

This Opinion is Not a  
Precedent of the TTAB

Mailed: September 10, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

*Skincode AG*

*v.*

*Skin Concept AG*

Opposition No. 91206091

Brendan P. McFeely of Kane Kessler, P.C.  
for Skincode AG.

Randolph E. Digges III of Rankin Hill & Clark LLP  
for Skin Concept AG.

Before Wellington, Shaw, and Kuczma,  
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Skin Concept AG (“Applicant”), filed an application to register the mark **SWISSCODE** in standard character form for “[s]oap; perfumery, essential oils, cosmetics, hair lotions; dentifrices” in International Class 3.<sup>1</sup>

<sup>1</sup> Application Serial No. 79105905 was filed on October 10, 2011 as a request for extension of protection under Section 66(a) of the Trademark Act, 15 U.S.C. Section 1141f based on ownership of International Registration No. 1063327.

Skincode AG (“Opposer”) has opposed registration of Applicant’s mark based on a likelihood of confusion with its registered mark:



for “soaps, cosmetics, all adapted for use on the skin and the scalp” in International Class 3.<sup>2</sup> Trademark Act Section 1052(d), 15 U.S.C. § 1052(d). Specifically, Opposer pleaded, *inter alia*, that its registered mark is “well-known and famous throughout the United States” and that the applied-for mark is “confusingly similar...such that the use and registration of Applicant’s mark is likely to cause confusion and mistake and will deceive the public into believing that Applicant’s goods originate or are in some way sponsored, licensed, associated or otherwise authorized by Opposer.”<sup>3</sup> ¶ 18. Opposer attached to its notice of opposition a copy of its pleaded registration obtained from the USPTO electronic database records showing the current status and title of the registration.

In its answer, Applicant denied the allegations that its use of the applied-for mark would cause a likelihood of confusion with Opposer’s registered mark.

#### I. Procedural Background and the Board’s Prior Order

On December 30, 2013, the Board issued an order (“Prior Order”) addressing Applicant’s motion to dismiss the opposition under Trademark Rule 2.132(b) on the basis that Opposer’s testimony period had passed without Opposer offering any

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<sup>2</sup> Registration No. 2803025 issued on January 6, 2004.

<sup>3</sup> Notice of Opposition.

evidence, and that the only evidence of record thus far, *i.e.*, the USPTO records regarding Opposer's pleaded registration that were attached to the notice of opposition, did not make a *prima facie* showing that Opposer is entitled to any relief. In the Prior Order denying the motion, the Board decided, *inter alia*, that "Opposer ha[d] at least made a *prima facie* case of likelihood of confusion with regard to the pleaded registered mark that dismissal of the opposition is therefore unwarranted."<sup>4</sup> However, the Board explained that the opposition would resume and that, "[o]f course, the *prima facie* case of likelihood of confusion established by opposer's registration of record is subject to introduction of countervailing evidence by applicant during its testimony period inasmuch as the burden of producing evidence to the contrary has now shifted to applicant."<sup>5</sup>

## II. Record

The record in this case consists of the pleadings and, by rule, the file of the involved application. Trademark Rule 2.122(b)(1).

As already noted, Opposer's pleaded registration is of record based on its submission of a USPTO electronic database copy thereof with the notice of opposition. Trademark Rule 2.122(d)(1).

The only other evidence of record is that submitted by Applicant under a notice of reliance filed during its testimony period.<sup>6</sup> These materials include:

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<sup>4</sup> 11 TTABVUE, Prior Order at p. 11. In the Prior Order, the Board also dismissed with prejudice Opposer's likelihood of confusion claim based on "asserted but unproven common law rights" as well as a dilution claim. *Id.* at p. 12.

<sup>5</sup> *Id.*, Prior Order at pp. 12-13.

<sup>6</sup> 12 TTABVUE.

