

This Opinion is Not a  
Precedent of the TTAB

Mailed: November 7, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Agave and Phoenix, LLC*

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Serial No. 97504141

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Matthew L. Bycer of Bycer & Marion, PLC,  
for Agave and Phoenix, LLC.

Andrew Chmielarski, Trademark Examining Attorney, Law Office 125,  
Robin Mittler, Managing Attorney.

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Before Lykos, Lynch, and O'Connor,  
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

## I. Background<sup>1</sup>

Agave and Phoenix, LLC (“Applicant”) seeks registration on the Principal Register of the mark AGAVE BLACK (AGAVE disclaimed) in standard characters for the following goods in International Class 3:<sup>2</sup>

Cosmetics; Cosmetic balls; Cosmetic bath salts; Cosmetic cleansing creams; Cosmetic creams; Cosmetic hand creams; Cosmetic masks; Cosmetic massage creams; Cosmetic milks; Cosmetic nail preparations; Cosmetic nourishing creams; Cosmetic oils; Cosmetic pads; Cosmetic powder; Cosmetic preparations; Cosmetic rouges; Cosmetic skin fresheners; Make-up; Make-up foundations; Make-up primer; Make-up remover; Moisturizing body lotions; Moisturizing creams; Moisturizing milk; Moisturizing preparations for the skin; Moisturizing solutions for the

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<sup>1</sup> Citations in this opinion to the briefs and other materials in the case docket refer to TTABVUE, the Board’s online docketing system. *See New Era Cap Co. v. Pro Era, LLC*, Opp. No. 91216455, 2020 TTAB LEXIS 199, \*4 n.1 (TTAB 2020). The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear.

As part of an internal Board pilot citation program on broadening acceptable forms of legal citation, this order 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 order employs citations to the LEXIS legal database and cites only precedential decisions. TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 101.03 (2024). Proceeding and serial numbers also are included for decisions of the Board. Those Board decisions that issued on or after January 1, 2008 may be viewed in TTABVUE by entering the proceeding number, application number, registration number, expungement/reexamination number, mark, party, or correspondent. Many precedential Board decisions that issued from 1996 to 2008 are available through USPTO.gov in the TTAB Reading Room by entering the same information. Most TTAB decisions that issued prior to 1996 are not available in USPTO databases.

<sup>2</sup> Application Serial No. 97504141 was filed July 14, 2022, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s alleged bona fide intent to use the mark in commerce. We note that in its January 18, 2024 Request for Reconsideration at TSDR 14 (downloaded pdf version), Applicant amended the identification of goods to delete “cosmetic sunscreen preparations” and “cosmetic patches containing sunscreen and sun block for use on the skin.” The Examining Attorney’s Brief acknowledges the amendment, and does not state or argue that it was unacceptable. 8 TTABVUE 13. However, the USPTO database was not updated to reflect this amendment. We have not considered the deleted goods part of Applicant’s identified goods for purposes of this appeal.

skin; Non-medicated cosmetics; Non-medicated hair serums; Non-medicated lip balms; Non-medicated lip protectors; Non-medicated skin creams; Non-medicated skin serums; Skin and body topical lotions, creams and oils for cosmetic use; Skin care products, namely, non-medicated skin serum; Skin creams in liquid and solid; Adhesives for cosmetic purposes; Anti-aging cleanser; Anti-aging moisturizer; Astringents for cosmetic purposes; Beauty serums; Facial cleansers; Facial moisturizer with SPF; Facial moisturizers; Fragranced facial moisturizer; Gels for cosmetic purposes; Hair moisturizers; Hand cleansers; Lotions for cosmetic purposes; Non-medicated serums for use on hair, skin, lips; Non-medicated skin care creams and lotions; Non-medicated skin care preparations, namely, creams, lotions, gels, toners, cleaners and peels; Non-medicated skin care preparations, namely, spot treatments and serum; Non-medicated anti-aging serum; Non-medicated preparations all for the care of skin, hair and scalp; Skin cleansers; Skin cleansing cream; Skin moisturizer; Skin moisturizer masks; Wipes impregnated with a skin cleanser; all of the foregoing containing agave as an ingredient.

