

This Opinion is not a
Precedent of the TTAB

Hearing: March 9, 2017

Mailed: June 2, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Cosmetic Warriors Limited

v.

Trang Diem Tran

Opposition No. 91214890
to Serial No. 85920771

Heather J. Kliebenstein and John A. Clifford of Merchant & Gould P.C.,
for Cosmetic Warriors Limited

Paul N. Tauger and Becky Christensen of WHGC, P.L.C.
for Trang Diem Tran.

Before Ritchie, Heasley and Larkin,
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

Trang Diem Tran (“Applicant”) seeks registration on the Principal Register of the mark LUSH VAPOR (in standard characters, with “VAPOR” disclaimed) for “chemical flavorings in liquid form used to refill electronic cigarette cartridges” in

International Class 30.¹

Cosmetic Warriors Limited (“Opposer”) has opposed registration of Applicant’s mark on the ground of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), with Opposer’s previously used and registered LUSH marks (the “LUSH marks”).² In its Notice of Opposition, as amended, Opposer pleaded ownership of seven registered marks (six standard character, one word-and-design) on the Principal Register:

- **LUSH**, U.S. Reg. No. 4,118,438, for cosmetics in International Class 3.³
- **LUSH**, U.S. Reg. No. 2,282,428, for perfumes; nonmedicated toilet and cosmetic preparations, namely, lotions, powders and creams for use on the skin, personal deodorants, preparations for the care of the hair, shampoos, soaps, in International Class 3;⁴
- **LUSH**, U.S. Reg. No. 3,008,685, for perfumes; nonmedicated toilet and cosmetic preparations, namely lotions, powders and creams for use on the skin; preparations for cleansing and care of the skin; bath oils in solid and liquid form; personal deodorants; hair care preparations; oil based massage bars that melt on contact with the skin; solid moisturizers and skin conditioners in the form of a paste or face mask; bath bars that melt on contact with hot water to

¹ Application Serial No. 85920771 was filed on May 1, 2013, based upon Applicant’s claim of first use anywhere since February 2013 and use in commerce since at least as early as March 2013.

² Amended Notice of Opposition ¶ 3, 10 TTABVUE 2-4. The Amended Notice of Opposition also claimed that use and registration of Applicant’s mark was likely to create a false suggestion of a connection with Opposer, and to dilute Opposer’s allegedly famous LUSH mark. Notice of Opposition ¶ 15, 10 TTABVUE 7. These additional claims were not pursued at trial, and are therefore waived. *See Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1479 (TTAB 2017).

³ Issued on March 27, 2012.

⁴ Issued on October 5, 1999, Section 8 & 15 declarations accepted and acknowledged, renewed. Prior to November 2, 2003, “standard character” marks were known as “typed” drawings. A typed mark is the legal equivalent of a standard character mark. Trademark Manual of Examining Procedure (“TMEP”) § 807.03(i) (Jan. 2017).

produce a soapy or oily suspension; soaps; and essential oils for personal use, in International Class 3;⁵



- U.S. Reg. No. 3,102,767, for the same goods as in Registration 3,008,685, also in International Class 3. ;⁶
- **LUSH**, U.S. Reg. No. 3,001,303, for catalogues listing and illustrating cosmetics and toiletry products; printed product lists featuring cosmetic products and toiletry products; printed point of sales display in the nature of signs and display boards; and paper bags, in International Class 16;⁷
- **LUSH**, U.S. Reg. No. 2,853,483, for bringing together, for the benefit of others, of a variety of goods enabling customers to conveniently view and purchase those goods in a retail cosmetics and toiletries store; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a mail order catalogue, or from an Internet web site, specializing in the marketing of cosmetics and toiletries, in International Class 35;⁸
- **LUSH**, U.S. Reg. No. 3,987,808, for hair salon services, namely, hair styling, coloring, washing, shampooing, conditioning, applying hair masks, head massages, and scalp massages; beauty salon therapy services, namely, cleansing of the skin, applying face masks, applying back pack masks, skin peelers, steam treatments, toning, shaving, exfoliation treatments, treatments using creams and lotions against problem skin or older skin, and facial and body treatments consisting of a combination of creams/lotions and massage; beauty salon services; aromatherapy services; skin care salon services; massage services; nail care and manicure services; trichology services, namely, providing advice and consultancy relating to hair disorders in the nature of greasy hair, lank hair, dry hair, dandruff and split hairs; counseling, advisory and information services in the field of beauty and cosmetics, and providing information about beauty by way of beauty

⁵ Issued October 25, 2005, Section 8 & 15 declarations accepted and acknowledged, renewed.

⁶ Issued on June 13, 2006, Section 8 & 15 declarations accepted and acknowledged, renewed.

⁷ Issued September 27, 2005, Section 8 & 15 declarations accepted and acknowledged, renewed.

⁸ Issued June 15, 2004, Section 8 & 15 declarations accepted and acknowledged, renewed.

demonstrations, in International Class 44.⁹

Opposer also claims common law rights in the LUSH word mark as used on incense and candles. Although these are not among the goods identified in Opposer's registrations, the Amended Notice of Opposition alleges that Opposer "sells incense, personal fragrances, and room scenting products,"¹⁰ thereby placing Applicant on notice of Opposer's claimed common law rights with respect to these goods. *See Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981) (common law rights); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 309.03(a)(2) (Jan. 2017) (short and plain statement of one or more grounds for opposition).

Applicant's Answer to the Amended Notice of Opposition admits that USPTO records reflect Opposer's ownership of the cited Registrations, most of which are incontestable, but denies the salient claim of likelihood of confusion.¹¹

The matter is fully briefed, and counsel for Opposer appeared at an oral hearing.¹² For the reasons that follow, we dismiss the opposition.

⁹ Issued July 5, 2011.

¹⁰ Amended Notice of Opposition ¶ 6, 10 TTABVUE 5.

¹¹ 11 TTABVUE. Applicant also raised seven affirmative defenses, which were not pursued at trial and are therefore deemed waived. *See Alcatraz Media v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013), *aff'd mem.*, 565 Fed. Appx. 900 (Fed. Cir. 2014).

¹² Applicant, by counsel, waived her right to appear at the oral hearing. 65 TTABVUE.

I. Standing/Priority

Because Opposer's registrations are properly of record, priority is not in issue as to the marks and goods and services identified therein. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110-11 (CCPA 1974). Applicant also "concedes priority — Opposer's cited marks were registered and recite a date of first use prior to Applicant."¹³ The record further establishes Opposer's prior common law use of the LUSH mark on incense and candles, as evidenced by its witnesses' testimony¹⁴ and by its Answer to Interrogatory number 8, made of record in Applicant's Notice of Reliance,¹⁵ which incorporates by reference the averment in its Notice of Opposition that this use "has been true many years before the date of first use and filing date of the subject mark and application."¹⁶ *See Otto Roth*, 209 USPQ at 43. Opposer consequently has a real interest in this proceeding and a reasonable basis for its belief of damage. 15 U.S.C. § 1063; *see Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Ind., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). Opposer has thus established its standing. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d

¹³ Applicant's brief p. 5, 50 TTABVUE 11.

¹⁴ Chan Dep. 36 TTABVUE 50:17-21, Halls Dep. 33 TTABVUE 102:21-105:19 (designated as confidential). We have reviewed testimony and documents that have been designated as confidential by the parties, and have summarized confidential materials where they are pertinent to our decision.

¹⁵ Applicant's Notice of Reliance, 41 TTABVUE 55-57.

¹⁶ Notice of Opposition ¶ 6, Amended Notice of Opposition ¶ 6, 1 TTABVUE 9, 10 TTABVUE 5.

1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 1401 (2015); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999).

II. The Record

The record includes the pleadings and, pursuant to Trademark Rule 2.122(b), Applicants' application file, as well as the following:

A. Opposer's evidence

- Testimonial deposition of Selina Chan, with exhibits;¹⁷
- Testimonial deposition of Brandi Halls, with exhibits;¹⁸
- Testimonial deposition of Alex Leonini, with exhibits;¹⁹
- Opposer's Notice of Reliance on its registered marks, the application files therefor, Applicant's discovery responses and initial disclosures, transcript of Applicant's deposition testimony, registration certificates and TSDR reports of cited registrations identifying both tobacco products and cosmetic/beauty products, website printouts of Applicant's use of social media, and printouts from Opposer's website;²⁰
- Opposer's Rebuttal Notice of Reliance on websites showing national retailers selling e-cigarette and cosmetic products, websites showing a retail shopping

¹⁷ 32, 36 TTABVUE.

