

This Opinion is Not a
Precedent of the TTAB

Mailed: May 2, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re BeBella Inc.

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Serial No. 97281194

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Amanda V. Dwight of Burkhalter Kessler Clement & George LLP,
for BeBella Inc.

Kelly Ryan, Trademark Examining Attorney, Law Office 111,
Chris Doninger, Managing Attorney.

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Before Wellington, Dunn and Cohen,
Administrative Trademark Judges.

Opinion by Cohen, Administrative Trademark Judge:¹

¹ As part of an internal Board pilot citation program on possibly broadening acceptable forms of legal citation in Board cases, this decision varies from the citation form recommended in the TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 101.03 (2023). This decision cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals by the page(s) on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). For decisions of the Board and the Director, this decision includes the serial or proceeding numbers and employs citations to the WESTLAW (WL) database. To facilitate broader research, the proceeding or application number for cited Board decisions is listed. Decisions issued prior to 2008 may not be available in TTABVUE. Until further notice, however, practitioners should continue to adhere to the practice set forth in TBMP § 101.03.

Citations to the prosecution file refer to the USPTO's TRADEMARK STATUS & DOCUMENT RETRIEVAL ("TSDR") system and identify the documents by title, date, and page in the online

Applicant BeBella Inc. seeks to register on the Principal Register the standard character mark NUDE X (the “Application”) for “cosmetics; cosmetics and cosmetic preparations; cosmetics and make-up, namely, palettes, eyeshadow palettes, contour palettes, glow palettes, highlighter, blush, eyeliner, lipstick, lip liners, contour sticks,” in International Class 3.²

Registration was refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s applied-for mark so resembles the standard character mark NAKED X (the “Registration”) registered on the Principal Register for “hair lotion; hair spray; hair butter; hair care lotions; hair care creams; hair care preparations; hair cleaning preparations; hair emollients; hair fixers; hair gel; hair nourishers; hair oils; hair styling spray; hair styling preparations; cosmetic preparations for the hair and scalp; hair conditioner; hair relaxers; hair relaxing preparations; hair shampoo; hair shampoos and conditioners; heat protectant sprays for hair; non-medicated hair restoration lotions; non-medicated scalp treatment cream; non-medicated preparations all for the care of skin, hair and scalp; wave-set

version. Citations to the briefs and other materials in the appeal record refer to the Board’s TTABVUE online docket system.

² Application Serial No. 97281194, filed February 23, 2022, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b) based on Applicant’s allegation of a bona fide intention to use the mark in commerce. Applicant has disclaimed the exclusive right to use NUDE apart from the mark as shown.

Applicant originally sought registration for “cosmetics and make-up, namely, palettes, eyeshadow palettes, contour palettes, glow palettes, highlighter, blush, eyeliner, lipstick, lip liners, contour sticks” in International Class 3. February 23, 2022 Application. Applicant sought to amend the identification of goods in its July 25, 2023 Request for Reconsideration which was accepted by the Examining Attorney. *See* August 21, 2023 Request for Reconsideration Denied.

lotions” in International Class 3,³ that it is likely to cause confusion, mistake or to deceive.

When the refusal was made final, Applicant appealed and requested reconsideration.⁴ After the Examining Attorney denied the request for reconsideration,⁵ the appeal proceeded and Applicant and the Trademark Examining Attorney filed briefs. For the reasons explained below, we affirm the Section 2(d) refusal.

I. Likelihood of Confusion

“The Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion [or] mistake, or to deceive.” *In re Charger Ventures LLC*, 64 F.4th 1375, 1379 (Fed. Cir. 2023) (cleaned up). Our determination of the likelihood of confusion under Section 2(d) of the Trademark Act is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (“*DuPont*”). *See Charger Ventures*, 64 F.4th at 1379. We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 1379 (Fed. Cir. 2019). “In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the

³ Registration No. 6185203 registered October 27, 2020.

⁴ July 25, 2023 Request for Reconsideration at TSDR 1-45.

⁵ 4 TTABVUE.

similarities between the [goods or] services.” *Monster Energy Co. v. Lo*, Opp. No. 91225050, 2023 WL 417620, at *6 (TTAB 2023) (citing *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (CCPA 1976)).

A. Goods, Channels of Trade and Classes of Consumers

“The second *DuPont* factor ‘considers [t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration.” *In re Embiid*, Ser. No. 8820289, 2021 WL 2285576, at *10 (TTAB 2021) (quoting *In re Detroit Athletic Co.*, 903 F.3d 1297, 1306 (Fed. Cir. 2018) (quoting *DuPont*, 476 F.2d at 1361)).

