

This Opinion is Not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re SMA Srl

Serial No. 86714378

John J. O'Malley of Volpe and Koenig, P.C.
for SMA Srl.

Siddharth Jagannathan, Trademark Examining Attorney, Law Office 114,
Laurie Kaufman, Managing Attorney.

Before Ritchie, Adlin, and Lynch,
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

I. Background

SMA Srl ("Applicant") seeks registration on the Principal Register of the mark
COLORGANICS in standard characters, for the following goods in International
Class 3:

Organic hair products, namely, hair conditioners, hair
shampoos, hair balsam, hair bleach, hair bleaches, hair

care creams, hair care lotions, hair care preparations, hair color, hair colorants, hair curling preparations, hair decolorants, bleaching preparations for the hair, color-removing preparations for hair, cosmetic hair dressing preparations, hair oils, hair sprays and hair gels, hair straightening preparations, hair styling preparations, hair-washing powder, hair emollients, hair fixers, hair frosts, hair gel and hair mousse, hair glaze, hair lacquers, hair lighteners, hair mousse, adhesives for affixing false hair.¹

The Examining Attorney has finally refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with the following two commonly-owned marks in standard characters registered on the Principal Register:

KOLORGANICS for Compacts containing make-up; Eye make-up; Make-up powder; Cosmetic mascara; Cosmetic foundation cream, liquid and powder; Cosmetic eye shadows; Cosmetic lip pencils; Cosmetic bronzer; Cosmetic concealer; Cosmetic rouges; Cosmetics; Cosmetics namely, compacts; Toners in International Class 3.²

KOLORGANIQUE for Cosmetic kits comprising lipstick, lip gloss, blush, and eye shadow; Cosmetics, namely, lipstick, concealer, blush, cosmetic pencils, lip pencils, bronzers, powders, foundation cream, foundation liquid; Make-up removing milks; Cosmetic sunscreen and sun-tanning preparations, namely, lotions and creams for sun-tanning and sun protection; Cosmetic accessories, namely, cleaner for cosmetic brushes in International Class 3 and Cosmetic brushes in International Class 21.³

¹ Application Serial No. 86714378 was filed August 4, 2015, based on a declared intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

² Registration No. 3493852 issued August 26, 2008; combined Section 8 & 15 affidavit accepted and acknowledged.

³ Registration No. 3999192 issued July 19, 2011; combined Section 8 & 15 affidavit accepted and acknowledged.

After the final Office Action, Applicant appealed. The appeal has been briefed. We affirm the refusal to register for the reasons set out below.

II. Likelihood of Confusion

The determination under Section 2(d) involves an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, hereinafter referred to as “*du Pont* factors”); *see also In re Majestic Distilling Co.*, 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 relatedness of the goods. *See In re Chatam Int’l Inc.*, 380 F.2d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *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.”). “[I]t is sufficient for finding a likelihood of confusion if relatedness is established for any item encompassed by the identification of goods within a particular class in the application.” *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126, n.5 (TTAB 2015); *see also Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

A. Similarity of the Marks

We first turn to the *du Pont* factor comparing the applied-for and cited marks, which we consider “in their entirety as to appearance, sound, connotation and

commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). The test assesses not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the goods and services offered under the respective marks is likely to result. *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); see also *Edom Labs., Inc. v. Glenn Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012). Applicant correctly points out that the marks must be considered in their entirety. However, the analysis may take account of particular features of marks “provided the ultimate conclusion rests on consideration of the marks in their entirety.” *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Turning first to the comparison of COLORGANICS to KOLORGANICS, the marks vary by only the first letter, and these letters C and K produce the same sound, as evidenced by pronunciation guidance in the record.⁴ See *In re Calphalon*, 122 USPQ2d 1153, 1163 (TTAB 2017) (SHARPIN deemed equivalent to “sharpen”). As a result, the marks would likely sound identical when consumers call for the goods. See *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1911 (Fed. Cir. 2012). Both marks appear to be a combination of the word “organics” and the word “color,” albeit with a spelling variation of “color” in the registered mark. Visually, the marks are

⁴ See TSDR November 18, 2015 Office Action at 7-8 (American Heritage Dictionary online, ahdictionary.com, entry for “color” shows the pronunciation with a “k” sound).

almost identical. Because consumers would recognize each mark as the combination of the same wording, we also find the connotation and commercial impression to be essentially the same. While Applicant makes a conclusory argument that the K versus the C “creates a distinct and different commercial impression,” Applicant provides no evidence supporting the mere argument, which we do not find persuasive.

