

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85121480
LAW OFFICE ASSIGNED	LAW OFFICE 102
MARK SECTION (no change)	
ARGUMENT(S)	
Please see the actual argument text attached within the Evidence section.	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_381008235-185314213_.FINGERNAILS_Request_for_Reconsideration_and_Notice_of_Appeal.pdf
CONVERTED PDF FILE(S) (9 pages)	\\TICRS\EXPORT11\IMAGEOUT11\851\214\85121480\xml7\RFR0002.JPG
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ORIGINAL PDF FILE	evi_381008235-185314213_.In_re_Gastroceuticals.pdf
CONVERTED PDF FILE(S) (14 pages)	\\TICRS\EXPORT11\IMAGEOUT11\851\214\85121480\xml7\RFR0011.JPG
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DESCRIPTION OF EVIDENCE FILE	PDF #1 - Request for Reconsideration Argument and Notice of Appeal; PDF #2 - TTAB decision - In re Gastroceuticals
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Paul W. Garrity/
SIGNATORY'S NAME	Paul W. Garrity
SIGNATORY'S POSITION	Attorney of Record; New York State Bar member
SIGNATORY'S PHONE NUMBER	212-634-3057
DATE SIGNED	01/13/2012
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO
FILING INFORMATION SECTION	
SUBMIT DATE	Fri Jan 13 19:05:24 EST 2012
TEAS STAMP	USPTO/RFR-38.100.8.235-20 120113190524575366-851214 80-490e92234693ec7ba604d4

Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **85121480** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

Please see the actual argument text attached within the Evidence section.

EVIDENCE

Evidence in the nature of PDF #1 - Request for Reconsideration Argument and Notice of Appeal; PDF #2 - TTAB decision - In re Gastroceuticals has been attached.

Original PDF file:

[evi_381008235-185314213_. FINGERNAILS Request for Reconsideration and Notice of Appeal.pdf](#)

Converted PDF file(s) (9 pages)

[Evidence-1](#)

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Original PDF file:

[evi_381008235-185314213_. In re Gastroceuticals.pdf](#)

Converted PDF file(s) (14 pages)

[Evidence-1](#)

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[Evidence-10](#)

[Evidence-11](#)

[Evidence-12](#)

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SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Paul W. Garrity/ Date: 01/13/2012

Signatory's Name: Paul W. Garrity

Signatory's Position: Attorney of Record; New York State Bar member

Signatory's Phone Number: 212-634-3057

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85121480

Internet Transmission Date: Fri Jan 13 19:05:24 EST 2012

TEAS Stamp: USPTO/RFR-38.100.8.235-20120113190524575

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of)	Examining Attorney:
)	
Coty US LLC)	Dominic J. Ferraiuolo
)	
Serial No.: 85/121,480)	Trademark Law Office: 102
)	
Filed: September 2, 2010)	
)	
For: FABULOUS FINGERNAILS)	
)	

REQUEST FOR RECONSIDERATION

Hon. Asst. Comm. For Trademarks
United States Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

Sir:

This Request for Reconsideration concerns the Final Office Action mailed on July 14, 2011 (the “Final Office Action”). Applicant has filed concurrently herewith a Notice of Appeal, appealing the referenced Final Office Action. A copy of the Notice of Appeal is submitted herewith for the Examining Attorney’s convenience.

The Examining Attorney has issued a final refusal to register Applicant’s mark FABULOUS FINGERNAILS in International Class 008 on the grounds that the mark, when used on or in connection with the identified goods, may be likely to cause confusion with the cited registration, FABEAULOUS (U.S. Reg. No. 3,683,893). *See* Final Office Action.

Applicant respectfully disagrees with the Examining Attorney’s conclusion and requests reconsideration of the Examining Attorney’s decision of final refusal.

I. APPLICANT’S MARK “FABULOUS FINGERNAILS” IS NOT LIKELY TO CAUSE CONFUSION WITH REGISTERED MARK “FABEAULOUS”

A. Comparison of the Marks

The Federal Circuit has instructed that in determining the similarity or dissimilarity of the marks, the Examining Attorney must compare the marks in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot*

Ponsardin Maison Fondée En1772, 73 USPQ2d 1689 (Fed. Cir. 2005). 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 their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *In re White Rock Distilleries, Inc.*, 92 USPQ2d 1282 (TTAB 2009).