“In analyzing the [goods], the Board ‘considers ‘the similarity or dissimilarity and nature of the [goods] as described in an application or registration.” *In re OSF Healthcare Sys.*, Ser. No 88706809, 2023 WL 6140427, at *4 (TTAB 2023) (quoting *Embiid*, 2021 WL 2285576, at *10) (internal quotation omitted). The respective goods need not be identical or even competitive in order to find that they are related for purposes of our likelihood of confusion analysis, but need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that they emanate from the same source.” *Coach Servs.*, 668 F.3d at 1369 (quoting *7-Eleven Inc. v. Wechsler*, Opp. No. 91117739, 2007 WL 1431084, at *6 (TTAB 2007)). The issue here is not whether consumers would confuse the goods, but whether there is a likelihood of confusion as to the source of those goods. *L’Oreal S.A. v. Marcon*, Opp. No. 91184456, 2012 WL 1267956, at *6 (TTAB 2012).

The Examining Attorney argues that “it is clear from the evidence of record that [A]pplicant’s cosmetic goods and Registrant’s non-medicated preparations all for the care of hair and scalp and hair products are closely related.” The Examining Attorney continues that it is common for the same entities to offer both “skin care and related cosmetics and hair care products” under the same mark to the same class of consumers leading to the mistaken belief that the goods originate from the same source.⁶ “[T]hird-party registrations ... have ... probative value to the extent they may serve to suggest that the goods are of a kind that emanate from a single source.” *In re I-Coat Co.*, Ser. No. 86802467, 2018 WL 2753196, at *10 (TTAB 2018). “[E]vidence ... such as whether a single company sells the ... [goods] of both parties, if presented, is relevant to a relatedness analysis” *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267 (Fed. Cir. 2002); *see also Detroit Athletic*, 903 F.3d at 1307 (affirming Board’s finding of relatedness of goods and services where the record included marketplace evidence of a single mark for both).

The record includes evidence of consumer exposure to goods of the type identified in the Application and Registration emanating from the same source under the same mark. For example:

- AVON mark used in connection with hair shampoo, hair conditioner, and cosmetics such as eyeshadow palettes and eyeliner;⁷
- NEUTROGENA mark used in connection with hair shampoos and cosmetics;⁸

⁶ *Id.*

⁷ January 25, 2023 Final Office Action at TSDR 4-5.

⁸ *Id.* at 6-7.

- THE ORDINARY mark used in connection with cosmetics such as foundation and primer and hair conditioner;⁹
- REVLON mark used in connection with hair color and foundation for the face;¹⁰
- AVEDA.COM website listing various hair care products such as shampoo and conditioner and cosmetics such as products for the lip, eye and face;¹¹
- BURT'S BEES mark used in connection with foundation and shampoo;¹²
- L'OREAL mark used in connection with shampoo, hair color and bronzer;¹³
- ULTA mark used to offer for sale third-party goods and ULTA branded goods such as eyeshadow, lipstick, makeup palettes and hair care products such as shampoos and styling products;¹⁴
- SEPHORA mark used to offer for sale third-party goods such as hair mask, hair shampoo and conditioner, lipstick crayon, and eye pencil;¹⁵
- CLARINS mark used in connection with hair shampoo and conditioner, hair mask, lipstick, lip gloss and lip oil;¹⁶
- SISLEY mark used in connection with eyeshadow, eye pencil, lipstick, hair shampoo;¹⁷
- LUSH mark used in connection with eye liner, mascara, and hair shampoo;¹⁸ and

⁹ *Id.* at 8-9.

¹⁰ *Id.* at 10-11.

¹¹ July 11, 2022 Office Action at TSDR 4-5.

¹² *Id.* at 6-7.

¹³ *Id.* at 8.

¹⁴ *Id.* at 11-13.

¹⁵ *Id.* at 14-15.

¹⁶ 4 TTABVUE 7-15.

¹⁷ *Id.* at 25-37.

¹⁸ *Id.* at 39-50.

- CLEURE mark used in connection with shampoo and eyeshadow palette.¹⁹

The evidence shows that, in a broader sense, Applicant's cosmetics and Registrant's hair products share a similar purpose for consumers as personal care products. Again, the goods need not be identical or serve the same purpose to be related. *See, e.g., In re Shell Oil Co.*, 992 F.2d 1204, 1207 (Fed. Cir. 1993) (automotive parts distributorship services and service station oil change and lubrication services deemed sufficiently related to cause confusion because even where the services differ, "the use of identical marks can lead to the assumption that there is a common source"). Rather, the test is whether consumers likely would believe such goods come from the same source. Applying this test, we find the marketplace evidence detailed above persuasive to show that consumers encounter hair care products such as those identified in the Registration coming from the same sources under the same marks as cosmetics such as Applicant has identified.

While we contemplate the similarity or dissimilarity of the respective goods, we also consider the third *DuPont* factor, which "considers '[t]he similarity or dissimilarity of established, likely-to-continue trade channels.'" *Detroit Athletic*, 903 F.3d at 1303 (quoting *DuPont*, 476 F.2d at 1361). Applicant seeks to distinguish its goods by arguing that its goods are sold only through its website and that the goods are "highly specialized."²⁰ These arguments are unavailing.

¹⁹ *Id.* at 106-07.

²⁰ 6 TTABVue 29.