The Examining Attorney refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a likelihood of confusion with the previously registered standard-character mark BLACK AGAVE ESPECIAL (BLACK AGAVE disclaimed; ESPECIAL translated as “special”) for “Skin care products, namely, suntan lotions, indoor tanning lotion, and skin moisturizers” in International Class 3.<sup>3</sup> After the Examining Attorney made the refusal final, Applicant filed a request for reconsideration and appealed. The Examining Attorney denied reconsideration, and the appeal proceeded. The appeal is fully briefed.

For the reasons set forth below, we affirm the refusal to register.

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<sup>3</sup> Registration No. 5950933 issued December 31, 2019 on the Principal Register.

## **II. Likelihood of Confusion**

Section 2(d) of the Trademark Act prohibits registration of a mark that “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d). The determination under Section 2(d) involves an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (setting forth factors to be considered, hereinafter referred to as “*DuPont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 1315 (Fed. Cir. 2003). A likelihood of confusion analysis often particularly focuses on the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (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.”). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortgage Co.*, 912 F.3d 1376, 1379 (Fed. Cir. 2019).

### **A. The Goods, Trade Channels and Classes of Consumers**

In analyzing the relatedness of the goods under the second *DuPont* factor, we look to the identifications in the application and cited registration. *Octocom Sys. v. Houston Comp. Servs.*, 918 F.2d 937, 942 (Fed. Cir. 1990). The application recites a

substantial list of goods that include the broad category “cosmetics,” as well as more specifically, “facial moisturizer with SPF” and “skin moisturizers,” with all Applicant’s goods described as including agave as an ingredient. The cited registration’s goods overlap with those in the application, at least as to “skin moisturizers,” which is unrestricted and therefore must be construed to encompass all types of skin moisturizers, including those that contain agave. *See, e.g., In re Hughes Furniture Indus., Inc.*, Serial No. 85627379, 2015 TTAB LEXIS 65, \*10 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”); *In re Linkvest S.A.*, Serial No. 74005053, 1992 TTAB LEXIS 48, \*2 (TTAB 1992) (“Registrant’s goods are broadly identified as computer programs recorded on magnetic disks, without any limitation as to the kind of programs or the field of use. Therefore, we must assume that registrant’s services encompass all such computer programs including those which are for data integration and transfer.”).

It is sufficient for a finding of likelihood of confusion as to a single-class application such as this one if relatedness is established for any one of the identified goods within the class. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 1336 (CCPA 1981); *Sage Therapeutics, Inc. v. Sageforth Psych. Servs., LLC*, Opp. No. 91270181, 2024 TTAB LEXIS 139 at \*19 n.41 (TTAB 2024). Thus, the overlap

between Applicant's and Registrant's skin moisturizers alone suffices to demonstrate relatedness under this *DuPont* factor.<sup>4</sup>

Turning to the trade channels, because some of the goods in the cited registration are legally identical to Applicant's goods, we presume that they travel through some of the same channels of trade to some of the same classes of purchasers, considerations under the third *DuPont* factor. *Am. Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, Opp. No. 91190361, 2011 TTAB LEXIS 260, \*14 (TTAB 2011) (where the services were legally identical, "the marketing channels of trade and targeted classes of consumers and donors are the same"); *see also In re Viterra, Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012) (where goods were identical, Board was entitled to rely on this legal presumption in determining likelihood of confusion); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 754 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same).

### **B. Similarity of the Marks**

Under the first *DuPont* factor, we next compare Applicant's mark, AGAVE BLACK, to the cited mark, BLACK AGAVE ESPECIAL "in their entirety as to appearance, sound, connotation and commercial impression." *Palm Bay Imps. 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

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<sup>4</sup> We also note that the Examining Attorney submitted evidence to support the relatedness of other identified goods, offered by third parties under the same marks. *See* 8 TTABVUE 11 (Examining Attorney's Brief, citing evidence).

may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, Serial No. 87075988, 2018 TTAB LEXIS 170, \*13 (TTAB 2018), *aff’d mem.*, 777 Fed. Appx. 516 (Fed. Cir. 2019). We assess not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 1368 (Fed. Cir. 2012).

