

ESTTA Tracking number: **ESTTA791723**

Filing date: **12/27/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Primavera Life GmbH
Granted to Date of previous extension	01/01/2017
Address	Naturparadies 1 Oy-Mittelberg, D-87466 GERMANY

Attorney information	Patrick J. Concannon Nutter, McClennen & Fish, LLP Seaport West 155 Seaport Boulevard Boston, MA 02210 UNITED STATES doCKET@nutter.com,pconCannon@nutter.com Phone:617-439-2177
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Applicant Information

Application No	86873750	Publication date	07/05/2016
Opposition Filing Date	12/27/2016	Opposition Period Ends	01/01/2017
International Registration No.	NONE	International Registration Date	NONE
Applicant	Amorepacific Corporation Cheonggyecheon-ro 100 Jung-gu Seoul, KOREA, REPUBLIC OF		

Goods/Services Affected by Opposition


Class 003. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Beauty masks; Cosmetics; Liquid bath soaps; Shampoos

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Other	Subject application is barred from registration by issue preclusion

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3632484	Application Date	02/07/2008
Registration Date	06/02/2009	Foreign Priority	NONE

		Date	
Word Mark	PRIMAVERA		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use: First Use: 1997/03/31 First Use In Commerce: 1997/03/31 perfumery; cosmetics; [essential oils for personal use; essential oils for per- fumed candles;] essential oils for oil burners, essential oils for saunas; essential oils in airsprays, fragrance oil comprised of essential oils [; perfume oils for the manufacture of cosmetic preparations]</p> <p>Class 021. First use: First Use: 1997/03/31 First Use In Commerce: 1997/03/31 fragrance oil burners, oil diffuser [incense burners]</p> <p>Class 035. First use: First Use: 2005/11/30 First Use In Commerce: 2005/11/30 wholesale stores and retail store services featuring cosmetics, perfumery, [hair lotions,] soaps and essential oils, oil burners, [incense burners and] stone dif- fusers</p>		

Attachments	77390907#TMSN.png(bytes) Notice of Opposition with Exhibits.pdf(444947 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/PJC/
Name	Patrick J. Concannon
Date	12/27/2016

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 86/873,750
Filed on January 13, 2016
For the Mark: PRIMERA
Published in the Official Gazette on July 5, 2016

Primavera Life GmbH,)	Opposition No.: _____
)	
-v-)	
)	
Amorepacific Corporation,)	
Applicant.)	
)	

BOX TTAB FEE
Assistant Commissioner for
Trademarks P.O. Box 1451
Alexandria, VA 22313-1451

Notice of Opposition

Opposer, Primavera Life GmbH, a company organized and existing under the laws of the Federal Republic of Germany and having its primary address at Am Fichtenholz 5, Sulzberg 87477, Germany (“Opposer”), believes that it would be damaged by issuance of the proposed registration of the trademark PRIMERA in Application No. 86/873,750 (the “Application”) published in the Official Gazette on July 5, 2016 and filed by Amorepacific Corporation, a corporation organized and existing under the laws of the Republic of Korea (“Applicant”), and hereby opposes the Application. Opposer filed timely Requests for Extensions of Time to Oppose the Application on July 25, 2016 and November 1, 2016, which were approved by the Board.

The grounds for this Opposition are as follows:

Opposer and Opposer's Mark

1. Opposer is a company organized and existing under the laws of the Federal Republic of Germany, with its principal place of business at Am Fichtenholz 5, Sulzberg 87477, Germany.

2. Opposer owns an incontestable U.S. registration for and common law rights in the mark PRIMAVERA (in standard characters, Registration No. 3,632,484) in connection with “perfumery; cosmetics; essential oils for oil burners, essential oils for saunas; essential oils in airsprays, fragrance oil comprised of essential oils” in Class 3 and related goods and services in Classes 21 and 35, registered on June 2, 2009. A copy of Opposer’s registration certificate, along with a U.S.P.T.O. trademark and assignment database print-out reflecting the current status and title of the registration, are enclosed at Exhibit A.

3. Opposer first used the mark PRIMAVERA commercially in the U.S. in relation to the Class 3 products listed in U.S. Trademark Registration No. 3,632,484 by at least as early as March 31, 1997, and such use is ongoing.

4. Opposer’s incontestable Registration No. 3,632,484 for the PRIMAVERA mark is valid and subsisting, unrevoked and uncanceled, and constitutes conclusive evidence of the validity of Opposer’s exclusive right to use PRIMAVERA in commerce in connection with the goods and services described in the registration, without condition or limitation. Opposer’s registration for PRIMAVERA constitutes constructive notice of Opposer’s ownership of that mark for the goods and services listed in the registration, as provided for by §§ 7(b) and 22 of the Lanham Act, 15 U.S.C.A. §§ 1057(b) and 1072.

5. Opposer also owns nationwide common law trademark rights in its PRIMAVERA mark in connection with the goods and services in the above registration by virtue of its

widespread, continuous and exclusive use of the mark throughout the United States. Opposer established such common law rights in its PRIMAVERA mark prior to any date of first use or priority date upon which Applicant can rely in relation to the applied-for mark PRIMERA.

6. Opposer has expended time and effort in advertising its goods and services under PRIMAVERA. As a result of Opposer's advertising and promotional activities and continuous and exclusive use of PRIMAVERA, the relevant public has come to associate and identify that mark exclusively with Opposer, and the mark has attained a high degree of consumer recognition. Opposer derives substantial goodwill from such identification by consumers.

Applicant and Applicant's Mark

7. Opposer hereby incorporates by reference the allegations in Paragraphs 1 through 6 hereof as if fully set forth herein.

8. Upon information and belief, Applicant is a corporation organized and existing under the laws of the Republic of Korea with an address of 181, 2ga, Hangang-ro, Yongsan-gu, Seoul, Republic of Korea 140-777.

9. Applicant filed the subject Application for the mark PRIMERA (in standard character form) on an intent-to-use basis on January 13, 2016. The Application covers "beauty masks; cosmetics; liquid bath soaps; shampoos" in International Class 3.

Count I: Likelihood of Confusion

10. Opposer hereby incorporates by reference the allegations in Paragraphs 1 through 10 hereof as if fully set forth herein.