The limitation that Applicant's goods are sold only through its website is not set forth in its identification of goods and so, can form no part of our analysis. *Detroit Athletic*, 903 F.3d at 1307 ("The third *DuPont* factor--like the second factor--must be evaluated with an eye toward the channels specified in the application and registration, not those as they exist in the real world."). Indeed, neither the Application or Registration includes any limitations with respect to channels of trade. It is the identification of goods that controls, not what extrinsic evidence may show about the specific nature of the goods. *Midwest Gaming & Entm't*, Ser. No. 85111552, 2013 WL 1442237, at *2 (TTAB 2013). "[I]n the absence of specific limitations," which we do not have in these identifications, we must assume that the identified goods move through all normal and usual channels of trade for such goods and to all normal potential purchasers. *In re i.am.symbolic llc*, 866 F.3d 1315, 1325 (Fed. Cir. 2017); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983). The marketplace evidence set out above reflects that goods like those in the Application and Registration (e.g., cosmetics and hair care products) are promoted and sold together through the same websites, reaching the same classes of consumers.

Overall, we find that the record demonstrates the relatedness of the relevant goods and the overlap in trade channels. These *DuPont* factors weigh in favor of likely confusion.

B. Alleged Weakness of the Registered Mark

"The sixth *DuPont* factor 'considers the number and nature of similar marks in use on similar goods,'" *Embiid*, 2021 WL 2285576, at *16 (quoting *Omaha Steaks Int'l*

Inc. v. Greater Omaha Packing Co., 908 F.3d 1315, 1318 (Fed. Cir. 2018)), and “is a measure of the extent to which other marks weaken the assessed mark.” *Spireon, Inc. v. Flex, Ltd.*, 71 F.4th 1355, 1362 (Fed. Cir. 2023). “The purpose of introducing evidence of third-party use is ‘to show that customers have become so conditioned by a plethora of such similar marks that customers have been educated to distinguish between different [such] marks on the bases of minute distinctions.’” *Omaha Steaks*, 908 F.3d at 1324 (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1374 (Fed. Cir. 2005)). The scope of protection that is accorded a mark based on its strength may narrow with proof of third-party use demonstrating weakness in the industry or third-party registrations demonstrating that a term has a normally understood and well recognized descriptive or suggestive meaning. See *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1339 (Fed. Cir. 2015); *Tao Licensing, LLC v. Bender Consulting Ltd.*, Can. No. 92057132, 125 WL 6336243, at *14 (TTAB 2017) (Third-party uses may bear on the commercial weakness of a mark and third-party registrations “may bear on conceptual weakness if a term is commonly registered for similar goods or services.”).

Applicant has sought to demonstrate that the term NAKED is weak for Registrant’s goods.²¹ Applicant did not introduce any evidence of third-party marketplace uses. See *Sabhani v. Mirage Brands, LLC*, Can. No. 92068086, 2021 WL 6072822, at *25 (TTAB 2021) (evidence of use is relevant to commercial weakness); *Tao Licensing, LLC v. Bender Consulting Ltd.*, Can. No. 92057132, 2017

²¹ *Id.* at 31.

WL 6336243, at *16 (TTAB 2017), (“[a]s to *commercial* weakness, ‘[t]he probative value of third-party trademarks depends entirely upon their usage’”) (emphasis in original) (quoting *Palm Bay Imps.*, 396 F.3d at 1373). Instead, Applicant submits what appears to be a trademark search result in table format listing 120 NAKED-formative registrations which it asserts are all live and for Class 3.²² It is well established that third-party registrations may not be made of record by such a listing. *Carl Karcher Enters. Inc. v. Stars Rests. Corp.*, Opp. No. 91077850, 1995 WL 9410635, at *6 (TTAB 1995). Notwithstanding, the Examining Attorney countered the substance of the table but failed to advise Applicant that the table,²³ which was proffered during prosecution, is insufficient to make the registrations of record. *See In re ActiveVideo Networks, Inc.*, Ser. No. 77967395, 2014 WL 3686863, at *8 n.40 (TTAB 2014) (objection waived where examining attorney, in continuing a refusal, failed to advise applicant that mere listing of third-party registrations was insufficient to make them of record); *In re City of Houston*, Ser. No. 77660948, 2012 WL 423805, at *2 (TTAB 2012) (“[T]he examining attorney’s failure to advise applicant of the insufficiency of the list of registrations when it was proffered during examination constituted a waiver of any objection to consideration of that list. Accordingly, we will consider the ... list of registrations ... ‘for whatever limited probative value such evidence may have,’” (citing *In re Broyhill Furniture Indus. Inc.*, 2001 WL 940421, at *2 n.3 (TTAB 2001)). Although we consider this table, it has

²² See December 21, 2022 Response to Office Action at TSDR 6-11; July 25, 2023 Request for Reconsideration at TSDR 6-9.