¹⁸ 33, 37 TTABVUE.

¹⁹ 34, 38 TTABVUE.

²⁰ 25 TTABVUE.

mall with one of Opposer's LUSH retail stores and another store specializing in e-cigarette and vaping products.²¹

B. Applicant's evidence

- Testimonial deposition of Applicant Trang Diem Tran, with exhibits;²²
- Applicant's Notice of Reliance on the subject Application's prosecution history, Opposer's initial disclosures and discovery responses, dictionary definitions, web pages showing third party use of "lush" in connection with products, third party registrations and TSDR reports showing registration of LUSH marks, Opposer's product price lists.²³

III. Likelihood of Confusion

We base our determination of likelihood of confusion under 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*"); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In the course of applying the *DuPont* factors, we bear in mind the principles underlying Section 2(d), which are to prevent consumer confusion as to commercial sources and relationships, and to protect registrants from damage caused by registration of confusingly similar marks. *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 224 USPQ 327, 331 (1985); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1163 (1995); *DuPont*, 177 USPQ at 566.

²¹ 42 TTABVUE.

²² 43, 44 TTABVUE.

²³ 40, 41 TTABVUE.

We have considered each *DuPont* factor for which there is evidence or argument, and have treated any other factors as neutral. *See M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *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. *Citigroup Inc. v. Capital City Bank Group 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) (factors “may play more or less weighty roles in any particular determination”).

Two key considerations are the similarities or dissimilarities between the marks and between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *Joel Gott Wines, LLC v. Rehoboth Van Gott, Inc.*, 107 USPQ2d 1424, 1429 (TTAB 2013).

A. The Parties' Goods or Services

We begin with the second *DuPont* factor, “[t]he similarity or dissimilarity and nature of the goods or services....” *DuPont*, 177 USPQ 567. This factor considers whether “the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services.” *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002)).

Applicant's goods are chemical flavorings in liquid form used to refill electronic cigarette cartridges. Opposer offers cosmetics and toiletries and related goods and

services, such as perfumes, salon services and aromatherapy. Opposer acknowledges that the parties' goods are not competitive, but maintains that they are nonetheless sufficiently related such that a reasonably prudent consumer would believe that the goods are from the same source, or are affiliated with, connected with, or sponsored by the same trademark owner.²⁴ See *In re Save Venice New York, Inc.*, 259 F.3d 1346, 59 USPQ2d 1778, 1784 (Fed. Cir. 2001). Opposer offers several reasons it contends the products are related.

To begin with, Opposer contends that the parties' products are related because they have ingredients in common.²⁵ Applicant's e-liquids consist of food flavoring and nicotine, plus two chemicals serving as a liquid base: propylene glycol and vegetable glycerin.²⁶ Those two chemicals are also used in some of Opposer's LUSH branded cosmetic and toiletry products, according to its Intellectual Property advisor, Selina Chan.²⁷ Opposer concludes that the parties' use of the same two chemicals in their goods weighs in favor of finding the goods sufficiently related to create a likelihood of confusion, citing *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1440-41 (TTAB 2012); *Pasco, Inc. v. Diamond Shamrock Corp.*, 191 USPQ 59, 63-64 (TTAB 1976); and *In re H & H Prods. Co.*, 228 USPQ 771, 772-73 (TTAB 1986).

²⁴ Opposer's brief pp. 25-26, 46 TTABVUE 32-33.

²⁵ Opposer's brief p. 26, 46 TTABVUE 33.

²⁶ Tran Dep. 44 TTABVUE 15:20-21; 54:16-55:4.

²⁷ Opposer's brief p. 26, 46 TTABVUE 33, Deposition of Selina Chan, 36 TTABVUE 51:17-53:8 and exhibit 7.

But the decisions on which Opposer relies are distinguishable.²⁸ In *L'Oreal*, the Board found the applicant's mark, L'OREAL PARIS for "aloe vera drinks," confusingly similar to the opposer's L'OREAL PARIS mark for cosmetic, skin care and hair care products, some containing aloe vera, partly because "consumers are aware that aloe or aloe vera is often prominently listed as a beneficial ingredient...." *L'Oreal*, 102 USPQ2d at 1440. Similarly, in *H & H Products*, the Board found that contemporaneous use of HARTLEY'S for soft drink syrups and HARTLEY'S for jams, jellies and preserves would be likely to result in confusion, partly because the same fruit flavorings used by both types of products "would obviously lead purchasers to think they originated with or were in some way associated" with the opposer. *H & H Products*, 228 USPQ at 773. And in *Pasco*, the Board found that contemporaneous use of DINOLENE on motor oils and other petroleum products and DINOLENE on fatliquors and emulsifiers used in treating leather was likely to lead purchasers to assume that the goods originate with or were connected with a single source, partly because both goods derived from petroleum products and had the common function of lubrication. *Pasco*, 191 USPQ at 64. Each of these cases involved common ingredients—aloe, fruit flavoring, and oil, respectively—that were promoted and recognized as the primary beneficial or desirable ingredient of the parties' products.

Here, in contrast, Applicant promotes the flavoring and nicotine content of its e-liquids.²⁹ Those two features would be most important to its target consumers,

²⁸ Applicant's brief, 50 TTABVUE 17-20.

²⁹ Tran Dep. 44 TTABVUE 29:9-13, 30:2-11, 49:4-16.

cigarette smokers who choose vaping as a means of smoking cessation³⁰—not the specific ingredients propylene glycol and vegetable glycerin, which provide the liquid base in which the nicotine and flavors are suspended.³¹ This is illustrated by one of Applicant’s advertisements, to which Opposer alludes in its briefs:³²



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The e-liquids’ flavor, such as tobacco (on the far left bottle), take center stage; to their left is the e-liquids’ nicotine content, ranging from zero to eighteen milligrams (depending on the user’s need for a tobacco substitute); and in the lower left corner, at the very bottom, appear the words “USP GRADE PG & VG” for propylene glycol and vegetable glycerin. As in *L’Oreal*, e-liquid consumers would be aware that flavors and nicotine content are often prominently listed as beneficial ingredients, not the neutral chemical base in which they appear. There is nothing in the record to show that e-cigarette consumers could even identify the chemicals abbreviated as “PG” and

³⁰ Tran Dep. 44 TTABVUE 14:9, 15:6, 16:20-21, 17:3-15, 51:18-23.

³¹ Tran Dep. 44 TTABVUE 15:20-24.

³² Opposer’s brief p. 14, 46 TTABVUE 53, Opposer’s reply brief p. 13, 55 TTABVUE 18.

³³ Tran Dep. ex. 9, 44 TTABVUE 101.

“VG,” much less that the chemicals are viewed by consumers as the primary beneficial or desirable ingredients of Applicant’s goods.

Opposer, by contrast, promotes the fresh ingredients in its cosmetics and toiletry products.³⁴ As its Director of Brand Communications for North America explained, “If you walk into a store and someone is talking to you about a fragrance or a hair care product or a skin care product, they’re going to be discussing it from an ingredients-and-effects-led perspective.”³⁵ They might say, for example, “Fresh pomegranate juice and grapefruit oil cleanses skin while a dash of almond oil moisturizes.”³⁶ Opposer does not, however, offer products containing nicotine, including goods marketed as a substitute to help purchasers quit smoking.³⁷ And it does not promote the base chemicals its cosmetics have in common with Applicant’s e-liquid. Manifestly, then, the coincidence of some base chemical ingredients in the parties’ goods does not establish their relatedness. The specific common ingredients are not touted by either of the parties in marketing their respective goods. Thus, consumers are not likely to be aware of the specific ingredients or to consider them in their purchases.

Opposer next argues that the goods are related because both parties sell liquid products designed to be used with atomizers. An atomizer in a perfume bottle sprays Opposer’s fragrances into the air, and an atomizer in an e-cigarette heats and

³⁴ Chan Dep. 32 TTABVUE 120, 190-394 (confidential).

³⁵ Deposition of Brandi Halls, 33 TTABVUE 62: 12-16 (confidential).

