

This Opinion is Not a  
Precedent of the TTAB

Hearing: September 5, 2024

Mailed: January 28, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Metabeauty, Inc.*  
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Serial No. 97492557  
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Heidi Tandy of Berger Singerman, LLP  
for Metabeauty, Inc.

Holland Hauenstein, Trademark Examining Attorney, Law Office 108,  
Kathryn Coward, Managing Attorney

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Before Acting Deputy Chief Administrative Trademark Judge Johnson, Kuhlke and  
Allard, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Metabeauty, Inc. (“Applicant”) seeks registration on the Principal Register for the  
mark  for goods and services identified as “Non-medicated skin care  
preparations,” in International Class 3 and “On-line retail store services featuring  
medical supplies, cosmetics, dermatologicals, and tools used for application of lotions,  
masks, serums, oils, exfoliants and creams; retail store services featuring medical  
supplies, cosmetics, dermatologicals, and tools used for application of lotions, masks,  
serums, oils, exfoliants and creams; providing consumer product information to

consumers and doctors, physicians and medical practitioners about medical supplies, cosmetics, dermatologicals, and tools used for application of lotions, masks, serums, oils, exfoliants and creams,” in International Class 35.<sup>1</sup>

The Trademark Examining Attorney refused registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), as likely to cause confusion with the registered mark TWELVE COSMETICS in standard characters (“COSMETICS” disclaimed) for “cosmetics; private label cosmetics,” in International Class 3.<sup>2</sup>

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request, the appeal resumed and briefs were filed. We reverse the refusal to register.

### I. Evidentiary Issues

The Examining Attorney’s objection to the twelve third-party registrations Applicant attached for the first time to its brief is sustained. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d) (“The record in the application should be complete prior to the filing of an appeal.”); *In re Fiat Grp. Mktg. & Corp. Commc’ns S.p.A.*, Serial No. 79099154, 2014 WL 721511, at \*4 (TTAB 2014) (examining attorney’s objection

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<sup>1</sup> Application Serial No. 97492557, filed on July 7, 2022 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging first use and first use in commerce on January 31, 2016. During examination, Applicant satisfied other requirements including providing the following description of the mark and color claim: “The mark consists of a light blue-green-colored stylized shaded octagon with curved sides with the number ‘12’ in it in a white serif font” and “The color(s) light blue-green and white is/are claimed as a feature of the mark.”

<sup>2</sup> Registration No. 6332043 issued on April 27, 2021.

to applicant's submission of registrations with appeal brief sustained).<sup>3</sup> The Examining Attorney's objection to the listing of third-party registrations in Applicant's Response to the First Office Action is moot inasmuch as Applicant properly submitted them attached to its Request for Reconsideration during prosecution of its application.

## II. Likelihood of Confusion

When the question is likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA, 1973) ("*DuPont*"). See also *In re Majestic Distilling Co.*, 315 F.3d 1311 (Fed. Cir. 2003). We consider each *DuPont* factor for which there is evidence and argument. See *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379 (Fed. Cir. 2019).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. See *In re Chatam Int'l Inc.*, 380 F.3d 1340, 1341-42 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (CCPA 1976) ("The fundamental inquiry

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<sup>3</sup> To introduce evidence after an appeal has been filed, an applicant may file a request for remand under separate cover. Trademark Rule 2.142(d)(1), 37 C.F.R. § 2.142(d)(1).

As part of an internal Board pilot citation program, the citation form in this opinion follows the TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 101.03 (2024). This opinion cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals by the page(s) on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). For decisions of the Board, this opinion cites the Westlaw legal database.

Citations to the briefs in the appeal record refer to the Board's public online database TTABVUE. Citations to the prosecution record refer to the USPTO's public online database TSDR.

mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”); *see also In re i.am.symbolic, LLC*, 866 F.3d 1315, 1322 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all [*DuPont*] factors for which there is record evidence but ‘may focus . . . on dispositive factors, such as similarity of the marks and relatedness of the goods [or services].’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65 (Fed. Cir. 2002)).

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

When considering the goods and services, trade channels, and classes of consumers, we must make our determinations based on the goods and services as they are identified in the application and cited registration. *See Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 1323 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 942 (Fed. Cir. 1990).

Applicant does not contest that the goods and services are not related for confusion purposes; Applicant merely states in its brief that “the goods and services differ” from each other. However, the issue is not whether the goods and services will be confused with each other, but rather whether the public will be confused as to their source. *See Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 1329 (Fed. Cir. 2000) (“[E]ven if the goods [or services] in question are different from, and thus not related to, one another in kind, the same goods [or services] can be related in the mind of the consuming public as to the origin of the goods [or services].”).

