

This Opinion is not a  
Precedent of the TTAB

Mailed: June 24, 2022

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

*In re Krete LLC*

Serial No. 90369855

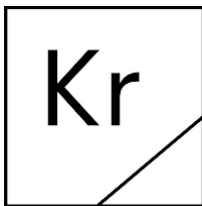
Stewart L. Gitler of Welsh Flaxman & Gitler LLC, for Krete LLC.

Julie Choe, Trademark Examining Attorney, Law Office 126,  
Andrew Lawrence, Managing Attorney.

Before Kuhlke, Cataldo and Wellington,  
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Krete LLC, filed an application to register on the Principal Register the



mark identifying the following goods: “non-medicated skin serums;

facial concealer; pre-moistened cosmetic wipes; and skin moisturizer” in International Class 3.<sup>1</sup>

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

likelihood of confusion with the cited registered mark identifying the following goods:



Air fragrancings preparations; Antistatic preparations for household purposes; Aromatic essential oils; Bergamot oil; Cleaning preparations; Cosmetics; Dentifrices; Deodorants for human beings or for animals; Essential oils for soothe the nerves use; Floor polishes; Fragrances; Fumigating incenses (Kunko); Glass cleaners; Perfume oils for the manufacture of cosmetic preparations; Plant and herb extracts sold as components of cosmetics; Potpourri; Rust removing preparations; Scouring liquids; Shampoos; Shampoos for pets in International Class 3.<sup>2</sup>

After the Trademark Examining Attorney made the refusal final, Applicant appealed to this Board.<sup>3</sup> We affirm the refusal to register.

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<sup>1</sup> Application Serial No. 90369855 was filed on December 9, 2020 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), asserting November 3, 2020 as a date of first use of the mark anywhere and in commerce. The application includes the following description of the mark and color claim statements: “The mark consists of a square box with a diagonal line inside the box in the bottom right corner. The literal elements, a capital letter ‘K’ and a lowercase letter ‘R’ are inside the box.” “Color is not claimed as a feature of the mark.”

<sup>2</sup> Registration No. 5390510 issued on the Principal Register on January 30, 2018 with the following description of the mark and color claim statements: “The mark consists of the stylized wording ‘KR’ to the left of a stylized quadrilateral design above a stylized curved triangular design.” “Color is not claimed as a feature of the mark.”

<sup>3</sup> All citations to documents contained in the Trademark Status & Document Retrieval (TSDR) database are to the downloadable .pdf versions of the documents in the USPTO TSDR


## I. Evidentiary Matters

Applicant appended to its appeal brief evidence in the form of screenshots from its website, a copy of a third-party registration, and a copy of its own Reg. No. 6540406.<sup>4</sup>

In her appeal brief, the Examining Attorney objected to this evidence as untimely.<sup>5</sup>

In response, Applicant argues:<sup>6</sup>

The Examining Attorney objected to the mention of Appellant's prior registration on the ground that it was not mentioned in the prosecution of the application. However, in Appellant's Response to Office Action of June 9, 2021, Appellant made note of its prior-filed application serial no.

88/715,512 for  and argued that the mark had been published and issued a Notice of Allowance.<sup>7</sup> Accordingly, the public did not feel there was any likelihood of confusion. The Examining Attorney addressed this evidence in her response ...<sup>8</sup>

Accordingly, the Examining Attorney addressed Appellant's evidence of its prior filed and co-existing allowed mark, so the Board should treat the application's mere maturation into a registration as part of the record. *See In re Olin Corp.*, 124 USPQ2d 1327, 1335 n.22 (TTAB 2017); *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1477 n.6 (TTAB 1999); *In re Dos Padres Inc.*, 49 USPQ2d 1860, 1861 n.2 (TTAB 1998) (explaining where the Examining Attorney treated evidence as part of the record, the Board considered it). Additionally, Appellant points out that its allowed mark registered on October 26, 2021, which was after

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Case Viewer. *See, e.g., In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1402 n.4 (TTAB 2018). References to the briefs on appeal refer to the Board's TTABVUE docket system. Before the TTABVUE designation is the docket entry number; and after this designation are the page references, if applicable. *See, e.g., New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, \*2 n.1 (TTAB 2020).

