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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pili Naturals USA Corp.

Serial No. 87517538

Keala Chan, of Chan Hubbard PLLC, for
Pili Naturals USA Corp.

Mark S. Tratos, Trademark Examining Attorney, Law Office 113,
Myriah Habeeb, Managing Attorney.

Before Goodman, Heasley, and Johnson,
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

I. Background

A. The Application


Applicant, Pili Naturals USA Corp., seeks registration on the Principal Register



of the composite mark (with “**PILI**” disclaimed) for “Anti-aging creams;
Anti-wrinkle creams; Beauty creams; Beauty serums; Cosmetic creams; Cosmetic

oils; Facial oils; Moisturizing creams; Moisturizing milks; Moisturizing preparations for the skin; Anti-aging moisturizer; Anti-aging moisturizers used as cosmetics; Skin moisturizer; Skin moisturizers used as cosmetics; **all of the aforesaid goods containing Pili oil**” in International Class 3 (emphasis added).¹

During the course of prosecution, Applicant disclaimed “PILI” and added “all of the aforesaid goods containing Pili oil” to its identification because all of its identified skincare products contain pili oil, an ingredient derived from the fruit or nut of the Pili tree, grown in the Philippines.² The Trademark Examining Attorney then suspended action on the subject Application for two and a half years pending

prosecution of another application, filed earlier, for , mainly for skincare products.³


¹ Application Serial No. 87517538 was filed on July 6, 2017, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s claim of first use anywhere as of May 31, 2017, and use in commerce since at least as early as June 30, 2017. The Application contains the following translation statement: “The English translation of ‘ANI’ in the mark is “HARVEST.” The Application also contains the following description of the mark: “The mark consists of the stylized words ‘PILI ANI’ in which the wording ‘PILI’ is over the wording ‘ANI’; above the wording is an image of a stylized plant in a shaded oval shape.” Color is not claimed as a feature of the mark.

The TTABVUE and Trademark Status & Document Retrieval (“TSDR”) citations refer to the docket and electronic file database for the involved application. All citations to the TSDR database are to the downloadable .pdf version of the documents.

² See Examining Attorney’s Oct. 10, 2017 amendment. See generally Exhibits A through C to Applicant’s September 4, 2020 Response to Office Action (printouts from Applicant’s website, PiliAniUSA.com) at TSDR 29-37.

³ Oct. 30, 2017 suspension letter pending disposition of App. Ser. No. 87404726, filed earlier, on April 10, 2017.

B. The Earlier-filed application Matures Into the Cited Registration

The suspension lasted two and a half years because the earlier-filed application for  encountered its own hurdles. During the course of its prosecution, it transpired that none of the products bearing that mark contained pili oil.⁴ The examining attorney in that case consequently refused registration on the ground that the mark was deceptive, leading consumers to purchase skincare products in the erroneous belief that they contained pili oil. 15 U.S.C. § 1052(a). That refusal was appealed to the Board, which found the evidence of record insufficient to show deceptiveness under Section 2(a). Specifically, the evidence failed to show that consumers in the United States were familiar with pili oil as a skincare ingredient, that those consumers would believe the skincare products contained pili oil, or that the presence of pili oil would be material to their purchasing decisions. The Board thus reversed the refusal of the earlier-filed application, allowing it to proceed to registration.⁵

Ultimately, when the earlier-filed application matured into a Registration, the




Examining Attorney refused registration of Applicant's mark under Section

⁴ Registrant's response to Request for Information: "Applicant states that its goods do not contain pili oil." Applicant's Sept. 4, 2020 Response to Office Action at 40.

⁵ *In re Farmacia Drogueria San Jorge Ltda – Drogueria San Jorge*, No. 87404726 (TTAB Sept. 19, 2019), Applicant's Sept. 4, 2020 Response to Office Action at 153-163.

2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground of likelihood of

confusion with the mark  for, specifically, “Body and beauty care cosmetics; Body oil; Body scrub; Hair lotions; Shampoo-conditioners; Cosmetic preparations for body care; Face and body creams; Face and body lotions; Hair shampoo; Lotions for face and body care; Non-medicated herbal body care products, namely, body oils; Skin and body topical lotions, creams and oils for cosmetic use; Toning lotion, for the face, body and hands” in International Class 3.⁶

When the refusal was made final, Applicant appealed. The appeal is fully briefed. We affirm the refusal to register.

