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# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86150955

MARK: DERMOPLUS GEL



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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

**TTAB INFORMATION:**

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: K & N Distributors

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

N/A

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## **EXAMINING ATTORNEY'S APPEAL BRIEF**

The applicant has appealed the examining attorney's final refusal to register the mark DERMOPLUS GEL (in standard character format) for the goods "cosmetics," in International Class 3. The examining attorney has refused registration on the Principal Register because applicant's mark is

confusingly similar with Registration No. 2324254 for the mark DERMA PLUS for the goods, "Skin care products, namely, medicated skin care lotions sold in aerosol containers." 15 U.S.C. §1052(d); 37 C.F.R. §2.46(a).

Accordingly, it is respectfully requested that the refusal based on likelihood of confusion under Trademark Act Section 2(d) be affirmed.

#### I. FACTS

On December 26, 2013, K & N Distributors filed U.S. Trademark Application Serial No. 86/150955, seeking registration of the proposed mark, DERMOPLUS GEL for "cosmetics," and provided a disclaimer of the term GEL. On March 28, 2014, the previously assigned examining attorney issued an office action refusing registration of the mark under Trademark Act Section 2(d).

On September 29, 2014, applicant responded to the Office Action and presented arguments in an effort to overcome the refusal under Section 2(d) of the Trademark Act.

On October 6, 2014, the current examining attorney was assigned to the application. On November 6, 2014, the examining attorney made final the refusal under Section 2(d) of the Trademark Act.

On November 10, 2014, the applicant filed its Brief in support of Registration of Serial Number 86/150955.

#### II. THE MARKS OF APPLICANT AND REGISTRANT ARE IDENTICAL IN DOMINANT PORTION AND THE GOODS ARE IDENTICAL OR CLOSELY RELATED SUCH THAT THERE EXISTS A LIKELIHOOD OF CONFUSION, MISTAKE, OR DECEPTION UNDER SECTION 2(d) OF THE TRADEMARK ACT

The Board should affirm the likelihood of confusion refusal because the marks are identical in part and the goods are closely related in nature and purpose. The Court in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973), listed the principal factors to be considered in determining whether there is a likelihood of confusion under Section 2(d) of the Trademark Act. Any one of the factors listed may be dominant in any given case, depending upon the evidence of record. In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods, and similarity of trade channels of the goods.

Any doubt as to the issue of likelihood of confusion must be resolved in favor of the registrant and against the applicant who has a legal duty to select a mark that is dissimilar to trademarks already being used. See *In re Hyper Shoppes (OHIO), Inc.*, 837 F.2d 463 (Fed. Cir. 1988).

**A. The marks are similar because the dominant portion of the mark is identical to the registrant's mark and thus confusingly similar.**

The marks must be compared for similarities in sound, appearance, meaning, or connotation. *E.I. du Pont de Nemours*, 476 F.2d 1357. Similarity in any one of these elements is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755 (TTAB 1977). The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. Instead, the issue is whether the marks create the same overall impression. *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). Thus, the primary focus is on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *Chemetron Corp. v. Morris Coupling and Clamp Co.*, 203 USPQ 537 (TTAB 1979). When an applicant's mark is compared to the registered mark, "the points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 40 (D.C. Cir.), cert. denied, 351 U.S. 973 (1956).

The applicant's mark is identical in dominant portion and highly similar in appearance, meaning, connotation and commercial impression to the registered marks. The applicant seeks to register the mark DERMOPPLUS GEL in standard character format. The registered mark is DERMA PLUS (RN 2324254) in standard character format.

A standard character or typed mark means that the mark may be displayed in any lettering style. 37 C.F.R. §2.52(a). The rights associated with a mark in typed or standard character form reside in the wording itself, and the applicant is free to adopt any style of lettering, including lettering identical to that used by the registrants. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991). The applicant's mark and the registrant's mark, despite the spacing, are highly similar. For example, the marks contain the similar two words, DERMO/DERMA and PLUS, and contain no additional stylization.

**1. The Dominant Portion of the Applicant's Mark Is the Wording DERMOPPLUS Rendering it Confusingly Similar in Appearance and Sound to the Registered Mark**

The law is clear that marks may still be confusingly similar notwithstanding the addition, deletion or subtraction of letters or words. *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988). "It is not necessary for similarity to go only to the eye or the ear for there to be infringement. The use of a designation which causes confusion because it conveys the same idea, or stimulates the same mental reaction, or has the same meaning is enjoined on the same basis as where the similarity goes to the eye or the ear." *Standard Oil Co. v. Standard Oil Co.*, 116 USPQ 176, 182 (10th Cir. 1958). The applicant's mark and the registrant's mark are similar in appearance and sound because they are comprised in part of the same wording. The commercial impression also remains the same because the term GEL in applicant's mark does not distinguish the overall meaning of the mark.

