

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

Paper No. 29
TJQ

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Paco Rabanne Parfums, S.A.
v.
Donald W. Magyar

Opposition No. 93,787
to application Serial No. 74/334,463
filed on November 25, 1992

Michael J. Striker of Striker, Striker & Stenby for Paco
Rabanne Parfums, S.A.

Edward F. McHale of McHale & Slavin for Donald W. Magyar.

Before Seeherman, Quinn and Walters, Administrative
Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Donald W. Magyar to
register the mark SEXCESS for "cosmetics, namely,
perfumery."¹

Registration has been opposed by Paco Rabanne Parfums,
S.A.² under Section 2(d) of the Act on the ground that

¹Application Serial No. 74/334,463, filed November 25, 1992,
alleging a bona fide intention to use the mark in commerce.

²The original opposition was filed by Arambel, S.A. When the
pleaded registration was assigned to Paco Rabanne Parfums, S.A.,

applicant's mark, when applied to applicant's goods, so resembles opposer's previously used and registered mark EXCESS for "perfume, personal deodorants, body soap, body oils, lotions and powder, bath gel and salt, hair shampoo, aftershave cologne, eau de toilette and lipstick, eyeliner, eyeshadow, mascara and blush"³ as to be likely to cause confusion, or to cause mistake, or to deceive.

Applicant, in his answer, denied the salient allegations of likelihood of confusion.

The record consists of the pleadings; the file of the involved application; trial testimony (with related exhibits) taken by each party; and a status and title copy of opposer's pleaded registration introduced by opposer's notice of reliance.⁴ Both parties filed briefs on the case. An oral hearing was not requested.

Opposer has made of record, as noted above, a status and title copy of its pleaded registration for the mark EXCESS. Thus, there is no issue with respect to opposer's priority. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

the two entities were joined as party plaintiffs. Paco Rabanne Parfums, S.A. is hereby substituted as the party plaintiff in this proceeding. Fed. R. Civ. P. 25(c).

³Registration No. 1,848,910, issued August 9, 1994. The assignment to the present opposer is recorded in the Office at reel 1261, frame 0405.

⁴Applicant has referred to a dictionary definition of the term "excess." Although a copy of the dictionary listing was not submitted, we take judicial notice of this evidence and, thus, have considered it in reaching our decision. The term is defined as "action or conduct which goes beyond the usual, reasonable or lawful limit; lack of moderation, intemperance, overindulgence."

Opposition No. 93,787

A determination of likelihood of confusion requires an analysis of the relevant factors listed in *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis under Section 2(d) of the Act, two key considerations are the similarities between the marks and the similarities between the goods. In the present case, as conceded by applicant (brief, p. 3), the goods are legally identical. Indeed, opposer's and applicant's perfume are assumed to travel in the same channels of trade and to be bought by the same classes of purchasers.

In view of the legal identity between the goods, we turn to focus our attention, as have the parties, on the crux of the controversy, that is, the similarities/dissimilarities between the marks EXCESS and SEXCESS. The Board notes, at the outset, that when marks appear on identical goods, as here, the degree of similarity between the marks necessary to support a conclusion of likelihood of confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Further, in considering the marks, we have kept in mind the normal fallibility of human memory over time and that the average consumer retains a general rather than a specific recollection of trademarks encountered in the marketplace.

Applicant took the testimony of Dr. Joan Young, a retired college professor of English. Dr. Young's training

Opposition No. 93,787

included a year of graduate study in English, and applicant has presented her as a language expert. Dr. Young testified as to some of the differences between the marks. However, certain other portions of her quite candid testimony are revealing. Dr. Young pointed out that applicant's mark is, in linguistics terminology, a "portmanteau" word, that is, a blended word formed from other words. She gave the example of "brunch" which is a blend of the words "breakfast" and "lunch." Although blended words typically are formed from the parts of other words, applicant's mark, according to Dr. Young, is formed from two entire words, namely "sex" and "excess." Dr. Young also conceded that an innate characteristic of languages is for "the last sound of one word [to] be slid into the next." In this connection, she acknowledged that a phrase comprising the word "excess" preceded by a word ending with the "ess" sound (such as, "across" or "likes") could be heard as "sexcess" (compare "She likes Excess." versus "She likes Sexcess.").

We find that the marks EXCESS and SEXCESS, when applied to identical and/or closely related cosmetics and toiletries, are likely to cause confusion. Simply put, the similarities between the marks outweigh the differences. The marks look and sound alike. As acknowledged even by applicant's expert, applicant's mark is a blend of "sex" and "excess." And, while the marks may have slightly different meanings, it is likely that consumers, upon encountering the marks EXCESS and SEXCESS on perfume, will ascribe somewhat

Opposition No. 93,787

similar meanings to the marks, given the general practice of marketing perfume as enhancing the sexual allure of the person wearing the perfume.

Opposer contends that its product sold under the mark EXCESS "has been actively promoted and has enjoyed enormous commercial success." Indeed, the testimony of Robert McCormick (vice president of a distributor in the United States of opposer's products) indicates that opposer has promoted its products in a variety of ways throughout the country and that opposer has enjoyed success with its products. However, to the extent that opposer would urge us to conclude that its mark is famous, the evidence falls short of establishing that the mark has achieved the status of a "famous" mark. Compare: *Kenner Parker Toys v. Rose Art Industries*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

We conclude that consumers familiar with opposer's perfume and related cosmetic products sold under its mark EXCESS would be likely to believe, upon encountering applicant's mark SEXCESS for perfume, that the goods originated with or were somehow associated with or sponsored by the same entity.

Decision: The opposition is sustained and registration to applicant is refused.

E. J. Seeherman

Opposition No. 93,787

T. J. Quinn

C. E. Walters
Administrative Trademark Judges
Trademark Trial and Appeal Board