

This Opinion is not a
Precedent of the TTAB

Mailed: October 19, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re P.T. Arista Latindo
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Serial No. 86499199

Michael A. Shimokaji of Shimokaji IP,
for P.T. Arista Latindo.

David I, Trademark Examining Attorney, Law Office 114,
K. Margaret Le, Managing Attorney.

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Before Bergsman, Wellington, and Gorowitz,
Administrative Trademark Judges.

Opinion by Gorowitz, Administrative Trademark Judge:

P.T. Arista Latindo (“Applicant”) seeks registration on the Principal Register of the
standard character mark SENSI for, as amended:

Adult diapers, baby diapers, and diaper insert, namely,
inserts adapted for cloth adult and baby diapers and made
of cloth in International Class 5;

Protective gloves for industrial use in International Class
9;

Operating room apparel, surgical head caps, incontinence
bed pads, gloves for medical purposes, masks for use by
medical personnel, surgical shoe covers in International
Class 10; and

Gloves for household purposes in International Class 21.¹

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), solely with respect to the goods in International Class 5, on the ground that Applicant's mark so resembles the following registered marks:

SENSI-CARE (in typed format)² for "medicated skin care preparations, namely, protectants for the prevention of skin irritation and preparations for the treatment and prevention of diaper rash,"³ in International Class 5, and

SENSI-CARE for "Body wash preparations and skin moisturizers," in International Class 3 and "Skin protectant preparations, namely, medicated skin care preparations; preparations for protecting the skin from irritation, namely, pharmaceutical skin lotions; preparations for treatment and prevention of diaper rash, namely, medicated diaper rash ointments and lotions"⁴ in International Class 5

as to be likely to cause confusion, mistake or deception. The registrations are owned by the same entity.

When the refusal was made final, Applicant appealed. We affirm the refusal to register.

¹ Application Serial No. 86499199 was filed on January 9, 2015, based upon Applicant's allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).


² Prior to November 2, 2003, "standard character" drawings were known as "typed" marks. A typed mark is the legal equivalent of a standard character mark. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012).

³ Registration No. 2618533, issued on September 10, 2002; renewed.

⁴ Registration No. 3640455, issued on June 16, 2009; Sections 8 and 15 combined declaration accepted and acknowledged.

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.*, 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).

A. Similarity or dissimilarity of the marks at issue.

We start with a determination of the similarity or dissimilarity of the marks. Applicant's mark is SENSI in standard characters and Registrant's marks are SENSI-CARE in typed format and **SENSI**  **CARE** .

Because the design element in the second cited mark arguably contains an additional point of difference with Applicant's mark, we confine our analysis to the issue of likelihood of confusion between Applicant's mark and the cited registration for the mark in typed format, which is the equivalent of standard character format. That is, if confusion is likely between those marks, there is no need for us to consider the issue with respect to the cited registration for the mark with design element, while if there is no likelihood of confusion between Applicant's mark and the cited mark in standard characters, then there would be no likelihood of confusion with the

mark with design elements. *See, e.g., In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

In comparing the marks we must consider the appearance, sound, connotation and commercial impression of the marks at issue. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

While “the similarity or dissimilarity of the marks is determined based on the marks in their entireties ... 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 Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). In this case, “Sensi” is the dominant portion of the SENSI-CARE mark. The first word in a mark is frequently the most dominant portion of a mark since it is the most likely to be impressed upon the mind of the purchaser and to later be remembered. *See Palm Bay Imports*, 73 USPQ2d at 1692 (“Veuve” is the most prominent part of the mark VEUVE CLICQUOT because “veuve” is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word); *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”). *See also In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) (finding

JOSE GASPAR GOLD “nearly identical” to GASPAR ALE once the commercial significance of the descriptive and otherwise non-dominant terms JOSE, GOLD and ALE are properly discounted).