³⁶ Halls Dep. 37 TTABVUE 62:23-25.

³⁷ Chan Dep. 32 TTABVUE 70:23-71:24, 75:20-22, 76:9-14, 96:5-16 (confidential).

vaporizes Applicant’s e-liquid, permitting the user to inhale the vapor.³⁸ But Opposer offers no authority, testimony or other evidence supporting its assertion that the mechanisms by which the liquid goods are delivered—part of a perfume bottle in one case, and an e-cigarette in the other—would induce their consumers to perceive them or their sources as related. As with Opposer’s “common ingredients” argument, the parties’ coincidental use of atomizers for otherwise different products does not establish that their goods are related in the mind of the purchasing public. As Applicant correctly notes, “Opposer offers no evidence whatsoever that consumers of e-liquids are even aware that the specific internal mechanism that turn[s] the e-liquid into a vapor is an atomizer.”³⁹ “[A] finding that the goods are similar is not based on whether a general term or overarching relationship can be found to encompass them both.” *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1410 (TTAB 2010).

Opposer next argues that the parties’ products are related because they can be packaged similarly, *citing Set Prods. v. Constr. Prods.*, 208 USPQ 842, 848 (TTAB 1980), in which the parties’ goods were found to be related in part because they “may be packaged in the same size bags.”⁴⁰ Opposer claims that “Applicant’s e-liquid product packages and containers are remarkably similar to those used by [Opposer]

³⁸ Opposer’s brief p. 27, 46 TTABVUE 34.

³⁹ Applicant’s brief p. 14, 50 TTABVUE 20.

⁴⁰ Opposer’s brief p. 27, 46 TTABVUE 34.

for its LUSH branded products—namely its fragrance and makeup liquids,”⁴¹ as it illustrates in the following tables:

<p>Opposer’s Products</p>	 <p>0.8 fl. oz. fragrance 0.2 oz. make-up fragrance bottles in assorted sizes</p> <p>(Ex. 6 to Chan Dep. [32 TTABVUE 146-89]; Ex. 11 to Halls Dep. [33 TTABVUE 323-30]; see also Exs. 30-46 to Chan Dep. [32 TTABVUE 477-526]; Exs. 41, 50 to Halls Dep. [33 TTABVUE 492-500, 927-30].)</p>
<p>Applicant’s Products</p>	 <p>30 ml e-liquid 15 ml e-liquid Both sizes</p> <p>(Ex. 5 to Tran Dep. [44 TTABVUE 117-130].)⁴²</p>

But the case law on which Opposer relies is once again distinguishable from the present case. In *Set Prods.*, the Board found MAXICRETE for premixed cement confusingly similar to MAXIMENT for dry material for making cementitious

⁴¹ *Id.*

⁴² Opposer’s brief p. 28, 46 TTABVUE 35.

structures, as they were “closely related building materials that may be packaged in the same size bags and sold through the same trade channels...” 208 USPQ at 848. In other words, the materials were already closely related; the size of the bags containing the materials was mentioned solely as a potential aggravating factor. Here, the parties offer different products, performing different functions for their respective consumers. Applicant was asked:

Q Is Lush Vapor a fragrance company?

A No, we are not.

Q Why not?

A Lush Vapor is an electronic cigarette liquid flavor company.

Fragrance is a perfume. We are not perfume.

We are a flavor company by taste.⁴³

Applicant uses a multiplicity of container designs, e.g.:



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⁴³ Tran Dep. 44 TTABVUE 15:1-6.

⁴⁴ Tran Dep. 44 TTABVUE 114.

⁴⁵ Tran Dep. 44 TTABVUE 126.

Even if some of the parties' containers are similar, that does not increase the likelihood of confusion, as Opposer does not claim trade dress in its containers,⁴⁶ which have a basic shape or design that is not unique, unusual or distinctive. *See Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 196 USPQ 289 (CCPA 1977); *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1069 (2000) (discussing Coca-Cola bottle as an example of distinctive packaging); *In re Procter & Gamble Co.*, 105 USPQ2d 1119 (TTAB 2012) (distinctive SCOPE cap and bottle). There is no reason to believe consumers of Applicant's e-liquid products are likely to believe its container designs indicate a connection with Opposer.

Opposer then suggests that the parties' goods are related because they both use similar product names, with themes featuring fruit and sexually oriented double entendres, such as "Strawberry Feels Forever" or "You've Been Mangoed."⁴⁷ This fares no better than its argument that the parties use similar containers. Opposer claims no trademark rights in its product names, either by registration or at common law. Its Notice of Opposition, as amended, is predicated solely on its pleaded LUSH marks, not its product names.⁴⁸ And there is no indication that the unpleaded issue of similar product names has been tried by implied consent. *See Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria La Michoacana Inc.*, 98 USPQ2d 1921, 1927 (TTAB 2011). We must focus on the goods as identified in the Application and the

⁴⁶ *See* Deposition of Alex Leonini, Opposer's Group Intellectual Property Manager, 38 TTABVUE 134:2-8.

⁴⁷ Opposer's brief pp. 28-29, 46 TTABVUE 35-36; Leonini Dep., 38 TTABVUE 56:12-20.

⁴⁸ Amended Notice of Opposition, 10 TTABVUE.

Registrations, not on extrinsic evidence of their actual use, which could change at any time. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Houston Comp. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). For these reasons, Opposer’s argument regarding the parties’ product names does not enhance the relatedness of their respective goods.

Opposer argues further that the parties’ goods are complementary:

Here, CWL sells candles and incense under its LUSH mark. Candles and incense are commonly used in conjunction with smoking products. More broadly, LUSH branded bath products, such as bath melts and bath bombs, are frequently used for their aromatherapy benefits to help users relax after a long day – not dissimilar to how people would normally enjoy Applicant’s products. Indeed, Applicant confirmed that its vapor products, when exhaled, emit scents that reflect the flavoring ingredients in the e-liquid, much like the scents emitted by CWL’s candles, incense, and aromatherapy products....⁴⁹

Opposer concludes that “goods that are often used in conjunction with or as complements to one another are also routinely found to be sufficiently related to support a likelihood of confusion.”⁵⁰ Opposer cites, *inter alia*, *In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1567-68, 223 USPQ 1289, 1290-91 (Fed. Cir. 1984) (bread and cheese “are complementary and often used and consumed together.”) and *In re Davia*, 110 USPQ2d 1810, 1815, 1819 (TTAB 2014) (pepper sauce and agave sweetener condiments are “commonly used together.”). Opposer’s claimed use of its

⁴⁹ Opposer’s brief p. 30, 46 TTABVUE 37.

⁵⁰ Opposer’s brief p. 29-30, 46 TTABVUE 36-37.

marks for incense and candles is properly pleaded⁵¹ and sufficiently supported by testimony.⁵²

What is *not* sufficiently supported by testimony or other evidence is Opposer's assertion that "[c]andles and incense are commonly used in conjunction with smoking products."⁵³ In *Martin's Famous Pastry Shoppe*, the Board found, and the Federal Circuit agreed, that it was common knowledge that bread and cheese are complementary:

Use of bread together with cheese, whether in sandwich form or as a snack or hors d'oeuvre base for a cheese spread or wedge, is a frequent and normal food consumption practice which hardly requires documentation. It provides one leg to the kind of product association that we believe would lead purchasers and consumers to assume a common source in the face of the same marks on such products -- and that, after all, is the critical inquiry in these cases rather than complementary use per se.

In re Martin's Famous Pastry Shoppe, 221 USPQ 364, 366 (TTAB 1984), *aff'd* 223 USPQ at 1290. And in *In re Davia*, the examining attorney submitted copies of web pages showing that the relevant products, pepper sauce and agave sweetener condiments, are often called for as ingredients in the same recipes. 110 USPQ2d at 1815.

Here, in contrast, Opposer's assertion that candles and incense are commonly used in conjunction with smoking products is unsupported by either common knowledge or by persuasive evidence of record. Opposer's Director of Brand

⁵¹ Amended Notice of Opposition ¶ 6, 10 TTABVUE 5.

⁵² *See, e.g.*, Chan Dep. 36 TTABVUE 50:20-22; Halls Dep. 37 TTABVUE 97:15-23.

⁵³ Opposer's brief p. 30, 46 TTABVUE 37.

