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U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re **Calrio Corporation**

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Serial No. 75/020,313

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Calrio Corporation, pro se.

Midge F. Butler, Trademark Examining Attorney, Law Office  
108 (David Shallant, Managing Attorney).

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Before Simms, Cissel and Hohein, Administrative Trademark  
Judges.

Opinion by **Cissel**, Administrative Trademark Judge:

On November 15, 1995, applicant filed an application to register the mark "LADY ESSENCE" on the Principal Register for "body shapers and health and beauty aids," in Class 25. The application was based on applicant's assertion that it possessed a bona fide intention to use the mark in commerce in connection with the specified goods.

In addition to requiring amendment to the identification-of-goods clause and a disclaimer of the word "LADY," the Examining Attorney refused registration under

Section 2(d) of the Act on the ground that if applicant's mark were applied to the goods set forth in the application, it would so resemble the mark "ESSENCE," which is registered for "panty hose,"<sup>1</sup> and "clothing, namely, t-shirts,"<sup>2</sup> that confusion would be likely.

Applicant responded by amending the identification-of-goods clause and entering the requested disclaimer, which pertained only to the goods in Class 25. The identification-of-goods clause was amended to read "health and beauty aids, namely, lotions and creams for topical application to a person's skin, in International Class 3; and, body shapers, in International Class 25." Applicant, in support of its arguments that confusion is not likely, included copies of five third-party registrations for marks incorporating the word "ESSENCE," together with a copy of printed materials from packaging for a body shaper sold under the mark "LADY DIANA" by a company which is related to applicant.

Applicant argued that confusion is not likely because the third-party registrations establish that the term "ESSENCE" is in common use for women's health care and

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<sup>1</sup> Reg. No. 1,893,636 issued to Essence Communications, Inc. on May 9, 1995.

<sup>2</sup> Reg. No. 1,204,615 issued to the same entity on August 10, 1982. An affidavit under Section 8 of the Act was subsequently submitted.

clothing products, and is therefore weak in source-identifying significance. The body shaper packaging was submitted to demonstrate that body shapers are different from the goods listed in the cited registrations. The goods are pictured and described in the text of these materials. Body shapers appear to be foundation garments similar to girdles or corsets.

The Examining Attorney was not persuaded by applicant's argument, and the refusal to register was made final in the second Office Action. In support of her conclusion that "ESSENCE" is the dominant portion of applicant's mark, she attached copies of a number of third-party registrations for clothing marks in which the term "LADY" is disclaimed.

Applicant timely filed a request for reconsideration, but although the refusal as to the goods in Class 3 was withdrawn, the Examining Attorney remained of the opinion that confusion would be likely with respect to the Class 25 goods.

Applicant appealed. Both applicant and the Examining Attorney filed briefs. Applicant's brief was accompanied by a copy of a dictionary definition of the word "essence" as meaning "the basic or intrinsic constituent or quality of a thing." Attached to the brief of the Examining Attorney was a photocopy of a dictionary definition of the same word as connoting, inter alia, "a perfume or scent." Applicant

filed a reply brief, but did not request an oral hearing before the Board.

Subsequent to the filing of the reply brief, the attorney who to that point represented applicant petitioned to withdraw as applicant's attorney. The Board granted the petition, but applicant did not designate a new attorney in this matter.

The only issue before the Board in this appeal is whether confusion would be likely between the registered mark "ESSENCE," for panty hose or t-shirts, and applicant's mark "LADY ESSENCE," if it were to be used in connection with body shapers. After careful consideration of the record in this appeal and the relevant legal principles and precedents, we hold that confusion would be likely with respect to the mark which is registered for panty hose.

As is often the case in resolving appeals on the issue of likelihood of confusion, our analysis centers around a comparison of the marks and the goods with which they are, or, in the case of this applicant, will be, used. Because the marks are similar and the goods set forth in the application are related to those specified in the cited registrations, confusion is likely and registration of applicant's mark is barred by Section 2(d) of the Act.

The arguments of applicant and the Examining Attorney center around the similarity of the marks, with very little

discussion of the similarity of the goods. Applicant does contend, however, primarily in its reply brief, that its body shapers are "intended for 'a specialized and an entirely different purpose' than the goods in the applied registrations." (Reply brief, p.2). Applicant goes on to argue that because body shapers are worn underneath other clothing and are ordinarily not visible to others during normal use, and because they are used for a very specific and different purpose than panty hose or t-shirts are, such goods "are not likely to be manufactured by entities offering registrant's goods." (Reply brief, p. 4).

