

This Opinion is not a  
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Murad, Inc.*

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Serial No. 86286112

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Michael A. Painter of Isaacman, Kaufman & Painter, P.C.  
for Murad, Inc.

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Before Zervas, Taylor, and Lynch,  
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

Murad, Inc. (“Applicant”) seeks registration on the Principal Register of the mark INVISIBLUR PERFECTING SHIELD (standard characters) for “Non-medicated skin care preparations, namely, creams, lotions, gels, toners, cleaners

and peels” in International Class 3 (“Application”).<sup>1</sup> The Examining Attorney required a disclaimer of PERFECTING SHIELD based on descriptiveness of the wording. See 15 U.S.C. §§ 1052(e)(1), 1056(a). Applicant provided only a disclaimer of SHIELD and argued against the requirement as to PERFECTING. Additionally, the Examining Attorney refused registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), as likely to cause confusion with the registered mark INVISIBLEND (standard characters) for “cosmetic creams; cosmetic creams for skin care; cosmetic preparations for skin care; face creams for cosmetic use,” also in International Class 3 (“Registration”).<sup>2</sup> After the Examining Attorney made the requirement and refusal final, Applicant appealed to this Board. We affirm both the disclaimer requirement and the Section 2(d) refusal to register.

#### I. Disclaimer Requirement

“The PTO can condition the registration of a larger mark on an applicant’s disclaimer of an ‘unregistrable component of a mark otherwise registrable.’ 15 U.S.C. § 1056(a).” *In re Louisiana Fish Fry Products, Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262, 1264 (Fed. Cir. 2015). Descriptiveness of particular wording can form the basis of a proper disclaimer requirement. *See id.*

First, we consider the requirement to disclaim PERFECTING based on its descriptiveness of the function of the skin care preparations identified in the Application. We take judicial notice of the relevant definition of “perfect” as a verb,

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<sup>1</sup> Application Serial No. 86286112 was filed May 20, 2014 based on 15 U.S.C. § 1051(b).

<sup>2</sup> Registration No. 4712733 issued October 13, 2010.

“to make perfect: improve, refine.”<sup>3</sup> The record includes voluminous evidence showing descriptive use of “perfecting” in the cosmetics field.<sup>4</sup> Examples include:

- JERGENS BB Body Perfecting Skin Cream.<sup>5</sup>
- RADICAL Skincare’s Skin Perfecting Screen<sup>6</sup> to help achieve “the perfect healthy radiance.”
- FACES Perfecting Skin Smoother<sup>7</sup> to smooth out “skin imperfections.”
- OLAY BB Cream Skin Perfecting Tinted Moisturizer<sup>8</sup> with Sunscreen with “6 skin-perfecting benefits.”
- EUCERIN REDNESS RELIEF Daily Perfecting Lotion.<sup>9</sup>
- NUXE Aroma-Perfection Skin-Perfecting Purifying Lotion<sup>10</sup> providing “Double action for oily skin: purifying and skin perfecting.”

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<sup>3</sup> *Merriam-Webster Online Dictionary*, <http://www.merriam-webster.com/dictionary/perfect>, © 2015 Merriam-Webster, Inc. The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

<sup>4</sup> September 8, 2014 Office Action at 5-9; 12-13; 19-31; October 1, 2014 Suspension Letter at 2-25. Although not objected to by Applicant, we did not consider the evidence regarding JOHNSON’S Skin Perfecting Oil because it appears to come from a United Kingdom-based retail or promotional website showing product prices in British pounds. September 8, 2014 Office Action at 10-11. We did not consider the evidence regarding GAZELLI White Oil Illuminating Perfecting Skin Polish for similar reasons. *Id.* at 14-18.

<sup>5</sup> September 8, 2014 Office Action at 5.

<sup>6</sup> *Id.* at 7-8.

<sup>7</sup> *Id.* at 12.

<sup>8</sup> *Id.* at 22-23.

<sup>9</sup> *Id.* at 26.

<sup>10</sup> *Id.* at 28.

- The Popsugar.com webpages entitled “Learn How to Create a Modern Holiday Makeup Look,”<sup>11</sup> stating that “Achieving a flawless makeup look starts with perfecting your skin. Jennings always dabs on a little moisturizer and eye cream before applying foundation ....”
- PHILOSOPHY NO REASON TO HIDE Instant Skin-tone Perfecting Moisturizer Broad Spectrum SPF 20 Sunscreen,<sup>12</sup> with product details indicating that “instantly the hydrating formula perfects the appearance of uneven areas.”
- PRIORI Perfecting Concealer SPF 25.<sup>13</sup>

These examples and the other evidence of record proves common use of the word “perfecting” in the cosmetics industry to describe the function of creams, such as those identified in the Application, that give skin an improved or refined appearance.