II. Likelihood of Confusion

Section 2(d) of the Trademark Act provides that a mark may be refused registration if it “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive....” 15 U.S.C. § 1052(d).

To determine whether there is a likelihood of confusion between the marks under Section 2(d), we analyze the evidence and arguments under the *DuPont* factors. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973)

⁶ Registration No. 6055880, issued on the Principal Register on May 19, 2020. The registration contains the following description of the mark: “The mark consists of the word ‘pili’ in a special typeface with a characteristic element on the letters ‘I’ and a leaf at the end.” Color is not claimed as a feature of the mark.

“*DuPont*”) cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015). We consider each *DuPont* factor for which there is evidence and argument. *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1161-62 (Fed. Cir. 2019). “Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances.” *Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, *3 (Fed. Cir. 2020). “In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services.” *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945 (Fed. Cir. 2004), cited in *Ricardo Media v. Inventive Software*, 2019 USPQ2d 311355 at *5 (TTAB 2019). In this case, both of those factors, as well as the similar channels of trade, weigh in favor of finding a likelihood of confusion.

A. Similarity of the Goods and Channels of Trade

The second *DuPont* factor concerns the “similarity or dissimilarity and nature of the goods or services as described in an application or registration...,” and the third *DuPont* factor concerns the “similarity or dissimilarity of established, likely-to-continue trade channels.” *DuPont*, 177 USPQ at 567; *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014).

A proper comparison of the goods considers whether the consuming public may perceive them as related enough to cause confusion about the source or origin. *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1086 (Fed. Cir. 2014) cited in *In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1672 (TTAB 2018). “The goods need only be sufficiently related that consumers would be likely to assume, upon encountering the

goods under similar marks, that the goods originate from, are sponsored or authorized by, or are otherwise connected to the same source.” *In re Davia*, 110 USPQ2d 1810, 1815 (TTAB 2014) (citing *Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012)).

Once again, the respective identified goods, in International Class 3, are:

Applicant	Registrant
“Anti-aging creams; Anti-wrinkle creams; Beauty creams; Beauty serums; Cosmetic creams; Cosmetic oils; Facial oils; Moisturizing creams; Moisturizing milks; Moisturizing preparations for the skin; Anti-aging moisturizer; Anti-aging moisturizers used as cosmetics; Skin moisturizer; Skin moisturizers used as cosmetics; all of the aforesaid goods containing Pili oil”	“Body and beauty care cosmetics; Body oil; Body scrub; Hair lotions; Shampoo-conditioners; Cosmetic preparations for body care; Face and body creams; Face and body lotions; Hair shampoo; Lotions for face and body care; Non-medicated herbal body care products, namely, body oils; Skin and body topical lotions, creams and oils for cosmetic use; Toning lotion, for the face, body and hands”

We note initially that the respective skin care products are legally identical. Even though Registrant denied using pili oil during prosecution of its application, its resulting Registration contains no such limitation. Our decision must be based on the identification of goods in the application and registration, *Stone Lion Capital v. Lion Capital*, 110 USPQ2d at 1162, and “a registration that describes goods broadly is presumed to encompass all goods or services of the type described.” *In re Country Oven, Inc.*, 2019 USPQ2d 443903, * 9 (TTAB 2019). Registrant’s broad identification of skin care products encompasses products with or without pili oil. So it encompasses Applicant’s narrowly identified products containing pili oil, and their products are legally identical. *See In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (cast iron and steel legally identical to carbon steel, alloy steel, semi-steel, and malleable and grey iron castings); *In re Hughes Furniture Indus., Inc.*, 114

USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”).

The legal identity of Applicant’s and Registrant’s skin care products establishes the relatedness of their Class 3 goods. *See In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015) (“[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.”).