The applied-for mark is DERMOPPLUS GEL, and because the term GEL is highly descriptive for the goods, the wording DERMOPPLUS is the dominant portion of the mark. Although the marks are

compared in their entireties under a Section 2(d) analysis, one feature of a mark may be recognized as more significant in creating a commercial impression. It is well established that “in articulating reasons for reaching a conclusion on the issue of confusion, 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 entireties.” *In re National Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985). For instance, “[t]hat a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark.” *Id.* Accordingly, there is nothing improper in giving less weight to the highly descriptive and disclaimed term GEL and more weight to the term(s) DERMOPLUS as the dominant term in the applicant’s mark, when consideration is given to the similarity of the marks in their entireties.

If the dominant portion of the marks is the same, then the marks may be confusingly similar notwithstanding peripheral differences. *See, e.g., In re Mighty Leaf Tea*, 601 F.3d 1342, 1347-48 (Fed. Cir. 2010). Even though the degree of required similarity between the marks is not as great here because the goods are the same, the marks in question are confusingly similar nonetheless.

## **2. Applicant’s mark and Registrant’s mark are Similar in Overall Impression and Meaning**

In order to distinguish itself from the registered marks, the applied-for mark must also contain some other non-descriptive wording like the registered marks. *See In re Mighty Leaf Tea*, 601 F.3d 1342 (Fed. Cir. 2010); *In re Optica Int’l*, 196 USPQ 775, 778 (TTAB 1977). Aside from the generic term GEL, however, there is no other wording in the applied-for mark to distinguish it from the registered marks. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 1343 (Fed. Cir. 2004) (“Viewed in their entireties with non-dominant features appropriately discounted, the marks [GASPAR’S ALE for beer and ale and JOSE GASPAR GOLD for tequila] become nearly identical.”). This is not the case here for there isn’t any non-

descriptive wording that distinguishes the applicant's mark from the registrant's mark and the spacing that exists in one versus the other is negligible.

Applicant essentially concedes this point by stating in its brief, "*From an initial context, Applicant must concede the phonetic equivalence of DERMOPPLUS versus DERMA PLUS. Moreover, as the Applicant has disclaimed GEL apart from its mark as a whole, Applicant must concede the highly similar nature of the first cited trademark against its mark.* (Please see Applicant's brief p. 8). Emphasis added.

### **3. Evidence of Dilution is Unpersuasive**

Applicant has submitted printouts of third-party registrations for marks containing the wording DERMO and DERMA to support the argument that this wording is weak, diluted, or so widely used that it should not be afforded a broad scope of protection. The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks in use in the marketplace in connection with similar goods and/or services. *See Nat'l Cable Television Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973).

This argument and the supporting evidence are unpersuasive. Evidence of weakness or dilution consisting solely of third-party registrations, such as those submitted by applicant in this case, is generally entitled to little weight in determining the strength of a mark, because such registrations do not establish that the registered marks identified therein are in actual use in the marketplace or that consumers are accustomed to seeing them. *See AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009); *Richardson-Vicks Inc. v. Franklin Mint Corp.*, 216 USPQ 989, 992 (TTAB 1982). Because the applied-for mark contains the same common wording as the registered marks but no other distinguishing wording, it does not create a distinct

commercial impression from the registered marks. Accordingly, even though the applied-for mark and the registered marks are not word-for-word copies of one another, they are confusingly similar.

**B. The goods are closely related because they overlap due to their nature and purpose.**

The likelihood of confusion should also be affirmed because the goods are related. It is well settled that the issue of likelihood of confusion between marks must be determined on the basis of the goods as they are identified in the application and the registration. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Accordingly, without limitations or restrictions as to their channels of trade or classes of purchasers, the goods must be deemed to be promoted in the same channels of trade and directed to the same purchasers. *Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910 (TTAB 2000).

**1. Definition of Cosmetics Encompasses Makeup and Skin Care Products**

Here, the applicant's "cosmetics," are closely related to the registrant's "Skin care products, namely, medicated skin care lotions sold in aerosol containers."<sup>1</sup> Both the applicant's and the registrant's goods are related skin care items. Neither identification limits the channels of trade or class of purchasers of the identified goods. Thus, it is presumed that these goods travel in the same channels of trade and are available to the same consumers.