The Examining Attorney presented evidence showing Applicant's type of goods, non-medicated skin care preparations, and services, online retail services for among other things cosmetics, and Registrant's type of goods, cosmetics, used or registered under the same mark. *See, e.g.*, February 10, 2023 Office Action, TSDR pp. 6-39 (www.bluemercury.com, www.sephora.com, www.ulta.com); June 14, 2023 Office Action, TSDR pp. 2-36 (www.charlottetilbury.com, www.capbeauty.com, www.shen-beauty.com, www.spacenk.com), pp. 38-43 (Registration Nos. 20190507, 20181102, 20200817, 20171107, 20210331); January 22, 2024 Recon. Denied, TSDR pp. 5-40 (www.elfcosmetics.com, www.honest.com, www.imageskincare.com).

These examples of screen captures from third-party websites show Applicant's goods and services, and Registrant's goods at issue are marketed and sold under a single trademark in the same trade channels and offered to the same classes of consumers. It is sufficient for a finding of likelihood of confusion if relatedness is established for any item encompassed by the identification of goods or services within a particular class in the application. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335 (CCPA 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, Opp. No. 91196527, 2014 WL 1827031 (TTAB 2014).

In view thereof, these factors weigh in favor of likely confusion.

B. Weakness of the number 12/TWELVE

Before we consider the similarity of the marks, we first consider the possible weakness of the number 12/TWELVE in connection with cosmetics, including skin

care and hair care preparations.<sup>4</sup> “A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength ...” *In re Chippendales USA Inc.*, 622 F.3d 1346, 1353-54 (Fed. Cir. 2010). Because the cited mark is registered on the Principal Register without a claim of acquired distinctiveness, it is treated as inherently distinctive--at the very least, suggestive. 15 U.S.C. § 1057(b). *In re Fiesta Palms LLC*, Ser. No. 76595049, 2007 WL 950952, \*3 (TTAB 2007). But its strength may vary along a spectrum from very strong to very weak. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 1325 (Fed. Cir. 2017). “The weaker [a Registrant’s] mark, the closer an applicant’s mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.” *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338 (Fed. Cir. 2015).


Applicant submitted 12 third-party registrations and one third-party application for marks that contain 12 or TWELVE and are for cosmetics, skin care preparations or hair care preparations.<sup>5</sup> The application has no probative value. *In re Team Jesus LLC*, Ser. No. 88105154, 2020 WL 7312021 at \*7 n.29 (TTAB 2020) (“an application would be evidence only of the fact that it was filed, and therefore has no probative value”). The registration, based on a Madrid application under Section 66(a), 15

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<sup>4</sup> We take judicial notice that cosmetics is defined as: “A preparation, such as powder or a skin cream, designed to beautify the body by direct application.” THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE ([www.ahdictionary.com](http://www.ahdictionary.com)). The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or regular fixed editions. *In re Cordua Rests. LP*, Ser. No. 85214191, 2014 WL 1390504, at \*2 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594 (Fed. Cir. 2016).

<sup>5</sup> December 11, 2023 Request for Reconsideration, TSDR pp. 98-158.

U.S.C. § 1141(f), has no probative value without a Section 71 affidavit of use. *In re Info. Builders*, Ser. No. 87753964, 2020 WL 2094122, at \*7 n. 19 (TTAB 2020) (“[W]e have not given any consideration to this registration [issued under Section 66(a)] because it does not demonstrate exposure of the mark prior to registration through use in commerce and, therefore, has no probative value.”). The registration for eyewear cleaners and eyewear is not sufficiently related for probative value. *See Spireon, Inc. v. Flex Ltd.*, 71 F.4th 1355, 1363 (Fed. Cir. 2023). Including the two registrations owned by the same registrant, the cited registration, and a registration in Chinese characters, the tally of third-party registrations comes to ten, summarized below:<sup>6</sup>

Registration Number	Mark	Goods
4913847	TWELVE SPRINGS	Cosmetics; Essential oils; Hair care preparations; non-medicated skin care preparations
5205139	12S	Cosmetics; Essential oils; Hair care preparations; Non-medicated skin care preparations
5662058	Twelve12Beaute	Hair care preparations; Hair oils
5656796	12months Soaps	Lotions for cosmetic purposes
5490992	 Translation TWELVE BEAUTIFUL WOMEN	Beauty masks; Cleansing milk for toilet purposes; Cosmetics; Sunscreen preparations

<sup>6</sup> We do not include two of the third-party registrations for the marks ONE TWO WASH and ONE TWO LASH owned by a single party as there is no evidence upon which to find consumers would perceive the ONE TWO elements as the word or number 12 or that the 12 in Applicant’s mark would be perceived as 1 and 2.

