

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: February 16, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Consolidated Artists BV
v.
Camille Beckman Corporation

Opposition No. 91188863
to application Serial No. 77479412
filed on May 20, 2008

Michael W. Garvey and Una L. Lauricia of Pearne & Gordon LLP
for Consolidated Artists BV.

Albert P. Barker of Barker Rosholt & Simpson LLP for Camille
Beckman Corporation.

Before Holtzman, Kuhlke and Shaw, Administrative Trademark
Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Camille Beckman Corporation, seeks
registration of the mark MANGO BEACH in standard characters
for goods identified in the application as "hand creams,
body creams, face complexion creams and toners, massage
oils, bubble baths, body cleansing gels, bath powders, soap,
bath beads, skin moisturizing creams, sachets, body splash,

light cologne and perfumes, room fragrances, and lip balms" in International Class 3.¹

Opposer, Consolidated Artists BV, opposed registration of applicant's mark on the ground that, as used in connection with applicant's goods, the mark so resembles opposer's registered mark **MANGO** for "body soaps, perfumery, essential oils for personal use, cosmetics, hair lotions, and dentifrices," as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

By its answer applicant denied the salient allegations.

EVIDENCE OF RECORD

The evidence of record consists of: (1) the pleadings; (2) the file of the opposed application; (3) opposer's notice of reliance on applicant's responses to opposer's first set of interrogatories;² (4) applicant's notice of

¹ Serial No. 77479412, filed May 20, 2008. The application is based on an allegation of first use and use in commerce on January 1, 2005 under Section 1(a) of the Trademark Act, 15 U.S.C. §1151(a).

² The responsive documents to the request for production of documents are not properly of record and have not been considered. Trademark Rule 2.120(j)(3)(ii); TBMP §704 (2d ed. rev. 2004). In addition, opposer's notice indicated it was relying on several of its registrations that contain the term MANGO; however, no registrations were attached to the notice of reliance. Thus, the only registration of record owned by opposer is the Trademark Electronic Search System (TESS) printout of the pleaded registration introduced as an exhibit to applicant's discovery deposition of opposer's in-house counsel, Jaime Passarell.

reliance on the discovery deposition, with exhibits, of Jaume Passarell, opposer's in-house counsel,³ and TESS printouts of third-party registrations; (5) applicant's testimony depositions, with exhibits, of Foad Roghani, one of applicant's partners, and Susan Roghani, applicant's founder and owner.

PRIORITY/STANDING

Because opposer's pleaded registration is of record, is valid and subsisting, and owned by opposer, opposer's standing to oppose registration of applicant's mark is established and its priority is not in issue. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Accordingly, we turn to the issue of likelihood of confusion under Section 2(d).

LIKELIHOOD OF CONFUSION

Our likelihood of confusion determination under Section 2(d) 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 and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

³ When a discovery response or discovery deposition has been made of record by one party in accordance with Trademark Rule 2.120(j), it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence. Trademark Rule 2.120(j) (7).

Opposer's pleaded registration is for the mark MANGO in stylized form for the following goods:

Bleaching preparations and other substances for laundry use, namely, laundry starch, laundry detergent, laundry soap; general purpose cleaning, polishing, grease removing and abrasive liquids, ponders and pastes; body soaps; perfumery; essential oils for personal use, cosmetics, hair lotions; dentifrices, in International Class 3;

Optical apparatus and instruments, namely, spectacles, eyeglasses, sunglasses, [etc.], in International Class 9;

Precious metals and their alloys; goods made of or coated with precious metals and their alloys, namely, badges decorative boxes, jewelry boxes, jewelry, [etc.], in International Class 14;

Leather and imitation leather sold in bulk, goods made of leather and imitation leather, namely, handbags, [etc.], in International Class 18;

Clothing for men, women and children, namely, anoraks, bathing suits, bathrobes, beachwear, belts, blazers, blouses, [etc.], in International Class 25.⁴

We begin with our consideration of the similarities between opposer's and applicant's goods, channels of trade and classes of purchasers. We must make our determinations under these factors based on the goods as they are recited in the application and registration, respectively. See *Octocom Systems Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The

⁴ Registration No. 3436144, filed on May 19, 2004, issued on May 27, 2008. Opposer's pleading references only the International Class 3 goods in the registration and opposer focuses its argument on the goods in International Class 3.

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 sales of the goods are directed."); and *In re Elbaum*, 211 USPQ 636 (TTAB 1981).