²³ See January 25, 2023 Final Office Action.

limited probative value. The table indicates only some of the registrations are in Class 3 and does not indicate if the registrations are on the Principal or Supplemental Register, if the registrations are owned by a single third-party or multiple third-parties, or specify the goods or services involved. *See, e.g., In re Broyhill Furniture Inds. Inc.*, Ser. No. 75473959, 2001 WL 940421, at *2 n.3 (TTAB 2001) (although objected-to listing was considered, it had “limited probative value” as it did not indicate whether registrations were on the Principal or the Supplemental Register and none of the file histories for any of the registrations were included).

Applicant does, however, attach what it calls “[r]epresentative certificates of the foregoing registrations”²⁴ arguing that “26 are for ‘hair products.’”²⁵ Upon review of Applicant’s attachments, there are only eleven registration certificates or screenshots of registrations in Class 3 attached, not twenty-six.²⁶ Those eleven registrations are for the marks:

²⁴ *Id.* With respect to some of the third-party registrations, Applicant submitted copies of certificates which do not show their current status. “[T]o make a third-party registration of record, or a registration owned by the applicant or registrant not the subject of the appeal, a copy of the registration (from either the electronic records of the Office or the paper USPTO record).” TBMP § 1208.02. Because it is not clear that the registrations are currently in force, their probative value is limited.

²⁵ July 25, 2023 Request for Reconsideration at TSDR 9.

²⁶ Applicant attached an additional table which lists 26 registrations. *Id.* at 25-26; *see* December 21, 2022 Response to Office Action at TSDR 24-25. We consider this table because the Examining Attorney failed to advise Applicant that the table, submitted during prosecution, does not make the registrations of record. *ActiveVideo Networks*, 2014 WL 3686863, at *8 n.40. However, this table is of limited probative value as it too indicates only some of the registrations are in Class 3 and does not indicate if the registrations are on the Principal or Supplemental Register, if the registrations are owned by a single third-party or multiple third-parties, or specify the goods or services involved.

Applicant also included TRADEMARK SEARCH screenshots for NAKED and NUDE (addressed below). July 25, 2023 Request for Reconsideration at TSDR 34-37.

- NAKED & THRIVING (Reg. No. 6877724) for “cosmetics; beauty care cosmetics; cosmetics sold as an integral component of non-medicated skincare preparations; natural cosmetics; organic cosmetics” in Class 3;²⁷
- NAKED FORMULA (Reg. No. 6764094) for “non-medicated skin care preparations” in Class 3;²⁸
- NAKEDMD (Reg. No. 6041959) for various goods including “skin creams, cosmetic products for skin care ... cosmetic skin care preparations for the hands; ... lip cream and lip gloss; ...” in Class 3;²⁹
- STAY NAKED (Reg. No. 5904825) for “cosmetics; make-up preparations” in Class 3;³⁰
- NAKED2 (Reg. No. 4550122) for “coloring preparations for cosmetic purposes; cosmetics; make-up; make-up preparations” in Class 3;³¹
- NAKED MINERALS (Reg. No. 3628891) for various good including “blush; body and beauty care cosmetics; compacts containing make-up; concealers for face and body; ... lip gloss; ... sun block; topical skin sprays for cosmetic purposes; under-eye enhancers” in Class 3;³²
- PRETTY NAKED SKINCARE (Reg. No. 6870524) for various goods including “cosmetics; hair creams; hair gel and hair mousse ... cosmetic preparations ...” in Class 3;³³
- THE NAKED FACE (Reg. No. 6262663) for “body scrub; body wash; cosmetics; face oils; hair conditioner; hair oils; oils for hair conditioning; toothpaste; cosmetic olive oil for the face and body; hair shampoo” in Class 3;³⁴

²⁷ *Id.* at 14.

²⁸ *Id.* at 16.

²⁹ *Id.* at 18.

³⁰ *Id.* at 20.

³¹ *Id.* at 22.

³² *Id.* at 24.

³³ *Id.* at 27.

³⁴ *Id.* at 29.

- NAKED SOUL (Reg. No. 5793603) for various goods including “baby bubble bath; baby hair conditioner; baby lotion ... cosmetics; essential oils; hair care preparations; body and beauty care ...” in Class 3;³⁵
- BARE NAKED (Reg. No. 2789894) for various goods including “after shave lotions, bath oils and salts, body and facial lotions ... hair shampoos and conditioners, ...” in Class 3;³⁶ and
- NAKED (Reg. No. 4896266) for “colognes; eau de perfume; perfumes” in Class 3.³⁷

Applicant also includes in its briefing a screenshot of a registration for NAKED (Reg. No. 4452275) for “hair products, namely, hair pieces, hair extensions, hair for use in weaving hair, wigs, and ponytail pieces” in Class 26.³⁸

In assessing the impact of third-party use or registrations,³⁹ we look to whether the third-party marks and goods are similar to the mark and goods of the Registration. If not, they can be discounted. *See, e.g., Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 675 (Fed. Cir. 1984) (discounting third-party evidence, noting: “None of these marks has a ‘SPICE (place)’ format or conveys a commercial impression similar to that projected by the SPICE ISLANDS mark, and these third-party registrations are of significantly greater difference from SPICE

³⁵ *Id.* at 31.