11. The mark PRIMERA, as set forth in the Application, is highly similar in appearance, sound, connotation, and overall commercial impression to Opposer's PRIMAVERA mark. Applicant is merely deleting two letters from Opposer's PRIMAVERA mark.

12. The goods in the Application and the goods and services in Opposer's pleaded registration either directly overlap (and thus must be presumed absent explicit limitations not applicable here to be traveling in the same channels of trade), or otherwise are closely related, and target the same audiences. Opposer's Registration No. 3,632,484 covers, *inter alia*, "perfumery; cosmetics; essential oils for oil burners, essential oils for saunas; essential oils in airsprays, fragrance oil comprised of essential oils" and the goods in the Application are "beauty masks; cosmetics; liquid bath soaps; shampoos". The goods in the Application all are either cosmetics or closely related to cosmetics.

13. Because Applicant's and Opposer's marks are confusingly similar, and because Applicant's and Opposer's goods identified by their respective marks overlap or are closely related, and target the same class of consumers (moreover, consumers who are not sophisticated or careful in their purchasing decisions), there is a strong likelihood that the public will believe that Applicant's goods advertised and sold under PRIMERA emanate from, are associated with, are connected to or are sponsored by Opposer. Accordingly, consumer confusion is likely between the PRIMAVERA and the PRIMERA mark in the Application.

14. Accordingly, Applicant's PRIMERA mark in the Application is likely to cause confusion, mistake, or to deceive the public into believing that Applicant's goods and services emanate from or are somehow affiliated or associated with, connected to or sponsored by Opposer, in violation of 15 U.S.C. § 1052(d).

15. If Applicant is permitted to register or use the PRIMERA mark in relation to the applied-for goods, there would be likelihood of confusion as to the source of Applicant's goods, resulting in damage and injury to Opposer.

Count II: Issue Preclusion

16. Opposer successfully opposed Applicant's Appl. No. 77/830,858 for PRIMAVERA (standard characters) in Opposition No. 91196106. The Board issued a judgment on the merits on September 11, 2013, finding that Opposer owns prior rights in its PRIMAVERA mark and that Applicant's PRIMERA is likely to cause consumer confusion with Opposer's PRIMAVERA as used or proposed for use in relation to "cosmetics and cosmetic preparations; non-medicated nourishing creams for skin; skin milk lotions; facial creams; cosmetic creams; toilet waters; make-up preparations; non-medicated skin care preparations; foundation cream; shampoos; beauty masks; make-up powder". Copies of the Board's decision on the merits, and also of an order dismissing a potential appeal of that decision before the Federal Circuit Court of Appeals, are included herewith at Exhibit B. Opposer did not challenge Applicant's earlier application in relation to "dentifrices", so Appl. No. 77/830,858 matured to registration solely covering "dentifrices" under Reg. No. 4787755 on August 11, 2015.

17. The issues to be determined in the present opposition, namely, priority and likelihood of confusion, are identical to those considered in Opposition No. 91196106. The goods in Appl. No. 77/830,858 that Opposer successfully opposed in Opposition No. 91196106 directly overlap the goods appear in the present Application. The mark in successfully opposed Appl. No. 77/830,858, PRIMERA in standard characters, is identical to the mark in the subject Appl. Serial No. 86/873,750. The determination of issues of priority and likelihood of confusion were necessary and essential to the judgment in Opposition No. 91196106. Applicant was fully represented in Opposition No. 91196106.

18. The issues raised in this opposition were fully litigated by these same parties in Opposition No. 91196106, and the Board made detailed and specific findings in favor of Opposer as to both priority and likelihood of confusion. On the basis of issue preclusion,

Applicant is estopped from litigating the issues of priority and likelihood of confusion, and Opposer is entitled to judgment as a matter of law.

Prayer for Relief

WHEREFORE, Opposer prays that this Opposition be sustained and that the Application be in all respects denied. The filing fee of \$300 for this Notice of Opposition is being submitted electronically with this Notice. Please charge Deposit Account No. 141449 in the event the actual fee is greater than the payment submitted or is inadvertently omitted.

Dated: December 27, 2016

Respectfully submitted,

NUTTER MCLENNEN & FISH, LLP

By: 

Patrick J. Concannon

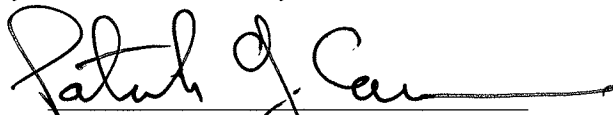
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Boston, Massachusetts 02210
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pconcannon@nutter.com
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Attorneys for Opposer

[Certificate of Electronic Mailing and Certificate of Service Appear on following page]

CERTIFICATE OF ELECTRONIC MAILING

I hereby certify that the foregoing Notice of Opposition is being submitted electronically through the Trademark Trial and Appeal Board's ESTTA System on this 27th day of December, 2016.


Patrick J. Concannon

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing NOTICE OF OPPOSITION is being deposited with the U.S. Postal Service with sufficient postage as first class mail this 27th day of December 2016 in an envelope addressed to Applicant's correspondent of record at the following address:

Sofia Jeong, Esq.
Troutman Sanders LLP
600 Peachtree Street NE, Suite 5200
Atlanta, GA 30308

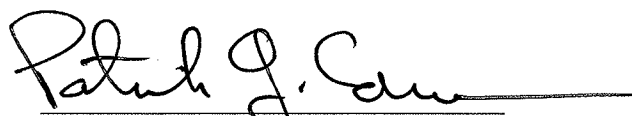

Patrick J. Concannon

Exhibit A

Int. Cls.: 3, 21, and 35

Prior U.S. Cls.: 1, 2, 4, 6, 13, 23, 29, 30, 33, 40, 50, 51,
52, 100, 101, and 102

Reg. No. 3,632,484

United States Patent and Trademark Office

Registered June 2, 2009

TRADEMARK
SERVICE MARK
PRINCIPAL REGISTER

PRIMAVERA

PRIMAVERA LIFE GMBH (FED REP GERMANY
CORPORATION)
AM FICHTENHOLZ 5
SULZBERG, FED REP GERMANY 87477

FOR: PERFUMERY; COSMETICS; ESSENTIAL
OILS FOR PERSONAL USE; ESSENTIAL OILS FOR
PERFUMED CANDLES; ESSENTIAL OILS FOR OIL
BURNERS, ESSENTIAL OILS FOR SAUNAS; ESSEN-
TIAL OILS IN AIRSPRAYS, FRAGRANCE OIL
COMPRISED OF ESSENTIAL OILS; PERFUME OILS
FOR THE MANUFACTURE OF COSMETIC PRE-
PARATIONS, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51
AND 52).