Moreover, the word “Care” is descriptive of “skin care preparation” because it directly informs potential consumers about the purpose of the product (*i.e.*, skin care). It is well-settled that descriptive matter may have less significance in likelihood of confusion determinations. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“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.’”) (quoting *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997).

Applicant adopted as its mark the first word of the cited mark SENSI-CARE, which is the dominant part of that mark. Thus, Registrant’s mark incorporates Applicant’s entire mark. In such circumstances, likelihood of confusion has been found where the entirety of one mark is incorporated within another. *See Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2d 1651, 1660 (TTAB 2014) (applicant’s mark PRECISION is similar to opposer’s mark PRECISION DISTRIBUTION CONTROL) (citing *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (applicant’s mark ML is similar to registrant’s mark ML MARK LEES). *See also Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406, 407 (CCPA 1967) (THE LILLY as a mark for women's dresses is likely to be confused with LILLI ANN for

women's apparel including dresses); *In re United States Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985) (CAREER IMAGE for women's clothing stores and women's clothing likely to cause confusion with CREST CAREER IMAGES for uniforms including items of women's clothing). In *United States Shoe*, the Board observed that “Applicant's mark would appear to prospective purchasers to be a shortened form of registrant's mark.” 229 USPQ at 709.

As such, we find that the marks are similar in appearance, sound, connotation and commercial impression.

Applicant argues that the marks are not similar because the commercial impressions and connotations of the marks are different. The asserted bases for Applicant's arguments are: 1) dictionary definitions of SENSI and 2) web pages from Applicant's and Registrant's websites.

Applicant contends that the meaning and commercial impression of its mark SENSI is “sensible.” Appeal Brief, 4 TTABUVE 8. Applicant's bases this contention on its use of the slogan, “Sensible way of living,” which Applicant asserts appears on a banner adjacent to the mark on Applicant's website. *Id.* However, Applicant has not submitted any evidence that “sensi” means “sensible.”⁵ In any event, “the trade dress may nevertheless provide evidence of whether the word mark projects a confusingly similar commercial impression.” *Specialty Brands, Inc. v. Coffee Bean Distributors*,

⁵ In the appeal brief, Applicant states: “In one instance, a dictionary defines ‘sensi’ as being short for ‘sensible.’ To support this contention, Applicant cites to Attachment 5 to the October 9, 2015 Response, TSDR pp.28-30. However, there is no such definition of “sensi” in Attachment 5 (definitions of “sensi” from the *Urban Dictionary*).

Inc., 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984). Trade dress may not be used to prove that the commercial impressions are different because trade dress may be changed at any time. *See Vornado, Inc. v. Breuer Elec. Mfg. Co.*, 390 F.2d 724, 727, 156 USPQ 340, 342 (CCPA 1968) (“the [advertising] display of the mark in a particular style is of no material significance since the display may be changed at any time as may be dictated by the fancy of the applicant or the owner of the mark.”). *See also American Rice, Inc. v. H.I.T. Corp.*, 231 USPQ 793, 796 (TTAB 1986) (“we may take into account whether the trade dress of packages or labels in the application file as specimens, or otherwise in evidence, may demonstrate that the trademark projects a confusingly similar commercial impression.”).

With respect to the cited mark, Applicant contends that “the commercial impression of SENSI-CARE is one of ‘sensitivity’ in the context of medical care or medical product – not in a way of living.” *Id.* at 10. Applicant bases this contention on the “Skin Care” page on Registrant’s website, which lists two products: ALOE VESTA and SENSI-CARE. The only mention of the word “sensitive” is in the description of the product. See Exhibit to Response dated October 9, 2015, TSDR p. 40, set forth below.

Sensi-Care®



Sensi-Care® products help to manage skin compromised by exposure to and caustic stool residue. Effective but gentle for cleansing and protecting patients with sensitive skin.

Applicant claims that consideration of both its website and Registrant's website is significant. However, neither website establishes the meaning of the term SENSI. Moreover, when determining the meaning of two marks in standard character format, it is the marks themselves, as set forth in the application and cited registration, not extrinsic evidence that establishes likelihood of confusion.

