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Precedent of the
TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Oncor Corporation aka DMK Cosmetics

Serial No. 86131491

Miriam Richter of Richter Trademarks
for Oncor Corporation aka DMK Cosmetics.

Andrew Rhim, Trademark Examining Attorney, Law Office 101,
Ronald R. Sussman, Managing Attorney.

Before Bergsman, Wellington, and Hightower,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Oncor Corporation aka DMK Cosmetics (“Applicant”) seeks to register the standard character mark A2Z on the Principal Register for “skin care products, namely skin cleansers, non-medicated exfoliating gels for skin, non-medicated acne treatment preparations, skin

conditioning masks, skin creams, skin moisturizers and tinted skin creams for daily use” in International Class 3.¹

The Trademark Examining Attorney refused registration of the mark on the ground of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). The Examining Attorney’s position is that Applicant’s proposed mark is likely to cause confusion or mistake or to deceive prospective purchasers because it so resembles the registered standard character mark, HEALTHA2Z, for the following goods:

Pharmaceutical preparations for the treatment of acne, anemia, arthritis, asthma, bacterial infections, cold and cough, constipation, dandruff, diarrhea, diseases of the central nervous system, fever, fungal infections, hemorrhoids, herpes, heartburn, inflammation, intestinal gas, migraines, nasal and sinus congestion, nausea, poor respiration, respiratory infections, sore throat, stomach ache, mouth pain caused by teething; and muscle pain [sic] pharmaceutical preparations for the prevention of acne, anemia, arthritis, asthma, bacterial infections, cold and cough, constipation, dandruff, diarrhea, diseases of the central nervous system, fever, fungal infections, hemorrhoids, herpes, heartburn, inflammation, intestinal gas, migraines, nasal and sinus congestion, nausea, poor respiration, respiratory infections, sore throat, stomach ache, mouth pain caused by teething, and muscle pain; amino acids for use as nutritional supplements; anesthetic for surgical purposes; topical anesthetics; anesthetics for non- surgical use; antibiotics; antibiotics; antibiotic creams; antibiotic ointments; antibiotic tablets; antihistamines and antihistamine combinations in the nature of cold and allergy remedies; calcium supplements for the treatment of osteoporosis; calcium supplements for the prevention of osteoporosis; cardiovascular pharmaceuticals;

¹ Application Serial No. 86131491 was filed on November 27, 2013, under Section 1(b) of the Trademark Act, based on an allegation of a bona fide intent to use the mark in commerce.

contraceptive foams; contraceptive sponges; oral contraceptives; dental needs, namely medicated mouthwash; dental needs, namely dental abrasives; dental needs, namely dental amalgams; dental needs, namely dental bleaching gels; dental needs, namely dental impression materials; dental needs, namely medicated tooth paste; room deodorants; diagnostic preparations for clinical or medical laboratory use; diaper rash ointment; diet aids, namely diet capsules and diet pills; electrolyte replacement solutions; electrolyte replacement tablets; enzymes for use as a dietary supplement; eye drops; eye ointments; medicated foot powder; medicated hair growth stimulants; non-medicated hair growth stimulants; gel for use as personal lubricant; pregnancy test kits for home use; medicated hair shampoo; medicated skincare preparations; sleep aids, namely sleeping pills and tablets; vaginal preparations, namely anti-fungals; medicated nailcare and nose care preparations; and nutraceuticals for use as dietary supplements; and herbal supplements, in International Class 5.²

After the Trademark Examining Attorney made the refusal final, Applicant requested reconsideration and simultaneously appealed to this Board. The Examining Attorney denied the request for reconsideration and this appeal proceeded. Applicant and the Examining Attorney have filed appeal briefs. For the reasons given in this decision, we affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours &*

² Registration No. 2805770, issued on January 13, 2004; renewed. The mark was registered in “typeset” form. Effective November 2, 2003, Trademark Rule 2.52, 37 C.F.R. § 2.52, was amended to replace the term “typed” drawing with “standard character” drawing. A mark registered as a typed drawing is the legal equivalent of a standard character mark. *See In re Brack*, 114 USPQ2d 1338, 1339 n.2 (TTAB 2015).

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 similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (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.”).

A. The similarity of the marks.

We first consider the *du Pont* likelihood of confusion factor involving the similarity or dissimilarity of the marks in their entireties 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, “two marks may be found to be confusingly similar if there are sufficient similarities in terms of sound or visual appearance or connotation.” *Kabushiki Kaisha Hattori Seiko v. Satellite Int’l, Ltd.*, 29 USPQ2d 1317, 1318 (TTAB 1991), *aff’d mem.*, 979 F.2d 216 (Fed. Cir. 1992) (citation omitted). *See also Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1519 (TTAB 2009) (citing *Krim-Ko Corp. v. Coca-Cola Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the

similarity in either form, spelling or sound alone is likely to cause confusion.”)).

