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Subject: U.S. TRADEMARK APPLICATION NO. 86165262 - VALMY - 3T14657472 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86165262

MARK: VALMY

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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: Product Brands SRL

CORRESPONDENT DOCKET: 3T14657472

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant Product Brands SRL has appealed the examining attorney's final refusal to register its proposed trademark pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the basis of a likelihood of confusion with the mark in U.S. Reg. No. 1300075.

I. FACTS

Applicant applied on January 14, 2014 to register VALMY & Design for, as originally worded, cosmetics and makeup, non-medicated skin care preparations, hair care preparations, hair care preparations, non-medicated toiletries and perfumery, body lotions, hair care products, namely, shampoo, hair conditioners, styling gel, sunscreen creams and lotions. The examining attorney refused registration on April 16, 2014 on the basis of a likelihood of confusion with the following two registrations:

> 980867: CHRISTINE VALMY (stylized) for mask for acne skin problem; cosmetic and toilet preparations;
>
> 1300075: CHRISTINE VALMY for skin care products-namely, cleansing lotions, cleansing creams, soaps, astringents, toners, softening and moisturizing fluids, freshening fluids, conditioning creams, hydrating jelly masks, skin moisturizing lotion, jelly masks for oily skin, jelly masks for blemished skin, masks for firming skin, facial peel creams, skin firming creams, deep-cleaning lotion for skin, lotion for protecting skin, lotions to restore acidity, creams for revitalizing the skin, conditioner for strengthening eyelashes, lotion to lessen superficial wrinkles and lines, mask to help clear away blackheads, whiteheads, blemishes and deep pore dirt, soap to help clear up blemishes and acne pimples, cream to fade dark spots and freckles; cosmetics-namely, makeup base, bronzer, facial powder, facial blush and brush, contour shading makeup, foundation facial cream, blemish cover sticks, compressed facial powder, lipsticks, lip liner pencils, lip liner pencil refills, lip gloss, rouge, eye liners, mascaras, eyebrow pencils, eyebrow pencil refills, lash thickener, eye shadow, eye cleansing pads, nail polish, nail gloss, eyelashes; hair shampoo; sunscreen; skin bleaching lotion; toiletries-namely, men's and women's colognes, men's after-shave lotion; brushes as part of makeup kit; depilatory wax.

The office action also included requirements to (i) make minor amendments to the identification, (ii) amend the mark description, (iii) submit a new drawing, and (iv) correct the entity information. Applicant subsequently complied with all of these requirements, in particular amending the identification to "cosmetics, makeup, nail polish and preparations for the care of the nails."

The application was suspended on October 23, 2014 to determine whether maintenance documents would be filed for Reg. No. 980867. The application was removed from suspension on November 10, 2016 after that registration was cancelled. The Section 2(d) refusal based on Reg. No.

1300075 was made final. A requirement for information was issued on May 31, 2017, and a subsequent final Section 2(d) refusal issued after applicant provided the required information. This appeal followed.

II. OBJECTION

As a preliminary matter, the examining attorney objects to the inclusion of applicant's Exhibit A, which consists of *Wikipedia* excerpts about Valmy, France and Francisco de Miranda, which were introduced into the record for the first time on appeal. On October 16, 2014, applicant submitted *Wikipedia* excerpts about Valmy, France and Francisco de Miranda as pages 8-29 of its response. Exhibit A is an updated version of those attachments and includes information that was not previously included. For example, the Francisco de Miranda excerpt of Exhibit A includes a section entitled *Hebrew-Jewish origin of Miranda* that is not included in the original. The record in an application must be complete prior to appeal. 37 C.F.R. §2.142(d); TMEP §710.01(c); TBMP §§1207.01 *et seq.* Accordingly, applicant's Exhibit A should be excluded and not considered by the Board.

III. ARGUMENT

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused, mistaken or deceived as to the source of the goods of the applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (*citing On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all of the *du Pont* factors, however, are necessarily relevant or given equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup*, 637 F.3d at 1355, 98 USPQ2d at 1260; *see du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods and similarity of the trade channels of the goods. *See In re Viterra Inc*., 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); TMEP §§1207.01 *et seq*. The overriding concern is not only to prevent buyer confusion as to the source of the goods, but also to protect registrants from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co*., 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc*., 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002).

A. The Goods Are Identical In Part And Otherwise Closely Related.

Applicant seeks to offer cosmetics, makeup, nail polish and preparations for the care of the nails. The registrant offers the following goods (emphasis added):

> skin care products-namely, cleansing lotions, cleansing creams, soaps, astringents, toners, softening and moisturizing fluids, freshening fluids, conditioning creams, hydrating jelly masks, skin moisturizing lotion, jelly masks for oily skin, jelly masks for blemished skin, masks for firming skin, facial peel creams, skin firming creams, deep-cleaning lotion for skin, lotion for protecting skin, lotions to restore acidity, creams for revitalizing the skin, conditioner for strengthening eyelashes, lotion to lessen superficial wrinkles and lines, mask to help clear away blackheads, whiteheads, blemishes and deep pore dirt, soap to help clear up blemishes and acne pimples, cream to fade dark spots and freckles; **cosmetics**-namely, makeup base, bronzer, facial powder, facial blush and brush, contour shading makeup, foundation facial cream, blemish cover sticks, compressed facial powder, lipsticks, lip liner pencils, lip liner pencil refills, lip gloss, rouge, eye liners, mascaras, eyebrow pencils, eyebrow pencil refills, lash thickener, eye shadow, eye cleansing pads, **nail polish**, **nail gloss**, eyelashes; hair shampoo; sunscreen; skin bleaching lotion; toiletries-namely, men's and women's colognes, men's after-shave lotion; brushes as part of makeup kit; depilatory wax.

