

THIS DISPOSITION IS NOT
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SEPT. 24, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Origins Natural Resources, Inc.
v.
One World, Inc.

Opposition No. 106,245
to application Serial No. 75/040,609
filed on January 5, 1996

Allan Zelnick and Patrick T. Perkins of Fross Zelnick
Lehrman & Zissu for Origins Natural Resources, Inc.

John Cyril Malloy, III and Andrew W. Ransom of Malloy &
Malloy for One World, Inc.

Before Quinn, Bucher and Bottorff, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by One World, Inc. to
register the mark shown below

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for "cosmetics, namely skin, medicated and body soaps."¹

Registration has been opposed by Origins Natural Resources, Inc. under Section 2(d) of the Act. As the basis of its claim of likelihood of confusion, opposer alleges that applicant's mark, if applied to applicant's goods, would so resemble opposer's previously used and registered ORIGINS marks for a wide variety of products, including cosmetics such as soap, cleansers, bubble bath and shower gel, as to be likely to cause confusion. Opposer also pleaded, under Section 2(a), that applicant's mark falsely suggests a connection with opposer.

Applicant, in its answer, denied the salient allegations of the notice of opposition.

The record consists of the pleadings; the file of the involved application; testimony taken by each party (with opposer's accompanied by related exhibits);² a testimonial declaration of opposer submitted pursuant to the parties' stipulation; and certified copies of opposer's registrations, applicant's responses to opposer's interrogatories, and excerpts from printed publications, all

¹ Application Serial No. 75/040,609, filed January 5, 1996, alleging a bona fide intention to use the mark in commerce.

² Opposer contends that nearly all of applicant's testimony of Gina Saati is inadmissible and "must largely be disregarded." Suffice it to say, we have read Ms. Saati's testimony with opposer's objections in mind, and have allowed the testimony in, and have accorded probative weight to it, where appropriate.

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introduced by way of opposer's notices of reliance. Both opposer and applicant filed briefs.

According to the testimony of Daria Myers, opposer's senior vice president, opposer, a subsidiary of Estee Lauder, is engaged in the manufacture and sale of cosmetics and related items. A confidentiality agreement precludes us from reciting the specific sales and advertising figures. Suffice it to say, the sales and advertising numbers are impressive. Opposer's products are sold nationwide in approximately 330 department stores and in 28 stores owned by opposer. Opposer's products are advertised on radio, and in magazines, as well as through direct mail campaigns. Opposer also distributes product guides and catalogs. In addition, opposer has benefited from unsolicited mention about its products in articles in publications such as *Family Circle*, *Self*, *Instyle* and *Bazaar*.

Applicant took the testimony of Gina Saati, applicant's founder and vice president. According to Ms. Saati, applicant sells a range of products under the mark GINA, primarily to customers in Caribbean, South American and other third-world countries. Ms. Saati, whose fanciful depiction apparently is shown in applicant's mark, testified that the involved mark was selected to avoid confusion with a previously used GINA mark, owned by a third party, for cosmetics. In this connection, Ms. Saati stated that "we

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decided that we needed a name that was very close to Gina" and that "when we realized we couldn't work with the Gina, we decided we would make Origina and let them [purchasers] know this is the Original Gina, not the ones those people are copying, this is the real thing." (Dep., pp. 11-12.)

With respect to priority of use, opposer's ownership of valid and subsisting registrations establishes its priority. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Opposer has made the following registrations of record: ORIGINS for "retail clothing and jewelry store services"; "jewelry"; "clothing, namely dresses, sweaters, coats, pants, long dresses, stoles, neckwear, scarves, hats, skirts, blouses, ponchos, shawls, kimonos and sarongs"; "body lotions, skin cleansing creams and facial moisturizing creams, sold in applicant's own store and through applicant's catalogs"; "stationery, greeting cards, wrapping paper and scented lining paper"; "face make-up, face powder, lipstick, blusher, mascara, eye make-up pencils, eye shadow, face and body moisturizers, cleansers, soap for personal use, bubble bath, shower gel, bath salt, bath oils, bath powder, suntanning and suncare preparations, personal deodorants, breath-freshener, skin treatment cleanser, creams and lotion"; "books in the fields of Native American culture, the American southwest, India and Indian spirituality, health and cooking"; "retail store

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services for the sale of scented lining paper, wrapping paper, greeting cards, stationery, hat boxes, umbrellas, nail brushes, body brushes, soap dishes, body washing mitts, shoe sachets, candles, rubber stamp pads and ink pads, pocketbooks, backpacks, makeup bags, books, cooking herbs, flavored honey syrups, hard candy, magazines, compact discs, cassettes, video cassettes, table coasters to protect furniture, agenda calendars, crayons, pencils, hair brushes, body massage brushes, [and] scented linen liners"; "bed linens, bed spreads, duvet covers, table linens, table cloths not of paper, textile wall hangings, textile napkins, textile placemats, embroidery, textile floor mats [and] rugs"; "musical sound recordings, namely compact discs, audio cassettes and phonograph records"; "pencil holders, mirrors, picture frames, wood carvings, wooden boxes, furniture, namely wall shelves, candle holders not of precious metal, baskets of straw, leather, woven metal bands and wire, bowls, decorative vessels, and textile wall hangings, primarily made from cloth, beads, and other fibers"; and the mark shown below

for "moisturizers and sunscreen preparations."