The Examining Attorney contends that the marks are similar because: they contain the identical words AGAVE and BLACK; the transposition of those terms is not a significant distinction; and the additional term ESPECIAL in the cited mark translates to “special,” and is a weak and laudatory term that also does not significantly distinguish the marks.

Applicant maintains that the marks differ sufficiently to avoid confusion because in the cited mark BLACK AGAVE would be understood to describe the plant source of the products, with a possible double entendre relating to bronzing; BLACK stands out as the first word of the mark; and ESPECIAL is its most distinctive component.<sup>5</sup> Applicant contrasts its mark by arguing, “the transposition of [AGAVE and BLACK] lends a unique commercial impression to Applicant’s Mark,”<sup>6</sup> whereby “the

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<sup>5</sup> 6 TTABVUE 5-7 (Applicant’s Brief).

<sup>6</sup> 6 TTABVUE 5 (Applicant’s Brief).

rearrangement of common terms becomes the mark itself, lending a unique characteristic....”<sup>7</sup>

Applicant asserts in its Brief that in the cited mark, “black agave” refers to “the nature of a seed/ingredient, and the nature of the black-spined agave plant or *black agave plant* from which the product components were sourced.”<sup>8</sup> According to Applicant, therefore, when the terms BLACK and AGAVE appear in that order, consumers perceive a reference to a black agave plant. On the other hand, when the same terms appear in the reverse order in Applicant’s mark, consumers would perceive them differently, with BLACK as “a superlative term” denoting a “version,” allegedly used in the same way as on Johnnie Walker “Black Label.”<sup>9</sup> Applicant’s Brief includes pictures of a Johnnie Walker Black Label bottle next to a box and bottle with “Applicant’s mark label,”<sup>10</sup> shown below.

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<sup>7</sup> 6 TTABVUE 7 (Applicant’s Brief).

<sup>8</sup> 6 TTABVUE 6 (Applicant’s Brief) (emphasis in original).

<sup>9</sup> 6 TTABVUE 9-10 (Applicant’s Brief).

<sup>10</sup> 6 TTABVUE 9. Applicant does not include a record cite for these materials, but they appear very similar (though not identical) to photos embedded in Applicant’s June 14, 2023 Response to Office Action at TSDR 12. The Examining Attorney does not object to these photos, so we have considered them.





Some of Applicant’s assertions about connotation and commercial impression lack solid support in the record. Applicant submitted with its request for reconsideration the file history of the cited registration, indicating that the disclaimer of BLACK AGAVE in the cited registration arose because BLACK described black bronzers and tanning lotions, while AGAVE described an ingredient of the goods.<sup>11</sup> As the Examining Attorney for the cited registration explained it in an Office action: “The evidence [including many third-party uses of “black bronzer”] shows that BLACK AGAVE merely describes the fact that applicant’s tanning products are in the nature of black bronzers made with agave extract.”<sup>12</sup> Thus, the disclaimer was not premised

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<sup>11</sup> January 18, 2024 Request for Reconsideration at TSDR 11-30 (“The evidence [including many third-party uses of “black bronzer”] shows that BLACK AGAVE merely describes the fact that applicant’s tanning products are in the nature of black bronzers made with agave extract”).

