

**THIS OPINION IS NOT A  
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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Galderma S.A.

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Serial No. 77704186

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G. Mathew Lombard and Darren M. Geliebter of Lombard & Geliebter LLP for Galderma S.A.

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Before Mermelstein, Bergsman and Wellington,  
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Galderma S.A. ("applicant") has appealed from the final refusal of the trademark examining attorney to register LIVE LIFE SKIN SMART, in standard character form, for goods and services ultimately identified as follows:

Printed materials, namely, booklets, pamphlets, newsletters in the fields of healthcare and dermatology, in Class 16;

Providing online forums for transmission of messages among computer

users concerning healthcare and dermatology, in Class 38; and

Educational services, namely, providing congresses, conferences, symposia, meetings, forums, seminars and workshops in the fields of healthcare and dermatology, in Class 41.

Applicant disclaimed the exclusive right to use the word "Skin."

Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's mark so resembles the previously registered mark SKINSMART, in standard character form, for "dermatology skin care services," in Class 44,<sup>1</sup> that as used in connection with applicant's identified goods and services, it is likely to cause confusion or mistake or to deceive.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the

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<sup>1</sup> Registration No. 3429170, issued May 20, 2008.

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, 192 USPQ 24, 29 (CCPA 1976).

A. The similarity or dissimilarity and nature of the goods and services described in the application and the services in the registration.

To show that the goods and services are related, the Examining Attorney submitted excerpts from the Internet websites discussed below.

1. Helendale Dermatology & Medical Spa (helendaledermatology.com) is a full service dermatology practice focusing on medical and surgical care of the skin. The Helendale Dermatology & Medical Spa offers an email newsletter in the field of skin health and beauty. This website shows the use of a mark in connection with a dermatology practice and a newsletter.

2. The User Instinct website (userinstinct.com) appears to be a business locator website. This excerpt identifies "Children's Dermatology Services in Wexford, Pennsylvania." It asks readers to write reviews of the company and asks companies, such as Children's Dermatology Services to post press releases on the website noting, however, that the Children's Dermatology Services has not opted to use the website to post press releases. This

website does not show the same mark used in connection with dermatology services and any services listed in the application.

3. The MIMA Dermatology website (mimadermatology.com) excerpt is a newsletter from D. Larry Bishop. Dr. Bishop explains that he is associated with the MIMA practice group. The excerpt also features a gift certificate for MIMA Dermatology. This website shows the use of a mark in connection with a dermatology practice and a newsletter.

4. Search result listings 1-10 from a GOOGLE search engine summary for the search for "'dermatology services' newsletters." The search summary is not probative because it does not provide enough information for a proper analysis. See *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 967, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007) (GOOGLE® search results that provided very little context of the use of ASPIRINA deemed to be "of little value in assessing the consumer public perception of the ASPIRINA mark"); *In re Tea and Sympathy, Inc.*, 88 USPQ2d 1062, 1064 n.3 (TTAB 2008) (truncated search engine results entitled to little probative weight without additional evidence of how the searched term is used); *In re Thomas*, 79 USPQ2d 1021 (TTAB 2006) (Board rejected an applicant's attempt to show

weakness of a term in a mark through citation to a large number of search engine "hits" because the list of results lacked sufficient context); *In re King Koil Licensing Co. Inc.*, 79 USPQ2d 1048 (TTAB 2006); *In re Remacle*, 66 USPQ2d 1222, 1223 n.2 (TTAB 2002); *In re Fitch IBCA Inc.*, 64 USPQ2d 1058 (TTAB 2002).

The Examining Attorney contends that because the goods and services are all in the field of dermatology and skincare, the goods and services are related. However, just because the goods and services are in the same field does not mean that they are related for purposes of the likelihood of confusion analysis. *Cooper Industries, Inc. v. Repcoparts USA, Inc.*, 218 USPQ 81, 84 (TTAB 1983) ("the mere fact that the products involved in this case (or any products with significant differences in character) are sold in the same industry does not of itself provide an adequate basis to find the required 'relatedness'"). See also *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282 (TTAB 2009) (regarding alcoholic beverages); *Information Resources Inc. v. X\*Press Information Services*, 6 USPQ2d 1034, 1038 (TTAB 1988) (regarding computer hardware and software); *Hi-Country Foods Corp. v. Hi Country Beef Jerky*, 4 USPQ2d 1169, 1171 (TTAB 1987) (regarding food products);

*In re British Bulldog, Ltd.*, 224 USPQ 854, 855-56 (TTAB 1984), and cases cited therein (regarding clothing).

Based on the evidence in the record, we find that dermatology skin care services and newsletters in the fields of healthcare and dermatology are related, but that there is no evidence to support a finding that dermatology skin care services and online forums and educational services concerning healthcare and dermatology are related.

