

UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB  
PWC

10/27/99

Opposition No. 101,936

Parfums De Coeur, Ltd.

v.

Colorado Medical Center,  
P.C.

Before Hanak, Quinn, and Walters,  
Administrative Trademark Judges.

By the Board:

Parfums De Coeur, Ltd. ("opposer") has opposed the application of Colorado Medical Center, P.C. ("applicant") to register the mark LE COEUR for "skin and hair care preparations; perfume and cologne; hair lotions; moisturizing lotions; skin soaps; essential oils for use in manufacturing cosmetics and perfume; cosmetics, namely foundation makeup, blushes, eyeliner, and skin cream."<sup>1</sup> As grounds for the opposition, opposer contends that it is engaged in the manufacture, advertising and distribution of perfumes, colognes, dusting powders, lotions and body sprays; that since September 17, 1981, it has continuously

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<sup>1</sup> Application Serial No. 74/665,541, filed on April 25, 1995, based on applicant's bona fide intent to use the mark in commerce. Applicant did not file an amendment to allege use prior to publication of the mark.

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used the mark PARFUMS DE COEUR on its goods in interstate commerce; that it owns two incontestable registrations: Registration No. 1,650,533, for the mark shown below for



"perfumes and cologne";<sup>2</sup> and Registration No. 1,653,415, for the mark PARFUMS DE COEUR in typed form for "perfumes and cologne";<sup>3</sup> that applicant's mark, LE COEUR, is highly similar to its registered marks; that the parties' asserted marks will be used on identical goods which will be sold in the same channels of trade to identical classes of purchasers; and that a likelihood of confusion exists under Trademark Act Section 2(d) between its previously used and registered marks and the mark in the application at issue.

Applicant, in its answer, denies the salient allegations of the notice of opposition, except that it admits that "Opposer has used the 'Parfums De Coeur' mark in connection with perfumes, colognes, and/or body sprays," and

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<sup>2</sup> Registration No. 1,650,533, issued July 16, 1991 with a disclaimer of "PARFUMS," reciting November 4, 1981 as a date of first use in commerce on the goods. Section 8 affidavit accepted, Section 15 affidavit filed.

<sup>3</sup> Registration No. 1,653,415, issued August 13, 1991 with a disclaimer of "PARFUMS," reciting November 4, 1991 as a date of first use in commerce on the goods. Section 8 affidavit accepted, Section 15 affidavit filed.

that "the public and retail trade has come to recognize the 'Parfums De Coeur' mark as a 'designer knockoff' or 'knockoff perfume' or 'designer imposter.'"

This case now comes before the Board for consideration of opposer's motion for summary judgment on the ground of likelihood of confusion under Trademark Act Section 2(d). The motion is fully briefed.<sup>4</sup>

In support of its motion for summary judgment, opposer essentially argues that applicant's mark, LE COEUR, is highly similar to its pleaded marks; that applicant's goods are identical in part to those identified by the marks in opposer's asserted registrations; that opposer's marks have achieved widespread recognition as the source of high quality, lower cost fragrances; that opposer has established priority of use inasmuch as both of its incontestable registrations pre-date applicant's intent-to use application; that the goods in the pleaded registrations and involved application will be available in the same channels of trade to the same classes of purchasers; that both parties' goods are inexpensive, "impulse" items receiving a lower degree of consumer care in their selection; and that

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<sup>4</sup> Opposer's consented motion to file a reply brief is granted. In this case, we have considered opposer's reply brief because it clarifies the issues and aids us in coming to a just decision on the motion. See Trademark Rule 2.127(a).

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applicant may have intended "to consciously imitate Opposer's mark."

Opposer has submitted the affidavits of its president, Mark A. Laracy, and one of its attorneys, Marni J. Beck; certified copies of its pleaded registrations; examples of media articles featuring opposer and its products; printed and videotaped copies of its advertisements; samples of its product packaging; portions of the record in this proceeding; and applicant's answers to opposer's first set of interrogatories and document requests.

In response to the motion for summary judgment, applicant maintains that there are disputed material facts relative to the character and prices of the respective goods, the channels of trade and distribution, the character of the purchasers and applicant's intent in adopting its mark, which should preclude the granting of summary judgment. More specifically, applicant argues that opposer's goods are "designer knock-off" fragrances ranging in price from \$1.95 to \$7.95 and distributed through chain drugstores and mass merchandisers, while applicant's goods will be designer fragrances ranging in price from \$20 to \$50 and marketed through mail order or high end retail outlets; that evidence submitted by opposer indicates that consumers of its goods are "totally different" from consumers of designer fragrances; that due to the sophistication of the

purchasers, differences in price, and different channels of trade, likelihood of confusion between the goods is small; and that applicant had no prior knowledge of opposer's marks and did not intend to adopt a confusingly similar mark.

