

This Opinion is not a  
Precedent of the TTAB

Mailed: April 8, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Beautiful Dreamer LLC*  
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Serial No. 87161372  
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Phillip Thomas Horton of Horton Law, PLLC,  
for Beautiful Dreamer LLC.

David Yontef, Trademark Examining Attorney, Law Office 118,  
Michael W. Baird, Managing Attorney.

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Before Kuhlke, Ritchie and Kuczma,  
Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Beautiful Dreamer LLC (“Applicant”) seeks registration on the Principal Register for the mark THE BEAUTIFUL THINGS in standard characters for services ultimately identified as “Operating on-line marketplaces featuring clothing and jewelry; operating on-line marketplaces for sellers and buyers of goods and/or services” in International Class 35.<sup>1</sup>

<sup>1</sup> Application Serial No. 87161372 was filed on September 6, 2016, under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), based upon Applicant’s allegation of use and use in commerce. In response to a refusal issued under Trademark Act Sections 1 and 45 based upon Applicant’s failure to show use in commerce with the identified services, Applicant

The Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, when used in connection with the identified services, so resembles the following marks as to be likely to cause confusion, mistake or deception:

COSABELLA in typed characters<sup>2</sup> with an English translation as "beautiful thing" registered on the Principal Register for "Retail apparel stores," in Class 35, owned by Luemme, Inc.<sup>3</sup>; and

BELLA COSA in standard characters with an English translation as "beautiful thing" registered on the Principal Register for "Retail Jewelry Store and Online Retail Jewelry Store Services," in Class 35, owned by Bella Cosa Inc.<sup>4</sup>

The Section 2(d) refusal was made final, and is the only remaining refusal at issue in this appeal. The appeal has been fully briefed. We reverse the refusal to register.

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requested and was granted remand for the Examining Attorney to consider substitute specimens or in the alternative an amendment to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b) as the filing basis. Although the Examining Attorney initially accepted the specimens, he subsequently requested remand to reinstate the failure to use refusal. On October 2, 2018, Applicant filed an amendment to the filing basis, and on November 26, 2018, the Examining Attorney accepted the amendment and withdrew the refusal based on failure to use the mark in commerce. Therefore, the Section 2(d) refusal is the only remaining refusal for our consideration on appeal.

<sup>2</sup> Prior to November 2, 2003, "standard character" drawings were known as "typed" drawings. A typed mark is the legal equivalent of a standard character mark. TMEP § 807.03(i) (October 2018).

<sup>3</sup> Registration No. 2604713, issued on August 6, 2002, renewed.

<sup>4</sup> Registration No. 4253014, issued on December 4, 2012, Sections 8 and 15 declaration accepted and acknowledged.

## I. Likelihood of Confusion

When the question is likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also In re Majestic Distilling Co.*, 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 services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). *See also M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006) (even within the *du Pont* list of factors, only factors that are “relevant and of record” need be considered).

### A. Similarity of the Services/Channels of Trade/Consumers

With regard to the services, channels of trade and classes of consumers, we must make our determinations under these factors based on the services as they are identified in the application and cited registrations. *See In re Dixie Rests. Inc.*, 41 USPQ2d at 1534. *See also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 110 USPQ2d at 1161; *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). “This factor considers whether ‘the consuming public may perceive [the respective services of the parties] as related enough to cause confusion about the source or origin of the goods and services.’” *In re St. Helena Hosp.*, 113 USPQ2d at 1086 (quoting *Hewlett Packard*, 62 USPQ2d at 1004). It is well settled that Applicant’s and the Registrants’ services do not have to

be identical or directly competitive to support a finding that there is a likelihood of confusion. *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000). It is sufficient if the respective services 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).

Applicant's services "Operating on-line marketplaces featuring clothing and jewelry; operating on-line marketplaces for sellers and buyers of goods and/or services" as identified encompass the "Retail Jewelry Store and Online Retail Jewelry Store Services," in Reg. No. 4253014 and are encompassed by the "Retail apparel stores" in Reg. No. 2604713 which broadly written includes brick and mortar, and online stores. The term "marketplace" in Applicant's mark is essentially the equivalent of retail store services as used in its identification of services and provides no point of difference in the services. *See, e.g.*, July 7, 2017 Office Action at 2-3 ("[t]he definition of a marketplace is a place where things are sold," "a place, esp. an open place, where goods are offered for sale" and "[t]he space, actual or metaphorical, in which a market operates" [www.yourdictionary.com](http://www.yourdictionary.com)). Applicant does not dispute this point.

Applicant argues without evidentiary support that Applicant's services are "a marketplace for other companies to see their goods [whereas Registrants] only sell

their own goods on their website.” 8 TTABVUE 12. Applicant’s argument is essentially a variation on the failed argument that as actually used the services are not related. However, as explained above, our determination is bounded by the four corners of the application and registrations, we may not read into them limitations based on actual use. *See, e.g., In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764–65 (TTAB 1986) (an applicant may not restrict the scope of its goods or services or the scope of the services covered in the registration by extrinsic argument or evidence). *See also Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647 (TTAB 2008). As identified the registrations do not restrict the sales to the registrants’ own goods, and Applicant’s “Operating on-line marketplaces featuring clothing and jewelry” are not restricted to only the goods of others.

Furthermore, because the services are legally identical and there are no limitations as to channels of trade or classes of purchasers, we presume that Applicant’s and Registrants’ services will be offered via the same channels of trade to the same classes of consumers. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

Applicant's argument based on actual use suffers from the same problem in the context this factor, as we must make our determination as to the channels of trade based on the services as identified.

In view thereof, these *du Pont* factors favor a finding of likelihood of confusion.