³⁶ *Id.* at 33.

³⁷ *Id.* at 34.

³⁸ *Id.* at 10; 6 TTABVUE 38.

³⁹ The probative value of third-party registrations is limited, particularly when the issue to be determined is likelihood of confusion, and there is no evidence of actual use of the mark shown in the registration. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 1347 (Fed. Cir. 2010) (“more is required than a showing of the existence of various marks”); *Weider Publ’ns, LLC v. D&D Beauty Care Co.*, Opp. No. 91199352, 2014 WL 343269, at * n.10 (TTAB 2014) (third-party registrations do not constitute evidence of use, thus of limited probative value to show mark is weak).

VALLEY and SPICE ISLANDS than either of these two marks from each other.”); *Palisades Pageants, Inc. v. Miss Am. Pageant*, 442 F.2d 1385, 1388 (CCPA 1971) (discounting third-party evidence, noting: “we are of the opinion that appellant’s mark is closer to appellee’s than even the closest of the third-party registrations in that it bodily incorporates appellee’s mark, merely adding an adjective to the beginning thereof which, as the board observed, ‘directs attention to the words which follow.’”).

We observe that none of the registrations submitted have a NAKED (letter) format or cadence and nearly all contain additional terms which convey a different commercial impression dissimilar to that of the Registration. These differences render most of the registrations less similar to the Registration than the Application is. *See Sabhnani*, Can. No. 92068086, 2021 WL 6072822, at *13 (TTAB 2021) (“[W]hile the registered marks all contain the word ‘MIRAGE,’ they contain additional elements that cause many of them to be less similar to Petitioner’s mark than Respondent’s marks are.”).

As for the NAKED registration for “hair products, namely, hair pieces, hair extensions, hair for use in weaving hair, wigs, and ponytail pieces” specifically mentioned by Applicant,⁴⁰ the registration is of little probative value. The goods, e.g., hair pieces and extensions, are not nearly as closely related to Registrant’s goods as Applicant’s goods are and there is no evidence that the registration is in continued use. *See Nat’l Cable Television Ass’n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572,

⁴⁰ July 25, 2023 Request for Reconsideration at TSDR 10-11.

1579 (Fed. Cir. 1991) (Discounting third-party use and registration evidence as “not only unpersuasive but essentially meaningless,” where “[n]one of the third party marks and uses of ACE made of record are nearly as closely related to the activities of the parties as the virtually identical uses of the parties are to each other.”); *Key Chemicals, Inc. v. Kelite Chems. Corp.*, 464 F.2d 1040, 1235 (CCPA 1972) (“Nor is our conclusion altered by the presence in the record of about 40 third-party registrations which embody the word “KEY.” The great majority of those registered marks are for goods unrelated to those in issue, and there is no evidence that they are in continued use. We, therefore, can give them but little weight in the circumstances present here”).

Additionally, although these third-party registrations have some characteristics similar to the marks in the Registration, the Office’s allowance of these prior third-party registrations does not bind the Office or the Board, as each application must be considered on its own merits. *See, e.g., In re Shinnecock Smoke Shop*, 571 F.3d 1171, 1174 (Fed. Cir. 2009) (“Applicant’s allegations regarding similar marks are irrelevant because each application must be considered on its own merits.”); *In re Boulevard Entm’t*, 334 F.3d 1336, 1343 (Fed. Cir. 2003). Accordingly, we are unpersuaded by Applicant’s argument that since NAKED X was registered despite the existence of a prior third-party registrations for NAKED and NAKED-formative marks for cosmetics or hair products, there is no likelihood of confusion between NUDE X and

NAKED X.⁴¹

In short, the third-party registrations are not the type of extensive use and registration which has been required to consider a mark, or a term in a mark, weak. *See Juice Generation, Inc.*, 794 F.3d at 1337 n.1 (twenty-six examples of third party use with restaurant services or food products); *In re i.am.symbolic, LLC*, Ser. No. 85916778, 2018 WL 3993582, at *10 (TTAB 2018) (“These five uses of WILLPOWER, while somewhat probative, are insufficient to “show that customers ... have been educated to distinguish between different ... marks on the basis of minute distinctions.”) (citation omitted). Even assuming some degree of weakness in the term NAKED is not dispositive, as “likelihood of confusion is to be avoided, as much between ‘weak’ marks as between ‘strong’ marks.” *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 1401 (CCPA 1974).

Applicant also submits three pairs of NAKED and NUDE registrations asserting that the terms “(in isolation) have both received approval for registration for similar goods notwithstanding distinct ownership.”⁴² These registrations are:

- NAKED for “colognes; eau de perfume; perfumes” and NUDE for various goods including “perfumes”;⁴³
- NAKED and design for “fruit-based beverage containing nutmilk” and NUDE for “flavored brewed malt-based alcoholic beverages in the nature of beer”;⁴⁴ and

⁴¹ 6 TTABVUE 31.