<sup>4</sup> 4 TTABVUE 16-29 (Applicant's brief).

<sup>5</sup> 7 TTABVUE 3 (Examining Attorney's brief).

<sup>6</sup> 8 TTABVUE 2-3 (Applicant's reply brief).

<sup>7</sup> June 9, 2021 Response to Office Action at 5. Applicant did not introduce into the record a copy of the pending application.

<sup>8</sup> June 30, 2021 final Office Action at 6-7.

receipt of the Final Office Action.<sup>9</sup> Since the Examining Attorney already made up her mind about the “non persuasive nature” of the existence of Serial No. 88/715,512 (now registration number 6,540,406) the Board should consider it as evidence on the record. However, if the Board deems it appropriate to remand the application to enter Appellant’s prior Registration claim, then the Appellant consents to this course of action.

First, to the extent Applicant’s arguments in its reply brief may be construed as a request for remand, it is denied. *In re Hollywood Lawyers Online*, 110 USPQ2d 1852, 1859 (TTAB 2014) (“To the extent applicant seeks to request remand for such consideration by the examining attorney, burying this request in its reply brief is not sufficient for the Board to treat it as a request for remand.”); *In re Future Ads LLC*, 103 USPQ2d 1571, 1573 (TTAB 2012) (claim of acquired distinctiveness raised for first time in reply brief should have been made in a separate request for remand); *In re HerbalScience Group LLC*, 96 USPQ2d 1321, 1323 (TTAB 2010) (request for remand should be filed by a separate paper, appropriately captioned “Request for Remand,” rather than by a request buried within a paragraph in the middle of a brief).

Second, in its June 9, 2021 Response to Office Action,<sup>10</sup> Applicant brought its then-pending application Serial No. 88715512 to the attention of the Examining Attorney, who addressed the prior application in her June 30, 2021 final Office Action.<sup>11</sup> Thus,

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<sup>9</sup> Applicant did not submit a request for reconsideration of the final Office Action or any additional filings during prosecution of its involved application.

<sup>10</sup> At 5.

<sup>11</sup> At 6-7.

the Examining Attorney was on notice of the existence of Applicant's prior application. Applicant's resulting Reg. No. 6540406 issued on October 26, 2021,<sup>12</sup> subsequent to the Examining Attorney's final Office Action and prior to Applicant's December 27, 2021 notice of appeal.<sup>13</sup> We therefore exercise our discretion to consider Applicant's resulting Reg. No. 6540406 for whatever probative value it may have.

With regard to the screenshots from Applicant's website and the third-party registration Applicant appended to its appeal brief,<sup>14</sup> Trademark Rule 2.142(d) reads as follows:

The record in the application should be complete prior to the filing of an appeal. Evidence should not be filed with the Board after the filing of a notice of appeal. If the appellant or the examining attorney desires to introduce additional evidence after an appeal is filed, the appellant or the examining attorney should submit a request to the Board to suspend the appeal and to remand the application for further examination.

The third-party registration and any of the website screenshots that were not submitted during prosecution of the involved application are not timely. To the extent any of these materials were timely submitted, they are redundant. Consequently, they will be given no consideration.<sup>15</sup> In addition, any unsupported arguments based

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<sup>12</sup> 4 TTABVUE 28-29.

<sup>13</sup> 1 TTABVUE.

<sup>14</sup> 4 TTABVUE 16-26.

<sup>15</sup> As noted above, the proper procedure for an applicant or examining attorney to introduce evidence after an appeal has been filed is to submit a written request with the Board to suspend the appeal and remand the application for further examination. *See* Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1207.02 (Jun. 2022) and authorities cited therein.

upon this excluded evidence will not be considered. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (“Attorney argument is no substitute for evidence.”) (quoting *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 1284, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005)); *see also In re U.S. Tsubaki, Inc.*, 109 USPQ2d 2002, 2006 (TTAB 2014) (finding that there was no proof to support the statements in the record by counsel).