FIRST USE 3-31-1997; IN COMMERCE 3-31-1997.

FOR: FRAGRANCE OIL BURNERS, OIL DIFFU-
SER INCENSE BURNERS, IN CLASS 21 (U.S. CLS. 2,
13, 23, 29, 30, 33, 40 AND 50).

FIRST USE 3-31-1997; IN COMMERCE 3-31-1997.

FOR: WHOLESALE STORES AND RETAIL
STORE SERVICES FEATURING COSMETICS, PER-
FUMERY, HAIR LOTIONS, SOAPS AND ESSEN-
TIAL OILS, OIL BURNERS, INCENSE BURNERS
AND STONE DIFFUSERS, IN CLASS 35 (U.S. CLS.
100, 101 AND 102).

FIRST USE 11-30-2005; IN COMMERCE 11-30-2005.

THE MARK CONSISTS OF STANDARD CHAR-
ACTERS WITHOUT CLAIM TO ANY PARTICULAR
FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 1,055,372, 3,051,081,
AND OTHERS.

SN 77-390,907, FILED 2-7-2008.

MARLENE BELL, EXAMINING ATTORNEY

From: TMOfficialNotices@USPTO.GOV
Sent: Wednesday, June 17, 2015 11:00 PM
To: trademark@lockelord.com
Subject: Official USPTO Notice of Acceptance/Acknowledgement Sections 8 and 15: U.S. Trademark RN 3632484: PRIMAVERA: Docket/Reference No. 301658-81218

Serial Number: 77390907
Registration Number: 3632484
Registration Date: Jun 2, 2009
Mark: PRIMAVERA
Owner: Primavera Life GmbH

Jun 17, 2015

NOTICE OF ACCEPTANCE UNDER SECTION 8

The declaration of use or excusable nonuse filed for the above-identified registration meets the requirements of Section 8 of the Trademark Act, 15 U.S.C. §1058. **The Section 8 declaration is accepted.**

NOTICE OF ACKNOWLEDGEMENT UNDER SECTION 15

The declaration of incontestability filed for the above-identified registration meets the requirements of Section 15 of the Trademark Act, 15 U.S.C. §1065. **The Section 15 declaration is acknowledged.**

The registration will remain in force for the class(es) listed below for the remainder of the ten-year period, calculated from the registration date, unless canceled by an order of the Commissioner for Trademarks or a Federal Court.

Class(es):
003, 021, 035

TRADEMARK SPECIALIST
POST-REGISTRATION DIVISION
571-272-9500

REQUIREMENTS FOR MAINTAINING REGISTRATION

WARNING: Your registration will be canceled if you do not file the documents below during the specified time periods.

Requirements in the First Ten Years

What and When to File: You must file a declaration of use (or excusable nonuse) and an application for renewal between the 9th and 10th years after the registration date. See 15 U.S.C. §§1058, 1059.

Requirements in Successive Ten-Year Periods

What and When to File: You must file a declaration of use (or excusable nonuse) and an application for renewal between every 9th and 10th-year period, calculated from the registration date. See 15 U.S.C. §§1058, 1059.

Grace Period Filings

The above documents will be considered as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

*****The USPTO WILL NOT SEND ANY FURTHER NOTICE OR REMINDER OF THESE REQUIREMENTS. THE REGISTRANT SHOULD CONTACT THE USPTO ONE YEAR BEFORE THE EXPIRATION OF THE TIME PERIODS SHOWN ABOVE TO DETERMINE APPROPRIATE REQUIREMENTS AND FEES.*****

To view this notice and other documents for this application on-line, go to <http://tdr.uspto.gov/search.action?sn=77390907>. NOTE: This notice will only be available on-line the next business day after receipt of this e-mail.

The Trademark organization is beta testing a next generation examination system. As a result, there may be instances where Office actions have unexpected formatting or spacing issues. The Office is working on improvements to resolve these issues and appreciates your patience. Please contact us at [TMFeedback](#) if you have comments or issues with the appearance of a particular Office action or its attachments.

STATUS DOCUMENTS

[Back to Search](#)

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Generated on: This page was generated by TSDR on 2016-12-27 11:36:50 EST

Mark: PRIMAVERA

PRIMAVERA

US Serial Number: 77390907

Application Filing Date: Feb. 07, 2008

US Registration Number: 3632484

Registration Date: Jun. 02, 2009

Register: Principal

Mark Type: Trademark, Service Mark

TM5 Common Status

LIVE/REGISTRATION/Issued and Active

Descriptor:



The trademark application has been registered with the Office.

Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.

Status Date: Jun. 17, 2015

Publication Date: Jun. 10, 2008

Notice of Allowance Date: Sep. 02, 2008

Mark Information

Mark Literal Elements: PRIMAVERA

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Related Properties Information

Claimed Ownership of US [1055372](#), [2637973](#), [3051081](#) and others
Registrations:

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: perfumery; cosmetics; [essential oils for personal use; essential oils for perfumed candles;] essential oils for oil burners, essential oils for saunas; essential oils in airsprays, fragrance oil comprised of essential oils [; perfume oils for the manufacture of cosmetic preparations]

International Class(es): 003 - Primary Class

U.S Class(es): 001, 004, 006, 050, 051, 052

Class Status: ACTIVE

Basis: 1(a)

First Use: Mar. 31, 1997

Use in Commerce: Mar. 31, 1997

For: fragrance oil burners, oil diffuser [incense burners]

International Class(es): 021 - Primary Class

U.S Class(es): 002, 013, 023, 029, 030, 033, 040, 050

Class Status: ACTIVE

Basis: 1(a)

First Use: Mar. 31, 1997

Use in Commerce: Mar. 31, 1997

For: wholesale stores and retail store services featuring cosmetics, perfumery, [hair lotions,] soaps and essential oils, oil burners, [incense burners and] stone diffusers

International Class(es): 035 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: ACTIVE