⁴² *Id.* at 38.

⁴³ July 25, 2023 Request for Reconsideration at TSDR 34-35.

⁴⁴ *Id.* at 36.

- NAKED for various clothing items and NUDE for various clothing items.⁴⁵

The fact that these registrations may coexist on the Register does not prove that the marks coexist in the marketplace without confusion. *In re Thomas*, Ser. No. 78334625, 2006 WL 1258862, *8 (TTAB 2006). There is no evidence that any of the pairs were compared in Board proceedings; they were issued as the result of separate decisions by examining attorneys. The Board is not bound by those decisions; it must make its own findings of fact in each case, and that duty may not be delegated by adopting conclusions reached by examining attorneys based on other marks on different records. *In re Sunmarks, Inc.*, Ser. No. 74178616, 1994 WL 598858, *3 (TTAB 1994). “In the final analysis, when determining whether a mark is eligible for registration, each application must be considered on its own record. *In re Cordua Rests., Inc.*, 823 F.3d 594, 600, ... (Fed. Cir. 2016).” *In re Sibony*, Ser. No. 86293054, 2021 WL 4812119, *4 (TTAB 2021). “We do not believe that our decision here is inconsistent with the registration of the third-party marks cited by Applicant, but to the extent that it is, it is the decision required under the statute on the record before us.” *In re Ala. Tourism Dept.*, Ser. No. 87599292, 2020 WL 2301221, *14 (TTAB 2020).

Upon consideration of the record, the sixth *DuPont* factor is neutral. NAKED X is registered on the Principal Register without a claim of acquired distinctiveness under Section 2(f) of the Trademark Act. *See Advance Mag. Publishers, Inc. v. Fashion Elecs., Inc.*, Opp. No. 91247034, 2023 WL 4261426, at *18 (TTAB 2023); *Tea Bd. of India v. Republic of Tea*, Opp. No. 91118587, 2006 WL 2460188, at *21 (TTAB 2006).

⁴⁵ *Id.* at 37.

We afford the Registration “the normal scope of protection to which inherently distinctive marks are entitled.” *Bell’s Brewery, Inc. v. Innovation Brewing*, Opp. No. 91215896, 2017 WL 6525233, at *15 (TTAB 2017).

C. Similarity of the Marks

We now consider the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *Detroit Athletic*, 903 F.3d at 1303; *Palm Bay Imps.*, 396 F.3d at 1371 (citing *DuPont*, 476 F.2d at 1361). Under the first *DuPont* factor, we determine the similarity or dissimilarity of Applicant’s and Registrant’s marks in their entireties, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 476 F.2d at 1361. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, Ser. No. 87075988, 2018 WL 2734893, at *5 (TTAB 2018) (quoting *In re Davia*, Ser. No. 85497617, 2014 WL 2531200, at *2 (TTAB 2014)).

“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.” *i.am.symbolic*, 866 F.3d at 1323 (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368 (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*, Ser. No. 78814088, 2016 WL 3915987, at *5

(TTAB 2016); *In re Mr. Recipe, LLC*, Ser. No. 86040643, 2016 WL 1380730, at *6 (TTAB 2016).

“No element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone.” *In re Electrolyte Labs. Inc.*, 929 F.2d 645, 647 (Fed. Cir. 1990) (citing *Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293 (CCPA 1974)). However, “in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety.” *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985); *see Coach Servs.*, 668 F.3d at 1368 (“It is well-established that it is improper to dissect a mark, and that marks must be viewed in their entirety. In some circumstances, however, one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark.”) (citations omitted). If a portion of both marks is the same, then the marks may be confusingly similar notwithstanding some differences. *See, e.g., Charger Ventures*, 64 F.4th at 1382 (“an additional word or component may technically differentiate a mark but do little to alleviate confusion”); *Hewlett-Packard*, 281 F.3d at 1266 (similar commercial impression even though applicant’s mark PACKARD TECHNOLOGIES, with “TECHNOLOGIES” disclaimed, does not incorporate every feature of opposer’s HEWLETT PACKARD marks).

Applicant contends that its proposed mark is distinct from the mark in the Registration because the “connotation and commercial impression between Applicant’s NUDE X mark and the Cited Mark are not the same.”⁴⁶ Applicant continues that “‘NAKED’ implies that a person is unprotected or vulnerable”⁴⁷ and describes something that is “unadorned or without embellishment, as in the oft-mentioned naked truth” whereas NUDE “means one thing: unclothed.”⁴⁸ In support, Applicant refers to dictionary definitions for “nude” and “naked” each generally defined as being without clothes and additionally for NUDE referring to the color that matches the wearer’s skin.⁴⁹ The Examining Attorney also relies on dictionary definitions which similarly define NUDE as “devoid of a natural or conventional

⁴⁶ 6 TTABVUE 30.