Moreover, “[t]he proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). *See also 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 mem.*, 972 F.2d 1353 (Fed. Cir. 1992).

We find the marks are similar because the registered mark, HEALTHA2Z, is comprised of the two recognizable terms, HEALTH and A2Z, and Applicant is seeking to register the latter and more distinctive element. With respect to the non-shared term, the word “health” in the context of registrant’s goods is highly suggestive, if not descriptive, inasmuch as the term means “the condition of being well or free from disease.”³ It provides information about the goods by describing their

³ The definition is taken from the online version of Merriam-Webster’s Learner’s Dictionary (www.merriam-webster.com). The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377

nature, intended outcome or purpose, *i.e.*, Registrant's pharmaceutical preparations are health products that will cure ailments for the consumer or user's health. Thus, although HEALTH is the initial element to Registrant's mark, it does very little to distinguish the two marks because both Registrant's and Applicant's preparations are intended to promote a healthy skin condition, including specifically the treatment of acne.

As to the latter element of Registrant's mark, A2Z, or Applicant's proposed mark, this plays a stronger role in creating the overall commercial impression of Registrant's mark. Although "A2Z" may connote a variety or extensive line of products (running from the letters "A" to "Z"), there is no evidence demonstrating this term is weak.⁴

(TTAB 2006). We further note that the Examining Attorney attached a printout from the "Oxford Dictionaries Language Matters" website that contains essentially the same definition (Office action issued on July 22, 2015).

⁴ During the prosecution of the application and in addition to the cited registration now before us, we note the Examining Attorney introduced copies of two other registrations and an application for marks containing the phrase "A to Z" or its equivalent as possible bases for a likelihood of confusion refusal. They were subsequently withdrawn as possible bases for refusal. They are:

Reg. No. 2847557 for the mark A2Z HARDWARE ("hardware" disclaimed) for online ordering services in the field of hardware, locks, tools, electrical products, containers, personal hygiene products, candles, water fountains, auto security products, luggage.

Reg. No. 4545931 for the mark ATOZ for computerized online retail store services featuring a wide variety of consumer goods of others.

Ser. No. 85567537 for the mark A-TO-Z GUARANTEED for online retail store services featuring a wide variety of consumer goods of others.

However, because third-party registrations of marks are not evidence that the registered marks are in use, they are of limited probative value for

Rather, we find A2Z is much more distinctive than the initial term HEALTH. While we must consider the marks in their entirety, it is appropriate to accord greater importance to the more distinctive elements in the marks. As the Court of Appeals for the Federal Circuit observed, “there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety. Indeed, this type of analysis appears to be unavoidable.” *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

In sum, the marks, A2Z and HEALTHA2Z, are very similar. The marks, when taken in their entirety, present overall similar commercial impressions. Applicant is attempting to register the more distinctive element of Registrant’s mark by lopping off the less distinctive, albeit initial, element. The differences in appearance and sound between the marks, based on the non-shared term HEALTH, are simply outweighed by the similarities in appearance, sound, connotation and commercial impression based on proposed sharing of A2Z.

demonstrating weakness of the marks. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010). Furthermore, the registrations and application are for retail services and do not cover the involved goods, namely, medicated or non-medicated skincare products. Thus, this is not the type or amount of evidence needed to show that a term carries a highly suggestive or descriptive connotation in the relevant industry and therefore may be considered somewhat weak. *Cf. Juice Generation, Inc. v. GS Enterprises LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015).

B. The similarity or dissimilarity and nature of the goods and their trade channels.

In support of the refusal, the Examining Attorney submitted copies of six different third-party registrations for marks in connection with the same or similar skincare preparations as those of both Applicant and Registrant.⁵ Specifically, each registration covers non-medicated skincare preparations in Class 3, as well as medicated skincare preparations in Class 5. This evidence shows that these goods are of a kind that may emanate from a single source under a single mark. *See In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

In addition, the Examining Attorney submitted printouts from various websites showing medicated skincare products and non-medicated skincare products being offered under the same mark, by the same manufacture or in proximity to each other on retail websites.⁶

These include:

- “Gold Bond” website shows skin care products that are medicated (“medicated body powder, medical body lotion, medicated baby powder”) as well as non-medicated skin care products under the same “Gold Bond” mark. The following is an excerpt from the website:

⁵ Submitted with Office Action issued on February 27, 2014.

