

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 vivawave Co., Ltd.

Serial No. 88848727

Sang Ho Lee of Novick, Kim & Lee, PLLC
for vivawave Co., Ltd.

James Prizant, Trademark Examining Attorney, Law Office 128,
Travis Wheatley, Managing Attorney.

Before Kuhlke, Adlin and Coggins, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Applicant vivawave Co., Ltd. seeks registration of the mark MOOD NARRATIVE,
in standard characters, for:

non-medicated skin care preparations being functional cosmetics; nail cosmetics; lip glosses; non-medicated lip balm; non-medicated make-up; cosmetic preparations for baths; body care cosmetics; beauty care cosmetics; non-medicated shampoos; non-medicated toiletry preparations; non-medicated cosmetic preparations for skin care; hair rinses; cosmetic creams; mask pack for cosmetic purposes; cosmetic oils; make-up removing preparations; cosmetics in Class 3; and

advertising services; marketing services; import-export agency services; **promoting the goods and services of others by means of operating an on-line comprehensive shopping mall**; business intermediary services relating to mail order by telecommunications,

namely, the matching of potential private investors with entrepreneurs in the field of mail order who are in need of funding; publicity agents; **retail store services featuring cosmetic utensils; wholesale store services featuring cosmetic utensils; sales agency services, namely, retail store services featuring goods owned by others for which applicant receives a commission upon the sale featuring cosmetic utensils;** sales brokerage services, namely, facilitating transactions between buyers and sellers featuring cosmetic utensils; **wholesale store services featuring cosmetics; retail store services featuring cosmetics; sales agency services, namely, retail store services featuring goods owned by others for which applicant receives a commission upon the sale featuring cosmetics;** sales brokerage services, namely, facilitating transactions between buyers and sellers featuring cosmetics in Class 35.¹

The Examining Attorney refused registration as to the Class 3 goods under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles the registered mark NARRATIVE COSMETICS, in standard characters ("COSMETICS" disclaimed), for "theatrical make-up" in International Class 3,² that it is likely to cause confusion. The Examining Attorney also issued a final partial refusal to register some of Applicant's Class 35 services (those bolded above) based on another registration.³ After the refusals became final, Applicant

¹ Application Serial No. 88848727, filed March 26, 2020 under Section 44(d) of the Trademark Act, 15 U.S.C. § 1126(d), and later amended to Section 44(e), 15 U.S.C. § 1126(e), based on Korean Registration No. 40-1734395.

² Registration No. 5825710, issued August 6, 2019.

³ Registration No. 2579928.

appealed only the refusal to register its Class 3 goods. Applicant and the Examining Attorney filed briefs.

I. Examining Attorney's Objection Sustained

The Examining Attorney's objection, 6 TTABVUE 4,⁴ to Exhibits 1 and 4 to Applicant's Appeal Brief is sustained, because the materials were not introduced until after Applicant appealed. Trademark Rule 2.142(d) ("The record should be complete prior to the filing of an appeal. Evidence should not be filed with the Board after the filing of a notice of appeal.").

II. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*") (setting forth factors to be considered); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each *DuPont* factor about which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated

⁴ Citations to the appeal record are to TTABVUE, the Board's online docketing system. The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear.

by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

A. The Goods, Their Channels of Trade and Classes of Consumers

The goods are legally identical in part because Applicant’s “non-medicated make-up” is broad enough to encompass Registrant’s “theatrical make-up.” It is sufficient for a finding of likelihood of confusion if legal identity is established for any item encompassed by the identification of goods in a particular class. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981).

Because the goods are legally identical in part, we presume that the channels of trade and classes of purchasers for those goods also overlap. *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); *Am. Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011).

The legal identity of the goods and their overlapping channels of trade and classes of purchasers not only weigh heavily in favor of finding a likelihood of confusion, but also reduce the degree of similarity between the marks necessary to find a likelihood of confusion. *In re Viterra*, 101 USPQ2d at 1908; *In re Mighty Leaf Tea*, 94 USPQ2d at 1260; *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010).

B. The Marks

We compare the marks “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 *DuPont*, 177 USPQ at 567). Obviously, the marks are similar because they share the word NARRATIVE, but different because in Applicant's mark NARRATIVE is preceded by MOOD, whereas in Registrant's mark NARRATIVE is followed by COSMETICS. Ultimately, we find that the similarities between the marks outweigh the differences.

The shared term NARRATIVE is the most distinctive and dominant portion of Registrant's mark, for two reasons. First, the mark's trailing term COSMETICS is generic for or at best highly descriptive of "theatrical make-up," and disclaimed. The term is therefore entitled to less weight in our analysis. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) ("Regarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.'") (quoting *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)); *see also In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (DELTA, not the disclaimed term CAFÉ, is the dominant portion of the mark THE DELTA CAFÉ). Second, the word NARRATIVE is the dominant portion of Registrant's mark because it comes first. *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) ("the identity of the marks' two initial words is particularly significant because consumers typically notice those words first"); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988)

(“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”); *see also*, *Palm Bay Imps. Inc.*, 73 USPQ2d at 1692.

We take judicial notice that the shared term NARRATIVE means “a story or a description of a series of events” or “a particular way of explaining or understanding events.”⁵ Thus, because COSMETICS is not source identifying in Registrant’s mark but instead merely names the types of goods Registrant sells, the meaning and commercial impression conveyed by Registrant’s mark derives primarily from the word NARRATIVE. In the context of Registrant’s goods, that term conveys a line of theatrical make-up products that depicts or explains events. More specifically, when used for the identified “theatrical make-up,” NARRATIVE COSMETICS conveys the commercial impression that Registrant’s make-up will enable actors or other theatrical performers to better convey events or stories, presumably by highlighting or changing the actors’ or performers’ facial expressions or appearance.

