

Hearing:  
October 29, 1997

Paper No. 18  
RFC

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB

JULY 30 ,98

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re RTS Laboratories

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Serial No. 74/607,709

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Michael M. Zadrozny of Shlesinger, Arkwright & Garvey LLP for  
RTS Laboratories.

Jeffrey Martin, Trademark Examining Attorney, Law Office 107  
(Thomas Lamone, Managing Attorney).

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Before Cissel, Quinn and Walters, Administrative Trademark  
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On December 5, 1994, applicant filed the above-referenced  
application to register the mark "NAIL RESTORE" on the  
Principal Register for a "treatment for cuticles and nail  
bed," in Class 3. The application was based on applicant's  
claim of use of the mark in interstate commerce on the filing  
date of the application.

The Examining Attorney refused registration under Section  
2(d) of the Lanham Act on the ground that applicant's mark, as

applied to the goods set forth in the application, so resembles the marks "RESTOR" and "RESTORE PLUS" that confusion is likely. The former is registered for, inter alia, "nail treatment preparations,"<sup>1</sup> and the later is registered for, inter alia, "nail care preparations."<sup>2</sup>

Applicant amended the identification-of-the goods clause to read as follows: "nail care preparations, namely treatments for nail cuticles and nail beds," and disclaimed the right to use the word "NAIL" apart from the mark as shown.

Applicant also included with its response to the refusal to register copies of five third-party registrations. These registered marks, most of which are on the Principal Register, are as follows: "Lip Restore" (in stylized script) for cosmetics, namely lip cream; "RESTORA" for conditioning ingredient in a hair relaxer; "RESTOR SKIN" for funeral cosmetics, namely masking sprays; "RESTORE" for contact lense cleaning enhancer preparations; and "PROTECT & RESTORE" (on the Supplemental Register) for skin cream.

Applicant argued that confusion is not likely because the marks in their entirety are not similar, the commercial impressions created by the marks are not similar, and the term "RESTORE" is weak in source-identifying significance, so that

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<sup>1</sup> Reg. No. 747,038, issued to Buty-Wave Products Company on March 19, 1963; affidavits under Sections 8 and 15 filed; renewed July 26, 1983.

<sup>2</sup> Reg. No. 1,795,524, issued to Buty-Wave Products Company on September 28, 1993.

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its inclusion in applicant's mark, the cited registrations,

and the five third-party registrations submitted by applicant is not likely to confuse prospective purchasers of the goods bearing applicant's mark or either of the cited marks.

The Examining Attorney was not persuaded, and in the second Office Action, he made the refusal to register final. Applicant filed a notice of appeal, followed by a timely-filed appeal brief. The Examining Attorney then filed his brief on appeal, after which applicant requested an oral hearing before the Board.

Applicant next filed a supplement to its brief, attached to which was a copy of an entry from a then-recently-published edition of the Official Gazette in which another third-party mark had been published. The mark is "RES•TOR WITH HUMAN HAIR KERATIN" and design, and the goods are listed as "hair shampoo, hand and body lotion, bubble bath, hair conditioner, hair spray and hair gel." Applicant argued that this information shows that the word "restore" has a normally understood meaning or suggestiveness in the field of cosmetics, and that "marks containing the term have been registered for the same or similar goods because the remaining portions of the mark (sic) are sufficient to distinguish the marks as a whole from one another."

The Board suspended action on the appeal and remanded the application to the Examining Attorney for consideration of the additional evidence. He issued an Office Action in which he

explained why he remained convinced that confusion is likely, and then the requested oral hearing was conducted before the Board on October 29, 1997.

After careful consideration, we hold that confusion is likely because the marks at issue are similar and the products with which they are used are closely related.

As to the first issue, when the marks are considered in their entirety, they are quite similar. As the Examining Attorney points out, the word "RESTORE" is the dominant portion of applicant's mark because the other component, the word "NAIL," is merely descriptive as applied to applicant's product. "NAIL" has, in fact, been disclaimed apart from applicant's mark in its entirety. The same word that dominates applicant's mark, "RESTORE," or its phonetic equivalent, "RESTOR," is also the dominant portion of the mark in one of the cited registrations, and the word is the entire mark in the other registration. The marks "RESTOR," "RESTORE PLUS," and "NAIL RESTORE" are similar in appearance, pronunciation, and connotation in connection with preparations used to treat nails. They all create similar commercial impressions, and each suggests that the product with which it is used can restore or repair nails.

Applicant's argument that the term is weak in trademark significance is not persuasive of a different conclusion. The third-party registrations (as well as the reference to the

published application wherein the goods are hair care products) do serve to establish the meaning of the term "restore" as applied to the cosmetic products listed therein. However, these third-party registrations and the third-party application do not establish use of the marks therein, nor do they show that the consuming public is familiar with the marks in connection with the listed goods, much less that such familiarity has resulted in any loss of source-identifying significance for the term "restore." Significantly, the goods listed in the application and the registrations are lip cream, skin cream, hair relaxer ingredients, masking sprays for funeral cosmetics, and hair and skin products. Even if we were presented with evidence of the use and promotion of these goods under these marks, such evidence would not establish that the term "restore" is weak in trademark significance as applied to nail care products.

The goods with which applicant uses its mark are closely related to the goods identified in the cited registrations. All are nail care preparations. Use of these three similar marks, all of which are suggestive as applied to such products, is quite likely to cause confusion, especially when the nature of the goods is considered. These nail-care preparations are not expensive products purchased by sophisticated purchasers. Instead, they are identical inexpensive consumer goods purchased by ordinary people, often

on impulse. Under these circumstances, where particular care is not necessarily exercised by the buyers, the use of these similar marks on the same kinds of goods is surely likely to cause confusion.

If we were left with any doubt on the issue of whether confusion is likely, such doubt would necessarily be resolved in favor of the prior registrant. Applicant, as the newcomer in this particular segment of the cosmetic market, had a duty to select a mark that would not cause confusion. By adopting the equivalent of one of the registered marks and the dominant portion of the other, and adding only the merely descriptive word "NAIL," applicant has failed to steer clear of the previously registered marks. *Burroughs Wellcome Co. v. Warner-Lambert Co.*, 203 USPQ 191 (TTAB 1979).

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Accordingly, the refusal to register based on the likelihood of confusion with the two cited marks is affirmed, and registration to applicant is denied.

R. F. Cissel

T. J. Quinn

C. E. Walters  
Administrative Trademark Judges,  
Trademark Trial & Appeal Board

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