We note that the issue of likelihood of confusion insofar as the registrability of applicant's mark is concerned is determined on the basis of such mark and registrant's mark as they are respectively set forth in the application and the cited registration. See, e.g., *Sealy, Inc. v. Simmons Co.*, 265 F.2d 934, 121 USPQ 456 (CCPA 1959); *Burton-Dixie Corp. v. Restonic Corp.*, 234 F.2d 668, 110 USPQ 272 (CCPA 1956); *Hat Corp. of America v. John B. Stetson Co.*, 223 F.2d 485, 106 USPQ 200 (CCPA 1955); and *ITT Canteen Corp. v. Haven Homes Inc.*, 174 USPQ 539 (TTAB 1972). Further, as the predecessor to our primary reviewing court stated in *Vornado, Inc. v. Breuer Elec. Mfg. Co.*, 390 F.2d 724, 727, 156 USPQ 340, 342 (CCPA 1968), “the [advertising] display of the mark in a particular style is of no material significance since the display may be changed at any time as may be dictated by the fancy of the applicant or the owner of the mark.” Thus, it is irrelevant to the issue of likelihood of confusion in this proceeding whether applicant and/or registrant use other words and/or design elements on their respective clothing.

In re Big Pig Inc., 81 USPQ2d 1436, 1439 (TTAB 2006) (emphasis added) and the cases cited therein. Similarly, in this case, since the slogan, “Sensible way of living,” is not part of Applicant's mark and can be changed, it cannot be considered in determining the meaning of the mark. The same reasoning applies to the use of the word “sensitive” in the Registrant's description of the use of its product.

Accordingly, we find that the marks are similar and that the first *du Pont* factor favors a finding of likelihood of confusion.

B. Similarity of goods, channels of trade and class of customers.

We continue our analysis with the second and third *du Pont* factors, the similarity of the goods, the channels of trade, and the class of customers. When determining the relationship between the goods,

[i]t is well settled that the issue of likelihood of confusion between applied-for and registered marks must be determined on the basis of the goods as they are identified in the involved application and cited registration, rather than on what any evidence may show as to the actual nature of the goods, their channels of trade and/or classes of purchasers.

In re Total Quality Group Inc., 51 USPQ2d 1474, 1476 (TTAB 1999). *See also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-1162 (Fed. Cir. 2014). The goods need not be identical or even competitive to support a finding of likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000). The respective goods need only be “related in some manner and/or the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1722 (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).

Applicant’s identification of goods in International Class 5 is “adult diapers, baby diapers, and diaper insert, namely, inserts adapted for cloth adult and baby diapers and made of cloth.”⁶ The identification of goods in the cited registration is “medicated

⁶ Neither the Applicant nor the Examining Attorney addressed the presence of “diaper inserts” in the identification of goods in the application. This is appropriate since likelihood

skin care preparations, namely, protectants for the prevention of skin irritation and preparations for the treatment and prevention of diaper rash.”

To establish that the goods are related, the Examining Attorney submitted copies of ten use-based third-party registrations, each of which includes diapers for adults and/or babies, medicated cream for diaper rashes, or a combination thereof⁷ and which serves to suggest that the goods are of a kind that may emanate from a single source. Use-based third-party registrations that individually cover a number of different items and that are based on use in commerce may have some probative value to the extent that they serve to suggest that the listed goods and/or services are of a type that may emanate from a single source. *See In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.6 (TTAB 2015); *See also In re RiseSmart Inc.*, 104 USPQ2d 1931, 1934-1935 (TTAB 2012); *In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993). The use-based registrations were attached to the Office Action dated November 17, 2015.