Finally, in her brief, the Examining Attorney requests that the Board “take judicial notice of the attached online dictionary entry from *Merriam-Webster*, which shows how the current periodic table of elements generally appears.<sup>16</sup> However, we need not rely upon this dictionary entry in order to determine the issue on appeal. Accordingly, the Examining Attorney’s request is denied, and Applicant’s objections thereto are moot.<sup>17</sup>

We turn now to the merits of this appeal.

## **II. Likelihood of Confusion**

We base our determination of likelihood of confusion under Trademark Act Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors enunciated in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”), *cited in B&B Hardware, Inc. v. Hargis Indus., Inc.*,

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<sup>16</sup> 7 TTABVUE 6.

<sup>17</sup> 8 TTABVUE 3-4.

575 U.S. \_\_\_, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015); *see also In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1161-62 (Fed. Cir. 2019).

We have considered all *DuPont* factors that are relevant.. *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010) (“Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered.”)); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”).

Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“the various evidentiary factors may play more or less weighty roles in any particular determination”).

Two key considerations are the similarities between the marks and the relatedness of the goods or services. *See 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.”); *In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1672 (TTAB 2018).

**A. The Goods and Channels of Trade**

The second *DuPont* factor concerns the “similarity or dissimilarity and nature of the goods or services as described in an application or registration,” *In re Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1159 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2004); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). “This factor considers whether ‘the consuming public may perceive [the respective goods or services of the parties] as related enough to cause confusion about the source or origin of the goods and services.’” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1086 (Fed. Cir. 2014) (quoting *Hewlett-Packard*, 62 USPQ2d at 1004).

In support of the refusal of registration, the Examining Attorney introduced into the record<sup>18</sup> the following definitions of “cosmetic:”

A preparation, such as powder or skin cream, designed to beautify the body by direct application; serving to beautify the body, especially the face and hair;<sup>19</sup> and

Of, relating to, or making for beauty especially of the complexion; a cosmetic preparation for external use.<sup>20</sup>

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<sup>18</sup> June 30, 2021 final Office Action at 10-11.

<sup>19</sup> AHdictionary.com

<sup>20</sup> Merriam-webster.com



The Examining Attorney further introduced the following definition of “cosmetics” from the U.S. Food and Drug Administration (FDA):<sup>21</sup>

The Federal Food, Drug & Cosmetic Act (FD&C Act) defines cosmetics as "articles intended to be rubbed, poured, sprinkled, or sprayed on, introduced into, or otherwise applied to the human body...for cleansing, beautifying, promoting attractiveness, or altering the appearance." Included in this definition are products such as skin moisturizers, perfumes, lipsticks, fingernail polishes, eye and facial makeup preparations, shampoos, permanent waves, hair colors, toothpastes, and deodorants, as well as any material intended for use as a component of a cosmetic product.

The goods in the cited registration include “cosmetics.” Applicant’s goods are identified as “non-medicated skin serums; facial concealer; pre-moistened cosmetic wipes; and skin moisturizer.” These goods fall within the general dictionary definition of “cosmetics.” Further, Applicant’s “skin moisturizer” is specifically mentioned in the FDA definition of a type of “cosmetics.” Similarly, the “shampoos,” “deodorants,” “perfume oils for the manufacture of cosmetic preparations” and “plant and herb extracts sold as components of cosmetics” are included among the FDA definition of “cosmetics” and “any material intended for use as a component of a cosmetic product.” Simply put, Registrant’s goods include cosmetics and sub-types of cosmetic and cosmetic components, and Applicant’s goods are types of cosmetics. The goods thus,

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<sup>21</sup> June 30, 2021 final Office Action at 12-14. The Examining Attorney further introduced evidence from Wikipedia.org (*Id.* at 15-26) defining “Cosmetics” in a manner that tends to buttress the above definitions. *See In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1768 (TTAB 2016) (“Wikipedia is an Internet source whose contents are continuously subject to change via collaborative user-input”).

in part, are overlapping and legally identical. *See, e.g., In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1629 (TTAB 2018) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 1336, 209 USPQ 986, 988 (C.C.P.A. 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014).