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. Federated Food, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Insofar as the goods are concerned, although opposer markets a wide range of products and services, some of which are entirely unrelated to applicant's goods, opposer's products include body soap and other cosmetics. Applicant's goods are identified as "cosmetics, namely skin, medicated and body soaps." Thus, the parties' goods, at least in part, are legally identical, and are otherwise related to the extent that both parties' goods include cosmetics. We presume that the parties' soaps are relatively inexpensive, and may be the subjects of impulse purchases. The goods would travel in the same channels of trade to the same classes of purchasers.

We next turn to a comparison of the marks which, for us, is a critical factor in deciding this case. The

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involved marks must be considered in their entireties. When so considered, it is our view that the marks are very different in terms of sound, appearance, meaning and overall commercial impression. The terms ORIGINS and ORI-GINA sound and look different. In any event, the term ORI-GINA in applicant's mark is accompanied by a pictorial representation of a woman's face. This design feature is quite prominent in applicant's mark and, coupled with the literal feature, clearly gives the mark a different meaning and overall commercial impression from opposer's word mark.

Applicant's mark conjures up the image of a woman whose name is "Gina," and, in applicant's case, who is the "original Gina." This commercial impression is to be contrasted with the one engendered by the commonly understood term "ORIGINS." As Ms. Myers testified in explaining why the term was selected for opposer's mark: "The concept behind Origins is the return to basics, going back to nature and plant materials for our product formulations and for simplicity and basically going back to our origins." (Dep., pp. 6-7.)

Opposer also has introduced, pursuant to stipulation, the declaration of Ms. Myers which is accompanied by two exhibits. One is a "face chart," showing a pictorial representation of the face of a woman, which is used to demonstrate potential cosmetics regimens for customers. The

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other exhibit is a product brochure which shows the actual face of a man. Opposer argues that its "mark has, on occasion, appeared in connection with a woman's, as well as a man's face" and that "[c]onsumers are likely to believe that applicant's mark is another instance of [opposer] presenting one of its marks in connection with a woman's face." (Brief, p. 12.) This argument hardly is persuasive of a different result when we compare opposer's mark with the mark sought to be registered. The faces used by opposer certainly are not trademarks and, moreover, are not included in any of its marks.

Opposer also argues that the design element of applicant's mark has no source identifying function, and that any mention of applicant's cosmetics in articles or editorials in fashion magazines would not include the design element, but rather only ORI-GINA. Opposer is ignoring the fact, however, that applicant is not attempting to register the literal portion only; the mark includes the woman's face design portion which, of course, we must consider in our comparison of the marks.

Opposer further contends that its mark is "famous" and "strong." Indeed, the record reveals that opposer has enjoyed success with the products sold under the mark ORIGINS. Further, the record is devoid of evidence of any third-party uses or registrations of similar marks for

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cosmetic products. Although we are willing to accept the claim that opposer's mark is strong in the trade, we do not accord, however, the status of "famous mark" to the mark ORIGINS. Cf.: *Kenner Parker Toys v. Rose Art Industries*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

In sum, we find that the marks, when considered in their entireties, are very different in overall commercial impressions such that, even when the marks are applied to identical products, confusion is unlikely to occur in the marketplace.

Finding no likelihood of confusion, we now turn to opposer's claim that applicant's mark falsely suggests a connection with opposer as contemplated by Section 2(a) of the Act. In order to prevail, opposer must show that the mark sought to be registered is the same or a close approximation of its previously used name or identity. It must also be shown that the person identified by the mark is not connected with the goods for which the mark is sought to be registered. Opposer must also show that the fame or reputation of its name or identity is sufficient that a connection with opposer would be presumed when applicant's mark is used on its goods. In re *North American Free Trade Association*, 43 USPQ2d 1282, 1284 (TTAB 1997), citing *In re Cotter & Co.*, 228 USPQ 202, 204 (TTAB 1985). See also: *The University of Notre Dame du Lac v. J. C. Gourmet Food*

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Imports Co., Inc., 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

In the present litigation, opposer has devoted the bulk of its efforts, both at trial and in its brief, to the likelihood of confusion claim. We likewise see no reason to dwell on the Section 2(a) claim inasmuch as it clearly falls short. Simply put, the claim fails because we find that applicant's mark is not the same as or even a close approximation of opposer's name or identity. As set forth in more detail above, there are significant differences between opposer's name or identity (which is also opposer's mark), ORIGINS, and applicant's mark ORI-GINA and design.

Decision: The opposition is dismissed.

T. J. Quinn

D. E. Bucher

C. M. Bottorff
Administrative Trademark
Judges, Trademark Trial
and Appeal Board