Applicant maintains that its mark FABULOUS FINGERNAILS and the registered mark FABEAULOUS are sufficiently different in their appearance, sound, connotation and overall commercial impressions so as to prevent confusion regarding source of the goods offered. It is well established that there is no rule that confusion is automatically likely simply because marks share common elements. *See Colgate-Palmolive Company v. Carter Wallace Inc.*, 167 U.S.P.Q. 529, 530 (C.C.P.A. 1970) (PEAK PERIOD for personal deodorants not confusingly similar to PEAK for dentifrice); *Lever Brothers Company v. The Barcolene Company*, 174 U.S.P.Q. 392 (CCPA 1972) (ALL CLEAR for household cleaner not likely to cause confusion with ALL for same goods).

1. The Marks Are not Phonetically Similar, and Any Potential Phonetic Similarity Between the Marks Should Be Given Minimal Weight.

Applicant respectfully maintains that the appearance of the constructed word “FABEAULOUS” sufficiently differs from FABULOUS given the addition of the letters “e” and “a” to the familiar term FABULOUS; grammatical construction of such a coined term would result in it being pronounced as “fa-how-lous,” whereas Applicant’s mark is FABULOUS FINGERNAILS with the term FABULOUS pronounced “fa-bu-lous.” The Examining Attorney states that “the marks in question could clearly be pronounced the same; such similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar.”

First, Applicant respectfully disagrees with the assessment that the marks “clearly could be pronounced the same.” Second, Applicant submits that even if FABULOUS and FABEAULOUS could be could have a similar pronunciation, the marks, considered as a whole as they must be, are sufficiently different their appearance to overcome any phonetic parallel. When marks are conspicuously different in their spelling, that visual difference can outweigh any potential phonetic resemblance in the similarity of the marks analysis. *See In re Gastroceuticals, LLC*, Serial No. 77527093 (T.T.A.B. Sept. 2, 2010) (decision attached) (finding the standard character marks at issue for beverage products, ROOBI and RUBYY, sufficiently different in appearance, despite letters in common, because the letters unique to each mark created terms which were “visually distinct from one another,” with the differences in appearance and connotation outweighing any similarity in sound). Here, FABULOUS FINGERNAILS and FABEAULOUS are sufficiently visually distinct from one another in their spelling and word count, and provide different connotations, so as to outweigh any potential phonetic similarity.

2. The Examining Attorney Gave Improper Weight to One Component of the Marks at the Expense of the Overall Impression of the Respective Marks.

The Examining Attorney states that “[t]he addition of the descriptive term ‘fingernail’ [sic] in the Applicant’s mark . . . does not sufficiently differentiate these marks due to the strong

commercial impression created by the wordings FABEAULOUS and FABULOUS in both marks.” However, TMEP § 1207.01(b)(iii) points out that there are exceptions to the general rule that mere addition of terms to a mark generally does not obviate the similarity between the marks, including when the marks in their entireties convey significantly different commercial impressions. *See* TMEP § 1207.01(b)(iii). Indeed, “[w]hile there are often discrete terms in marks that are more dominant and, thus, more significant to the assessment of similarity, the law forbids the type of dissection proposed by” the Examining Attorney in this instance. *See Shen Mfg. Co. v. Ritz Hotel Ltd.*, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004). “It is well settled that marks must be considered in their entireties, not dissected or split into component parts and each part compared with other parts. It is the impression created by the involved marks, each considered as a whole, that is important.” *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1601 (TTAB 2011). Under the trademark anti-dissection rule, “the commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail.” *Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545-46, 40 S.Ct. 414, 416-17, 64 L.Ed. 705 (1920).

Applicant respectfully submits that the Examining Attorney has focused too intensely on only the FABEAULOUS and FABULOUS components of the respective marks, at the expense of giving proper consideration to the more important overall distinct impressions conveyed by Applicant’s mark FABULOUS FINGERNAILS and the registered mark FABEAULOUS. Indeed, comparison of component parts of conflicting marks, if used, should only be a “as a preliminary step on the way to an ultimate determination of probable customer reaction to the conflicting composites as a whole.” *See* Thomas McCarthy, *Trademarks and Unfair Competition* §23:41 (4th Ed. 2002) (emphasis added).