In addition, the Examining Attorney introduced into the record evidence in the form of screenshots from seven third parties offering, under the same trademark or trade name, goods identified in both the involved application and cited registration.<sup>22</sup> This evidence establishes that these third parties offer the cosmetics and skin care products provided by Applicant, and various of the items identified in the cited registration under the same house marks or trademarks.

Applicant argues that the “Cited Mark is associated with a laundry list of goods,”<sup>23</sup> and that a “consumer seeking to capitalize on the new ‘clean’ beauty trend would be wary of a company that also sold in association with its mark, floor polishes, glass cleaners, and rust removing preparations, especially considering these products are notoriously chocked full of chemicals and distinctly ‘impure.’”<sup>24</sup> However, Applicant’s identification of goods is not limited to “clean,” “natural,” or any other subset of skin serums, facial wipes, concealers or moisturizers, and we will not read such limitations into its goods.

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<sup>22</sup> June 30, 2021 final Office Action at 27-156. These include M.A.C., IT Cosmetics, E.L.F., Bobbi Brown, Bésame Cosmetics, Merle Norman, and Clinique.

<sup>23</sup> 4 TTABVUE 11.

<sup>24</sup> 4 TTABVUE 12.

In addition, we must base our likelihood of confusion determination on the basis of the goods as they are identified in the application and registration at issue. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *In re William Hodges & Co., Inc.*, 190 USPQ 47, 48 (TTAB 1976). *See also Octocom*, 16 USPQ2d at 1787 (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed”). Applicant cites to no authority or evidence in support of its position that consumers view cosmetics offered under the same brand name or trademark as cleaning products differently from those not so offered, or that cleaning products cannot also be naturally formulated and free of chemicals.

With regard to the third *DuPont* factor, the similarity of the trade channels in which the goods are encountered, we must again base our likelihood of confusion determination on the goods as they are identified in the application and registration at issue. *In re Elbaum*, 211 USPQ at 640; *In re William Hodges & Co., Inc.*, 190 USPQ at 48. *See also Octocom*, 16 USPQ2d at 1787. We thus are not persuaded by Applicant’s arguments that its goods are specialty, high end products available in exclusive trade channels.<sup>25</sup> We cannot consider asserted marketplace realities not

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<sup>25</sup> 4 TTABVue 13-14.

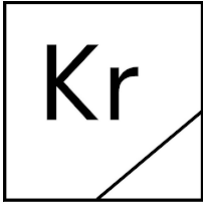

reflected in the identifications. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000).

Because Applicant's goods are legally identical, in part, to Registrant's goods, we presume that such goods of Applicant and Registrant move in the same channels of trade and are offered to the same classes of consumers. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *see also American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994).

Accordingly, the *DuPont* factors relating to the similarity or dissimilarity of the goods and the similarity or dissimilarity of their trade channels heavily favor a finding of likelihood of confusion.

## B. The Marks

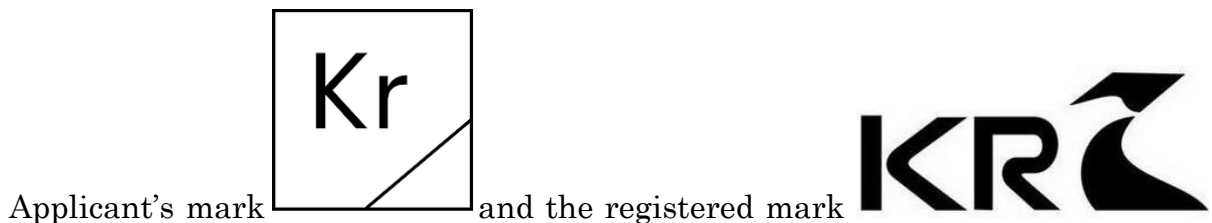
Under the first *DuPont* factor, we determine the similarity or dissimilarity of