In support of its position, applicant has submitted the affidavit of its attorney and vice president, Thomas H. Swineheart; a copy of a trademark search performed by applicant; and a price list regarding additional goods offered by applicant under different marks from the one at issue in this proceeding.

In reply, opposer submits the affidavit of its president, Mark A. Laracy, asserting that because applicant does not argue the differences between its mark and those of opposer, applicant effectively concedes the similarity thereof; and that because the goods as identified in the application at issue are not limited as to price, channels of trade, or classes of purchasers, applicant's arguments regarding such limitations are immaterial.

As has often been stated, summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). The party moving for summary judgment has the initial burden of demonstrating the absence of any genuine issue of material fact. See *Celotex Corp. v.*

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*Catrett*, 477 U.S. 317 (1986), and *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). A factual dispute is genuine, if, on the evidence of record, a reasonable finder of fact could resolve the matter in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992), and *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). The evidence must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993), and *Opryland USA, supra*.

Preliminarily we note that priority of use is not at issue in this proceeding inasmuch as opposer has pleaded ownership of Registration Nos. 1,650,533 and 1,653,415 and introduced status and title copies thereof, and because applicant has not filed a counterclaim for cancellation of those registrations. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 182 USPQ 108 (CCPA 1974).

Turning to the statutory grounds of likelihood of confusion in determining the issue thereof, and hence whether there is any genuine issue of material fact relating thereto, we must consider all of the probative facts in evidence which are relevant to the factors bearing on

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likelihood of confusion, as identified in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). As noted in the *du Pont* decision itself, each of the factors may from case to case play a dominant role. Indeed, our principal reviewing court and this Board frequently have held, in appropriate cases, that a single *du Pont* factor may be dispositive of the likelihood of confusion analysis. See, for example, *Kellogg Co. v. Pack 'Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990), aff'd. 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). The factors to which we have probative evidence are discussed below.

After a careful review of the record in this case, we find that there are no genuine issues of material fact relating to those factors.

Turning first to the relatedness of the parties' goods, the likelihood of confusion analysis is based upon the goods as identified in the involved application and registrations. See, for example, *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973). Moreover, the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods.

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*See Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). Herein, opposer's goods, identified as perfumes and cologne, are included among the goods identified in the application at issue. Applicant's goods are thus identical in part to those of opposer. As such, applicant's contention that the parties' goods differ is not well taken. In contending that opposer's product is less expensive, sold primarily in drugstores and costing between \$2-8 while applicant's are intended to be sold in high-end department stores and by mail order, costing between \$20-50, applicant improperly attempts to impose limitations on the parties' goods that are not present in the identifications thereof. *See Id.* As identified in the pleaded registrations and the application at issue, the parties' perfume and cologne are identical.

Turning next to the parties' asserted marks, our primary reviewing court has held that when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines. *See Century 21 Real Estate Corp. v. Century Life of America*, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Moreover, it is well established that the test for determining likelihood of confusion is not whether the marks are distinguishable upon side-by-side comparison but rather whether they so resemble one another as to be likely to

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cause confusion. *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). The marks at issue must be considered in their entireties; however, if one feature of a mark is more significant than another feature, it is proper to give greater force and effect to that dominant feature for purposes of determining likelihood of confusion. See, for example, *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983).

In this case, opposer's pleaded mark (in Registration No. 1,653,415) comprises the wording PARFUMS DE COEUR in typed form. In regard to the wording in the marks at issue, descriptive or generic wording is less significant for purposes of determining likelihood of confusion. See *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976); and *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988). Inasmuch as the term "PARFUMS" is descriptive if not generic for the goods at issue, the dominant portion of those marks is "DE COEUR." Applicant's mark, LE COEUR, is nearly identical to the most significant and distinctive feature of opposer's marks.

Therefore, we find that a likelihood of confusion exists, at a minimum, between applicant's mark LE COEUR and opposer's word mark PARFUMS DE COEUR as used on their identical goods. Moreover, applicant's unsupported

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assertions that its goods are intended to move in different channels of trade from those of opposer, and will be subject to careful scrutiny by sophisticated consumers, are unpersuasive given the fact that as set forth in the application and Registration No. 1,653,415 the goods are, in part, identical.

In sum, applicant has failed to disclose any evidence that points to the existence of a genuine issue of material fact on the issue of likelihood of confusion.

We find therefore that opposer has carried its burden of proof that no genuine issues of material fact remain as to likelihood of confusion and that opposer is entitled to judgment as a matter of law. In view thereof, opposer's motion for summary judgment is granted. The opposition is sustained and registration is refused to applicant.

E. W. Hanak

T. J. Quinn

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