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| <p>This Opinion is Not a Precedent of the TTAB</p> |
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Mailed: March 14, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Amogreentech Co., Ltd.
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Serial No. 86618200
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Morton J. Rosenberg of Rosenberg Klein & Lee,
for Amogreentech Co., Ltd.

Jason Malashevich, Trademark Examining Attorney, Law Office 114,
K. Margaret Le, Managing Attorney.

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Before Quinn, Cataldo and Kuczma
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Amogreentech Co., Ltd. (“Applicant”) seeks registration on the Principal Register
of the mark SNOWMASK (in standard characters) for

Cosmetics; mask pack for cosmetic purposes in
International Class 3.¹

The Trademark Examining Attorney has refused registration of Applicant’s mark
under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground of

¹ Application Serial No. 86618200 was filed on May 4, 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.

likelihood of confusion with Registration No. 3277028 for the mark ICE MASK (in standard characters, “MASK” disclaimed) for

Facial beauty masks; facial cleansers; facial emulsions; facial lotion;
facial masks in International Class 3.²

When the refusal was made final, Applicant appealed.³ We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion as set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods at issue. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Relatedness of the Goods, Channels of Trade and Classes of Consumers.

We turn to the *du Pont* factors involving the similarity or dissimilarity of Applicant’s goods and Registrant’s goods, their trade channels and classes of consumers. It is settled that in making our determination, we must look to the goods as identified in the application vis-à-vis those recited in the cited registration. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110

² Issued on August 7, 2007. Section 8 affidavit accepted; Section 15 affidavit acknowledged. First renewal.

³ The exhibits to Applicant’s brief, which are duplicative of exhibits to Applicant’s July 13, 2016 communication, will be given no consideration. *See* Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 1203.02(e) and authorities cited therein.

USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Houston Computers Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *In re Integrated Embedded*, 120 USPQ2d 1504, 1514 (TTAB 2016); *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011). The respective goods need only be “related in some manner and/or if 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 1713 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007). *See also On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984). The issue here is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of these goods. *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2012); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

In this case, Applicant’s goods are “cosmetics; mask pack for cosmetic purposes,” and the goods identified in the cited registration are “facial beauty masks; facial cleansers; facial emulsions; facial lotion; facial masks.” In support of his position that the goods are related, the Examining Attorney argues:

Applicant’s goods are cosmetics and mask packs for cosmetic purposes. Since Applicant has identified these goods without any restrictions as to nature, type, channels of trade, or classes of purchasers, they must be presumed to encompass all goods of the type described. Accordingly, Applicant’s “cosmetics” goods must be presumed to include any and all types of cosmetic products, and its “mask packs” must be presumed to encompass all types of cosmetic masks. *See In re Viterro Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012). Registrant’s goods

include a variety of cosmetic products, the most pertinent of which are “facial beauty masks” and “facial masks,” which fall under the categories of both “cosmetics” and “mask packs for cosmetic purposes.” This makes the parties’ goods legally identical.⁴

The Examining Attorney has not introduced evidence to support his position that the goods in the cited registration are both “cosmetics” and “mask packs for cosmetic purposes,” and the asserted identity of the goods is not immediately apparent from the goods as recited in the application and registration. Nonetheless, as identified, the goods are related to the extent that Applicant’s “mask pack for cosmetic purposes” appears to perform a similar function as the “facial beauty masks” and “facial masks” in the cited registration.

Applicant disagrees that the goods are legally identical but acknowledges:

the goods associated with the cited registration are silk masks which absorb a liquid solution applied thereto. Once the mask has been set on a user’s face for a specified period of time, the mask is removed and discarded. In contrast, the mask associated with Applicant’s mark is a fiber membrane mask which dissolves after being set on a user’s face for a particular period of time.⁵

However, and as noted by the Examining Attorney, these asserted limitations are not present in the goods as identified. Based upon their identifications, the goods of both Applicant and Registrant include masks intended to be set upon a user’s face in order to enhance the user’s appearance. Thus, the goods appear, at least in part, to be closely related skin care masks used for the purpose of maintaining or enhancing the

⁴ 11 TTABVUE 5-6.