Applicant offers no criticism of the descriptiveness evidence, but rather focuses its argument against the disclaimer on a 2010 non-precedential decision of the Board reversing a descriptiveness refusal of a different mark, PERFECTING SERUM for “skin moisturizer.” See *In re Murad*, Serial No. 77556539. Non-precedential decisions do not bind the Board but may, of course, be cited and considered for whatever persuasive value they have. *In re Fiat Group Marketing & Corporate Communications S.p.A.*, 109 USPQ2d 1593, 1596 n.6 (TTAB 2014). The

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<sup>11</sup> October 1, 2014 Suspension Letter at 2-3.

<sup>12</sup> *Id.* at 7-8.

<sup>13</sup> *Id.* at 21.

Board, however, does not encourage the practice. Applicant concedes that the Board is not bound in this case, but contends that the Examining Attorney erred by ignoring the decision, which Applicant maintains is “highly persuasive evidence.”<sup>14</sup> Indeed, the Board is not bound by this non-precedential decision, and “prior cases, precedential or not, are only useful to the extent that the facts in the prior cases are somewhat analogous to the facts in the current case.” *Inter IKEA Systems. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1742 (TTAB 2014). Furthermore, each case must be decided on its own facts and merits. *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (Each case must be assessed “on the record of public perception submitted with the application”). In contrast to the prior case, in this case, Applicant failed to counter the voluminous evidence of third-party descriptive use and offered no proof of successful enforcement efforts to stop third-party use. We must conclude on this record that many others in Applicant’s industry use the term PERFECTING on an ongoing basis, and consumers frequently encounter this term to describe the purpose of certain creams and cosmetic preparations.

Finally, based on a list of marks and Serial Numbers in its Appeal Brief, Applicant also claims that the USPTO has registered a number of other marks containing the word PERFECTING with no disclaimer of it for goods in International Class 3.<sup>15</sup> The Examining Attorney correctly objects that Applicant failed to properly make any prior registrations of record by merely listing them but

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<sup>14</sup> 4 TTABVUE at 6.

<sup>15</sup> 4 TTABVUE at 6-8.

not submitting copies of the registrations themselves as required.<sup>16</sup> *See In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1843 (TTAB 2012) (mere listing of third-party registrations insufficient); *Trademark Trial and Appeal Board Manual of Procedure* § 1208.02 (June 2015) (“Mere listings of registrations ... are not sufficient to make the registrations of record”). Because Applicant did not properly introduce the third-party registrations and they are not part of the record, we decline to consider them.

Based on the strong evidence that PERFECTING describes a feature of the goods, in that they make skin appear perfect or flawless, we affirm the disclaimer requirement.

## II. Likelihood of Confusion

The determination under Section 2(d) involves an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relatedness of the goods. *See In re Chatam Int’l Inc.*, 380 F.2d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

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<sup>16</sup> 6 TTABVUE at 10.

With respect to the marks, we must compare them “in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). The test assesses not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *see also Edom Laboratories Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012).

As to the goods, we must determine whether their degree of relatedness rises to such a level that consumers would mistakenly believe the goods emanate from the same source. The comparison must be based on the identifications in the Application and Registration. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

We first consider the relatedness of Applicant’s and Registrant’s goods, and find that this *du Pont* factor weighs heavily in favor of likely confusion because the goods are identical in part. The Registration broadly identified “cosmetic creams,” or creams for cosmetic purposes, includes the non-medicated skin care creams

identified in the Application. The goods, therefore, are legally identical. Applicant does not argue that there are any differences in the goods.

We also presume, as we must, that Applicant's and Registrant's identical goods, for which both identifications are unrestricted, travel through the same channels of trade to the same class of purchasers. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *see also Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (affirming Board finding that where the identification is unrestricted, "we must deem the goods to travel in all appropriate trade channels to all potential purchasers of such goods"). Because the goods are common consumer goods, and particularly, because registrant's goods are non-medicated, we find that consumers of Applicant's and registrant's goods include members of the general public. Applicant makes no argument that the channels of trade differ. Accordingly, given the identical goods and lack of trade channel restrictions in the identifications of goods, we deem the trade channels identical, and this *du Pont* factor favors likely confusion.