Communications for North America was asked:

Q. ... Do you have any basis for believing that the consumers who buy Lush candles, such as the ones that are identified on this list, are also consumers of e-liquids?

A. Not specifically.

Q. Okay.

A. Unless you consider the fact that they're individuals who enjoy scent and fragrance and vapor and those types of things in which you could say that they could be the same individuals interested in both.

Q. Okay. And what facts are you aware of that would support that?

A. I'm not – there's none specifically.⁵⁴

“How many of the incense products have nicotine?” another witness was asked. “Zero” was the answer.⁵⁵ There is simply no evidence that e-liquids infused with nicotine complement candles and incense. *See In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009) (“[T]here is no evidence that energy vodka infused with caffeine and wine are ingredients for any particular cocktails such that we could consider them complementary products that would be bought and used together.”). As Opposer’s witness asserted, “Well, if you’re referring to smoking a cigarette or an e-cigarette or that, it would not be permitted inside a Lush spa.”⁵⁶

⁵⁴ Halls Dep. 37 TTABVUE 202:5-17.

⁵⁵ Chan Dep. 36 TTABVUE 96:5-7.

⁵⁶ Halls Dep. 37 TTABVUE 156:18-20.

Opposer finally submits that its goods and services are diversified and constantly expanding—an expansion that could naturally be expected to continue in the future. Consequently, Opposer contends, its rights and protectable interest extend not only to its current goods and services, but also into “areas to which a normal consumer would expect the product offerings to expand,”⁵⁷ citing *S & L Acquisition Co. v. Helene Arpels, Inc.*, 9 USPQ2d 1221, 1225 n.8 (TTAB 1987) and *DuPont*, 177 USPQ at 567 (9th *DuPont* factor).

Under the doctrine of natural expansion, the first user of a mark in connection with particular goods or services possesses superior rights in the mark as against subsequent users of the same or similar mark for any goods or services which purchasers might reasonably expect to emanate from it in the normal expansion of its business under the mark. *Mason Eng’g and Design Corp. v. Mateson Chem. Corp.*, 225 USPQ 956, 962 (TTAB 1985); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1598 (TTAB 2011), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014); *Orange Bang, Inc. v. Olé Mexican Foods, Inc.*, 116 USPQ2d 1102, 1119 (TTAB 2015). The application of the doctrine is strictly limited to those cases where the expansion, whether actual or potential, is “natural.” *Mason*, 225 USPQ at 962. “Without such evidence of a natural expansion, opposer would be asserting the dreaded right in gross to a mark, a right to prevent the registration of any similar mark regardless of the dissimilarities of the parties’ goods....” *Sheller-Globe Corp. v. Scott Paper Co.*, 204 USPQ 329, 334 (TTAB 1979).

⁵⁷ Opposer’s brief p. 31, 46 TTABVUE 38.

Here, Applicant's goods are e-liquids containing nicotine, designed for e-cigarette use as a substitute for smoking. Applicant explains, "We produce e-liquid, or electronic cigarette liquid..." which, when placed in e-cigarettes, "is vaporized or atomized for consumers to inhale the vapor," a process now commonly known as "vaping."⁵⁸ Opposer provides cosmetics and toiletries, non-cosmetic goods such as incense and candles, and related services such as salon and aromatherapy services. Opposer does not provide goods with nicotine.⁵⁹ It does not allow smoking or vaping at its spas or salons.⁶⁰

Smoker or vapers cannot look to Opposer's stores for supplies:

Q. ... Does Lush sell e-cigarettes in their stores?

A. No.

Q. E-liquids?

A. No.

Q. Hookahs?

A. No.

Q. Pipes?

A. No.⁶¹

Neither can these goods be found on Opposer's website:

A. No, I can't find in [its website] as displayed any ... e-liquids and the other ones you mentioned.

Q. E-cigarettes, smoking products, nothing like that?

⁵⁸ Tran Dep. 44 TTABVUE 9:6-16, 13:3-7

⁵⁹ Chan Dep. 36 TTABVUE 96:5-7.

⁶⁰ Halls Dep. 37 TTABVUE 156:18-20.

⁶¹ Halls Dep. 37 TTABVUE 196:24-197:1-7.

A. Yes.⁶²

A witness for Opposer tried to hold open the possibility of expansion into Applicant's goods, but had to admit that such an expansion was unlikely:

Q. Could you tell me which e-cigarette products Cosmetic Warriors is planning to develop?

...

A. I'm not aware of any e-cigarette products we are planning to develop, but I would not say we would never go there because we are obviously always innovating and always introducing new products so I would not rule it out ***as unlikely as it might be.***⁶³

If Opposer's own witness deems such an expansion unlikely, there is no reason, based on the record evidence, to find that the public would expect any such expansion. *Mason*, 225 USPQ at 962.

Opposer nonetheless maintains that "There is precedent to support expansion of a mark from, on the one hand, cosmetics, bath and body products, and non-cosmetic products such as clothing, bags, artwork, incense, and candles to, on the other hand, tobacco-related and substitute products. [Opposer] has identified three dozen active

⁶² Chan Dep. 36 TTABVUE 76:9-14.

⁶³ Chan Dep. 32 TTABVUE 69:7-18 (emphasis added) This section was redacted as confidential, but cannot reasonably be considered confidential. *See Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1461 (TTAB 2014) (the Board will not be bound by improper confidentiality designations); Trademark Rule 2.116(g) (Jan. 2017) ("The Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.").

trademark registrations in the United States directed to both tobacco-related products and cosmetics.”⁶⁴ A representative sample is depicted in this table:

Registration No.	Registrant	Pertinent Goods
1724832	Takasago Koryo Kogyo K.K.	Organic chemicals for industrial purposes, colorants in the manufacture of foodstuffs and beverages; essential oils for use in flavorings, perfumes, aromatic chemicals; flavorings other than essential oils, plant extracts used as flavorings, extracts used in the manufacture of tobacco products
2197202	Bell Flavors & Fragrances, Inc.	Chemicals for use in manufacture of flavors and fragrances; aroma chemicals; fragrances for use in manufacturing toiletries and cosmetics; essential oils for flavoring food and beverages; food and beverage flavoring additives for non-nutritional purposes; flavorings for tobacco
2952055	Bell Flavors & Fragrances, Inc.	Chemicals for use in the manufacture of flavors and fragrances; aroma chemicals, fragrances for use in manufacturing toiletries and cosmetics; synthetic resins for use in manufacturing cosmetics; and artificial sweeteners; essential oils for flavoring food and beverages; essential oils for use in manufacturing perfumes, scents, cosmetics, detergents, cleaning preparations and personal care products; scents perfumes; colognes; and incense; food and beverage flavoring additives for non-nutritional purposes; extracts used as flavoring for food and beverages; flavoring syrup for food and beverages; sauces; seasonings for food and beverages; and flavorings for tobacco
2291918	Systems Bio-Industries	Gelatins used in the paper industry; gelatins used in the tobacco industry for closing cigarette seams; gelatins used in the cosmetic industry as an ingredient in protection creams, beauty masks, lotions, toothpaste and shampoo base;
2911954	Bertolucci SA	Soaps, personal deodorants, perfumery, eau de toilette, essential oils for personal use,

⁶⁴ Opposer’s brief p. 31, 46 TTABVUE 38, citing Principal Register registrations at 26 TTABVUE 356-538, 29 TTABVUE 2-190.