Turning next to the comparison of COLORGANICS to KOLORGANIQUE, the marks again vary by the first letter, a C versus a K, which both make the same sound, and the last syllables of the marks also differ. It is unpredictable how the last syllable of KOLORGANIQUE will affect the public’s pronunciation of the mark. *See Embarcadero Techs., Inc. v. RStudio, Inc.*, 105 USPQ2d 1825, 1835 (TTAB 2013) (quoting *Viterra* 101 USPQ2d at 1912). One possible pronunciation of the last syllable – ik – sounds almost identical to the last syllable of Applicant’s mark, while another possible pronunciation – eek – sounds a bit different, but still results in a similar sounding mark overall. Regardless of the relatively insignificant variation in pronunciation of the last syllable, consumers who hear the marks spoken by others might not notice, or could easily forget, the difference. *See Viterra*, 101 USPQ2d at 1912; *In re Energy Telecomms. & Elec. Ass’n*, 222 USPQ 350, 351 (TTAB 1983) (“Slight differences in the sound of similar marks do not avoid a likelihood of confusion.”). The S at the end of Applicant’s mark, in and of itself, merely suggests a plural form and does little to differentiate the marks. *See, e.g. Wilson v. Delaunay*, 245 F.2d 877, 114 USPQ 339, 341 (CCPA 1957) (“It is evident that there is no material

difference, in a trademark sense, between the singular and plural forms of the word ...”); *Swiss Grill Ltd. v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2011 n.17 (TTAB 2015) (SWISS GRILL and SWISS GRILLS deemed “virtually identical”). Overall, we find that the marks would sound quite similar, and that they resemble each other. As with COLORGANICS, KOLORGANIQUE gives the connotation and commercial impression of a combination of the words “color” and “organic.” Thus, the connotation and commercial impression of COLORGANICS and KOLORGANIQUE also is similar.

This *du Pont* factor weighs in favor of likely confusion as to each cited registration.

B. Relatedness of the Goods

As to the goods, they need not be “competitive or intrinsically related” to find a likelihood of confusion. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1737 (Fed. Cir. 2017). “Instead, likelihood of confusion can be found ‘if the respective products are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.’” *Coach Servs.*, 101 USPQ2d at 1722 (internal citations omitted). In analyzing the second *du Pont* factor, we look to the identifications in the application and cited registrations. *See Stone Lion Capital Partners v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Applicant identifies various hair care products, while both the cited registrations include various cosmetics. The record contains substantial evidence of consumer exposure to goods of this type emanating from the same sources under the same marks. For example:

- The Yves Rocher website offers shampoo, conditioner, and hair oil bearing the same mark as lipstick and foundation.⁵
- The L'Oreal website offers foundation, powder, hair color, and shampoo, all under the L'OREAL mark.⁶
- The Body Shop website features under its BODY SHOP and design mark various hair products including shampoo and conditioner, as well as mascara, lip gloss and foundation;⁷
- The Aveda website shows the AVEDA mark used for cosmetics and hair care products including conditioner;⁸
- The Origins website shows its mark on lipstick and mascara, and on shampoo.⁹
- The Bliss website shows the BLISS mark used on mascara, lipstick, foundation, lip gloss, as well as on shampoo and conditioner.¹⁰
- The Lush website offers both cosmetics and hair care products under the same LUSH mark.¹¹

Applicant contends that the goods are different and serve different purposes.

However, in the broader sense, the goods at issue serve a similar purpose as personal

⁵ TSDR June 5, 2016 Office Action at 2-7 (yvesrocherusa.com).

⁶ *Id.* at 8-24 (lorealparisusa.com).

⁷ *Id.* at 25-30 (bodyshop-usa.com).

⁸ *Id.* at 31-32 (aveda.com).

⁹ *Id.* at 33-39 (origins.com).

¹⁰ *Id.* at 40-46 (blissworld.com).

¹¹ *Id.* at 47-56 (lushusa.com).

care products. Regardless, as we have explained above, the goods need not be identical or serve the same purpose to be related. *See, e.g., Shell Oil Co.*, 26 USPQ2d at 1689 (automotive parts distributorship services and service station oil change and lubrication services deemed sufficiently related to cause confusion because even where the services differ, “the use of identical marks can lead to the assumption that there is a common source”). Rather, the test is whether consumers likely would believe such goods come from the same source. Applying this test, we find the marketplace evidence detailed above persuasive to show that consumers encounter cosmetics such as those identified in the cited registrations coming from the same sources under the same marks as hair care products such as Applicant has identified.

Overall, we find that the record amply demonstrates the relatedness of the relevant goods. This *du Pont* factor also weighs in favor of likely confusion.

C. Trade Channels and Classes of Consumers

The *du Pont* factor on trade channels and classes of consumers also must be assessed according to the identifications of the respective goods in the application and registration at issue, not on extrinsic evidence of actual use. *See, e.g., Coach Servs.*, 101 USPQ2d at 1722; *Octocom*, 16 USPQ2d at 1787. “[I]n the absence of specific limitations,” which we do not have in these identifications, we must assume that the identified goods move through all normal and usual channels of trade for such goods and to all normal potential purchasers. *In re i.am.symbolic llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1750 (Fed. Cir. 2017); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983). The marketplace evidence set out above reflects that

cosmetics and hair care products are promoted and sold together through the same websites, reaching the same classes of consumers. Thus, we find that the trade channels and classes of consumers overlap, weighing in favor of the likelihood of confusion.

III. Conclusion

We find Applicant's mark similar to each of the cited marks, and the goods at issue are related, and move in overlapping channels of trade, reaching the same classes of customers. These factors establish that confusion is likely as to each of the cited marks.

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