The words "makeup" and "cosmetics" are synonyms. See *m-w.com* dictionary definition of "makeup" at page 4 of May 31, 2017 office action. Furthermore, the evidence demonstrates that the cosmetic goods included after "namely" in the registration are commonly referred to as makeup. See pages 5-8 of the May 31, 2017 office action showing that the registered cosmetic goods are categorized

by retailers as makeup. Thus, both parties offer cosmetics and makeup. Additionally, both parties offer nail polish. The goods are therefore identical in part. With respect to applicant's "preparations for the care of the nails," this broadly worded item encompasses the more narrow registered item "nail polish." *See, e.g., Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015). Moreover, the evidence shows that various preparations for the care of the nails and cosmetics are commonly offered by a single source:

1. Pp. 2-3 of the December 20, 2017 action showing that both goods are offered by Revlon.

2. Pp. 4-5 of the December 20, 2017 action showing that both goods are offered by Chanel.

3. Pp. 6-7 of the December 20, 2017 action showing that both goods are offered by Zoya.

4. Pp. 8-9 of the December 20, 2017 action showing that both goods are offered by Nars.

Furthermore, the identifications do not include any restrictions as to the channels of trade and are therefore "presumed to travel in the same channels of trade to the same class of purchasers." *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)).

Applicant does not argue that the goods differ. Where the goods of an applicant and registrant are identical or virtually identical, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse goods. *See In re Bay State Brewing Co.,* 117 USPQ2d 1958, 1960 (TTAB 2016) (citing *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); TMEP §1207.01(b).

B. <u>The Marks Are Very Similar.</u>

The marks are nevertheless extremely similar. Applicant's proposed mark is VALMY & Design, and the registered mark is CHRISTINE VALMY. Each mark includes the distinctive word VALMY. Marks may be confusingly similar in appearance where similar terms appear in the compared marks and create a similar overall commercial impression. *See Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987); TMEP §1207.01(b)(ii)-(iii). Consumers are likely to believe that VALMY in applicant's mark is the surname VALMY from the registered mark. Thus, they are likely to believe mistakenly that these same goods bearing two marks that both include the word VALMY emanate from the same source.

Applicant argues that the marks differ because its mark originated in Venezuela (currently applicant's largest consumer market), and Venezuelan general Francisco de Miranda fought in the Battle of Valmy in France in 1792. See applicant's brief at 6. This is quite a tenuous connection, and American consumers who encounter the marks are unlikely to have any awareness of such facts. The town of Valmy had a population of only 284 people as of 1999. See page 9 of applicant's October 16, 2014 response. It is therefore small and obscure and would not have any geographic significance in the minds of the consuming public in the United States.

Applicant then argues that the marks differ because the registered mark is unitary. See applicant's brief at 7-8. Whether a mark is unitary is relevant when determining whether a portion of it should be disclaimed. *See* TMEP §1213.05. There are no descriptive terms in the registered mark, so the concept of a unitary mark was not relevant to its prosecution. The question of whether the registered mark is unitary therefore has no bearing on this likelihood of confusion analysis.

However, applicant's argument does imply that marks should not be dissected for purposes of comparison. While it is true that marks must be compared in their entireties and should not be

dissected, a trademark examining attorney may weigh the individual components of a mark to determine its overall commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1322, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014) ("[Regarding the issue of confusion,] there is nothing improper in stating that . . . 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." (quoting *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985))). The rule against dissection of a mark does not mean that marks need to be identical for there to be a likelihood of confusion. Indeed, they do not. In this case, the fact that the two marks share the distinctive term VALMY causes the likelihood of confusion.

When evaluating a composite mark containing both words and designs, the word portion is more likely to indicate the origin of the goods because it is that portion of the mark that consumers use when referring to or requesting the goods. *Bond v. Taylor*, 119 USPQ2d 1049, 1055 (TTAB 2016) (citing *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012)); TMEP §1207.01(c)(ii). Thus, although marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar. The dominant portion of applicant's mark, VALMY, is extremely similar to the registered mark CHRISTINE VALMY and consumers are likely to believe mistakenly that the goods offered in connection with these marks emanate from the same source.

Finally, applicant argues that its proposed mark has been used abroad for over 40 years, invoking the 13th *du Pont* factor. The scope of federal trademark jurisdiction is limited to commerce that may be regulated by the U.S. Congress. *See* 15 U.S.C. §1127; TMEP §901.03. Therefore, any use or fame of the proposed mark abroad has no bearing on this analysis.

IV. CONCLUSION

The goods at issue in this case are identical in part, and the marks are extremely similar, resulting in a likelihood of confusion. The examining attorney therefore respectfully requests that the refusal to register in pursuant to Section 2(d) of the Trademark Act be *affirmed*.

Respectfully submitted,

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