Additionally, though, the Examining Attorney shows that Applicant’s skin care products and Registrant’s hair care products are related. Printouts from various websites—such as The Body Shop,⁷ Neutrogena,⁸ Kiehl’s,⁹ True Botanicals,¹⁰ Aveeno,¹¹ Philosophy,¹² and Peter Thomas Roth¹³—show that the same entity commonly provides skin care and hair care products of the types identified in the application and cited registration under the same mark. This evidence supports a finding that the skin care and hair care products “are closely related cosmetic and toiletry products that are, as the record shows, generally sold through the same outlets....” *Revlon, Inc. v. La Maur, Inc.*, 157 USPQ 602, 605 (TTAB 1968).

The Examining Attorney adds sixteen third-party registrations showing that

⁷ TheBodyShop.com, July 1, 2020 Office Action at 8-13.

⁸ Neutrogena.com, July 1, 2020 Office Action at 21-26.

⁹ Kiehls.com, September 28, 2020 Office Action at 84-97.

¹⁰ TrueBotanicals.com, September 28, 2020 Office Action at 98-105.

¹¹ Aveeno.com, September 28, 2020 Office Action at 117-129.

¹² Philosophy.com, September 28, 2020 Office Action at 142-156.

¹³ PeterThomasRoth.com, September 28, 2020 Office Action at 157-170.

Applicant's and Registrant's respective goods may emanate from a single source under a single mark.¹⁴ For example:

Registration No.	Mark	Pertinent Goods
3573057	TRANSPARENT CLINIC	Skin care lotions, creams and gels; facial and body creams, lotions and gels; skin and facial moisturizer; skin cleansing lotions, creams and gels.
3402585	JORDAN ESSENTIALS	Skin exfoliating lotions, skin or facial moisturizing sprays,; skin cleansing lotion; fair conditioners, skin cleansing cream, skin cream, vanishing cream; hair gel; non-medicated hair care preparations; hair shampoo; skin cleansing gel, skin emollients.
3906102	ARIS (and Design)	Hair care lotions; hair care preparations; hair cleaning preparations; hair conditioners; hair shampoo; beauty creams for body care; body cream soap; body and beauty care cosmetics; body lotions; body oils; face and body creams; face and body lotions.
3528921	BEAUTY SOCIETY	Beauty creams; beauty gels; beauty lotions; body and beauty care cosmetics; cosmetic creams for skin care; cosmetic preparations for skin renewal; face and body creams; face and body lotions; lotions for face and body care; skin conditioners.
4672052	TIBI	Cosmetic creams for skin care; cosmetic preparations for body care; face and body creams; face and body lotions; hair care preparations; hair cleaning preparations; hair shampoos and conditioners; lotions for face and body care; non-medicated skin care preparations.
4649716	WHOLEFACE HAPPINESS	Beauty creams for body care; cosmetic creams for skin care; cosmetic nourishing creams; face and body creams; Hair care creams; non-medicated skin care creams and lotions; skin creams.

Such third-party registrations may serve to suggest that Applicant's and Registrant's goods are of a type that may emanate from a single source. *See Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir.

¹⁴ Sept. 28, 2020 Office Action at 12-61.

2002) (evidence that “a single company sells the goods and services of both parties, if presented, is relevant to a relatedness analysis”); *DeVivo v. Ortiz*, 2020 USPQ2d 10153, *13 (TTAB 2020).

Because Applicant’s and Registrant’s goods are identical in part and otherwise related, they are presumed to travel in the same channels of trade to the same classes of customers—ordinary consumers of cosmetic and toiletry products. *See In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where the goods are legally identical, the channels of trade and classes of purchasers are considered to be the same); *In re Solid State Design Inc.*, 125 USPQ2d 1409, 1414 (TTAB 2018).

Applicant does not dispute the similarity of the goods or the channels of trade. We find accordingly that the second and third *DuPont* factors favor a finding of likelihood of confusion.

B. Similarity of the Marks

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Applicant’s and Registrant’s marks in their entireties, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *Stone Lion v. Lion Capital*, 110 USPQ2d at 1160; *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) *aff’d* 777 Fed. Appx. 516 (Fed. Cir. 2019) (citing *In re Davia*, 110 USPQ2d at 1812).



Once again, Applicant's mark is and Registrant's mark is .