⁴⁷ *Id.*

⁴⁸ *Id.*

⁴⁹ *Id.* at 30 n.2-4. Applicant provided links to CAMBRIDGE.COM and MERRIAM-WEBSTER.COM dictionary definitions for NUDE and NAKED without including copies of the dictionary definitions during prosecution. *See, e.g.*, December 21, 2022 Response to Office Action at TSDR 5-6 n.2-4; 6 TTABVUE 30 n.2-4. Ordinarily, we would not consider the dictionary definitions because Applicant provided only links without including the corresponding text. *See In re ADCO Indus. Tech., L.P.*, Ser. No. 87545258, 2020 WL 87545533, at *2 (TTAB 2020) (web addresses or hyperlinks are insufficient to make the underlying webpages of record); *TV Azteca, S.A.B. de C.V. v. Martin*, Can. No. 92068042, 2018 WL 6504575, at *4 n.15 (TTAB 2018) (providing an Internet link to an article is insufficient to make the article of record because the information displayed at a link’s Internet address is impermanent; article is of record only because it was submitted as an exhibit to a declaration. “The Board does not accept Internet links as a substitute for submission of a copy of the resulting page.”).

Notwithstanding, the Examining Attorney made the same dictionary definitions referenced by Applicant of record. January 25, 2023 Final Office Action at TSDR 14-15. We thus have considered the definitions referenced by Applicant, for “nude” defined as “not wearing any clothes ... the same color as a person’s skin” and as “lacking something essential especially to legal validity a nude contract ... not covered by clothing or a drape ... having a color that matches the wearer’s skin tone” and “naked” defined as “not covered by clothes.” December 21, 2022 Response to Office Action at TSDR 5-6 n. 2-4.

covering especially: not covered by clothing or a drape ... frequented by naked people”⁵⁰ and NAKED as “not covered by clothing: NUDE; devoid of customary or natural covering.”⁵¹ Applicant argues that NAKED is edgier and rebellious while NUDE is “a ‘matter of fact’ without making a moral statement.”⁵² The dictionary definitions submitted do not support this argument. Rather, the definitions are nearly identical for both “nude” and “naked” indicating that the terms are synonyms and have similar connotations.

Although the marks differ in terms of sound and appearance, this does not alleviate confusion. *Charger Ventures*, 64 F.4th at 1382 (citing *Detroit Athletic*, 903 F.3d at 1304-05). Rather, the marks are similar because they have very similar connotations. Although the term NAKED in Registrant’s mark, as argued by Applicant, may be edgier and convey the meaning and commercial impression of being “unprotected or vulnerable,”⁵³ at the same time, Applicant’s mark does not necessarily convey a different meaning or impression from the Registration. When viewed in connection with cosmetics and hair care products, the meaning of is the same in both marks, as evidenced by the dictionary definitions submitted by Applicant and the Examining Attorney. The marks both suggest products that are

⁵⁰ MERRIAM-WEBSTER DICTIONARY, July 11, 2022 Office Action at TSDR 2. Applicant also submitted a link to the Although Applicant provided only a link and thus, has not properly made this definition of record, we need not take judicial notice of this definition as the Examining Attorney made the MERRIAM-WEBSTER DICTIONARY definition of NUDE of record.

⁵¹ *Id.* at 3.

⁵² *Id.*

⁵³ 6 TTABVUE 30.

bare and devoid of something, albeit an unspecified something. Consumers familiar with Registrant's mark, NAKED X, who encounter Applicant's mark, NUDE X, could perceive NUDE X as related to Registrant's line of products. *See Mighty Leaf Tea*, 601 F.3d at 1346.

Even though, as Applicant points out, there are differences between the marks in terms of appearance when viewed on a side-by-side basis, we find that in their entirety, because of the similar connotation and meaning of NUDE and NAKED and the shared identical letter X, the marks are more similar than they are different and, overall, convey very similar connotations and commercial impressions.

Further, NUDE is disclaimed and thus, an admission of descriptiveness by Applicant. *See In re Zuma Array Ltd.*, Serial No. 79288888, 2022 WL 3282655, at *7 (TTAB 2022) (“Applicant ‘disclaimed exclusive rights in the term ‘Smart,’ thus conceding that ‘smart’ is merely descriptive of electronic sensor modules.”) (citing *In re Six Continents Ltd.*, Serial No. 88430142, 2022 WL 407385, at *8 (TTAB 2022) (disclaimer of the word SUITES in mark ATWELL SUITES “is a concession that ‘Suites’ is not inherently distinctive”). Disclaimed matter that is descriptive of a party's goods is typically less significant or less dominant when comparing marks. *Detroit Athletic*, 903 F.3d at 1305.

We are cognizant that consumers are unaware of disclaimers and that we must consider the entirety of the mark including the disclaimed terms. However, as noted, “there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion

rests on consideration of the marks in their entireties.” *Nat’l Data*, 753 F.2d at 1058. The disclaimer of NUDE constitutes a rational reason for giving the term less weight in our analysis. *See Detroit Athletic*, 903 F.3d at 1305. Consumers may consider the X portion of Applicant’s mark (the portion which is identical to Registrant’s X portion) as the source-indicator for the goods, as opposed to the disclaimed NUDE. Further, “the presence of an additional term in the mark does not necessarily eliminate the likelihood of confusion if some terms are identical.” *Mighty Leaf Tea*, 601 F.3d at 1347-48.