In *Shen Mfg.*, the Federal Circuit compared the marks RITZ and PUTTING ON THE RITZ, and concluded that despite RITZ being the dominant part of both marks, PUTTING ON THE RITZ, when evaluated as a whole, conveyed a strong commercial impression distinct from that of simply RITZ. 73 USPQ2d at 1354. The Federal Circuit reasoned that PUTTING ON THE RITZ,

conjures images of fancy, even swanky, ladies in full length gowns and gentlemen in tails and top hats congregating in a large Art Nouveau restaurant where an orchestra is about to start. This image, one of comfort, sophistication and wealth, resonates strongly with the buying public, leaving them with an impression unlike that from [the] RITZ mark, which, when used on kitchen textiles, invokes images, if any, of cleaning, cooking or manual labor generally. The two marks also differ in terms of sound and appearance.

Id.; *see also Kellogg Co. v. Pack'em Enters.*, 951 F.2d 330, 332-33, 21 USPQ2d 1142 (Fed. Cir. 1991) (“substantial and undisputed differences” between parties’ use of FROOTEE ICE and FROOT LOOPS warranted summary judgment for federal registration applicant in opposition proceeding; “the dissimilarity of the marks in their entireties itself made it unlikely that confusion would result from the simultaneous use of the marks”) (internal quotation marks omitted). In the same way, the dissection of the FABULOUS FINGERNAILS mark is improper because of the distinctly different impression the entire mark conveys from that of simply FABEAULOUS.

The differences in appearance, overall sound, and connotations between FABEAULOUS and FABULOUS FINGERNAILS are sufficient to prevent consumer confusion, even if the identified arguably goods fall within the same broad category of products. *See Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459 (Fed. Cir. 1998) (CRISTAL for champagne not likely to cause confusion with CRYSTAL CREEK for wine in view of differences between the marks in sound, appearance, meaning and commercial impression).

In *Champagne Louis Roederer*, the Federal Circuit affirmed the TTAB's finding that the word marks "CRISTAL" and "CRYSTAL CREEK" evoked different images in the minds of relevant consumers: while the former suggested the clarity of the wine within the bottle or the glass of which the bottle itself was made, the latter suggested "a very clear (and hence probably remote from civilization) creek or stream." 148 F.3d at 1375. In the same way, FABEAULOUS and FABULOUS FINGERNAILS convey different ideas. Standing alone, the mark FABEAULOUS (a coined or intentionally misspelled mark, just like CRISTAL) suggests the superlative physical quality of its "pedicure instrument" products; that is, its pedicure instruments are superb in their craftsmanship and capabilities. Quite differently, FABULOUS FINGERNAILS suggests the stunning appearance and sensation of one's fingernails from use of Applicant's manicure kits. Similar to the way in which CRYSTAL modified CREEK in the mark CRYSTAL CREEK, the word FABULOUS in Applicant's mark is used as a modifier of FINGERNAILS to describe the look and feeling of one's fingernails, a part of the human body, as well as the feeling one derives from the nails' positive appearance after use of Applicant's product. Thus, each mark projects different connotations from its unique use of the allegedly common term, "fabulous." In short, the commercial impressions from FABULOUS FINGERNAILS and FABEAULOUS are quite distinct, and when combined with the overall differences in sound and appearance of the marks, lead to the conclusion that the marks are indeed not sufficiently similar for a likelihood of confusion.