The Examining Attorney correctly notes that in order for confusion to be likely, the goods in question need not be identical or even competitive. All that is necessary is that they be related in some manner, or that the conditions surrounding their marketing are such that they could be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods emanate from a common source. In re International Telephone & Telegraph Corp., 197 USPQ 910 (TTAB 1978). She cites a number of decisions by the Board and our principal reviewing Court wherein confusion was found when similar marks were used on a wide variety of apparel items, from both "underwear" and "neckties," Jockey International, Inc. v. Mallory & Church Corp., 25 USPQ2d 1233 (TTAB 1992), to

"brassieres and girdles," on one hand, and "slacks for men and young men," on the other. Esquire Sportswear Mfg. Co. v. Genesco Inc., 141 USPQ 400 (TTAB 1964). She contends further that the fact that registrant registered its mark for panty hose thirteen years after it registered it for t-shirts demonstrates that clothing manufacturers can be expected to expand their clothing lines to include undergarments such as body shapers. Applicant disagrees.

We do not need to speculate as to why the owner of the cited registrations registered its mark for panty hose long after it registered it for t-shirts. It is well established that in the absence of any restrictions in the identifications of the goods in the application and the cited registrations, the goods named therein must be assumed to move through all normal channels of trade for such goods and to reach all normal purchasers of such products. Alliance Manufacturing Co., Inc. v. ABH Diversified Products, Inc., 226 USPQ 348 (TTAB 1985). Notwithstanding the somewhat different purposes for which body shapers and panty hose are used, such goods are both sold in the women's departments of department stores. They are purchased by or for women and may be worn simultaneously. It is not unreasonable to conclude that a woman, or, for that manner, a man who is shopping for someone else, would encounter both panty hose and undergarments such as the body shapers of

applicant on the same visit to the same department in the same store. Under these circumstances, if the goods were to bear similar trademarks, confusion would clearly be likely.

Turning then to the marks in the instant case, we need not become entangled in the extended arguments of applicant and the Examining Attorney concerning the probative effect of applicant's disclaimer of the word "LADY." The clear rule is that in resolving the question of whether confusion is likely, we must consider the marks in their entireties, in the same way that they are perceived by the purchasing public, rather than dissecting them into their component parts. In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993). The fact that an arguably descriptive word has been disclaimed has no effect on the resolution of this issue. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Nonetheless, under appropriate circumstances, it is not unreasonable to recognize that one word or component of a mark may be dominant in creating the commercial impression engendered by a particular mark. Chemical New York Corp. v. Conmar Form Systems, Inc., 1 USPQ2d 1139 (TTAB 1986). Descriptive matter, whether or not it is disclaimed, may be less significant than another part of a particular trademark. In re National Data Corp., supra. Ordinarily, one may not appropriate the mark of another and avoid a finding of likelihood of confusion

simply by adding a non-distinctive word to the prior-used mark. In re Denise, 225 USPQ 624 (TTAB 1985).

When these principles are considered in view of the marks in the case at hand, we conclude that these marks in their entireties are similar. The word "LADY" per se has obvious descriptive significance in connection with women's foundation garments such as body shapers. In view of this significance, we can reasonably conclude that the term "ESSENCE" will play a more significant role in determining the commercial impression of applicant's mark as a whole.

In light of the fact that the same word, "ESSENCE," constitutes the entirety of the registered mark, we find that confusion would be likely if both marks, "ESSENCE" and "LADY ESSENCE," were used on these related products for women. A shopper in the women's department of a department store who is familiar with the "ESSENCE" brand of panty hose would, upon encountering the mark "LADY ESSENCE" on body shapers in the same area of the same store, be likely to assume, mistakenly, as it would turn out to be in this case, that the same commercial source was responsible for both products.

The existence of the third-party registrations of other marks which consist of or include the word "ESSENCE" does not dictate a different result. The registrations do show that the term has a suggestive meaning in connection with

some products, and the dictionary definitions made of record by both the Examining Attorney and the applicant shed light on what that meaning is. With respect to these items of apparel, which presumably are not scented or perfumed, the word connotes that the goods possess "the intrinsic or indispensable properties that serve to characterize or identify (them)." (The American Heritage Dictionary, Second Edition, submitted by the Examining Attorney with her brief). The term suggests that the item of apparel with which it is used is the essence or distillation of the characteristics of such a product. The point here is not what suggestive connotation the word has, however, but rather that the suggestive connotation of the word is the same with respect to both panty hose and body shapers. It is that very close similarity of the connotations of these marks in connection with these related products, as well as the similarities in sound and appearance, that lead us to the conclusion that confusion is likely.

Accordingly, the refusal to register based on Section 2(d) of the Act is affirmed as to the registration of "ESSENCE" for panty hose. In view of this finding, we need not resolve the issue of whether confusion is likely with regard to the mark registered for t-shirts, and we decline to do so. Because confusion is likely with respect to the

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mark registered for panty hose, registration to applicant is refused.

R. L. Simms

R. F. Cissel

G. D. Hohein  
Administrative Trademark Judges,  
Trademark Trial & Appeal Board

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