Applicant's  mark and the registered  mark in

their entireties, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *Stone Lion Capital v. Lion Capital*, 110 USPQ2d at 1160; *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)); accord *Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); see also *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be

dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). On the other hand, 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. *Nat’l Data*, 224 USPQ at 751.



both consist of the stylized letters “KR” and only differ inasmuch as Applicant’s mark surrounds the letters “KR” with a square carrier and triangular line in the bottom right corner, and the registered mark includes a wavy line design above a stylized curved triangular design to the right of the letters “KR.” The marks thus are more similar than dissimilar in appearance.

With regard to sound, nothing in the record suggests that the letters “KR” will be pronounced differently in Applicant’s mark than in the registered mark. We further find no support in the record for Applicant’s argument that “the design element in the Cited Mark so clearly resembles a ‘7’ which results in the Cited Mark being pronounced ‘kr seven’”<sup>26</sup> or that its mark is intended to be pronounced as “Krete.”<sup>27</sup> Applicant has submitted no evidence to support its position that consumers will view

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<sup>26</sup> 4 TTABVUE 6.

<sup>27</sup> 4 TTABVUE 6.

or pronounce the quadrilateral and triangular design in the registered mark as the number “7” or that consumers will pronounce “KR” in its mark as Applicant’s name, “Krete.” As a result, when verbalized by consumers, the marks are identical in pronunciation.



Similarly, the relatively modest geometric designs in the applied-for mark and cited mark do not significantly contribute to the mark’s commercial impression, but rather are subordinate to the letters “KR” in both marks. Where, as here, a mark is comprised of both literal elements and a design, the literal elements are normally accorded greater weight, in part because consumers are likely to remember and use the letters(s) to request the goods. *In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1911 (Fed. Cir. 2012) (“the verbal portion of a word and design mark likely will be the dominant portion”); *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987) (holding that “if one of the marks 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” and “because applicant’s mark shares with registrant’s mark that element responsible for creating its overall commercial impression, the marks are confusingly similar”).

The general principle applies here. The cases relied upon by Applicant for its position that the design elements are sufficient to distinguish the marks are inapposite.<sup>28</sup> In all of those cases, the design portions of the marks were more

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<sup>28</sup> 4 TTABVue 10-12.

prominent in terms of their distinctiveness, size and overall contribution to the commercial impression of the marks at issue. In the present case, Applicant's mark and the cited mark consist of the identical letters "KR" and geometric shapes that are not nearly as significant to the commercial impressions of the involved marks.

Compared in their entireties, the marks  and  are highly similar in appearance and sound. As discussed above, both marks consist of the letters "KR" and geometric shapes. As a result, the marks are highly similar in connotation. There is no evidence of record that "KR" has any particular significance in connection with the goods, or that "KR" has one meaning as applied to Applicant's goods and another in connection with the goods in the cited registration. Thus, the letters "KR" appear to be distinctive as applied to both sets of goods. Applicant argues:<sup>29</sup>

Appellant's Mark mimics the font of the periodic table of elements and is distinctive from the capital and stylized letters "KR" of the Cited Mark, which is in a particularly loose and curvy distinctively different font that is all followed by a curved design, which appears as stylized number 7. Although described in the Registration of the Cited Mark "as a stylized quadrilateral design above a stylized curved triangular design" the purchasing public will surely view it as a "7" and not quadrilateral design above a stylized curved triangular design. In fact, a large percentage of the purchasing public will not even understand what a quadrilateral is. The font and characteristics of the Cited Mark leave a commercial impression of relaxation and taking it easy whereas the font and characteristics of Appellant's Mark leave the impression of scientific, pure, and clinical. Accordingly, Appellant's composite mark

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<sup>29</sup> 4 TTABVUE 8.



and unique design features render the two marks dissimilar and therefore not likely to be confused with the Cited Mark.

