

From: Gustason, Anne

Sent: 3/12/2015 9:34:36 AM

To: TTAB EFiling

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 86150854 - NEOPLUS GEL - N/A - EXAMINER BRIEF

Attachment Information:

Count: 4

Files: evidence1-1.jpg, evidence1-2.jpg, evidence1-3.jpg, 86150854.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86150854 MARK: NEOPLUS GEL	
CORRESPONDENT ADDRESS: MATTHEW H SWYERS THE TRADEMARK COMPANY 344 MAPLE AVE W STE 151 VIENNA, VA 22180-5612	GENERAL TRADEMARK INFORMATION: http://www.uspto.gov/trademarks/index.jsp TTAB INFORMATION: http://www.uspto.gov/trademarks/process/appeal/index.jsp
APPLICANT: K & N Distributors	
CORRESPONDENT'S REFERENCE/DOCKET NO: N/A CORRESPONDENT E-MAIL ADDRESS: admin@thetrademarkcompany.com	

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the examining attorney's final refusal to register the mark NEOPLUS GEL (in standard character format) for the goods "cosmetics," in International Class 3. The examining attorney has refused registration on the Principal Register because applicant's mark is confusingly

similar with Registration No. 2582466 for the mark NEO PLUS (in standard character format) for the goods, "all purpose preparations for cleaning, washing and scrubbing, namely, face cleansing products, namely cleansing gel, tonic lotion, scrub; products for face care, namely, day cream, night cream, eye cream/gel, nourishing cream, anti-age/anti-wrinkle cream, serum, anti-wrinkle eye cream, moisturizer, mask." 15 U.S.C. §1052(d); 37 C.F.R. §2.46(a).

Accordingly, it is respectfully requested that the refusal based on likelihood of confusion under Trademark Act Section 2(d) be affirmed.

1. FACTS

On December 26, 2013, K & N Distributors filed U.S. Trademark Application Serial No. 86/150854, seeking registration of the proposed mark, NEO PLUS GEL for "cosmetics," and provided a disclaimer of the term GEL. On March 28, 2014, the previously assigned examining attorney issued an office action refusing registration of the mark under Trademark Act Section 2(d).

On September 29, 2014, applicant responded to the Office Action and presented arguments in an effort to overcome the refusal under Section 2(d) of the Trademark Act.

On October 6, 2014, the current examining attorney was assigned to the application. On November 6, 2014, the examining attorney made final the refusal under Section 2(d) of the Trademark Act.

On November 10, 2014, the applicant filed its Brief in support of Registration of Serial Number 86/150854.

II. THE MARKS OF APPLICANT AND REGISTRANT ARE IDENTICAL IN DOMINANT PORTION AND THE GOODS ARE SIMILAR OR CLOSELY RELATED SUCH THAT THERE EXISTS A LIKELIHOOD OF CONFUSION, MISTAKE, OR DECEPTION UNDER SECTION 2(d) OF THE TRADEMARK ACT

The Board should affirm the likelihood of confusion refusal because the marks are identical in part and the goods are closely related in nature and purpose. The Court in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973), listed the principal factors to be considered in determining whether there is a likelihood of confusion under Section 2(d) of the Trademark Act. Any one of the factors listed may be dominant in any given case, depending upon the evidence of record. In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods, and similarity of trade channels of the goods.

Any doubt as to the issue of likelihood of confusion must be resolved in favor of the registrant and against the applicant who has a legal duty to select a mark that is dissimilar to trademarks already being used. See *In re Hyper Shoppes (OHIO), Inc.*, 837 F.2d 463 (Fed. Cir. 1988).

A. The marks are similar because the dominant portion of the mark is identical to the registrant's mark and thus confusingly similar.

The marks must be compared for similarities in sound, appearance, meaning, or connotation. *E.I. du Pont de Nemours*, 476 F.2d 1357. Similarity in any one of these elements is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755 (TTAB 1977). The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. Instead, the issue is whether the marks create the same overall impression. *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). Thus, the primary focus is on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *Chemetron Corp. v. Morris Coupling and Clamp Co.*, 203 USPQ 537 (TTAB 1979). When an applicant's mark is compared to the registered mark, "the points of similarity are of greater importance than the points of

difference.” *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 40 (D.C. Cir.), *cert. denied*, 351 U.S. 973 (1956).

The applicant’s mark is identical in dominant portion and highly similar in appearance, meaning, connotation and commercial impression to the registered marks. The applicant seeks to register the mark NEOPLUS GEL in standard character format. The registered mark is NEO PLUS (RN 2582466) in standard character format.