B. The similarity or dissimilarity of likely-to-continue trade channels and classes of consumers.

With respect to dermatology skin care services and newsletters in the field of dermatology and skincare, as demonstrated by the Helendale Dermatology & Medical Spa and MIMA Dermatology websites, we find that dermatologists use newsletters to educate patients and to promote their services. Accordingly, we find that dermatology skin care services and associated newsletters move in the same channels of trade to the same classes of consumers.

However, with respect to online forums and educational services concerning healthcare and dermatology, there is no evidence to suggest that those services would be marketed under circumstances likely to give rise to the mistaken belief that they emanate from the same source as dermatology skin care services: that is, there is no

evidence of dermatology practices offering educational services to lay persons in the field of dermatology or providing online forums for transmission of messages among computer users concerning healthcare and dermatology. For example, the educational services are specifically for providing congresses, conferences, symposia, meetings, forums, seminars and workshops in the fields of healthcare and dermatology. Although not expressly limited to professionals, these services do not appear to be directed to lay persons.

C. The strength of the term SKINSMART.

A major part of our consideration of whether the similarity of the marks factor favors a likelihood of confusion is the strength of the mark in the cited registration. The marks are similar to the extent that they both share the term "Skin Smart" and applicant's mark incorporates the entirety of registrant's mark. However, applicant contends that the weakness of the term "Skin Smart" coupled with the addition of the term LIVE LIFE is sufficient to distinguish the marks.

In order to show that the registrant's mark SKINSMART is weak, applicant has submitted the following evidence attached to its January 15, 2010 response:

1. An excerpt from the Skin Smart Dermatology website (skinsmartderm.com). "Skin Smart Dermatology" is a service mark used by Dr. Toby Shawe, M.D., to identify his practice in Wyndmoor and Philadelphia, Pennsylvania.

2. The listing of the dermatology practice of Samy Badawy, MD., dba, Skinsmart Dermatology located in Glendale, Pennsylvania at Yahoo! search engine directory. Glendale is a suburb of Pittsburgh.

3. An excerpt from the Skin Smart Salon website (skinsmartsalon.com). The Skin Smart Salon is located in Ashland, Massachusetts and specializes in skin care.

4. An excerpt from the Smart Skin Spa & Salon (smartskinspasalon.com) website. Smart Skin Spa & Salon is located in Prattville, Alabama and specializes in skin care.

5. A listing of skin care service providers in North Carolina in the iLookBetter.com website. The list identifies Skin Smart located in Rocky Mount, North Carolina.

6. An excerpt from the Cooperlabs website (cooperlabs.com) advertising CABOT skin moisturizer using the advertising line "Skin Smart Solutions ... for healthy skin."

7. An excerpt from the Coleman website (coleman.com) advertising SKINSMART insect repellent. There was also a review about this product in the SNEWS website (snewsnet.com).

8. An excerpt for the Apotek website (apotecksmartskin.com) advertising APOTEK SMART SKIN "anti-aging skincare product."

9. An advertisement for the sale of PRESTIGE Light Response Skin Smart Liquid Foundation in the Beauty Encounter website (beautyencounter.com).

10. An excerpt from the ST. TROPEZ anticancer website (sttrophezskinsmart.org) regarding its St. Tropez SkinSmart Campaign promoting awareness of the dangers of tanning beds.

11. An article published by the University of Southern California in its online publication "USC Health Now" (healthnow.usc.edu) entitled "Skin Smart." The subject of the article is skin cancer awareness.

12. An article appearing the *Medical News Today* website (medicalnewstoday.com) entitled "Skin Smart - Protecting Yourself Against Melanoma." The website appears to be a website in the field of dermatology and skin care. This article is also referenced in an excerpt from the Skin Clinics website (skinclinics.net).

13. An excerpt from the American Federation for Aging Research website (afar.org). This excerpt features an article entitled "Skin Smart Seniors Are Safe Year-Round" regarding skin cancer awareness.

14. An excerpt from a book entitled The Complete Idiot's Guide to Beautiful Skin retrieved from GOOGLE Books (books.Google.com). The authors use the term SKIN SMART to identify inserts with tips regarding skin care.

15. An abstract for an article entitled "Skin smart: common sense advice for warding off winter's bite" in an unidentified website (faqs.org).

16. An article entitled "Skin-smart diet-Brief Article" in the BNET website (findarticles.com) regarding the proper diet for improving your complexion.

17. A list of articles regarding skin care from the website SmartSkinCare.com, a website dedicated to helping people find information about skin care.

We find from the evidence of third-party use that the term "Skin Smart" is highly suggestive when used in connection with skin care products and services because it implies or suggests intelligent skin management.

