

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: April 17, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board

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In re Aiko Beauty, Inc.

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Serial No. 88109580
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Tommy SF Wang of Wang IP Law Group PC,
for Aiko Beauty, Inc.

Brendan McCauley, Trademark Examining Attorney, Law Office 114,
Laurie Kaufman, Managing Attorney.

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Before Kuczma, Lynch, and Pologeorgis,
Administrative Trademark Judges.

Opinion by Pologeorgis, Administrative Trademark Judge:

Aiko Beauty, Inc. (“Applicant”) seeks registration on the Principal Register of the standard character mark GIVON for “Cosmetics; Cosmetics and cosmetic preparations; Cosmetic creams; Cosmetic creams for skin care; Cosmetic preparations for skin care; Facial cleansers; Skin cleansers; Skin lotions; Skin toners” in International Class 3.¹

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¹ Application Serial No. 88109580, filed on September 8, 2018, based on an allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground of likelihood of confusion with the registered mark  for "Make-up" in International Class 3.²

When the refusal was made final, Applicant appealed and requested reconsideration. When the request for reconsideration was denied, this appeal resumed. Both Applicant and the Examining Attorney filed briefs. For the reasons explained below, we affirm the refusal to register.³

I. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*"); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *DuPont* factor for which there is evidence and argument of record. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v.*

² Registration No. 5598916, issued on November 6, 2018. The registration includes the following description of the mark: "The mark consists of the stylized 'GIVONI' with two 'G's intertwined above." Additionally, the registration has a translation statement that reads as follows: "The wording 'GIVONI' or it's [sic] mark of two intertwined 'G's has no meaning in a foreign language."

³ 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.

Capital City Bank Grp. Inc., 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination.”).

In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods or services. See *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (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.”); see also *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

A. Similarity of the Goods

We initially turn to the comparison of the goods under the second *DuPont* factor. In making our determination regarding the relatedness of the goods, we must look to the goods as identified in Applicant’s application and the cited registration. See *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys., Inc. v. Hous. Computs. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the

identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.")); *see also In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011).

Moreover, registration must be refused in a particular class if Applicant's mark for any of its identified goods in that class is likely to cause confusion with the Registrant's mark for any of its identified goods. *See SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 938-39 (Fed. Cir. 1983) (holding that a single good from among several may sustain a finding of likelihood of confusion); *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods or services in the application).

Applicant's goods include "cosmetics." Registrant's goods are identified as "make-up." The record includes the dictionary definition of the term "makeup" which is defined as "cosmetics applied to the face to improve or change your appearance."⁴ Thus, Applicant's broadly worded "cosmetics" encompass and are legally identical to Registrant's "make-up."

Applicant argues that the goods are different. Specifically, Applicant maintains that its skin care products are used to alleviate dry skin and reduce the appearance of fine lines and wrinkles.⁵ In contrast, Applicant contends that Registrant's goods

⁴ November 9, 2018 Office Action, TSDR pp. 15-16.

⁵ Applicant's Appeal Brief, p. 10, 4 TTABVUE 11.

are exclusively makeup brushes.⁶ In support of its argument, Applicant has submitted photographs of its skin care products, as well as screenshots from Applicant's and Registrant's websites.⁷

The purported restrictions identified by Applicant, however, do not appear in the identification of goods in Applicant's involved application or the cited registration. As noted above, the question of likelihood of confusion is determined based on the description of goods in the application and registration at issue, not on extrinsic evidence of actual use. *See Stone Lion Capital Partners, LP*, 110 USPQ2d at 1162; TRADEMARK MANUAL OF EXAMINING PROCEDURE ("TMEP") § 1207.01(a)(iii) (October 2018) ("An applicant may not restrict the scope of its goods and/or the scope of the goods covered in the registration by extrinsic argument or evidence ..."). Here, there are no restrictions to the goods in the involved application or the cited registration, and neither Applicant's statements in its brief nor the extrinsic evidence of actual use submitted by Applicant limits the scope or nature of the goods for purposes of our likelihood of confusion analysis. Therefore, Applicant's argument is unavailing.

Because we find that the identification of goods recited in Applicant's involved application and the cited registration contain no limitations, Applicant's "cosmetics" are presumed to encompass all types of cosmetics, including Registrant's "make-up." *See, e.g., In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) ("Applicant's broadly worded identification of 'furniture' necessarily encompasses

⁶ *Id.*

⁷ March 29, 2019 Response to Office Action, TSDR pp. 11-16 and 25-32; September 27, 2019 Request for Reconsideration, TSDR pp. 18-19.

Registrant's narrowly identified 'residential and commercial furniture.');" *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992). As such, the goods are legally identical in part.

Thus, the second *DuPont* factor strongly favors a finding of likelihood of confusion.

B. Similarity of Trade Channels and Classes of Purchasers

Next we consider established, likely-to-continue channels of trade, the third *DuPont* factor. Because we have found that Applicant's and Registrant's goods are legally identical in part, we must presume that these goods travel through the same channels of trade and are offered to the same or overlapping classes of purchasers. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding Board entitled to rely on this legal presumption in determining likelihood of confusion); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same).