A standard character or typed mark means that the mark may be displayed in any lettering style. 37 C.F.R. §2.52(a). The rights associated with a mark in typed or standard character form reside in the wording itself, and the applicant is free to adopt any style of lettering, including lettering identical to that used by the registrants. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991). The applicant’s mark and the registrant’s mark, despite the spacing, are almost identical. For example, the marks contain the same two words (NEO and PLUS) and contain no additional stylization.

1. The Dominant Portion of the Applicant’s Mark Is the Wording NEOPLUS Rendering it Confusingly Similar in Appearance and Sound to the Registered Mark

The law is clear that marks may still be confusingly similar notwithstanding the addition, deletion or subtraction of letters or words. *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988). “It is not necessary for similarity to go only to the eye or the ear for there to be infringement. The use of a designation which causes confusion because it conveys the same idea, or stimulates the same mental reaction, or has the same meaning is enjoined on the same basis as where the similarity goes to the eye or the ear.” *Standard Oil Co. v. Standard Oil Co.*, 116 USPQ 176, 182 (10th Cir. 1958). The applicant’s mark and the registrant’s mark are similar in appearance and sound because they are comprised in part of the same wording. The commercial impression also remains the same because the term GEL in applicant’s mark does not distinguish the overall meaning of the mark.

The applied-for mark is NEOPLUS GEL, and because the term GEL is highly descriptive for the goods, the wording NEOPLUS is the dominant portion of the mark. Although the marks are compared in their entireties under a Section 2(d) analysis, one feature of a mark may be recognized as more significant in creating a commercial impression. It is well established that “in articulating reasons for reaching a conclusion on the issue 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 consideration of the marks in their entireties.” *In re National Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985). For instance, “[t]hat a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark.” *Id.* Accordingly, there is nothing improper in giving less weight to the highly descriptive and disclaimed term GEL and more weight to the term(s) NEOPLUS as the dominant term in the applicant’s mark, when consideration is given to the similarity of the marks in their entireties.

If the dominant portion of the marks is the same, then the marks may be confusingly similar notwithstanding peripheral differences. *See, e.g., In re Mighty Leaf Tea*, 601 F.3d 1342, 1347-48 (Fed. Cir. 2010). Even though the degree of required similarity between the marks is not as great here because the goods are the same, the marks in question are confusingly similar nonetheless.

2. Applicant’s mark and Registrant’s Mark are Similar in Overall Impression and Meaning

In order to distinguish itself from the registered marks, the applied-for mark must also contain some other non-descriptive wording like the registered marks. *See In re Mighty Leaf Tea*, 601 F.3d 1342 (Fed. Cir. 2010); *In re Optica Int’l*, 196 USPQ 775, 778 (TTAB 1977). Aside from the highly descriptive term GEL, however, there is no other wording in the applied-for mark to distinguish it from the registered marks. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 1343 (Fed. Cir. 2004) (“Viewed in their entireties with non-dominant features appropriately discounted, the marks [GASPAR’S ALE for beer and

ale and JOSE GASPAR GOLD for tequila] become nearly identical.”). This is not the case here for there isn’t any non-descriptive wording that distinguishes the applicant’s mark from the registrant’s mark and the spacing that exists in one versus the other is negligible.

Applicant essentially concedes this point by stating in its brief, “*From an initial context, Applicant must concede the phonetic equivalence of NEOPLUS versus NEO PLUS. Moreover, as the Applicant has disclaimed GEL apart from its mark as a whole, Applicant must concede the highly similar nature of the first cited trademark against its mark.* (Please see Applicant’s brief p. 8). Emphasis added.

3. Evidence of Dilution is Unpersuasive

Applicant has submitted printouts of third-party registrations for marks containing the wording NEO to support the argument that this wording is weak, diluted, or so widely used that it should not be afforded a broad scope of protection. The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks in use in the marketplace in connection with similar goods and/or services. *See Nat’l Cable Television Ass’n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973).

This argument and the supporting evidence are unpersuasive. Evidence of weakness or dilution consisting solely of third-party registrations, such as those submitted by applicant in this case, is generally entitled to little weight in determining the strength of a mark, because such registrations do not establish that the registered marks identified therein are in actual use in the marketplace or that consumers are accustomed to seeing them. *See AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009); *Richardson-Vicks Inc. v. Franklin Mint Corp.*, 216 USPQ 989, 992 (TTAB 1982). Because the applied-for mark contains the same common

wording as the registered marks but no other distinguishing wording, it does not create a distinct commercial impression from the registered marks. Accordingly, even though the applied-for mark and the registered marks are not word-for-word copies of one another, they are confusingly similar.