As the Examining Attorney correctly notes, Applicant adopts the entire literal wording of Registrant's mark, PILI, and places it prominently as the first word in its own mark, where it is "most likely to be impressed in the mind of a purchaser and remembered." *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988), *quoted in TiVo Brands LLC v. Tivoli, LLC*, 129 USPQ2d 1097, 1115-16 (TTAB 2019). While there is no explicit rule that the marks are automatically similar because one contains the other, "[l]ikelihood of confusion often has been found where the entirety of one mark is incorporated within another." *Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2d 1651, 1660 (TTAB 2014) (Opposer's mark PRECISION DISTRIBUTION CONTROL contains the entirety of Applicant's mark PRECISION). *quoted in Double Coin Holdings Ltd. v. Tru Development*, 2019 USPQ2d 377409, *6-7 (TTAB 2019) (ROAD WARRIOR contains WARRIOR).

While we do not discount the effect of ANI in Applicant's mark, it is insufficient to overcome the strong similarity engendered by the identical and dominant word PILI. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049 n. 3 (Fed. Cir. 2018) (accepting Board's finding that identical wording at the beginning of the marks "lessens the possible influence of differing wording at the end."). "Thus, if the dominant portion of both marks is the same, then confusion may be likely

notwithstanding peripheral differences.” *In re Denisi*, 225 USPQ 624, 624 (TTAB 1985).

The strong literal similarity in the marks’ wording dominates any minor differences in their stylization or design. “[T]he verbal portion of a word and design mark likely will be the dominant portion. ... This makes sense given that the literal component of brand names likely will appear alone when used in text and will be spoken when requested by consumers.” *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1911 (Fed. Cir. 2012) *cited in In re Information Builders Inc.*, 2020 USPQ2d 10444, *7 (TTAB 2020). The design elements do not serve as points of distinction, as both marks have leaf designs. And the respective type fonts in which the words are displayed are not so distinctive or different as to denote different sources.

Applicant focuses on the marks’ commercial impressions. It argues that its mark is descriptive or suggestive of its principal ingredient: pili oil, from the pili tree native to the Philippines, whereas Registrant’s mark is arbitrary. Applicant elaborates:

Applicant does not dispute that its mark projects a suggestive commercial impression of Pili nut oil. ...

What Applicant strongly disputes, however, is that the Cited Mark has the same commercial impression. The Examining Attorney’s evidence simply does not support that the commercial impression of the Cited Mark is Pili oil.¹⁵

The image shows the word "pili" in a stylized, black, serif font. The letters are lowercase and have a classic, slightly ornate appearance. The 'p' has a distinct loop, and the 'i's have small dots. The font is centered horizontally in the text block.

Applicant cites the prosecution history of the cited mark, and the Board’s 2019 decision finding that “the record does not show that the relevant U.S.

¹⁵ Applicant’s brief, 4 TTABVUE 5.

consumer generally would be familiar with pili as an ingredient in such goods.”¹⁶ In that meticulous and detailed opinion, the Board found that most of the evidence of pili-based skincare products comes from foreign websites, primarily from the Philippines,” and that “statements on many of the websites actually corroborate the obscurity of pili as a skincare ingredient.”¹⁷ Indeed, as Applicant notes, “many of these online articles and blogs are actually marketing materials and product placements about Applicant’s PILI ANI goods, in which Applicant seeks to educate the public about Pili oil.”¹⁸

Applicant agrees that “PILI” is an obscure term in the United States, and that it must educate U.S. consumers as to its meaning:

Applicant is not aware of any newly arisen evidence would support that consumers are more aware of skincare products with Pili oil since the Board’s 2019 opinion.¹⁹

Recognizing this, Applicant sought to build a market for Pili oil in the US, launching its luxury cosmetics products containing Pili oil in mid-2017. In addition to Applicant’s product packaging, descriptions and web pages, which emphasized that all of its products contain Pili oil, Applicant’s marketing included placement of blogs and articles to educate the public on the benefits of Pili oil.²⁰

... Applicant must educate the consumer about the existence and benefit of Pili oil, not take it at face value that the consuming public is aware of this ingredient.²¹

¹⁶ Applicant’s brief, 4 TTABVUE 4 (quoting *In re Farmacia Drogueria San Jorge Ltda – Drogueria San Jorge*, No. 87404726 (TTAB Sept. 19, 2019), Applicant’s Sept. 4, 2020 Response to Office Action at 158).