The final office action included online articles depicting single sources providing cosmetics and skin care items, such as creams and masks. For example, the excerpt from Lush cosmetics company demonstrates that they provide both "skin creams and lotions," and "makeup," (Please see pages 2-7 from final office action dated November 6, 2014) for purchase from their website. The excerpt from Macy's cosmetic department (p. 8-14) describes the provision "make up," and "skin care lotions" for

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<sup>1</sup> The Examining Attorney requests that the Board take judicial notice of the attached dictionary definition for the words "cosmetics" from Collins' Online Dictionary. The Board may take judicial notice of dictionary definitions. TBMP §1208.04.



purchase. Further, web page evidence from Motives (p. 15-18), and Neoteric Cosmetics, Inc. (p. 19-21) depicts “skin care creams and lotions,” and various cosmetics, such as eye shadow, blush, and foundation, provided by a single source. This market evidence tends to show that cosmetics and beauty care creams and lotions are closely related.

## **2. Applicant’s Goods and Registrant’s Goods Overlap in Function**

Applicant has submitted new information regarding purported third-party usage of the applied-for mark. The examining attorney objects to the submission of this evidence and asks the Board to reject it and the accompanying argument. This submission is untimely because the evidentiary record should be complete prior to the filing of an *ex parte* appeal to the Board. 37 C.F.R. §2.142(d). See TBMP §1207.01; *In re Trans Continental Records Inc.*, 62 USPQ2d 1541 (TTAB 2002). Even if it were determined this third-party usage is both a registered mark and confusing, it is no defense to register yet another confusingly similar mark. *AMF Inc. v. American Leisure Products, Inc.*, 177 USPQ 268, 269 (C.C.P.A. 1973).

The evidence of record shows that the goods are closely related because applicant’s and registrant’s goods are related skin care items and serve the same purpose and function, namely, to provide the user with better quality and more beautiful skin. Thus, the factor of the relatedness of the goods favors a finding of likelihood of confusion.

## **III. CONCLUSION**

Because the marks are conceded identical in dominant portion and the goods are closely related, consumers encountering the applicant’s mark and the registered marks in the marketplace are likely to mistakenly believe that the goods emanate from a common source. For the foregoing reasons, the refusal to register under Section 2(d) of the Trademark Act should, therefore, be affirmed.

Respectfully submitted,

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You are here > Home > American English Dictionary > Definition of 'cosmetic'

English > English for Learners > French > German > Spanish > Italian >

## American English Dictionary

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Your search found **cosmetics** / **cosmetics** / **cosmetics**

Word Frequency ●●●●●

**cosmetic** (kəz'metɪk **••**)

### Definitions

#### adjective

1. beautifying or designed to beautify the complexion, hair, etc.
2. for improving the appearance by the removal or correction of blemishes or deformities, esp. of the face
3. of or for improving the appearance without making any basic changes, as to conceal defects, make more acceptable, etc.; also, superficial

#### noun

4. any cosmetic preparation for the skin, hair, etc., as blusher and powder
5. anything cosmetic (*often used in pl.*)

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**cos'metically** *adverb*

► **Word Origin**

Gr *kosmētikos*, skilled in arranging < *kosmein*, to arrange, adorn < *kosmos*, order

► **Synonyms**

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= [beautifying](#), [nonessential](#), [superficial](#), [surface](#)

► **Translations for 'cosmetic'**

American English: [cosmetic](#). Cosmetics are substances such as lipstick or powder, which people put on their face to make themselves look more attractive. [cosmetics](#): the cosmetics counter of a department store.

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- Nothing
- I've never heard of this
- Lots of love
- Lots of luck

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cosméticos

European Spanish: [cosmético](#)

French: produit de beauté

German: Kosmetikum

Italian: [cosmetico](#)

Japanese: 化粧品

► **Example Sentences Including 'cosmetic'**

Especially for my friend here," I gestured at Skink, "who could use a little cosmetic surgery

**William Lashner** FATAL FLAW (2003)

I might be a cynic, but rather than curing a disease, I'll bet we'll find a new flood of cosmetic upgrades.

**SLASHDOT** (2004)

Her beauty indulgence is Restylane, a \$400 cosmetic injection to plump her lips.

**SEATTLE TIMES** (2004)

In the latter case, much of his craft involved makeup and other cosmetic techniques.

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