. University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

be considered in the manner of dictionary definitions, to show that a term has a particular significance in an industry, id., but the four third-party registrations submitted by applicant are for very different goods from those at issue herein, such that they do not show that "SK" has a significance for the registrant's goods.[6] Because SK is the first part of applicant's mark, and INFLUX has a slight suggestive significance, we view SK as the dominant part of applicant's mark. See Palm Bay Imports v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

It is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. In re National Data Corp., 753 F.2d

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[6] Registration No. 3438660 for SK-Electronics and design is for, inter alia photomasks for use in manufacture of electronic visual display panels and other electronic devices; Registration No. 3425869 for SK-2000 is for adhesive for use with cellulose insulation; Registration No. 3580685 for SKion is for, inter alia, chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry, fire extinguishing compositions, and chemical substances for preserving food stuffs; Registration No. 3583617 for SKK and design is for custom manufacture of compression moulded pharmaceutical preparations for others.

1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Therefore, in comparing the marks, we give greater weight to the letters "SK" in the registrant's mark, and to the "SK" portion of applicant's mark, although we hasten to add that we are not comparing only these elements, but are considering the marks as a whole. Because of the manner in which "SK" appears in applicant's mark, it gives the impression of a house mark, with "INFLUX" indicating a product line. As a result, those who are familiar with the registrant's SK and design mark are likely to believe, if the mark is used on goods that are the same or similar to the registrant's, that the goods emanate from the same source.

In concluding that the marks are similar, we have considered applicant's various arguments, but are not persuaded thereby. The cases relied on by applicant, in which no confusion was found despite a common element, are inapposite. In those cases, the common element was descriptive or highly suggestive, and therefore was not a sufficient basis on which to predicate a finding of likelihood of confusion. In this case, there is no evidence that "SK" is not an arbitrary mark. Applicant has also argued that its mark would be pronounced SKIN FLUX, and therefore it differs in pronunciation and connotation from the cited mark. Although it is *possible* that some

consumers might run the mark together in order to create a shorter, two-syllable term, it is more probable that consumers would treat the hyphen in the mark, SK-INFLUX, as indicating that these are separate elements, and would view the mark as consisting of the letters S and K and the word Influx and therefore pronounce the mark as the four syllable S-K-Influx,. Certainly in light of the role that hyphens play in the English language to separate elements of a term, we cannot accept applicant's unsubstantiated assertion that consumers would view and pronounce the mark as applicant suggests. Because of the common element SK in both marks, and because INFLUX in applicant's mark gives the impression of a subsidiary product line mark, we find that the element INFLUX in applicant's mark is not sufficient to distinguish the marks, and that overall the marks are similar in appearance, pronunciation, meaning and commercial impression.[7]

We turn next to the question of the similarity of the goods. The examining has pointed out that this cited

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[7] Applicant makes the argument that "a simple side by side viewing" of the cited mark in contrast to its mark demonstrates the significant differences in the marks. Reply brief, p. 3. However, side-by-side comparisons are not the appropriate test. See Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106, 108 (TTAB 1976)("it is well established that the test to be applied in determining likelihood of confusion is not whether marks are distinguishable on the basis of a side-by-side comparison").

registration includes citric acid and acetone, and has submitted evidence showing that these items are used as ingredients in cosmetics and pharmaceuticals. We note that the identification for citric acid in the identification is for "citric acid for industrial use," and therefore we cannot treat this item as being for cosmetic and pharmaceutical use, which is the field in which applicant's identified additives and auxiliary agents for the production of cosmetic and pharmaceutical products are used. However, the "acetone" identified in the cited registration is not limited to any particular field, and the evidence submitted by the examining attorney shows that this product is used in cosmetic products. For example, the website for Spectrum Chemicals and Laboratory Products states that it is "a major manufacturer and distributor of cosmetic ingredients and cosmetic chemicals used in the production of personal care, cosmeceutical, toiletry and fragrance products," and lists, under the "Cosmetic Chemicals & Cosmetic Ingredients" that it supplies, "acetone NF" and "acetone reagent ACS."[8] An article in

[8] www.spectrumchemical.com, attached to July 21, 2011 Office action, pages 24 and 29.