B. The goods are closely related because they overlap due to their nature and purpose.

The likelihood of confusion should also be affirmed because the goods are related. It is well settled that the issue of likelihood of confusion between marks must be determined on the basis of the goods as they are identified in the application and the registration. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Accordingly, without limitations or restrictions as to their channels of trade or classes of purchasers, the goods must be deemed to be promoted in the same channels of trade and directed to the same purchasers. *Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910 (TTAB 2000).

1. Definition of Cosmetics Encompasses Makeup

Here, the applicant's "cosmetics," which are commonly known as makeup in the industry, are closely related to the registrant's "all purpose preparations for cleaning, washing and scrubbing, namely, face cleansing products, namely cleansing gel, tonic lotion, scrub; products for face care, namely, day cream, night cream, eye cream/gel, nourishing cream, anti-age/anti-wrinkle cream, serum, anti-wrinkle eye cream, moisturizer, mask."¹ Both the applicant's and the registrant's goods are related beauty care items and serve the same purpose and function, namely, to provide the user with better quality and more beautiful skin. The nature of the registrant's goods overlap because the goods are types of cosmetics. Neither identification limits the channels of trade or class of purchasers of the identified

¹ The Examining Attorney requests that the Board take judicial notice of the attached dictionary definition for the words "cosmetics" from Collins' Online Dictionary. The Board may take judicial notice of dictionary definitions. TBMP §1208.04.

goods. Thus, it is presumed that these goods travel in the same channels of trade and are available to the same consumers.

The Final Office Action included online articles depicting single sources that provide cosmetics and beauty care items, such as creams and masks. For example, the excerpt from Lush Cosmetics Company demonstrates that they provide both “fresh face masks,” and “makeup,” (Please see page 2 from final office action dated November 6, 2014) for purchase from their website. The excerpt from Aпивita Cosmetic Company (p. 4-6) describes the provision “face masks,” and “lip care” cosmetics for purchase. Further, web page evidence from Ulta Beauty (p. 8-21), depicts “hair masks,” and various cosmetics, such as eye shadow, blush, and foundation, provided by a single source. This market evidence tends to show that cosmetics and beauty care creams and lotions are closely related.

2. Applicant’s Goods and Registrant’s Goods Overlap in Function

Applicant argues that “The blocking mark’s cosmetics are designed to attract a very sophisticated[sic], namely, consumers visiting a medical spa or physician’s office for skin care needs. This is an unsupported assertion by the applicant. The goods are common everyday goods, and no specialized knowledge is needed to purchase these goods. The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); see, e.g., *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d. 1317, 1325, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011).

Applicant has submitted new information regarding purported third-party usage of the applied-for mark. The examining attorney objects to the submission of this evidence and asks the Board to reject it and the accompanying argument. This submission is untimely because the evidentiary record should be complete prior to the filing of an *ex parte* appeal to the Board. 37 C.F.R. §2.142(d). See TBMP

§1207.01; *In re Trans Continental Records Inc.*, 62 USPQ2d 1541 (TTAB 2002). Even if it were determined this third-party usage is both a registered mark and confusing, it is no defense to register yet another confusingly similar mark. *AMF Inc. v. American Leisure Products, Inc.*, 177 USPQ 268, 269 (C.C.P.A. 1973).

The evidence of record shows that the goods are closely related because applicant's and registrant's goods are related beauty care items and serve the same purpose and function, namely, to provide the user with better quality and more beautiful skin. Thus, the factor of the relatedness of the goods favors a finding of likelihood of confusion.

III. CONCLUSION

Because the marks are conceded identical in dominant portion and the goods are closely related, consumers encountering the applicant's mark and the registered marks in the marketplace are likely to mistakenly believe that the goods emanate from a common source. For the foregoing reasons, the refusal to register under Section 2(d) of the Trademark Act should, therefore, be affirmed.

Respectfully submitted,

/Anne C. Gustason/

Anne C. Gustason

Trademark Examining Attorney

Law Office 117

(571) 272-9722

Hellen Bryan-Johnson

Managing Attorney

Law Office 117

ALL-NEW **fire HD**  POWERFUL TABLET. BREAKTHROUGH PRICE. ~~from \$199~~ **\$99** [SHOP NOW](#) amazon

You are here > [Home](#) > [American English Dictionary](#) > Definition of 'cosmetic'

English > English for Learners > French > German > Spanish > Italian >

American English Dictionary

Pioneers in dictionary publishing since 1819

British English American English

Browse the American Dictionary (A-Z)

Your search found: [synonyms](#) / [usage examples](#) / [images](#)

Word Frequency ●●●○

cosmetic (kɑːzˈmɛtɪk )

SHOCKING! Oprah Lied!