*B. Similarity/Dissimilarity of the Marks*

We consider Applicant's mark THE BEAUTIFUL THINGS and Registrants' marks COSABELLA and BELLA COSA and compare them "in their entireties as to appearance, sound, connotation and commercial impression." *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the services offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)). Further, marks "must be considered ... in light of the fallibility of memory ...." *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1 (CCPA 1977)). The proper focus is on the recollection of the average customer, who retains a general

rather than specific impression of the marks. *Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Applicant's mark is clearly different in appearance and sound from the Registrants' respective marks. The Examining Attorney relies on the doctrine of foreign equivalents in making his determination that the marks are similar in connotation and that this similarity is sufficient to find the marks confusingly similar. "Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine similarity of connotation with English word marks. *See Palm Bay Import, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369 , 73 USPQ2d 1689 (Fed. Cir. 2005). The doctrine is applied when it is likely that 'the ordinary American purchaser would 'stop and translate [the term] into its English equivalent.' *Palm Bay, supra* at 1696, quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976.)." *In re Thomas*, 79 USPQ2d 1021, 1024 (TTAB 2006). *See also In re Aquamar, Inc.*, 115 USPQ2d 1122, 1127-28 (TTAB 2015) (equivalency in meaning or connotation can outweigh differences in the marks). However, "such similarity as there is in connotation [between the foreign word mark and the English word mark] must be weighed against the dissimilarity in appearance, sound, and all other factors, before reaching a conclusion on likelihood of confusion as to source." *In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983); *see also In re Ness & Co.*, 18 USPQ2d 1815, 1816 (TTAB 1991).

As shown by the cited registrations, COSABELLA and BELLA COSA translate to BEAUTIFUL THING as compared to Applicant's mark THE BEAUTIFUL THINGS. Applicant does not dispute this, acknowledging that it's "mark may be the foreign equivalent of the registered marks" (8 TTABVUE 9), but contends that the differences in appearance and sound outweigh the similarity in meaning. Therefore, we find that the connotation or meaning of the marks is the same, other than the fact that the marks in the registrations are in singular form and the applied-for mark is in plural form. Applicant asserts that the marks have a different commercial impression based on the singular/plural difference arguing that:

Consumers viewing Applicant's mark will notice 'THINGS' is plural, meaning multiple and not one. The registered trademarks, which are identical, are in singular form. While this may seem like a minute detail, Applicant asserts that the difference in the marks being plural and singular have a significant effect on the consumer. Applicant's mark is used to sell multiple items from multiple sellers. The registered marks products do not come from multiple sellers, but instead, the same seller selling the same items. The apparel at COSABELLA is a beautiful thing, as well as the Jewelry from BELLA COSA. However, consumers seeing Applicant's mark will not think of one particular thing, but instead, a multitude of things since those things come from numerous sellers.

8 TTABVUE 9-10.

Again, with regard to Applicant's argument based on actual use, we cannot read such limitations into the services and therefore the argument is not relevant to the commercial impressions of the respective marks. However, while THE BEAUTIFUL THINGS and COSABELLA and BELLA COSA have a similar meaning when the doctrine of foreign equivalents is applied, "such similarity as there is in connotation



must be weighed against the dissimilarity in appearance, sound and all other factors, before reaching a conclusion on likelihood of confusion as to source.” *In re Sarkli, Ltd.*, 220 USPQ at 113. As the Examining Attorney notes, the meaning of “beautiful thing[s]” “suggest[s] that the services feature attractive or pleasing items.” 21 TTABVUE 10. *See In re L’Oreal S.A.*, 222 USPQ 925, 926 (TTAB 1984) (noting that “similarity in connotation [of the marks] must be viewed as but a single factor in the overall evaluation of likelihood of confusion”). We find that the wording “beautiful things” is somewhat laudatory and to that extent falls more on the suggestive end of the spectrum.<sup>5</sup> Thus, whether or not a consumer may stop and translate COSABELLA or BELLA COSA, the suggestiveness of these marks lessens the possibility that confusion is likely. *See In re Ness & Co.*, 18 USPQ2d at 1815 (finding no likelihood of confusion between the French mark LABONTE, which means “the goodness,” and the mark GOOD-NESS for the same goods because of the laudatory nature of the marks, the dissimilarity in sight and sound, the slight differences in meaning, and the connotation of the mark GOOD-NESS in relation to applicant’s company name “Ness & Co.”); *In re L’Oreal S.A.*, 222 USPQ at 925-26 (applying the doctrine to the French mark HAUTE MODE, which means “high fashion,” but finding no likelihood of confusion between the mark and HI-FASHION SAMPLER because of the suggestive nature of the marks and because of the differences in the marks due to the addition of the term SAMPLER in the English-language mark); and *In re Lar*

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<sup>5</sup> We note in this regard another third-party registration originally cited by the Examining Attorney for the mark BEAUTIFUL THINGS LINKS (Registration No. 4935402 for earrings, necklaces, and other jewelry items). *See* December 15, 2016 Office Action at 9-11.

*Mor Int'l, Inc.*, 221 USPQ 180 (TTAB 1983) (translating the marks BIEN JOLIE and TRES JOLIE to compare their meanings, but concluding that confusion was not likely, despite the marks' substantially similar meanings, because of, *inter alia*, the highly laudatory nature of the wording "JOLIE," and the "obvious visual and phonetic differences" between the marks).

Overall, we find that the dissimilarities in appearance, sound, and commercial impression outweigh the similarity in connotation applying the doctrine of foreign equivalents in view of the inherent weakness of the phrase "beautiful thing[s]" in connection with retail sales of jewelry and clothing, which are things that may be beautiful, and this *du Pont* factor weighs against finding a likelihood of confusion. Moreover, we find this factor to be pivotal in that this factor of the dissimilarities of the marks outweighs the other factors such that confusion is not likely. *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").

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