¹⁷ *In re Farmacia Drogueria San Jorge Ltda – Drogueria San Jorge*, No. 87404726 (TTAB Sept. 19, 2019), Applicant’s Sept. 4, 2020 Response to Office Action at 159-60).

¹⁸ Applicant’s brief, 4 TTABVUE 5.

¹⁹ Applicant’s brief, 4 TTABVUE 8.

²⁰ Applicant’s brief, 4 TTABVUE 3.

²¹ Applicant’s brief, 4 TTABVUE 12-13.

Applicant thus maintains that its mark, suggesting or describing its principal ingredient of pili oil, conveys a wholly different commercial impression from Registrant's mark: "In this case, we have PILI as an arbitrary word vs. PILI ANI suggestive of the Pili harvest."²²

Applicant's and Registrant's trade dress reflects this difference, it argues. Registrant's products appear "in a lowercase, naturalistic font (with the word 'natural' appearing in lowercase, small font below the second half of the word) evoking an arbitrary, naturistic impression. The labels also feature the name and image of the key ingredient in each product."²³ For example:



²² Applicant's brief, 4 TTABVUE 14.

²³ Applicant's brief, 4 TTABVUE 9.

²⁴ Applicant's brief, 4 TTABVUE 10, Sept. 4, 2020 Response to Office Action at 59.

By contrast, Applicant argues, “Applicant’s specimen and materials show that ‘WITH PILI AND ELEMI OIL’ or ‘MADE WITH PURE PILI OIL’ is printed on every label, thereby linking the word PILI in Applicant’s mark with the inclusion of Pili oil in the product’s ingredients.”



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As evidenced by this trade dress, Applicant concludes, the marks’ shared word, “PILI,” though literally identical, conveys differing commercial impressions for the differing goods. It cites a trio of decisions in support of this position: *In re Sears, Roebuck & Co.*, 2 USPQ2d 1312, 1314 (TTAB 1987) (holding CROSS-OVER for bras and CROSSOVER for ladies’ sportswear not likely to cause confusion, noting that the term ‘CROSS-OVER’ was suggestive of the construction of applicant’s bras, whereas ‘CROSSOVER,’ as applied to registrant’s goods, was “likely to be perceived by purchasers either as an entirely arbitrary designation, or as being suggestive of sportswear which ‘crosses over’ the line between informal and more formal wear . . . or the line between two seasons”); *In re British Bulldog, Ltd.*, 224 USPQ 854, 856 (TTAB 1984) (holding PLAYERS for men’s underwear and PLAYERS for shoes not likely to cause confusion, agreeing with applicant's argument that the term

²⁵ Applicant’s brief, 4 TTABVUE 11, Sept. 4, 2020 Response to Office Action at 29, 31.

‘PLAYERS’ implies a fit, style, color, and durability suitable for outdoor activities when applied to shoes, but “implies something else, primarily indoors in nature” when applied to men’s underwear); *In re Sydel Lingerie Co.*, 197 USPQ 629, 630 (TTAB 1977) (holding BOTTOMS UP for ladies’ and children’s underwear and BOTTOMS UP for men’s clothing not likely to cause confusion, noting that the wording connotes the drinking phrase ‘Drink Up’ when applied to men’s clothing, but does not have this connotation when applied to ladies’ and children’s underwear).²⁶

We find Applicant’s argument unavailing. Where, as here, marks are used on legally identical goods, the degree of similarity between the marks necessary to support a determination that confusion is likely declines. *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (“When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines.”) *quoted in In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010). As noted, Registrant’s identification of goods is broad enough to encompass skincare goods containing pili oil.

What’s more, the consuming public does not scrutinize marks. *Information Builders Inc.*, 2020 USPQ2d 10444, at *6 (“However, in the normal environment of the marketplace where purchases are actually made, purchasers and prospective purchasers would not usually have the opportunity for a careful examination of these marks in minute detail...”). “The marks ‘must be considered ... in light of the fallibility of memory’ and ‘not on the basis of side-by-side comparison.’” *In re St.*

²⁶ Applicant’s brief, 4 TTABVUE 13-14.