Accordingly, with respect to the inherent strength of registrant's mark, the cited registration is not entitled to a broad scope of protection because it is highly

suggestive. However, as the examining attorney has pointed out, even suggestive or weak marks are entitled to protection from the use of a very similar mark for related services. See *In re Chica Inc.*, 84 USPQ2d 1845, 1850 (TTAB 2007), quoting *In re Colonial Stores*, 216 USPQ 793, 795 (TTAB 1982):

[I]f the word CORAZON, and its English translation, was considered to be highly suggestive of jewelry, it nonetheless is entitled to protection from the use of a very similar mark on jewelry products. "[E]ven weak marks are entitled to protection against registration of similar marks, especially identical ones, for related goods and services."

With respect to the marketplace strength of the term "Skin Smart," applicant has made of record evidence of five third parties using the term "Skin Smart" in connection with dermatology services or spa services and four third-party uses for skin care products. Widespread and significant use by third parties of marks containing elements in common with the mark in the cited registration may indicate that confusion is not, in reality, likely to occur in the marketplace. Extensive third party use suggests that consumers will look to other elements as a means of distinguishing the source of the goods and services. *In re Broadway Chicken, Inc.*, 38 USPQ2d 1559,

1565-66 (TTAB 1996). By relying on such third-party use, applicant is asserting that small variations in the SKIN SMART marks used in connection with different skin care goods and services are sufficient to avoid confusion.

With respect to the dermatology practices and spa services, the Internet evidence indicates that these service providers are local in nature. Thus, the relevant patients/clients may not have encountered multiple "Skin Smart" dermatology practices or spas so as to condition them to look to other elements of the marks or trade names to distinguish their source.

With respect to the "Skin Smart" products identified by the Internet evidence, applicant has not provided any evidence regarding the extent of such use by these third parties. As the Court of Appeals for the Federal Circuit, our primary reviewing court has previously held, where the "record includes no evidence about the extent of [third party] uses ... [t]he probative value of this evidence is ... minimal." *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557, 1561 (Fed. Cir. 2001).

The evidence of third-party use is insufficient for us to find that consumers are so used to seeing marks containing the term "Skin Smart" for skin care products and services of the types identified in applicant's application

and the cited registration that the additional wording, in this case LIVE LIFE, necessarily causes consumers to look to the additional wording to distinguish the marks.

- D. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 9 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). In comparing the marks, we are mindful that the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods and services offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir.

June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than a specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

As noted, the cited mark is SKINSMART and applicant's mark is LIVE LIFE SKIN SMART. Thus, applicant incorporates the entire registered mark. Likelihood of confusion is often found where the entirety of one mark is incorporated within another. *The Wella Corp, v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design for men's cologne, hair spray, conditioner and shampoo is likely to cause confusion with the mark CONCEPT for cold permanent wave lotion and neutralizer); *Coca-Cola Bottling Co. v. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105, 106 (CCPA 1975) (BENGAL LANCER and soldier design for club soda, quinine water and ginger ale is likely to cause confusion with BENGAL LANCER for gin); *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558 (CCPA 1972) (WEST POINT PEPPERELL and griffin design for fabrics is likely to cause confusion with WEST POINT for woolen piece goods).

We are not persuaded that the addition of the term LIVE LIFE to applicant's mark is sufficient to differentiate applicant's mark from the registered mark in any meaningful way. The composite mark LIVE LIFE SKIN SMART conveys the message "live your life with intelligent skin care." Thus, the marks have similar connotations and engender a similar commercial impression in that they both convey the message of intelligent skin care.

In view of the foregoing, we find that the marks are similar in terms of appearance, sound, meaning and commercial impression.

E. Balancing the factors.

In view of the similarity of the marks, goods and services, channels of trade and classes of consumers, we find that applicant's mark LIVE LIFE SKIN SMART for printed materials, namely, booklets, pamphlets, newsletters in the fields of healthcare and dermatology so resembles the mark SKINSMART for "dermatology skin care services" as to be likely to cause confusion. However, the record lacks any evidence regarding the relationship, channels of trade and classes of consumers with respect to "providing online forums for transmission of messages among computer users concerning healthcare and dermatology" and "educational services, namely, providing congresses, conferences,

symposia, meetings, forums, seminars and workshops in the fields of healthcare and dermatology" in the application and "dermatology skin care services" in the cited registration. Therefore, we find that applicant's mark LIVE LIFE SKIN SMART for the services set forth in Classes 38 and 41 are not likely to cause confusion with the mark SKINSMART for "dermatology skin care services."

**Decision:** The refusal of register the mark in connection with the goods in Class 16 is affirmed.

The refusal to register the mark in connection with the services in Classes 38 and 41 is reversed.