We note that the owner of the cited registration is not a “party” to Applicant’s *ex parte* appeal of the Examining Attorney’s refusal of registration.

⁵ 4 TTABVUE 8.

appearance of the user's skin. Because all of Applicant's goods are identified in a single class, there is no need for us to consider whether Applicant's cosmetics are similar to Registrant's identified goods. In the context of an analysis under Section 2(d), where all of the goods in the application are in a single International Class, it is sufficient if likelihood of confusion is found with respect to use of the mark on any item that comes within the description of goods in the application or registration. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1398 (TTAB 2007). Accordingly, the *du Pont* factor of the similarity or dissimilarity of the goods weighs in favor of a finding of likelihood of confusion.

Neither Applicant's nor Registrant's identification of goods recites any limitations on the channels of trade in which the goods may be encountered or the classes of consumers to whom they may be marketed. Thus, absent any restrictions in the identifications of goods, the goods of Applicant and Registrant are presumed to move in all normal channels of trade and be available to all classes of potential consumers of such goods. *See In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). In each case, the customers would include ordinary users of facial masks and skin care products; and the channels of trade would include any normal distribution channels for such products at any price point as beauty care stores or drug stores. In addition, "Applicant admits that the goods may, in certain instances, travel in the same or similar channels of [trade].⁶

⁶ *Id.* at 7.

The overlap in trade channels and classes of purchasers are factors that further weigh in favor of a finding of likelihood of confusion.

Similarity of the Marks.

We turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. See *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 110 USPQ2d at 1160; *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Profls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)).

The mark in the involved application is SNOWMASK and the cited mark is ICE MASK. Both marks are presented in standard characters and the term “MASK” is disclaimed in the cited mark. The marks are similar in appearance and sound to the extent that they share the common term MASK. In support of his contention that the marks are similar in meaning, the Examining Attorney introduced into the record with his August 14, 2015 first Office action, the following dictionary definitions:⁷

Snow – frozen precipitation consisting of hexagonally symmetrical ice crystals that form soft, white flakes;

Ice – water, frozen solid; a surface, layer, or mass of frozen water.

⁷ Pages 8-12. References from ahdictionary.com, American Heritage Dictionary of the English Language, 5th ed. (2015).

We find based upon these definitions that the marks convey similar meanings of masks imparting a cooling or refreshing sensation. We agree with Applicant that ice and snow are somewhat different forms of frozen precipitation and “are not used interchangeably which supports the notion that the words do not necessarily stimulate the same mental impression.”⁸ Nonetheless, the terms “snow mask” and “ice mask,” used in connection with facial or cosmetic masks, both impart a cooling or refreshing mask, and thus impart related meanings.

While the term MASK common to both marks is disclaimed in the registered mark and appears, at best, to be highly descriptive of some of the involved goods, as the wording of the disclaimer indicates (i.e., “no claim is made to the exclusive use of ... *apart from the mark as shown*” – *emphasis added*), the disclaimed matter is accorded significance as an integral part of the composite mark. *See American Dietetics Co., Inc. et. al. v. Plus Products*, 191 USPQ 146 (DCNY 1976). The disclaimer of matter in a mark does not have the effect of removing the matter from the mark. *Bordon, Inc. v. W.R. Grace & Co.*, 180 USPQ 157 (TTAB 1973). It is further established that a disclaimer is of no legal significance in determining likelihood of confusion, rather, the disclaimed matter must be considered. *See Glamorene Products Corp. v. Boyle-Midway, Inc., et. al.*, 188 USPQ 145 (SDNY 1975); *Kellogg Co. v. Pack ‘Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990). Moreover, the public viewing the mark is unaware of what, if any, portions of a mark may be disclaimed in a federal registration. *See In re National Data Corp.*, 224 USPQ 749, 751 (Fed. Cir. 1985); *In*

⁸ 4 TTABVue 10.

re MCI Communications Corp., 21 USPQ2d 1534, 1537 (Comr. Pats. 1991) (“Therefore, disclaimer of matter will never serve to obviate the issue of likelihood of confusion.”), *citing In re National Data Corporation*, 224 USPQ at 751.