Examples are:

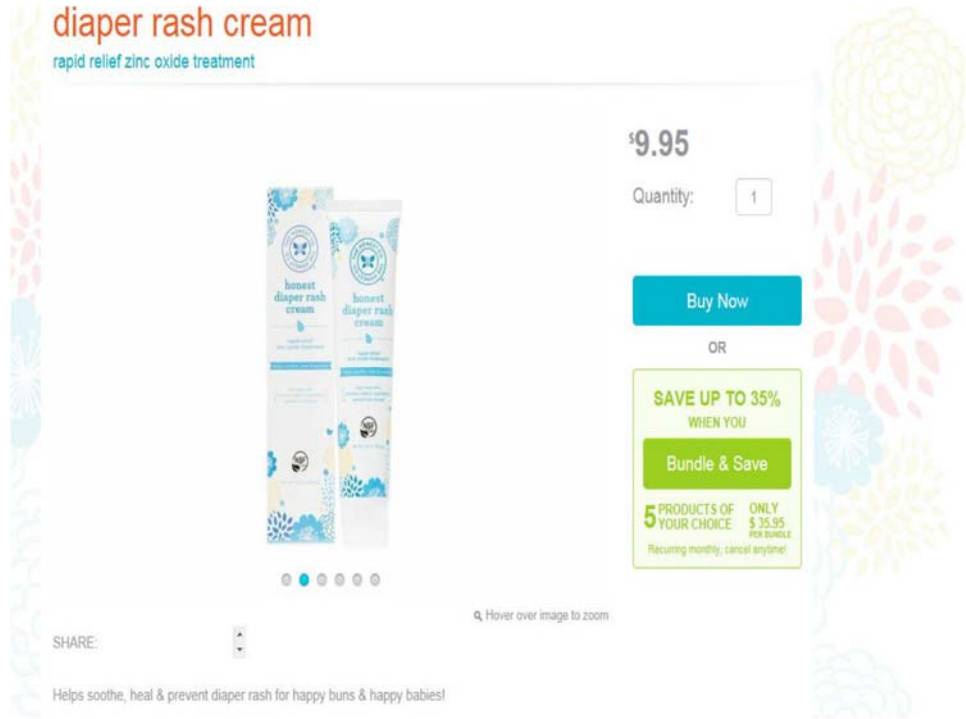
of confusion must be found as to the entire class if there is likely to be confusion with respect to any item in the identification of goods for that class. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981). Moreover, Applicant's diaper inserts are closely related to diapers.

⁷ Registration No. 3991673, which is for the mark MOUNTAIN MERINO (standard characters) for, *inter alia* adult diapers impregnated with medicated diaper rash ointments, lotions and absorption substances is evidence of the existence of goods incorporating both Applicant's and Registrant's goods. Exhibit to Office Action dated November 17, 2015, TSDR pp. 8-14.