Thus, the third *DuPont* factor also weighs in favor of finding a likelihood of confusion.

C. Similarity of the Marks

We next consider the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 369 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). "The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their

commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *In re i.am.symbolic, LLC*, 123 USPQ2d at 1748 (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (internal quotation marks omitted)). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Moreover, where, as here, the goods at issue are in-part legally identical, the degree of similarity between the marks necessary to find a likelihood of confusion declines. *In re Viterra*, 101 USPQ2d at 1908; *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); *In re Max Capital Grp., Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010).

Applicant’s mark is GIVON and the cited mark is  GIVONI. In challenging the refusal, Applicant maintains that its applied-for mark is distinct from the cited mark visually, aurally and in overall commercial impression.⁸ Specifically, Applicant contends that its mark features the single term “GIVON” in plain text with no design elements.⁹ In contrast, Applicant maintains that Registrant’s mark consists of the stylized letters “GG” that are intertwined in bold and prominently displayed above

⁸ Applicant’s Appeal Brief, p. 7-9, 4 TTABVUE 8-10.

⁹ *Id.* at p. 8, 4 TTABVUE 9.

the stylized text “GIVONI.”¹⁰ Applicant further argues that although both Applicant’s mark and the cited mark contain the lettering “GIVON,” Registrant’s mark contains additional wording that signify key visual differences between the marks in their entireties.¹¹

With regard to pronunciation, Applicant maintains that the marks at issue differ aurally because Applicant’s and Registrant’s marks are composed of different words and Applicant’s mark does not contain the interlocking letters “GG” nor the letter “I” at the end of the mark. Given these clear visual and aural differences between the marks, Applicant concludes that confusion is unlikely to occur.

Finally, Applicant contends that Registrant has abandoned its mark.¹² In support of its contention, Applicant submitted purported screenshots from a Google search indicating that “No information is available for this page” and from Registrant’s website which states that “[t]his store is currently unavailable due to maintenance.”¹³

We find Applicant’s arguments unpersuasive. The entirety of Applicant’s mark is nearly identical to the GIVONI portion of the cited mark which, as discussed below, we find to be the dominant element of the cited mark. The only difference between

¹⁰ *Id.*

¹¹ *Id.*

¹² *Id.* at p. 13, 4 TTABVUE 14.

¹³ September 27, 2019 Request for Reconsideration, TSDR pp. 24-26. Interestingly, Applicant was able to submit screenshots from Registrant’s website to support its argument that Registrant’s goods are limited to makeup brushes but now claims that the website is unavailable. We assume that when Applicant accessed Registrant’s website to obtain evidence of the purported nature of Registrant’s goods, the website was available at such time.

Applicant's GIVON mark and the GIVONI component of the cited mark is the addition of the letter "I" at the end of the term GIVONI in Registrant's mark. The inclusion of the letter "I" at the end of the term GIVONI in the cited mark may cause the marks to be somewhat dissimilar in sound. However, as noted above, the average purchaser retains a general rather than a specific impression of trademarks. As such, while GIVON and GIVONI may not be pronounced in the identical manner, they are nonetheless aurally similar.

Moreover, although the description of the mark in the cited registration provides that the mark includes two intertwining letter "G"s, we find that relevant consumers, upon viewing the cited mark in its entirety, would not observe this portion of the cited mark as described in the registration but instead would view this component as a decorative design element. We note that even Applicant refers to this portion of the cited mark as a design element.¹⁴ That being said, we find that while the construed design element is a visually significant feature of Registrant's mark, we nonetheless find that it is entitled to somewhat lesser weight in assessing the cited mark's commercial impression. As such, we find that the dominant source-indicating feature of the composite cited mark is the wording GIVONI, for the following reasons.

In word and design marks such as Registrant's mark, the words are normally accorded greater weight because they are likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the goods. *See In re Viterra, Inc.*, 101 USPQ2d at 1911 (citing *CBS Inc. v. Morrow*, 708 F.2d

¹⁴ Applicant's Appeal Brief, pp. 4, 7 and 8, 4 TTABVUE 5 and 8-9.

1579, 218 USPQ 198, 200 (Fed. Cir. 1983)). Additionally, it is the word portion of Registrant's mark, not the design, that would be articulated when discussing or calling for Registrant's goods. Also, the design element appears smaller than the wording GIVONI in the cited mark, causing consumers to focus more on the term GIVONI instead of the design component.

Further, Applicant's involved mark is in standard characters. A mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. *See In re Viterra Inc.*, 101 USPQ2d at 1909; *In re Mighty Leaf Tea*, 94 USPQ2d at 1260; TMEP §1207.01(c)(iii). Thus, a mark presented in stylized characters and/or with a design element generally will not avoid likelihood of confusion with a similar mark in typed or standard characters because the word portion could be presented in the same manner of display. *See, e.g., In re Viterra Inc.*, 101 USPQ2d at 1909; *Squirtco v. Tomy Corp.*, 216 USPQ at 939 (stating that "the argument concerning a difference in type style is not viable where one party asserts rights in no particular display"). Accordingly, in this case Applicant's mark could be displayed in any stylization, including one identical to cited mark. As a result, the stylization of the cited mark does not overcome the similarity between the marks.