In addition, the space between the terms in the registered ICE MASK mark and the truncation of Applicant’s SNOWMASK mark are not significant for purposes of our analysis. The presence or absence of a space between terms in a composite mark generally does not affect its overall commercial impression. *See Seaguard Corp. v. Seaward Int’l, Inc.*, 223 USPQ 48, 51 (TTAB 1984); *In re Narwood Productions, Inc.*, 223 USPQ 1034 (TTAB 1984); *In re Best W. Family Steak House, Inc.*, 222 USPQ 827, 827 (TTAB 1984).

Finally, Applicant relies upon the following third-party registrations issued on the Principal Register to different entities,⁹ in support of its position that the

USPTO has determined that, on at least two other occasions, marks comprised of a variation of the word “water” or a term related thereto and the word “mask” for related goods in International Class 3 were entitled to concurrent registration.¹⁰

These registrations are:

Reg. No. 4375066 (issued July 30, 2013) for the mark AQUATIC MASK (standard characters, “MASK” disclaimed) for “plastering type face-pack cosmetics;” and

Reg. No. 2280000 (issued September 21, 1999, cancelled under Section 8 June 24, 2006) for the mark WATER MASK (typed form, equivalent of standard characters,¹¹ “MASK” disclaimed) for “hydrating mask.”

⁹ Applicant’s July 13, 2016 communication, treated as request for reconsideration, at 4-7.

¹⁰ 4 TTABVue 11.

¹¹ Effective November 2, 2003, Trademark Rule 2.52, 37 C.F.R. §2.52, was amended to replace the term “typed” drawing with “standard character” drawing. A mark depicted as a typed drawing is the legal equivalent of a standard character mark.

The Examining Attorney argues in response that “unlike the terms ‘ice’ and ‘snow’, the term ‘aquatic’ does not connote frozen water, and thus has a distinguishable connotation and overall meaning from that of Applicant’s and Registrant’s marks.”¹²

With regard to Applicant’s evidence, cancelled Reg. No. 2280000 is not evidence of anything except that it issued. *See Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) (“[A] cancelled registration does not provide constructive notice of anything”). *See also In re Datapipe, Inc.* 111 USPQ2d 1330, 1336 n.11 (TTAB 2014); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1654 n.6. (TTAB 2002). Any benefits conferred by the registration, including the evidentiary presumptions afforded by Section 7(b) of the Trademark Act were lost when the registration expired. *See, e.g., Anderson, Clayton & Co. v. Krier*, 478 F.2d 1246, 178 USPQ 46 (CCPA 1973). Even setting aside the Examining Attorney’s argument regarding the different connotation of AQUATIC MASK versus SNOWMASK or ICE MASK, we find that the presence of this single third-party registration is insufficient to persuade us that the cited ICE MASK mark is entitled to such a narrow scope of protection as to permit registration of a confusingly similar mark for related goods. *Cf. Jack Wolfskin Ausrüstung Fur Draussen GmbH v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (third-party weakness evidence characterized as “voluminous”).

Considering the marks SNOWMASK and ICE MASK in their entirety, we note they somewhat resemble each other visually and aurally, and more so in meaning to

¹² 11 TTABVUE 9.

the extent that each connotes a cooling, refreshing mask. Although we acknowledge the differences in sound, meaning and appearance that arise from the different terms SNOW and ICE, the marks share a structural similarity, in that each consists of MASK preceded by a qualifying term identifying frozen precipitation. The fact that Registrant's mark includes a space between the terms while Applicant's mark lacks such a space is insignificant. The applicable test is not whether the marks can be distinguished when subjected to a side-by-side comparison. *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). Rather, the proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Considering the overall commercial impressions of the two marks, we find it likely that customers would perceive the two marks as related to each other, that is, marks pointing to a common source. Accordingly, we find that the *du Pont* factor of the similarity or dissimilarity of the marks weighs in favor of a finding of likelihood of confusion.

Summary.

We have considered all of the arguments and evidence of record, including those not specifically discussed herein, and all relevant *du Pont* factors. In view of the similarity of the marks at issue, the related nature of the goods, and the absence of limitation to their channels of trade and classes of customers, we find that Applicant's

mark so closely resembles the registered mark as to be likely to cause confusion, mistake or deception as to the source of Applicant's goods.

Decision: The refusal to register is affirmed.