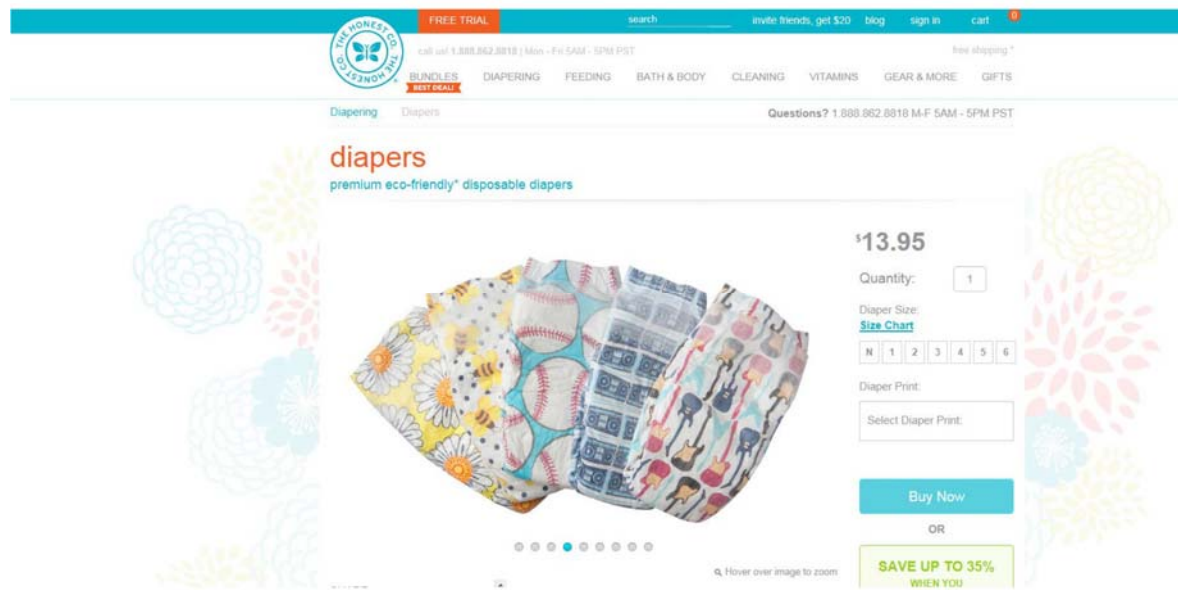
- Registration No. 4238088 for the mark GREEN SPROUTS (standard characters) for adult diapers; hand-sanitizing preparations; incontinence diapers; medicated baby oils; medicated baby powders; and medicated diaper rash ointments and lotions (TSDR p. 16);
- Registration No. 4385447 for the mark SIKAER & design for adult diapers; babies' diapers of paper; babies' napkins; babies' napkin-pants; baby diapers; diapers for incontinence; disposable adult diapers; disposable baby diapers; disposable diapers for incontinence; incontinence diapers; infant cloth diapers; infant diaper covers; inserts specially adapted for cloth infant diapers made of bamboo; inserts specially adapted for cloth infant diapers made of hemp; inserts specially adapted for cloth infant diapers made of microfiber; medicated diaper rash ointments and lotions (TSDR pp. 26-27); and
- Reg. 4769592 for the mark ANANBABY & design for, *inter alia*, babies' diapers of paper; baby diapers disposable adult diapers; disposable baby diapers; disposable diapers for incontinence; medicated diaper rash ointments and lotions (TSDR pp. 38-40).

In addition, the Examining Attorney submitted webpages evidencing the use of the same mark for diapers and diaper rash cream. Pages from the following websites were attached as exhibits to the Office Action dated April 20, 2015.

- The Honest Co. (www.honest.com) TSDR pp. 5-11

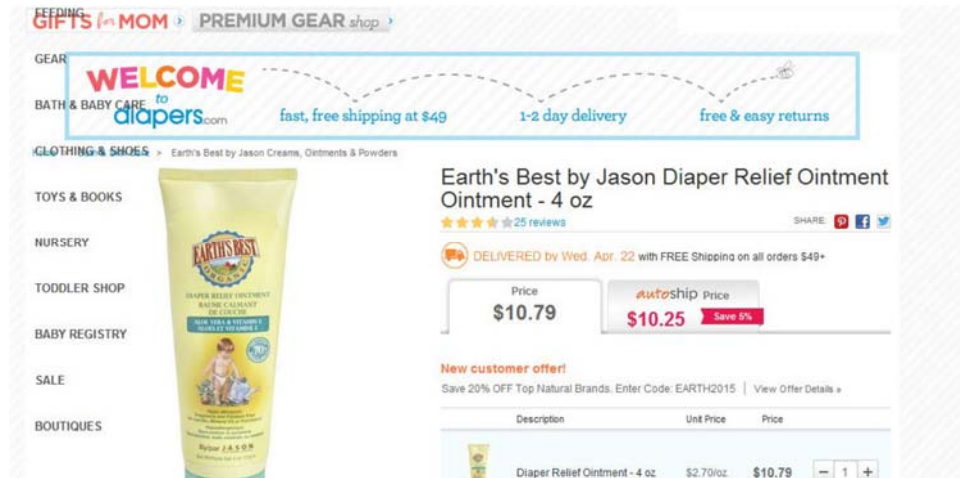


TSDR p. 5 and



TSDR p. 8; and

- diapers.com (www.diapers.com) TSDR pp. 24-45



TSDR p. 24



TSDR p. 35.