B. Comparison of the Goods

Applicant maintains that the respective goods herein, and their respective trade channels, are not closely related, eliminating any possibility that a likelihood of confusion could result. The cited registration identifies as its goods, "pedicure instruments, namely, disposable electrically driven pedicure tool in the nature of cuticle pushers and nail files." These goods are significantly different from Applicant's listed manicure kits.¹

¹ As noted in Applicant's initial response, it is well-settled that "there can be no rule that certain goods or services are per se related," TMEP §1207.01(a)(iv), let alone that goods are related merely because they both can be identified in a single registration or both classified as nail care products. *See, e.g. Information Resources, Inc. v. X*Press Information Services*, 6 U.S.P.Q.2d 1034, 1038 (T.T.A.B. 1988) (regarding computer hardware and software); *Hi-Country Foods Corp. v. Hi Country Beef Jerky*, 4 U.S.P.Q.2d 1169, 1171 (T.T.A.B. 1987) (regarding food products); *In re Quadram Corp.*, 228 U.S.P.Q. 863, 865 (T.T.A.B. 1985) (regarding computer hardware and software); *In re British Bulldog, Ltd.*, 224 U.S.P.Q. 854, 855-56 (T.T.A.B. 1984), and cases cited therein (regarding clothing). Furthermore, the Federal Circuit ruled against such sweeping conclusions in *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 21 U.S.P.Q.2d 1388, 1391 (Fed. Cir. 1992) and there cautioned that confusion may not be likely even when "the two parties conduct business not only in the same fields but also with some of the same companies" if the actual persons who make purchasing decisions are not confused.

The Examining Attorney focuses on the fact that both “nail files” and “cuticle pushers” are listed in the identified goods of Applicant’s mark and the registered mark, at the expense of focusing on the fact that the registered mark is really for “pedicure instruments” and Applicant’s mark is really for “manicure kits.” In other words, the Examining Attorney has in essence ignored the words “consisting of” an “in the nature of” in Applicant’s and registrant’s respective goods listings, and simply substituted the word “and.” Applicant respectfully submits that the Examining Attorney has made the assumption that because some of the listed items in the two descriptions are identical, that the registrant’s professional “pedicure instruments, namely, disposable electrically driven pedicure tool” and Applicant’s “manicure kits” would travel through identical channels of commerce. Simply because there is overlap of named products between two different categories of goods does not mean there will be consumer confusion. The Examining Attorney has failed to provide evidence of “manicure kits” and “pedicure instruments” being offered under the same mark in the same trade channel.

In determining whether there is a likelihood of confusion between two marks, one cannot stop at just a comparison of the similarity of the items listed and assume similar channels of trade. One must analyze and compare the identity of retail outlets and purchasers as well as the similarity of advertising media used. *La Dove Inc. v. Playtex Jhirmack Inc.*, 19 USPQ (BNA) 1149 (S.D. Fla. 1991). The goal of such comparisons is to determine if there would be an overlap in marketing channels that would significantly add to the likelihood of consumer confusion. *Wynn Oil Co. v. Thomas*, 5 USPQ (BNA) 1944 (6th Cir. 1988).

In *La Dove Inc. v. Playtex Jhirmack Inc.*, 19 USPQ (BNA) 1149, 1152 (S.D. Fl. 1991), the court ruled against a finding of likelihood of confusion between the mark FAST FREEZE for hair care products, and FAST FREEZE, also for hair care products, partially basing its ruling on the fact that “[t]he products were sold in different channels of trade. Playtex sells to retail public through mass merchandisers such as Eckerd’s, whereas La Dove product is sold exclusively through a relatively small number of salons. There is no overlap. The two products are not advertised in any of the same media.”

Applicant respectfully submits that the evidence proffered by the Examining Attorney is insufficient to demonstrate that the trade channels for the identified goods are closely related enough to support a likelihood of confusion. A closer examination of the Examining Attorney’s website evidence shows that while the Examining Attorney has included a plethora of websites showing sales of nail or cuticle scissors, the Examining Attorney has failed to provide evidence of “manicure kits” being sold alongside professional “pedicure instruments, namely, disposable electrically driven pedicure tool” under the same mark. The closest that the proffered evidence comes is a “Pedinova Electric Pedicure Kit” described as a “Manicure/Pedicure Machine.” Applicant submits that this singular “all-in-one” product is insufficient to demonstrate a marketplace practice of “manicure kits” being sold alongside professional “pedicure instruments, namely, disposable electrically driven pedicure tool” under the same mark. The next closest that the proffered evidence comes is screenprints from www.sallybeauty.com of items under a “New Manicure & Pedicure Products” header. However, none of the goods listed on those screenprints are listed as “manicure kits” or professional “pedicure instruments, namely, disposable electrically driven pedicure tool,” nor are there any “pedicure” or “manicure” products listed