		cosmetics and hair lotions; eyeglasses; smokers' articles made of precious metal, namely ashtrays, cigar and cigarette cases, lighters, match boxes; writing materials; goods of leather and imitation leather; clothing; tobacco, matches, and smokers' articles not made of precious metal, namely ashtrays, cigar and cigarette cases, lighters, match boxes
29493562	Givaudan SA	Chemical additives for use in manufacturing beverages, foodstuffs, food ingredients and flavorings; flavoring-imparting chemicals and compositions; essential oils for food flavoring; cosmetic and perfumery products, and non-medicated skin care preparations, namely, perfumes, eau de toilette, eau de cologne, skin protecting and sun tanning lotions, lipsticks, make-ups, shower gels, bubble bath, body scrubs; printed materials; food and beverage flavoring additives for non-nutritional purposes for use in flavoring and aromatizing; flavoring additives for non-nutritional purposes for tobacco
3276430	Hood Rich Apparel Inc.	Toilet soap, bath salts, bubble bath, perfume toilet water, cologne, lipsticks, nail polishes, make-up creams, cleansing milk, body and face powders, eyeliner, after shave lotion, shaving soap, personal deodorants and hair lotions; audio and video equipment; eyeglass frames; jewelry, watches; photographs, posters, souvenir books featuring photographs; luggage, bourbon, brandy, gin, rum, scotch, tequila, vodka, whiskey and wine; raw or manufactured tobacco, cigarettes, smokers articles, namely cigar bands, cigarette ash receptacles, cigarette papers and matches;
3764122	684538 Ontario Ltd	Smoking cessation preparations in the nature of tobacco extract gels, foams, and lotions
4030793	Topsee Int'l Co. Ltd.	Bath lotion, cleaning and polishing preparations, cleansing milk, cosmetics for animals, dentifrices, facial cleansers; hair lotions, make-up, perfumery, potpourri, cigar lighters for automobiles, computer peripheral apparatus, electric navigational instruments; Ashtrays for smokers, cigarette cases, cigarette filters, cigarettes, cigarettes containing tobacco substitutes no for medical

		purposes, electric cigarettes, lighters for smokers, matches, tobacco, tobacco pouches
4036645	Flavor & Fragrance Specialties, Inc.	Essential oils in the nature of flavorings and fragrances for use in the manufacture of personal care products, food, beverages, pharmaceuticals, scented products, household cleaning and detergent products, tobacco products and a variety of other general industrial applications; Manufacture of flavorings and fragrances to the order and specification of others for use in the manufacture of personal care products, food, beverages, pharmaceuticals, scented products, household cleaning and detergent products, tobacco products and a variety of other general industrial applications
4321016	Feellife Bioscience Int'l Co., Ltd	Air fragrancng preparations, bathing lotions, cakes of toilet soap, cleaning and washing preparations, cleaning preparations, cosmetics, cosmetics for animals, dentifrices, essential oils, fragrances and perfumery, hair lotions, incense, polishing preparations, polishing scouring and abrasive preparations, washing powder; alarm installations and alarms, automatic indicators of low pressure in tyres, batteries, electric, cases for eyeglasses and sunglasses; baby layettes for clothing, bathing suits, gloves, neckties, shirts, shoes; ashtrays for smokers, chewing tobacco cigarette cases, cigarette filters, cigarettes, cigarettes containing tobacco substitutes nor for medical purposes

These third-party registrations fail to prove that expansion from cosmetics to tobacco or tobacco substitute products is common. A dozen of the registrations—a third of Opposer’s list—are owned by one company, Feel Life BioScience International; nine are owned by another company, Bell Flavors & Fragrances; and three are owned by yet another, Flavor & Fragrance Specialties. Many of the third-party registrations are for chemical flavoring—flavors used for foods and beverages, and, incidentally, tobacco products. They do not, in the main, show a “natural” leap

of the use of marks for cosmetics and toiletries to use for tobacco-related products sold at retail. Even assuming diversification and expansion by a few companies, the record does not establish that the practice is sufficiently common that the purchasing public would naturally expect expansion of the use of a mark from the retail sale of cosmetics, toiletries and related goods and services into e-liquid and e-cigarettes for vaping. Overall, based on the record, there is insufficient evidence from which to infer that purchasers might reasonably expect Opposer to expand from its base product lines into e-liquids for e-cigarettes.

In sum, none of the rationales advanced by Opposer establishes that its goods are related to Applicant's. The second *DuPont* factor thus weighs strongly against a likelihood of confusion.⁶⁵

B. The Parties' Channels of Trade

We next consider the third *DuPont* factor: the similarity or dissimilarity of the parties' established, likely-to-continue channels of trade. *DuPont* 177 USPQ 567. The record shows that there is little or no overlap between the channels of trade for cosmetics and related goods, and e-cigarette liquids.

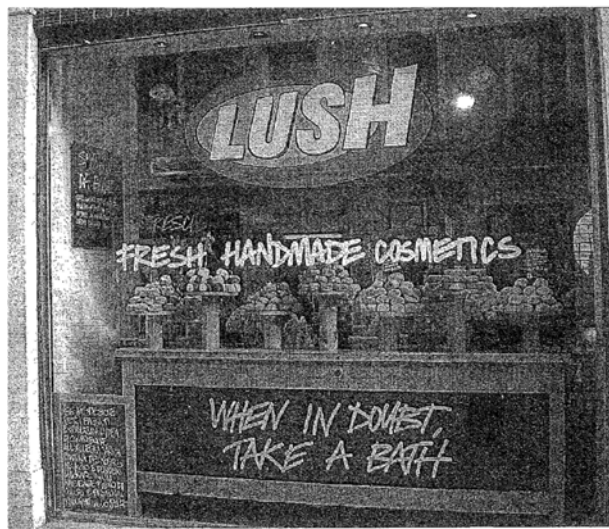
Turning first to the record evidence regarding the parties' current channels of trade, Applicant targets cigarette smokers ages 18 and over.⁶⁶ Her products are sold alongside tobacco products at tobacco stores, gas stations, convenience stores, and

⁶⁵ With regard to the ninth *DuPont* factor, concerning Opposer's current diversification, that is, the variety of goods on which its LUSH marks are currently used, Opposer has established that it offers various types of cosmetics, toiletries, and related goods and services such as candles, incense, and spa services. We find this factor to be neutral.

⁶⁶ Tran Dep. 44 TTABVUE 16:20-25.

kiosks.⁶⁷ She also markets her e-liquids via her website at www.LushVaporUSA.com, and has a presence on Facebook, Instagram and Twitter.⁶⁸ Applicant is unaware of any occasion when LUSH VAPOR products would be sold in the same stores as cosmetics and Opposer's other products.⁶⁹

Opposer sells its cosmetics, toiletries, and related goods to the general public through its own branded LUSH retail stores, e.g.:⁷⁰



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Opposer points to no instance in which the parties' products have ever been offered from the same retail store. It admits that it is not aware of any publications, including magazines, journals, periodicals and newspapers, in which its LUSH-branded goods

⁶⁷ Tran Dep. 44 TTABVUE 9:21-10:5, 31-32, Applicant's Answer to Interrogatory no. 7, Opposer's first Notice of Reliance, 25 TTABVUE 916.

⁶⁸ Tran Dep. 44 TTABVUE 10:9-10, 20-25.

⁶⁹ Tran Dep. 44 TTABVUE 10:16-19.

⁷⁰ Opposer's Answer to Interrogatory no. 5, Applicant's Notice of Reliance, 40 TTABVUE 9-10.

⁷¹ Applicant's Notice of Reliance 41 TTABVUE 82.

and services and Applicant's goods have appeared.⁷² And it is not aware of any trade shows at which both it and Applicant exhibit their branded products.⁷³ Like Applicant, it markets its products on the Internet via its own website at www.LushUSA.com, as well as Facebook, YouTube, Twitter, Instagram, and Pinterest.⁷⁴ But “[a]dvertising on the Internet is ubiquitous and ‘proves little, if anything, about the likelihood that consumers will confuse similar marks used on such goods or services.’ *In re St. Helena Hosp.*, 113 USPQ2d at 1087-88 (quoting *Kinbook, LLC v. Microsoft Corp.*, 866 F. Supp. 2d 453, 470-71 n.14 (E.D. Pa. 2012) (quoting, in turn, J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:53.50)). As the Board has made clear, “the mere fact that goods and services may both be advertised and offered through the Internet is not a sufficient basis to find that they are sold through the same channels of trade. The Internet is such a pervasive medium that virtually everything is advertised and sold through the Internet.” *Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012, 1021 (TTAB 2007) *quoted in Bond v. Taylor*, 119 USPQ2d 1049, 1054 (TTAB 2016). There is thus little or no current overlap in the parties’ channels of trade.

As noted above, however, we must consider not only current channels of trade but all other normal channels of trade for the parties’ goods as identified. As Opposer

⁷² Opposer’s Response to Applicant’s Request for Admission no. 4, Applicant’s Notice of Reliance, 41 TTABVUE 117.

⁷³ Opposer’s Response to Applicant’s Request for Admission no. 2, Applicant’s Notice of Reliance, 41 TTABVUE 117.