Although the pleaded registration has a variety of goods, we focus our consideration of the du Pont factors on the most closely related goods, specifically those in International Class 3. The massage oils, body cleansing gels, soap, light cologne and perfumes listed in the application are identical to or encompassed by the body soaps, perfumery, and essential oils for personal use listed in the pleaded registration. In view thereof, we find the goods to be identical in part. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981) (it is sufficient for a determination of likelihood of confusion if the relatedness is established for any item encompassed by the identification of goods in the application). Further, inasmuch as the identifications of goods are identical in part and given the lack of restrictions in the identifications of goods, we must presume for purposes of the likelihood of confusion

analysis, that the trade channels and classes of purchasers overlap. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002) and *Octocom*, 16 USPQ2d at 1783. Similarly, these goods would be offered to the same classes of consumers.

Applicant's arguments, centered on the differences between the actual channels of trade for the parties' respective goods, ignore well established case law requiring that the comparison of the goods must be based on how the goods are identified in the involved application and opposer's registration.

Applicant argues that opposer's "customers and target market are careful, sophisticated purchasers that know the brand ... [thus t]he conditions of sale and the different level of sophistication of the shoppers render this factor in favor of [applicant]." Br. p. 17. We reiterate that the identifications have no such restrictions and we must consider the lowest level of sophistication for these goods. Therefore, the overlap in class of customers for the goods, as identified, includes the least sophisticated purchaser of soaps and fragrances.

We turn then to consider the du Pont factor of the similarity of the marks. Opposer's basic position is that applicant's mark "includes the MANGO mark in its entirety" and, as such, is similar in "spelling sound and form." Br.

p. 12. Opposer asserts that its mark "has become a well-known and famous mark" and the BEACH portion of applicant's mark is descriptive because it was picked by applicant to "designate a coconut smell."⁵ Id. Having asserted that its MANGO mark is "famous" and that the shared element MANGO is the dominant part of applicant's mark, opposer concludes that the marks are similar.

Because fame plays a dominant role in the likelihood of confusion analysis, we first address opposer's assertion that its mark is famous. *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). See also *Recot Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). "[T]he fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident." *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002).

The record here does not support a finding of fame. Opposer relies on the discovery deposition of its in-house

⁵ The reference in opposer's brief to USPTO records with the word BEACH has not been considered. Factual statements made in a party's brief on the case can be given no consideration unless they are supported by evidence properly introduced at trial. *Jansen Enterprises, Inc. v. Rind*, 85 USPQ2d 1104, 1110 (TTAB 2007) (party's reference in the brief to third-party registrations does not make them of record).

counsel, Mr. Passarell, taken by applicant. Specifically, opposer asserts that it has "advertised its MANGO Marks on buses, billboards, radio, in magazines, brochures, catalogs, and press releases throughout the entire US." Br. p. 15.

Mr. Passarell testifies as follows:

Q. What kind of advertising and marketing do you do for the "mango" mark in the United States?

A. We do outdoor, we do buses, press releases, and catalogs, brochures, radio, billboards, and - I don't know. ... I think that's everything yes.

Passarell Dep. p. 42.

There is no testimony as to how long it has been advertising in the United States, how often, or the way the mark appears on the advertising. There is nothing upon which we may understand the extent to which consumers have been exposed to this mark or for which goods, e.g., clothing, accessories, perfume, etc. There is not one example in the record of how the mark is used in opposer's advertising, other than an excerpt from its website submitted by applicant as an exhibit to Mr. Passarell's deposition. Opposer asserts that there are eleven MANGO retail stores in the United States located in "prime locations." However, we do not know where these stores are located or how the mark is used, so again, we have no information as to the extent of consumer exposure to the mark. Opposer also asserts that "MANGO products are sold in multi-brand stores, such as perfume shops and in JCPenney

department stores." The testimony on this point is as follows:

A. ... I mean, we sell also perfumes in other multi-brand stores which are specially dedicated to perfumery.

Q. How is that - can you give me an example of a multi-brand store that sells perfumes where you also sell?

A. As an example - a name of a store, for example, selling this kind of perfumes?

Q. Sure.

A. I don't know. There are different retailers which are especially dedicated only to perfumes, and then between all the brands there is also available our Mango perfume.