under the same mark, nor are even the at-issue-marks' common articles "nail files" and "cuticle pushers" listed. Applicant maintains that simply because both "manicure kits" and professional "pedicure instruments, namely, disposable electrically driven pedicure tool," may fall under the same broad header of "nail/foot/hand care products," confusion is still not likely where the goods are used for different purposes and there is not sufficient evidence of the same channels of trade. *See Astra Pharmaceuticals Prods. v. Beckman Instruments*, 220 USPQ (BNA) 609 (D. Mass. 1983) (in which the use of the same mark "ASTRA" by two parties, one in connection with pharmaceuticals, the other in connection with clinical laboratory reagents, was held *not* to result in a likelihood of confusion, because the goods were used for different purposes and sold through different channels of trade).

In the alternative, even if the Examining Attorney insists that the marks' identified goods, professional pedicure instruments and manicure kits, are related or may potentially travel in the same channels of trade, if the marks are sufficiently different in meaning, the goods' similarity does not compel a likelihood or confusion. *In re Sydel Lingerie Co., Inc.*, 197 USPQ 629 (TTAB 1997) (BOTTOMS UP for ladies' and children's underwear held not likely to be confused with BOTTOMS UP for men's clothing, the Board finding that the term connotes the drinking phrase "Drink Up" when applied to men's suits, coats, and trousers, but does not have this connotation when applied to ladies' and children's underwear, notwithstanding the fact that the goods traveled in the same channels of trade, specifically clothing stores); *see also, e.g., In re Sears, Roebuck & Co.*, 2 USPQ2d 1312 (TTAB 1987) (CROSS-OVER for bras held not likely to be confused with CROSSOVER for ladies' sportswear, the Board finding that the term was suggestive of the construction of the applicant's bras, but was likely to be perceived by purchasers either as an entirely arbitrary designation or as being suggestive of sportswear that "crosses over" the line between informal and formal wear when applied to ladies sportswear). Thus, given the different connotations conveyed by FABULOUS FINGERNAILS and FABEAULOUS discussed above, the simple fact that both marks have identified nail care goods does not support a likelihood of confusion.

II. CONCLUSION

Applicant has demonstrated that its mark FABULOUS FINGERNAILS, when applied to its identified goods, is not subject to the same interpretations as registered mark FABEAULOUS (U.S. Reg. No. 3,683,893) when applied to its respective named goods. Nor are the marks' goods and respective trade channels the same, so there is not a likelihood of confusion. Applicant therefore submits that the objection to the FABULOUS FINGERNAILS mark should be withdrawn.

DATED: January 13, 2011

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

By /Paul W. Garrity/

PAUL W. GARRITY
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In re application of
Coty US LLC
Serial No.: 85/121,480
Filed: September 2, 2010
For: FABULOUS FINGERNAILS

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Applicant Coty US LLC hereby appeals to the Trademark Trial and Appeal Board from the decision of the Trademark Examining Attorney refusing registration based on the likelihood of confusion in the above-identified application.

The Commissioner is authorized to charge [credit card information provided via TTAB website] in the amount of \$100 for the requisite fee under 37 C.F.R. § 2.6(a)(18) to appeal the decision in International 41 and for any additional fees required.

A request for reconsideration is being filed concurrently with this notice of appeal and Applicant respectfully requests that the appeal be suspended pending the Examining Attorney's reconsideration of this application.

DATED: January 13, 2011

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

By /Paul W. Garrity/
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THIS OPINION IS NOT
A PRECEDENT OF
THE TTAB

Mailed: September 2, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Gastroceuticals, LLC

Serial No. 77527093

Max Moskowitz and Sean P. McMahon of Ostrolenk Faber LLP
for Gastroceuticals, LLC.¹

Natalie Polzer², Trademark Examining Attorney, Law Office
108 (Andrew Lawrence, Managing Attorney).

Before Hairston, Kuhlke and Taylor, Administrative
Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Gastroceuticals, LLC has filed an application to
register on the Principal Register the mark ROOBI (in
standard character form) for goods ultimately identified as
"drinking water enhanced with antioxidants" in
International Class 32.³

¹ Applicant was represented by other counsel prior to its filing
of the request for reconsideration.