⁷⁴ Opposer’s Answer to Interrogatory no. 5, Applicant’s Notice of Reliance, 40 TTABVUE 9-10.

correctly observes, the goods identified in its Registrations and the subject Application contain no restrictions on trade channels, and must therefore be presumed to move in all channels of trade usual for such goods. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (affirming Board finding that where the identification is unrestricted, “we must deem the goods to travel in all appropriate trade channels to all potential purchasers of such goods”); *In re Davia*, 110 USPQ2d at 1818. The record shows that these channels could include retail stores such as convenience stores, pharmacies, “big box” retail stores, and shopping malls, where cosmetics and toiletries, as well as e-cigarette or vaping products are sold.⁷⁵

The mere presence of the parties’ disparate goods in the same convenience store, mass merchandise store, pharmacy, or mall, however, does not establish an “overlap” in channels of trade that will enhance the likelihood of confusion:

It has long been held that the mere fact that two different items can be found in a supermarket, department store, drugstore or mass merchandiser store is not a sufficient basis for a finding that the goods are related. *Recot Inc. v. M.C. Becton*, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000) (“the law is that products should not be deemed related simply because they are sold in the same kind of establishments”); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“A wide variety of products, not only from different manufacturers within an industry but also from diverse industries, have been brought together in the modern supermarket for the convenience of the customer. The mere existence of such an environment should not foreclose further inquiry into

⁷⁵ *See* Opposer’s Rebuttal Notice of Reliance, 42 TTABVUE exhibits 1-4 (websites showing national retailers selling both e-cigarette and vaping products, as well as cosmetics and personal care products); 42 TTABVUE exhibit 6 (websites showing a retail shopping mall in the United States containing one of Opposer’s LUSH-branded stores and a store specializing in e-cigarette and vaping products); Tran Dep. 44 TTABVUE 59:22-25 (“Q. So you’ll agree with me there are stores that sell your products and also sell cosmetics and bath products? A. Sure”).

the likelihood of confusion from the use of similar marks on any goods so displayed”); *Shoe Factory Supplies Co. v. Thermal Engineering Company*, 207 USPQ 517, 526 (TTAB 1980) (“This contention [to equate different or unrelated goods by urging that they are all sold in supermarkets, department stores, and similar establishments] has been rejected...”).

Morgan Creek Prods. Inc. v. Foria Int’l Inc., 91 USPQ2d 1134, 1142 (TTAB 2009).

As Professor McCarthy puts it, “In the modern marketing environment of mega-sized stores selling all manner of goods, ‘under the same roof’ is not probative of a likelihood of confusion.” 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:53.50 (4th ed. 2017).

For these reasons, the third *DuPont* factor is neutral.

C. Purchasing Conditions/Sophistication of Consumers

The fourth *DuPont* factor concerns the conditions under which and buyers to whom sales are made, i.e. “impulse” versus careful, sophisticated purchasing. *DuPont*, 177 USPQ at 567. “Purchaser sophistication may tend to minimize likelihood of confusion. Conversely, impulse purchases of inexpensive items may tend to have the opposite effect.” *Bd. of Regents, Univ. of Texas Sys. v. Southern Ill. Miners, LLC*, 110 USPQ2d 1182, 1193 (TTAB 2014).

Since Applicant markets its e-liquids to customers 18 years of age or older, alongside tobacco products,⁷⁶ and Opposer purports to market its goods to customers of all ages,⁷⁷ the overlap between the two is adult purchasers. The Board has found

⁷⁶ “Applicant’s products can only be sold to those over the age of 18.” Applicant’s Answer to Interrogatory no. 7, Opposer’s first Notice of Reliance, 25 TTABVUE 916; Tran Dep. 44 TTABVUE 16:20-21.

⁷⁷ Chan Dep. 36 TTABVUE 98:9-13; Halls Dep. 33 TTABVUE 98:11-13.

that the degree of sophistication exercised in purchasing tobacco products (for which Applicant's e-liquids substitute) varies proportionately to the cost of the product. *See Top Tobacco, L.P. v. North Atl. Op. Co., Inc.*, 101 USPQ2d 1163, 1171 (TTAB 2011). And the Board has found that skin care products (of the sort Opposer offers) "are relatively low-priced, and do not require much consumer sophistication...." *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1261 (Fed. Cir. 2010) (affirming Board finding).

In this case, as Opposer rightly observes, Applicant's e-liquid products range in price from about \$7 to \$19,⁷⁸ prices that fall squarely within Opposer's range of \$5 to \$85.⁷⁹ Given these low to moderate prices, there is no reason to expect the adult purchasers of the parties' products to exercise more than ordinary care. *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *In re Davia*, 110 USPQ2d at 1818 ("Generally, casual purchasers of low-cost, every-day consumer items exercise less care in their purchasing decisions and are more likely to be confused as to the source of the goods."). On the other hand, because there is no relationship between the parties' goods, purchasers of e-liquids and purchasers of cosmetics, toiletries and related products are not likely to assume that the differing goods have a common source, even if they exercise no more than ordinary care. *Cf. Parfums De Coeur*, 83 USPQ2d at 1022.

⁷⁸ Tran Dep. 44 TTABVUE 16:4-8 ("The product ranges from 6.99 to 18.99.").

⁷⁹ Ex. 6 to Chan Dep. 32 TTABVUE 146-89.

The fourth *DuPont* factor weighs slightly in favor of finding a likelihood of confusion.

D. The Parties' Marks

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Applicant's and Opposer's marks as compared in their entireties, taking into account their appearance, sound, connotation and commercial impression. *Du Pont*, 177 USPQ at 567; *Stone Lion*, 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).

Opposer argues that: its LUSH mark is the first word of Applicant's LUSH VAPOR mark; LUSH, the first and most dominant element of Applicant's mark, most likely to be impressed on the minds of consumers; VAPOR, the disclaimed portion of Applicant's mark, is entitled to less weight, as it is generic for Applicant's goods; thus, it concludes, the marks are highly similar to one another in sight, sound, and commercial impression.⁸⁰

Applicant responds that: Opposer ignores the anti-dissection rule; Applicant was indeed required to disclaim VAPOR, as it was descriptive (not generic) for vaping goods, but LUSH VAPOR must still be considered in its entirety; and if LUSH for cosmetics and toiletries is compared with LUSH VAPOR for electronic cigarette liquid, then the marks have different meanings, as LUSH VAPOR connotes the flavorful vapor emitted by e-cigarettes; thus, Applicant concludes, the applied-for

⁸⁰ Opposer's brief pp. 24-25, 46 TTABVue 31-32.

mark, taken in its entirety, connotes different, unrelated goods, and conveys a different commercial impression.⁸¹

Upon consideration of all the arguments and evidence, we find that LUSH is the dominant component of Applicant's mark, appearing first and often most prominently on Applicant's goods.

The first term in a mark is the part that is first encountered by purchasers, and most likely to be remembered by those purchasers. *See Palm Bay Imps.*, 73 USPQ2d at 1692; *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word); *Presto Prod. Inc. v. Nice-Pak Prods., 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 re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1090 (TTAB 2016). Although we must ultimately consider Applicant's mark as a whole, "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 consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable." *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985), *quoted in ProMark Brands*, 114 USPQ2d at 1243.

The first word of Applicant's mark looks and sounds exactly the same as Opposer's LUSH mark. In terms of connotation, Opposer's witnesses testify that they are

⁸¹ Applicant's brief pp. 8-10, 50 TTABVUE 14-16.

unaware of any meaning of the word “LUSH” apart from Opposer’s brand.⁸² Their testimony guardedly avoids admitting that the word “LUSH” is descriptive of Opposer’s goods. As Opposer states in its brief:

LUSH has no readily apparent descriptive meaning when used in connection with bath and body products or in connection with the sale of those products, providing spa, aromatherapy, massage, and beauty services, or disseminating educational and commercial content online about them. **At most, LUSH suggests that the products being offered are luxurious.**⁸³

Applicant states in her brief that “LUSH” suggests “a luxuriant vapor or mist....”⁸⁴ She testified that she selected the word “LUSH” because it suggested the succulence of her e-liquids’ VAPOR:

A. Lush is an English word that I chose for my company and it suggests succulent, lavish and rich.

Q. Let’s talk about how you chose the word lush. How did you come to decide on lush for the name of Lush Vapor?

A. I wanted to suggest to my customers the tasty flavor of my liquid so I — I came up with the word succulent. But the word did not sound appealing, so I Googled succulent and lush was a part of the definition.⁸⁵

Her testimony is consistent with the first dictionary definition of “lush”:

“Lush’: 1. Full of juice; succulent.