Basis: 1(a)

First Use: Nov. 30, 2005

Use in Commerce: Nov. 30, 2005

Basis Information (Case Level)

Filed Use: No	Currently Use: Yes	Amended Use: No
Filed ITU: Yes	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: Primavera Life GmbH
Owner Address: Am Fichtenholz 5
 Sulzberg GERMANY 87477
Legal Entity Type: CORPORATION
State or Country Where Organized: GERMANY

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Patrick J. Concannon
Docket Number: 301658-81218
Attorney Primary Email Address: trademark@lockelord.com
Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: PATRICK J. CONCANNON
 Nutter McClennen & Fish LLP
 155 Seaport Boulevard
 Seaport West
 Boston, MASSACHUSETTS UNITED STATES 02210-2604
Phone: 617-439-2177
Fax: 617-310-9177
Correspondent e-mail: doCKET@nutTER.com pconcannon@nutTER.com
Correspondent e-mail Authorized: Yes

Domestic Representative

Domestic Representative Name: Patrick J. Concannon
Phone: 617.239.0419
Fax: 866.955.8685

Domestic Representative e-mail: trademark@lockelord.com
Domestic Representative e-mail Authorized: Yes

Prosecution History

Date	Description	Proceeding Number
Jul. 24, 2015	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Jun. 17, 2015	NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - E-MAILED	
Jun. 17, 2015	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	76985
Jun. 17, 2015	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	76985
May 29, 2015	TEAS SECTION 8 & 15 RECEIVED	
Jun. 02, 2009	REGISTERED-PRINCIPAL REGISTER	

Apr. 29, 2009	LAW OFFICE REGISTRATION REVIEW COMPLETED	76539
Apr. 24, 2009	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Apr. 24, 2009	EXAMINER'S AMENDMENT ENTERED	88888
Apr. 24, 2009	NOTIFICATION OF EXAMINERS AMENDMENT E-MAILED	
Apr. 24, 2009	EXAMINERS AMENDMENT E-MAILED	
Apr. 24, 2009	SU-EXAMINER'S AMENDMENT WRITTEN	76629
Apr. 05, 2009	NOTIFICATION OF NON-FINAL ACTION E-MAILED	
Apr. 05, 2009	NON-FINAL ACTION E-MAILED	
Apr. 05, 2009	SU - NON-FINAL ACTION - WRITTEN	76629
Mar. 16, 2009	STATEMENT OF USE PROCESSING COMPLETE	76873
Feb. 27, 2009	USE AMENDMENT FILED	76873
Mar. 16, 2009	EXTENSION 1 GRANTED	76873
Feb. 27, 2009	EXTENSION 1 FILED	76873
Mar. 16, 2009	CASE ASSIGNED TO INTENT TO USE PARALEGAL	76873
Feb. 27, 2009	TEAS EXTENSION RECEIVED	
Feb. 27, 2009	TEAS STATEMENT OF USE RECEIVED	
Sep. 02, 2008	NOA MAILED - SOU REQUIRED FROM APPLICANT	
Jun. 10, 2008	PUBLISHED FOR OPPOSITION	
May 21, 2008	NOTICE OF PUBLICATION	
May 07, 2008	LAW OFFICE PUBLICATION REVIEW COMPLETED	76539
May 07, 2008	ASSIGNED TO LIE	76539
May 06, 2008	APPROVED FOR PUB - PRINCIPAL REGISTER	
Apr. 24, 2008	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Apr. 24, 2008	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Apr. 24, 2008	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Mar. 22, 2008	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Mar. 22, 2008	NON-FINAL ACTION E-MAILED	6325
Mar. 22, 2008	NON-FINAL ACTION WRITTEN	76629
Mar. 18, 2008	ASSIGNED TO EXAMINER	76629
Feb. 12, 2008	NEW APPLICATION ENTERED IN TRAM	

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: TMEG LAW OFFICE 105

Date in Location: Jun. 17, 2015

Assignment Abstract Of Title Information - None recorded

Proceedings - Click to Load

Exhibit B

3475828.2

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed:
September 11, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Primavera Life GmbH

v.

Amorepacific Corporation

Opposition No. 91196106
to application Serial No. 77830858
filed on September 21, 2009

Patrick J. Concannon and Kelly Donahue of Edwards Wildman
Palmer LLP for Primavera Life GmbH.

Terrence J. McAllister and Jeffrey J. Scepaniski of Ohlandt,
Greeley, Ruggiero & Perle, L.L.P. for Amorepacific
Corporation.

Before Seeherman, Lykos and Shaw, Administrative Trademark
Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Primavera Life GmbH has opposed the application of
Amorepacific Corporation to register PRIMERA, in standard
characters, as a trademark for:

Cosmetics and cosmetic preparations; non-
medicated nourishing creams for skin; skin milk

Opposition No. 91196106

lotions; facial creams; cosmetic creams; toilet waters; make-up preparations; non-medicated skin care preparations; foundation cream; shampoos; beauty masks; make-up powder.¹

The application includes the statement that "the wording 'PRIMERA' has no meaning in a foreign language."

Opposer has brought this opposition on the ground of likelihood of confusion Section 2(d) of the Trademark Act. In particular, opposer has alleged that it is the owner of common law rights in and trademark registrations for the mark PRIMAVERA for perfumery, cosmetics and essential oils, as well as for related goods and services in Classes 21 and 35, and for skin cleansers, creams, perfume, bath oil, hair shampoo and hair spray; that since as early as March 31, 1997, and prior to any date on which applicant can rely, opposer has used the mark PRIMAVERA in connection with cosmetics, perfumery and essential oils; and that applicant's mark is confusingly similar to opposer's mark, and its goods either directly overlap or are closely related to opposer's goods, and applicant's goods will be offered in the same channels of trade to the same class of consumers, and therefore applicant's mark for its

¹ Application Serial No. 77830858, filed September 21, 2009, based on an asserted intent to use the mark in commerce (Section 1(b) of the Trademark Act). The identification of goods also includes dentifrices. In the notice of opposition, opposer states that it does not oppose the registration of the mark for such goods. ¶7.

Opposition No. 91196106

identified goods is likely to cause confusion or mistake or to deceive.

In its answer, applicant denied the salient allegations of the notice of opposition.