- copies of thirteen (13) third-party registrations for marks containing the term CODE and covering products similar to those involved in this proceeding;
- copies of nineteen (19) third-party registrations for marks containing the term SWISS and covering products similar to those involved in this proceeding;
- copy of a decision (with translation) issued by the Swiss Federal Administrative Court involving Applicant's mark;
- copies of Applicant's Swiss, European Community, Russian, Chilean and International trademark registrations for the mark SWISSCODE;
- printouts from nine (9) third-party websites showing use of CODE in marks in connection with products similar to those involved in this proceeding; and
- printouts from thirteen (13) third-party websites showing use of SWISS in marks in connection with products similar to those involved in this proceeding.

### III. Opposer's Standing and Priority

The Board advised the parties in the Prior Order that because Opposer's pleaded registration is of record this "is sufficient to establish Opposer's standing and would remove priority as an issue at final hearing," citing to *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *King Candy Co. v. Eunice King's Kitchen, Inc.*, 182 USPQ 108 (CCPA 1974). Applicant has

acknowledged as much and “does not contest Opposer’s standing or priority in this proceeding.”<sup>7</sup>

#### IV. Likelihood of Confusion

Our determination under Trademark Act Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *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.”).

##### A. Similarity of the Parties’ Goods, Trade Channels and Consumers

Opposer’s goods, as described in its pleaded registration, are soaps and cosmetics for use on the skin and scalp and Applicant’s goods, as described in the subject application, include cosmetics and soap. To the extent that Applicant’s soap and cosmetics are not limited as to their use, they encompass all types of soaps and cosmetics, including those that can be used on the skin and scalp. Because the goods are in part identical and neither party’s goods are limited to any specific trade channels, we must also presume that the trade channels and classes of customers

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<sup>7</sup> 14 TTABVUE, Brief at p. 4.

are the same. *See American Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011); *see also In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding Board entitled to rely on this presumption).

Accordingly, the factors focusing on the similarity of the parties' goods, trade channels and consumers all support a finding of likely confusion.

#### B. Similarity of the Marks/ Third-Party Use of Similar Marks

We now consider the similarity or dissimilarity of the marks at issue in terms of appearance, sound, meaning, and overall commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Where, as here, the parties use their marks in connection with goods that are legally identical, the similarity between the marks necessary to support a determination that confusion is likely declines. *See Bridgestone Americas Tire Operations LLC v. Federal Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012).

In conjunction with the similarity of the marks factor, we also consider the sixth *du Pont* factor that requires consideration of any evidence pertaining to "the number and nature of similar marks in use on similar goods." In essence, this factor involves the notion that as a result of a certain degree of third-party use of similar marks for similar goods, consumers may be able to differentiate between such marks and that confusion is not likely even if the marks contain a common element.

In comparing the respective marks in their entireties, we agree with Applicant that the overall dissimilarity between them suffices for purposes of avoiding a

likelihood of confusion. This is not to say that we are disavowing the observations made in the Prior Order, including both marks being comprised of two syllables and the term “Code” is found in both Applicant’s mark, **SWISSCODE**, and Opposer’s

mark, **skincode**. Rather, we find that the points of dissimilarity, combined with evidence introduced since the Prior Order, persuades us to find that the marks are sufficiently different to avoid a likelihood of confusion.

The first and foremost difference in the respective marks is that they begin with terms that are very different in both sound and meaning. That is, SWISS clearly has geographic connotation and SKIN is suggestive of the area of application of the goods. While the terms may be accorded less source-identifying significance in view of their suggestive or descriptive nature, we do not ignore the importance of their different meanings and the fact that they appear first in each mark. Cf., *Palm Bay Imports Inc.*, 396 F.3d at 1372, 73 USPQ2d at 1692 (2005); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); and *Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (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”).

In the Prior Order, the Board acknowledged Opposer’s argument that the letter “i” in its mark invokes the country of Switzerland as a result of dot in the letter being a design that purportedly represents or is similar to the flag of that country. In addressing this contention, the Board stated that “the letter ‘I’ arguably could –

though we not now so rule – connote or suggest Swiss origin.”<sup>8</sup> Based on the entire record now before us, we are able to decide that this contention has not been established and we cannot make a finding with any certainty whether consumers would view this design in the manner suggested by Opposer.