2. of luxuriant growth; as, *lush* vegetation.

3. characterized by a rich growth of vegetation; as, *lush* fields.

4. characterized by rich and extravagant ornamentation, invention, etc.

⁸² Chan Dep. 36 TTABVUE 91:8-16, 92:16-24; Leonini Dep. 38 TTABVUE 115:7-9, 13-24; Halls Dep. 37 TTABVUE 124:17-23.

⁸³ Opposer’s brief p. 19, 46 TTABVUE 26 (emphasis added).

⁸⁴ Applicant’s brief p. 10, 50 TTABVUE 16.

⁸⁵ Tran Dep. 44 TTABVUE 8:12-20.

often tending to excess; as, *lush* writing.”⁸⁶

In terms of connotation, then, the parties appear to concur in their briefs that the word LUSH suggests that their respective goods are “luxurious” or “luxuriant.”⁸⁷

Opposer contends that the commercial significance of the word VAPOR is minimized because the term is disclaimed as generic for the goods sold by Applicant,⁸⁸ citing *In re Chatam Int’l. Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1947-48 (Fed. Cir. 2004). As Applicant correctly observes, though, the term VAPOR, as used in LUSH VAPOR, is not generic for e-liquids; it is descriptive, denoting the vapor produced by e-cigarettes.⁸⁹

Disclaimed descriptive matter like VAPOR is often accorded less weight in a likelihood-of-confusion calculus. *In re National Data Corp.*, 224 USPQ at 751 (“That a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark....”); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”). Still, even though we may place more weight on the dominant prefix of Applicant’s mark and less on the disclaimed descriptive suffix, the ultimate

⁸⁶ Exhibit 9, WEBSTER’S NEW UNIVERSAL DICTIONARY DELUXE SECOND EDITION, 41 TTABVUE 121. The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006); *Bond v. Taylor*, 119 USPQ2d at 1056n. 14.

⁸⁷ Opposer’s brief p. 19, 46 TTABVUE 26, Applicant’s brief p. 10, 50 TTABVUE 16.

⁸⁸ Opposer’s brief p. 25, 46 TTABVUE 32.

⁸⁹ Applicant’s brief p. 9, 50 TTABVUE 15.

conclusion must rest on consideration of the mark as a whole. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012). Ultimately, the question is whether the overall impression of the marks is so similar that consumers will believe that they identify goods emanating from a single source. *North Face Apparel Corp. v. Sanyang Indus. Co.*, 116 USPQ2d 1217, 1228 (TTAB 2015).

In this case, VAPOR signals to purchasers the nature of Applicant's goods.

As Applicant testified:

Q. ... Why is vapor the second word?

A. Most of the e-liquids in the market put the word "vapor" so customers know it's an electronic cigarette.⁹⁰

Applicant states, "Applicant's mark, viewed in its entirety as it must, suggests a luxuriant and rich vapor or mist, i.e. 'lush' in Applicant's mark modifies 'vapor.'"⁹¹ And VAPOR, in turn, indicates vaping e-cigarette goods. We agree. Applicant's mark LUSH VAPOR, considered in its entirety, connotes a flavorful vapor emitted from vaping its e-liquid. Opposer's mark does not. This dissimilarity in the connotation of the marks distinguishes this case from *In re Chatam*, on which Opposer relies. There, the Board found the marks to have a similar connotation in the context of related alcoholic beverages. 71 USPQ2d at 1946 (JOSE GASPAR GOLD for tequila confusingly similar to GASPAR'S ALE for beer and ale because "both marks convey the commercial impression that a name, GASPAR, is the source of related alcoholic beverages, tequila and beer or ale.")

⁹⁰ Tran Dep. 28 TTABVUE 995:3-7.

⁹¹ Applicant's brief p. 10, 50 TTABVUE 16.

In terms of overall commercial impression, the parties' marks are similar to one another, with common components that look and sound alike; that similarity is mitigated to some degree by the difference in connotation engendered by Applicant's suffix VAPOR, referring to goods that are unrelated to Opposer's. On balance, the first *DuPont* factor weighs in favor of finding a likelihood of confusion.

E. Strength of Opposer's marks

As noted, Opposer has not pursued its initial claim that its LUSH mark is famous for purposes of protection against dilution. Rather, it claims, in accordance with the fifth *DuPont* factor, that its mark is strong and entitled to a broad scope of protection under Section 2(d).⁹² Fame under Section 2(d) arises where a significant portion of the relevant consuming public recognizes the mark as a source indicator; a mark's renown within a specific product market, meaning its customers and potential customers, is the proper standard. *Palm Bay Imps.*, 73 USPQ2d at 1694.

Likelihood of confusion fame "varies along a spectrum from very strong to very weak." *Id.*, quoted in *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, ___ F.3d ___, No. 2016-1089, slip op. at 3, 2017 BL 173120 (Fed. Cir. May 24, 2017). The commercial strength of a mark may be measured indirectly by the volume of sales of and advertising expenditures for the goods identified by the marks, the length of time those indicia of commercial awareness have been evident, widespread critical assessments, notice by independent sources of the goods, and the general reputation of the goods. *In re Mr. Recipe*, 118 USPQ2d at 1086 (citing *Bose Corp. v. QSC Audio*

⁹² Opposer's brief p. 18, 46 TTABVUE 25.

Products Inc., 293 F.3d 1367, 63 USPQ2d 1303, 1305-06, 1309 (Fed. Cir. 2002)).

Here, the record shows that the LUSH brand for cosmetics, toiletries, and related goods and services has steadily grown in recognition since its debut in 1996.⁹³ Its brick-and-mortar retail stores have expanded from one store in San Francisco to well over a hundred nationwide, located in malls and on streets with high levels of pedestrian traffic.⁹⁴ It has sold over 200 million separate items in the United States from 2006 to 2015, with proportionate dollar sales which, though confidential, are nonetheless impressive.⁹⁵ Its marketing and promotional expenditures during that same period, also confidential, are commensurately significant.⁹⁶ Over this time, it has garnered numerous mentions in the print media—in magazines such as *Cosmopolitan*, *Allure*, *Forbes*, *Women’s Wear Daily*, *Better Homes and Gardens*, *Architectural Digest*, *Marie Claire*, and *Vogue*.⁹⁷ And it has established a significant online presence, not only through its website at www.LushUSA.com, but also on Facebook, YouTube, Twitter, Instagram, and Pinterest.⁹⁸ Opposer has also promoted the LUSH brand by untraditional means, through its “ethical campaigns” against tar

⁹³ Halls Dep. 33 TTABVUE 104:5-10 (confidential).

⁹⁴ Halls Dep. 37 TTABVUE 87:13-19, 33 TTABVUE 90:4-17 (confidential), 37 TTABVUE 95:9-17, 33 TTABVUE 191:1-2 (confidential), 33 TTABVUE 437-444, exs. 36-37 (confidential).

⁹⁵ Halls Dep. 37 TTABVUE 102:6-104:4, 33 TTABVUE 110:2-8, 501-562, exs. 42, 44, 45 (confidential).

⁹⁶ Halls Dep. 37 TTABVUE 111:18-25, 33 TTABVUE 931, 937, exs. 47, 51 (confidential).

⁹⁷ Halls Dep. 33 TTABVUE 73:18-74:8 (confidential), 37 TTABVUE 77:3-20, 180:10-23, 33 TTABVUE 940-957, exs. 17-33, 55 (confidential).

⁹⁸ Opposer’s Answer to Interrogatory no. 5, Applicant’s Notice of Reliance, 40 TTABVUE 9-10; Halls Dep. 33 TTABVUE 22:16-24, 47:18-48:8, 49:6-11, 50:5-15, 51:3-14, 51:20-52:4, 53:10-13, 54:19-55:2, 55:21-56:3, 19-23, 60:13-24, 64:8-11.

sands, nuclear energy, palm oil, and the over-use of plastic packaging in the cosmetics industry, among other causes.⁹⁹ “As a result of this extensive advertising and promotion, both paid and unpaid,” Opposer concludes, “the LUSH brand is extremely well known and admired among consumers interested in bath, body and cosmetic products.”¹⁰⁰

We agree, and find that Opposer has demonstrated that its LUSH mark is strong under the fifth *DuPont* factor, which weighs in favor of finding a likelihood of confusion.