Oprah Has Been Exposed For TRICKING THE WORLD! She Has Lied for Years!

Definitions

adjective

1. beautifying or designed to beautify the complexion, hair, etc.
2. for improving the appearance by the removal or correction of blemishes or deformities, esp. of the face
3. of or for improving the appearance without making any basic changes, as to conceal defects, make more acceptable, etc.; also, superficial

noun

4. any cosmetic preparation for the skin, hair, etc., as blusher and powder
5. anything cosmetic (*often used in pl.*)

Gaga or Shakespeare?

Who said it?

Stumped by

This site uses cookies to improve your browsing experience. For more information see our [privacy policy](#).

Close message x

cos'metically *adverb*

Word Origin

Gr *kosmētikos*, skilled in arranging < *kosmein*, to arrange, adorn < *kosmos*, order

Synonyms

[View thesaurus entry](#)

= [beautifying](#), [embellishing](#), [superficial](#), [surface](#)

Translations for 'cosmetic'

American English: [cosmetic](#) Cosmetics are substances such as lipstick or powder, which people put on their face to make themselves look more attractive. [cosmetics](#) ..the cosmetics counter of a department store.

[Show more](#)

maiden's?

Use our A-Z of cricketing terms

What Do You Think?

Would you bother learning another language if perfect translation technology existed?

No

Yes

I'm not sure

This site uses cookies to improve your browsing experience. For more information see our [privacy policy](#).

Close message x

cosméticos

European Spanish: [cosmético](#)

French: produit de beauté

German: Kosmetikum

Italian: cosmetico

Japanese: 化粧品

Example Sentences Including 'cosmetic'

Especially for my friend here," I gestured at Skink, "who could use a little cosmetic surgery.

William Lashner FATAL FLAW (2003)

I might be a cynic, but rather than curing a disease, I'll bet we'll find a new flood of cosmetic upgrades.

SLASHDOT (2004)

Her beauty indulgence is Restylane, a \$400 cosmetic injection to plump her lips.

SEATTLE TIMES (2004)

In the latter case, much of his craft involved makeup and other cosmetic techniques.

CHICAGO SUN-TIMES (2005)

[Cruffin](#)

[Jerdon Babbler](#)

[Chinchorro](#)

[Nice Nelly](#)

[quantrophenia](#)

[View More](#)

Related Terms

0 results

Browse nearby words

- > [cosmic rays](#)
- > [cosmo-](#)
- > [cosmogony](#)

This site uses cookies to improve your browsing experience. For more information see our [privacy policy](#).

Close message x

Sponsored Links

Ads by Google related to: cosmetics

covergirl.com **Makeup Cosmetics**
★★★★ (4.8) For Exceptionally Full Lashes Try Bloom Mascara by LashBlast™ Now!
1,027 people follow COVERGIRL on Google+
Colorful Lipstick Nail Polish
Girls Can Shine COVERGIRL
Full Lash Bloom Mascara Need Advice?

lifeskin.com **Lifeline® Skin Care**
Anti-Aging Skin Care Leaders. Guaranteed Results. Shop Now!

l'orealparisusa.com **Cosmetics**
★★★★★ (4.6) Always Look Your Best With L'Oréal Paris. Because You're Worth It.
Makeup Genius App Colour Riche
Voluminous Butterfly Makeup Setting Spray

All American words that begin with 'c':

"cosmetics" photos from Flickr

This site uses cookies to improve your browsing experience. For more information see our [privacy policy](#).

Close message x

Comments

[Log in](#) to comment on this word.

Collins Dictionary # A B C D E F G H I J K L M N O P Q R S T U V W X Y Z

The Collins English Dictionary	The Collins American English Dictionary	The Collins English for Learners Dictionary
The Collins American English for Learners Dictionary	The Collins English-French Dictionary	The Collins French-English Dictionary
The Collins English-German Dictionary	The Collins German-English Dictionary	The Collins English-Spanish Dictionary
The Collins Spanish-English Dictionary	The Collins English-Italian Dictionary	The Collins Italian-English Dictionary
The Collins English Thesaurus	The Collins American Thesaurus	Latest New Word Suggestions

This site uses cookies to improve your browsing experience. For more information see our [privacy policy](#).

Close message x