² A different examining attorney represented the Office prior to
briefing.

³ Serial No. 77527093, filed July 21, 2008, and alleging a bona
fide intention to use the mark in commerce.

Ser No. 77527093

Registration has been refused on the ground that there is a likelihood of confusion with the mark in U.S. Registration No. 3415865, RUBYY (in standard characters), for "Energy drinks, Non-alcoholic beverages containing fruit juices" in International Class 32.⁴

When the refusal was made final, applicant appealed and requested reconsideration. The examining attorney denied the request for reconsideration on September 21, 2009 and this appeal resumed on October 5, 2009. Both applicant and the examining attorney filed briefs. We reverse.

Before we begin our likelihood of confusion analysis, we must discuss an evidentiary matter. The examining attorney has objected to a printout of search results retrieved from the Trademark Electronic Search System (TESS), and made of record with applicant's request for reconsideration, on the ground that the mere submission of a list of registrations does not make such registrations a part of the record.⁵ Applicant responded to the objection, arguing that the search report was obtained from the U.S.

⁴ Issued April 22, 2008.

⁵ The printout is of a list of 100 live registrations that were obtained by the search strategy ((bottled)ADJ(water))[GS] and (live)[LD] and 'RD>"18000101.'" The printout also indicated that 692 records satisfied the query.

Ser No. 77527093

Patent and Trademark Office (USPTO) website and not a private company, and introduced not to make the listed third-party registrations of record but to demonstrate the "sheer number" of marks that the USPTO has registered for bottled water.

We will consider the printout properly of record for that limited purpose, and overrule the examining attorney's objection to that extent. We hasten to point out that the report is of little to no probative value. As applicant notes, the TESS printout indicates 692 records were found that satisfy its search query. However, the report merely shows that "bottled water" is a recited term in the goods/services description of the found records. We can not ascertain how the term "bottled water" is used in those identifications, including those of the 100 registrations listed on the report.⁶ As such, and contrary to applicant's contention, the report does not necessarily identify registrations of marks for "bottled water," per se.

Turning now to the merits of the appeal, our determination of the issue of likelihood of confusion is

⁶ To elaborate, the term "bottled water" may only describe a component of the identified goods and services, e.g., as part of a survival kit, goods distributed by a distribution service or sold in wholesale or retail stores.

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 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are 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, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We first consider the *du Pont* factor of the relatedness of the goods. It is settled that the question of likelihood of confusion must be determined based on an analysis of the goods recited in applicant's application vis-à-vis the goods recited in the cited registration. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ 2d 1715 (TTAB 1991). Further, it is a general rule that the goods do not have to be identical or directly competitive to support a finding that there is a likelihood of confusion. It is sufficient if the respective goods are related in some manner and/or

that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used in connection therewith, give rise to the mistaken belief that they emanate from or are associated with a single source. In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785 (TTAB 1993); In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

In this case we compare applicant's drinking water enhanced with antioxidants with registrant's "energy drinks; non-alcoholic beverages containing fruit juice." Applicant argues that "[b]ecause Registrant sells energy drinks and fruit juices used as a cocktail mixer, whereas applicant sells drinking water with natural antioxidants, with no added flavor, the goods are not sufficiently related to cause confusion in the crowded field of RUBY marks for beverages." Br. p. 10.

Applicant also essentially maintains that the goods are functionally different; energy drinks consumed to increase mental alertness and physical performance and water, including water enhanced with antioxidants, consumed to restore one's water levels or to quench one's thirst.⁷

⁷ Applicant's Request for Reconsideration, Exh. F, G, and K.

The examining attorney conversely maintains that applicant's drinking water is closely related to the registrant's energy drinks and fruit juice drinks because they are similar in nature, are the type of beverages that commonly emanate from a single source, and are marketed and sold together within the beverage industry. The examining attorney has supported this position with printouts of seven third-party registrations for marks used in connection with the goods of the type identified in both the application and the cited registration, i.e., energy drinks or fruit drinks vis-à-vis drinking water and/or antioxidant drinks as well as one for antioxidant drinks, including fruit juices.⁸ Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. In re Albert Trostel & Sons Co., *supra*.