DERMAdoctor, which discusses cosmetic ingredients, lists "acetone" under "Common Ingredients."[9]

Because the registrant's identification is not restricted as to the use of the various chemicals, and because the evidence shows that acetone may be used in cosmetics, the registrant's identified goods must be deemed to be, in part, additives for the production of cosmetic products, and therefore applicant's and the registrant's goods must be considered to be in part identical.

Applicant argues that there is no evidence that the purchasing decisions for the applicant's and the registrant's goods would be made by the same people. However, to the extent that the goods are legally identical, they must be presumed to travel in the same channels of trade and be sold to the same classes of purchasers. In re Smith and Mehaffey, 31 USPQ2d 1531, 1532 (TTAB 1994).

The du Pont factors of the similarity of the goods and the channels of trade favor a finding of likelihood of confusion.

The next factor we consider is the sophistication of the purchasers. As we have previously discussed, the

[9] www.dermadoctor.com, attached to January 3, 2011 Office action, p. 158.

purchasers must be considered sophisticated and careful. However, even careful consumers can be confused if similar marks are used on identical goods since, even though they would be aware of the differences in the marks, they would believe those differences represented variant brands emanating from a single source. As for applicant's argument that consumers would be "well aware that the product is coming from the Applicant company," brief, p. 7, this apparently refers to applicant's earlier comment that "consumers would recognize Applicant's goods as coming from the Applicant source based in Germany, in contrast to the goods from the Korea-based owner of the cited registrations." Brief, p. 7. In other words, applicant is relying on the extrinsic fact of the geographic locations of the applicant and registrant to show that confusion is not likely. However, we must determine whether applicant's *mark* is likely to cause confusion with the registrant's mark, not whether consumers might be able to obtain other information as to the source of the goods. For example, the cases are legion that information on labels that states the company name or house mark of the manufacturer will not permit the manufacturer to register a mark that is confusingly similar to another party's mark. See, for example, In re 1st USA Realty Professionals Inc., 84 USPQ2d

1581, 1587 (TTAB 2007). We also point out that the registrant is not restricted to manufacturing its products in Korea, and certainly in today's global economy with its multinational corporations, consumers are likely to believe that a company could have branches or subsidiaries in more than one country. In this connection, we note that the website for Siegfried states that it has pharmaceutical production facilities located in Switzerland, Germany, Malta and the U.S.A., and subsidiaries in China and Taiwan.[10]

We affirm the refusal of registration based on this registration.

Registration No. 3411705

The mark in this registration is the same as that in Registration No. 3422863. The goods, however, are not as close to applicant's goods as those in Registration No. 3422863. Accordingly, we need not engage in an extended analysis of whether applicant's use of its mark is likely to cause confusion with this registration. If confusion is likely with Registration No. 3422863, applicant's mark must be refused registration on that basis, and there is no need to also consider whether the refusal of registration on the

[10] www.siegfried.ch, attached to May 25, 2010 Office action at page 82.

basis of Registration No. 3411705 must also be affirmed. On the other hand, if applicant's mark were not likely to cause confusion with Registration No. 3422863, then, because the goods in Registration No. 3411705 are not as close to applicant's goods as are the goods in Registration No. 3422863, *a fortiori* there can be no likelihood of confusion with respect to Registration No. 3411705. See In re Hartz Hotel Services Inc., 102 USPQ2d 1150, 1151 (TTAB 2012) (if confusion is likely between applicant's mark and a registration for same services, there is no need to consider the issue of likelihood of confusion with a registration for other goods and services, while if there is no likelihood of confusion with respect to mark for identical services, there would be no likelihood of confusion with respect to a registration for goods and services that are not identical).

Decision: The refusal of registration is affirmed on the basis of likelihood of confusion with Registration No. 3422863.