Q. What's the scent of your Mango perfume? Is it a mango scent?

A. No.

Q. Would you describe the scent for me?

A. No. I'm sorry. I cannot describe it.

Q. Okay. Do you know, is there a breakdown between how much - the percentage of the perfumes you sell in your store and how much you sell through independent retailers?

A. I do not have that information. ...

Q. There was an announcement that I pulled off of the website of the company that says - that announces an agreement with JCPenney?

A. Yes.

Q. Okay. Can you explain to me the company's reasoning for entering into an agreement with JCPenney?

A. I don't know the reasoning. I know that we have reached an agreement with JCPenney, but I don't know what was the reasoning.

Passarell Dep. pp. 18-20.

There is no information as to how many other stores sell MANGO branded products, where they are, for how long, or how the mark is displayed. There is no information as to the offering for sale or actual sales of MANGO products in JCPenney, simply an agreement to do so. Opposer states that the sales of MANGO products have been "about 150 million Euros annually." Br. p. 15. The testimony does not specify if this figure represents worldwide sales or if it is specific to the United States. Based on the calculation in Euros the inference would lean more towards worldwide sales. Further, there is no evidence to put such sales numbers in the context of the clothing industry and accessories. Presumably the vast majority of the sales numbers are from the clothing line, but the record provides no information on this issue.

In short, the record evidence does not show such extensive public exposure to rise to the level of fame such that it plays a dominant role in the determination. *Lacoste Alligator S.A. v. Maxoly Inc.*, 91 USPQ2d 1594, 1597 (TTAB 2009) ("Because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in

the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it"); *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901 (TTAB 2007).

With respect to the involved marks, we examine the similarities and dissimilarities of the marks in their appearance, sound, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods offered under the respective marks is likely to result.

We first note that because applicant seeks registration in standard characters, its mark is not limited to any particular depiction. The rights associated with a mark in standard characters reside in the wording and not in any particular display. *In re RSI Systems, LLC*, 88 USPQ2d 1445 (TTAB 2008); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988); TMEP 1207.01(c)(iii) (7th ed. rev. 2010). Thus, the minimal stylization in registrant's mark cannot serve to distinguish the marks, inasmuch as we must consider applicant's mark "regardless of font style, size,

or color." Citigroup Inc. v. Capital City Bank Group Inc., 98 USPQ2d 1253, 1258-59 (Fed. Cir. 2011).

While it is true that applicant's mark begins with the word MANGO, which can serve to increase similarity, see Palm Bay Imports, 73 USPQ2d at 1689, in this case we read applicant's mark as a unitary phrase MANGO BEACH which has the connotation and commercial impression of a place. This is very different from opposer's mark that evokes simply the fruit. We find the overall connotation and commercial impressions quite different and sufficient to outweigh any similarities in appearance or sound based on the common element.

Moreover, to the extent the word "mango" in applicant's mark presents a separate commercial impression apart from the unitary phrase, it is merely descriptive of applicant's product. As applicant points out, the USPTO required applicant to disclaim MANGO because it is merely descriptive of the scent of its products. Although there is no counterclaim, we may make findings as to the inherent strength of opposer's mark and we find it to be highly suggestive in connection with soaps and fragrances.⁶

⁶ Although opposer has testified that its soaps and perfumes do not have a mango scent, that does not detract from the suggestive nature of the term in connection with these goods, in general. The question is how would consumers view this term in connection with such goods.

Mango is defined as "a tropical fruit ... with a ... juicy aromatic pulp."⁷ Applicant submitted examples of third-party use of the term "mango" in connection with skin lotion or soap. See Foad Roghani Test. Exhs. 4 (Suave Naturals Mango Mandarin Lotion) and 5 (The Body Shop Mango Shower Gel); Passarell Depo. Exh. 13 (California Mango). Examples of third-party use may be used to show that a mark is relatively weak and entitled to only a narrow scope of protection. *Palm Bay Imports*, 73 USPQ2d at 1693. Applicant also submitted third-party registrations for soap, skin lotion and fragrances that include the word MANGO in their marks. See App. NOR Exh. A (Reg. No. 3488730 MANGO MAGIC, Reg. No. 3193611 BRAZILIAN MANGO GRAPEFRUIT, Reg. No. 2664840 JAMAICAN MANGO & LIME). Third-party registrations may be used to show that a portion of a mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods. In *re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991). Used in this manner, third-party registrations are similar to dictionaries showing how language is used. *Textronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95

⁷ Merriam-Webster's Collegiate Dictionary (10th ed. 1993). The Board may take judicial notice of dictionary definitions. In *re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006). See also *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

(CCPA 1976). We find this evidence sufficient to establish that, similar to applicant's mark, the word "mango" is used for these types of goods to describe a characteristic of the goods, namely the scent.