As noted above, there is no evidence consumers of Registrant's goods will view the design element in its mark as the number "7" nor is there any evidence consumers of Applicant's goods will perceive its mark as a play on the periodic table of elements, signifying that its goods are "scientific, pure, and clinical." There is no support in the record for Applicant's speculative arguments regarding the putative differences in the connotations of the marks at issue and such arguments thus are entitled to little weight. *Cai*, 127 USPQ2d at 1799; *U.S. Tsubaki*, 109 USPQ2d at 2006.

Applicant further argues that "when the marks are considered in their [entirety], with the design portions, the marks are clearly distinguishable."<sup>30</sup> However, it is not necessary for the marks to be indistinguishable to be found similar. "The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties." *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (internal quotation marks omitted); *see also Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016). Consumers may not necessarily encounter the marks in close proximity and must rely upon their recollections over time. *In re*

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<sup>30</sup> 4 TTABVUE 6.

*Mucky Duck Mustard*, 6 USPQ2d 1467, 1468 (TTAB 1988), *aff'd mem.*, 864 F.2d 149 (Fed. Cir. 1988).

This is particularly the case where similar marks are used on goods that are, in part, identical. “When marks would appear on virtually identical ... [goods or] services, the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines.” See *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992), cert. denied, 506 U.S. 1034 (1994); see also *ECI Division of E-Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443, 449 (TTAB 1980).

We find, as a result, that the differences between the marks are far outweighed by their similarity in appearance, sound and meaning. Considered in their entirety, we find that the marks convey highly similar overall commercial impressions. This *DuPont* factor supports a finding that confusion is likely.

### **C. Conditions of Purchase**

Under the fourth *DuPont* factor, we consider “[t]he conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing.” *DuPont*, 177 USPQ at 567. Applicant argues:<sup>31</sup>

A consumer seeking Appellant’s “clean” skin products is educated in the field of cosmetics and seeking a specialty product to address a specific need. When a consumer goes in search of a high-end skin care product, they go to a specialty cosmetic retailer where an attendant is always staffed and knowledgeable about the products and able to make recommendations regarding which product will best address the

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<sup>31</sup> 4 TTABVue 13-14.

consumer's need. A consumer seeking general "cosmetics" is an unsophisticated impulse buyer who pays little if any attention to the mark associated with that product.

However, the cosmetic items identified in the application and cited registration must be presumed to include both expensive and inexpensive varieties, available in any common channels of trade. There is nothing in the nature of these identified cosmetics, without any limitation as to their type, price point or intended consumers, to suggest their purchasers are particularly sophisticated or careful. *See In re I-Coat Co.*, 126 USPQ2d 1730, 1739 (TTAB 2018). In fact, the standard of care is that of the least sophisticated potential purchaser. *Stone Lion*, 110 USPQ2d at 1163 *cited in In re FCA US LLC*, 126 USPQ2d 1214, 1222 (TTAB 2018) ("Board precedent requires our decision to be based on the least sophisticated potential purchasers."). Similarly, as discussed, neither Applicant's identified services nor the goods identified in the cited registration are limited to any niche that might elevate the level of care exercised by purchasers thereof.

All in all, we have insufficient bases to find that ordinary consumers would exercise more than an ordinary degree of care. The fourth *DuPont* factor is neutral.