<sup>12</sup> *Id.* at TSDR 30.

on a reference to a so-called black agave plant. Also, Applicant separately concedes that in relation to the goods in the cited registration, BLACK refers to “a colorization or darkening ... as the term may be used to describe pigmented or melanized skin tones.”<sup>13</sup> As evidentiary support for the connotation of BLACK AGAVE as a type of plant, Applicant’s Brief points only to a Wikipedia article it submitted on “Agave macroacantha,” also called “the black-spined agave,” which nowhere refers to the plant as “black agave.”<sup>14</sup> By contrast, another Wikipedia article Applicant submitted for the record titled “Blue agave” refers to that plant as “Agave tequilana, commonly called blue agave....”<sup>15</sup> And while we note that the label for the cited Registrant’s bronzer includes: “DARK BRONZING TANNING TEQUILA BLACK AGAVE & HEMP INFUSION,”<sup>16</sup> the reference lacks sufficient clarity as to whether the infusion consists of “agave & hemp” or “black agave & hemp.”

Nor are we persuaded by the Johnnie Walker analogy, as we see no reason that consumers would perceive BLACK in Applicant’s mark in the same way as the “Black Label” on the Johnnie Walker bottle, nor do we have a basis on this record to discern how consumers perceive the Johnnie Walker “Black Label” reference regardless.<sup>17</sup> In

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<sup>13</sup> 6 TTABVUE 9 (Applicant’s Brief). *See also* June 14, 2023 Response to Office Action at TSDR 11.

<sup>14</sup> January 18, 2024 Request for Reconsideration at TSDR 375-77 (wikipedia.org).

<sup>15</sup> *Id.* at 392-94.

<sup>16</sup> *Id.* at 54.

<sup>17</sup> We deny Applicant’s request made in its Reply Brief that the Board take “judicial notice of numerous pervasive uses of colors in superlative, non-descriptive manner [sic], on products in various Classes of goods and services.” 9 TTABVUE 4 n.5. In addition to the untimely nature of the request in a reply brief, we find that the proposed subject matter does not meet the standard under Fed. R. Evid. 201 (judicial notice may be taken of facts not subject to

fact, we find the most notable aspect of Applicant's label shown above to be the prominent use of "Special" (the English translation of the additional term in the cited mark) in close proximity to Applicant's AGAVE BLACK mark. Overall, we remain unconvinced by Applicant's argument that consumers would understand BLACK AGAVE and AGAVE BLACK differently in the respective marks.

Having considered all the arguments and evidence, we find the marks somewhat similar in appearance and sound because of the shared words AGAVE and BLACK, and we find the marks' connotations and commercial impressions very similar. While the additional word in Registrant's mark, ESPECIAL, creates an additional difference between the marks, we find it insufficient to distinguish them significantly.

First, contrary to Applicant's arguments, consumers would attribute the same meaning to, and derive the same general impression from, the wording AGAVE BLACK in Applicant's mark and the wording BLACK AGAVE in the cited mark. "Confusion is likely between two marks [or a mark and part of another mark] consisting of reverse combinations of the same elements if they convey the same meaning or create substantially similar commercial impressions." *Made in Nature, LLC v. Pharmavite LLC*, 2022 TTAB LEXIS 228 (TTAB 2022) (NATURE MADE for various foods and beverages, including snack bars containing dried fruits and fruit juice, likely to be confused with MADE IN NATURE for dried fruits and vegetables, snack products, and fresh fruit). *See also In re Wine Soc'y. of Am. Inc.*, Serial No.

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reasonable dispute because they are generally known or "can be accurately and readily determined from sources whose accuracy cannot reasonably be questioned").