Additions to marks may be sufficient to avoid a likelihood of confusion if the marks in their entireties convey significantly different commercial impressions or the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted.

In *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011), the Court of Appeals for the Federal Circuit (Court) affirmed the Board's conclusion of no likelihood of confusion based, in part, on findings that the phrase CITY BANK is frequently used in the banking industry and that CAPITAL in applicant's mark gave the mark a geographic connotation as well as a look and sound distinct from opposer's mark. See also *In re Shawnee Milling Co.*, 225 USPQ 747, 749 (TTAB 1985) (GOLDEN CRUST for flour, and ADOLPH'S GOLD'N CRUST and design (with GOLD'N CRUST disclaimed) for coating and seasoning for food items, not likely to cause confusion, noting that, because GOLDEN CRUST and GOLD'N CRUST are highly suggestive as applied to the respective goods, the addition of ADOLPH'S is sufficient to distinguish the marks).

Here, the record establishes that the common element MANGO is, at a minimum, highly suggestive of oils for personal use, perfume and soap. Further, the addition of the term BEACH gives applicant's mark a geographic connotation as well as a look and sound different from opposer's mark. We find this case also similar to *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459 (Fed. Cir. 1998) where the Court affirmed the Board's decision, that despite the fact that the goods and channels of trade were the same and plaintiff's mark had "come to serve as a very strong indication of origin for [its] champagne," the marks CRISTAL and CRYSTAL CREEK evoked very different images in the minds of consumers sufficient to obviate a likelihood of confusion. *Id.* at 1460, quoting, slip op. Opposition No. 91080932 at p. 9 (TTAB June 25, 1997).

Opposer argues that it uses its mark on a variety of goods and similar house marks are used on both clothing and related accessories.⁸ Even assuming opposer's mark is a "house mark" used on a variety of goods and the record supports such a finding, this factor does not overcome the inherent weakness of this term used in connection with these goods, and the differences between opposer's and applicant's

⁸ The reference to a "Beach Collection" is not supported by evidence adduced at trial and has not been considered.

marks. In addition, with regard to opposer's assertion that MANGO BEACH would be viewed as "another marketing variant of [opposer's] MANGO marks," as noted earlier opposer's other marks are not of record, and it is not clear to what extent goods are sold under those marks in the United States.⁹ Moreover, MANGO BEACH does not fit as a variant to MANGO, or opposer's other asserted marks, MNG BY MANGO, MNG MANGO and HE HOMINI EMERITO BY MANGO.

Finally, opposer argues that it has been active in policing its marks. In its brief, opposer lists seven opposition proceeding numbers, the respective marks opposed and the outcome of each proceeding. Once again opposer attempts to introduce evidence through its brief. The only proceedings of record are in the form of a list from the electronic database TTABVUE showing four of the proceeding numbers asserted by opposer, which was introduced as Exhibit 6 to the Passarell discovery deposition. Because applicant has responded on the merits with regard to these proceedings, we have considered the four listed proceedings in the TTABVUE printout. None of the marks involved in these proceedings was for applicant's goods in the instant case, most were for clothing.

⁹ Opposer relies on Exhibit 5 to the Passarell deposition but this is simply an agreement with JCPenney to launch the MNG BY MANGO brand. As noted supra, this is not evidence that the goods were actually sold or of the level of actual sales and consumer exposure to the brand.

Because the marks are sufficiently different, given the weakness of the term "mango" in connection with the relevant goods, the du Pont factor of the dissimilarities of the marks outweighs the other relevant du Pont factors discussed above. In view thereof, we conclude that there is no likelihood of confusion between applicant's mark MANGO BEACH and opposer's mark **MANGO**. See Kellogg Co. v. Pack'em Enterprises Inc., 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) ("We know of no reason why, in a particular case, a single du Pont factor may not be dispositive"). See also, In re E.I. du Pont de Nemours & Co., USPQ at 567 ("[E]ach [of the thirteen elements] may from case to case play a dominant role").

In view of the above, opposer has not proven its claim of likelihood of confusion under Section 2(d) of the Trademark Act.

Decision: The opposition is dismissed.