**D. Applicant's Registration No. 6540406**

We now consider Applicant's prior registration under the thirteenth *DuPont* factor which relates "to 'any other established fact probative of the effect of use.'" *In re. Strategic Partners, Inc.*, 102 USPQ2d 1397, 1399 (quoting *DuPont*, 177 USPQ at

567).<sup>32</sup> Applicant argues that it owns prior Reg. No. 6540406 for the “similar mark”



identifying “non-medicated skin serums.”<sup>33</sup>

The Board’s decision in *Strategic Partners* is instructive. In that case, the applicant owned a registered mark that had coexisted with the cited mark for over five years. Because the applicant’s prior registration was over five years old, the Board noted that any challenge thereto by the owner of the cited registration based on a claim of likelihood of confusion would be time-barred under Section 14 of the Act 102 USPQ2d at 1399. In finding no likelihood of confusion in *Strategic Partners*, the Board provided the following explanation:

T]he present case involves the unique situation presented by the coexistence of applicant's existing registration with the cited registration for over five years, when applicant’s applied-for mark is substantially similar to its existing registered mark, both for identical goods. When we consider these facts under the thirteenth du Pont factor, we find in this case that this factor outweighs the others and leads us to conclude that confusion is unlikely.

In this case, Applicant’s prior registration issued in 2021 and thus is not contestable, for a mark with similar elements identifying some of the goods at issue herein. While we are sympathetic to Applicant’s position on this point, we do not consider, on this record, the issuance of Applicant’s earlier registration to outweigh

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<sup>32</sup> Applicant does not rely upon the so-called *Morehouse* defense, see *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 166 USPQ 715 (CCPA 1969). “The *Morehouse* defense is an equitable affirmative defense which, in appropriate circumstances, may be asserted by a defendant/applicant in an *inter partes* proceeding. . . . This defense does not apply in an *ex parte* context.” *Strategic Partners*, 102 USPQ2d at 1399-400.

<sup>33</sup> 4 TTABVUE 7. Reg. No. 6540406 issued on October 25, 2021. 4 TTABVUE 28.

the other *DuPont* factors. Moreover, it would be improper to give preclusive effect to the decision of the Examining Attorney in granting Applicant's earlier registration, and the Board is not bound by the prior decisions of examining attorneys in allowing marks for registration. *In re Cordua Rests., Inc.*, 823 F.3d 594, 600, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016) ("The [US]PTO is required to examine all trademark applications for compliance with each and every eligibility requirement ... even if the PTO earlier mistakenly registered a similar or identical mark suffering the same defect."); *see also In re Boulevard Entm't Inc.*, 334 F.3d 1336, 67 USPQ2d 1475, 1480 (Fed. Cir. 2003) ("The fact that, whether because of administrative error or otherwise, some marks have been registered even though they may be in violation of the governing statutory standard does not mean that the agency must forgo applying that standard in all other cases."); *In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1793 n.10 (TTAB 2017).

Indeed, as is often noted by the Board and the courts, each case must be decided on its own merits. The determination of registrability of a mark in another case does not control the merits in the case now before us. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("[D]ecisions regarding other registrations do not bind either the agency or this court."); *see also, In re Kent-Gamebore Corp.*, 59 USPQ2d 1373 (TTAB 2001); *In re Wilson*, 57 USPQ2d 1863 (TTAB 2001). The issuance of an earlier registration to Applicant does not compel the approval of another if, as in this case, it would otherwise be improper to do so. *See, e.g., In re Perez*, 21 USPQ2d 1075, 1077 (TTAB 1991) (Section 2(d) refusal affirmed

even though the cited registration had not been cited against applicant's previous registration, now expired, of the same mark for the same goods). For the reasons previously discussed, the Examining Attorney's refusal is justified on the record in this case.

This *DuPont* factor is neutral.

### **E. Conclusion**

When we consider the record and the relevant likelihood of confusion factors, and all of Applicant's arguments relating thereto, including those arguments and evidence not specifically addressed herein, we conclude that consumers familiar with Registrant's goods offered under its mark would be likely to believe, upon encountering Applicant's mark, that the goods in the cited registration and Applicant's goods originated with or are associated with or sponsored by the same entity.

**Decision:** The refusal to register Applicant's mark is affirmed under Section 2(d) of the Trademark Act.