Moreover, there is no explicit rule that marks are automatically similar where the entirety of the junior mark is incorporated in the cited mark. However, where, as here, there is no evidence of record to demonstrate that the cited mark is either conceptually or commercially weak, and, therefore, is entitled to the normal scope of

protection accorded an inherently strong mark, the fact that Applicant's mark is subsumed by Registrant's mark only increases the similarity between them. This especially holds true where, as here, the marks are used on goods that are legally identical in part.

With respect to the meanings of the mark, the Examining Attorney submitted dictionary definitions of each mark that indicates that neither has a defined meaning.¹⁵ It would therefore be reasonable for an average consumer to perceive the marks as visually similar coined terms. Thus, to the extent a meaning will be ascribed to either mark, the marks are similar in connotation or meaning.

With regard to Applicant's contention that Registrant has abandoned its mark, we find that this is an improper collateral attack on the cited registration. As the Federal Circuit held when dismissing an applicant's contentions that the cited registered mark was no longer in use in *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997), "the present ex parte proceeding is not the proper forum for such a challenge." "[I]t is not open to an applicant to prove abandonment of [a] registered mark" in an ex parte proceeding; thus, the "appellant's argument . . . that [a registrant] no longer uses the registered mark . . . must be disregarded." *Id.* (quoting *Cosmetically Yours, Inc. v. Clairol Inc.*, 424 F.2d 1385, 165 USPQ 515, 517 (CCPA 1970)). Thus, we have given no consideration to Applicant's abandonment argument.

¹⁵ November 9, 2018 Office Action, TSDR pp. 9-14.

In sum, when viewing the marks in their entireties, we find that GIVON and  GIVONI are far more similar than dissimilar. Moreover, given that Applicant's GIVON mark and the GIVONI portion of the cited mark are practically identical, we find the similar commercial impressions between Applicant's mark and the cited mark are sufficient to cause purchasers and prospective purchasers who then encounter the other's mark on the other's goods, to mistakenly believe that these products originate from or are sponsored by the same entity, particularly since the goods at issue are legally identical in part. *See Phillip Morris Incorporated v. Rothmans of Pall Mall Limited*, 180 USPQ 592 (TTAB 1973) and cases cited therein.

Accordingly, the first *DuPont* factor favors a finding of likelihood of confusion.

D. Nature and Extent of Any Actual Confusion

Applicant points to the absence of evidence of actual confusion, the seventh *DuPont* factor, as weighing in its favor.¹⁶ We do not accord significant weight to Applicant's contention, particularly given that the involved application was filed based upon Applicant's assertion of a bona fide intent to use the mark. Moreover, while Applicant has submitted excerpts of its website displaying its identified goods under its involved mark, there is no evidence as to the length of time Applicant has been using its mark (presumably use commenced recently), nor is there any evidence

¹⁶ Applicant's Appeal Brief, p. 13, 4 TTABVUE 14. Unlike in *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1163-64 (Fed. Cir. 2019), as noted below, Applicant did not argue nor submit any evidence relating to the eighth *DuPont* factor, i.e., the length of time during and conditions under which there has been concurrent use without evidence of actual confusion. Accordingly, we have given no consideration to the eighth *DuPont* factor in our analysis.

as to the geographic reach, or the amount and extent of Applicant's sales of Applicant's identified goods under its involved mark.

The Federal Circuit has addressed the question of the weight to be given to an assertion of no actual confusion by an applicant in an ex parte proceeding:

With regard to the seventh DuPont factor, we agree with the Board that Majestic's uncorroborated statements of no known instances of actual confusion are of little evidentiary value. *See In re Bissett-Berman Corp.*, 476 F.2d 640, 642, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving testimony of appellant's corporate president's unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion). A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight, [citation omitted], especially in an ex parte context.

In re Majestic Distilling, 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003).

Accordingly, while examples of actual confusion may point toward a finding of a likelihood of confusion, an absence of such evidence is not as compelling in support of a finding of no likelihood of confusion. Thus, we cannot conclude from the lack of instances of actual confusion that confusion is not likely to occur.

Therefore, this *DuPont* factor is neutral.

II. Conclusion

We have considered all of the arguments and evidence of record. We find that the Applicant's goods and the goods identified in the cited registration are legally identical in part, and are presumed to move in common channels of trade to the same or overlapping classes of consumers. We further find Applicant's mark and the mark in the cited registration are more similar than dissimilar, and no evidence of record establishes that the cited mark is so weak in connection with the goods at issue to

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overcome the identity in part of the goods and similarity of the marks. In view thereof, we conclude that Applicant's GIVON mark, as used in connection with the goods identified in its involved application, so resembles the cited mark  GIVONI for Registrant's identified goods as to be likely to cause confusion or mistake, or to deceive under Section 2(d) of the Trademark Act.

Decision: The refusal to register Applicant's standard character GIVON mark under Section 2(d) of the Trademark Act is affirmed.