⁶ Submitted with Office action issued on July 22, 2015.

Gold Bond Medicated
Does What It Says.



ORIGINAL STRENGTH
Medicated Body Powder

Triple Action Relief:
Cooling, Absorbing and
Itch Relieving

Original Gold Bond Powders, Lotions & Creams

[VISIT THE SITE](#)

Gold Bond Ultimate
This Stuff Really Works.



HEALING
Skin Therapy
Lotion and Cream

With Aloe to Heal
Dry, Problem Skin

Gold Bond Ultimate Lotions, Creams and Powders

[VISIT THE SITE](#)

- “Clear Essence” website shows it offers a “skin beautifying milk” product as well as “medicated fade crème” and a “medicated cleansing bar plus exfoliants,” all offered under the same “Clear Essence Platinum” line of goods.
- “La Roche-Posay” website features an Effaclar-branded line of goods that includes “instant oil-absorbing coverage cream mousse ... dual action acne treatment ... dermatological acne system.” The website states that “EFFACLAR offers a comprehensive line of medicated acne treatments and complementary non-medicated skincare to provide dermatologists and our consumers with effective solutions for oily and acne-prone skin.”
- “Carmex” website lists several Carmex-branded products, such as lip balm “filled with our medicated formula” and a different lip balm that is not touted as having a “medicated formula.” The website also displays a variety of skincare products. The following is an excerpt from the website:



The evidence is sufficient for purposes of demonstrating a close relationship between Applicant's goods, namely, non-medicated skincare preparations and creams, including those specifically for treating acne, and Registrant's goods, which include medicated skincare preparations for a treating a variety of conditions (of which "acne" is listed as one). The evidence shows that it is possible for consumers to encounter medicated and non-medicated skincare products offered under the same mark. That is, and put more specifically in the context of the involved goods as they are identified in the application and cited registration, there is the likelihood that a consumer with an acne condition will encounter both Applicant's and Registrant's goods whose stated purpose is to treat acne.

With respect to the trade channels, there are no restrictions in the identifications in the application and the registration. We must presume Applicant's and Registrant's goods are sold in all normal trade channels and to all the usual purchasers of such goods. *See Hewlett-Packard Co.*

v. Packard Press Inc., 281 F.3d 1261, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002). Here, we have evidence showing that both Applicant's non-medicated skincare products and Registrant's medicated skincare products may be found in the same online retail trade channels, either being offered directly online by the manufacture, *e.g.*, the Clear Essence website, or through a third-party, online retailer, *e.g.*, the Steris website offers "healthcare products," such as skin cream and medicated lotion soap and "The Betty Mills Company" website offers a product category of "skin care products" that includes "moisturizing skin protectant cream" as well as "medicated skin cream."⁷ The relevant consumer for both Applicant's and Registrant's goods is anyone interested in purchasing skincare products and this would include the general public. The registration's medicated preparations are for treatment of a variety of conditions, including some common skin conditions such as acne and dandruff. Furthermore, the record shows that medicated and non-medicated skincare products are relatively inexpensive.⁸ Consequently, although consumers may be purchasing the products for treating a particular ailment, the fact that they are relatively inexpensive could lead to less discriminating or impulse purchase.

⁷ Printouts from websites attached to Office action issued on July 22, 2015.

⁸ As demonstrated by the website evidence attached to the July 22, 2015 Office Action, medicated and non-medicated skincare preparation goods can be purchased for under \$ 7.00.

Balancing the factors.

Because the marks are very similar, and the goods are closely related and would be found in the same trade channels by the same class of purchasers, we find that Applicant's mark, A2Z, when used on its skin care products, is likely to cause confusion with the registered mark, HEALTHA2Z, for Registrant's goods, particularly, "pharmaceutical preparations for the treatment of acne ... [and] medicated skincare preparations." In this particular case, we find that consumers already familiar with Registrant's mark being used on its goods, upon encountering Applicant's A2Z on its goods, may mistakenly believe the goods emanate from a common source, albeit under a mark from which the weak term, HEALTH, has been omitted. The fact that we have pinpointed certain goods within the registration's identification does not detract from any likelihood of confusion. *Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) ("[L]ikelihood of confusion must be found if the public, being familiar with appellee's use of MONOPOLY for board games and see the mark *on any item that comes within the description of goods set forth by appellant in its use of the mark, directly or under license, such item ...*").

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