By operation of the rules, the record includes the pleadings and the file of the opposed application. Opposer made its pleaded registration No. 3632484 of record, pursuant to Trademark Rule 2.122(d)(1), by submitting as part of the notice of opposition a copy of this registration, taken from the electronic records of the U.S. Patent and Trademark Office, and showing its status and title. The registration is for PRIMAVERA in standard characters, for "perfumery; cosmetics; essential oils for personal use; essential oils for perfumed candles; essential oils for oil burners, essential oils for saunas; essential oils in airsprays, fragrance oil comprised of essential oils; perfume oils for the manufacture of cosmetic preparation."²

² This registration issued on June 2, 2009. The registration also includes goods in Class 21 and services in Class 35.

Opposer also submitted as part of its notice of opposition its Registration No. 1055372 for PRIMAVERA, in standard characters, for "skin cleansers, toning lotion, night cream, moisturizing cream, perfume bathoil, hair shampoo and hair spray." This registration issued on January 4, 1977, and was renewed in 1997. At the time opposer filed the notice of opposition, in 2010, Office records listed the status of the registration as active (although it would have been due for renewal in 2007). As is standard Board practice, we have checked the status of the

Opposition No. 91196106

Opposer has also submitted, under notices of reliance, specimens submitted by opposer as part of its pleaded and proved Registration No. 3632484; applicant's responses to opposer's requests for admission, the pertinent admissions being that applicant has not used its mark in commerce and has not advertised or promoted any product or service under the mark in commerce, and that applicant's products will be sold directly to consumers of all types;³ certain third-party registrations listing both cosmetics and shampoo; status and title copies of two additional (and unpleaded) registrations owned by opposer, Nos. 3252000 and 3051081, for marks that include the term PRIMAVERA;⁴ a printout from the USPTO TESS database with the search results for

registration at this time, and Office records show that it was cancelled on June 30, 2012. Therefore, we have not considered this registration in determining opposer's likelihood of confusion claim. We also point out that opposer has not discussed this registration in its brief, and is obviously not relying on it.

³ Opposer submitted applicant's response to the requests for admission in its entirety, even though applicant denied most of the requests. Requests that are denied have no probative value, and, in fact, the rules do not provide for submission of such denials by notice of reliance. See Trademark Rule 2.120(j)(3)(i); Life Zone Inc. v. Middleman Group Inc., 87 USPQ2d 1953, 1957 (TTAB 2008).

⁴ It is clear that opposer does not rely on these registrations as a basis for its likelihood of confusion claim, and therefore there is no issue as to whether the question of likelihood of confusion with respect to these registrations was tried by express or implied consent of the parties. It was not.

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PRIMAVERA in Class 3,⁵ and the electronic record for one of the third-party registrations shown in that TESS search summary, No. 4113379, for a mark that includes the term PRIMAVERA; a printout from the USPTO TESS database with the search results for marks containing the term PRIMERA,⁶ and the electronic record of one of the applications shown in that search, namely, an additional application, Serial No. 85216621, owned by applicant for PRIMERA in lower case font for various cosmetics, skin and eye creams, shampoo and dentifrices; and excerpts from third-party internet websites which show both opposer's and applicant's goods offered for sale.

Applicant has made of record, by notices of reliance, dictionary definitions for PRIMAVERA and the results of dictionary searches for PRIMERA; internet printouts showing recipes in which the word PRIMAVERA has been used; webpages showing listings of restaurants having PRIMAVERA as part of the restaurant name; applicant's Registration No. 4274041 for PRIMERA in stylized lower case font for various skin lotions and creams, cosmetics, shampoo and dentifrices,

⁵ TESS search summaries cannot be made of record by notice of reliance. However, applicant has treated this document as being of record, brief, p. 7, and we therefore deem it to be stipulated into the record.

⁶ As noted in footnote 5, this document cannot be made of record by notice of reliance, but because applicant has treated it as being of record, we deem it to be stipulated into the record.

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which issued on January 15, 2013--this is the registration resulting from application Serial No. 85216621 that opposer made of record; and third-party registrations, as well as a third-party application, for PRIMAVERA and PRIMERA marks for goods and services unrelated to those at issue herein.

Neither party took any testimony depositions. Both filed briefs, and opposer filed a reply brief.

Standing

Opposer has established its standing by making its registration No. 3632484 for PRIMAVERA of record. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Affirmative Defenses

In its answer applicant did not assert any affirmative defenses. Thus, the first question we will consider is what is essentially an affirmative defense argued by applicant in its brief. Applicant points to its Registration No. 4274041 for PRIMERA in stylized format,

primera

and argues that because opposer acquiesced to the registration of that mark, there is no confusion between applicant's subject mark and opposer's mark. The

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application that resulted in this registration was filed on January 13, 2011, after the filing of the notice of opposition on August 16, 2010, and the filing of the answer on October 26, 2010, so applicant could not have pleaded an affirmative defense based on this application/registration in its answer. However, opposer submitted a copy of the then-application under a notice of reliance, and in its brief anticipated that applicant might assert a prior registration or Morehouse defense.⁷ In the circumstances, we deem the pleadings amended to assert both acquiescence and a Morehouse defense. Fed. R. Civ. P. 15(b).

The Morehouse defense is "an equitable defense, to the effect that if the opposer can not be further injured because there already exists an injurious registration, the opposer can not object to an additional registration that does not add to the injury." *O-M Bread Inc. v. United States Olympic Committee*, 65 F.3d 933, 36 USPQ2d 1041 (Fed. Cir. 1995). As the Court explained in Morehouse:

[A]s a matter of law, the opposer cannot be damaged, within the meaning of section 13 of the statute, by the issuance to the applicant of a second registration where applicant already has an existing registration of the same mark for the same goods. Implicit in this are corollaries that if opposer cannot procure the cancellation

⁷ *Morehouse Mf. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969).

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of the existing registration it cannot prevent the granting of the second registration; that there is no added damage from the second registration of the same mark if the goods named in it are in fact the same, and that if there is no added damage there is no ground for sustaining the opposition.

160 USPQ at 717. Thus, the Morehouse defense requires "that the prior and proposed marks be essentially the same. O-M Bread, 36 USPQ2d at 1045.