The registrations are as follows:

Registration No. 3229753 for, inter alia,
drinking water and energy drinks;

⁸ We consider the broadly worded "drinking water" listed in the referenced registrations to include drinking water enhanced with antioxidants.

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Registration No. 3532485 for inter alia, drinking water, energy drinks and non-alcoholic beverages containing fruit juice;

Registration No. 3420462 for, inter alia, energy drinks and drinking water, lithia water and mineral water;

Registration No. 3420521 for, inter alia, non-alcoholic beverages, namely, fruit flavored beverages and fruit juices and drinking water;

Registration No. 3438203 for, inter alia, energy drinks and bottled water;

Registration No. 3390462 for, inter alia, drinking water and energy drinks;

Registration No. 3417172 for, inter alia, liquid anti-oxidant drinks derived from and containing hibiscus extracts and plant extracts and non-alcoholic beverages containing fruit juice; and

Registration No. 3135476 for, inter alia, liquid dietary supplement with antioxidant properties containing pomegranate juice, pear juice and mangosteen.

The examining attorney has also introduced various internet evidence to support her position that the goods are related, including:

- 1) a press release from Advanced Beverage Technologies Corporation ("ABT") indicating its intent to compete in the energy drink and bottled water markets;⁹

⁹ www.prlog.org/10065334-abt-to-compete...

- 2) an excerpt from the website
www.coffeeforall.com showing the sale of energy
drinks and fortified water together on various
pages of the website;
- 3) pages from the website of HYDRIVE Energy
describing the product HYDRIVE X as one that
includes antioxidants - Triple Berry is loaded
with 6 powerful antioxidants ... Antioxidants are
substances that protect against the effects of
free radicals...;¹⁰ and
- 4) pages from the website of the SNAPPLE brand
showing the brand used on antioxidant water
drinks and fruit juices.¹¹

Despite some evidence that registrant's energy drinks and fruit beverages and applicant's antioxidant enhanced drinking water may serve different functions, the record clearly demonstrates that the bottled water and energy drink markets overlap, that single entities sell in both markets, that consumers will see the same marks used on both antioxidant supplements and juice drinks and that energy drinks and fortified waters are sold in close proximity to each other. The record also shows that energy

¹⁰ <http://www.hydriveenergy.com/flavors.cfm?productid=1011>.

¹¹ <http://www.snapple.com>.

drinks can include antioxidants. Under these circumstances, we find the goods related for purposes of our likelihood of confusion analysis.¹²

Further, in the absence of any limitations in the application and the cited registration as to channels of trade and classes of purchasers, we must presume that the respective goods travel in all the usual trade channels for such goods, including supermarkets, and to all usual classes of consumers for such goods, including ordinary consumers. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

In view thereof, the *du Pont* factors of relatedness of the goods, classes of purchasers and channels of trade favor a finding of likelihood of confusion.

We turn next to the first *du Pont* factor, i.e., a determination of whether applicant's mark and the registered mark, when viewed in their entirety, are similar in terms of appearance, sound, connotation and commercial impression. 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

¹² In reaching our decision with respect to the relatedness of the goods, we have not relied on the evidence submitted by the examining attorney consisting of web pages from the REDBULL website, as they are not probative of the relationship between drinking water and energy drinks.

similar in terms of their overall commercial impression that confusion as to the source of the goods and services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

In comparing applicant's ROOBI mark and the cited RUBYY mark, we find them markedly different in appearance. Although both marks are comprised of a single term having the letters "R" and "B" in common, the three letters unique to each mark create terms which are visually distinct from one another.

As regards the connotation of the marks, because registrant's RUBYY mark may be viewed as a novel spelling of the term "ruby," its use on or in connection with beverages containing fruit juices, imparts an image of the intense color of ruby red fruit. Indeed, as stated on registrant's website at www.rubyy.com, registrant's product takes its name from the "deep, rich flavor and color of the ruby blood orange."¹³ Applicant's mark, on the other hand,

¹³ Applicant's Response [March 3, 2009], Exh. B and Applicant's Request for Reconsideration, Exh. A.