F. Third-Party Marks

The sixth *DuPont* factor addresses the number and nature of similar marks in use on similar goods. *DuPont*, 177 USPQ at 567. This factor, if proven, may mitigate a mark’s strength under the fifth *DuPont* factor because a multiplicity of parallel uses by third-party sources would tend to diffuse the purchasing public’s perception that the mark is traceable to a single source. *See Palm Bay Imps.*, 73 USPQ2d at 1694 (“the purpose of a defendant introducing third-party uses is to show that customers have become so conditioned by a plethora of such similar marks that customers have been educated to distinguish between different such marks on the bases of minute distinctions.”) (internal punctuation omitted).

⁹⁹ Halls Dep. 37 TTABVUE 58:12-16.

¹⁰⁰ Opposer’s brief p. 11, 46 TTABVUE 18.

Applicant indicates that one of Opposer's competitors, Sephora, uses the term "lush" in connection with its cosmetic goods.¹⁰¹ Furthermore, Applicant claims, the USPTO identifies 85 applications or registrations for marks consisting of or containing "LUSH."¹⁰²

Applicant's evidence, however, does not rise to the level of demonstrating that third-party use of the mark is so wide as to condition the consuming public or weaken Opposer's mark. Sephora's use of "lush" on such products as its "Sephora stila Lush Lip Brush" or "Bite Beauty Lush Lip Tint"¹⁰³ appears more descriptive of its cosmetic goods than source-indicating. And even if its use was in a trademark sense, "...evidence of one third-party user of a mark that is similar to Opposer's mark is not sufficient to establish that Opposer's mark is a weak mark entitled to only a narrow scope of protection or exclusivity of use especially when Applicant has not introduced any evidence regarding the extent to which that mark has been used." *Bond* 119 USPQ2d at 1055. Opposer has, moreover, engaged in extensive enforcement efforts against third parties in order to protect and preserve the strength of its mark.¹⁰⁴ This cuts against a finding that the mark has been weakened. *See UMG Recordings, Inc. v. Mattel, Inc.*, 100 USPQ2d 1868, 1883 (TTAB 2011) ("active and extensive trademark enforcement program").

¹⁰¹ Applicant's brief pp.10-11, 22, 50 TTABVUE 16-17, 28; Applicant's Notice of Reliance exs. 15, 16, 41 TTABVUE 5.

¹⁰² Applicant's brief pp.10-11, 22, Applicant's Notice of Reliance exs. 17-41.

¹⁰³ Applicant's Notice of Reliance ex. 16, 41 TTABVUE 159, 168.

¹⁰⁴ Leonini Dep. ex. 2, 34 TTABVUE 201-207 (confidential).

The USPTO third party “LUSH” registrations to which Applicant refers number 18, not 85.¹⁰⁵ One of the registrations is currently the subject of a cancellation proceeding by Opposer,¹⁰⁶ and will not be considered. The remaining registrations are for disparate and unrelated goods and services, e.g.:

Ex #	Mark / Registration#	Pertinent Goods/Services	Owner
17	LUSH Registration #5,044,161	Dance club services; night clubs Int'l Class: 041	Cocktails And Dreams, LLC
19	LUSH Registration#: 4,112,945	Bicycles and structural parts thereof Int'l Class: 012	Trek Bicycle Corporation
20	LUSH Registration#: 4,317,468	Aerated fruit juices; drinking water, energy drinks, herbal juices, Int'l Class: 032	Caspian Gourmet Foods
24	LUSH Registration#: 3,850,762	Eyeglasses, sunglasses, frames, cases Int'l Class: 009	Allure Eyewear L.L.C.
25	LUSH Registration#: 3,530,376	Retail store services featuring wine and spirits Int'l Class: 035	Lush Wine & Spirits, LLC
26	LUSH Registration#: 3,923,521	Chewing gum Int'l Class: 030	Wm. Wrigley Jr. Company

As this representative sample demonstrates, the cited third-party registrations are for goods or services far removed from cosmetics and toiletries; this significantly diminishes their probative value. *See In re Integrated Embedded*, 120 USPQ2d 1504,

¹⁰⁵ Applicant’s Notice of Reliance exs. 17-34, 41 TTABVUE 170-245.

¹⁰⁶ Reg. no. 4990746, Cancellation no. 92065596.

1512 (TTAB 2016) (“[T]he probative value of the third-party registrations in this case is significantly diminished because the trademarks cover a wide variety of goods and services that are not related to the types of services involved here.”); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009) (“In this case, the third-party registrations are of limited probative value because the goods identified in the registrations appear to be in fields which are far removed from [the subject goods]”). If anything, this evidence demonstrates how registrations for LUSH may coexist with Opposer’s registered LUSH marks, so long as they are for unrelated goods or services.

But the third-party registrations do not diminish the strength of Opposer’s LUSH mark in its identified product lines and services. The sixth *DuPont* factor is accordingly neutral.

G. Actual Confusion

We next consider the seventh *DuPont* factor (nature and extent of any actual confusion) and the related eighth *DuPont* factor (extent of the opportunity for actual confusion). *DuPont*, 177 USPQ at 567.

Opposer points to two possible instances of actual confusion. In one instance in February 2014, one of its North American customer care representatives, located in Vancouver, Canada, received an email originating from the United States inquiring whether, given the similarity between Opposer’s and Lush Vapor’s names and domain names, there was any affiliation between the two.¹⁰⁷ In another instance, Applicant reported that she “was asked while on a business trip to a tobacco event in

¹⁰⁷ Leonini Dep. 34 TTABVUE 60:10-65:1, ex. 10, 35 TTABVUE 343.

France by a woman whether Lush Vapor was the same company as Lush. This occurred approximately in April 2014.”¹⁰⁸ This evidence is far too equivocal to prove actual confusion. *See Georgia-Pacific Corp. v. Great Plains Bag Co.*, 614 F.2d 757, 204 USPQ 697, 701 (CCPA 1980) (“Actual confusion is entitled to great weight but only if properly proven. ... Such is not the case here.”). Inquiries as to whether one firm’s mark indicates affiliation with another firm do not, without more, suffice to show that the inquirers were actually confused. *See Mini Melts*, 118 USPQ2d 1464, 1475 (TTAB 2016). Applicant further testified:

Q Can you tell me how many times someone has either called Lush Vapor, written to Lush Vapor, commented on the Web site, sent an e-mail to Lush Vapor, asking about a Cosmetic Warrior’s product?

...

A No, not that I know of. No one has contacted us.

Q Can you tell me how many times Cosmetic Warriors has ever contacted you or any of your employees because someone had contacted Cosmetic Warriors about a Lush Vapor product?

A Not that I know, no.

Q And can you tell me how many times, to your knowledge, anyone who is a United States consumer has been confused about the source or the origin or affiliation of your products?

A Zero.¹⁰⁹

Given the vague and inconclusive nature of the two inquiries, and the lack of any

¹⁰⁸ Applicant’s Answer to Interrogatory no. 15, ex. 17 to Opposer’s Notice of Reliance, 25 TTABVUE 919.

¹⁰⁹ Tran Dep. 44 TTABVUE 52:7-24.

further evidence of confusion, the seventh and eighth *DuPont* factors are neutral.

IV. Conclusion

We have considered all of the evidence of record and all of the arguments of the parties, including evidence and arguments not specifically discussed in this opinion, as they pertain to the relevant *DuPont* likelihood of confusion factors. The fact that the parties' goods are dissimilar and unrelated weighs heavily in Applicant's favor, and, in the totality of the circumstances, outweighs the factors favoring a finding of likelihood of confusion, including without limitation the findings that Opposer's mark is strong and somewhat similar to Applicant's mark. Our weighing of all relevant *DuPont* factors above leads us to conclude, on balance, that the record evidence fails to establish a likelihood of confusion between Applicant's applied-for mark and Opposer's marks under Section 2(d).

Decision: The opposition is dismissed.