73662515, 1989 TTAB LEXIS 29, \*9 (TTAB 1989) (finding AMERICAN WINE SOCIETY 1967 and design “substantially similar” to THE WINE SOCIETY OF AMERICA, noting “where the sole significant difference between marks applied to similar goods or services is the transposition of the words which compose those marks and where the transposition of words does not change the overall commercial impression, confusion has been found”); *In re Nationwide Indus., Inc.*, Serial No. 73492987, 1988 TTAB LEXIS 19, \*4 (TTAB 1988) (RUST BUSTER for rust-penetrating spray lubricants found to be confusingly similar to BUST RUST for penetrating oil because there was no distinctly different commercial impression) (citing *Bank of Am. Nat’l Trust and Savings Ass’n v. Am. Nat’l Bank of St. Joseph*, 1978 TTAB LEXIS 149, \*9 (TTAB 1978) (BANKAMERICA and BANK OF AMERICA for banking services found to be confusingly similar to AMERIBANC for the identical services)). As discussed above, Applicant’s and Registrant’s goods overlap, and the combination of AGAVE and BLACK, regardless of word order, carries the same meaning and impression in the context of, for example, skin moisturizers, or Applicant’s “cosmetics” and “facial moisturizer with SPF” and Registrant’s indoor tanning lotion/bronzer. Applicant proposes to distinguish the caselaw on transposition as involving marks with “standard modifications to the grammatical structure including prepositions and modification of verb tense,” and that in this case “no such common grammatical modification is included.”<sup>18</sup> We disagree with Applicant’s interpretation of the cases, from which we discern no such guiding

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<sup>18</sup> 6 TTABVUE 8 (Applicant’s Brief).

principle. Instead, we look to whether the transposition changes the meaning or impression, and in this case, it does not.

Second, while the additional word in Registrant's mark, ESPECIAL, adds the nuance of "special" to the cited mark, we find the term highly suggestive and laudatory in this context – not an element that, by itself, consumers would focus on for source-indication. Thus, ESPECIAL does not add to the connotation or commercial impression of the mark in any significant way that distinguishes BLACK AGAVE ESPECIAL from AGAVE BLACK.

To the extent Applicant argues it has a family of marks using the term AGAVE, and points to other applications, the family of marks doctrine is not available to an applicant seeking to overcome a likelihood of confusion refusal in an ex parte proceeding. The focus must be on the mark Applicant seeks to register, not other marks Applicant may have used. *In re Cynosure Inc.*, Serial No. 76653359, 2009 TTAB LEXIS 379, \*5-6 (TTAB 2009); *see also In re Lar Mor International, Inc.*, Serial No. 256334, 1983 TTAB LEXIS 1, \*12-13 (TTAB 1983) (giving "no weight" to a family of marks argument because "the issue before us is the likelihood of confusion of applicant's mark vis-a-vis the registered mark."). Even if the doctrine were applicable here, Applicant has not made the requisite showing.

We also roundly reject Applicant's attempt to collaterally attack the cited registration by arguing that the cited mark is not used in the manner of a mark, but instead "as a descriptor, and not as part of a mark or any indication of source or

origin.”<sup>19</sup> Such attacks cannot be considered in an ex parte appeal, where the registrant lacks the opportunity to participate and defend itself. *In re Dixie Rests.*, 105 F.3d 1405, 1408 (Fed. Cir. 1997). The registration enjoys its presumption of validity. 15 U.S.C. § 1057(b).

The marks overall are similar, particularly as we remain mindful that “marks must be considered in light of the fallibility of memory and not on the basis of side-by-side comparison.” *In re St. Helena Hosp.*, 774 F.3d 747, 751 (Fed. Cir. 2014) (cleaned up). We agree with Applicant that the shared terms AGAVE and BLACK have descriptive significance, which would generally lessen their weight in the analysis. However, where the cited mark consists of BLACK AGAVE ESPECIAL, and Applicant’s mark AGAVE BLACK adds no other element, it is too similar to avoid likely confusion.

### **C. Conclusion**

Where the goods are in-part legally identical, as they are here, the degree of similarity between the marks necessary to support a determination that confusion is likely declines. *Bridgestone Ams. Tire Ops., LLC v. Fed. Corp.*, 673 F.3d 1330, 1337 (Fed. Cir. 2012). In this case, the similarity of the marks for overlapping goods that move in some of the same channels of trade to some of the same classes of customers renders confusion likely. 15 U.S.C. § 1052(d). All the relevant factors favor likely confusion, some heavily so.

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<sup>19</sup> 6 TTABVUE 10 (Applicant’s Brief).

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**Decision:** The refusal to register Applicant's mark is affirmed.