Applicant's registration is for the mark PRIMERA in a particular stylized form, while the mark applicant seeks to register is PRIMERA in standard character form. As opposer points out, if applicant were to obtain a registration for PRIMERA in standard characters, that registration would give applicant the right to use the mark without limitation as to a particular font or style. Citigroup Inc. v. Capital City Bank Group Inc., 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011) (a registrant that obtains a standard character mark "is entitled to depictions of the standard character mark regardless of font, style, size, or color").⁸

⁸ It should be noted that the Board decision that resulted in the appeal to the Federal Circuit dealt with virtually the same circumstances. There, the applicant attempted to assert a Morehouse defense in seeking to register its mark in standard character format based on its prior registrations of the words in stylized form. The Board found that, because the standard character mark was not limited to any special or particular form, the marks in the application and the prior registrations were "not essentially the same marks for purposes of the prior

Further, the identification of goods in the present application is broader than that in the prior registration. For example, applicant now seeks to register its mark for "toilet water"; the prior registration does not include any kind of perfume product. (We point out that one of the items listed in opposer's registration is "perfumery.") Therefore, the mark PRIMERA in standard characters that is the subject of applicant's current application is different from the mark in its prior registration, and the goods are different as well. In addition, the Morehouse defense requires that the plaintiff not be able to cancel the prior registration. In the present case, applicant's prior registration issued on January 15, 2013, and therefore it is subject to all the grounds that may be invoked to cancel a registration. Therefore, opposer could still procure the cancellation of this registration on the ground of likelihood of confusion, the same ground that it has asserted in this proceeding. We find the Morehouse or prior registration defense is not available to applicant.

The equitable defense of acquiescence is somewhat more complicated in that it involves more elements, but we need

registration defense." *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645, 1652 (TTAB 2010). The Board's analysis of the Morehouse defense was not discussed in the Federal Circuit decision.

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not engage in an extended discussion of them, as the difference between the mark and goods in the subject application and the mark and goods in the prior registration is enough to defeat that claim as well.

Applicant's affirmative defenses are dismissed, and we turn to the likelihood of confusion ground on which opposer has brought this opposition. This ground has two elements, priority and likelihood of confusion.

Priority

Because of opposer's ownership of its registration, priority is not in issue with respect to the goods listed in the registration. *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Likelihood of confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

We turn first to the du Pont factor of the "similarity or dissimilarity and nature of the goods or services as

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described in an application or registration or in connection with which a prior mark is in use." 177 USPQ at 567. The goods as identified in opposer's registration include "perfumery" and "cosmetics." The goods identified in applicant's application include "cosmetics and cosmetic preparation" and "toilet waters," as well as additional items that would be encompassed by the term "cosmetics," e.g., "make-up preparations," "foundation cream" and "make-up powder." These goods of applicant and opposer are legally identical. Opposer has also submitted evidence to show relatedness of its goods and the other goods in applicant's identification, but we need not discuss that evidence, as the fact that some of applicant's identified goods are identical to some of opposer's identified goods is sufficient for us to find that this du Pont factor weighs in favor of opposer. See *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 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 in the application).

Because the identifications in opposer's registration and applicant's application have no restrictions on channels of trade, we must presume that the goods travel in

all channels of trade appropriate for such goods. Further, because at least some of the parties' goods are legally identical, we must presume that these goods travel in the same channels of trade, to the same classes of consumers. This du Pont factor, too, favors opposer.

The next factor we consider is the strength of opposer's mark. There is no evidence of third-party use of other PRIMAVERA marks. Although opposer has submitted a copy of a third-party registration for the following mark



for various hair products, a registration is not evidence of use of the mark or that the public is familiar with it.⁹ See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). Thus, applicant's assertion that "opposer does not enjoy exclusivity in its PRIMAVERA mark for cosmetics and highly related goods," brief p. 18, is not supported by the record. On the contrary, on this record there is no

⁹ Opposer also submitted a printout of results from a search of the TESS database that lists three additional registrations; such a search summary is not sufficient to make the registrations listed therein of record. We also point out that the summary does not include the goods covered by these registrations. Therefore, this mere listing has no probative value.

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evidence of any third-party use of marks consisting of or containing the term PRIMAVERA.

Third-party registrations can be used in the same manner as dictionaries are employed, namely, to show the meaning of a mark or a portion of a mark. See *Mead Johnson & Co. v. Peter Eckes*, 195 USPQ 187 (TTAB 1977). However, in this case, a single third-party registration for hair products (and, we note, one in which "di Primavera" appears in a very subordinate manner), does not show that PRIMAVERA has a particular significance in connection with cosmetics and perfumery, such that opposer's mark should be considered a weak mark that is entitled to a limited scope of protection.

Rather, opposer's mark, which means SPRING, appears to be an arbitrary mark for opposer's goods, and arbitrary marks are strong marks. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) ("VEUVE is an arbitrary term as applied to champagne and sparkling wine, and thus conceptually strong as a trademark").

With the foregoing in mind, we now turn to the factor of the similarity or dissimilarity of the marks. We compare the marks in their entireties as to appearance, sound, connotation and commercial impression. Palm Bay

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Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 73 USPQ2d at 1691. Opposer's registration is for the mark PRIMAVERA in standard characters, and applicant's mark is PRIMERA in standard characters. Thus, there is no visual difference between the marks in terms of particular stylizations. The visual similarities between the marks, however, are obvious: both begin with the letters PRIM and end with the letters ERA. Opposer's mark has the additional letters "AV" between these beginning and ending letters, but the presence or absence of these two letters in the middle of a mark that is otherwise identical is not likely to be noticed.

When it comes to the sound of the marks, the additional letters in opposer's mark do make a difference, because they make opposer's mark a four-syllable mark in which the "V" is emphasized. However, because the goods as identified could be taken from store shelves by consumers, as opposed to their orally requesting them from a clerk, the difference in the pronunciation of the marks is not as significant to our analysis as the appearance of the marks.