The Examining Attorney also submitted webpages from the Seventh Generation website which depict both diapers and diaper rash cream on the same page.

Evidence of sales of both Applicant's goods and the goods in the cited registration on the websites of The Honest Company, Seventh Generation and diapers.com also

establishes that these goods are sold in the same channels of trade to the same classes of customers.

Based on the foregoing, we find the goods to be similar.

Applicant attempts to avoid this finding by arguing that the competitive distance between Applicant's goods and Registrant's goods was not considered. Appeal Brief, 4 TTABVUE 13. Applicant's argument is unfounded. As discussed above, in determining whether the goods are related, it is not necessary that the goods of the parties be similar or competitive in character to support a holding of likelihood of confusion; it is sufficient for such purposes that a party claiming damage establish that the goods are related in some manner and/or that conditions and activities surrounding marketing of these goods are such that they would or could be encountered by same persons under circumstances that could, because of similarities of marks used with them, give rise to the mistaken belief that they originate from or are in some way associated with the same producer. *Coach Servs., Inc.* USPQ2d 1713, at 1722; *Edwards Lifesciences Corp.*, 94 USPQ2d at 1410; *Schering Corporation v. Alza Corporation*, 207 USPQ 504, 507 (TTAB 1980); *Oxford Pendaflex Corporation v. Anixter Bros. Inc.*, 201 USPQ 851, 854 (TTAB 1978).

Similarly, Applicant's argument that a baby diaper is a 'different type' of baby product and has a 'different use' from a baby diaper rash cream ..." and that Applicant's and Registrant's goods are sold in "different parts of a store." Appeal Brief, 4 TTABVUE 13 is not well-taken. The issue is not whether purchasers would confuse the parties' goods and/or services, but rather whether there is a likelihood of

confusion as to the source of these goods and/or services. *In re Cook Medical Technologies LLC*, 105 USPQ2d 1377, 1380 (TTAB 2012); *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 UPSQ2d 1618, 1624 (TTAB 1989); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). The record establishes that both Applicant's and Registrant's goods are not only sold under the same mark, but also that they are also positioned near or even next to each other on various websites.⁸

Given the relationship between the goods and their sale in the same channels of trade to the same customers, the second and third *du Pont* factors favor a finding of likelihood of confusion.

C. Actual Confusion.

Applicant has also alleged that it “has conducted a search of its internal records and can find no instance of actual confusion between [A]pplicant and [R]egistrant.” Appeal Brief, 4 TTABVUE 14. Since the application is based on intent-to-use and Applicant has submitted no evidence of use, Applicant has not established that there would be an opportunity for consumers to be confused. Moreover, “[t]he ultimate consideration, however, is likelihood of confusion. Absence of proof of actual confusion is of minor relevancy in the resolution of the issue.” *J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 964, 144 USPQ 435, 438 (CCPA 1965), especially in an *ex parte* context.

⁸ The record does not reflect the positioning of the goods in brick and mortar stores.

D. Conclusion.

After considering all the evidence and argument on the relevant *du Pont* factors regarding likelihood of confusion between Applicant's mark SENSI-CARE (in standard characters) for "adult diapers, baby diapers, and diaper insert, namely, inserts adapted for cloth adult and baby diapers and made of cloth" and the cited mark SENSI-CARE (in typed format) for "medicated skin care preparations, namely, protectants for the prevention of skin irritation and preparations for the treatment and prevention of diaper rash," we find that there is a likelihood of confusion.

Decision: The refusal to register Applicant's mark SENSI in International Class 5 is affirmed. The application will proceed to publication with respect to the goods in International Class 9 and 10 only.