Helena Hosp., 113 USPQ2d at 1085 (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977)). The proper focus is on the recollection of the average consumer, who retains a general rather than specific impression of the marks. *In re FabFitFun*, 127 USPQ2d at 1675.

The classes of consumers of Applicant's and Registrant's products—ordinary consumers of cosmetic and toiletry products—cannot be expected to draw the fine distinctions that Applicant expects. As the Examining Attorney cogently points out, the classes of consumers may reasonably be expected to fall into two groups: those who are unfamiliar with pili oil (the larger group in the United States) and those who are familiar with pili oil (the smaller group). The Examining Attorney observes:

If the consumer is familiar with the Pili nut or Pili oil, then the wording "PILI" would connote the Pili nut or Pili oil and would create a commercial impression the Applicant's and Registrant's goods have something to do with the Pili nut or Pili oil. Alternatively, if a consumer were not familiar with a Pili nut or Pili oil, then the wording "PILI" would create a commercial impression of an arbitrary or coined word. A consumer's knowledge of the Pili nut or Pili oil, and its uses, will directly affect the commercial impression created by the wording in the marks. In either case, the commercial impression of the wording "PILI" is the same.²⁷


We agree. If, as Applicant acknowledges, "PILI" is an obscure term, unfamiliar to most consumers in the United States, then it creates the same arbitrary commercial impression in both marks. If, on the other hand, Applicant succeeds in "educating" consumers about pili oil, then "PILI" would convey the same connotation and commercial impression in both marks. Applicant's trio of cited cases—e.g., *In re Sears, Roebuck*, 2 USPQ2d at 1314 (CROSS-OVER versus CROSSOVER)—is thus

²⁷ Examining Attorney's brief, 6 TTABVUE 10.

distinguishable, for in those cases, consumers would perceive differing connotations in connection with different goods; here they would not.

Applicant's addition of the suffix "ANI," translated as "harvest," would not change this impression. If consumers are unfamiliar with the Philippine Tagalog word "PILI," they would be even less familiar with "ANI." And if Applicant succeeds in educating U.S. consumers that PILI ANI means "pili harvest," that would simply direct their focus back to the dominant, shared word PILI.²⁸ As noted, the identical "PILI" wording at the beginning of Applicant's mark "lessens the possible influence of differing wording at the end." *In re Detroit Athletic*, 128 USPQ2d at 1049 n. 3.

The differing trade dress does not avert the marks' similarity. The samples shown above would have to be examined with the utmost scrutiny to discern their differences; yet as we have seen, the purchasing public cannot be expected to scrutinize such details. *See In re Information Builders Inc.*, 2020 USPQ2d 10444, at *6. And as those samples demonstrate, trade dress "may be changed at any time." *Miles Labs. Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445, 1452 (TTAB

1986). Registrant changes its display of its  mark, sometimes displaying it alone, other times with the word "natural." Its optional addition of "natural" does not dispel its similarity with Applicant's mark. The Examining Attorney rightly notes, "if a consumer is familiar with Pili oil, perhaps from encountering the Applicant's goods, the wording 'natural' on the Registrant's packaging will likely reinforce the same or similar commercial impression created by the wording 'PILI' in the Applicant's

²⁸ See Examining Attorney's brief, 6 TTABVUE 8.

mark.”²⁹ As the Board has observed, “we do not consider how Applicant and Registrant actually use their marks in the marketplace, but rather how they appear in the registration and the application. We must compare the marks as they appear in the drawings, and not on any labels that may have additional wording or information.” *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1186 (TTAB 2018). In sum, the issue is the marks, and they are similar.

For these reasons, the first *DuPont* factor weighs in favor of finding a likelihood of confusion.

III. Conclusion

Because the marks, goods, and channels of trade are all similar, we find that Applicant’s mark is likely to cause confusion with the cited registered mark under Section 2(d). 15 U.S.C. § 1052(d).



Decision: The refusal to register Applicant’s mark PILI ANI is affirmed.

²⁹ Examining Attorney’s brief, 6 TTABVUE 12-13.