Applicant also attempts to distinguish the marks based on apparent real world depictions of Applicant’s and Registrant’s packaging for its goods.⁵⁴ For example:



v.



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Contrary to Applicant’s argument that Registrant’s and Applicant’s uses “clearly differentiates the parties’ mark[s],”⁵⁶ because the marks in the Application and

⁵⁴ *Id.* at 39.

⁵⁵ July 25, 2023 Request for Reconsideration.

⁵⁶ 6 TTABVUE 39.

Registrations are in standard characters, they are not limited to any particular depiction. The rights associated with a mark in standard character reside in the wording and not in any particular display. *In re RSI Sys., LLC*, Ser. No. 78848532, 2008 WL 4419360, at *3 (TTAB 2008). We must consider Applicant's and Registrant's marks "regardless of font style, size, or color," *Citigroup Inc. v. Cap. City Bank Grp., Inc.*, 637 F.3d 1344, 1356, (Fed. Cir. 2011), including iterations that emphasize the common element X and deemphasize the word NAKED or NUDE.

Based upon the above analysis, when comparing the marks overall, they are similar in meaning, connotation and commercial impression.⁵⁷ On the whole, the first *DuPont* factor weighs in favor of finding a likelihood of confusion. *See Double Coin Holdings Ltd. v. Tru Dev.*, Can. No. 92063808, 2019 WL 4877349, at *9 (TTAB 2019).

D. Purchasing Conditions and Degree of Customer Care

"The fourth *DuPont* factor considers '[t]he conditions under which and buyers to whom sales are made, i.e. 'impulse' vs. careful, sophisticated purchasing.'" *Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 1319 (Fed. Cir. 2014) (quoting *DuPont*, 476 F.2d at 1361). "When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care." *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329 (Fed. Cir. 2000).

⁵⁷ Although we have pointed to the identical dominant portions of the marks, we acknowledge the fundamental rule that the marks must be considered in their entireties. *See Jack Wolfskin Ausrüstung Fur Draussen GmbH v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1371 (Fed. Cir. 2015); *Massey Junior Coll., Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 1402 (CCPA 1974).

Applicant argues that “[f]actors such as the sophistication of purchasers, coupled with the expense of the product and the likely care purchasers of the product would exercise, can reduce the likelihood of confusion”⁵⁸ while at the same time admitting that the goods provided by Applicant and Registrant are “not expensive.”⁵⁹ Applicant, however, suggests that consumers are “picky when it comes to products that may enhance their physique, especially their face.”⁶⁰ Applicant’s argument fails to account for the goods as identified in the Application and Registration and the customers that entails. *Stone Lion Cap.*, 746 F.3d at 1324. Because the identifications of goods are unrestricted without limitation as to their price or intended consumer, potential consumers include people who are not picky. *Gen. Mills, Inc. v. Fage Dairy Processing Indus. S.A.*, Opp. No. 91118482, 2011 WL 6001095, at *13 (TTAB 2011) (“we must base our decision on the least sophisticated potential purchasers”). Thus, while Applicant’s and Registrant’s consumers may include those who are picky and exercise care in selecting their hair or cosmetic products, “[i]t is settled ... that even sophisticated purchasers are not immune from source confusion, especially in cases such as the instant one involving similar marks and closely related goods.” *In re Cook Med. Techs. LLC*, Ser. No. 77882876, 2012 WL 8254584, at *7 (TTAB 2012); see *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 948-49 (Fed. Cir. 2000); *In re Rsch. Trading Corp.*, 793 F.2d 1276, 1279 (Fed. Cir. 1986) (citing *Carlisle Chem. Works*,

⁵⁸ 6 TTABVUE 29.

⁵⁹ December 21, 2022 Response to Office Action at TSDR 4 n.1.

⁶⁰ *Id.* Applicant provides no evidence in support of these arguments. “Attorney argument is no substitute for evidence.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1373 (Fed. Cir. 2018).

Inc. v. Hardman & Holden Ltd., 434 F.2d 1403, 1406 (CCPA 1970) (“Human memories even of discriminating purchasers...are not infallible.”)).

We find the fourth *DuPont* factor is neutral. See *Turdin v. Trilobite, Ltd.*, Conc. Use No. 94002505, 2014 WL 343270, at *11 (TTAB 2014).

II. Conclusion – Considering the DuPont Factors

We have carefully considered all of the evidence made of record, as well as all of the arguments related thereto. Applicant has not shown that NAKED X is weak and while somewhat different in appearance and sound, overall the marks evoke similar connotations and commercial impressions. The similarities of the marks, coupled with similarity in goods marketed in the same trade channels to the same classes of consumers, lead us to the conclusion that there is a likelihood of confusion resulting from registration of the Application.

Decision: The Section 2(d) refusal is affirmed.