The crux of the likelihood of confusion analysis in this case rests on the similarity of the marks themselves, which we compare in their entireties. When the goods are identical, as they are at least in part in this case, "the degree of similarity necessary to support a conclusion of likely confusion declines." *See Century 21 Real Estate v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992). INVISIBLUR clearly dominates the mark in the Application. INVISIBLUR appears first in the mark, and "it is often the first part of a mark which is most



likely to be impressed upon the mind of a purchaser and remembered.” *Presto Products v. Nice-Pak Products*, 9 USPQ2d 1895 (TTAB 1988); *see also Palm Bay*, 73 USPQ2d at 1692 (noting the “prominence” resulting from being the first word in the mark). In addition, the other wording, PERFECTING SHIELD, is highly descriptive of the goods as a reference to the function of the product, and therefore less significant. *See Cunningham*, 55 USPQ2d at 1846, *quoting In re National Data Corp.*, 753 F.2d 1056, 224 USPQ at 752 (Fed. Cir. 1985) (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’”). Applicant already has disclaimed SHIELD based on the Examining Attorney’s proof from the skin care field that a “shield” protects the skin. As discussed more fully above in connection with the disclaimer requirement as to PERFECTING, the evidence reflects that this term describes a feature of the cosmetic goods. Nothing about the use of these terms together imparts a meaning that differs from the combination of individually descriptive terms. In contrast to these descriptive components of the mark, INVISIBLUR is a fanciful term and therefore stronger in the trademark sense. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1684 (Fed. Cir. 2010). Thus, when encountering the mark, consumers would perceive PERFECTING SHIELD as a reference to the function of the product, and focus more on INVISIBLUR as the source-indicating portion of the mark. The mark in the registration consists only of the term INVISIBLEND.

We find that Applicant's mark and the Registrant's mark are similar in appearance and sound, and they create a similar commercial impression. The mark in the Registration and the dominant element of Applicant's mark both start with the INVISI- prefix, and contain one additional syllable that starts with BL-. Thus, these common elements render INVISIBLUR and INVISIBLEND consonant in appearance and sound. Moreover, the record includes definitions of the terms embedded behind the prefix, and BLUR and BLEND both connote something indistinguishable or indistinct.<sup>17</sup> The similar meanings of these terms, coupled with the identical prefix, establish parallel commercial impressions. Although Applicant argues against this point by noting that "the word 'blur' is not used in any definition of the word 'blend' and correspondingly the word 'blend' is not used in any definition of the word 'blur,'"<sup>18</sup> we disagree that the words must be exact synonyms in order to create similar impressions.

Applicant contends that the Examining Attorney's comparison of the marks failed to take account of its mark as a whole, including the PERFECTING SHIELD portion.<sup>19</sup> However, we disagree and remain mindful that "[a]lthough the court may place more weight on a dominant portion of a mark, for example if another feature of the mark is descriptive or generic standing alone, the ultimate conclusion nonetheless must rest on consideration of the marks in total." *Viterra*, 101 USPQ2d

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<sup>17</sup> April 7, 2015 Office Action at 4-7 (*The American Heritage Dictionary* entries for "blend" defined as "To combine or mix (different substances) so that the constituent parts are indistinguishable from one another" and "blur" defined as "To make indistinct and hazy in outline or appearance").

<sup>18</sup> 4 TTABVUE at 5.

<sup>19</sup> 7 TTABVUE at 3-4.

at 1908 (citations omitted). As indicated above, consumers are unlikely to rely on the PERFECTING SHIELD wording to distinguish the source of Applicant's goods, and nothing about its addition to INVISIBLUR in the mark creates a distinct meaning or impression. Considering these marks in their entireties, we find that the great similarity between the mark in the cited Registration and the mark in the Applicant's Application weighs in favor of likely confusion, particularly in a case such as this where the goods are the same. *See Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004) (marks need not be as similar for likely confusion when the goods are identical). Accordingly, this factor favors likely confusion.

Thus, given the similarity of the marks, as well as the identical nature of the goods and trade channels, we consider the mark set forth in the Application likely to result in consumer confusion with the cited registered mark.

**Decision:** The refusal to register Applicant's mark under Section 2(d) is affirmed and the requirement that Applicant disclaim the term PERFECTING is affirmed. Therefore, registration is refused.