With respect to the connotations of the marks, applicant asserts that the marks "are strikingly distinct in meaning." Brief, p. 11. Applicant has submitted dictionary definitions of "primavera" as meaning "served

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with a mixture of fresh vegetables (as zucchini, snow peas, and broccoli)—usually used postpositively <pasta primavera>,"¹⁰ and "prepared with an assortment of lightly cooked, fresh, usually young vegetables in a light cream sauce => spaghetti primavera."¹¹ These definitions show that the origin of the term is Italian, meaning "spring (the season)." Applicant has also submitted evidence of the use of "primavera" in the name of recipes, e.g., "Giobbi's Primavera Pasta," www.foodandwine.com, and "Pasta Primavera," www.cookingchanneltv.com, and printouts from the internet search site yellowpages.com that list restaurants in certain states that have the word "Primavera" in their name. In addition, applicant has submitted excerpts from dictionary websites stating that, for a search of the word "Primera," no results were retrieved, thereby indicating that "Primera" is not an English word.¹²

¹⁰ www.merriam-webster.com

¹¹ American English Dictionary, www.collinsdictionary.com. It also has the definition of "a central American tree, *Cybistax donnell-smithii*, of the bignonia family, having showy, tubular yellow flowers." Dictionary. Com, based on the Random House Dictionary, © 2013.

¹² As indicated above, applicant's application includes the statement that "the wording 'PRIMERA' has no meaning in a foreign language." However, we note that applicant's registration for PRIMERA in stylized form contains the translation statement, "The English translation of 'PRIMERA' in the mark is 'first'."

Applicant relies heavily on the differences in meaning of the marks to show that confusion is not likely, citing three cases in which the Court or the Board found no likelihood of confusion when one of the marks at issue was a common English word, and the other was not. However, we do not believe that these three cases, or the statements made in them, require the same conclusion in the present case. In *In re General Electric Company*, 304 F.2d 688, 134 USPQ 190 (CCPA 1962), the applied-for mark was VULKENE for electrical wires and cables. The cited mark was VULCAN in stylized form for electrical building wires. It is clear from the opinion that a strong factor in the Court's decision was the fact that the goods that would overlap would be purchased by licensed electricians and electrical contractors, and that such consumers "would buy their electrical supplies with a reasonable amount of care and with considerable professional know-how as to what they are buying." 134 USPQ at 191. As for the marks, the Court stated that VULCAN is "a name well-known to the American people" and, therefore, "[a]nyone confronted with it, in other words, would recognize it as something already known—it would not impress itself on his consciousness as anything new or strange, but rather as something familiar." *Id.* at 192. VULKENE was found to be an arbitrary and

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coined word, that would be immediately recognized as consisting of "one syllable from a common word, 'vulcanize,' and a common ending on the names of many now well-known chemical compounds in everyday use, such as kerosene, neoprene, and, of recent date, polyethylene." Id.¹³

In *National Distillers and Chemical Corporation v. William Grant & Sons, Inc.*, 505 F.2d 719, 184 USPQ 34 (CCPA 1974), the Court found no likelihood of confusion between DUVET for French brandy and liqueurs and DUET for cocktails because of the differences in the marks. It treated DUET as a suggestive mark, with a meaning indicating that there were two drinks in the can or that the can contains drinks for two people. As for DUVET, the Court did not believe that purchasers of alcoholic beverage would think that DUVET is an English word, even though it was found in Webster's Third New International Dictionary, unabridged. "[I]t is not a familiar English word."¹⁴ 184 USPQ at 35. Therefore, the Court stated that "DUET is a familiar word; DUVET is not. DUET has clear and obvious meaning; DUVET does not." Id.

¹³ We point out that this decision issued in 1962.

¹⁴ This decision issued in 1974, obviously before "duvet" became popular in the United States as a term for comforters.

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The third case cited by applicant is Faberge, Incorporated v. Dr. Babor GmbH & Co., 219 USPQ 848 (TTAB 1983).¹⁵ The Board found no likelihood of confusion between cosmetics products that were in part identical because of differences in the marks BABE and BABOR. The Board found that "BABE is a well known and universally used word of the English language," *id.* at 850, while BABOR had no meaning.

All of these cases relied on the fact that one of the marks was a common, familiar word, while the other was not, and that "the familiar is readily distinguishable from the unfamiliar." *National Distillers*, 184 USPQ at 35. First, we point out that, as the Board stated in *Faberge*, "a familiar versus an unfamiliar mark is not enough in and of itself to dictate a common result in every case." 219 USPQ at 851. Second, and more importantly, in all of the cited cases one of the marks was found to be a "familiar" word. We cannot make such a finding in this case. Although *PRIMAVERA* is found in the dictionary, that is not sufficient to make it a "familiar" word. In fact, in *National Distillers*, "duvet" was found in the dictionary, but the Court rejected the mere listing in a dictionary as

¹⁵ Applicant also cited, as a "See also," *Ralston Purina Co. v. On Cor Frozen Foods, Inc.*, 223 USPQ 979 (Fed. Cir. 1984), but it is clear that applicant is not actually relying on this case and, in any event, it is distinguishable for many reasons, including the differences in the parties' goods.

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showing that consumers would be familiar with the word or its meaning. Applicant has also submitted evidence that PRIMAVERA is used to indicate a style of serving pasta, and that the term appears in telephone directory listings of restaurants. However, we cannot conclude from this evidence that PRIMAVERA is a familiar term to purchasers of perfumery and cosmetics, such that when they see it on such goods, they will immediately recognize it as the same word that is used for a pasta dish. On the contrary, the dictionary definitions show that this word comes from Italian, and many consumers are likely to regard it merely as a foreign word, and certainly not as a common word in the manner of DUET or BABE. Further, since applicant's mark PRIMERA also is a foreign word (at least according to applicant's statement in its companion registration), many consumers may simply regard both marks as foreign words with unknown and possibly, because of the similarity of the words, similar meanings. As for the restaurant listings, the minimal number of restaurants that have PRIMAVERA in their names (e.g., one in Ohio, one in Wisconsin, one in Florida, two in Illinois, even only twelve in the entire state of New York) does not show that PRIMAVERA is a term that would be understood by consumers as a "common word."¹⁶

¹⁶ We also note that in some of the listings PRIMAVERA appears

Thus, we find that consumers would not understand PRIMAVERA to be a common word, and therefore would not distinguish the marks based on their meanings.

Finally, because the marks both have a similar construction and can appear to be foreign words, they convey similar commercial impressions.

Because the similarities of the marks outweigh their differences, and because the differences, viewed in the context of the goods, are not sufficient to distinguish the marks, we find that this du Pont factor favors opposer.