The meaning and commercial impression conveyed by Applicant’s mark is remarkably similar. We take judicial notice that “mood” means “the way you feel at a particular time.”⁶ Applicant seems to agree with this definition. November 8, 2020

⁵ dictionary.cambridge.org/us/dictionary/English/narrative. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *Threshold TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1038 n.14 (TTAB 2010).

⁶ dictionary.cambridge.org/us/dictionary/English/mood.

Office Action response TSDR 10⁷ (“The term ‘mood’ in Applicant’s Mark, which we often think of as being a synonym for emotion or feeling”). Thus, in the context of Applicant’s “non-medicated make-up,” MOOD NARRATIVE conveys a product that helps convey the wearer’s mood. Applicant concedes as much in its Appeal Brief. 4 TTABVUE 8 (“make-up can be applied in a manner that reflects one’s mood (*e.g.*, glitter, festive eye makeup”). Similarly, MOOD NARRATIVE conveys that the goods may help the user/wearer depict or explain events or stories related to how he or she feels at the time, again by highlighting or changing the wearer’s facial expression or appearance. *Id.* (“Applicant’s mark ‘MOOD NARRATIVE’ suggests that Applicant’s makeup can be used to express or narrate one’s feelings.”).

It is settled that similarity in appearance, sound, meaning or commercial impression alone may be enough to establish that the marks are confusingly similar. *In re 1st USA Realty Prof., Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988). But here, the marks’ similarities do not end with their meanings and commercial impressions. The shared word NARRATIVE makes the marks somewhat similar in appearance and sound as well, especially because the second word in Registrant’s mark is merely a non-source identifying generic or highly descriptive term on which consumers are unlikely to focus.

We recognize that MOOD comes first in Applicant’s mark, and as explained above,

⁷ Citations to the application file are to the USPTO’s Trademark Status & Document Retrieval (“TSDR”) online database, by page number, in the downloadable .pdf format.

it could therefore be perceived as the dominant feature of Applicant's mark. But in this case, as explained above, the word "MOOD" specifies the type of "NARRATIVE" conveyed by the mark as a whole – a narrative about how the user feels at a particular time. Thus, the word "MOOD" is connected and draws attention to the word "NARRATIVE," such that the mark as a whole is likely to be perceived as a phrase. In other words, consumers may not separate the mark into dominant and non-dominant components, but instead view the mark as an integrated whole.

Because the marks are so similar, especially in the meaning and commercial impression they convey, consumers familiar with NARRATIVE COSMETICS theatrical make-up who encounter MOOD NARRATIVE cosmetics could very well assume that the products come from the same source. Indeed, consumers could perceive one of these cosmetic/make-up products as a product line extension of the other, or one of these marks as a brand extension of the other.

We have considered the differences between the marks, but we must consider whether these differences are "likely to be recalled by purchasers seeing the marks at spaced intervals," i.e. consumers who encounter one party's mark and do not encounter the other's until later. *Grandpa Pidgeon's of Mo., Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973). Thus, we keep in mind: (1) "the fallibility of memory over a period of time;" and (2) that the "average" purchaser "normally retains a general rather than a specific impression of trademarks." *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). *See also In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) ("marks must be considered

in light of the fallibility of memory”) (citation, internal quotation marks, and ellipsis omitted). Here, the marks convey such similar meanings and commercial impressions, and look and sound similar enough, that when used for legally identical products confusion is likely, especially among consumers encountering the marks “at spaced intervals.”⁸

III. Conclusion

The goods are legally identical in part, the channels of trade and classes of consumers are presumed to overlap, and the marks are more similar than dissimilar. Confusion is likely.

Decision: The refusal to register Applicant’s mark for the identified Class 3 goods under Section 2(d) of the Trademark Act is affirmed. The application will proceed with respect to the following Class 35 services not subject to the partial refusal:

⁸ Applicant introduced third-party Registration No. 5693644 for the mark IDENTITY NARRATIVE for cosmetics and related products, November 8, 2020 Office Action response TSDR 13-14, pointing out that it coexists with the two registrations cited against its application (only one of which remains relevant on appeal). *Id.* at 10. However, neither the existence of third-party registrations nor any of the evidence in their prosecution records (when it is of record) compels a specific result in later, allegedly analogous cases. *See, e.g., Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1377 (Fed. Cir. 2018) (“these prior registrations do not compel registration of [Applicant’s] proposed mar[k]”) (citing *In re Cordua Rests., Inc.*, 823 F.3d 594, 600 (Fed. Cir. 2016)); *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 91 USPQ2d 1218, 1221 (Fed. Cir. 2009) (“Even if all of the third-party registrations should have been refused registration under section 1052(a), such errors do not bind the USPTO to improperly register Applicant’s marks.”). Furthermore, Applicant’s attempt to rely on additional third-party registrations by merely listing them in its Appeal Brief, 4 TTABVUE 6, rather than properly and timely introducing them into the record, is unavailing. The IDENTITY NARRATIVE registration, standing alone, is not enough to establish that the cited mark is conceptually weak.

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“advertising services; marketing services; import-export agency services; business intermediary services relating to mail order by telecommunications, namely, the matching of potential private investors with entrepreneurs in the field of mail order who are in need of funding; publicity agents; sales brokerage services, namely, facilitating transactions between buyers and sellers featuring cosmetic utensils; sales brokerage services, namely, facilitating transactions between buyers and sellers featuring cosmetics.” *See* Trademark Rule 2.65(a)(1); TMEP § 718.02(a).