5645137	Twelve Spells	Skin moisturizers, Essential oils; Skin cleansers; Facial moisturizers
5847036	CS12	Body lotions; Cosmetic preparations
6414490	PM ACTIVE12	Cosmetics
6895851	12TWENTY	Skin lotions; cosmetics
632043	TWELVE COSMETICS	Cosmetics; private label cosmetics


Third-party registrations are relevant to the conceptual strength of a mark because they “show the sense in which a mark is used in ordinary parlance,’ that is, some segment that is common to both parties’ marks may have ‘a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak[.]” *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1374 (Fed. Cir. 2015) (quoting *Juice Generation*, 794 F.3d at 1338; see also *In re Box Sols. Corp.*, Ser. No. 76267086, 2006 WL 1546499, at \*2 (TTAB 2006) (“[T]hird-party registrations can be used in the manner of a dictionary definition to illustrate how a term is perceived in the trade or industry”); see, e.g., *Spireon*, 71 F.4th at 1364 (citing 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:90); *Sock It to Me v. Fan*, Opp. No. 91230554, 2020 WL 3027605, \*12 (TTAB 2020) (quoting *In re Melville Corp.*, Ser. No. 736814, 1991 WL 325859, \*2 (TTAB 1991) (“The conclusion to be drawn [from third-party registrations] is that there is an inherent weakness in a mark comprised in whole or in part of the word in question and that, therefore, the



question of likelihood of confusion is colored by that weakness to the extent that only slight differences in the marks may be sufficient to distinguish one from the other.”)).

Because two registrations come from one third party (TWELVE SPRINGS and 12S), the number of third-parties we consider in the record is nine with ten third-party marks. We find these registrations probative of conceptual weakness of the number 12 and TWELVE. *Spireon*, 71 F.4th at 1363-4 (third-party composite marks relevant to show common segment weak). The number 12 or TWELVE suggests a form of measurement: days, months, hours, amount. These various marks with the element 12 or TWELVE coexist for the same or similar goods with varying levels of other elements to distinguish them. *Id.* Even if we do not count the mark in Chinese characters (which creates further distinction), the remaining nine marks tend to show the common element 12, or TWELVE, to be conceptually weak, so we accord it a restricted scope of protection. This factor weighs against likely confusion.

### C. Similarity/Dissimilarity of the Marks

We compare the marks  and TWELVE COSMETICS in their entireties as to “appearance, sound, connotation and commercial impression.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371 (Fed. Cir. 2005) (quoting *DuPont*, 476 F.2d at 1361). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s*, Serial No. 87075988, 2018 WL 2734893, at \*5 (TTAB 2018), *aff’d mem.*, 777 Fed. Appx. 516 (Fed. Cir. 2019) (citing *In re Davia*, Serial No. 85497617, 2014 WL 2531200, at \*2 (TTAB 2014)).

In Registrant's mark, COSMETICS is disclaimed because it is the generic word for the identified cosmetics. Disclaimed matter that is descriptive of or generic for a party's goods and/or services is typically less significant or less dominant when comparing marks. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1305 (Fed. Cir. 2018) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407 (Fed. Cir. 1997)). Taken as a whole, the most memorable element in Registrant's mark is the word TWELVE.

With regard to Applicant's mark, the number 12 is more memorable than the green colored curved octagon because it is the name by which consumers will call for the goods. *In re Aquitaine Wine USA, LLC*, Ser. No. 86928469, 2018 WL 1620989 (TTAB 2018). However, the carrier design and coloring adds to the commercial impression of the mark, creating a medallion like appearance.

The Examining Attorney argues that the marks are confusingly similar because "the entirety of the wording in Applicant's mark both sounds the same and conveys the same meaning as the dominant wording in Registrant's mark." Ex. Atty. Brief, 8 TTABVUE 5. "Consumers are therefore likely to notice these equivalent terms, as they comprise the only word or first word in Applicant's mark and Registrant's mark, respectively." *Id.* Further, the Examining Attorney argues that they are phonetically equivalent and similarity in sound alone may be sufficient to support a finding of confusing similarity.<sup>7</sup>

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<sup>7</sup> The Examining Attorney argues that because Registrant's mark is in standard characters it "could be presented in a similar manner of display as the wording in Applicant's mark." Ex. Att. Brief, 8 TTABVUE 7. This overstates the analysis for standard character marks. While we do consider similar manners of font or display, we do not consider displays with the design elements of the other mark. Applicant's green octagon is a clear point of distinction.

Applicant argues that the dissimilarities engendered by the green colored octagon in Applicant's mark and the use of the word TWELVE in Registrant's mark along with the added word COSMETICS are sufficient to distinguish the marks.

While the word COSMETICS in Registrant's mark is generic for the identified goods, is disclaimed and is less memorable than the word TWELVE, the structure and appearance of Registrant's mark, two words, is very different from Applicant's mark. In contrast, Applicant's mark with its green colored design element, conveys a very different appearance and commercial impression. Taking the marks in their entirety, we find the dissimilarities are sufficient to distinguish the marks given the weak nature of the numeral 12 and the word TWELVE in connection with cosmetics, including skin lotion.

In view thereof, the dissimilarity of the marks weighs against likely confusion.

#### D. Conclusion

In sum, the relatedness of the goods and services and overlap in the trade channels and classes of consumers weigh in favor of likely confusion, but the weakness of the numeral 12 and the word TWELVE in connection with cosmetics, and the dissimilarities in the marks, weigh against likely confusion. In view thereof, we hold that confusion is not likely between Applicant's mark  and Registrant's mark TWELVE COSMETICS.

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