The next factor we consider is the conditions under which and buyers to whom sales are made, i.e., "impulse" vs. careful, sophisticated purchasers. The products as identified in the respective registration and application are cosmetic items that are sold to the general public. Therefore, the consumers cannot be considered to be sophisticated, or to have any particular expertise. Further, the perfumery and cosmetics items in both the registration and application that are legally identical can be relatively inexpensive, and subject to frequent

with foreign words, and therefore consumers would be likely to view the word as a foreign term as well, e.g., Cocina Primavera in Beverly Hills, CA; Primavera Ristorante in Coronado, CA; La Primavera in La Puente, CA; La Primavera Trattoria in West Orange, NJ; and La Primavera in Hicksville, NY and in New York City.

replacement, such that they are likely to be purchased without careful study of the trademark applied to the product. *Alberto-Culver Co. v. F.D.C. Wholesale Corp.*, 16 USPQ2d 1597, 1602-03 (TTAB 1990); *Helene Curtis Industries, Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). This du Pont factor favors a finding of likelihood of confusion.¹⁷

Applicant points to the fact that two sets of registrations issued to different registrants for the marks PRIMAVERA and PRIMERA, i.e., PRIMAVERA (stylized) for fresh fruits and vegetables, and PRIMERA for fresh nuts; and PRIMAVERA for real estate investment and real estate management,¹⁸ and PRIMERA for real estate management.¹⁹

¹⁷ Applicant argues that consumers of cosmetics should not be held to a lesser standard of care, relying on a statement made in *Faberge, Inc. v. Dr. Babor GmbH & Co.*, supra. The Board made it very clear that "each case depends on its particular fact situation for its determination" in finding that "purchasers of cosmetic products would have no difficulty in distinguishing between the well-known, easily recognized word "BABE" and applicant's unfamiliar "BATOR." As discussed supra, we do not consider PRIMAVERA to be in the same category as BABE in terms of being a "well-known, easily recognized word." Given the similarity between PRIMAVERA and PRIMERA, and the fact that PRIMAVERA is not a readily recognized English word, the general public is not likely, when making a replacement purchase of the particular cosmetic, to make a careful study of the marks to detect a relatively minor and buried difference.

¹⁸ This registration was cancelled in April 2012.

¹⁹ Applicant also points to a third set of PRIMAVERA/PRIMERA marks, namely a registration for PRIMERA for commercial water heaters and boilers and an application for PRIMAVERA for taps for washstands, bidets and sinks; showers and shower fittings; and the like. An application has no evidentiary value except to show that it has been filed. In any event, even if the registration

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Applicant has submitted them to show that the examining attorneys who considered the applications resulting in the registrations did not believe that there was a likelihood of confusion. We give no probative value to those registrations. Each application must be decided on its own set of circumstances. We do not know whether, in the other applications, the examining attorney was persuaded because of differences in the goods, or the sophistication of the relevant purchasers, or the weakness of the earlier registered mark, or even by a consent agreement. Based on the record before us in this proceeding, we find that opposer has shown that applicant's mark, if used on the goods that have been opposed, is likely to cause confusion with opposer's registered mark.

These are the only du Pont factors that the parties have discussed or on which they have submitted evidence. To the extent that any others are relevant, we have treated them as neutral.

Finally, to the extent that there is any doubt on the issue of likelihood of confusion, we must resolve such doubt in favor of opposer. A new entrant presenting a new mark for registration has an obligation to avoid confusion

had issued, for the reasons discussed above, it would not change the result herein.

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with established marks in the same market. *Bridgestone Americas Tire Operations LLC v. Federal Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1063 (Fed. Cir. 2012), citing *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001 (Fed. Cir. 2002) ("This court resolves doubts about the likelihood of confusion against the newcomer because the newcomer has the opportunity and the obligation to avoid confusion with existing marks.") and *Planters Nut & Chocolate Co. v. Crown Nut Co.*, 305 F.2d 916, 924-25, 134 USPQ 504 (CCPA 1962) ("all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer").

Decision: The opposition is sustained with respect to the following goods:

Cosmetics and cosmetic preparations; non-medicated nourishing creams for skin; skin milk lotions; facial creams; cosmetic creams; toilet waters; make-up preparations; non-medicated skin care preparations; foundation cream; shampoos; beauty masks; make-up powder.

As noted previously, opposer has not opposed the application with respect to "dentifrices." However, in view of the evidence showing that applicant provided a translation of PRIMERA in its Registration No. 4274041 that "the English translation of 'primera' in the mark is 'first,'" and that in the subject application it stated that

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"the wording 'primera' has no meaning in a foreign language," the application must be remanded for further examination. See Trademark Rule 2.131. Therefore, upon the expiration of the appeal period, the application will be remanded to the examining attorney to determine whether a correction to the translation statement is necessary and, if that issue is satisfactorily resolved, the application, solely for "dentifrices," will be forwarded for publication.

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

14-1255

AMOREPACIFIC CORPORATION,
Appellant,

v.

PRIMAVERA LIFE GMBH,
Appellee.

Appeal from the United States Patent and Trademark Office, Patent Trial and Appeal Board in No.
91196106.

MANDATE

In accordance with the judgment of this Court, entered March 21, 2014, and pursuant to Rule 41(a) of the Federal Rules of Appellate Procedure, the formal mandate is hereby issued.

FOR THE COURT

/s/ Daniel E. O'Toole

Daniel E. O'Toole
Clerk of Court

cc: Terrence Joseph McAllister
Lawrence R. Robins
United States Patent and Trademark Office

NOTE: This order is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

AMOREPACIFIC CORPORATION,
Appellant,

v.

PRIMAVERA LIFE GMBH,
Appellee.

14-1255
(Serial No. 91196106)

Appeal from the United States Patent and Trademark
Office, Patent Trial and Appeal Board.

ORDER

The parties having so agreed, it is

ORDERED that the proceeding is DISMISSED under
Fed. R. App. P. 42 (b). Each side shall bear its own costs.

FOR THE COURT

March 21, 2014

/s/ Daniel E. O'Toole
Daniel E. O'Toole
Clerk of Court

ISSUED AS A MANDATE: March 21, 2014

cc: Clerk's Office, United States Patent and Trademark
Office
Terrence Joseph McAllister
Lawrence R. Robins