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does not convey such a connotation because it is unlikely to be recognized as a novel spelling of "ruby." And, even if so recognized, it would not have the same meaning in relation to applicant's drinking water - a substance which is usually clear in color. ROOBI appears, on this record, to be arbitrary in relation to applicant's identified goods.

With regard to sound, we agree with the examining attorney and acknowledge that inasmuch as there is no correct way to pronounce a trademark, applicant's mark and the cited mark are phonetic equivalents and, thus, may sound alike. We also acknowledge that under certain circumstances, similarity in sound alone may suffice to support a finding of likelihood of confusion. See, e.g., *Centraz Industries Inc. v. Spartan Chemical Co. Inc.*, 77 USPQ2d 1698, 1701 (TTAB 2006) (acknowledging that "there is no correct pronunciation of a trademark" and finding ISHINE (stylized) likely to be confused with ICE SHINE, both for floor-finishing preparations); *In re Great Lakes Canning, Inc.*, 227 USPQ 483 (TTAB 1985) (CAYNA (stylized) for soft drinks held likely to be confused with CANA for, *inter alia*, canned and frozen fruit and vegetable juices); and *In re Energy Telecommunications & Electrical Ass'n*, 222 USPQ 350 (TTAB 1983) (ENTELEC and design for association

services in the telecommunication and energy industries held likely to be confused with INTELECT for conducting expositions for the electrical industry). In this case, however, such similarity in sound alone does not support a finding of likelihood of confusion. The differences in appearance and connotation simply outweigh any similarity in sound, resulting in marks that create distinctly different commercial impressions.

Accordingly, the *du Pont* factor of the similarity/dissimilarity of the marks favors applicant.

In reaching our determination that applicant's mark is dissimilar from the cited mark, we have not relied on applicant's argument that given the prevalence of marks incorporating RUBY for fruit juices, the cited mark should be given only a narrow scope of protection. In support of this position, applicant made of record seven third-party registrations. While third-party registrations may be used to demonstrate that a portion of a mark is suggestive or descriptive, they are not evidence that the marks shown therein are in use or that the public is aware of them. See *AMF Incorporated v. American Leisure Products, Inc.*, 177 USPQ 268, 269 (CCPA 1973) ("little weight is to be given such registrations in evaluating whether there is likelihood of confusion."). Moreover, our review of such

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registrations reveals that three of them (Registration Nos. 2664686, 2743109 and 2214712) have been cancelled. The four remaining registrations are for marks with additional literal elements (RUBY MUSHROOM, RUBY-TANGERINE, RUBY KIST AND ROYAL RUBY RED ("Ruby Red disclaimed). Four registrations simply do not persuade us that marks including the term "Ruby(y)" are entitled to limited protection.

Similarly, we have not based our finding that the marks are dissimilar on applicant's argument that the cited mark is weak because the word "Ruby" is descriptive of a characteristic of registrant's goods.¹⁴ Such an argument constitutes a collateral attack on the cited registration. During an ex parte appeal, an applicant will not be heard on matters that constitute a collateral attack on the cited registration. *Dixie Restaurant's Inc.*, 41 USPQ2d at 1534.

Last, we make clear that our finding of no likelihood of confusion is not based on applicant's assertion that the purchasers of its drinking water enhanced with antioxidants are sophisticated and discriminating. We find, on this record, that applicant's water product is an inexpensive

¹⁴ Applicant's argument includes its contention that "the additional letter "y" [in registrant's mark] does not diminish the descriptive significance of the cited mark." Br. p. 17.

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ordinary consumer item which will be purchased by ordinary consumers exercising no more than ordinary care.

In conclusion, having carefully considered all of the evidence and arguments, including the ones not discussed here, we find that confusion is unlikely to result from the contemporaneous use of registrant's RUBY mark and applicant's ROOBI mark, even though the marks are used on somewhat related products that move in the same trade channels and are sold to ordinary consumers. We conclude so because the dissimilarity of the marks simply outweighs the evidence as to the other factors. See *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) ("We know of no reason why, in a particular case, a single *du Pont* factor may not be dispositive"). See also, *In re E.I. du Pont de Nemours & Co.*, 177 USPQ at 567 ("each [of the thirteen factors] may from case to case play a dominant role").

Decision: The refusal of registration under Section 2(d) of the Trademark Act is reversed.