On the other hand and not previously addressed in the Prior Order, we note the addition of the subscript “2” element in Opposer’s mark. Because this follows the letters C and O, it may be understood as injecting a different connotation in Opposer’s mark, *i.e.*, CO<sub>2</sub> (carbon dioxide) or O<sub>2</sub> (oxygen). In either case, the subscript “2” may be understood as possessing an element with a meaning not present in Applicant’s mark and further distinguishing the two marks.

As to the common element CODE, Opposer acknowledges in its own brief that Applicant has “submitted as evidence the USPTO records of numerous third-party marks containing the term ‘code.’”<sup>9</sup> For purposes of demonstrating the weakness of a mark, the third-party registrations by themselves are entitled to no weight, because they are not evidence that the marks are *in use*, and thus “provide no basis for saying that the marks so registered have had, or may have, any effect at all on the public mind so as to have a bearing on likelihood of confusion.” *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973); *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 (TTAB 2011). However, Applicant buttressed its submission of third-party registrations with printouts or photographs of the marks actually being used on

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<sup>8</sup> 11 TTABVUE, Prior Order at p. 11.

<sup>9</sup> Brief at p. 6.



products similar to those involved in this proceeding. The following are examples of the registered marks as well as photographs of many of these marks on packaging or advertised on retail websites:

Mark	Reg. No.	Goods
<b>BEAUTY CODE</b>	2926673	personal hygiene products namely hair and skin preparations...
<b>ARMANI CODE (and design)</b>	3362274	perfume; gels for the bath and the shower not for medical purpose; body deodorants; cosmetics, namely, lotions for the face, the body and the hands...
<b>BIOCODE BEAUTY CARE (stylized with design)</b>	3484463	facial cream; facial lotion; perfume; face and body milk; lipstick; foundation make-up; wrinkle resistant cream; skin whitening creams; cosmetic products in the form of aerosols for skin care; cosmetics; facial cleansing milk; cleaning preparations for skin...
<b>CODE SPORT</b>	3907096	perfume, eaux de toilette; gels, salts for the bath and the shower not for medical purposes; toilet soaps, body deodorants; cosmetics, namely, creams, milks, lotions, gels and powders for the face, the body and the hands...
<b>3D CODE (stylized with design)</b>	3913848	body and beauty care cosmetics; cosmetic creams for skin care; non-medicated skin care preparations; private label cosmetics...
<b>COLLAGEN CODE</b>	3938833	skin care products and preparations, namely, facial washes, body washes, non-medicated facial mists, skin moisturizers, skin moisturizing masks, bar soaps, bath soaps in liquid, solid or gel form, liquid soaps for hands, face and body...cosmetics and make-up products, namely, eye makeup, eye makeup remover...
<b>COWBOY CODE</b>	4195736	body powder
<b>FACE CODE</b>	4419637	soaps for body care; facial cleansers; skin moisturizer; cosmetic preparations for skin care...
<b>YOUTH CODE</b>	4420202	gels for the face, skin and body; toilet soaps... cosmetics, namely, creams, milks, lotions, gels...
<b>CODE 4</b>	4467475	lotions for face and body care; Non-medicated skin care preparations, namely, creams, lotions, gels, toners, cleaners and peels; skin creams; skin creams in liquid and solid form; skin moisturizer



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<sup>10</sup> The wording BEAUTY CODE appears at the top of the bottles.



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Although the evidence does not indicate the popularity, if any, that these marks may enjoy or to what extent consumers have been exposed to them, it does show that the parties in this proceeding are hardly unique in seeking to register and use marks containing the term CODE in connection with soap, cosmetics and other skincare goods. The fact that this term is found in both marks, as a secondary

element, has less importance when considering the overall similarity of the two marks.

Because the two marks begin with very different terms and the commonality of the term CODE has diminished importance, we find the marks are sufficiently dissimilar and there would be no likelihood of confusion.

## V. Conclusion

In sum, Applicant has adequately rebutted Opposer's *prima facie* showing of a likelihood of confusion that was based solely on its registration. Although we have found herein that the parties' goods, trade channels and classes of consumers are identical in-part, we find that the differences between the respective marks are sufficient so as to avoid a likelihood of confusion.

**Decision:** The opposition is dismissed and the application will proceed to registration.